

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.: IPR2024-01132

Patent 7,586,121

**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	Declaration of Benjamin T. Wang in Support of Motion to Appear <i>Pro Hac Vice</i>
2002	Declaration of Andrew D. Weiss in Support of Motion to Appear <i>Pro Hac Vice</i>
2003	Declaration of Christian W. Conkle in Support of Motion to Appear <i>Pro Hac Vice</i>
2004	Declaration of Paul A. Kroeger in Support of Motion to Appear <i>Pro Hac Vice</i>
2005	Declaration of Dr. Eric Bretschneider in support of Patent Owner's Response ("Bretschneider Decl.")
2006	<i>Curriculum vitae</i> of Dr. Eric Bretschneider
2007	April 17, 2025, Deposition Transcript of Dr. Dean Neikirk, <i>IPR2024-01132, IPR-2024-01315</i>
2008	Roel. J. Theeuwes, <i>Surface passivation approaches for silicon, germanium, and III-V semiconductors</i> , J. VAC. SCI. TECHNOL., A.42, 060801 (2024).
2009	Mark LaPedus, <i>Capping Tools Tame Electromigration</i> , Semiconductor Engineering (2012) (https://semiengineering.com/capping-tools-tame-electromigration) (Wayback Machine capture from June 20, 2014, available at https://web.archive.org/web/20140620152135/https://semiengineering.com/capping-tools-tame-electromigration , accessed May 6, 2025).
2010	Excerpts from WILEY ELECTRICAL AND ELECTRONICS ENGINEERING DICTIONARY (2004).
2011	Excerpts from William S. Rees, CVD OF NONMETALS (1996).
2012	Excerpts from MCGRAW-HILL DICTIONARY OF SCIENTIFIC AND TECHNICAL TERMS (5th Edition) (1994).
2013	<i>Passivation (chemistry)</i> , WIKIPEDIA, available at https://en.wikipedia.org/wiki/Passivation_(chemistry) (last accessed Sept. 15, 2025).
2014	Excerpt from <i>BOE Technology Group Co., Ltd.'s Fourth Supplemental Responses To Plaintiff's First Set Of Interrogatories (Nos. 1-13)</i>
2015	"Progress in Polymer Science," Liaw et al. (2012) [Resubmission of Ex. 1024].

2016	Response to BOE’s Motion for Summary Judgment in <i>Optronic Sciences LLC v. BOE Tech. Group Co., Ltd.</i> , No. 2:23-cv-00549-JRG, Dkt. 152 (E.D. Tex. Oct. 14, 2025).
2017	Pages from Petitioner’s Reply in IPR2025-00132, filed in <i>Optronic Sciences LLC v. BOE Tech. Group Co., Ltd.</i> , No. 2:23-cv-00549-JRG, Dkt. 152-3 (E.D. Tex. Oct. 14, 2025) (filed as MSJ “Exhibit F”).
2018	Deposition Transcript, Dr. Adam Fontecchio, September 30, 2025 (filed as MSJ “Exhibit H”).
2019	BOE_549_00015426, produced by BOE in <i>Optronic Sciences LLC v. BOE Tech. Group Co., Ltd.</i> , No. 2:23-cv-00549-JRG (filed as MSJ “Exhibit I”).
2020	“Advantage of ‘UPIA’” as obtained from UBA Corporation’s website https://www.ube.com/ube/en/contents/chemical/polyimide/upia/ on or about October 3, 2025 (filed as MSJ “Exhibit K”).
2021	BOE_549_00017305, produced by BOE in <i>Optronic Sciences LLC v. BOE Tech. Group Co., Ltd.</i> , No. 2:23-cv-00549-JRG (filed as MSJ “Exhibit L”).
2022	BOE_549_00006466, produced by BOE in <i>Optronic Sciences LLC v. BOE Tech. Group Co., Ltd.</i> , No. 2:23-cv-00549-JRG (filed as MSJ “Exhibit M”).
2023	Excerpts from the Rebuttal Report of Dr. Dean Neikirk regarding U.S. Patent Nos. 7,586,121 and 8,492,222, from <i>Optronic Sciences LLC v. BOE Tech. Group Co., Ltd.</i> , No. 2:23-cv-00549-JRG (filed as MSJ “Exhibit E”).
2024	Excerpts from Opening Expert Report of Dr. Dean Neikirk regarding U.S. Patent Nos. 7,586,121 and 8,492,222, from <i>Optronic Sciences LLC v. BOE Tech. Group Co., Ltd.</i> , No. 2:23-cv-00549-JRG (excerpted from filing in MSJ “Exhibit G”).
2025	Highlighted Excerpts from Dean Neikirk’s September 26, 2025, Deposition Transcript from <i>Optronic Sciences LLC v. BOE Tech. Group Co., Ltd.</i> , No. 2:23-cv-00549-JRG (filed as MSJ “Exhibit J”).
2026	Patent Owner’s Demonstrative
2027	Director Squire’s October 28, 2025 Memorandum.
2028	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).

2029	<i>Letter to U.S. International Trade Commission</i> , U.S. HOUSE OF REPRESENTATIVES SELECT COMMITTEE ON THE CHINESE PARTY (dated December 18, 2024).
2030	BOE Technology Ground Co., LTD. Annual Report 2024 (Summary).
2031	BOE Technology Ground Co., LTD. Annual Report 2024, available for download at https://www.boe.com/en/investorRelations/regularCompanyAnnouncements (last visited Nov. 6, 2025).
2032	<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).
2033	<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).
2034	<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).
2035	<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. 2027 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. 2027 at 2–3; Ex. 2028; Ex. 2035 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

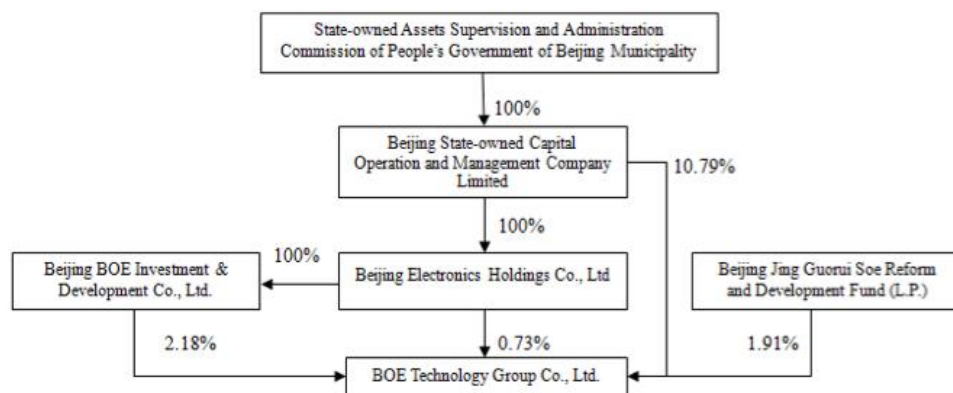
of PRC-backed anticompetitive practices, including aggressive state-sponsored subsidization, as well as intellectual property (IP) theft.” Ex. 2029 at 1. The House Committee’s letter concluded:

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 own annual report confirms that China/Beijing are the “Actual Controller” of the Petitioner:

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



Ex. 2030 at 7; *see also* Ex. 2031 at 111–12 (“Nature of the actual controller: Local institution for state-owned assets management”); *see, e.g.*, Ex. 2032 at 6 (an “actual controller” is “a non-shareholder who can nevertheless control a company through

voting rights, investment relations, or by agreements”); Ex 2033 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. 2034 (“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 ’121 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. 2027 at 1 (de-designating *SharkNinja*).

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Patent 7,586,121

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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