

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIDENDUM PRODUCTION SOLUTIONS, INC.,
Petitioner,

v.

ROTOLIGHT LIMITED,
Patent Owner.

IPR2023-01219
Patent 10,197,258 B2

Before GRACE KARAFFA OBERMANN, JEFFREY W. ABRAHAM, and
KIMBERLY McGRAW, *Administrative Patent Judges*.

ABRAHAM, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314, 37 C.F.R. § 42.4

I. INTRODUCTION

A. *Background and Summary*

Videndum Production Solutions, Inc. (“Petitioner”) filed a petition for an *inter partes* review (Paper 1 (“Pet.”)) challenging claims 1–22 of U.S. Patent No. 10,197,258 B2 (Ex. 1001 (“the ’258 patent”)). Rotolight Limited (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). After receiving authorization from the Board, Petitioner filed a Reply to the Preliminary Response (Paper 7), and Patent Owner filed a Sur-reply (Paper 8).

We have authority to determine whether to institute an *inter partes* review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). For the reasons set forth below, we do not institute an *inter partes* review of the challenged claims.

B. *Real Parties-in-Interest*

Petitioner identifies itself and Videndum PLC as real parties-in-interest. Pet. 71. Patent Owner identifies itself and Rotolight Group Ltd. as real parties-in-interest. Paper 4, 1.

C. *Related Matters*

The parties identify *Rotolight Limited v. Videndum PLC and Videndum Product Solutions, Inc.*, Case No. 22-928-MN-JLH (D. Del), in which Rotolight has asserted infringement of the ’258 patent against Petitioner. Pet. 71; Paper 4, 1.

Petitioner indicates that Arnold & Richter Cine Technik GmbH & Co. Betriebs KG (referred to by the parties as “ARRI”) previously filed an *inter partes* review petition against the ’258 patent.¹

Patent Owner identifies several additional related matters, including two IPR proceedings involving the ’258 patent: (1) IPR2022-00262, filed by Petitioner² on December 3, 2021 (“the 262 IPR”) and (2) IPR2021-01497, filed by ARRI on September 3, 2021 (“the 1497 IPR”). Prelim. Resp. 13–14. As discussed in more detail below, the Board denied institution in the 262 IPR on June 8, 2022, and terminated the 1497 IPR on January 30, 2023, after the parties filed a settlement agreement. Prelim. Resp. 14; 262 IPR, Paper 7; 1497 IPR, Paper 36.

D. The ’258 Patent (Ex. 1001)

The ’258 patent, titled “Lighting System and Control Thereof,” issued on February 5, 2019. Ex. 1001, codes (45), (54). The ’258 patent “relates to a lighting system, and the control of a lighting system, and the simulation of lighting special effects, and in particular to a lighting system for videography, broadcasting and cinematography.” Ex. 1001, 1:17–20. According to the ’258 patent, a typical “lighting controller called a ‘flicker box’ . . . is used to produce flickering light effects to mimic flickering light for example from a fire place, candle, electrical spark or lightning.”

¹ Petitioner refers to IPR2021-01496, which did not involve the ’258 patent, but instead involved related U.S. Patent No. 10,197,257 B2. Pet. 71. We consider this to be a harmless typographical error, and understand that Petitioner intended to identify IPR2021-01497, which did involve the ’258 patent. Pet. 71.

² Vitec Production Solutions is listed as the Petitioner in IPR2022-00262, and The Vitec Group PLC is listed as a real party in interest. 262 IPR, Paper 1 at 1. Petitioner changed its name from The Vitec Group PLC to Videndum Production Solutions, Inc. in May 2022. See Ex. 2003.

Ex. 1001, 1:21–25. But flicker boxes are “complex, costly and time consuming” to set up, and the “connection and control of multiple pieces of hardware . . . requir[e] a physical wired connection to the ‘hot’ light source desired to be controlled.” Ex. 1001, 1:30–35. Flicker boxes are also “incompatible with LED light sources” and “require the use of ‘hot’ incandescent light sources which are energy inefficient and also pose health and safety risks to those working on set.” Ex. 1001, 1:39–42.

