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 SECOND 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 August 14, 2024, Petitioner moves to strike: (1) new Exhibit 2083 and the portions of Patent Owner's sur-reply (Paper 30) relying on this exhibit, (2) the portions of Patent Owner's sur-reply relying on un-filed new Exhibits 2084 and 2085, and (3) the portions of Patent Owner's sur-reply referencing Exhibits 2028 and 2041-2043. As explained in greater detail below, these portions of the sur-reply run afoul of the Board's rules prohibiting the introduction of new exhibits (37 C.F.R. § 42.23(b)) and incorporation of arguments by reference (37 C.F.R. § 42.6(a)(3)).

I. Improper Introduction of New Ex. 2083 (Dr. Pattison's ITC Testimony)

Patent Owner's sur-reply was accompanied by new Ex. 2083, an excerpt from Dr. Pattison's ITC testimony. The sur-reply repeatedly cites to—and extensively quotes from—Ex. 2083 to allege that Dr. Pattison purportedly took "inconsistent" positions and to make substantive arguments regarding the prior art: p. 1, line 14 ("Moreover …") through p. 2, line 1 ("… here.[1]"); p. 2, line 5 ("For example…") through p. 3, line 14 ("… A. Yes."); p. 3, line 17 ("Perhaps ,…") through line 20 ("… opinion"); p. 10, line 17 ("Dr. …") through p. 11, line 2 ("…308:6;"); p. 15, line 19 ("Dr. …") through p. 16, line 1 (" … 300:16-19"); and p. 21, line 11 ("belied …") through line 12 ("…299:5-11"). String citations referencing Ex. 2083 also appear on pp. 4 (line 6), 14 (line 18), 15 (lines 9, 14-15), and 16 (line 6).

None of the cited testimony from Ex. 2083 was discussed during Dr. Pattison's reply deposition. In fact, no substantive questions were asked about Ex. 2083 at all. Patent Owner only asked Dr. Pattison to confirm (1) that Ex. 2083 is in fact a transcript of his ITC trial testimony and (2) that he assessed the same prior art references in the ITC and this IPR. *See* Ex. 2086, 18:8-19:14.

"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). This rule is intended to "provide[] a ***blanket prohibition*** on a patentee filing exhibits with a sur-reply…." *Netflix, Inc. v. Divx, LLC*, IPR2020-00511, Paper 46 at 53-54 (PTAB Aug. 13, 2021) (emphasis added). Certain non-precedential panel decisions have recognized a narrow exception to this. In particular, a patentee may be permitted to employ new exhibits in a sur-reply if those exhibits were introduced at deposition to "test[] the witness' testimony" and are necessarily to provide the Board with "the full context available in order to evaluate the testimony." *Ascend Perf. Materials Ops. LLC v. Samsung SDI Co.*, IPR2020-00349, Paper 53 at 12. (PTAB Jul. 15, 2021) ("*Ascend*"); *Edwards Lifesciences Corp. et al. v. Cardiovalve Ltd.*, IPR2021-00383, Paper 60 at 87 (PTAB Jul. 18, 2022) (sur-reply exhibits may be used for "cross-examination," not "as substantive evidence"). Consistent with this, in an email dated July 31, 2024 the Board informed Patent Owner that it was authorized to submit Ex. 2083 with its sur-reply only "***[i]f***" the

"trial testimony before the ITC was presented to Dr. Pattison for questioning" and "***[i]f*** Patent Owner's sur-reply refers to Dr Pattison's answers at cross-examination pertaining to his trial testimony." Ex. 3002.

Here, Ex. 2083 was not used during Dr. Pattison's reply deposition to "test" his opinions in this IPR. Nor was any of the testimony in Ex. 2083 "presented to Dr. Pattison for questioning." Moreover, Ex. 2083 is not necessary for the Board to understand Dr. Pattison's IPR reply deposition transcript. And Patent Owner's sur-reply does not "refer" to any "answers at cross-examination" in this IPR "pertaining to" Ex. 2083. Again, no substantive questions were asked about and no substantive answers were provided regarding Ex. 2083. Instead, Patent Owner employs Ex. 2083 as a ***completely separate, stand-alone exhibit***. It follows that Ex. 2083—and the portions of Patent Owner's sur-reply citing it—should be struck.

