

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG DISPLAY CO., LTD.,
Petitioner,

v.

SOLAS OLED, LTD.,
Patent Owner.

Case IPR2019-01668
Patent 9,256,311 B2

Before SALLY C. MEDLEY, JESSICA C. KAISER, and JULIA HEANEY,
Administrative Patent Judges.

KAISER, *Administrative Patent Judge.*

DECISION

Denying Patent Owner's Request for Rehearing of
Final Written Decision Determining All Challenged Claims Unpatentable
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Solas OLED Ltd. (“Patent Owner”) filed a Request for Rehearing, (Paper 47, “Request” or “Req. Reh’g”) of our Final Written Decision (Paper 46, “Decision” or “Dec.”) finding that claims 1–20 (“the challenged claims”) of U.S. Patent No. 9,256,311 B2 (Ex. 1001, “the ’311 patent”) are unpatentable. As explained below, we have considered the arguments presented by Patent Owner in the Request for Rehearing, but we discern no reason to modify the Decision. Accordingly, we deny Patent Owner’s Request for Rehearing.

II. ANALYSIS

A. *Standard of Review*

The party challenging a decision in a request for rehearing bears the burden of showing that the decision should be modified. 37 C.F.R. § 42.71(d). A request for rehearing “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, a reply, or a sur-reply.” *Id.* A request for rehearing, therefore, is not an opportunity to merely disagree with the Board’s assessment of the arguments or weighing of the evidence, or to present new arguments or evidence.

In the Decision, we determined that Petitioner demonstrated, by a preponderance of the evidence, that: (1) claims 1–13, 15, 16, and 18 would have been obvious over the combined teachings of Moran¹ and Joo;²

¹ WO 2010/099132; published Sept. 2, 2010 (Ex. 1007).

² US 2008/0223708 A1; published Sept. 18, 2008 (Ex. 1008).

(2) claims 14 and 17 would have been obvious over the combined teachings of Moran, Joo, and Philipp;³ and (3) claims 19 and 20 would have been obvious over the combined teachings of Moran, Joo, and Rappoport.⁴ Dec. 35. Petitioner asserted additional grounds (Grounds 1–3) based on the combined teachings of Kuriki⁵ and Mikladal⁶ or based on Kuriki and Mikladal in combination with additional references. Dec. 6. Because the grounds based on Moran and Joo or Moran and Joo in combination with additional references “addressed all of the challenged claims,” we concluded that “we need not and do not decide whether Petitioner has shown by a preponderance of the evidence that claims 1–20 are unpatentable as obvious over Kuriki and Mikladal or Kuriki and Mikladal in combination with additional references.” *Id.* at 33–34.

Patent Owner’s Rehearing Request raises two primary arguments: (1) the Board improperly concluded that Petitioner demonstrated motivation to combine Moran and Joo; and (2) the Board improperly declined to address Grounds 1–3 of the Petition (Paper 1, “Pet.”). *See generally* Req. Reh’g.

B. Alleged Improper Motivation

Patent Owner asserts that the Board improperly changed the reason to modify Moran based on the teachings of Joo from “application of a known technique” to a modification based on “the known benefits [] described by Joo.” Req. Reh’g 2–5. Patent Owner specifically argues that the Board

³ US 2011/0102361 A1; published May 5, 2011 (Ex. 1005).

⁴ US 2012/0218219 A1; published Aug. 30, 2012 (Ex. 1006).

⁵ US 8,722,314 B2; issued May 13, 2014 (Ex. 1003).

⁶ US 9,395,851 B2; issued July 19, 2016 (Ex. 1004).

“improperly reframed the Petition’s obviousness argument based on Joo’s ‘known technique’ and specific disclosures,” and “transformed Petitioner’s argument involving the combination of elements from two references, Moran and Joo, into essentially a single-reference obviousness theory not presented in the Petition.” *Id.* at 4–5. According to Patent Owner, if it had been apprised that the Board was going to rely on the “benefits” discussed in Joo, it “would have submitted evidence addressing that issue.” *Id.* at 5. In particular, Patent Owner argues that in the Petition, Petitioner argued that an ordinary artisan would apply Joo’s “known technique,” but in the Petitioner Reply (Paper 27, “Reply”), Petitioner relied on the “benefits” attributed to Joo. *Id.* at 3–4 (citing Pet. 67; Reply 23). According to Patent Owner, the Board appears to have agreed with this change, without apprising Patent Owner that this would be the basis for the motivation to combine the teachings of Moran and Joo. *Id.* at 4–5 (citing Dec. 21–23).

