

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAMSUNG ELECTRONICS CO., LTD., AND  
SAMSUNG ELECTRONICS AMERICA, INC.,  
Petitioner

v.

SINOTECHNIX LLC,  
Patent Owner

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Case IPR2025-00336

U.S. Patent No. 7,901,113

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**PATENT OWNER’S DISCRETIONARY DENIAL BRIEF<sup>1</sup>**

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<sup>1</sup> Under Director Stewart’s March 26, 2025 memorandum entitled “Interim Processes for PTAB Workload Management”

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| Ex. 2005 | Excerpts of Petitioner's Amended Invalidity Contentions served in <i>Sinotechnix LLC v. Samsung Electronics Co., Ltd., et al.</i> , 2:24-cv-544-JRG (E.D. Tex. Jul. 17, 2024) (highlighting added) |
| Ex. 2006 | Petitioner's Subpoena to Lumileds, LLC dated February 5, 2025 (trimmed)                                                                                                                            |
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Pursuant to the memorandum regarding the “Interim Processes for PTAB Workload Management” issued on March 26, 2025 by Director Coke Morgan Stewart of the United States Patent and Trademark Office (“Memorandum”),<sup>2</sup> Patent Owner Sinotechnix LLC submits this request for the Director to exercise her discretion to deny institution of this *inter partes* review proceeding under 35 U.S.C. §§ 314(a) and/or 325(d).

## **I. INTRODUCTION**

In light of the United States Patent and Trademark Office (the “Office”) rescinding the June 21, 2022 memorandum entitled “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” on February 28, 2025,<sup>3</sup> the Director should deny institution pursuant to 35 U.S.C. § 314 in view of the district court trial between the Patent Owner and the

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<sup>2</sup> Director Stewart’s March 26, 2025 Memorandum Entitled “Interim Processes for PTAB Workload Management,” at

<https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf>.

<sup>3</sup> USPTO’s February 28, 2025 News Brief Entitled “USPTO rescinds memorandum addressing discretionary denial procedures,” at

<https://www.uspto.gov/about-us/news-updates/uspto-rescinds-memorandum-addressing-discretionary-denial-procedures>.

Petitioner<sup>4</sup> with respect to the validity of this patent that will commence on May 4, 2026—over four months *before* the expected date of the Board’s final decision. If instituted, the Board will have to expend substantial resources to decide issues that will have already been addressed and decided by the district court.

Additionally, the Director should deny institution under 35 U.S.C. § 325 because the challenged patent claims were thoroughly examined during a prosecution in which the Office considered two of the four prior art references the Petition presents.

## **II. THE ’113 PATENT IS THE SUBJECT OF DISTRICT COURT LITIGATION SET FOR TRIAL IN LESS THAN A YEAR**

Patent Owner and Petitioner are parties to district court litigation involving U.S. Patent No. 7,901,113 (the “’113 Patent”) (hereinafter, the “Litigation”)<sup>5</sup>, which has been pending since July 2024.

On July 17, 2024, Patent Owner filed its Original Complaint against Petitioner for infringement of the ’113 Patent in the United States District Court for the Eastern District of Texas. Litigation, Dkt. No. 1, Complaint (*see* Litigation Docket Report, Ex. 2001 at 9). The Court held a scheduling conference on November 7, 2024, where it set a trial date of May 4, 2026. Litigation, Dkt. No. 40,

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<sup>4</sup> Petitioners Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. will be referred to herein as a singular Petitioner.

<sup>5</sup> *Sinotechnix LLC v. Samsung Electronics Co., Ltd., et al.*, 2:24-cv-544-JRG (E.D. Tex. Jul. 17, 2024).

Docket Control Order, Ex. 1010; *Id.*, Dkt. No. 48, Amended Docket Control Order (“DCO”), Ex. 2002.

