

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.

Case No.: IPR2024-01130

Patent 7,168,842

**PATENT OWNER'S MOTION TO DISMISS FOR BOE'S
FAILURE TO DISCLOSE ALL REAL PARTIES IN INTEREST**

TABLE OF AUTHORITIES

Cases

<i>Corning Optical Communications RF, LLC v. PPC Broadband Inc.,</i> IPR2014-00440, Paper 68 (PTAB Aug. 18, 2015)	1, 3
<i>SharkNinja Operating LLC v. iRobot Corp.,</i> IPR2020-00734, Paper 11 (PTAB Oct. 6, 2020)	1, 3

Statutes

35 U.S.C. § 312(a)(2)	1
35 U.S.C. § 315(e)	3

PATENT OWNER'S UPDATED EXHIBIT LIST

Ex. No.	Description
2001	Docket Control Order from <i>Optronic Sciences LLC v. BOE Tech. Group Co., Ltd.</i> , No. 2:23-cv-00549-JRG, Dkt. 33 (E.D. Tex. Aug. 5, 2024).
2002	Optronic Sciences LLC's Infringement Contentions from <i>Optronic Sciences LLC v. BOE Tech. Group Co., Ltd.</i> , No. 2:23-cv-00549-JRG (E.D. Tex. July 19, 2024).
2003	BOE Technology Group Co., LTD's Invalidity Contentions from <i>Optronic Sciences LLC v. BOE Tech. Group Co., Ltd.</i> , No. 2:23-cv-00549-JRG (E.D. Tex. Oct. 25, 2024).
2004	Machine translation of JP2004-279262, retrieved from https://patents.google.com/patent/JP2004279262A/en?q=JP2004-279262 on October 26, 2024.
2005	Declaration of Benjamin T. Wang in Support of Motion to Appear <i>Pro Hac Vice</i>
2006	Declaration of Andrew D. Weiss in Support of Motion to Appear <i>Pro Hac Vice</i>
2007	Declaration of Christian W. Conkle in Support of Motion to Appear <i>Pro Hac Vice</i>
2008	Time to Trial for Rodney Gilstrap Report from Docket Navigator, accessed December 12, 2024.
2009	Declaration of Paul Kroeger in Support of Motion to Appear <i>Pro Hac Vice</i>
2010	<i>POS Solutions</i> , Cirque: Innovative Touch Solutions, available at https://web.archive.org/web/20131109010416/http://www.cirque.com/solutions/posSolutions.aspx (archived by the Wayback Machine on Nov. 9, 2013).
2011	Gu et al., <i>White LED Performance</i> , Lighting Research Center.
2012	Specifications for Nichia Chip Type White LED, NICHIA CORPORATION.
2013	Excerpts from <i>Optoelectronics Data Book</i> 1995-1996, SIEMENS.
2014	TONY KORDYBAN, HOT AIR RISES AND HEAT SINKS: EVERYTHING YOU KNOW ABOUT COOLING ELECTRONICS IS WRONG (1998).
2015	C.O. BENNET & J.E. MYERS, MOMENTUM, HEAT, AND MASS TRANSFER (3d ed. 1982).
2016	FRANK INCROPERA & DAVID DEWITT, FUNDAMENTALS OF HEAT AND MASS TRANSFER (4th ed. 1996).