The “improved solution” the ’258 patent offers includes methods, controllers, and computer programs “for controlling a lighting device to produce user customisable lighting effect,” by, among other things, “calculating a time varying lighting value based on at least one simulation parameter” and “outputting said time varying lighting value thereby to simulate a lighting effect.” Ex. 1001, 1:45–51, 2:61–67, 3:37–43. Figure 2 is illustrative and reproduced below.

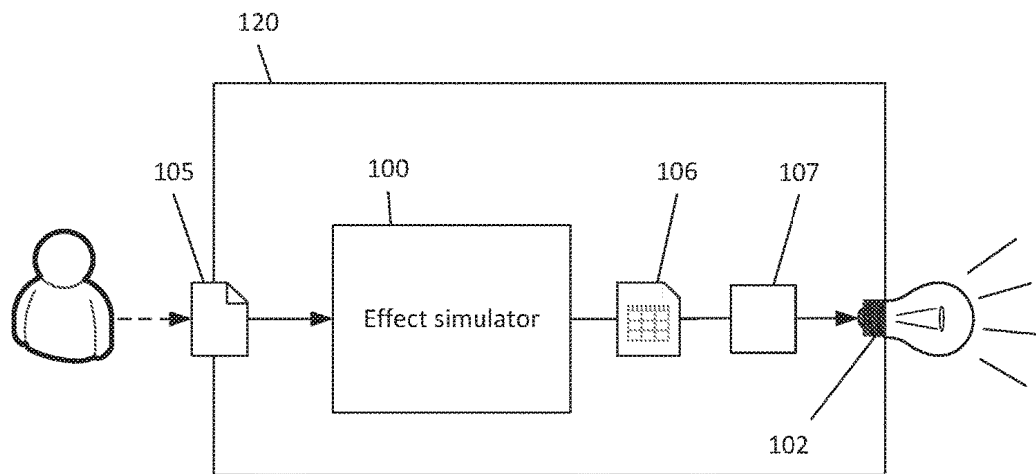


Figure 2

Figure 2 “is a schematic diagram of a further lighting system.” Ex. 1001, 5:29. Figure 2 shows studio lamp device 120 that includes input interface 105 and lighting effect simulator 100 which produces data 106 used to modulate light 102. Ex. 1001, 5:55–6:11. “In one example, the light 102 is an array of LEDs, preferably of differing colours” and a “microcontroller or other computing unit is integrated in the lamp device 120 for performing calculations.” Ex. 1001, 5:63–6:3. The ’258 patent explains that “[t]his arrangement does not require the DMX distribution hub 302 [and] power elements 304, 306” required in a flicker box lighting system. Ex. 1001, 5:64–66. Figure 6, reproduced below, illustrates a simulated lighting effect that employs an exemplary graphic user interface.