Fact discovery commenced on December 9, 2024. *Id.*, Dkt. No. 48, DCO, Ex. 2002 at 5. To date, the parties have undertaken substantial discovery. Initial and additional disclosures have been exchanged; six depositions have been conducted; voluminous amounts of documents have been produced; numerous interrogatories, requests for production, and requests for admission have been exchanged and answered; and a total of twenty third-party subpoenas have been issued. *See* Kennedy Declaration, Ex. 2016; Subpoena Notices, Ex. 2008.

In addition to their extensive discovery activities, the parties have also undertaken substantial motion practice. Petitioner has filed a Motion to Transfer Venue (Dkt. No. 53), a Partial Motion to Dismiss (Dkt. No. 55), and a Motion to Strike Certain Products from the Infringement Contentions (Dkt. Nos. 65, 68). *See* Litigation Docket Report, Ex. 2001 at 13-15. Patent Owner has filed a Motion to Compel Discovery (Dkt. Nos. 70, 76), and a Motion to Compel Site Inspections (Dkt. Nos. 91, 93). *Id.* at 15-18. The Court heard oral arguments from the parties regarding motions at two different hearings on March 10, 2025 (Dkt. Nos. 102), and March 15, 2025 (Dkt. No. 120). *Id.* at 18, 21. Petitioner filed a Motion to Stay the Litigation on April 18, 2025 (Dkt. Nos. 119, 121). *Id.* at 21. Patent Owner filed its Response in Opposition to Petitioner’s Motion to Stay on April 25, 2025 (Dkt. No. 125). *Id.* The Court has not yet ruled on Petitioner’s Motion to Stay; however, it is the Court’s “universal practice” “to deny a motion to stay when the Board has

not yet acted on the IPR petition(s).” *Arbor Global Strategies v. Samsung Elecs. Co.*, No. 2:19-cv-333-JRG-RSP, 2021 U.S. Dist. LEXIS 2434, at \*7 (E.D. Tex. Jan. 7, 2021).

### **III. THE DIRECTOR SHOULD EXERCISE HER DISCRETION TO DENY INSTITUTION UNDER 35 U.S.C. § 314**

Trial between Petitioner and Patent Owner in the Litigation is scheduled for May 4, 2026, which is over four months before the expected date of the Board’s final written decision. DCO, Ex. 2002 at 1. As explained in detail below, in view of precedential guidance, this is precisely the circumstance in which the Director should deny institution of this proceeding.

Under Section 314(a), the Director “is permitted, but never compelled, to institute an IPR proceeding.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016); *see also* 35 U.S.C. § 314(a). The Director may exercise her discretion under § 314(a) to deny institution of an *inter partes* review when the parties have a parallel district court proceeding scheduled to finish before the Board’s deadline to issue a final written decision in an instituted proceeding. *See, e.g., Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 3 (PTAB Mar. 20, 2020) (“*Fintiv*”) (precedential, designated May 5, 2020); *NHK Spring Co. v. Intriplex Techs. Inc.*, IPR2018-00752, Paper 8 (“*NHK Spring*”) (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019); *Intel Corp. v. VLSI Tech. LLC*, IPR2019-01192, Paper 15 at 11 (PTAB Jan. 9, 2020) (“When considering the impact of

parallel litigation in a decision to institute, the Board seeks, among other things, to minimize the duplication of work by two tribunals to resolve the same issue.”).

The Director frequently evaluates the following six factors in determining whether “to deny institution in view of an earlier trial date in the parallel proceeding”:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

*Fintiv*, Paper 11 at 5-6. However, these considerations are not exclusive. *See* Memorandum at 2-3 (explaining the Director may evaluate other considerations). As discussed below, the relevant factors weigh heavily in favor of denying institution in view of the parallel Litigation. *See Fintiv*, Paper 11 at 6 (“in

evaluating the factors, the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.”).

**A. *Fintiv* Factor 1: A Stay Does Not Exist and Is Not Likely to be Granted**

This factor weighs against institution because the Court has not stayed the Litigation and it is not likely to be stayed in the future.

