

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CHINA STAR OPTOELECTRONICS SEMICONDUCTOR DISPLAY
TECHNOLOGY CO., LTD.; TIANMA MICROELECTRONICS CO. LTD.; AND
VISIONOX TECHNOLOGY, INC.
Petitioner,

v.

SAMSUNG DISPLAY CO., LTD.
Patent Owner.

Case No. IPR2023-00941
U.S. Patent No. 7,414,599

**PETITIONER'S OPPOSITION TO PATENT OWNER'S
MOTION FOR ADDITIONAL DISCOVERY**

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LISTING OF EXHIBITS

Exhibit	Description
EX1001	U.S. Pat. 7,414,599 (Chung)
EX1002	U.S. Pat. Pub. 2003/0132931 (Kimura)
EX1003	Expert Declaration of Dr. Daniel Foty
EX1004	U.S. Pat. 6,362,798 (Kimura '798)
EX1005	File History for U.S. Pat. 7,414,599
EX1006	U.S. Pat. Pub. 2001/0022565
EX1007	U.S. Pat. Pub. 2003/0030603
EX1008	Excerpts from <i>Analog Integrated Circuit Design</i> , David A. Johns et al., John Wiley & Sons, Inc., 1997.
EX1009	<i>Modeling and Simulation of Insulated-Gate Field-Effect Transistor Switching Circuits</i> , Harold Shichman et al., IEEE Journal of Solid-State Circuits, Vol. SC-3, No. 3, September 1968.
EX1010	Excerpts from <i>Physics and Technology of Semiconductor Devices</i> , A. Grove, John Wiley & Sons, 1967.
EX1011	Excerpts from <i>CMOS Digital Integrated Circuits: Analysis and Design</i> , (third edition), S. Kang et al., McGraw-Hill, 2003.
EX1012	U.S. Pat. 6,229,506 (“Dawson”)
EX1013	U.S. Pat. 5,666,046
EX1014	<i>TFT AMOLED Pixel Circuits and Driving Methods</i> , J. Stanford, SID 03 Digest, pp. 10-13 (2003))
EX1015	<i>A New Pixel Circuit for Active Matrix Organic Light Emitting Diodes</i> , J. Goh, IEEE Electron Device Letters vol. 23, pp. 544-546 (2002)

Exhibit	Description
EX1016	<i>A Novel Pixel Circuit for Active-Matrix Organic Light-Emitting Diodes</i> , J. Goh et al., SID 03 Digest, pp. 494-497 (2003)
EX1017	<i>Current-Writing Active-Matrix Circuit for Organic Light-Emitting Diode Display Using a-Si:H Thin-Film-Transistors</i> , R. Hattori et al., IEICE Transactions on Electronics vol. E83-C, pp. 779 – 782 (2000).
EX1018	Declaration of T. Credelle
EX1019	Reserved
EX1020	Reserved
EX1021	Reserved
EX1022	<i>Certain Active Matrix Organic Light-Emitting Diode Display Panels & Modules for Mobile Devices</i> , ITC Inv. No. 337-TA-1351, Staff’s Prehearing Brief (Public Version) (Excerpt) (Jan. 12, 2024)

I. INTRODUCTION

Secondary considerations of nonobviousness include: long-felt but unsolved need, failure of others, unexpected results, commercial success, copying, licensing/commercial acquiescence, skepticism of others, and industry praise. Patent Owner (“PO”) does not even allege it needs discovery from Petitioner to pursue seven of these factors. *See generally* Paper 26 (“Mot.”). Rather, for a *single factor*—purported “copying”—PO seeks broad district-court style discovery. In particular, under the guise of a single “discovery request,” PO seeks: over **5,000 pages** of highly technical confidential documents (which are all native Chinese language documents with PO’s self-serving non-certified translations); *dozens of pages of emails* (including third-party emails which raises additional confidentiality issues); *five full-day fact witness deposition transcripts* (covering over ninety 30(b)(6) topics and source code testimony); and various *interrogatory responses* provided in a sprawling ITC proceeding that spanned five patents.

Of course, the Board would not know this because PO’s sole “discovery request” consists of nothing more than a series of exhibit numbers. PO’s failure to describe the discovery sought in any meaningful way deprives the Board the ability to evaluate the substance of what is requested (*infra* *Garmin* factor (1)). PO asserts that “the ITC protective order limits [PO’s] ability to describe the requested documents.” Mot. at 5. But that’s precisely the point—PO is not allowed to use its

knowledge of Petitioner’s confidential information (gleaned exclusively from ITC productions) to obtain the very same information in an IPR proceeding.

