

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE  
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

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LUMINEX INTERNATIONAL CO., LTD.,  
Petitioner,

v.

SIGNIFY HOLDINGS B.V.,  
Patent Owner.

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IPR2024-00101  
Patent 10,299,336 B2

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Before KATHERINE K. VIDAL, *Under Secretary of Commerce for  
Intellectual Property and Director of the United States Patent and  
Trademark Office.*

ORDER

Granting Director Review, Vacating the Decision Denying Institution, and  
Remanding to the Patent Trial and Appeal Board  
for Further Proceedings

## I. INTRODUCTION

Luminex International Co., Ltd. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–20 of U.S. Patent No. 10,299,336 B2 (Ex. 1001, “the ’336 patent”). Signify Holdings B.V. (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”). With Board authorization, Petitioner filed a Preliminary Reply (Paper 8, “Prelim. Reply”) to address Patent Owner’s arguments that instituting review is barred under 35 U.S.C. § 315(b), as well as other arguments. Patent Owner filed a Preliminary Sur-reply (Paper 9, “Prelim. Sur-reply”).

On May 9, 2024, the Board issued a Decision denying institution of *inter partes* review (Paper 10, “Dec.” or “Decision”). The Board determined that Petitioner had failed to identify Menard, Inc. (“Menard”)<sup>1</sup> as a real party in interest (“RPI”), and that Menard was, in fact, a real party in interest. Dec. 42. Accordingly, because Menard was served with a complaint alleging infringement of the ’336 patent more than one year before the Petition was filed, the Board held that 35 U.S.C. § 315(b) barred institution. *Id.* The Board did not reach other issues argued by the parties. *See id.* at 18, 23, 42–43.

On June 6, 2024, Petitioner filed a request for Director Review seeking review of the Board’s RPI determination. Paper 11 (“DR Req.” or “Director Review Request”), 3; Ex. 3100. I have reviewed the Director Review Request, the Board’s Decision denying institution, the relevant papers, and the relevant exhibits of record in this proceeding. I determine

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<sup>1</sup> Petitioner supplies products to Menard, which owns stores that sell these products. *See, e.g.*, Ex. 2002, 8; Ex. 2013, 8; Ex. 3002, 3.

that Director Review of the Board’s Decision denying institution is appropriate. *See Revised Interim Director Review Process*<sup>2</sup> §§ 4.B, 5.A. For the reasons set forth below, I vacate the Board’s denial of institution and remand to the Board for further proceedings consistent with this decision.

## II. BACKGROUND

On August 26, 2022, Patent Owner served third-party Menard with a complaint alleging infringement of the ’336 patent and five other patents related to lighting products. *See Exs. 2003–2004*. On October 14, 2022, Menard filed an answer to the complaint. *See Ex. 3002*. In Menard’s answer, Menard asserted “all available defenses” under “35 U.S.C. §271,” “§283,” “§284,” and “§285,” but it did not assert invalidity as defense under § 282. *Id.* at 15–16. Menard also asserted as a defense that “Menard’s suppliers will indemnify and defend Menard in this action. The suppliers will be added to this action.” *Id.* at 15.

On October 27, 2022, Menard filed a third-party complaint against Petitioner and twelve other light suppliers in the existing civil action between Signify and Menard. *See Ex. 2001*.<sup>3</sup> In its third-party complaint,

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<sup>2</sup> Available at [www.uspto.gov/patents/ptab/decisions/revised-interim-director-review-process](http://www.uspto.gov/patents/ptab/decisions/revised-interim-director-review-process).

<sup>3</sup> Menard subsequently filed an amended third-party complaint. *See Ex. 3003*. Menard identifies American Lighting, Inc. and AFX, Inc. as third-party defendants in its third-party complaint, but does not name them in its amended third-party complaint. *Compare Ex. 2001, 1, with Ex. 3003, 1–2*. Additionally, Menard identifies Canarm, Ltd. and Test Rite Products Corporation as third-party defendants for the first time in its amended third-party complaint. *Compare Ex. 2001, 1–2, with Ex. 3003, 1–2*. In its portions relevant to this proceeding, the amended third party-

Menard asserted a count of indemnification and defense against each of its thirteen lighting suppliers including Luminex for Plaintiff Signify’s claims against Menard. *Id.* ¶¶ 23–189. Further, Menard asserted that “if held liable, Menard is entitled to indemnification by the Third-Party Defendants.” *Id.* ¶ 3. On February 27, 2023, Petitioner answered Menard’s third-party complaint, asserting both affirmative defenses to Patent Owner’s complaint against Menard, including invalidity of the asserted claims of the ’336 patent, and also “cross-claims” against Patent Owner seeking, among other things, a declaratory judgment of invalidity of the ’336 patent claims. Ex. 2002, 93–102.<sup>4</sup>

On October 25, 2023, Petitioner filed the Petition requesting *inter partes* review of claims 1–20 of the ’336 patent, representing itself as the sole real party in interest. *See* Pet. 89.

