

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 Company, Ltd.,
Patent Owner.

U.S. Patent No. 9,330,593

Case No. IPR2024-00620

PETITIONER'S PRELIMINARY REPLY

I. INTRODUCTION

Pursuant to the authorization provided by the Board, Petitioner submits the following reply to Patent Owner's Preliminary Response (Paper 9, "Response"). According to Patent Owner, the *General Plastic* factors considered by the Board when determining whether to institute IPR in circumstances where the patent-at-issue is the subject of multiple, sequential IPR proceedings "favor[] denial" here. Response, 2. Patent Owner posits that *General Plastic* applies because, despite withdrawing its first '593 patent petition shortly after filing, Petitioner filed a second petition and is thus somehow seeking a "second bite at the apple." *Id.*, 7, 14.

This mis-understands the law. *General Plastic* does not completely bar IPR. Instead, it is meant to guard against a specific scenario: when a petitioner improperly seeks to employ an earlier Board decision (or preliminary response) as a roadmap when crafting later IPRs. This did not occur here. Only a single petition challenging the '593 patent is currently pending. While Petitioner did file an earlier petition, it was never addressed on the merits. The petition was withdrawn before Patent Owner filed its preliminary response and before the Board rendered an institution decision.

Next, there is a co-pending ITC proceeding relating to the '593 patent. Patent Owner's priority date allegations in that proceeding—and not its assessment of the prior art, which lacks merit—did play a role in defining the scope of Petitioner's challenge. This, however, is neither particularly unusual nor improper. IPR

proceedings are *intended* to serve as an alternative to the litigation of invalidity challenges in other forums. Thus, both petitioners and patent owners routinely craft IPR filings in ways that address positions taken in co-pending actions.

II. ARGUMENT

When determining whether to institute a “follow-on petition[]” under § 314(a), the Board considers factors set forth in *General Plastic Industrial Co. v. Canon Kabushiki Kaisha*, Case IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (“*General Plastic*”). These factors balance competing goals: the Board seeks to “improve patent quality” while avoiding “abuse of the review process by repeated attacks on patents.” *Id.* at 15-16. At its heart, *General Plastic* seeks to prevent a petitioner from improperly “benefit[ing] from receiving and having the opportunity to study Patent Owner’s Preliminary Response, as well as [the Board’s] institution decisions on [a] first filed petition, prior to its filing of follow-on petitions.” *Id.* at 17. Thus, the Board may decline to institute if it determines that petitioner repeatedly filed petitions “using [Board] decisions as roadmap....” *Id.*

Here, there is currently only a *single* pending petition relating to the ’593 patent. Petitioner did file another, earlier petition. But it was withdrawn before Patent Owner filed its preliminary response and before the Board issued an institution decision. Thus, Petitioner *did not* use a prior Board decision (or Patent Owner’s response) as “roadmap.” In such circumstances, *General Plastic* is

inapplicable. *See, e.g., CSC Serviceworks, Inc. v. Payrange Inc.*, IPR2023-01449, Paper 14 at 11 (PTAB Apr. 12, 2024) (the fact that there are “no longer multiple petitions pending against” a patent “obviate[s]” *General Plastics*); *Regeneron Pharms., Inc. v. Novartis Pharma AG*, IPR2021-00816, Paper 13 at 18-19 (PTAB Oct. 26, 2001) (similar). The Board has recognized as much, explaining that “allowing [a petitioner] the opportunity to pursue a decision... in a second-filed petition, when the first-filed petition was not evaluated on the merits”—as is the case here—“best balances the desire to improve patent quality ... against the potential for abuse ... by repeated attacks on patents.” *Code200, UAB v. Bright Data Ltd.*, IPR2022-00861, Paper 19 at 4-5 (PTAB Aug. 23, 2022) (precedential) (“*Code 200*”). Patent Owner ignores this. Rather than citing *General Plastic* to ensure that the ’593 patent is assessed by the Board only once, Patent Owner seeks to ***completely avoid*** Board review and limit assessment of ’593 patent to only its preferred forums.