We are not persuaded that we misapprehended or overlooked Petitioner’s arguments regarding motivation to combine the teachings of Moran and Joo. In our Decision, we found that, “[a]s Patent Owner acknowledges (PO Sur-reply 26), Petitioner’s combination does not rely on any manufacturing techniques in Joo.” Dec. 21. We agreed with Petitioner that “creat[ing] additional touch sensitive regions on the sides of the device as taught in Joo,” provides the benefits attributed to Joo, but the benefits “are not wholly dependent upon the injection molding technique of Joo.” *Id.* (citing Pet. 66–67). Although we appreciate that Joo uses injection molding to form his device, we determined that the “benefits [of Joo] inure from having the touch sensitive portion on the side of the display rather than the manufacturing technique that results in that touch sensitive portion (i.e.,

injection molding versus bending the touch sensitive portion to wrap it around the edge of the display).” *Id.* at 21–22. This is consistent with Petitioner’s “Motivation to Combine” set forth in the Petition, i.e., “application of a known technique [Joo’s teaching of wrapping a touch sensor around the edges of a touchscreen display] to a piece of prior art ready for the improvement [Moran’s flexible capacitive touch sensor for a touchscreen device].” Pet. 67 (citing *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007)). Indeed, in our Decision on Institution (Paper 7, 21), we expressly stated that we did not “understand Petitioner’s combination to rely on any manufacturing techniques in Joo.” Accordingly, we determine we did not change reasoning midstream as to why we agreed with Petitioner’s motivation to combine the teachings of Moran and Joo, and thus, did not misapprehend or overlook Petitioner’s motivation to combine the teachings of Moran and Joo.

Patent Owner also asserts that the Board “overlook[ed] Mr. Credelle’s testimony that ‘[n]either Joo nor the POSITA’s generalized level of skill would inform a POSITA, starting with Moran, *how* to modify Moran’s PET film such that it would be ‘configured’ to wrap around the edge of a display.’” Req. Reh’g 6 (citing Ex. 2002 ¶ 164). According to Patent Owner, Mr. Credelle’s testimony was unrebutted by Petitioner, and the Board recognized that Petitioner did not explain “how the proposed modification would be achieved.” *Id.* Nonetheless, according to Patent Owner, the Board concluded that Petitioner need not provide a “complicated explanation” because “the modification is relatively straightforward.” *Id.* (citing Dec. 25–26). Thus, Patent Owner concludes that, absent hindsight, an ordinary artisan would not understand how to modify Moran to arrive at a

substrate and touch sensor configured to wrap around an edge of a display, as claimed. *Id.* at 7.

We disagree. In our Decision, we found Dr. Wolfe’s testimony “credible and persuasive that resolving [implementation] details would have been well within the skill of a person of ordinary skill in the art.” Dec. 23 (citing Ex. 1023 ¶¶ 178–183). Dr. Wolfe provided detailed testimony supported by objective evidence on this point. *See id.* (citing Pet. 68); Ex. 1023 ¶¶ 182–183 (citing Ex. 1007, 8:13–21; Ex. 1012 ¶¶ 8–9; Ex. 1018, 2955, 2962; Ex. 1019 ¶¶ 25, 33, 81; Ex. 1003, 21:8–12, 27:48–28:38, 29:55–30:33). Thus, even if Mr. Credelle’s testimony was not directly rebutted, we properly weighed Mr. Credelle’s testimony against Dr. Wolfe’s testimony. As such, we determined that a preponderance of the evidence supported Petitioner’s contention that an ordinary artisan would have known how to modify Moran to arrive at a substrate and touch sensor configured to wrap around an edge of a display. *See* Dec. 26. Accordingly, we are not persuaded that we overlooked or failed to consider any argument or evidence related to how the proposed modification would have been achieved.