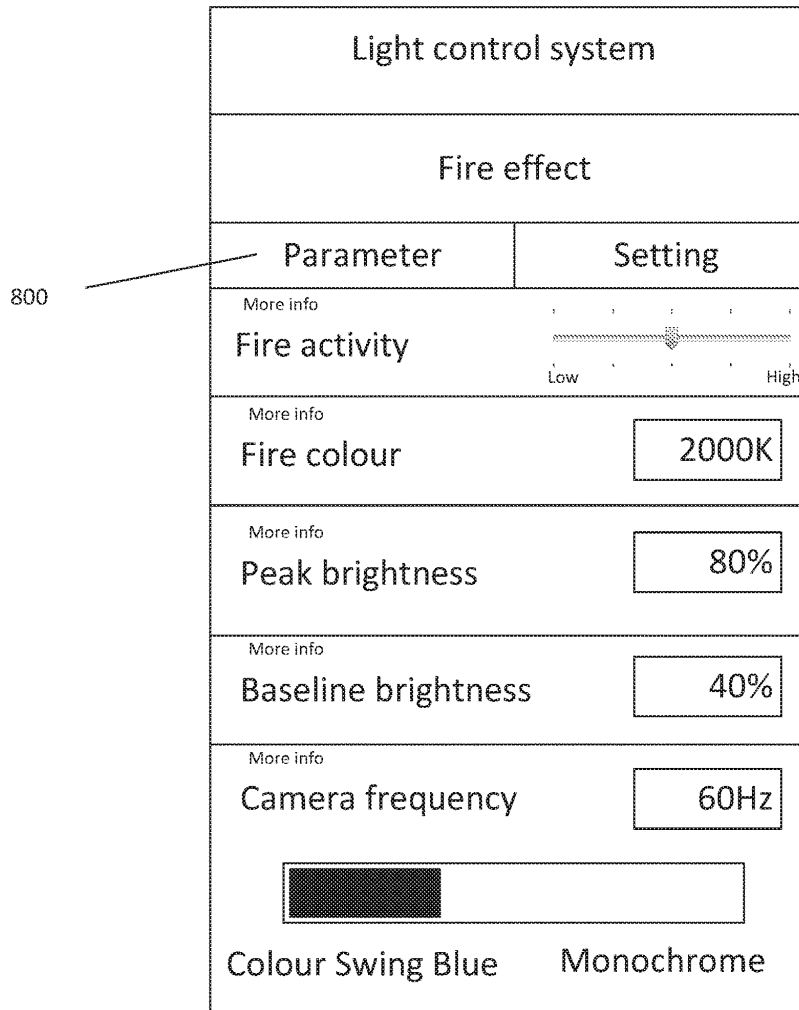


Figure 6

Figure 6 “is a graphic user interface [800] for user input of simulation parameters.” Ex. 1001, 5:35–36. According to Figure 6, the simulated effect is a fire effect. Ex. 1001, 8:17–25. Interface 800 allows the user to select a “fire activity” by sliding the slider between low to high and set values for “fire colour,” “peak brightness,” “baseline brightness,” and “camera frequency.” Ex. 1001, 8:17–25.

E. Illustrative Claim

Petitioner challenges claims 1–22 of the '258 patent, with claim 1, reproduced below, being the only independent claim.

1. A lighting system comprising:
 - a lighting device; and
 - a controller adapted to control the lighting device to produce a user customisable cinematic lighting special effect selected from a range of different user customisable cinematic lighting special effects, the controller comprising:
 - an input interface for receiving user input to enable a user to select user customisable cinematic lighting special effect from said range of different user customisable cinematic lighting special effects; and
 - an effect simulator adapted to calculate a time varying lighting value based on at least one simulation parameter, said at least one simulation parameter depending on the selected user customisable cinematic lighting special effect being simulated, and adapted to output said time varying lighting value to said lighting device so as to simulate the selected user customisable cinematic lighting special effect;
- wherein said lighting device and said controller are integrated in a combined unit.

Ex. 1001, 11:59–12:12.

F. Asserted Unpatentability Challenges

Petitioner asserts that claims 1–22 are unpatentable based on the following challenges:

Claim(s) Challenged	35 U.S.C. §³	Reference(s)/Basis
1–6, 8–14, 16–22	102	Showline Manual ⁴
1–6, 8–14, 16–22	103	Showline Manual
7	103	Showline Manual, Choong ⁵
15	103	Showline Manual, Reinoso ⁶
1–22	102	Pohlert ⁷
1–22	103	Pohlert

Petitioner relies on the declarations of Woody Smith (Ex. 1003) and Martin Palmer (Ex. 1005).

II. WHETHER TO INSTITUTE *INTER PARTES* REVIEW

Patent Owner argues we should exercise our discretion to deny institution under 35 U.S.C. § 314 and 37 C.F.R § 42.108(a), citing and discussing the factors in *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i)). Prelim. Resp. 13–27. Petitioner asserts that discretionary denial is not warranted. Pet. 70–71; Reply 1–3.

³ The relevant sections of the Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, took effect on March 16, 2013. Given that the application from which the ’258 patent issued was filed after this date (Ex. 1001, code (22)), the current versions of §§ 102 and 103 apply.

⁴ Showline SL PAR 155 Zoom RGBW LED Luminarie Installation & User Manual, published 2013 (Ex. 1004).

