From:	Trials
To:	Zhong, Annita; Garr, David; Trials
Cc:	#PictivaIPR; Weidenfeller, Scott; SDC-Pictiva-IPR
Subject:	RE: IPR2024-01093 -01094, -01095, -01222, and -01223 -- joint email on litigation developments
Date:	Monday, November 10, 2025 4:33:21 PM
Attachments:	image001.png

Counsel,

The parties' joint statement is noted.

Patent Owner's further statement and its subsequent reply email go far beyond appraising the Board of developments, improperly circumvent our rules and procedures regarding motions practice, and will be ignored. The Board will not consider Patent Owner's further statement or reply email. This is not the first time that Patent Owner has included improper substantive argument in email correspondence with the Board. See, e.g., IPR2024-01093, Ex. 3102. Patent Owner is cautioned that it should refrain from substantive argument or engaging in motions practice by email and that the Board will consider punitive/protective measures if Patent Owner does not abide by our rules or instructions in the future.

A copy of this email will made of record in these proceedings.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
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UNITED STATES PATENT AND TRADEMARK OFFICE

From: Zhong, Annita <HZhong@irell.com>
Sent: Monday, November 10, 2025 12:54 PM
To: Garr, David <dgarr@cov.com>; Trials <Trials@USPTO.GOV>
Cc: #PictivaIPR <PictivaIPR@irell.com>; Weidenfeller, Scott <SWeidenfeller@cov.com>; SDC-Pictiva-IPR <SDC-Pictiva-IPR@cov.com>
Subject: RE: IPR2024-01093 -01094, -01095, -01222, and -01223 -- joint email on litigation developments

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Dear Honorable Board,

Petitioner does not dispute that the grounds raised in the district court are cumulative of the grounds in IPR2024-01095. Petitioner also does not assert that it could not have raised before the Board Kondakova or Wei. The Board should terminate the proceeding, which risks inconsistent outcomes and is neither a fair not efficient use of Office resources.

Respectfully,

H. Annita Zhong
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From: Garr, David <dgarr@cov.com>
Sent: Monday, November 10, 2025 9:12 AM
To: Zhong, Annita <HZhong@irell.com>; Trials <Trials@USPTO.GOV>
Cc: #PictivaIPR <PictivaIPR@irell.com>; Weidenfeller, Scott <SWeidenfeller@cov.com>; SDC-Pictiva-IPR <SDC-Pictiva-IPR@cov.com>
Subject: RE: IPR2024-01093 -01094, -01095, -01222, and -01223 -- joint email on litigation developments

Dear Honorable Board,

Petitioner believes that Patent Owner's lengthy email argument is improper and immaterial. The Board's General Order merely directs the parties to "keep the Board apprised of developments" on related adjudications; it is not an open-ended invitation for additional briefing. Additionally, a jury verdict on different prior art should not preclude the Board from issuing a final written decision on the prior art references at issue in IPRR2024-01095. Indeed, these references were not raised and could not have been raised in the district court, in light of Petitioner's stipulation.

Respectfully submitted,
David Garr
Counsel for Petitioner Samsung Display Co., Ltd.

David A. Garr
Pronouns: He/Him/His

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From: Zhong, Annita <HZhong@irell.com>
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Cc: #PictivaIPR <PictivaIPR@irell.com>; Garr, David <dgarr@cov.com>; Weidenfeller, Scott <SWeidenfeller@cov.com>; SDC-Pictiva-IPR <SDC-Pictiva-IPR@cov.com>
Subject: IPR2024-01093 -01094, -01095, -01222, and -01223 -- joint email on litigation developments

[EXTERNAL]

Dear Honorable Board,

Pursuant to the General Order on Related Matters Updates, the parties to the above-referenced proceedings write to notify the Board that a trial was held in *Pictiva Displays International Ltd. v. Samsung Electronics Co., Ltd.*, Case No. 2:23-cv-00495 (E.D. Texas), involving the patents challenged in these proceedings (U.S. Patent Nos. 6,949,389, 8,558,223, 8,723,164, and 11,818,425), along with 8,314,547.

