UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MIANYANG BOE OPTOELECTRONICS TECHNOLOGY CO., LTD.; TCL CHINA STAR OPTOELECTRONICS TECHNOLOGY CO., LTD.; TIANMA MICROELECTRONICS CO. LTD.; AND VISIONOX TECHNOLOGY, INC.,

Petitioner,

v.

SAMSUNG DISPLAY CO., LTD.,

Patent Owner.

Case No. IPR2023-00988
U.S. Patent No. 10,854,683

PETITIONER'S MOTION TO STRIKE

Pursuant to 37 C.F.R. §§ 42.5(a), 42.7(a), 42.20(a) and the authorization provided by the Board via an email dated April 16, 2024, Petitioner moves to strike the portions of Patent Owner's recently filed Response (Paper 18, "Response") that improperly incorporate arguments from Exhibits 2028 and 2041-2043 by reference in contravention with 37 C.F.R. § 42.6(a)(3) and numerous decisions applying it.

Patent Owner points to Exhibits 2028 and 2041-2043—either directly in its Response or indirectly via citation to its expert declaration, Ex. 2009—to make arguments regarding purported "secondary considerations" of non-obviousness. According to Patent Owner, these exhibits show that (1) a certain Samsung product allegedly "practices" the subject matter claimed by the '683 patent at issue, (2) that Petitioner BOE allegedly "copied" a Samsung product, and (3) that certain third-party products allegedly "infringe" the '683 patent's claims. But, rather than explaining the basis for these arguments in its Response, Patent Owner attempts to do so only in the cited exhibits themselves. This is shown in the quoted passages from Patent Owner's Response below:

> **Response at 69**: "For example, the AMOLED display used in the Samsung Galaxy S22 Ultra product practices all challenged claims of the '683 Patent. Ex. 2009, ¶¶328-330; Ex. 2028 (Galaxy S22 ULTRA Claim Chart); Ex. 2063."

> **<u>Response at 66</u>**: "Petitioner Mianyang BOE copied Samsung Display's pixel arrangements to commercialize AMOLED displays for products including the iPhone 12. Ex. 2009, ¶319. [citing Ex. 2041 (*Samsung Display Co., Ltd. v. BOE Tech. Co. Ltd. et al.*, Case No. 2-23-cv-00309, Compl. (E.D. Tex. Jun. 26, 2023)]."
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> **<u>Response at 66-67</u>**: "AMOLED displays distributed by numerous vendors of replacement AMOLED displays for mobile phones … infringe the challenged claims (see, e.g., Ex. 2042 (chart mapping claims 1-2, 4-10, 13, and 15 to Group Vertical AMOLED Display); Ex. 2043 (chart mapping claims 1-2, 4-10, 13, and 15 to Sourcely Plus AMOLED Display))…."

The passages above constitute improper incorporations by reference that are contrary to the Board's rules and should be struck. While Petitioner bears the ultimate burden to establish that the '683 patent's claims are obvious, it is Patent Owner who must come forward in the first instance with argument and evidence of any purported secondary considerations of non-obviousness. *Bos. Sci. SciMed, Inc. v. Iancu*, 811 F. App'x 618, 623 (Fed. Cir. 2020) (patent owner "bears the burden of production with respect to evidence of secondary considerations of non-obviousness.") (quoting *ZUP, LLC v. Nash Mfg., Inc.*, 896 F.3d 1365, 1373 (Fed. Cir. 2018)). And to the extent Patent Owner alleges—as part of its effort to satisfy this burden—that its own products "practice" the '683 patent, or that others

purportedly engaged in "cop[ying]" or "infringe" the patent's claims, it was required to explain why this is the case in the body of its Response. It cannot do so merely in separate exhibits.

