

From: [Trials](#)
To: [Johnson, Jeffrey](#); [Phenix WBD Service](#); [DL Innolux IPR](#); [Miller, Rodney](#); [Marino, Fabio](#); [Wright, John](#); [eldwin.hseu@wbd-us.com](#)
Cc: [Trials](#)
Subject: RE: IPR2025-00043; -00044; Authorization to File Petitioner's Reply to POPR
Date: Wednesday, March 19, 2025 9:12:11 AM

Counsel,

In connection with IPR2024-00043

Petitioner is authorized to file a Reply of no more than 7 pages that is limited to responding to the following issues addressed in Patent Owner's Preliminary Response:

- (i) under § 314(d) regarding the *Fintiv* factors;
- (ii) concerning the priority date of U.S. Patent 7, 233,305; and
- (iii) concerning *Nakata* and *Yamazaki* references as cumulative with references already reviewed in by the USPTO.

Petitioner's Reply will be due 2 weeks from the date of this email.

Patent Owner is authorized to file a Sur-reply to Petitioner's Reply of no more than 7 pages within 2 weeks of the filing of the Reply and limited to issues discussed in the Reply.

Neither Petitioner nor Patent Owner may introduce new evidence in their Reply or Sur-reply.

In connection with IPR2024-00044

Petitioner is authorized to file a Reply of no more than 7 pages that is limited to responding to the following issues addressed in Patent Owner's Preliminary Response:

- (i) under § 314(d) regarding the *Fintiv* factors;
- (ii) alleged Violation of Rule 104(b)(3); and
- (iii) concerning *Greene* and *DaCosta* references as cumulative with references already reviewed in by the USPTO.

Petitioner's Reply will be due 2 weeks from the date of this email.

Patent Owner is authorized to file a Sur-reply to Petitioner's Reply of no more than 7 pages within 2 weeks of the filing of the Reply and limited to issues discussed in the Reply.

Neither Petitioner nor Patent Owner may introduce new evidence in their Reply or Sur-reply.

Regards,

Tina Williams
Supervisory Paralegal Specialist
Patent Trial and Appeal Board

From: Johnson, Jeffrey <jeffrey.johnson@bakerbotts.com>

Sent: Tuesday, March 18, 2025 1:29 PM

To: Trials <Trials@USPTO.GOV>

Cc: Phenix WBD Service <phenixwbdservice@wbd-us.com>; DL Innolux IPR <dlinnoluxipr@BakerBotts.com>; Miller, Rodney <rodney.miller@wbd-us.com>; Marino, Fabio <Fabio.Marino@wbd-us.com>; Wright, John <John.Wright@wbd-us.com>; eldwin.hseu@wbd-us.com

Subject: IPR2025-00043; -00044; Authorization to File Petitioner's Reply to POPR

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Dear Board,

Petitioner in the above-captioned petitions respectfully requests authorization to file replies to Patent Owner's Preliminary Responses in both petitions to address the following issues:

In Both Petitions

- § 314(d) – Fintiv Factors: To address Patent Owner's arguments under § 314(d) regarding the *Fintiv* factors. Good cause exists for this reply because, between the filing of the Petition and the Patent Owner's Preliminary Response, on February 28, 2025, the USPTO rescinded the *Interim Procedure for Discretionary Denials* ("Interim Procedure"). Petitioner seeks leave to file a reply to address the *Fintiv* factors under the framework now being applied by the Board. Specifically, Petitioner aims to address the potential change in standard under *Fintiv* factors 2 (relating to trial dates) and 4 (relating to the effect of stipulations), which it could not have known about when the Petition was filed.

In IPR2024-00043 (regarding U.S. Patent 7,233,305 ('305 Patent))

- Priority Date of the '305 Patent & *Nakata*: To address Patent Owner's arguments that the '305 Patent is entitled to its alleged priority date, even though the Provisional Application to which it claims priority describes an entirely different invention. Good cause exists to reply on this issue because Patent Owner unexpectedly argued that the USPTO committed a clerical error and submitted evidence it alleges supports this claim. However, the USPTO's own records demonstrate that there was no clerical error on the part of the USPTO, and that Patent Owner failed to file a Provisional Application that supports the claims under § 112. Now in possession of Patent Owner's argument, Petitioner has located the allegedly "switched" application as U.S. Provisional 60/480,987, which was filed almost *three weeks* after the purported priority date by the same law firm, and does not contain the specification allegedly filed on the alleged priority date of the '305 Patent. This issue is relevant to the Petition because it will determine the priority date of the '305 Patent, and whether the *Nakata* reference is prior

art.

