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Paper 21
Entered: April 14, 2025

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.

IPR2024-01130 (Patent 7,168,842 B2)
IPR2024-01131 (Patent 7,226,801 B2)
IPR2024-01132 (Patent 7,586,121 B2)
IPR2024-01133 (Patent 9,263,509 B2)
IPR2024-01134 (Patent 9,406,733 B2)
IPR2024-01315 (Patent 8,158,477 B2)[1]

Before THU A. DANG, BENJAMIN D. M. WOOD, and
ROBERT J. WEINSCHENK, *Administrative Patent Judges*.

PER CURIAM.

ORDER
Denying Patent Owner's Request for Authorization to File Motion for Reconsideration of Decision Granting Institution
37 C.F.R. § 42.5

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[1] The combined caption is for administrative convenience only and does not indicate a joined case or an expanded panel. The parties are not authorized to use this caption absent express permission of the Board.

BOE Technology Group Co., LTD. ("Petitioner") filed petitions requesting institution of *inter partes* reviews in IPR2024-01130, IPR2024-01131, IPR2024-01132, IPR2024-01133, IPR2024-01134, and IPR2024-01315. Paper 1 ("Petition" or "Pet.").[2] Optronic Sciences LLC ("Patent Owner") filed preliminary responses in each case. Paper 7 ("Preliminary Response" or "Prelim. Resp."). We instituted an *inter partes* review in all six cases. Paper 16 ("Institution Decision" or "Dec.").

In IPR2024-01132, IPR2024-01134, and IPR2024-01315, Patent Owner did not address discretionary denial in its Preliminary Response, and Patent Owner did not request additional briefing prior to the Institution Decision. In IPR2024-01130, IPR2024-01131, and IPR2024-01133, Patent Owner argued that we should exercise our discretion to deny institution based on a parallel District Court Litigation under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) ("*Fintiv*"). Prelim. Resp. 20–23. With authorization from the Board, Petitioner filed a Preliminary Reply (Paper 11, "Prelim. Reply") addressing discretionary denial under *Fintiv*, and Patent Owner filed a Preliminary Sur-reply (Paper 12, "Prelim. Sur-reply"). The Institution Decision addressed the parties' *Fintiv* arguments and declined to exercise discretion under § 314(a) to deny institution. Dec. 7–14.

[2] For convenience, all citations are to papers and exhibits entered in IPR2024-01130, unless otherwise indicated.

On February 28, 2025, the USPTO rescinded the June 21, 2022 memorandum entitled "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation" ("Interim Procedure"). On March 24, 2025, the Chief Administrative Patent Judge issued a memorandum providing guidance on the rescission of the Interim Procedure ("Chief Judge's Memorandum" or "C.J. Mem.).[3] The Chief Judge's Memorandum states that "[t]he Board will consider timely requests for additional briefing on the application of the Interim Procedure's [rescission] on a case-by-case basis," but "[a]bsent extraordinary circumstances, the Board will not revisit a decision on institution if the time for seeking Director Review or rehearing has passed." C.J. Mem. 2.

On March 26, 2025, the Acting Director of the USPTO issued a memorandum entitled "Interim Processes for PTAB Workload Management" ("Director's Memorandum" or "Dir. Mem.").[4] The Director's Memorandum sets forth interim processes that bifurcate decisions on whether to institute an *inter partes* review or a post-grant review "between (i) discretionary considerations and (ii) merits and other non-discretionary

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[3] The Chief Judge's Memorandum is available at https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf.

[4] The Director's Memorandum is available at https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf.

statutory considerations." Dir. Mem. 1. The Director's Memorandum states that "[t]he processes described herein will be implemented in IPR and PGR proceedings where the deadline for the patent owner to file a preliminary response *has not yet passed*." *Id.* at 3 (emphasis added).