⁵ US 8,632,208 B1, issued Jan. 21, 2014 (Ex. 1006).

⁶ US 8,581,513 B1, issued Nov. 12, 2013 (Ex. 1007).

⁷ US 2012/0044374 A1, published Feb. 23, 2012 (Ex. 1008).

A. Background

As noted above, the '258 patent was the subject of two earlier IPR proceedings, one filed by ARRI (IPR2021-01497, filed Sept. 3, 2021) and one filed by Petitioner (IPR2022-00262, filed Dec. 3, 2021).

In the 1497 IPR, ARRI challenged claims 1–22 of the '258 patent based on the same art Petitioner relies on here: Showline Manual, Choong, Reinoso, and Pohlert. Ex. 2004, 3–4. On March 16, 2022, the Board instituted proceedings in the 1497 IPR. 1497 IPR, Paper 8. The 1497 IPR proceeded through briefing and oral hearings, but the Board terminated the proceedings (before a final written decision issued) on January 30, 2023, at the request of the parties after they filed a settlement agreement. 1497 IPR, Paper 36.

Three months after ARRI filed its petition in the 1497 IPR, Petitioner filed a petition (Petitioner's "first Petition") in the 262 IPR, challenging claims 1–22 of the '258 patent based on Morgan⁸ in view of Hinrichs⁹ and Pohlert (i.e., different art than that asserted by ARRI in the 1497 IPR). Ex. 2005, 2. The Board denied institution on June 8, 2022, stating Petitioner had failed to show a reasonable likelihood that it would prevail on the merits. 262 IPR, Paper 7 at 27–28.

On July 17, 2023, over a year after Petitioner's first petition challenging the '258 patent was denied and six months after the parties in the 1497 IPR filed their joint motion to terminate the proceedings in view of settlement, Petitioner filed the present Petition (Petitioner's "second Petition"), again challenging claims 1–22 of the '258 patent.

⁸ US 8,938,468 B2, issued Jan. 20, 2015.

⁹ US 9,532,422 B2, issued Dec. 27, 2016.

B. General Plastic Factors

The Board’s decision in *General Plastic* articulates a non-exhaustive list of factors to be considered in evaluating whether to exercise discretion, under 35 U.S.C. § 314(a), to deny a petition that challenges a patent that was previously challenged before the Board. These factors are:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition;
4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite resources of the Board; and
7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

General Plastic, Paper 19 at 9–10.

C. Assessment of the Factors

1. Factor One

Under the first *General Plastic* factor, we consider “whether the same petitioner previously filed a petition directed to the same claims of the same patent.” *General Plastic*, Paper 19 at 16. As stated above, the Petition in this proceeding is the second petition Petitioner has filed challenging claims

1–22 of the ’258 patent. Pet. 1; Ex. 2005, 2. Accordingly, we determine that the first *General Plastic* factor weighs in favor of denying institution.

2. *Factor Two*

Under the second *General Plastic* factor, we consider “whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it.” *General Plastic*, Paper 19 at 16. Here, there is no dispute that at the time Petitioner filed the first petition in the 262 IPR, Petitioner knew of the prior art that it now asserts in its second Petition. In its first petition, Petitioner listed the 1497 IPR as a related matter. Ex. 2005, 1 (“The following currently pending matters relate to the challenged ’258 Patent: IPR2021–01496–01498.”). As noted above, the petition in the 1497 IPR relied on the Showline Manual, Choong, Reinoso, and Pohlert, which is the same art Petitioner now relies upon in its present, second Petition. Ex. 2004, 3–4. Accordingly, Petitioner knew of this prior art, which Petitioner now asserts in its present, second Petition, when Petitioner filed its first petition.

Thus, we determine that the second *General Plastic* factor weighs in favor of denying institution.

