

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MIANYANG BOE OPTOELECTRONICS TECHNOLOGY CO., LTD.; WUHAN
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 MOTION TO STRIKE PATENT OWNER’S
UNAUTHORIZED SUR-REPLY EXHIBIT AND
ACCOMPANYING ARGUMENT**

Pursuant to 37 C.F.R. §§ 42.5(a), 42.7(a), 42.20(a) and the Board's email authorization dated July 18, 2024, Petitioner moves to strike the portions of Patent Owner's Sur-Reply (Paper 45) that untimely challenges Petitioner's expert Dr. Foty's qualification under Patent Owner's definition of a person of ordinary skill in the art ("POSITA") and cites EX2054 (an ALJ order from the ITC) in contravention of 37 C.F.R. § 42.23(b) and the Board's rules.

The facts here are straightforward. Petitioner defined a POSITA and offered Dr. Foty as an expert supporting its Petition. Pet. (Paper 1), 2, 13 (citing EX1003). In its Preliminary Response, Patent Owner did not dispute Petitioner's definition of a POSITA nor Dr. Foty's qualifications. POPR (Paper 9), 21. At the Institution stage, the Board adopted Petitioner's definition, noting that the definition is supported by Dr. Foty's testimony and "reflected by the content of the applied prior art references." ID (Paper 12), 12. Although Patent Owner proposed what it viewed as a different POSITA definition in its Response, *Patent Owner did not challenge Dr. Foty's qualifications as a POSITA under either party's articulation.* See Response (Paper 33), 7-9.

Nor did Patent Owner's expert (Dr. Wolfe) render any opinion on Dr. Foty's qualifications as a POSITA. See EX2008, ¶¶45-49. Indeed, when asked directly at his deposition, Patent Owner's expert testified he had not: "Q. Did you render any

opinion in your report about Dr. Foty's qualifications or expertise? *A. No.*"
EX1028, 47:5-7.

Petitioner prepared its Reply brief in accordance with the arguments, evidence, and opinions presented in Patent Owner's Response, addressing the dispute over the *definition* of a POSITA. Reply (Paper 41), 2-3. In its Sur-reply, however, Patent Owner belatedly raises the argument—for the first time—that "Petitioner's declarant, Dr. Foty, fails to qualify as a POSITA." Sur-reply (Paper 45), 3; *see also id.*, 21-22. In support of its new argument—which Patent Owner could have raised in its Response brief but did not—Patent Owner submitted EX2054 as a new exhibit. *Id.*, 21-22. To be clear, Petitioner is *not* moving to strike Patent Owner's argument regarding the *definition of a POSITA*, which is a separate issue. Rather, Petitioner is moving to strike Patent Owner's evidence (EX2054) and related argument that Dr. Foty does not *qualify as a POSITA*.

Patent Owner neither sought nor obtained authorization from the Board to submit EX2054 with its Sur-reply. Submitting new EX2054 without authorization plainly violates the unambiguous rule that "[a] sur-reply ... may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness." 37 C.F.R. § 42.23(b); *see also* Practice Guide, 73 (same). And, correspondingly, belatedly raising a dispute over Dr. Foty's qualifications violates the clear rule that "[a] sur-reply may only respond to arguments raised in the

corresponding reply.” 37 C.F.R. § 42.23(b); *see also* Practice Guide, 74 (“[s]ur-replies should only respond to arguments made in reply briefs, comment on reply declaration testimony, or point to cross-examination testimony.”); Paper 13, 9 (“Patent Owner is cautioned that any arguments not raised in the response may be deemed waived.”).

Patent Owner’s new argument and exhibit should be struck because, without this remedy, Petitioner has no opportunity to respond to them at this juncture of the proceeding and would be prejudiced. *3M Co. v. Westech Aerosol Corp.*, Case IPR2018-00576, Paper 45, 7 (P.T.A.B. Apr. 26, 2019) (“[W]e are not persuaded that allowing Patent Owner’s new theory outweighs the prejudice to Petitioner in having to respond to such arguments and with no ability to develop evidence on such short notice”); *see also id.*, 3-4. The prejudice here is substantial because Patent Owner contends this issue is dispositive of the IPR.¹ Sur-reply (Paper 45), 3. If Patent Owner disputed Dr. Foty’s qualifications, it could have and should have raised this dispute in its Response, not in the last principal brief between the parties. *See 3M*,

¹ Petitioner in no way agrees this issue is case dispositive, and believes the Board can—and should—consider Dr. Foty’s testimony regardless because “[t]here is ... no requirement of a perfect match between the expert’s experience and the relevant field.” Practice Guide, 34.

Case IPR2018-00576, Paper 45, 6. And contrary to Patent Owner’s suggestion that until “now” (*i.e.*, issuance of the ALJ order in the ITC) the record was not sufficiently developed for it to raise the issue, the new exhibit was in no way essential to raising the dispute. *See* Sur-reply (Paper 45), 3. There is simply no reason why Patent Owner could not have made the same substantive argument in its Response.

Like the exhibits stricken by the Board in *Satco Prods., Inc. v. Seoul Semiconductor Co., Ltd.*, EX2054 should be stricken because it “w[as] not of record prior to Patent Owner filing [it] with its Sur-reply,” constitutes “new evidence,” and was “improperly submitted, without authorization and in violation of [the Board’s] Rules and Guidance.” IPR2020-00836, Paper 45 at 75-76 (P.T.A.B. Oct. 22, 2021). Patent Owner could have sought Board authorization to submit this new exhibit. *Resi Media LLC v. Boxcast Inc.*, Case IPR2022-00067, Paper 56, 49 (P.T.A.B. Apr. 12, 2023) (“Thus, the proper avenue for seeking entry of additional evidence is not by submitting such evidence *sub silentio*, but by requesting authorization to file such evidence and permitting the Board to determine whether such a submission should be entered and the scope and timing of the submission, as well as determining whether the other party will be provided with further opportunity to respond with or without additional evidence.”). Instead, Patent Owner chose to ignore the Board’s rules and guidelines. Patent Owner’s tactics should not be rewarded. Petitioner

respectfully moves the Board to strike EX2054 and the new argument for which Patent Owner cites EX2054.

Respectfully submitted,

ORRICK, HERRINGTON & SUTCLIFFE LLP

Dated: July 24, 2024

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CERTIFICATE OF SERVICE

The undersigned certifies that on July 24, 2024, the foregoing paper was served in its entirety via electronic mail, upon the following attorneys of record for the Patent Owner:

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