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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

IPR2024-01134
Patent 9,406,733 B2

Record of Oral Hearing
Held: October 27, 2025

Before THU A. DANG, BENJAMIN D. M. WOOD, and KEVIN W. CHERRY, *Administrative Patent Judges*.

APPEARANCES:

ON BEHALF OF THE PETITIONER:

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The above-entitled matter came on for hearing on October 27, 2025, commencing at 9:00 a.m., via video teleconference.

P R O C E E D I N G S

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JUDGE WOOD: Okay. We're back on the record then?

COURT REPORTER: We are.

JUDGE WOOD: Thank you. We are making a new record for IPR2024-01134. The parties are given the opportunity to discuss the means or the type of termination that we should do to this case. So Mr. Limbach, is five minutes sufficient?

MR. LIMBACH: More than enough.

JUDGE WOOD: Go ahead and take five minutes. And if you want to reserve some time for rebuttal, we can go through the rebuttal process that we've just done in the previous case.

MR. LIMBACH: Very good. So the issue here is in the '733 Patent of this IPR. The Patent Owner has disclaimed all the claims. So what is the appropriate procedure going forward here? The dispute between the parties is should there just be a termination or there should there be any determination -- termination with adverse judgment? And we believe that the -- it's appropriate for adverse judgment.

So 37 CFR 42.73(b) says that a disclaimer will be construed as a request for adverse judgment. There are certain legal implications that follow that, like estoppel, which is appropriate in this case. It's equitable for our case. We spent a lot of money filing that petition and fighting it through before they disclaimed. And so it's equitable that there be an adverse judgment. And to the extent that any estoppel should apply, that's fair. That's why the CFR is written the way that it is.

We've shown case law where this has happened. It even happened in a case where the disclaimer had a statement saying, we do not want -- we're not requesting adverse judgment. And the Board said, no, you can't do that. And they went ahead and terminated with an adverse judgment that went up to the Federal Circuit. The Federal Circuit said that would be appropriate. So in this particular case, it seems to be the appropriate outcome.

There's also some gray region, if this happens before or after institution. Obviously, Your Honors have more discretion before institution to maybe terminate without adverse judgment. This is after institution. This is after the proceedings had gone forward. And so with an instituted IPR, we believe that an adverse judgment is appropriate.

JUDGE CHERRY: And I just looked at -- it does look like -- is this the same situation in -- this is in IPR2024-1315 involving a U.S. Patent 8,158,477?

MR. LIMBACH: Same issue, same parties, same result should happen in both.

JUDGE CHERRY: Okay. Great.

MR. LIMBACH: That was the number that I was trying to conjure up, but I didn't have it on top of my head. So I appreciate that. Thank you, Your Honor.

JUDGE CHERRY: No problem.

MR. LIMBACH: Are there any other questions?

JUDGE CHERRY: No.

JUDGE WOOD: Did you -- I'm sorry, I apologize. I have one quick question. Did you provide the citation that you just mentioned in your

Petitioner reply?

MR. LIMBACH: We did.

JUDGE WOOD: Thank you.

MR. LIMBACH: Yeah. And the point that we want to make is, they waited until after institution. If they saw what they saw in the petition and thought, oh, we should terminate, they had the opportunity to do it before. They intentionally waited until after institution. So we believe that it's the appropriate remedy.

JUDGE WOOD: Thank you, Mr. Limbach.

MR. TONG: Your Honors, Peter Tong here on behalf of Patent Owner.

JUDGE WOOD: Thank you.

MR. TONG: So the Board should not find this patent invalid and enter adverse judgment as a matter of policy. We disclaimed this patent because there are many patents asserted in litigation. We dropped it as one of, you know, just general case streamlining to prevent them from doing unnecessary work, to prevent the Board from writing unnecessary final written decision.

We, the Patent Owners, should be incentivized to take these type of actions that make life easier for everyone as a matter of policy. The Board may enter adverse judgment, but it doesn't have to. There's nothing compelling the Board to do that, not even the case -- the Federal Circuit case that they were talking about. That just says, yes, the Board can, but it doesn't have to.

For example, in our brief, there's a case, Apple versus Zipit, where the Board didn't. And the issue here is really one of fairness, okay? There's

two issues, one is, does the Board want to encourage Patent Owners to do this to simplify the proceedings when it's appropriate? There's no purpose in having all of us waste our time.