For these reasons, we did not improperly conclude that Petitioner demonstrated motivation to combine Moran and Joo, and we do not modify our finding that a preponderance of the evidence supports Petitioner’s contention that an ordinary artisan would have known how to modify Moran to arrive at a substrate and touch sensor configured to wrap around an edge of a display.

*C. Alleged assertion that the Board improperly declined to address
Grounds 1–3 of the Petition*

Patent Owner asserts that the Board must address “Grounds 1–3 (including the prior art antedation issue) [as] required under the statutory scheme,” and in order to “assist the parties in developing the arguments in post-trial motion practice and appeal in the district court litigation.” Req. Reh’g 9. Specifically, Patent Owner argues that once the Board institutes an *inter partes* review, it “has a ‘statutory obligation to rule on all claims **and grounds** presented in the petition,’” and that “failure . . . to address all grounds is a violation of the statutory scheme.” *Id.* at 7–8 (quoting *AC Techs. S.A. v. Amazon.com, Inc.*, 912 F.3d 1358, 1364–65 (Fed. Cir. 2019)).

Patent Owner’s arguments are unpersuasive. Rule 42.71 makes clear that a rehearing is limited to “matters the party believes the Board misapprehended or overlooked.” 37 C.F.R. § 42.71(d). The Board’s decision to not address a redundant ground, though, is not a misapprehended or overlooked matter within the meaning of the rule. That is, a conscious decision not to consider a ground is quite different than failing to understand an argument or overlooking an argument.

We did not misapprehend or overlook Grounds 1–3. Rather, we determined that Grounds 4–6 based on Moran and Joo or Moran and Joo in combination with additional references are sufficient to establish that “Petitioner has shown, by a preponderance of the evidence, that claims 1–20 of the ’311 patent are unpatentable as obvious.” Dec. 33. We further determined that “[i]n addressing these grounds, we have addressed all of the challenged claims.” *Id.* (citing 35 U.S.C. § 318(a) (requiring the Board to “issue a final written decision with respect to the patentability of any patent

claim challenged by the petitioner and any new claim added under section 316(d)"); *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1359 (2018) (holding that "Congress's prescribed policy here is clear: the petitioner in an inter partes review is entitled to a final written decision addressing all of the claims it has challenged").

Our decision not to address certain grounds did not misapprehend the law. "[T]he Board need not address issues that are not necessary to the resolution of the proceeding." *Bos. Sci. Scimed, Inc. v. Cook Grp. Inc.*, 809 F. App'x 984, 990 (Fed. Cir. 2020). Patent Owner relies primarily on *AC Technologies* to support its contrary argument. Req. Reh'g 8–9. In that case, however, the Federal Circuit held that the Board properly considered a ground on which it did not initially institute, when the originally non-instituted ground challenged claims that were not shown unpatentable based on the originally instituted grounds. *AC Technologies*, 912 F.3d at 1364–65. The reasoning of *AC Technologies* is that *SAS* requires the Board to address all claims challenged by a petitioner, so a final decision holding that some challenged claims were not shown unpatentable without addressing all of the grounds presented in the petition would violate the statutory scheme. *Id.* In other words, *AC Technologies* involved addressing additional grounds as to claims that had not already been held unpatentable on other grounds, and thus that case did not address the situation in this proceeding. *See also Beloit Corp. v. Valmet Oy*, 742 F.2d 1421, 1423 (Fed. Cir. 1984) (holding that once a dispositive issue is decided, there is no need to decide other issues).

D. Constitutionality

The remainder of Patent Owner's arguments on rehearing are devoted to contesting the constitutionality of the appointments of the Administrative Patent Judges. Req. Reh'g 9–12. We decline to address Patent Owner's constitutional challenge except to note that the constitutionality of the appointments of the Administrative Patent Judges was addressed by the U.S. Supreme Court in *United States v. Arthrex, Inc.*, 141 S. Ct. 1970, 1986–87, 1997 (2021).

III. CONCLUSION

For the foregoing reasons, Patent Owner has not demonstrated that we misapprehended or overlooked arguments or evidence in determining whether claims 1–20 of the '311 patent are unpatentable. Accordingly, we do not modify our Decision in this proceeding.

IV. ORDER

Accordingly, it is

ORDERED that Patent Owner's Request for Rehearing of our Decision is *denied*.

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