

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

**PATENT OWNER'S RESPONSE TO PETITIONER'S NOTICE
REGARDING MULTIPLE PETITIONS**

Mail Stop "PATENT BOARD"
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

As the Board recognizes, “one petition should be sufficient to challenge the claims of a patent in most situations.” PTAB Consolidated Trial Practice Guide (“TPG”) (Nov. 2019) at 59. Petitioner suggests that its filing of a second petition is justified because “there is a dispute about priority date requiring arguments under multiple prior art references.” Paper 3 at 1. But Petitioner does not explain why the alleged dispute regarding priority date justifies its filing of the second petition.

Instead, Petitioner makes the boilerplate assertion that “despite its best efforts ..., 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.” Paper 3 at 3. What Petitioner fails to mention is that it has included two separate primary references in IPR2024-01222, Yamazaki and Weaver. *See* IPR2024-01222 Petition. Petitioner offers no justification for doing so. For example, it does not explain why it could not have included the Kijima ground instead of the Weaver ground in IPR2024-01222. Paper 3 at 3-4. In *Whatfix Inc. v. Walkme Ltd.*, IPR2023-01443, faced with a similar situation, the Board declined to institute both trials:

Petitioner does not persuasively explain in its Ranking why these arguments could not have been provided in a single petition. It is

difficult to reconcile Petitioner's arguments that two petitions were necessary when Petitioner has asserted three alternative challenges against nineteen of the challenged claims in the -01368 petition.

IPR2023-01443, Paper 11 at 13-14 (PTAB, March 20, 2024). The same is true here: Petitioner offers no reason for why it could not have filed a single petition that includes only the Kijima and Yamazaki (or Weaver) grounds. In other words, Petitioner offers no reason why it has to include both Yamazaki and Weaver in its first petition and all three of Yamazaki, Weaver and Kijima over two petitions.

Petitioner also does not specify the particular strengths with respect to each petition, stating instead generally and meaninglessly that “[e]ach 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.” Paper 3 at 2. This does not inform the Board or the Patent Owner why both petitions are needed and why IPR2024-01222 references would be preferred. For example, Petitioner does not assert that IPR2024-01223 references fail to disclose or render obvious certain limitations while IPR2024-01222 references do not suffer from the same deficiencies.

The fact that the Petitioner apparently views the second petition, which does not implicate priority issue, as having similar strength to the first petition counsels against instituting both trials. This is because, if the 102(b) references at issue in

IPR2024-01223 are as strong as or stronger than those at issue in IPR2024-01222, then regardless of whether a dispute over priority exists, there is no reason to institute a trial over IPR2024-01222 involving references that are weaker (or of equal strength) but have potential priority issues. Instead, to best utilize the Board's resources, to the extent a trial is warranted, the Board should institute the trial on the petition based on references having at least the same strength and no priority disputes, *i.e.*, the IPR2024-01223 petition.

Petitioner also makes the unsubstantiated and nonsensical assertion that “the burden to address the grounds raised in both petitions would not be substantially greater than that for just one petition.” Paper 3 at 3-4. That statement is demonstrably false. As Petitioner's own table summarizing the grounds in the two petitions shows, the two petitions involve completely different references with very different disclosures and therefore different analysis. Paper 3 at 2. There is little if any overlap between the two petitions. Moreover, as Petitioner concedes, one petition may involve priority issues while the other won't. Hence, instituting both petitions would “place a substantial and unnecessary burden on the Board the patent owner.” TPG at 59. It would also “raise fairness, timing and efficiency concerns.” *Id.* Consequently, to the extent that priority is an issue and should both petitions are sufficient for institution, the Board should simply institute IPR2024-01223 that permits a more streamlined proceeding.

Dated: December 11, 2024

Respectfully submitted,

By: / Hong Zhong /

H. Annita Zhong. (Reg. No. 66,530)

IRELL & MANELLA LLP

1800 Avenue of the Stars, Suite 900

Los Angeles, CA 90067

Tel: (310) 277-1010

Fax: (310) 203-7199

Email: hzhong@irell.com

CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. section 42.6, that on December 11, 2024, a complete copy of the foregoing document **PATENT OWNER'S RESPONSE TO PETITIONER'S NOTICE REGARDING MULTIPLE PETITIONS** was served by electronic mail, as agreed to by the parties, upon the following:

COVINGTON & BURLING LLP

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

dgarr@cov.com

Scott C. Weidenfeller (Reg. No. 54,531)

sweidenfeller@cov.com

SDC-Pictiva-IPR@cov.com

/Susan M. Langworthy/

Susan M. Langworthy