2017	SHUNSUKE KOBAYASHI ET AL., LCD BACKLIGHTS (2009).
2018	ALLAN KRAUS & AVRAM BAR-COHEN, DESIGN AND ANALYSIS OF HEAT SINKS (4th ed. 1996).
2019	<i>Connect</i> , MERRIAM-WEBSTER, https://www.merriam-webster.com/dictionary/connect (last visited Apr. 21, 2025).
2020	Declaration of Dr. Eric Bretschneider in support of Patent Owner's Response ("Bretschneider Decl.")
2021	<i>Curriculum vitae</i> of Dr. Eric Bretschneider
2022	Deposition Transcript of Dr. Jacob Baker, <i>IPR2024-01130</i> , <i>IPR2024-01133</i> , <i>IPR2024-01134</i> , Volume 1.
2023	Deposition Transcript of Dr. Jacob Baker, <i>IPR2024-01130</i> , <i>IPR2024-01133</i> , <i>IPR2024-01134</i> , Volume 2.
2024	Deposition Transcript of Dr. Jacob Baker, <i>IPR2024-01130</i> .
2025	<i>Qualcomm Inc. v. Apple Inc.</i> , Nos. 2023-1208, 2023-1209 (Fed. Cir. 2025).
2026	Non-confidential excerpts of the Opening Expert Report of Dr. Baker Regarding Invalidity of U.S. Pat. No. 7,168,842 from <i>Optronic Sciences LLC, v. BOE Tech. Group Co., Ltd.</i> , No. 2:23-cv-00549 (W.D. Tex.)
2027	Markman Order from <i>Optronic Sciences LLC v. BOE Tech. Group Co., Ltd.</i> , No. 2:23-cv-00549-JRG, Dkt. 157 (E.D. Tex. Oct. 20, 2025).
2028	Patent Owner's Demonstrative for October 27, 2025 Oral Argument in IPR2024-01130.
2029	Director Squire's October 28, 2025 Memorandum.
2030	Highlighted Excerpts from "Entity List," <i>Export Administration Regulations</i> , BUREAU OF INDUSTRY AND SECURITY, available at https://www.bis.gov/regulations/ear/744#supplement-4-744 (last accessed Nov. 5, 2025).
2031	<i>Letter to U.S. International Trade Commission</i> , U.S. HOUSE OF REPRESENTATIVES SELECT COMMITTEE ON THE CHINESE PARTY (dated December 18, 2024).

2032	BOE Technology Ground Co., LTD. Annual Report 2024 (Summary).
2033	BOE Technology Ground Co., LTD. Annual Report 2024, available for download at https://www.boe.com/en/investorRelations/regularCompanyAnnouncements (last visited Nov. 6, 2025).
2034	<i>Primer on Important Amendments to the Chinese Company Law</i> , AMERICAN BAR ASSOCIATION, https://www.americanbar.org/groups/franchising/resources/franchise-lawyer/2024-winter/primer-important-amendments-chinese-company-law/ (published Aug. 23, 2024).
2035	<i>Actual controllers with foreign residency rights and corporate tax avoidance: Evidence from private listed companies in China</i> , EMERGING MARKETS REVIEW VOL. 26, available at https://www.sciencedirect.com/science/article/abs/pii/S1566014125001207 (last accessed Nov. 5, 2025).
2036	<i>Legal Representative vs. Actual Controller: Who Really Runs a Chinese Company?</i> , CNBIZINSIGHT, available at https://cnbizinsight.com/legal-representative-vs-actual-controller-who-really-runs-a-chinese-company/ (last accessed Nov. 5, 2025).
2037	<i>Yangtze Memory Tech. Co. Ltd. v. Micron Tech. Inc.</i> , IPR2025-00098, IPR2025-00099, Paper 33 (Nov. 10, 2025).

35 U.S.C. § 312(a)(2) permits considering a petition “only if” BOE discloses all real parties in interest (“RPIs”). Director Squires’s October 28, 2025 memo ordered that “the Office **will** now enforce § 312(a)(2)’s requirement.” Ex. 2029 at 4 (emphasis added). The memo designated *Corning Optical Communications RF, LLC v. PPC Broadband Inc.*, IPR2014-00440, Paper 68 (PTAB Aug. 18, 2015) as precedential and de-designated *SharkNinja Operating LLC v. iRobot Corp.*, IPR2020-00734, Paper 11 (PTAB Oct. 6, 2020).

BOE has failed to disclose all RPIs, including the People’s Republic of China. BOE is widely known as a state-backed foreign actor. BOE is on the Department of Commerce’s “entity list”—exactly the type of entity Director Squires warned has already “been deemed a national security threat” and is filing a “substantial and increasing number of IPRs.” Ex. 2029 at 2–3; Ex. 2030; Ex. 2037 at 2 (“Petitioner is listed on the Bureau of Industry and Security’s Entity List, which ‘identifies persons . . . reasonably believed to be involved, or to pose a significant risk of being or becoming involved, in activities contrary to the national security or foreign policy interests of the United States.’”).