The trial began on October 27, and a verdict was entered on November 3. The jury found that claim 2 of the '425 patent was infringed and not invalid over (1) a system art called Clix2 alone or in combination with a reference called Wei and (2) a reference called Kondakova. Patent Owner is happy to provide the Board with both Wei and Kondakova.

The jury found that claims 34 and 35 of the '389 patent, claims 1, 2, and 9 of the '223 patent, and claims 1, 5, 6, and 9 of the '164 patent were not proven to be infringed; the jury did not make an invalidity finding on those claims.

Patent Owner's Further Statement:

Patent Owner respectfully submits that this development ***requires termination*** of at least ***IPR2024-01095*** (involving the '425 patent) for the reasons explained below. At minimum, the Board should consider the arguments made in the related matter by Petitioner's real-parties-in-interest (see Paper 1, at 2) Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, "the Samsung Defendants"), as well as the jury's findings.

The Board should terminate IPR2024-01095 because the attached ***verdict*** found, among other things, that the ***Samsung Defendants willfully infringed*** and ***failed to prove the invalidity*** of claim 2 of ***the '425 patent***, and awarding $92.6 million in damages tied to that specific patent claim. *Pictiva Displays Int'l Ltd. v. Samsung Elecs. Co.*, No. 2:23-cv-00495, Dkt. No. 577 (E.D. Tex. Nov. 3, 2025). This verdict is highly relevant to the pending IPR proceedings. *See, e.g.*, *Inergy Tech., Inc. v. Force MOS Tech. Co.*, IPR2024-00094, Paper 41 (Acting Director Order), at 3 (Sept. 17, 2025) (noting that "it is important for the Board to consider a district court's prior validity determination when adjudicating the patentability of the same or

substantially the same claims," and that "Patent Owner should have brought the jury verdict to the Board's attention immediately after the verdict was entered").

The disclosures and theories relied upon by the Samsung Defendants in the district court litigation are cumulative of those relied upon by Petitioner in this IPR. For example, the Samsung Defendants told the jury that Kondakova discloses all of the claim elements including a reference to Liq as the n-dopant for the electron transport layer, which they argued was disclosed or suggested by Kondakova. Similarly, while conceding that "Clix2 doesn't use an N-doped ETL," Samsung argued that the missing limitation would be obvious in light of a Wei reference, which was by the same research group as Ma and presented nearly identical information as Ma. Here, Petitioner similarly contends that Diekmann and Suzuki disclose every limitation other than an electron transport layer comprising n-doping by Liq, which Petitioner argues is suggested by Ma. In other words, the jury in Texas already addressed the fundamental arguments being advanced by Petitioner in these proceedings.

This jury verdict confirms that the Board should not have instituted IPR in view of *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020) (precedential) and the co-pending district court litigation. Patent Owner alerted the Board to the high likelihood of a validity determination by the district court prior to the deadline for a final written decision in this IPR. *See* Paper 7 (POPR), at 64-65; Paper 9 (Preliminary Sur-Reply), at 5. Indeed, the Board declined to institute another IPR based on a previously filed petition involving the same Petitioner challenging a different patent involved in the same co-pending litigation. *See* IPR2024-00855, Paper 12, at 8-9 (Nov. 19, 2024) (finding that the "second factor favors denial based on the trial date set for the District Court action").

The Board's Institution Decision characterized discretionary denial as "a close issue" but appearing to minimize the importance of the trial date and the investments in that litigation by the parties and the district court, while placing greater weight on the belated *Sand Revolution* stipulation submitted by Petitioner after Patent Owner's Preliminary Response and Preliminary Sur-Reply. *See* Paper 12 (Institution Decision), at 10-12. The Board's Institution Decision cited the now-rescinded June 21, 2022 Memorandum regarding *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* (Paper 12 at 7 n.10), which elevated the role of stipulations regarding parallel litigation by prohibiting discretionary denial in the face of a *Sotera* stipulation, and which diminished the importance of the proximity to trial. The Board's Institution Decision appears to reflect the spirit of that Memorandum, which was rescinded shortly thereafter. *See generally* Paper 14 (Patent Owner Request for Director Review).

