

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Hayato Nakanishi
U.S. Patent No.: 7,259,736 Attorney Docket No.: 54108-0002IP1
Issue Date: August 21, 2007
Appl. Serial No.: 10/712,381
Filing Date: November 14, 2003
Title: ELECTRO-OPTICAL DEVICE, ACTIVE-MATRIX SUB-
STRATE, AND ELECTRONIC APPARATUS

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**PETITIONER'S NOTICE RANKING AND EXPLAINING MATERIAL
DIFFERENCES BETWEEN PETITIONS FOR *INTER PARTES* REVIEW
OF UNITED STATES PATENT NO. 7,259,736**

BOE Technology Group Co., Ltd., Beijing BOE Display Technology Co., Ltd., and Motorola (Wuhan) Mobility Technologies Communication Co., Ltd. (“Petitioners”) are filing two petitions (IPR2023-00605 and IPR2023-01178) challenging U.S. Patent No. 7,259,736 (“the ’736 patent”). Pursuant to the Board’s July 2019 Trial Practice Guide Update, Petitioners submit this paper to “identify: (1) a ranking of the Petitions in the order in which it wishes the Board to consider the merits..., and (2) a succinct explanation of the differences between the Petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions.”

I. RANKING OF PETITIONS

Although Petitioners believe that both Petitions are meritorious and justified, Petitioner requests that the Board consider the Petitions in the following order:

Rank	Petition	Primary References	Challenged Claims
1	IPR2023-00605	Matsuda, Inoue	3-5, 7, 9, 13-17
2	IPR2023-01178	Matsuda, Kimura	18, 23, 33, 35

II. DIFFERENCES THAT COMPEL PERMITTING MULTIPLE PETITIONS

A. Patent Owner’s New Identification of Asserted Claims in District Court Litigation

Petitioners’ second IPR petition is justified to challenge claims that, until recently, were not asserted in the parties’ ongoing district court litigation (*Element*

Capital Commercial Company PTE. Ltd. v. BOE Technology Group Co., Ltd. et al., Case No. 2:22-cv-0118-JRG (E.D. Tex.)). At the time Petitioners filed their first IPR petition, Patent Owner had served infringement contentions pursuant to the Eastern District of Texas' Local Patent Rules alleging that Petitioners infringe Claims 3-5, 7, 9, and 13-17 of the '736 patent. EX-1017 at 2 (2023-01-05 Plaintiff's Infringement Contentions). Because Patent Owner identified no other '736 patent claims as asserted, and because this patent contains 37 claims total, Petitioners chose at that time to only challenge the asserted claims in the first IPR petition. On February 22, 2023, Petitioner filed IPR2023-00605 challenging those claims. Over three months later, on May 31, 2023, Patent Owner informed Petitioner that it intended to move the district court for leave to amend its infringement contentions to additionally assert claims 23 and 35, which depend from independent claims 18 and 33, respectively. EX-1018 (2023-05-31 Email from Patent Owner). Petitioners' second IPR petition (filed concurrently) addresses newly-asserted claims 23 and 35 and the independent claims 18 and 33 from which the newly-asserted claims depend.

Petitioners' second IPR petition should be instituted because the Board regularly institutes second petitions challenging claims that Patent Owners did not assert at the time of the first petition. *See, e.g., Volkswagen Grp. of Am., Inc. v.*

Carucel Invs., L.P., No. IPR2019-01573 (Paper 7) (P.T.A.B. Jan. 22, 2020) (instituting second IPR where Patent Owner waited nearly three months after Petitioner filed its first IPR to assert the newly added claims that were being challenged in the second IPR); *R.J. Reynolds Vapor Co. v. Fontem Holding I B.V.*, IPR2017-01120 (Paper 11) (P.T.A.B. Oct 23, 2017) (“To conclude that a Petitioner is foreclosed from pursuing any additional claims in connection with a subsequent petition when faced with new infringement contentions is, in our view, untenable.”); *see also Fisher & Paykel Healthcare Ltd. v. ResMed Ltd.*, IPR2017-01789 (Paper 7) (P.T.A.B. Jan. 25, 2018) (instituting third petition on unasserted claims 1-22 that “w[ere] not involved in the ITC or district court case that triggered the [first and second] petitions”).