Patent Owner's failure to follow the Board's rules and instructions prejudiced Petitioner. By not asking questions about Ex. 2083 at deposition, Patent Owner prevented Dr. Pattison from clarifying and providing important context. It also deprived Petitioner of the ability to engage in meaningful redirect. Moreover, if Ex. 2083 and the portions of Patent Owner's sur-reply relying on this exhibit remain in the record, Petitioner will be forced to dedicate a portion of its limited oral argument time—which should be spent addressing substantive issues—to correct Patent Owner's repeated mischaracterizations of Dr. Pattison's ITC trial testimony.

Patent Owner may attempt to argue that it could not have introduced Ex. 2083 earlier because Dr. Pattison's ITC testimony did not take place until July 8, 2024. That is of no moment. Once again, Patent Owner could have asked questions about Ex. 2083 at Dr. Pattison's deposition. It chose not to do so in an apparent effort to maintain its ability to mischaracterize Ex. 2083 and interfere with Petitioner's ability to respond. The Board's rules prevent this type of gamesmanship. *See Ascend* at 12 (parties are prohibited from introducing evidence in ways that "depriv[e] the opposing party the opportunity to fully address that evidence")

II. Improper Use of New Exs. 2084-2085 (Dictionary Excerpts)

Exs. 2084-2085 are two dictionary excerpts that define terms such as "active circuit." While the dictionaries were not filed with Patent Owner's sur-reply, Patent Owner nonetheless cites to and relies on portions of Dr. Pattison's reply deposition transcript where passages from the dictionaries were read into the record. Patent Owner employs these indirect citations to show what Matthies—at least in Patent Owner's view—means when it uses the words "active" and "passive": *see* p. 5, line 7 ("Matthies discusses …") through line 14 ("… Ex. 2086, 41:5-42:4").

Again, a patentee is prohibited from introducing new exhibits with a sur-reply. *See* 37 C.F.R. § 42.23(b). If this could be avoided simply by engaging in the type of procedural maneuvering Patent Owner employs here—*i.e.*, reading portions of exhibits into the record at a deposition but not filing them—then the prohibition

would be rendered meaningless. *See Guardant Health, Inc. v. Univ. of Wash.*, IPR2022-00817, Paper 47 at 47-48 (PTAB Oct. 10, 2023) (striking exhibits that are "merely read, without substantive questioning, … into the record").

Moreover, while past panel decisions note that exhibits introduced during a reply deposition can potentially be used for "impeachment," these same decisions also emphasize that new exhibits may not under any circumstances be employed "***as evidence supporting the party's arguments on the merits***" in a sur-reply. *Ascend*, p. 12 (emphasis added). That, however, is exactly how Patent Owner attempts to use the dictionaries here. If Patent Owner wanted to introduce evidence and make arguments regarding the meaning of the terms "active" and "passive" in Matthies, the time to do so was when it filed its response. Indeed, the Board put Patent Owner on notice of this when it explained in its institution decision that it was interested in hearing the parties' views on Matthies' teachings of active and passive-matrix displays. *See* Paper 10 at 40.

III. Continued Improper Incorporation by Reference of Arguments from Exs. 2028 and 2041-2043 (Claim Charts and District Court Complaint)

Patent Owner once again points to Exhibits 2028 and 2041-2043 to make arguments regarding purported "practic[ing]" of "the claims" and "copying." Sur-Reply, 24. This is improper for the same reasons explained in Petitioner's prior motion to strike (Paper 23): the rules require arguments be made in the papers themselves and prohibit incorporation by reference. *See* 37 CFR 42.6(a)(3).

Respectfully submitted,

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Dated: August 21, 2024

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CERTIFICATE OF SERVICE

The undersigned hereby confirms that the foregoing paper was caused to be served on August 21, 2024 via email upon the following counsel of record for Patent Owner:

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