Petitioner recently filed a motion to stay the Litigation, but the Court’s established practice is to deny motions to stay filed before institution of *inter partes* review. *See Arbor Global Strategies v. Samsung Elecs. Co.*, No. 2:19-CV-333-JRG-RSP, 2021 U.S. Dist. LEXIS 2434, at \*7 (E.D. Tex. Jan. 7, 2021) (“The ‘universal practice’ in this District, as well as the practice of most district courts, is to deny a motion to stay when the Board has not yet acted on the IPR petition(s).”); *Polaris Power Techs. v. Samsung Elecs. Co.*, No. 2:22-CV-469-JRG, 2023 U.S. Dist. LEXIS 246491, at \*4-5 (E.D. Tex. Aug. 18, 2023) (“[T]his Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings.”); *Viavi Sols. Inc. v. Zhejiang Crystal-Optech Co Ltd.*, No. 2:21-CV-00378-JRG, 2022 U.S. Dist. LEXIS 205106, at \*15 (E.D. Tex. Nov. 10, 2022) (denying stay pending *inter partes* review because “[i]t is the Court’s established practice to consider that motions to stay pending IPR proceedings which have not been instituted are inherently premature and should be denied as such.”); *Trover Grp., Inc. v. Dedicated Micros USA*, No. 2:13-CV-1047-WCB, 2015 U.S. Dist. LEXIS 29572, at \*17 (E.D. Tex. Mar. 11, 2015) (“In this district,

that is not just the majority rule; it is the universal practice. This Court’s survey of cases from the Eastern District of Texas shows that when the PTAB has not yet acted on a petition for inter partes review, the courts have uniformly denied motions for a stay.”).

Even if Petitioner renews its motion to stay post-institution, the District Court is unlikely to stay the case. Here, as discussed above, the district court trial is scheduled to begin more than four months before a final written decision is expected if *inter partes* review is instituted. Judge Gilstrap (the judge presiding over the Litigation) routinely denies motions to stay district court litigation pending IPRs when the district court trial is scheduled before the Board’s final decision. *See, e.g., MyPort, Inc. v. Samsung Elecs. Co., Ltd.*, Case No. 2:22-cv-00114-JRG, Order, Dkt. 73 (E.D. Tex. June 13, 2023), Ex. 2003 at 4-5 (denying a motion to stay when trial was scheduled and “the PTAB [final written] decision is not due until over two months after jury trial is set to begin”); *Solas OLED Ltd. v. Samsung Display Co., Ltd.*, Case No. 2:19-CV-00152-JRG, 2020 U.S. Dist. LEXIS 125973 (E.D. Tex. July 17, 2020) (denying a motion to stay partly because the Board’s final written decision would have been issued months after the scheduled trial); *General Access Solutions, Ltd. v. Cellco Partnership*, Case No. 2:22-cv-00394-JRG, Order, Dkt. No. 225 (E.D. Tex. May 22, 2024), Ex. 2004 at 3 (denying a motion to stay where “the PTAB decision is not due until over six months after jury trial is set to begin”).

**B. *Fintiv* Factor 2: The Court’s Trial Date Precedes the Board’s Projected Statutory Deadline**

This factor weighs heavily in favor of denying institution. “If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under *NHK*.” *Fintiv*, Paper 11 at 9. Here, trial is scheduled to commence on May 4, 2026 (DCO, Ex. 2002), over **four months before** the projected deadline for the Board’s final written decision on September 6, 2026.<sup>6</sup>

The Board has found similar circumstances—a four-month gap between the district court trial and the Board’s final decision—to weigh in favor of denial. *See AT&T Servs. Inc. v. ASUS Tech. Licensing Inc.*, IPR2024-00997, Paper 15 at 9 (PTAB Dec. 16, 2024) (denying institution and holding that trial occurring “four to five months prior to the deadline for our final written decision, based on the scheduled trial date and median time-to trial statistics ... weighs substantially in favor of discretionary denial”); *Ericsson Inc. v. Active Wireless Techs. LLC*, IPR2024-00886, Paper 8 at 8-9 (PTAB Nov. 12, 2024) (collecting cases).

