

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG DISPLAY CO., LTD.,
Petitioner,

v.

PICTIVA DISPLAYS INTERNATIONAL LTD.,
Patent Owner.

Case No. IPR2024-01222
Patent No. 6,949,389

**PETITIONER'S PRELIMINARY REPLY ADDRESSING
DISCRETIONARY DENIAL UNDER 35 U.S.C. § 314(a)**

Petitioner respectfully submits that discretionary denial is not warranted for this patent challenge. U.S. Patent No. 6,949,389 (the “’389 patent”) is now asserted against Samsung Electronics in two matters, *Pictiva Displays International Ltd. v. Samsung Elecs. Co., Ltd.*, Case No. 2:23-cv-00495 (E.D. Texas) (the “-495 matter”), and *Pictiva Displays International Ltd. et al., v. Samsung Elecs. Co., Ltd. et al.*, No. 2:24-cv-00532 (E.D. Texas) (“-532 matter”). Both cases remain in early stages.

Patent Owner argues for denial in view of the -495 matter, in which trial is currently scheduled for August 4, 2025. In IPR2024-00855, the Board found that *Fintiv* factor 3 favored institution, Paper 12, at 10, and the same still holds true. The lawsuit remains in an early stage, with limited discovery activity to date. While a Markman hearing is scheduled for February 4, 2025, as Patent Owner acknowledges, by the institution deadline expert discovery would not have yet begun.

Additionally, after Defendants filed a motion to dismiss the -495 matter due to the plaintiff’s lack of standing, Patent Owner joined with an entity named Key Patent Innovations Ltd. to file a replacement lawsuit on July 12, 2024 (the -532 matter). That replacement lawsuit is at an earlier stage than the -495 matter, with infringement contentions served on October 24, 2025, an initial scheduling conference held on November 7, 2025, and trial currently scheduled for May 4, 2026—*after* the deadline for a final written decision. Currently, both litigations are proceeding in parallel. Unless and until the -495 matter is dismissed, both case

schedules are operative. Petitioner also filed this IPR approximately five months after service of infringement contentions on March 11, 2024, in a case with six asserted patents, demonstrating that Petitioner acted with diligence.

With respect to *Fintiv* factor 4, Petitioner advises that Defendants will be providing a stipulation shortly in the parallel litigation to mitigate overlap between the proceedings. Additionally, Patent Owner would need to narrow the asserted claims in advance of any trial, such that a trial could not resolve all of Petitioner's claim challenges.

Patent Owner also argues that *Fintiv* factor 6 favors denial because "as in the case of IPR2024-00855, priority dispute and reasonable diligence are at issue.... Such issues are better dealt with in the district court." POPR at 68. This is incorrect.

First, this reasoning was expressly rejected in the January 10, 2025 Director Review decision in IPR2024-00855. As the decision explained "the Board's finding or suggestion that the district court 'may be better suited,' as a matter of course, than the Board for resolving a priority dispute does not consider the available PTAB procedures and tools, and is corrected here." IPR2024-00855, Paper 13, at 7.

Second, "a dispute about priority date requiring arguments under multiple prior art references" is one of the core scenarios in which the Trial Practice Guide "recognizes that more than one petition may be necessary." Consolidated Trial Practice Guide ("TPG") at 59. As set forth in Petitioner's Explanation of Parallel

Petitions, Petitioner understood that in parallel litigation involving the '389 patent, Patent Owner contended that the asserted claims were entitled to an earlier priority date. Paper 3 at 1. In light of the possibility that Patent Owner would similarly seek to antedate certain prior art in an IPR challenge, Petitioner filed two petitions. *Id.* The first petition, IPR2024-01222, asserts references that qualify as prior art under 35 U.S.C. § 102(a), (b), and/or (e). The second petition, IPR2024-01223, asserts references that all qualify as prior art under at least 35 U.S.C. § 102(b).

Patent Owner's preliminary response confirms that it plans to attempt to antedate at least some of the prior art in the first petition, though it appears to acknowledge that the disputed priority date would not extend to all of the claims challenged by the first petition, including claims 41-46. *See, e.g.*, POPR at 6 ("For example and as relevant to the claims at issue, the inventors conceived the concepts described in at least claims 34-37 and 40 by February 8, 2001); Pet. at 3 ("Ground II: Claims 41-46 are obvious over Yamazaki in view of AAPA/Ghosh and Fujimori."). Accordingly, even if Patent Owner were able to establish an earlier priority date for certain claims, at least Ground II of the first petition would still be applicable.

Finally, Patent Owner argues that "denying this petition under 314(a) works no prejudice to Petitioner," because the second petition is "at least as strong" but does not have the "extraneous issues associated with priority ... and 'printed

publication’ status.” POPR at 68.¹ This suggestion is contrary to the Board’s practice, which allows petitioners to provide the “ranking of the petitions in the order in which [they] wish[] the Board to consider the merits.” TPG at 60. Petitioner ranked the petition in this matter (IPR2024-01222) first, including because it asserts grounds based upon a single reference as to certain claims. *See, e.g.*, Pet. at 3 (listing grounds). Thus, Petitioner respectfully submits that it is proper for the Board to institute trial in both proceedings, but to the extent the Board is inclined to institute as to only a single proceeding, it would be appropriate to follow Petitioner’s election rather than Patent Owner’s contention.

Date: January 14, 2025

Respectfully submitted,

By /David A. Garr/

David A. Garr

Registration No.: 74,932

Scott C. Weidenfeller

Registration No.: 54,531

COVINGTON & BURLING LLP

One CityCenter, 850 Tenth Street, NW

Washington, DC 20001

¹ Patent Owner’s “printed publication” arguments (*see* POPR at 14–18) were rejected by the Federal Circuit’s opinion issued today in *Lynk Labs, Inc. v. Samsung Elecs. Co., Ltd.*, No. 2023-2346 (Fed. Cir. Jan. 14, 2025).

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, I hereby certify that the foregoing Petitioner's Preliminary Reply was served by electronic mail on the following counsel of record for patent owner:

hzhong@irell.com
PictivalPR@irell.com
rcarson@irell.com

Date: January 14, 2025

/David A. Garr/
David A. Garr (Reg. No. 74,932)