

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 IPR2024-00620
U.S. Patent No. 9,330,593

PATENT OWNER'S PRELIMINARY SUR-REPLY

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I. Introduction

Petitioner does not attempt to justify its serial petitioning, and tacitly admits its representation to the Board as to the reason for dismissing its First Petition was inaccurate. Although Petitioner considered and relied upon discovery responses by Patent Owner in a parallel litigation before the ITC in preparing its Second Petition, filed 8 months later, Petitioner asserts that it did not engage in the same “road-mapping” as in *General Plastic* and would limit the Office’s discretion to deny serial petitions to that “specific scenario” of road-mapping. Prelim. Reply at 2. But *General Plastic* is not so limited. Petitioner does not dispute it should have filed the Second Petition in place of the First Petition, nor explain its failure to do so. Petitioner’s choice to file both petitions serially is fatal to the Second Petition.

II. *General Plastic* Is Not Limited to Factor 3

Petitioner incorrectly tries to limit *General Plastic* to “a specific scenario: when a petitioner improperly seeks to employ an earlier Board decision (or preliminary response) as a roadmap when crafting later IPRs.” Prelim. Reply at 2. *General Plastic*’s seven factors are not so limited, and only one (factor 3) concerns this type of road-mapping. See *General Plastic Industrial Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16 (PTAB Sept. 6, 2017) (precedential) (“*General Plastic*”) (enumerating six other “non-exhaustive” factors). Indeed, *General Plastic* expressly states that the other factors are used “to assess and weigh

whether a petitioner should have or could have raised the new challenges earlier.”
Id. at 18.

As the Office has explained, the *General Plastic* “framework supports the Office’s goal of reducing duplicative challenges to a patent” in all forms, not just this type of road-mapping. Discretionary Denial NPRM, 89 Fed. Reg. 28,693, 28,699 (Apr. 19, 2024); *see id.* at 28,704 (proposing a rule providing discretion to “deny institution of *any* serial petition”) (emphasis added). *Code200* is likewise not limited to this type of road-mapping, as the sentence Petitioner crops (Prelim. Reply at 3) makes clear when read in its entirety: “Where the first-filed petition under factor 1 was discretionarily denied or otherwise was not evaluated on the merits, factors 1–3 only weigh in favor of discretionary denial when there are ‘road-mapping’ concerns under factor 3 *or other concerns under factor 2.*” *Code200, UAB v. Bright Data Ltd.*, IPR2022-00861, Paper 18 at 5 (PTAB Aug. 23, 2022) (precedential) (emphasis added). Such concerns (e.g., those under factor 2) are present here, *see* POPR at 9-13, and they warrant discretionary denial.

III. Factors 1-3 Favor Denial Because Petitioner Revised Its Grounds in View of Issues in the ITC Proceeding

General Plastic factors 1-3 favor denial here. Petitioner’s cited materials are either inapplicable or support denial. The Trial Practice Guide clarifies that prohibited serial petitioning is not limited to road-mapping. *See* Trial Practice Guide at 56 (*General Plastic*’s “non-exclusive factors” apply “especially as to

‘follow-on’ petitions challenging the same patent as challenged previously in an IPR, PGR, or CBM proceeding,” without limiting to road-mapping). Petitioner’s citations to unrelated portions of the Trial Practice Guide do not show otherwise. Prelim. Reply at 4 (citing Trial Practice Guide at 47 (addressing claim construction), 59 (addressing parallel petitions)).

Petitioner cites *Valve* and two non-precedential decisions as involving road-mapping, Prelim. Reply at 4 (citing *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11 (PTAB Apr. 2, 2019)), but those decisions do not establish road-mapping as a requirement for discretionary denial under *General Plastic*. *Valve* addresses how *General Plastic* applies to different, but related petitioners, and Petitioner does not explain how *Valve* precludes denial.