Indeed, the Board has found this factor favors denial in cases with even less time between the trial date and final decision date. *See EClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10 at 9 (PTAB Apr. 13, 2022) (finding this

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<sup>6</sup> The Notice of Filing Date Accorded To Petition was mailed on March 6, 2025. Paper 6 at 1. A Final Written Decision will therefore be due by September 6, 2026. *See* 35 U.S.C. §314(b); 35 U.S.C. §316(a)(11).

factor weighed in favor of discretionary denial and denying institution where “the beginning of the jury trial in the WDTX Cases is roughly one to two months before any final decision would have been due had *inter partes* review been instituted”); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 13 (PTAB May 13, 2020) (finding this factor weighed in favor of discretionary denial and denying institution where the district court trial was scheduled to occur two months before the deadline for the Board to reach a final written decision).

Further, the trial date set by the Court is a “deadline that cannot be changed without an acceptable showing of good cause,” which strongly indicates the Court intends to stick with its set trial date. DCO, Ex. 2002 at 1, 5. Petitioner’s argument that there is “significant uncertainty over the trial date” is unpersuasive. Petition at 76; *see also HP Inc. v. Universal Connectivity Technologies, Inc.*, IPR2024-01428, Paper 12 at 6 (“*HP Inc.*”) (PTAB April 8, 2025) (“The District Court has stated that this trial date setting ‘cannot be changed without an acceptable showing of good cause.’ ... We are not persuaded by Petitioner’s unsupported argument that the trial date is speculative.”). For example, the Eastern District of Texas had 809 total pending cases in a 12-month period ending in September 2024 and completed 13 trials. Judicial Caseload Profile for E. D. Tex., Ex. 1011. Thus, it is highly likely that Judge Gilstrap’s schedule will clear on the set trial date. The Court’s May 6, 2026 trial setting (just under 22 months from filing) is consistent with the Court’s median time-to-trial date of 21.9 months, which gives credibility to the Court’s entered schedule. *See id.* (showing the median time from filing to trial in

civil cases in the Eastern District of Texas is 21.9 months); *HP Inc.*, Paper 12 at 6 (“The fact that the time-to-trial statistic is earlier than the trial date set by Judge Gilstrap confirms that the schedule set by the District Court is credible and should be given weight.”).

Because trial in the Litigation is scheduled to commence on May 4, 2026, more than four months before the projected deadline for the Board’s final written decision if *inter partes* review is instituted, this factor weighs heavily in favor of denial. *See Google LLC v. Cerence Operating Co.*, IPR2024-01465, Paper 15 (“*Google-Cerence*”) (PTAB April 23, 2025) (“Because the District Court Litigation will address the issues relating to the validity of the [challenged] patent in a trial scheduled to occur several months before we would issue a final written decision, we weigh the second *Fintiv* factor as favoring discretionary denial.”).

**C. *Fintiv* Factor 3: The Court and Parties Have Made a Substantial Investment of Time and Resources in the Parallel Proceeding**

This factor asks the Panel to “consider [] the amount and type of work that the court and the parties will have completed in the parallel litigation by the time of [an] institution decision.” *See Google-Cerence*, Paper 15 at 9. It “is related to the trial date factor, in that more work completed by the parties and court in the parallel proceeding tends to support the arguments that the parallel proceeding is more advanced, a stay may be less likely, and instituting would lead to duplicative costs.” *Fintiv*, Paper 11 at 10. This factor weighs heavily in favor of denying institution.