Putting aside the propriety of PO’s request, it is undisputed that PO had “other means” (*viz.*, asking the ITC) to obtain the discovery, but chose not to do so. This fact distinguishes the principal case (*Apple v. Masimo*) cited throughout PO’s motion. While other panels have held this factor alone to be dispositive (*infra* *Garmin* factor (3)), Petitioner addresses all of the *Garmin* factors. Collectively, the factors overwhelmingly favor denying PO’s motion. The voluminous materials sought (for a single secondary consideration) fall far short of meeting the high “interests of justice” standard necessary for additional discovery. *See* 37 C.F.R. §§ 42.20(c) and 42.51(b)(2). Rather than approaching the ITC as it should (and could) have, PO burdens the Board with a vague request in what amounts to nothing short of an end run around the ITC protective order. The Board should deny PO’s motion.

II. GARMIN FACTOR (1): A MERE POSSIBILITY AND ALLEGATION

A. Patent Owner’s Conclusory Assertion Fails to Meet Factor (1)

Garmin factor (1) requires more than “[t]he mere possibility of finding something useful,” more than “mere allegation that something useful will be found” through the requested discovery. *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6 (PTAB Mar. 5, 2013) (precedential). “[U]seful” means favorable in substantive value to a contention of the [movant],” not “merely

‘relevant’ and/or ‘admissible.’” *Id.* at 7. PO’s argument fails this test.

PO argues that because it has cited the requested materials in the related ITC litigation with respect to the secondary consideration of copying, it “has shown beyond speculation that the requested materials are favorable in substantive value.” Mot. at 6. This is circular reasoning. By PO’s logic, ***anything*** cited in an ITC or district court expert report would automatically be deemed relevant and discoverable in an IPR proceeding. Why? Because it was cited by an expert. That is not the law, nor should it be. See *Silicon Labs. Inc. v. Cresta Tech. Corp.*, IPR2014-00728, Paper 27 at 3–4 (PTAB Dec. 10, 2014) (denying additional discovery based on a similarly bare allegation). “Patent Owner has not offered any evidence from which [the Board] can assess the accuracy of its contentions.” *Id.* at 3. This deficiency contrasts with the record that satisfied factor (1) in *Brunswick v. Cobalt Boats* and thus warrants a different finding. See *Dynamic Air Inc. v. M-I Drilling Fluids UK Ltd.*, IPR2016-00260, Paper 39 at 6 (PTAB Nov. 30, 2016) (distinguishing *Brunswick*, IPR2015-01060, Paper 20 at 3 (PTAB Dec. 28, 2015)).

PO also characterizes the requested materials as “highly relevant.” Mot. at 2. This characterization is both conclusory and disputed. Not only is it disputed by Petitioner, but the ITC’s Office of Unfair Import Investigations (“OUII”) has evaluated PO’s secondary-consideration arguments and concluded that it “does not believe that the alleged secondary considerations affect the obviousness analysis.”

EX1022 (*Certain Active Matrix Organic Light-Emitting Diode Display Panels & Modules for Mobile Devices*, ITC Inv. No. 337-TA-1351, Staff’s Prehearing Brief (Public Version) (Excerpt) (Jan. 12, 2024)) at 17. “[A]s an independent third party that represents the public interest,” OUII’s finding should carry more weight than PO’s unsubstantiated, self-serving characterization. *See Silicon Labs.*, IPR2014-00728, Paper 27 at 4. In essence, PO simply says: “trust me.” Even if PO were correct that somewhere among the 5,000+ pages of materials was something relevant, that is “not sufficient to establish evidence or reasoning tending to show beyond speculation that something *useful* will be uncovered.” *St. Jude Med., LLC v. Snyders Heart Valve LLC*, IPR2018-00105, Paper 37 at 4–5 (emphasis original).

Moreover, PO’s vague and shifting request raises doubt as to whether its IPR counsel even has an adequate basis to characterize the requested materials as “relevant” or “useful.” On the February 7, 2024 conference call with the Board, PO stated the additional discovery was intended to support three secondary-considerations: industry praise, long-felt need, and copying. In its motion, however, PO only alleges relevance to copying. Mot. at 2, 6, 7. PO’s shifting position indicates that its IPR counsel is unsure of the content and relevance of the requested discovery. Uncertainty regarding even the relevance of the requested discovery cannot support any contention regarding its usefulness. *See Garmin*, IPR2012-00001, Paper 26 at 7 (“useful” involves more than “relevant”).