3. *Factor Three*

Under the third *General Plastic* factor, we consider “whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition.” *General Plastic*, Paper 19 at 16. Petitioner filed the present, second Petition on July 17, 2023. At that time, Petitioner had already received Patent Owner’s Preliminary Response to its first petition filed in the 262 IPR (262 IPR, Paper 6, March 14, 2022) and the Board’s Decision Denying Institution (262

IPR, Paper 7, June 8, 2022). Additionally, as of July 17, 2023, in the related 1497 IPR involving the same art Petitioner now asserts in its second Petition, the Board had issued its Decision on Institution (1497 IPR, Paper 8, Mar. 16, 2022), Patent Owner’s Response (1497 IPR, Paper 17, June 17, 2022), Patent Owner’s Sur-reply (1497 IPR, Paper 27, Oct. 21, 2022), and the Oral Hearing Transcript (1497 IPR, Paper 33, Dec. 28, 2022).

Petitioner argues that this *General Plastic* factor favors institution because it is intended to prevent roadmapping – and Patent Owner cannot argue that Petitioner used its first petition in the 262 IPR as a roadmap for its present second Petition because “the two petitions use different prior art, present different invalidity arguments, and Petitioner did not modify the Instant Petition in light of the decision on the [first petition].” Reply 1. Petitioner’s argument is unavailing, as it is based on a very narrow definition of roadmapping that requires both petitions to rely on the same art and invalidity arguments. The Board, however, has previously explained:

[F]actor 3 is directed to Petitioner’s potential benefit from receiving and having the opportunity to study Patent Owner’s Preliminary Response, as well as our institution decisions on the first-filed petitions, prior to its filing of follow-on petitions. . . . Multiple, staggered petitions challenging the same patent and same claims raise the potential for abuse. The absence of any restrictions on follow-on petitions would allow petitioners the opportunity to strategically stage their prior art and arguments in multiple petitions, using our decisions as a roadmap, until a ground is found that results in the grant of review. All other factors aside, this is unfair to patent owners and is an inefficient use of the *inter partes* review process and other post-grant review processes.

General Plastic, Paper 19 at 17–18 (internal citation and footnote omitted).

Here, Petitioner was able to use the Board’s decision denying institution in the 262 IPR to learn that the art and arguments asserted in the first petition were insufficient for institution, which led Petitioner to find a different ground that would “result[] in the grant of review.” *Id.* In that regard, contrary to Petitioner’s assertion, Petitioner did modify the second Petition in light of the institution decision in the first petition. *See* Reply 1.

Moreover, as Patent Owner correctly notes, Petitioner was able to monitor the developments in the related 1497 IPR and use that information in preparing the Petition in this proceeding. Prelim. Resp. 19. The evidence of record thus shows that Petitioner was in a position to use the Board’s previous decisions regarding challenges to the ’258 patent as a roadmap—to avoid certain grounds and find others—for its second Petition.

Based on the foregoing, we determine that the third *General Plastic* factor weighs in favor of denying institution.

4. *Factors Four and Five*

Under the fourth and fifth *General Plastics* factors, we consider “the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition” and “whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent.” *General Plastic*, Paper 19 at 16.

The evidence of record shows that Petitioner had knowledge of the prior art now asserted in its present, second Petition (i.e., Showline Manual, Choong, Reinoso, and Pohlert) at least by December 3, 2021, when Petitioner filed its first petition. Ex. 2005, 1. Petitioner filed its second Petition, asserting this art, on July 17, 2023. Thus, at a minimum, over one year and seven months elapsed between the time Petitioner had knowledge

of the prior art asserted in the second Petition and the filing of the second Petition.

Patent Owner argues that Petitioner fails to provide an adequate explanation for waiting one year and seven months between filing its two petitions challenging the claims of the '258 patent. Prelim. Resp. 22–24. In particular, Patent Owner asserts that “Petitioner had ample time and the ability to file copy-cat petitions asserting the same references as ARRI after institution of its 1st Petition was denied but chose not to do so,” and that “Petitioner was also able to file a copy-cat petition asserting the same references even after the Board granted termination of IPR2021-01497, but again, Petitioner opted not to do so, and waited almost seven months to bring the 2nd Petition.” Prelim. Resp. 25. Patent Owner also argues that Petitioner “waited until nearly the very last day . . . to file the 2nd Petition before it became time-barred under 35 U.S.C. § 315(b).” Prelim. Resp. 23.