The parties have already invested substantial time and effort in the Litigation. At the time of this request, the parties have prepared and exchanged preliminary and amended infringement contentions, preliminary and amended invalidity contentions that are 552 pages with 99 exhibit charts, and initial and additional disclosures. *See* DCO, Ex. 2002 at 5; Excerpts of Petitioner’s Invalidity Contentions, Ex. 2005 at 1, 11. This weighs in favor of denial. *See Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3 (“*Motorola Solutions*”) (PTAB March 28, 2025) (holding this factor strongly favors denial because, among other things, “the parties had served extensive infringement and invalidity contentions”). The parties have also invested substantial effort in discovery, including venue discovery and third-party discovery, which is ongoing. *See Samsung Electronics Co., Ltd. v. Evolved Wireless LLC*, IPR2021-00950, Paper 10 at 13 (“*Samsung-Evolved*”) (PTAB November 29, 2021) (denying institution and holding the investment factor weighed in favor of denial notwithstanding the fact that the district court had not issued any substantive orders and finding “the Parties have exchanged and/or answered 138 Interrogatories, 171 Requests for Production, 79 Requests for Admission, served 30(b)(6) Deposition Notices comprising 64 topics, and exchanged over 1.3 million pages of documents (not counting source code).”). Here, discovery has been extensive in the parallel Litigation: six depositions have been conducted thus far; nearly 300,000 pages of documents have been produced; and the parties have exchanged and/or answered 39 interrogatories, 20 requests for production, and 12 requests for admission. *See*

Kennedy Declaration, Ex. 2016; *see also Motorola Solutions*, Paper 19 at 3 (holding this factor strongly favors denial because, among other things, the parties had “conducted several depositions.”). Additionally, the parties have issued numerous third-party subpoenas for production and testimony. *See, e.g.*, Exs. 2006-2008. To date, nearly 500 pages of third-party material have been produced in response to these subpoenas, with more expected.

Notably, the vast majority of the third-party subpoenas have been issued by Petitioner seeking documents and information concerning prior art. *See, e.g.*, Petitioner’s Subpoena to Lumileds (trimmed), Ex. 2006; Petitioner’s Subpoena to Carclo (trimmed), Ex. 2007. Specifically, Petitioner has issued subpoenas to the following entities: EMCORE Corp., SRI International, Inc., Eastman Kodak Company, Sharp Electronics Corp., Nintendo of America, Inc., Fujitsu North America, Inc., Mitsubishi Electric US, Inc., Lumileds, LLC, The University of Florida, Panasonic Corp. of North America, Sony Corporation of America, 3M Company, Amkor Technology, Inc., Analog Devices, Inc., Carsem, Inc., Lingsen America, Inc., Carclo US Holdings, Inc., Osram Sylvania Inc., and CTP Carrera, Inc. *See* Subpoena Notices, Ex. 2008. These subpoenas, which seek information concerning product prior art that cannot be asserted in IPR, highlight not only the significant efforts that have been undertaken in the district court proceedings, but also (as discussed further below) that these proceedings are not a “true alternative” to the district court proceedings. *See Motorola Solutions*, Paper 19 at 3–4 (Director vacating decision granting institution where the petitioner’s “stipulation does not

ensure that these [*inter partes* review] proceedings would be a ‘true alternative’ to the district court proceeding”).

The parties have also invested substantial resources in the Litigation related to briefing and argument submitted to the Court in connection with the parties’ various motions. For example, the parties’ submitted briefing in connection with disputes concerning provisions in the Court’s protective and discovery orders (Dkt. Nos. 39, 51). *See* Litigation Docket Report, Ex. 2001 at 12-13. The parties have also completed briefing on two motions to dismiss filed by the defendants in the Litigation (Dkt. Nos. 55, 56, 59, 61-64, 66, 67). *See id.* at 13-15. They have also submitted briefing in connection with several discovery disputes (Dkt. Nos. 70, 76, 85, 90, 91, 93, 100). *See id.* at 15-18.

The Court has also invested substantial time and resources into the Litigation. The Court held a scheduling conference on November 7, 2024. *Id.* at 12. The Court had to expend resources resolving disputed provisions in the protective and discovery orders submitted by the parties (Dkt. Nos. 50, 52). *See id.* at 13 (resolving disputes and entering Discovery Order); *id.* (resolving disputes and entering Protective Order). The Court has also conducted two hours-long hearings addressing four different disputes, including a motion to strike Patent Owner’s infringement contentions filed by Petitioner. Litigation, Dkt. No. 102, April 10, 2025 Hearing Minutes Entry, Ex. 2009; *Id.*, Dkt. No. 120, April 15, 2025 Hearing Minutes Entry, Ex. 2010. Notably, Petitioner’s motion to strike required the Court

to familiarize itself with the '113 Patent's claims and the technology underlying and implicated by Patent Owner's infringement contentions.