Likewise with *CSC Serviceworks, Inc. v. Payrange Inc.*, IPR2023-01449, Paper 14 (PTAB Apr. 12, 2024), and *Regeneron Pharms., Inc. v. Novartis Pharma AG*, IPR 2021-00816, Paper 13 (PTAB Oct. 26, 2021), which Petitioner asserts show that “the fact that there are ‘no longer multiple petitions pending against’ a patent ‘obviate[s]’ *General Plastics* [sic].” Prelim. Reply at 3 (quoting *CSC*, Paper 14 at 11). First, this has nothing to do with road-mapping, as it addresses *General Plastic* factors 4-7. *CSC*, Paper 14 at 11. Even then, it applied only “[u]nder the circumstances” in that case, including the fact that the Patent Owner abandoned its argument that the Petition should be discretionarily denied. *Id.* Similarly,

Regeneron was “a unique situation created solely by [Patent Owner’s] actions.” Paper 13 at 20. Neither *CSC* nor *Regeneron* establish that road-mapping is the only basis for discretionary denial of serial petitions.

Yet even if Petitioner were correct that factors 1-3 only weigh in favor of discretionary denial when there are road-mapping concerns, Prelim. Reply at 3, *Code200*’s articulation of road-mapping activity, which includes “refin[ing] based on lessons learned from later developments,” encompasses Petitioner’s actions. *Code200* at 5. Here, Petitioner admits that it “tailor[ed] its challenge in view of issues in a co-pending proceeding.” Prelim. Reply at 4. Indeed, Petitioner changed its analysis of the prior art to take into account Patent Owner’s arguments at the ITC. *See, e.g.*, Pet. at 85 (“[W]hile certain of Tobita’s transistors do not directly provide output to node N1, Patent Owner has taken the position in the associated ITC action that the claimed ‘first driver’ can indirectly control node voltage.”).

IV. Factors 4 and 5 Favor Denial Because Petitioner Could Have and Should Have Filed the Present Petition Earlier

Petitioner does not dispute that it should have been aware of all relevant prior art when it filed the first petition, nor does Petitioner explain its delay.

Petitioner’s sole argument with respect to factors 4 and 5 is that Petitioner’s delay of 8 months was reasonable, Prelim. Reply at 4-5, even though it knew or should have known of all of the relevant prior art at the outset. As support, Petitioner cites a non-precedential case where the petitioner only delayed for three

months. *Id.* at 5. Petitioner does not engage with the precedential decision cited by Patent Owner. POPR at 10 (citing *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 at 9-11 (PTAB Oct. 28, 2020) (precedential) (factors 2 and 4 weigh against institution where Petitioner failed to provide explanations)). That failure is telling.

V. Factors 6 and 7 Favor Denial Because Denial is Efficient

Petitioner fails to engage with Patent Owner's showing that Patent Owner had made Petitioner aware that at least certain references in the First Petition were not prior art *before* it was filed. POPR at 14-15. Petitioner's choice to subsequently revise its grounds is entirely an issue of Petitioner's own making. *Id.*; see Prelim. Reply at 2 (admitting Petitioner revised its grounds because of Patent Owner's contentions). And Petitioner was not "streamlining the parties' dispute (by pursuing only one petition)" when it withdrew the First Petition, Prelim. Reply at 5; it instead ended the sole IPR involving this patent, allegedly for efficiency, POPR at 13, only to inefficiently raise this entirely new controversy months later.

Finally, Petitioner disputes neither the timeline explained by Patent Owner nor that this IPR would delay resolution of the parties' disputes. POPR at 15-16.¹

¹ Curiously, Petitioner stresses that "IPR proceedings are intended to serve as an *alternative*" to the ITC proceeding, Prelim. Reply at 1-2 (emphasis added), even though trial has already concluded in the ITC proceeding.

Date: July 25, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, I hereby certify that the foregoing Patent Owner's Preliminary Sur-reply was served by electronic mail on the following counsel of record for petitioner:

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