

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

CORRECTED PATENT OWNER'S PRELIMINARY SUR-REPLY

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Patent Trial and Appeal Board

U.S. Patent and Trademark Office

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EXHIBIT LIST

Exhibit No.	Document Description
EX2001	Declaration of Mr. Kurt Humphrey
EX2002	Declaration of Dr. E. Fred Schubert on behalf of Samsung Electronics Co., Ltd. et al. in <i>Pictiva Displays Int'l Ltd. v. Samsung Electronics Co. Ltd.</i> , et al., Case No. 2:23-cv-000495 (Nov. 12, 2024)
EX2003	Samsung's Notice of Corrected Exhibit B to Joint P.R. 4-3 Statement in <i>Pictiva Displays Int'l Ltd. v. Samsung Electronics Co. Ltd.</i> , et al., Case No. 2:23-cv-000495, Dkt. 110 & 110-1 (E.D. Tex. Nov. 13, 2024)
EX2004	Samsung's Proposed Claim Constructions for the Terms and Phrases Identified for Construction per Local Rule 4-2 in <i>Pictiva Displays Int'l Ltd. v. Samsung Electronics Co. Ltd.</i> , et al., Case No. 2:23-cv-000495 (E.D. Tex. Oct. 22, 2024)
EX2005	omitted
EX2006	389 Invention Disclosures
EX2007	U.S. Patent Application No. 2003/0054579A1 to Pakbaz et al.
EX2008	U.S. Patent Application No. 2003/0052616A1 to Antoniadis et al.
EX2009	U.S. Patent Application No. 2004/009304A1 to Pichler et al.
EX2010	U.S. Pat. No. 7,121,642 to Stoessel et al.
EX2011	U.S. Pat. No. 6,702,419 to Stoessel et al.
EX2012	Seog Soon Kim et al., <i>Ultra-high Precision Inkjet Printing Technology for Display</i> , 64-1 SID 2018 Digest, 839-842 (2018), available from https://sid.onlinelibrary.wiley.com/doi/abs/10.1002/sdtp.12244 (last visited Dec. 10, 2024)
EX2013	Lorentz Force downloaded from https://en.wikipedia.org/wiki/Lorentz_force (last visited Dec. 10, 2024)
EX2014	Docket Control Order in <i>Pictiva Displays Int'l Ltd. v. Samsung Electronics Co. Ltd.</i> , et al., Case No. 2:23-cv-000495, Dkt. 40 (E.D. Tex. Apr. 17, 2024)

Exhibit No.	Document Description
EX2015	Federal Court Management Statistics for U.S. District Courts, available from https://www.uscourts.gov/statistics/table/na/federal-court-management-statistics/2024/06/30-1
EX2016	Samsung Invalidity Contentions in <i>Pictiva Displays Int’l Ltd. v. Samsung Electronics Co. Ltd., et al.</i> , Case No. 2:23-cv-000495 (E.D. Tex. Jun. 11, 2024)
EX2017	Stephen J. Matthews, <i>Back to Basics: Organic LEDs</i> , Laser Focus World (Jul. 31, 2001), downloaded from https://www.laserfocusworld.com/lasers-sources/article/16556776/back-to-basics-organic-leds (last visited Dec. 10, 2024)
EX2018	Petitioner’s Stipulation (Jan. 17, 2025 Email from Baldoni)

The reply addresses only *Fintiv* factors 3, 4 and 6. *See* Reply. Notably, Samsung does not dispute that *Fintiv* factors 1, 2 and 5 favor discretionary denial or that it has not demonstrated compelling merits to warrant institution of trial. POPR 64-68; Reply 1-4.

Concerning whether to institute IPR2024-01222 in light of the IPR2024-01223 petition, Petitioner does not dispute that it took the position that the two petitions are of similar strengths. Paper 7 at 2.¹ The Trial Practice Guide does not provide that a priority dispute would warrant instituting trial on both petitions. As Patent Owner explained, if a petition that allegedly has no priority issue has allegedly the same strength as a petition with a priority issue, then the most efficient use of the Board's resources is to institute the one without the priority issue as this would best effectuate Congress's intent to use IPR as an alternative streamlined forum for priority. Petitioner's four-page reply offers no justification for instituting IPR2024-01222 when IPR2024-01223 is allegedly just as strong and

¹ Petitioner also mischaracterizes Patent Owner's statement regarding the relative strengths of the two petitions. Patent Owner took no position on that issue but observed that "*if*" the IPR2024-01223 petition is as strong as or stronger than the IPR2024-01222 petition, then there would be no reason to institute both. Paper 7 at 2-3.

the parties can focus solely on distinguishing the prior art in IPR2024-01223.