B. The ITC Protective Order Does Not Excuse PO's Failure

PO argues that “the ITC protective order limits [its IPR] counsel’s ability to describe the requested documents in this motion.”¹ Mot. at 5. PO is asking the Board to “accept at face value the representation of its litigation counsel that the requested documents are ‘[useful] to disputed issues in these IPR proceedings.’” *Dynamic Air*, IPR2016-00260, Paper 39 at 3.

The Board has soundly and repeatedly rejected PO’s argument. For example, in *Duncan Parking Techs., Inc. v. IPS Grp., Inc.* (“DPT”), the movant for additional discovery was “unable to provide any substantive analysis or detail of the relevance of the content of any of the [requested] documents” because a protective order in a related district court litigation barred the use of the requested materials outside of the litigation. IPR2016-00067, Paper 18 at 3 (PTAB Sept. 27, 2016). The Board found the utter lack of analysis “problematic in meeting the ‘interests of justice’

¹ Per the ITC protective order, confidential information produced there is to be used “solely for purposes of [that] investigation.” ITC Inv. No. 337-TA-1351, EDIS Doc. ID 789367, Order No. 1, ¶ 4. There is no exception allowing PO to use its knowledge of Petitioner’s confidential information (gleaned exclusively from confidential ITC productions) to seek the very same discovery elsewhere. Petitioner reserves all rights to seek appropriate relief in the ITC for any protective order violations.

standard.” *Id.* Noting that the movant had not asked the district court for leave to provide the Board a summary or explanation of the requested documents, the Board found factor (1) against the movant. *Id.* at 3–4. Similarly, in *Dynamic Air*, the movant failed to substantively discuss the requested documents and had not asked “the district court [in co-pending litigation] for relief from the restrictions of the protective order.” IPR2016-00260, Paper 39 at 5–6. The Board found factor (1) weighed against the movant. *Id.* The Board should find the same here. *See also MediaTek Inc. v. Nippon Tel. & Tel. Corp.*, IPR-2020-01607, Paper 20 at 4–6 (PTAB Oct. 1, 2021) (denying discovery due to insufficient evidence supporting factor (1) where party had not moved the district court for protective order relief); *contra Baker Hughes Inc. v. LiquidPower Specialty Prods., Inc.*, IPR2016-01901, Paper 29 at 4–5 (PTAB Sept. 18, 2017) (granting discovery where “unclear” if district court protective order permitted more substantive discussion of requested documents).

PO’s reliance on *Apple* is misplaced for multiple reasons. *First*, the patent owner there had first attempted to obtain the requested discovery from the ITC. *Apple Inc. v. Masimo Corp.*, IPR2022-01465, Paper 23 at 4 (PTAB Mar. 17, 2023). PO, like the movants in *DPT*, *Dynamic Air*, and *MediaTek*, chose not to do so. *Second*, unlike here, the materials in *Apple* bore on numerous issues (*viz.*, reasonable expectation of success, commercial success, skepticism, failure of others, copying) and were expressly relied in the public ITC ruling holding the challenged patent

valid, and thus “useful” in IPR. *Id.* at 1, 3. Here, OUII found the requested materials to have no bearing on secondary considerations of the ’599 patent. EX1022 at 17.

III. GARMIN FACTOR (2): LITIGATION POSITIONS

Petitioner does not dispute factor (2).

IV. GARMIN FACTOR (3): ABILITY TO GENERATE EQUIVALENT INFORMATION BY OTHER MEANS

This factor should be dispositive. PO has the ability to generate equivalent information (indeed, identical information) by other means. Its counsel conceded as much during the conference call with the Board on February 7, 2024. Specifically, like the patent owner in *Apple* did, PO could have moved the ITC (where a live proceeding remains ongoing) to modify the protective order to allow use of the requested information here. *Apple*, IPR2022-01465, Paper 23 at 4. But unlike in *Apple*, PO here chose not to do so. Instead, PO seeks an end-run around the ITC.

In such situations, the Board has found factor (3) dispositive in favor of the nonmovant. *Polygroup Ltd. (MCO) v. Willis Elec. Co.*, IPR2016-01610, Paper 31 at 6 (PTAB May 16, 2017) (“Here [the] ability to generate equivalent information by other means, is dispositive. In particular, approaching the [ITC] for permission to use the documents was, and is, ‘other means.’”); *see also DPT*, IPR2016-00067, Paper 18 at 3–4 (similar); *see also St. Jude Med.*, IPR2018-00105, Paper 37 at 6 (similar); *Dynamic Air*, IPR2016-00260, Paper 39 at 5–6 (similar).

