

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

Inter Partes Review No.: IPR2024-01315

**PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE TO
PETITION FOR INTER PARTES REVIEW OF U.S. PAT. NO. 8,158,477**

INDEX OF EXHIBITS

Exhibit No.	Description
1001	U.S. Patent No. 8,158,477 (477 Patent)
1002	Declaration of Dean Neikirk in Support of Petition for Inter Partes Review of U.S. Patent 8,158,477 (477 Patent)
1003	U.S. Patent No. 7,330,168 (“Anzai”)
1004	U.S. Patent No. 6,992,332 (“Yamazaki”)
1005	File History of U.S. Patent No. 8,158,477
1006	Polysilicon TFT Technology for Active Matrix OLED Display by Mark Stewart, et. al., (“Stewart”)
1007	U.S. Patent Publication No. 2003/0067266 (“Kim”)
1008	U.S. Patent Publication No. 2006/0208979 (“Fish”)
1009	PCT Publication No. WO 2003/71511 (“Choi”)
1010	U.S. Patent No. 6,476,419 (“Yasuda”)
1011	U.S. Patent Publication No. 2003/0117059 (“Koo”)
1012	U.S. Patent No. 6,610,997 (“Murade”)
1013	U.S. Patent No. 6,246,179 (“Yamada”)
1014	A Flexible Multilayer Resist System Using Low Temperature Plasma-Deposited Silicon Nitride by B.R. Soller et. Al., (“Soller”)
1015	Room Temperature Deposition of Silicon Nitride Films for Passivation of Organic Electroluminescence Device Using a Sputtering Type Electron Cyclotron Resonance Plasma by Dawei Gao, et. al. (“Gao”)
1016	U.S. Patent No. 7,948,170 (“Strakhilev”)
1017	Declaration of Zachary Loney in Support of Motion for Pro Hac Vice Admission
1018	Judgment, IPR2016-00917 (September 21, 2016)
1019	<i>Arthrex, Inc. v. Smith & Nephew, Inc.</i> , No. 17-1239 (Fed. Cir. 2018)

I. ALL ARGUMENTS FOR PATENTABILITY HAVE BEEN WAIVED

Patent Owner's Response (Paper 26, "POR") contains no arguments for patentability. Therefore, it should be deemed that Patent Owner has waived any and all arguments for patentability.

II. ADVERSE JUDGMENT SHOULD BE ENTERED

Patent Owner filed a disclaimer in the U.S. Patent and Trademark Office, disclaiming all challenged claims (claims 1 and 3) of U.S. Patent No. 8,158,477 ("477 patent"). EX2005, 5. In its response, Patent Owner merely submitted that this IPR is now moot in view of the disclaimer, and requested this proceeding be terminated. POR, at 1.

Petitioner respectfully submits that mere termination is improper, that an adverse judgment should be entered against Patent Owner under 37 C.F.R. § 42.73(b).

37 C.F.R. § 42.73(b) states:

(b) Request for adverse judgment. A party may request judgment against itself at any time during a proceeding. **Actions construed to be a request for adverse judgment include:**

- (1) Disclaimer of the involved application or patent;
 - (2) Cancellation or **disclaimer of a claim such that the party has no remaining claim in the trial;**
 - (3) Concession of unpatentability or derivation of the contested subject matter; and
 - (4) Abandonment of the contest.
- (emphasis added)

Petitioner respectfully submits that Patent Owner's disclaimer of all challenged claims of the patent (EX2005, 5) should be construed as a request for adverse judgment, and the Board order that judgment be entered against Patent Owner under 37 C.F.R. § 42.73(b) concurrent with ordering that this proceeding be terminated. Any request by the Patent Owner that this proceeding be terminated without an adverse judgment should be rejected for the following reasons.

First, treating Patent Owner's disclaimer as a request for adverse judgment is consistent with the text of Rule 42.73(b), which provides a non-limiting set of actions to be construed as a request for adverse judgment. One of those actions is a disclaimer of all challenged claims, which Patent Owner has filed. EX2005, 5.

