

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG DISPLAY CO., LTD; SAMSUNG ELECTRONICS CO., LTD.; and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner

v.

POLARIS POWERLED TECHNOLOGIES, LLC,
Patent Owner

Case IPR2023-00771
U.S. Patent No. 7,259,521

PATENT OWNER'S MOTION TO STRIKE

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I. INTRODUCTION AND STATEMENT OF RELIEF REQUESTED

Petitioner improperly presents new arguments in its Reply and belatedly presents evidence that could have been filed with the Petition. Offering shifting theories for unpatentability that originate after filing the Petition violates the Board's rules and established precedent and unduly prejudices Patent Owner. Accordingly, Patent Owner requests that the Board strike (i) paragraphs 328–330 of Dr. Kattamis's Supplemental Declaration (EX1015) and (ii) the arguments on pages 20–21 of Petitioner's Reply citing these paragraphs.

II. LEGAL STANDARD

Petitioners must “adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’” *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (quoting 35 U.S.C. § 312(a)(3)). Accordingly, the petitioner is “obliged to make an adequate case in its Petition and the Reply limited to a true rebuttal role.” *Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1367 (Fed. Cir. 2015). Thus, a petitioner’s “reply may only respond to arguments raised in the ... patent owner response,” 37 C.F.R. § 42.23(b), and a petitioner may not “submit new evidence or argument in reply that it could have presented earlier, e.g. to make out a prima facie case of unpatentability.” Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) (“Consolidated TPG”), 73. Indeed,

a “petitioner must make out its arguments for unpatentability in the petition, and cannot change course later.” *In-Depth Geophysical, Inc. v. ConocoPhillips Co.*, IPR2019-00850, FWD, 30 (P.T.A.B. Sept. 3, 2020). For example, “an IPR petitioner may not raise in reply ‘an entirely new rationale’ for why a claim would have been obvious.” *Henny Penny Corp. v. Fry-master LLC*, 938 F.3d 1324, 1331 (Fed. Cir. 2019) (quoting *Intelligent Bio-Sys.*, 821 F.3d at 1370).

A petitioner’s reply or reply evidence that “crosses the line from the responsive to the new” risks being stricken. *See Ariosa Diagnostics*, 805 F.3d at 1368. “[W]here a reply clearly relies on a new theory not included in prior briefing, and where addressing this new theory during oral hearing would prejudice the opposing party, striking the portion of the brief containing that theory may be appropriate.” Consolidated TPG, 81.

III. THE BOARD SHOULD STRIKE PETITIONER’S NEW AND UNTIMELY INVALIDITY THEORIES

Petitioner’s Reply introduces new arguments for alleging why a POSITA would have replaced the addition circuit of Hayafuji with a differential amplifier circuit. Reply, 21 (citing EX1015, ¶¶326-333). There is no dispute that these invalidity arguments are new. Petitioner’s own declarant, Dr. Kattamis, admitted on multiple occasions during his deposition that these arguments were not in his original declaration. For example, when discussing Dr. Kattamis’s assertion that Hayafuji would teach that a POSITA can manipulate op amps to perform algebraic

operations on signals, EX1015, ¶¶328-329, the following exchange occurred:

Q. And is this a discussion that is new to the supplemental declaration?

A. Yes. I believe so.

Q. This is not an argument that was in your original declaration, right?

A. I don't think so, no.

EX2017, 22:15–20. A similar admission, concerning EX1015, ¶¶329-330, was elicited shortly thereafter:

Q. This discussion of multiple inversions and the current at the pixel being anti-phased with Vdata, is that also a new argument in your supplemental declaration?

A. Yes. Yeah.

EX2017, 25:20–26:2. *See also* EX2017, 18:21-22:20, 22:21-26:2, 26:3-27:14.

Paragraphs 328–330 and the arguments relying on them in Petitioner's Reply do not rebut Patent Owner's arguments. They instead attempt to improperly supplement insufficient unpatentability arguments in the Petition. Indeed, Petitioner's arguments and evidence raise a new rationale alleging why the claims would have been obvious in a belated attempt to establish a *prima facie* case of unpatentability. Retaining the new arguments in the record would subvert established rules of procedural fairness, prejudicing Patent Owner.

IV. CONCLUSION

The Board should strike Petitioner's new arguments and evidence from the record.

Respectfully submitted,

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

I certify that the above-captioned **PATENT OWNER'S MOTION TO STRIKE** was served in its entirety on June 17, 2024 upon the following parties via electronic mail:

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