

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BOE Technology Group Co., LTD.
Petitioner

v.

Optronic Sciences LLC
Patent Owner

Inter Partes Review No.: IPR2024-01130

U.S. Patent No. 7,168,842

**PETITIONER'S REPLY TO PATENT OWNER'S
PRELIMINARY RESPONSE**

INDEX OF EXHIBITS

Exhibit No.	Description
1001	U.S. Pat. No. 7,168,842 (“ the 842 Patent ”)
1002	Declaration of Dr. R. Jacob Baker
1003	File History of 7,168,842 (11/00,372)
1004	JP 2004-279262 (“ Kurokawa ”)
1005	U.S. 7,218,041 (“ Isoda ”)
1006	U.S. 2002/0047978 (“ Fukuta ”)
1007	U.S. 2002/0140880 (“ Weindorf ”)
1008	U.S. Pat. No. 6,927,424 (“ Uekusa ”)
1009	U.S. 2002/0030445 (“ Fukasawa ”)
1010	JP 2002-164583 (Machine Translated via Google Translate and Espacenet)
1011	U.S. 2004/0061440 (“ Imai ”)
1012	U.S. 2004/0130884 (“ Yoo ”)
1013	JP 2004-193002 (“ Sakai ”) (Machine Translated via Google Translate)
1014	U.S. 2004/0262053 (“ Ludewig ”)
1015	U.S. 2004/0169451 (“ Oishi ”)
1016	KR 2004/0057269 (Machine Translated via Google Translate)
1017	EP 1467414 (“ Ge ”)
1018	U.S. 2001/0024250 (“ Fujishiro ”)
1019	JP 2001-160312 (“ Takuo ”) (Machine Translated via Google Translate)
1020	U.S. 2001/0030866 (“ Hochstein ”)
1021	Curriculum Vitae of Dr. R. Jacob Baker
1022	Docket Navigator Report (highlighted)
1023	’842 Statutory Disclaimer

Petitioner files this Reply pursuant to the Board's November 22, 2024 email to address the *Fintiv* factors in light of developments in the underlying litigation.

Factor 1 continues to be neutral because the Board should not speculate on how the Court will rule on any motion to stay filed post-institution. Pet., 90.

Factor 2 weighs in favor of institution. Any trial in the litigation will occur sometime after jury selection, which is set for January 5, 2026. EX2001, 1. And trial is likely to occur substantially after that date, because the court set 10 cases for jury selection on the same day. EX1022, 1-2 (highlighting cases). In the unlikely event trial started on the day of jury selection, the trial would end on January 9, just 20 days before this Board's Final Written Decision would be due. This timing weighs in favor of institution. See Paper 9 at 33-34, IPR2024-00613 (trial less than three months before the Final Written Decision favors institution).

Factor 3 weighs heavily in favor of institution. While contentions have been served, nothing else of significance has occurred in the litigation. To date, PO has not even produced the agreement(s) through which PO allegedly obtained ownership of the patent. The Board's decision on institution will issue no later than January 29, 2025, almost six weeks before the parties begin the claim construction process by identifying claim terms (March 11, 2025). EX2001, 5.

Factor 4 weighs heavily in favor of institution because this IPR challenges claims 5-9, while the litigation will address, at most, claims 5, 7 and 8. EX2002;

EX1023 (statutory disclaimer of claims 3-4). Claims 6 and 9 represent 40% of this IPR and raise substantially different issues related to the placement of heat sinks, which was the sole purported problem in the prior art. EX1001, 1:61-2:5.

Further, the patent likely will not reach trial because PO disclaimed claims 3 and 4, so there will likely be no overlap. The remaining claims require an L-shaped “fastener” that fastens an LED to a first portion and fastens a circuit board to a second portion. *See, e.g.*, EX1001, [7b] (“L-shaped”), [7c] (LED “disposed on” first portion), [7d] (circuit board “connecting” second portion). Only one of PO’s two infringement theories includes a circuit board. EX2002, 8 (remaining theory with circuit board), 9 (disclaimed theory with no circuit board). In PO’s remaining theory, the LED and circuit board are on the same, horizontal portion of the accused fastener. EX2002, 16. The LED is not fastened to the other, vertical portion. *Id.* (showing dark air gap between LED and vertical portion). PO obscures the shape of the LED in some figures with annotations. *Id.*, 12. But figures without annotations show the LED clearly (*id.*, 9) as well as the air gap. *Id.*, 16.

Factor 5 weighs slightly in favor of institution because the Board will resolve these issues before, or contemporaneously with, the district court. Pet., 90-91. *See* IPR2020-00603, Paper 11, at 23 (PTAB Sept. 3, 2020).

Factor 6 weighs in favor of institution because in the litigation, under PO’s remaining theory, the alleged “fastener” does not fasten as claimed. *See* Factor 4.

Date: November 27, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that on November 27, 2024, a true and correct copy of the Petitioner's Reply was served by emailing a copy of same (by agreement) to the following attorneys for the Patent Owner:

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