At the time of the institution decision, the parties' and the Court's investment in the Litigation will be even more substantial. In addition to ongoing discovery efforts, claim construction will be well under way. By the expected institution deadline, the parties will have exchanged proposed claim terms (July 7, 2025), the parties will have exchanged preliminary claim constructions (July 25, 2025), the parties will have submitted their joint claim construction statement (August 15, 2025), and claim construction discovery will be nearly complete (September 12, 2025). DCO, Ex. 2002 at 4. Shortly thereafter, the parties will commence claim construction briefing (September 19, 2025), with a *Markman* hearing scheduled for November 7, 2025. *Id.* Additionally, the deadline to complete fact discovery and serve expert reports is just three months after the expected institution decision date. *Id.* at 3.

Given the substantial time and effort the parties and the district court have already invested in the parallel litigation, and the additional investment they will make before an institution decision is expected, this factor weighs heavily in favor of denial.

**D. *Fintiv* Factor 4: Issues Raised in the Petition Substantially Overlap with Issues Raised in the Litigation and IPR Is Not a “True Alternative” to the Litigation**

“This factor evaluates ‘concerns of inefficiency and the possibility of conflicting decisions’ when substantially identical prior art is submitted in both the

district court and the *inter partes* review proceeding.” *Google-Cerence*, Paper 15 at 11 (quoting *Fintiv*, Paper 11 at 12). In the Memorandum regarding “Guidance on USPTO’s recission of ‘Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,’” issued by the Chief Administrative Patent Judge of the Patent Trial and Appeal Board on March 24, 2025 (hereinafter, “Guidance Memo”),<sup>7</sup> the Chief Judge stated,

[A] timely-filed *Sotera* stipulation[] (*i.e.*, a stipulation from a petitioner that, if an [*inter partes* review] or [post-grant review] is instituted, the petitioner will not pursue in district court . . . any ground raised or that could have been reasonably raised in the [*inter partes* review]/[post-grant review]) is highly relevant, but will not be dispositive by itself.

Guidance Memo, 2-3. In considering this factor, the Panel should consider whether *inter partes* review would be a “true alternative” to parallel district court litigation. *See Motorola*, Paper 19 at 3-4 (Director vacating decision granting institution where the petitioner’s “stipulation does not ensure that these [*inter partes* review] proceedings would be a ‘true alternative’ to the district court proceeding”).

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<sup>7</sup>Available at

[https://www.uspto.gov/sites/default/files/documents/guidance\\_memo\\_on\\_interim\\_procedure\\_recission\\_20250324.pdf](https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf)

This factor weighs in favor of discretionary denial because there is substantial overlap in the invalidity theories presented in the Petition and in the Litigation, and Petitioner’s untimely *Sotera* stipulation does not ensure that these IPR proceeding would be a true alternative to the parallel Litigation. Indeed, as discussed below, “Petitioner’s invalidity arguments in the district court are more expansive and include” system prior art and “combinations of the prior art asserted in these proceedings with unpublished system prior art, which Petitioner’s stipulation is not likely to moot.” *Motorola Solutions*, Paper 19 at 4. In short, this IPR proceeding would not be a “true alternative” to the district proceeding. *See id.* at 3-4.