Petitioner relies heavily on the Board's analysis of *Fintiv* factor 3 in IPR2024-00855, but the parties have invested significant resources in the underlying litigation since that time. Claim construction briefing is complete and the *Markman* hearing is scheduled for February 4, 2025. Discovery has also advanced significantly: Pictiva will have conducted five fact witness depositions and one expert deposition by January 22, 2025 (four of them in person in Korea); it has conducted multiple days of in-person source code review; the parties have multiple discovery motions pending before the Court; and each party has served multiple subpoenas on third parties. Indeed, given that discovery is scheduled to close by March 10, 2025 and the opening expert reports are scheduled to be served on March 17, 2025, Pictiva expects that a lot more significant resources will be spent by the parties and the Court by March 11, 2025, the deadline for institution. EX2014, 3-4. Petitioner mentions that Defendants filed a motion to dismiss the - 495 matter, but fails to inform the Board that the district court already found "dismissal improper here" in granting Pictiva's motion to amend its complaint to add Key Patent Innovations Limited as a plaintiff. *Pictiva Displays Int'l Ltd. v. Samsung Elecs. Co.*, No. 2:23-cv-00495- JRG, Dkt. 128-1 (E.D. Tex. Dec. 11,

2024) (“the Order on Standing Issues”).² Petitioner also neglects to mention that Plaintiffs have requested that the district court consolidate the -495 and -532 “for all pre-trial and trial proceedings,” such that both cases would proceed on exactly the same schedule, with trial scheduled for August 4, 2025. -495 Matter, Dkt. 129 at 1.

As to *Fintiv* factor 4, Petitioner’s stipulation (EX2018) not to pursue an invalidity defense “based on the same grounds asserted in, or grounds involving any of the prior art asserted” in these proceedings does not alter the analysis. The Board routinely finds similar stipulations insufficient to avoid discretionary denial. *See, e.g., AT&T Services, Inc. et al v. ASUS Tech. Licensing Inc.*, IPR2024-00992, Paper 14, 12-13 (PTAB Dec. 16, 2024) (denying institution despite petitioner’s stipulation it would not raise grounds “based on the grounds or the primary prior art references asserted in that Petition”); *Samsung Elecs. Co., Ltd. v. Cal. Inst. of Tech.*, IPR2023- 00130, Paper 10 (PTAB May 4, 2023) (denying institution despite a stipulation characterized as “broader to some degree than the stipulation discussed in *Sand Revolution*”); *LG Elecs., Inc. v. Ancora Techs., Inc.*, No.

² Samsung filed a motion to dismiss the second amended complaint on January 2, 2025, which Pictiva expects the district court will deny. *See* -495 Matter, Dkt. 128-1, 10-11 (finding “dismissal improper here” in ruling on standing issues).

IPR2021-00581, Paper 16, 9-10 (PTAB June 10, 2021) (denying institution despite petitioner’s stipulation “it will not subsequently assert invalidity in the district court on the same grounds asserted in the IPR or on the basis of the Hellman reference, either alone or in combination with any other reference”). Petitioner’s speculation about the potential for claim narrowing in the litigation does not change the result either. The Board rejected this exact argument in denying institution in IPR2024-00855, and should do so again here. Paper 12, 10-11.

With respect to *Fintiv* factor 6, Petitioner’s reliance on the director review decision is misplaced. The decision affirmed the Board’s denial of institution, finding that “the above noted errors related to *Fintiv* Factor 6 do not alter the Board’s holistic determination of this case with regard to discretionary denial.” IPR2024-00855, Paper 13, at 8. Here, the litigation is at a far more advanced stage than in IPR2024-00855, and discretionary denial is even more appropriate. Petitioner does not identify any prejudice it would suffer if this petition was dismissed under 314(a). Defendants would be free to raise the same invalidity challenges in district court, and Petitioner does not refute that the second petition (IPR2024-01223) does not involve any priority dispute. *See* POPR, 68; Reply 3-4.

For reasons stated herein and on POPR 64-68, discretionary denial under 35 U.S.C. § 314(a) is appropriate.

Dated: January 22, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. section 42.6, that on January 22, 2025, a complete copy of the foregoing document **CORRECTED PATENT OWNER'S PRELIMINARY SUR-REPLY** were served by electronic mail, as agreed to by the parties, upon the following:

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