**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. IPR2024-01223
Patent No. 6,949,389

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# PETITIONER'S EXPLANATION OF PARALLEL PETITIONS CHALLENGING U.S. PATENT NO. 6,949,389

Petitioner Samsung Display Co., Ltd. ("Petitioner") submits this explanation for filing two petitions for *inter partes* review ("IPR") of U.S. Patent No. 6,949,389 (the "'389 patent").

As the Office's Trial Practice Guide recognizes, "there may be circumstances in which more than one petition may be necessary," including "when there is a dispute about priority date requiring arguments under multiple prior art references." Consolidated Trial Practice Guide ("TPG") at 59. This is such a circumstance.

The '389 patent was filed on May 2, 2002 and does not claim priority to any earlier application. However, in parallel litigation involving this patent, Petitioner's counsel understands Patent Owner has contended that the asserted claims of the '389 patent are entitled to a right of priority that may be as early as February 8, 2001.

In light of the possibility that Patent Owner may raise such an argument in an IPR challenge, Petitioner believes that two petitions are necessary to challenge the '389 patent, as explained below.

## I. EXPLANATION OF THE MATERIAL DIFFERENCES BETWEEN THE TWO PETITIONS

The petitions challenge the same claims, but over different prior art references, as summarized the following table. 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).

| Petition | Ground | Challenged Claims |
|---|---|---|
| IPR2024-01222 | I. Obvious over Yamazaki in view of the applicant admitted prior art ("AAPA") and/or Ghosh | 34, 35, 37, 40 |
| | II. Obvious over Yamazaki in AAPA/Ghosh and Fujimori | 41-46 |
| | III. Obvious over Weaver | 34, 40 |
| | IV. Obvious over Weaver in view of Palanisamy | 35, 36 |
| | V. Obvious over Weaver in view of Burrows | 37 |
| IPR2024-01223 | I. Obvious over Kijima in view of Suzuki | 34, 37, 40 |
| | II. Obvious over Kijima in view of Suzuki and Sturm | 35 |
| | III. Obvious over Kijima in view of Suzuki and Duthaler | 36 |
| | IV. Obvious over Kijima in view of Suzuki and Fujimori | 41-46 |

The Board should, consistent with previous Board decisions, institute both petitions here. Each petition involves different prior art references, and therefore presents materially different grounds for challenging the patent, even though both petitions challenge all claims of the '389 patent that Patent Owner has asserted against Petitioner in the district court litigation. *See SolarEdge Techs. Ltd. v. SMA Solar Tech. AG*, IPR2019-01224, Paper 10 at 10 (Jan. 23, 2020).

The first petition, IPR2024-01222, includes grounds based on the asserted prior art Yamazaki, Weaver, Palanisamy, and Burrows references, which are not asserted in the second petition. Petitioner expects that Patent Owner may challenge whether some of those references are prior art. This potential dispute has required Petitioner to make arguments under multiple priority scenarios. *See* TPG at 59. The second petition, IPR2024-01223 includes grounds based on the asserted Kijima, Suzuki, Sturm, and Duthaler references, which are not asserted in the first petition. Fujimori is included as a combination reference in both petitions.

Each of these references has particular strengths with respect to the claimed features and positions that Patent Owner may take during the proceeding, including as to priority. Accordingly, despite its best efforts to narrow the unpatentability issues presented to the Board, Petitioner had to separate the challenges into two petitions in order to ensure the grounds associated with each challenged claim within each petition contain the necessary specificity as to how the asserted prior art meets the recited limitations within the word limit applicable to IPR petitions.

## II. RANKING OF THE PETITIONS

Given the overlapping claims challenged in the petitions, the Board should institute both inter partes reviews because the burden to address the grounds raised in both petitions would not be substantially greater than that for just one petition. In addition, the Board and the parties can obtain efficiencies by holding a single

oral hearing and consolidating depositions between the proceedings. In accordance with the Board's direction that Petitioner should identify "a ranking of the petitions in the order in which it wishes the Board to consider the merits," however, Petitioner ranks IPR2024-01222 first. TPG at 60.

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Respectfully submitted,

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