

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.; AND
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner

v.

Polaris PowerLED Technologies, LLC,
Patent Owner.

Case No. IPR2023-00484
U.S. Patent No. 8,217,887

**PETITIONERS' PRELIMINARY REPLY
IN SUPPORT OF
INTER PARTES REVIEW OF U.S. PATENT NO. 8,217,887**

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Petitioner submits this Preliminary Reply as authorized by the Board. In its Preliminary Response (“POPR”), Patent Owner (“PO”) requests that the Board disregard Petitioner’s expert declaration and further deny institution because the declaration includes an error in a single paragraph defining the qualifications of a hypothetical person of ordinary skill in the art (“POSITA”) and, under *Xerox*, based on alleged copying between the declaration and the petition. PO’s request should be denied and the declaration given due weight.

I. THE BOARD SHOULD NOT DISREGARD DR. HATALIS’S OPINIONS

Dr. Hatalis’s credentials and fifteen paragraphs of technical background testimony demonstrate that he is an expert in the relevant fields of electrical engineering, display technology, and optics, and also demonstrate that he applied this perspective in his testimony. Ex-1002 ¶¶41–56; Ex-1003 (Dr. Hatalis’s CV). Yet PO seizes on an artifact inadvertently carried over from an expert declaration template that Dr. Hatalis did not update, and which was replicated in the Petition.¹ POPR, 30–34 (citing Ex-1002 ¶40). PO places form over substance. Under Federal Circuit law and PTAB precedent, what matters is not a mistaken “definition” of the level of skill, but that Dr. Hatalis conducted his actual analysis using the correct level of skill. PO’s request would throw out a fulsome declaration by a qualified

¹ PO recognizes that the error is a carry-over artifact from an unrelated declaration of a different declarant from other IPRs. POPR, 5–6 (citing Ex-2006).

expert and deny a meritorious Petition. Instead, the Board should reject this extraordinary result and give Dr. Hatalis's opinions the weight they deserve.

As set forth below, the Board should disregard as harmless the erroneous POSITA definition. There is no legal requirement to define a level of skill, where, as here, the level of skill is plain from the prior art and Dr. Hatalis actually applied the correct level of skill. And, to simplify the dispute, Petitioner adopts PO's level of skill, which Dr. Hatalis plainly possesses and which aligns with his opinions.

A. There Is No Requirement to Define a Level of Skill Where It Is Plain from the Prior Art

The obviousness inquiry requires the level of skill be resolved, *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17 (1966), but this does not require parties or the Board to set forth an express definition. *Okajima v. Bourdeau*, 261 F. 3d 1350, 1355 (Fed. Cir. 2001) (finding “no harm” “in the Board’s failure to set forth express findings as to the level of skill”). The Federal Circuit recognizes that “the absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown.’” *Id.* at 1355 (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

PTAB cases addressing similar circumstances at this *preliminary* stage confirm that a petition's missing or erroneous definition of the level of skill does not preclude institution, so long as the obviousness analysis was viewed through

the appropriate lens. For example, in *Ooma, Inc. v. Deep Green Wireless, LLC*, the Board instituted an IPR over PO's argument that the Petition failed to set forth a POSITA definition, noting that it was sufficient that the prior art itself reflected an appropriate level of skill. IPR2017-01541, Paper 8 at 7–8 (PTAB Dec. 18, 2017). Similarly, where, as here, a patent owner argued that a “flawed” POSITA definition tainted an obviousness analysis, the Board disagreed because “Patent Owner [did] not explain[] how the allegedly incorrect definition leads to an incorrect obviousness analysis.” *TRW Auto. US LLC v. Magna Elecs. Inc.*, IPR2014-00261, Paper 19 at 17 (PTAB June 26, 2014). Here, PO does not explain how the incorrect definition led to an incorrect obviousness analysis, nor can it.