Second, Petitioner is entitled to the estoppel provided by an adverse judgment, where "[a] patent applicant or owner is precluded from taking action inconsistent with the adverse judgment, including obtain in any patent: (i) A claim that is not patentably distinct from a finally refused or cancelled claim." 37 C.F.R. § 42.73(d)(3). Patent Owner's request for termination without adverse judgment would avoid the estoppel provision of Rule 42.73(d)(3), which could prejudice Petitioner. Without any estoppel, Patent Owner could file for a Reissue of the 477 patent and obtain claims patentably indistinct from the disclaimed claims. For example, the 477 patent is a divisional of U.S. Pat. No. 7,586,121 (EX1001, cover page), which is the subject of a concurrent IPR proceeding (2024-01132), and the

estoppel would prevent Patent Owner from taking actions in that IPR proceeding inconsistent with the adverse judgment.

Third, equities favor treating Patent Owner's disclaimer as a request for adverse judgment. Petitioner has incurred significant cost and effort in defending against the patent infringement action in the concurrent district court case for the 477 patent before Patent Owner dismissed the 477 patent from that litigation in view of its disclaimer. Petitioner has also incurred significant cost and effort in searching for prior art, preparing the Petition and supporting declaration, and submitting the IPR filing fees. Patent Owner should not be able to avoid the resolution of the issues presented in the Petition simply by disclaiming the patent without prejudice to Patent Owner's ability to later pursue patentably indistinct claims or inconsistent positions in the concurrent IPR of the 121 patent.

Precedent confirms Petitioner's request should be granted. In IPR2016-00917, the Patent Owner there filed a disclaimer of all challenged claims along with a Preliminary Response that stated "[b]y filing the statutory disclaimer, [Patent Owner] is not requesting an adverse judgment." EX1018, at 2. The Board held that its rules permit it to construe a statutory disclaimer of all challenged claims as a request for adverse judgment, even when the disclaimer occurs before the Board has entered a decision on institution and when the Patent Owner submitted it was not requesting an adverse judgment. *Id.*, 6. The Board found

treating the disclaimer as a request for adverse judgment is in keeping with “the policies of finality and repose embodied in the doctrines of res judicata and collateral estoppel.” *Id.*, 8 (citing *In re Deckler*, 977 F.2d 1449, 1452 (Fed. Cir. 1992)). The Board held entering adverse judgment is also a more equitable result in the circumstances of the case (petitioner expending considerable resources to challenge the claims), finding it would be unfair if Patent Owner were able to avoid Petitioner’s challenge through a statutory disclaimer and then pursue patentably indistinct claims. *Id.*, 8-9. Despite Patent Owner’s statement it was not requesting adverse judgment, the Board ordered the adverse judgment be entered. *Id.*, 9.

The Patent Owner in IPR2016-00917 appealed the adverse judgment decision to the Federal Circuit, which affirmed the Board’s entry of adverse judgment. EX1019, 9 (*Arthrex, Inc. v. Smith & Nephew, Inc.*, No. 17-1239 (Fed. Cir. 2018)). The Court rejected Patent Owner’s argument that its statement that it was not requesting an adverse judgment could avoid the Board’s authority articulated in 37 C.F.R. § 42.73(b), and held this section permits the Board to enter an adverse judgment when a patent owner cancels all claims at issue, even before an institution decision. *Id.*, 7, 9.

The fact that Patent Owner in the present proceeding filed its disclaimer after institution weighs even more favorably in entering adverse judgment here.

Petitioner respectfully requests that the Board order that judgment be entered against Patent Owner under 37 C.F.R. § 42.73(b) and that this proceeding be terminated.

Respectfully submitted,

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), Petitioner certifies that this Reply includes 937 words, as measured by Microsoft Word, exclusive of the table of contents, mandatory notices under § 42.8, certificates of service, word count, claim listing, and exhibits.

Date: August 11, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies pursuant to 37 C.F.R. §§ 42.6(e) and 42.105 that on August 11, 2025, a true and correct copy of the Reply to Patent Owner's Response was served by emailing a copy of same (by agreement) to the following attorneys for the Patent Owner:

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