The Board's rules unambiguously explain that "[a]rguments must not be incorporated by reference from one document into another document." 37 CFR 42.6(a)(3); *see also Cisco Sys., Inc. v. C-Cation Techs., LLC*, Case IPR2014-00454, Paper 12, at 10 (P.T.A.B. Aug. 29, 2014) (Informative). This "prohibition … minimize[s] the chance that an argument may be overlooked and … eliminate[s] abuses that rise from incorporation and combination." *Parus Holdings, Inc. v. Google LLC*, 70 F.4th 1365, 1372 (Fed. Cir. 2023). Among other things, an improper "incorporation by reference" both operates as "self-help increase in the length of the brief" and results in an "pointless imposition" on the Board's time by forcing it to dig through the record to determine what is actually being argued. *Id.* (quoting *DeSilva v. DiLeonardi*, 181 F.3d 865, 866-67 (7th Cir. 1999)).

This is what occurred here. Patent Owner's brief is just 300 words short of the 14,000-word limit applicable to such a response. *See* Response at 73. By shifting necessary secondary considerations argument out of its Response and into exhibits, Patent Owner improperly provided itself with "self-help." It was able to jam more arguments (albeit poorly supported ones) into its response and avoided the need to make choices regarding what arguments to include and exclude. Moreover, by not

fleshing out its arguments in the body of its Response, Patent Owner now forces the Board—and Petitioner—to dig through its various exhibits to determine the totality of what it is arguing. *Gen. Access Sols., Ltd. v. Sprint Spectrum L.P.*, 811 F. App'x 654, 658 (Fed. Cir. 2020) ("This exercise of 'playing archaeologist with the record' is precisely what the rule against incorporation by reference was intended to prevent, 77 Fed. Reg. 48,617, and the Board was within its discretion in excluding the arguments made in the claim chart.").

Both the Board and the Federal Circuit have specifically rejected attempts to incorporate claim charts and other lengthy documents that are no different from what Patent Owner has done here. For example, in one case the Board rejected an attempt to show that certain claim limitations were satisfied by the prior art by making only short, declarative statements in the petition itself while citing to exhibits spanning "nearly five pages, four pages of which is a claim chart." *Cisco Sys.,* Case IPR2014-00454, Paper 12, at 8. Similarly, in another case, the Federal Circuit affirmed the Board's refusal to delve into twenty-plus page claim charts to find arguments not raised in the briefs. *Gen. Access Sols.*, 811 F. App'x at 658. And in yet another case, the Federal Circuit agreed that a Patent Owner violated the incorporation by reference rules when citing hundreds of pages of exhibits—including claim charts—in an effort to establish an earlier date of conception. *See Parus Holdings*, 70 F.4th at 1369. Moreover, the Federal Circuit explained that this did not improperly shift

the burden of proof to Patent Owner: when Patent Owner "chose to take on an affirmative burden to show that it was the first to make its claimed inventions," it "bore the responsibilities that came with" such an argument "including submitting a response that complied with the rules and regulations of the USPTO." *Id.* at 1371.

Again, this is precisely what Patent Owner does here. Rather than explaining why the "Samsung Galaxy S22 Ultra product practices all challenged claims" in its Response, it simply says so and points to Exhibit 2028 (a 20-page claim chart) for the supporting argument. *See* Response at 69. Similarly, rather than laying out whatever facts it purports show that "BOE copied Samsung Display's pixel arrangements" in its Response, Patent Owner once again simply declares that this is the case and relies on its expert declaration and an 80-page district court complaint cited therein (Ex. 2041) to explain the allegation. *Id.* at 66. And rather than articulating in its Response why certain third-party displays purportedly "infringe the challenged claims," Patent Owner once again makes a bald allegation in its Response and then points to Exhibits 2042 and 2043 (both 20-page claim charts) for the actual explanation. *Id.* at 66-67.

In sum, and for the reasons explained, the Patent Owner Response passages quoted above constitute improper incorporations by reference. Thus, Petitioner requests that they be struck.

Respectfully submitted,

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Dated: April 23, 2024

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CERTIFICATE OF SERVICE

The undersigned hereby confirms that the foregoing paper was caused to be served on April 23, 2024 via email upon the following counsel of record for Patent Owner:

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