B. Dr. Hatalis Applied the Correct Level of Skill in His Analysis

What matters is applying the correct level of skill in the obviousness analysis. *See Ooma*, Paper 8 at 7–8 (“Petitioner . . . addressed the obviousness arguments with arguments specifically invoking the perspective of one of ordinary skill in the art.”). Both Dr. Hatalis and Petitioner addressed the obviousness arguments from the perspective of a POSITA consistent with the prior art and the definition proposed by PO's own expert: “knowledge of electrical engineering, display technology, and optics.” Ex-2001 ¶24. This aligns with Dr. Hatalis's thorough discussion of the relevant technology, including LEDs, LCD and display illumination and backlighting, vertical synchronization signals, and ambient

lighting sensors. Ex-1002 ¶¶41–56. As discussed below, Dr. Hatalis based his analysis on the correct POSITA perspective, describing relevant display technology. Accordingly, his opinions are entitled to all due weight.

C. Petitioner Adopts PO's Level of Skill, Which Dr. Hatalis Possesses

To help resolve this dispute, Petitioner adopts the level of skill in the art proposed by PO's expert. Ex-2001 ¶24 (having "knowledge of electrical engineering, display technology, and optics"). This level of skill aligns with the prior art and analysis in Dr. Hatalis's declaration. *See* Ex-1002 ¶¶41–56. Dr. Hatalis's credentials and experience exceed this requisite level of skill. *See* Ex-1002 ¶¶5–20 (identifying expertise in electrical engineering, display technology, and optics); Ex-1003. PO has not argued that Dr. Hatalis fails to meet PO's proposed level of skill, so if the Board adopts PO's definition, it should credit Dr. Hatalis's testimony invoking the perspective of a POSITA. *See Acclarent, Inc. v. Ford Albritton, IV*, IPR2017-00498, Paper 12 at 9–10 (PTAB July 10, 2017).

II. THE BOARD SHOULD NOT DISCREDIT DR. HATALIS'S DECLARATION BASED ON PO'S MISAPPLICATION OF XEROX

PO argues that the Board should discredit Dr. Hatalis's declaration because it allegedly copies the Petition. POPR, 31–33 (citing *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15–16 (PTAB Aug. 24, 2022) (precedential)). As an initial matter, panels applying *Xerox* have rejected the idea that similar language means the expert copied the petition, as PO argues here. *TikTok, Inc. v. Advanced*

Coding Techs., LLC, IPR2022-01548, Paper 7 at 5 n.7 (“[T]o the extent there is repetition, it is more reasonable to infer that the Petition repeats [the expert’s] testimony (not the other way around).”). Rather, under *Xerox*, the “critical inquiries” are whether the declaration testimony discloses the underlying facts or data on which the opinion is based and whether the testimony supports the arguments in the petition. *Id.* (quoting *Xerox*, Paper 9 at 15). PO’s superficial file-compare (Ex-2005) argument does not address these critical inquiries.

Indeed, PO’s file comparison shows that Dr. Hatalis provided significant analysis over and above the analysis in the Petition. For example, as shown by the comparison of declaration paragraph 74 with the corresponding Petition paragraph, Dr. Hatalis provided a half-page of additional explanation including a cite to another contemporaneous, supporting reference, Ex-1025 (2006 article). Ex-2005 ¶74. His other opinions are similarly supported by evidence and analysis. *See, e.g.*, Ex-2005 ¶¶105, 112, 203. This does not mean the Board must necessarily agree with Dr. Hatalis, but it does mean that his testimony should be adjudged on “each particular issue on which [he] opines based on the factual corroboration, articulated reasoning, and disclosure of underlying facts or data provided.” *Comcast Cable Commc’ns, LLC v. Veveo, Inc.*, IPR2019-00237, Paper 59 at 16 (PTAB Aug. 12, 2020) (citing *In re Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1368 (Fed. Cir. 2004)).

Respectfully Submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies pursuant to 37 C.F.R. §§ 42.6(e) and 42.105 that on June 8, 2023, a true and correct copy of this Preliminary Reply in connection to the Petition for *Inter Partes* Review was served in its entirety by filing this document through the PTAB P-TACTS System, as well as by email, on the counsel of record for the Patent Owner.

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