The jury verdict demonstrates that the continued litigation of this IPR proceeding is out of step with current USPTO policy. Indeed, numerous subsequent institution and Director Review decisions confirm that even broader *Sotera*-style stipulations should not preclude discretionary denial. *See, e.g.*, *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 (Director Review Order), at 3-4 (Mar. 28, 2025) (holding that "Petitioner's [*Sotera*] stipulation does not ensure that these IPR proceedings would be a 'true alternative' to the district court proceeding"). Here, the Board relied on a *Sand Revolution*-style stipulation, which extended only to "those grounds that were raised in the IPR." Paper 12, at 10. Indeed, Petitioner's district court invalidity arguments relied in part on a published patent application and a journal article that it could have raised in its IPR Petition. *See Pictiva Displays*, No. 2:23-cv-00495, Dkt. No. 524 at 1-2 (Defendants' Notice of Final Invalidity Theories and Equitable Defenses) (E.D. Tex. Nov. 3, 2025) (identifying U.S. Patent Application Publication No. 2006/0134460

('Kondakova') as a ground of invalidity based on anticipation and obviousness theories and relying on a reference called Wei for an obviousness theory). In support, the Board cited a decision that actually determined that a *Sand Revolution* stipulation was "narrowly scoped" and weighed "only marginally against denying institution." *Nokia of Am. Corp. v. Soto*, IPR2023-00680, Paper 30 (Director Review Decision), at 13 (Dec. 3, 2024). Such stipulations merit even less weight under current agency policy.

Regardless of whether the Institution Decision was correctly decided (it was not), the Board should now terminate IPR2024-01095 and should not issue a final written decision ***after*** a federal jury rejected invalidity arguments raised by Petitioner's real-parties-in-interest based on at least one ground that could have been raised in this IPR. Doing so is neither an efficient use of Office resources, nor consistent with the AIA's goals of ***providing an alternative to district court litigation***. Moreover, the ***risk of inconsistent determinations*** raises significant Separation of Powers concerns.

Furthermore, Patent Owner has explained in this IPR why a POSITA would not have regarded Liq as a "suitable molecular n-dopant for an electron-transporting material in OLEDs" (as argued by Petitioner) because its HOMO is too far below the LUMO of alleged ETL materials. Paper 21 (POR), at 30. Petitioner resisted that argument for validity, but the Samsung Defendants embraced that same argument for non-infringement despite testimony that Liq used a different mechanism for n-doping in the accused products. Petitioner's real-parties-in-interest's agreement that Liq is unsuitable as a molecular n-dopant despite the Petitioner's contrary arguments in these IPR proceedings provides another independent reason to terminate IPR2024-01095 or find claims 2 and 17 not unpatentable. *See Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 (Director Review Order) (Nov. 3, 2025) (precedential) (vacating institution decision because the petitioner proposed different claim construction positions before a district court and the PTAB without explanation).

Patent Owner is also happy to provide further instances of inconsistent claim construction positions in other proceedings, including IPR2024-01094 (as noted in the POR, the Sur-Reply and at hearing), IPR2024-01222 and IPR2024-01223. As made clear by *Revvo Technologies*, Petitioner's assertion that it was allegedly applying Patent Owner's interpretation is insufficient under Rules 104(b)(3)-(4) and by extension Section 312(a)(4), and such deficiencies warrant rescission of the institution decision(s) because a petition "may be considered only if" the requirements of Section 312(a) are met. Section 312(a)(4) specifically requires "the petition provide[] such other information as the Director may require by regulation," one of which is Rule 104(b).

Patent Owner further notes that the jury found claims 1 and 8 of the '547 patent infringed and not invalid over a combination based on the same Igarashi reference at issue in IPR2024-00855, which the Board declined to institute.

Respectfully,

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