While this alone merits rejection of Patent Owner’s argument, a factor-by-factor assessment leads to the same conclusion: the Board should institute IPR.

Factors 1-3: The Board has explained that “*General Plastic* factor 1 must be read in conjunction with factors 2 and 3.” *Code200* at 5. And “[w]here the first-filed petition ... was ... not evaluated on the merits, factors 1-3 only weigh in favor of discretionary denial when there are ‘road-mapping’ concerns...” *Id.* Such “road-mapping” occurs when a petitioner uses a prior Board decision as a guide in later

filings. *Id.* (quoting *General Plastic* at 17). Again, no “road-mapping” occurred in this case. No institution decision issued, and no preliminary response was filed.

Despite this, Patent Owner argues that these factors favor denial of institution because “Petitioner had the benefit of analyzing Patent Owner’s validity positions in a parallel proceeding before the” ITC. *E.g.*, Response, 3-4. This is not what *General Plastic* guards against. *See, e.g., Valve Corp. v. Elec. Scripting Prods. Inc.*, IPR2019-00062, Paper 11 at 2, 13 (PTAB April 2, 2019) (precedential) (discussing petitioner use of a ***prior Board institution decision*** as a roadmap in a later IPR filing). Moreover, the Board has repeatedly indicated that it is ***appropriate*** for a petitioner to take co-pending litigation positions into account. For instance, the Board’s rules require submission of district court and ITC claim construction determinations. *See* Nov. 2019 Practice Guide at 47. Similarly, the rules explain that other co-pending litigation events—such as “dispute[s] about priority date[s]”—can be accounted for in and even justify additional filings. *Id.* at 59. Accepting Patent Owner’s position here—and penalizing Petitioner for tailoring its challenge in view of issues in a co-pending proceeding—would be inconsistent with rules like these. It would also undermine one of the central purposes of an IPR: to serve as efficient alternative to expensive district court or ITC litigation.

Factors 4-5: These factors consider how much time elapsed between filings. Here, Petitioner filed its second petition only 8 months after filing the first (and only

4 months after it moved to terminate this first petition). Nothing about this timing is unreasonable, particularly since the '593 patent is part of a multi-patent case. *See Arista Networks Inc. v. Corrigent Corp.*, IPR2023-00839, Paper 9 at 13-14 (PTAB Dec. 7, 2023) (three month delay reasonable; no further explanation required).

Factors 6-7: Patent Owner argues that the “Board should not expend its finite resources to endorse Petitioner’s second bite at the apple.” Response, 14. This misses the point: these *General Plastic* factors are meant to avoid ***duplicative*** Board efforts. They do not prevent IPR entirely. *See Code* 200 at 6 (“[T]he Board’s mission to improve patent quality ... outweighs the impact on Board resources....”). Patent Owner next improperly posits that Petitioner’s decision to withdraw its first petition and file a second somehow resulted “from its own errors.” Response, 14. It did not. To date, Patent Owner has failed to meaningfully distinguish any reference identified by Petitioner from the '593 patent’s claims. Thus, by withdrawing its first petition, Petitioner was not remedying a disclosure issue (as there are none). It was streamlining the parties’ dispute (by pursuing only one petition) and avoiding unnecessary, collateral issues (like prior conception arguments). Patent Owner concludes by seeking to leverage the timing of the ITC proceeding. *See* Response, 15. Per Patent Owner, the ITC’s advanced “schedule” somehow also merits non-institution. *Id.* But co-pending ITC proceedings have no bearing on whether IPR is appropriate. *See* June 2022 Interim Proced. for Discr. Denials at 2-3.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby confirms that the foregoing paper was caused to be served on July 18, 2024 via electronic mail upon the following counsel of record for Patent Owner:

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