B. Patent Owner Agreed Not to Argue that the Board Should Exercise its Discretion to Deny the Second IPR Petition

In exchange for Petitioners not opposing Patent Owner’s motion for leave to amend its infringement contentions before the district court, Patent Owner agreed “[n]ot to argue discretionary denial of a subsequent IPR petition filed against the newly asserted claims.” EX-1019 (2023-06-29 Email Thread Memorializing Agreement). Patent Owner should be held to this agreement by allowing Petitioners’ second IPR petition to proceed.

C. The Second Petition Includes Materially Distinct Arguments and Prior Art

The second IPR petition challenges different claims and presents new arguments and prior art that were not present in the first petition. The first petition challenged claims 3-5, 7, 9, and 13-17 based on Patent Owner's initial infringement allegations, whereas the second IPR petition challenges claims 18, 23, 33, and 35 based on Patent Owner's new infringement allegations that occurred after the first IPR petition was filed. Dependent claims 23 and 35 generally recite that "at least one of the first and second [light-emitting regions/element forming regions]" has "an electronic circuit to [control light emission of / drive] the [first or second light-emitting film provided in another first or second light-emitting region / electro-optical element that is provided in another first or second element forming region]."¹ This limitation does not appear in the claims challenged in the first IPR petition. As a result, Petitioners' second IPR petition presents a ground that uses a new prior art reference (U.S. Pub. App. No. 2003/0090447 to Kimura) that was not used in any of the first IPR petition's grounds. *See* 35 U.S.C. 325(d).

At the same time, the second IPR petition leverages a common prior art reference (JPH11185654A to Masuda) to address the independent claim limitations

¹ In the bracketed language, the language before the slash refers to limitations of claim 23 and the language after the slash refers to limitations of claim 35.

challenged in both petitions (i.e., claim 3 in the first petition and claims 18 and 33 in the second petition). Accordingly, the second IPR petition avoids burdening the Board any more than necessary, respecting the Board’s interest in “efficient administration of the Office.” *See* 35 U.S.C. § 315(b).

Petitioners submit that further efficiencies may be achieved by accelerating the schedule of the second IPR such that it may be consolidated with the first IPR (e.g., by determining whether to institute both IPRs by October 13, 2023—three months after the last date by which Patent Owner must file its preliminary response to the first IPR). Because the newly challenged independent claims (18 and 33) overlap significantly with the previously challenged independent claim (3) and because only two additional dependent claims are challenged, Petitioners submit that such acceleration is feasible.

III. Conclusion

The Board should not exercise its discretion to deny either of Petitioner’s IPR petitions. As discussed above, the first IPR petition challenges claims that Patent Owner initially asserted in litigation, and the second IPR petition challenges different claims that Patent Owner only recently chose to assert. Denying institution of either petition would effectively penalize Petitioner for Patent Owner’s late assertion of claims. As the Board has recognized, such a penalty is “untenable.”

Even Patent Owner has agreed not to argue that the Board should exercise its discretion to deny the second IPR petition. The second IPR petition is further justified by the fact that it challenges new limitations and presents new prior art that were not at issue in the first IPR petition. At the same time, the second IPR petition does not impose significant additional burdens on the Board because the independent claims challenged in the first petition significantly overlap with the independent claims challenged in the second petition.

Respectfully submitted,

Dated July 7, 2023

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(Control No. IPR2023-01178)

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4)(i) *et seq.* and 42.105(b), the undersigned certifies that on July 7, 2023, a complete and entire copy of this Petition for *Inter partes* Review and all supporting exhibits were served via email to the Patent Owner. These materials were also provided via Federal Express to the correspondence address of record as follows:

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