- Alleged Cumulative Prior Art: To address Patent Owner's arguments that the *Nakata* and *Yamazaki* references are cumulative with references already reviewed in by the USPTO. Good cause exists because neither reference was of record in the '305 Patent, and Petitioner could not have anticipated Patent Owner's arguments that they were allegedly cumulative with art already of record.

In IPR2024-00044 (regarding U.S. Patent 7,557,788 ('788 Patent))

- Alleged Violation of Rule 104(b)(3): To address Patent Owner's arguments that the petition is allegedly improper for failing provide an analysis as to why the term "means for executing a predetermined algorithm" does not invoke § 112(f). Good cause exists because Petitioner could not have anticipated Patent Owner's argument that a Petition may be denied institution under the Trial Practice Guide for this reason, given Petitioner's position that this term carries its plain and ordinary meaning. Neither party has argued that the term "means for executing a predetermined algorithm" invokes 35 U.S.C. 112(f), nor does 37 C.F.R. 42.104(b)(3) require presenting such a construction where both parties rely on a plain and ordinary meaning for a term.
- Alleged Cumulative Prior Art: To address Patent Owner's arguments that the *Greene* and *DaCosta* references are cumulative with references already reviewed by the USPTO. Good cause exists because neither reference was of record in the '305 Patent, and Petitioner could not have anticipated Patent Owner's arguments that they were allegedly cumulative with art already of record.

Petitioner requests 7 pages for each Reply with a due date of April 4, 2025 for both.

Patent Owner opposes Petitioner's request for leave to file a reply to a preliminary response because Petitioner has failed to establish good cause.

§ 314(d) – Fintiv Factors – Both Petitions

Neither Petitioner nor Patent Owner relied on the USPTO's *Interim Procedure for Discretionary Denials* in prior briefing. Instead, the Petition does not fully address the six *Fintiv* factors and improperly sought to reserve the right to reply to Patent Owner's 314(d) arguments in a reply prior to institution. But since Patent Owner's 314(d) argument did not rely on the rescinded Interim Procedure, Petitioner cannot establish good cause to file a reply.

Alleged Cumulative Prior Art – Both Petitions

Patent Owner's 325(d) argument was foreseeable because the Petition concerning the 788 patent relies, at least in part, on prior art references applied during examination and the Petition concerning the 305 patent relies, at least in part, on prior art references applied during

the prior Wistron IPR. More importantly, Petitioner acknowledges these references in the Petitions and addresses 325(d) in both Petitions. Allowing Petitioner to revise or better develop its 325(d) argument to address Patent Owner's reasonably foreseeable arguments does not warrant good cause.

Priority Date of the '305 Patent & Nakata in IPR2024-00043 Petition

Petitioner was on notice of the correct date of invention (which precedes *Nakata*) and in possession of the evidence cited by Patent Owner prior to filing the Petition. In particular, Patent Owner's Disclosures of Asserted Claims and Infringement Contentions was served on August 12, 2024 stated and put Petitioner on notice that contemporaneous documentation supported Patent Owner's claim of priority and included the evidence submitted in support of Patent Owner's priority invention date. *Compare* Exhibit 2003 and Phenix_Innolux_000004-10; *compare* Exhibit 2004 and Phenix_Innolux_0000026-30. Moreover, the fact that a clerical error was committed by the USPTO does not change the fact that Petitioner was on notice of the correct invention date prior to filing the Petition, yet chose not to address it in the Petition.

Violation of Rule 104(b)(3) in IPR2024-00044 Petition

According to the Rule, the Petition **must** identify "the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function" "[w]here the claim to be construed contains a means-plus-function." Given this clear reading of requirement of the "Contents of the Petition," it is reasonably foreseeable for Patent Owner to make its argument.

If Petitioner's request for 7-page reply is authorized by the Board, Patent Owner requests authorization for a preliminary sur-reply of equal length within one week of the filing of the preliminary reply and limited to the issues discussed in the preliminary reply.

The parties are available at the following dates and times for a conference call:

Wednesday, March 19 from 2-3:30 pm ET

Thursday, March 20 from 12-2 pm ET

Kind regards,
Jeffrey

Jeffrey L. Johnson

Partner

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