The U.S. House of Representative’s *Select Committee on the Chinese Communist Party* issued a December 18, 2024 letter to the International Trade Commission (ITC) stating that “the [People’s Republic of China (“PRC”)] has groomed BOE as its national champion in the display industry” through “a variety

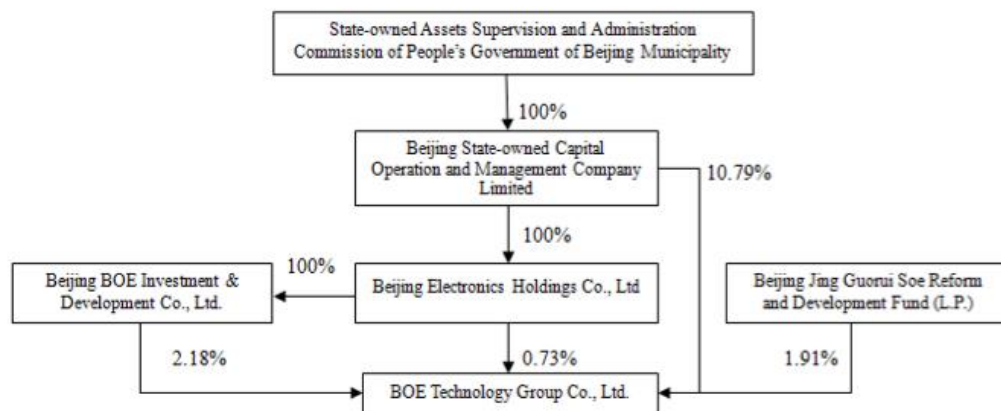
of PRC-backed anticompetitive practices, including aggressive state-sponsored subsidization, as well as intellectual property (IP) theft.” Ex. 2031 at 1. The House Committee’s letter concluded:

BOE’s IP theft will continue to benefit the PRC’s military-civil fusion strategy, and BOE’s growing dominance in the display industry will leave the United States overly reliant on the PRC for an advanced technology critical to military applications. Additionally, the Commission will be sending a dangerous message to the PRC that its companies can continue to steal American IP at will.

Id. at 2.

BOE’s annual report confirms that China/Beijing are the largest shareholder and the “Actual Controller” of the Petitioner:

(3) Ownership and Control Relations between the Actual Controller and the Company



Ex. 2032 at 5, 7; *see also* Ex. 2033 at 111–12 (“Nature of the actual controller: Local institution for state-owned assets management”); *see, e.g.*, Ex. 2034 at 6 (an “actual controller” is “a non-shareholder who can nevertheless control a company through

voting rights, investment relations, or by agreements”); Ex 2035 at 2 (“The actual controller refers to the natural person, legal person, or other organization that controls the company's behavior through investment relations, agreements, or other arrangements.”); Ex. 2036 (“The Actual Controller . . . is defined under Article 265 of the Company Law. This is the entity or individual who, while not necessarily holding a formal position or being publicly registered, exercises de facto dominant control.”).

Not only is Petitioner’s actual controller a foreign adversary, but Petitioner’s failure to include the PRC as a real party in interest prevents estoppel from attaching under 35 U.S.C. § 315(e). Petitioner’s Sotera stipulation does not remedy such prejudice, and other state-controlled companies would still be permitted to seek invalidation of the ’842 Patent. The Petition failed to disclose the PRC as a real-party in interest and because BOE is a state-backed actor with a known interest in weakening the American intellectual property system.

Patent Owner respectfully requests that the Director terminate this IPR under *Corning*, which instructs the Board to “grant Patent Owner’s Motions to Dismiss, vacate the Decisions on Institution, and do not issue final written decisions” when a new filing date cannot be granted with an amended RPI list. *Corning* at 25–26. The *SharkNinja* remedy of permitting BOE to simply amend its RPI listing is no longer good precedent. Ex. 2029 at 1 (de-designating *SharkNinja*).

Date: November 26, 2025

Respectfully submitted,

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CERTIFICATE OF PAGE LIMIT

I certify that there are less than 3 pages, as authorized by the Board in the Parties' November 20, 2025 hearing.

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))

The undersigned hereby certifies that the above document was served on November 26, 2025, by filing this document through the P-TACTS system as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioner:

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