V. GARMIN FACTOR (4): UNDERSTANDABLE INSTRUCTIONS

Hiding behind the ITC protective order, PO’s discovery request is nothing more than a list of exhibit numbers. PO’s approach deprives the Board of its ability to understand the substance of what is requested and should not be rewarded. Even if the Board finds factor (4) in favor of PO, this factor “is significantly outweighed by the other factors discussed above, and below, which pertain specifically to the substance and context of the [r]equest[.]” *Am. Nat’l Mfg. Inc. v. Sleep No. Corp.*, IPR2019-00497, Paper 67 at 9 (PTAB Jan. 6, 2020).

VI. GARMIN FACTOR (5): BURDEN TO ANSWER

Factor (5) “includes financial burden, burden on human resources, and burden on meeting the time schedule of this review.” *Garmin*, IPR2012-00001, Paper 26 at 14. “Requests should be sensible and responsibly tailored according to a genuine need.” *Id.* Here, PO seeks over 5,000 pages of highly technical documents, five full-day fact-witness deposition transcripts with nearly 800 designated excerpts, emails—some with third-parties, and interrogatory responses. The depositions include two Rule 30(b)(6) witnesses—including an HR representative of Petitioner—who testified on more than 90 designated 30(b)(6) topics. This voluminous information targets just one of eight secondary-consideration factors. *See* Mot. at 2 (copying). This is not a sensible request reasonably tailored according to a genuine need. *Dynamic Air*, IPR2016-00260, Paper 39 at 6–7 (finding factor (5) favors the nonmovant where the request includes 800 pages of documents and

“testimony of three Rule 30(b)(6) witnesses who testified on numerous and irrelevant Rule 30(b)(6) topics”). Rather, it is the tail wagging the dog and only serves to distract the Board and parties from the substantive merits of a single-reference obviousness assertion by larding the otherwise streamlined record with satellite litigation over purported copying. To the extent PO argues its failure to tailor the request results from the ITC protective order, such an argument has no merit because PO could have sought relief from the ITC. *See supra* § II.B.

Further, the voluminous documents PO seeks are almost exclusively native Chinese language documents. Although the documents include PO’s self-serving English translations, the translations are not certified. Thus, to verify the accuracy of translation, Petitioner would bear the burden of substantial time, hassle, and expense to obtain check translation for thousands of pages.

Moreover, based on recent reviews, Petitioner discovered that a source code computer was used to question at least one witness whose deposition transcript is sought. Source code is subject to heightened protection under the ITC protective order and introduces another layer of complexity and hassle to the proceeding.

The use of Petitioner’s confidential information would also impose a burden on Petitioner to seal and redact filings in this proceeding. *DPT*, IPR2016-00067, Paper 18 at 4. Moreover, Petitioner would be further burdened by having to respond to the thousands of pages of materials PO seeks to use, including by seeking

counterpart discovery from PO to rebut its allegations.

And, to the extent PO will use the requested materials to support alleged copying, such contentions are likely to lengthen the schedule. “For objective evidence to be accorded substantial weight, its proponent must establish a nexus between the evidence and the merits of the claimed invention.” *In re GPAC Inc.*, 57 F.3d 1573, 1580 (Fed. Cir. 1995); *see also Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1366 (Fed. Cir. 2001) (“copying ... is legally irrelevant unless ... shown to be an embodiment of the claims.”). This will require a “meaningful infringement analysis” of Petitioner’s and/or PO’s products—a disputed issue in the related ITC litigation. *Fleming v. Cirrus Design Corp.*, 28 F.4th 1214, 1224 (Fed. Cir. 2022). Accordingly, the requested discovery “would broaden the scope of the instant proceedings significantly into infringement issues, which are inappropriate in this proceeding, and also delay the trial schedule.... This is contrary to the goal of *inter partes* review to be an efficient, streamlined alternative to litigation.” *Am. Nat’l Mfg.*, IPR2019-00497, Paper 67 at 12.

In short, PO’s assertion of no material burden on Petitioner ignores reality. Factor (5) favors a denial of PO’s motion.

VII. CONCLUSION

Collectively, the *Garmin* factors weigh strongly against the requested additional discovery. Petitioner respectfully asks the Board to deny PO’s motion.

Dated: February 16, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that on February 16, 2024, a copy of the following was served in its entirety via electronic mail, upon the following attorneys of record for the Patent Owner:

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