Petitioner argues that this factor favors institution because the first petition was filed and terminated before Patent Owner filed suit against Petitioner in district court. Reply 1–2. Petitioner also argues that it “had no obligation to file [its second Petition] sooner” than it did. Reply 1–2.

Although Petitioner is correct that it was not obligated under 35 U.S.C. § 315(b) to file this Petition sooner, that does not constitute an adequate explanation as to why it waited until July 17, 2023 to file this second Petition based on prior art references it was aware of nineteen months earlier. Petitioner provides no evidence or argument why it did not assert these prior art references in its first petition. Additionally, the fact that Petitioner filed its first petition *before* Patent Owner filed suit against Petitioner undermines Petitioner’s argument that the time elapsed between

the filing dates of the two petitions was related to Patent Owner filing suit against Petitioner. *See* Reply 1–2.

In view of the foregoing, we agree with Patent Owner that Petitioner fails to provide an adequate explanation for the time elapsed between the filing of the first and second petitions directed to the same claims of the '258 patent. In view of this lengthy delay, coupled with the lack of explanation for the delay, we determine that the fourth and fifth *General Plastic* factors weigh in favor of denying institution of the proceeding.

5. *Factors Six and Seven*

Under the sixth and seventh *General Plastic* factors, we consider “the finite resources of the Board” and “the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.” *General Plastic*, Paper 19 at 16. The sixth and seventh factors are efficiency considerations. *See id.* at 16–17; *see also* Consolidated Trial Practice Guide 56 (Nov. 2019) (“CTPG”), <https://go.usa.gov/xpvPF> (citing *General Plastic*, Paper 19 at 16–18) (noting that the Director’s discretion under § 314(a) is informed by 35 U.S.C. § 316(b), which requires “the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter”).

We determine that the sixth and seventh *General Plastic* factors weigh against institution. In general, having multiple petitions challenging the same patent, especially when not filed at or around the same time as in this case, is inefficient and tends to waste resources. Here, Petitioner waited over 19 months to file its second Petition based on art that it was aware of when it filed its first petition. This serial and repetitive attack implicates the

efficiency concerns underpinning *General Plastic*, and, thus, favors denying institution.

Petitioner argues that these factors favor institution because, in the 1497 IPR, “[t]he Board already found a likelihood that the ’25[8] patent may be invalid based on the same grounds as raised in the Instant Petition.”

Reply 2. This argument fails to address concerns of efficiency and wasted resources at the Board. At the time the parties to 1497 IPR filed their motion to terminate based on settlement, the trial was nearly complete as the matter had been fully briefed and oral argument had already been held. All that remained was for the Board to issue its final written decision. A decision instituting an *inter partes* review on Petitioner’s second petition would require us to start another proceeding, on the same grounds as raised before, from the very beginning, thus duplicating much of the Board’s and Patent Owner’s efforts exerted in that proceeding.

Based on the foregoing, we determine that the sixth and seventh *General Plastic* factors weigh in favor of denying institution of the proceeding.

D. Summary

As discussed above, the evidence of record shows that all of the *General Plastic* factors weigh against institution. Although no single factor is dispositive, the evidence and circumstances as a whole weigh strongly in favor of denying institution in this case. As a result, we determine that it is appropriate to exercise our discretion under § 314(a) to deny institution.

III. CONCLUSION

For the foregoing reasons, we exercise our discretion under § 314(a) to deny institution of an *inter partes* review.

IV. ORDER

For the reasons given, it is:

ORDERED that, pursuant to 35 U.S.C. § 314, the Petition is denied, and no *inter partes* review is instituted.

IPR2023-01219
Patent 10,197,258 B2

FOR PETITIONER:

David Magee
Marc Vander Tuig
ARMSTRONG TEASDALE LLP
dmagee@atllp.com
mvandertuig@atllp.com

FOR PATENT OWNER:

Bradley Liddle
Scott Breedlove
Michael Pomeroy
Lithaw Lim
CARTER ARNETT PLLC
bliddle@carterarnett.com
sbreedlove@carterarnett.com
mpomeroy@carterarnett.com
hlim@carterarnett.com