On March 27, 2025, Patent Owner emailed the Board requesting "permission to file a motion for reconsideration of institution now that former Director Vidal's *Fintiv* guidance is rescinded and in light of Acting Director Stewart's March 26, 2025 Memorandum." Ex. 3001. In its email, Patent Owner indicates that it "believes that it meets the criteria for extraordinary circumstances" and proposes filing "a supplemental brief of no more than 7,000 words addressing the [rescission] of former Director Vidal's guidance and Acting Director Stewart's guidance within two weeks." *Id.* The email also indicates that "Petitioner opposes because the time for seeking Director Review of the institution decisions has passed and Patent Owner has not identified any 'extraordinary circumstances' as required by the March 24, 2025 guidance related to the [rescission]." *Id.*

On April 3, 2025, Judges Dang, Wood, and Weinschenk held a conference call with counsel for the parties. Brian Erickson appeared on behalf of Petitioner, and Benjamin T. Wang appeared on behalf of Patent Owner. This Order summarizes statements made during the call.

During the conference call, Patent Owner argued that extraordinary circumstances exist that warrant revisiting the Institution Decision even though the time for requesting rehearing or Director Review has passed.

Specifically, Patent Owner argued that *Fintiv*'s overall goal of achieving efficiency without duplicating efforts is not met here. Patent Owner argued that Petitioner has not filed petitions for *inter partes* review of three of the patents asserted in the District Court, meaning that the District Court will be required to address those patents. Patent Owner also argued that subsequent to the Institution Decision, Petitioner filed motions in the District Court to amend its invalidity contentions to add additional prior art not at issue in these cases. According to Patent Owner, Petitioner's motion admits that Petitioner performed tear-downs of physical products because documents alone were insufficient. Patent Owner further argued that Petitioner filed a motion for summary judgment in the District Court alleging that Patent Owner does not own the patents challenged in these cases. Patent Owner also asserted that Petitioner relies extensively on expert testimony in these cases and the challenged patents are old, with three of them expiring before the deadline for a final written decision.

In response, Petitioner pointed out that Patent Owner did not request discretionary denial in three of these cases and thus it is improper for Patent Owner to now request additional briefing in those cases. Petitioner also argued that the rescission of the Interim Guidance is immaterial because the Institution Decision declined to deny institution without relying on a *Sotera* stipulation or a compelling merits determination. Petitioner further argued that developments in the District Court subsequent to the Institution Decision are irrelevant because *Fintiv* only considers investment that occurs

by the time of the Institution Decision. Regarding Petitioner's motion to amend its invalidity contentions in the District Court, Petitioner asserted that those amendments are not relevant to the prior art references asserted in these cases. Concerning the disputed ownership of the challenged patents, Petitioner stated that its arguments in the District Court relate to an issue of standing to sue for infringement under certain license agreements and is not relevant to these *inter partes* reviews where Patent Owner is undisputedly the assignee.

We considered the parties' arguments, and we do not find extraordinary circumstances that justify revisiting the Institution Decision when the time for requesting rehearing or Director Review has passed. The Chief Judge's Memorandum states that following the rescission of the Interim Guidance, a "*Sotera* stipulation . . . is highly relevant, but will not be dispositive," and "compelling merits alone is not dispositive." C.J. Memo. 2–3. Here, the Institution Decision did not rely on a *Sotera* stipulation or a finding of compelling merits. Dec. 7–14. For that reason, the rescission of the Interim Guidance does not warrant revisiting the Institution Decision.

Further, the Director's Memorandum allows a Patent Owner to file discretionary denial briefing under the bifurcated processes "where the deadline for the patent owner to file a preliminary response has not yet passed" as of March 26, 2025. Dir. Mem. 3. Because the Preliminary Response deadline in these cases already passed on March 26, 2025, the

processes described in the Director's Memorandum do not apply. Thus, the Director's Memorandum does not warrant revisiting the Institution Decision.

Accordingly, it is ORDERED that Patent Owner's request for leave to file a motion for reconsideration of the Institution Decision is *denied*.

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