### III. ANALYSIS

As noted above, the Board determined that Menard was a real party in interest of Petitioner, and because Menard had been served with a complaint alleging infringement of the ’336 patent more than one year before the Petition was filed, the Petition was barred under 35 U.S.C. § 315(b). Dec. 42. The Board, however, did not reach the issues of whether (1) “Menard is also a ‘privy of the petitioner’ under § 315(b);” (2) “Petitioner’s crossclaim seeking a declaratory judgment of invalidity for the ’336 patent is a civil action that triggered § 315(a)’s bar to institution;” (3) “[the Board]

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complaint is identical in substance to the third-party complaint. *Compare* Ex. 2001 ¶¶ 1, 3, 21, 23–35, *with* Ex. 3003 ¶¶ 1, 3, 21, 23–35.

<sup>4</sup> Petitioner subsequently filed an amended answer. Ex. 2013. In its portions relevant to this proceeding, the amended answer is identical in substance to the answer. *Compare* Ex. 2002, 5, 7, 93–102, *with* Ex. 2013, 5, 7, 93–126.

should exercise [its] discretion under § 314(a) to deny institution in view of [a parallel district court] case;” and (4) whether the Petition presents a reasonable likelihood of prevailing with respect to at least one of the challenged claims under 35 U.S.C. § 314(a). Dec. 18, 23, 42–43.

Based upon my review of the current record, I respectfully disagree with the Board’s determination that the facts of record establish that Menard is a real party in interest to this proceeding. I also find, on the current record, that the evidence does not establish Menard to be a privy of Petitioner. Therefore, I determine, on the current record, that institution of *inter partes* review is not barred under 35 U.S.C. § 315(b). I additionally conclude that 35 U.S.C. § 315(a)(1) does not apply to the “cross-claims” asserted by Petitioner, and that 35 U.S.C. § 315(a)(1) likewise does not bar institution in this case.

Finally, in light of Petitioner’s *Sotera*<sup>5</sup> stipulation (Prelim. Reply 7), I decline to exercise my discretion under 35 U.S.C. § 314(a) to deny the Petition in view of a parallel district court proceeding. *See* USPTO Memorandum, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings With Parallel District Court Litigation, 7–8 (June 21, 2022).<sup>6</sup>

Mindful of the parallel district court action and to not further delay these proceedings, I issue this Order now, remanding to the Board to timely address the only remaining issue I will not address here or in my subsequent

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<sup>5</sup> *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A).

<sup>6</sup> Available at [www.uspto.gov/sites/default/files/documents/interim\\_proc\\_discretionary\\_denials\\_aia\\_parallel\\_district\\_court\\_litigation\\_memo\\_20220621\\_.pdf](http://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf).

opinion – to determine whether the Petition presents a reasonable likelihood of prevailing with respect to at least one of the challenged claims under 35 U.S.C. § 314(a), and to determine whether to institute *inter partes* review accordingly. I will issue a subsequent opinion in due course that details my reasoning for my determinations above.<sup>7</sup> Because I will not be addressing issues that will impact the Board’s § 314(a) merits determinations, the Board should proceed with the remand without delay.

#### IV. CONCLUSION

I respectfully vacate the Board’s Decision denying institution and remand to the Board for further proceedings consistent with this Order.

#### V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Director Review is granted;

FURTHER ORDERED that the Board’s Decision denying institution of *inter partes* review (Paper 10) is vacated; and

FURTHER ORDERED that the case is remanded to the Board for further proceedings consistent with this decision.

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<sup>7</sup> The time period for a party to request rehearing based on my determinations herein regarding real party in interest, privity, and the § 315(a) bar to institution will not begin to toll until my forthcoming decision issues. *See* Revised Interim Director Review Process § 5.C.ii; 37 C.F.R. §§ 42.5(b), 42.71(d).

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