

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 REPLY IN SUPPORT OF ITS
MOTION TO STRIKE PATENT OWNER'S UNAUTHORIZED
SUR-REPLY EXHIBIT AND ACCOMPANYING ARGUMENT**

Patent Owner's Opposition concludes by saying: "it is unclear what Petitioner's motion seeks to accomplish." Opp. (Paper 47), 4. Petitioner's Motion was quite clear—Petitioner seeks to strike EX2054 and the accompanying Sur-reply argument for blatantly violating the Board's rules. Mot. (Paper 46), 1.

Contrary to what Patent Owner's Opposition would lead one to believe, this briefing is *not* a dispute about whether Dr. Foty qualifies as a POSITA. That issue is simply not before the Board. Rather, the issues are: (1) whether Patent Owner ("PO") was authorized to file EX2054 (it was not); and (2) whether PO's Sur-reply argument that Dr. Foty is not a POSITA *was a new argument* (it was).

PO cites no exception allowing new sur-reply arguments that could have been raised in the patent owner response, but were withheld. *See generally* Opp. PO seeks to excuse its violation by saying EX2054 is "publicly accessible." Opp., 1. But many types of documents and evidence—including prior art—are also public. That is simply not the test. And PO's argument misses the bigger point altogether—this is a matter of *procedural fairness*. By raising a new argument and evidence in its Sur-reply, PO deprived Petitioner of an opportunity to respond on the merits.

PO makes three additional arguments, all of which fail.

First, PO asserts Petitioner was "on notice" (Opp., 3) of the issue because PO's "Objections to Evidence" (the "Objections") stated Dr. Foty did not qualify as a POSITA (Paper 14, 1). But the evidentiary rules for sur-reply make no such

exception (*see* 37 C.F.R. § 42.23(b)) and the Objections do not provide a basis to introduce arguments or evidence in PO's Sur-reply. If anything, the Objections demonstrate PO knew how to make the argument and, at most, put Petitioner on notice that PO might file a motion seeking to exclude Dr. Foty's testimony. But Patent Owner's Response did ***not*** challenge Dr. Foty's qualifications, and there was no reason for Petitioner to address it in Reply.

Under PO's logic, a petitioner's reply brief would need to address every evidentiary objection a patent owner made. But briefing on evidentiary objections runs on a different track in IPR proceedings. *See* 37 C.F.R. § 42.64. Notably, that track expressly provides for serving supplemental evidence (which Petitioner did) and motion practice with an opposition brief. Paper 13 (Scheduling Order), 12 (setting briefing schedule for motions to exclude evidence). PO's argument is simply misdirection and only serves to further buttress Petitioner's point—PO strategically withheld its argument until its Sur-reply so Petitioner could not respond.

Second, PO argues EX2054 is a legal ruling, not evidence. Opp., 1. That is wrong. Evidence is “[t]he collective mass of things, esp. testimony and exhibits, presented before a tribunal in a given dispute.” EVIDENCE, Black's Law Dictionary (12th ed. 2024). EX2054 plainly fits this definition: it is an exhibit presented before the Board in a (new) dispute over Dr. Foty's qualifications. Crucially, PO cites EX2054 for a finding of fact by another tribunal. *AstraZeneca*

AB v. Mylan Pharms. Inc., 522 F. Supp. 3d 200, 214 (N.D.W. Va.), *aff'd in relevant parts, remanded*, 19 F.4th 1325 (Fed. Cir. 2021) (who qualifies as a POSITA is a factual question). Such findings are evidence, albeit ***inadmissible*** evidence. *U.S. v. Jones*, 29 F.3d 1549, 1554 (11th Cir. 1994); *Int'l Land Acquisitions, Inc. v. Fausto*, 39 F. App'x 751, 756 (3d Cir. 2002) (collecting cases).

Setting aside the law that EX2054 is inadmissible evidence, the Board's rules unambiguously limit sur-reply evidence to "deposition transcripts of the cross-examination of any reply witness." 37 C.F.R. § 42.23(b). PO could have requested the Board's authorization to submit EX2054, but did not. 37 C.F.R. §42.123(b). PO's violation of the rules should not be countenanced.

Third, PO contends its Response brief argument over the ***definition of a POSITA*** is synonymous with the argument that a particular individual ***qualifies as a POSITA***. Opp., 3-4. Not so. The definition of the level of ordinary skill and the qualifications of an individual under a defined level are two distinct issues. PO's Objections to Dr. Foty's qualifications confirm and clarify this distinction. The Objections stated Dr. Foty "does not qualify as a person of ordinary skill in the art" because of an alleged lack of active-matrix display experience. Paper 14, 1. In contrast, Patent Owner's Response argued only against "Petitioner's definition" of ordinary skill. Response (Paper 33), 7-9. The terms "Foty" and "Petitioner's expert" do not appear anywhere in that dispute. *See id.* The Objections demonstrate PO

knew how to dispute Dr. Foty's POSITA qualifications—but chose not to do so in its Response. Further, the Objections (made before EX2054 issued) confirm PO's argument did not depend on the ALJ's finding and could have been raised earlier.

Nor did Petitioner's Reply put Dr. Foty's qualifications in dispute. The Reply focused on the dispute over the level of ordinary skill. *See* Paper 41, 2-3 (noting PO's expert "rendered no opinion on Dr. Foty's ... qualifications."). Dr. Wolfe's (and PO's) silence confirm Dr. Foty's qualifications were not at issue in PO's Response brief, and thus there was no need to address it in Reply. Further, Petitioner next argued that a higher level of skill would render the Challenged Claims even more obvious, again demonstrating that the dispute was solely over the definition. *See id.*, 3.

Finally, PO insinuates Petitioner violated its duty of candor. *Opp.*, 1. That insinuation is both incorrect and gratuitous. The ethics rules require a practitioner to "disclose to the tribunal legal authority in the controlling jurisdiction" 37 C.F.R. § 11.303(a)(2). The controlling jurisdiction is the Federal Circuit, not the ITC. 28 U.S.C. §1295(a)(4); 35 U.S.C. §141(c).

In summary, Patent Owner's Response did not challenge Dr. Foty's qualifications as a POSITA. Its Sur-reply did, raising a new argument. Relatedly, the ALJ's finding of facts (EX2054) is new (albeit inadmissible) evidence. Petitioner respectfully requests that the Board grant its motion to strike.

Respectfully submitted,

ORRICK, HERRINGTON & SUTCLIFFE LLP

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CERTIFICATE OF SERVICE

The undersigned certifies that on August 5, 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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