Russ August & Kabat is representing another Patent Owner, Paneltouch, and another set of IPR proceedings against BOE. And for example, if the Board enters adverse judgment here and we may have wanted to -- in the event that we would want to disclaim a patent in those IPRs or in other co-pending IPRs, we are incentivized to fight it through the end, no matter what, to avoid adverse judgment even if we're no longer asserting the patent and litigation.

JUDGE CHERRY: Yes. Do you have continuations pending of either of these patents?

MR. TONG: No, Your Honor. And I will represent that. We are not going to seek any type of amendment in this IPR or another IPR to get the same types of claims. That's the fairness.

JUDGE CHERRY: But I guess, then why shouldn't we enter adverse judgment? And what -- what is the difference?

MR. TONG: Yes, Your Honor. I'm happy to address that on the head. We are worried that either they or some other Petitioner or defendant is going to argue that adverse judgments creates an unfair collateral estoppel or res judicata effect. They're going to say, okay, well the Board invalidated the '733 Patent. That must mean that the Board either adopted their claim construction about auxiliary electrodes from the '733 case or that certain prior art anticipates certain claim elements in the '733 case.

And that should be similarly applied to the '509 Patent where we are litigating on the merits. And that's unfair because traditionally for

estoppel or res judicata to apply, you need the identity of the patents, you need similar facts, you need a final judgment. And that was actually litigated on the merits. And that's the part that we don't have here in the '733 Patent case. There is no trial on the merits. It's just --

JUDGE CHERRY: But this is not a question for the -- for a subsequent panel applying collateral estoppel to address not -- - if -- for example, if there is a default judgment, that doesn't necessarily mean that there's collateral estoppel or res judicata effects, that's determined later in a subsequent proceeding. I'm not seeing -- yes, that's a possibility, but isn't that -- regardless of what we do, if you've disclaimed these claims, haven't you dedicated that subject matter to the public?

MR. TONG: And Your Honor, that is dedicating that subject matter to the public is the more efficient path. Terminating the IPR proceeding, that creates no unfair risk to Patent Owners. If the Board grants adverse judgment, it creates an unfair risk of collateral estoppel or res judicata, we are going to have to worry about it. And for that, we are going to be incentivized not to do this again, even if it would have otherwise been warranted.

If the Board has some way to, you know, say, okay, we grant adverse judgment, but it is purely procedural. And it -- this no collateral estoppel should apply, that might be a middle ground that the Board can consider taking. But we are really concerned about the unfair effect to the Patent Owner, to the '509 Patent even -- and we are promising not to seek claims that are -- amend claims, file new claims that get at this. So there's no risk to them if you just terminate the IPRs.

Any other questions, Your Honors?

JUDGE WOOD: I don't think so. Thank you, Mr. Tong. Okay. Do you have --

MR. LIMBACH: Four quick points --

JUDGE WOOD: All right.

MR. LIMBACH: -- if I could.

JUDGE WOOD: Yeah, two minutes max.

MR. LIMBACH: Not even that. The CFR doesn't have the word "may" in it. Yes, there's discretion. But I just want to say that's not explicit in the CFR that says it may be treated as a request. Second, for policy, they waited and rolled the dice on whether there was institution. So the policy actually would go the other way.

They saw exactly what the art was in the petition. Nothing changed with before and after institution. So the policy should be if you're going to roll the dice and force an institution decision, then there should be adverse judgment. No risk to us, they could file a reissue. Now, prosecution is wide open. They could file a reissue application tomorrow on this family. So there is risk.

And four, they talk about all this unfair estoppel. To your point, Your Honor, that's all speculation. And that shall be treated down -- if and when someone tries to apply estoppel, if it's unfair, it won't be granted. Thank you.

JUDGE WOOD: Thank you both again for your comments.

MR. TONG: May I say one thing, Your Honors?

JUDGE WOOD: Yeah, go ahead. I'm sorry.

MR. TONG: I promise to the Board we're not seeking a reissue on the same claims. Thank you.

JUDGE WOOD: All right. Thank you, Mr. Tong. Again, thank you both. And this hearing for 2024-1134 is adjourned.

(Whereupon, the above-entitled matter went off the record at 2:19 p.m.)

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