**1. The same art and arguments are at issue in the Litigation**

This factor favors denial because Petitioner “asserts the same prior art and arguments” in both proceedings and both the Board and the Court are “analyz[ing] the same issues.” *NHK Spring*, Paper 8 at 20. There is complete overlap of the prior art references—all three references relied upon by the Petition are also relied upon by Petitioner in the district court. Further, Petitioner’s invalidity contentions served in the Litigation repeat all of the assertions made in the Petition with the exception that the Petition contains three extra dependent claims (claim 3, 9, and 11) not asserted in the Litigation.

| Invalidity Assertions in the Litigation                                                                                                          | Invalidity Assertions in the Petition                                         |
|--------------------------------------------------------------------------------------------------------------------------------------------------|-------------------------------------------------------------------------------|
| Any combination of <i>Odawara</i> , <i>Sommers</i> , and <i>West</i> anticipate or render obvious all asserted claims (claims 1, 2, 4-8, and 10) | <i>Odawara</i> anticipates or renders obvious claims 1, 2, 4, 5, 7, 8, and 10 |
|                                                                                                                                                  | <i>Odawara</i> and <i>West</i> render obvious claims 1, 2, 4-8, and 10        |
|                                                                                                                                                  | <i>Sommers</i> anticipates or renders obvious claims 1, 3, 4, 7, and 9        |
|                                                                                                                                                  | <i>Sommers</i> and <i>West</i> render obvious claims 1, 3-7, 9, and 11        |

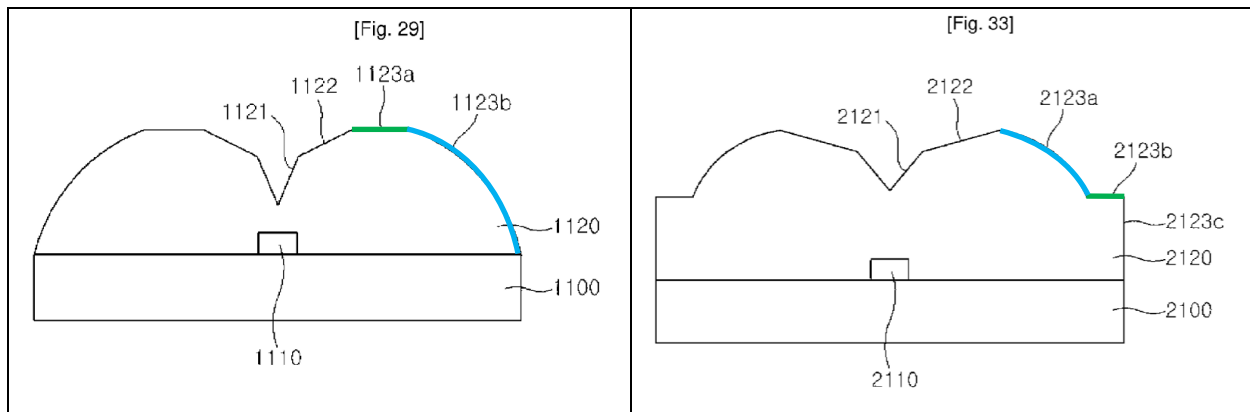
See Excerpts of Petitioner’s Invalidity Contentions, Ex. 2005 at 2-10 (originally pp. 83-88, 490-492); Petition at 6. The substantial overlap raises “concerns of inefficiency and the possibility of conflicting decisions,” weighing in favor of denial. *Fintiv* at 12.

Petitioner’s challenge to dependent claims 3, 9, and 11, which are not asserted in the Litigation, is a hollow attempt to make the Petition appear to address different issues than those in the Litigation. Petitioner has not identified any real interest in canceling these additional claims. Further, the difference between determining validity of the additional claims and the asserted claims in the Litigation is nominal. See *Fintiv*, Paper 11 at 13 (“if a petition involves the same prior art challenges but challenges claims in addition to those that are challenged in the district court, it may still be inefficient to proceed because the district court

may resolve validity of enough overlapping claims to resolve key issues in the petition.”).

The additional claims are similar in scope to the claims at issue in the district court proceeding and resolution as to validity on the overlapping claims will likewise resolve key issues in the additional claims. For example, claim 2, asserted in the Litigation, and claim 3, subject to the Petition but not asserted in the Litigation, both provide a similar structural limitation to the lens surface of claim 1:

| Claim 2 (in Litigation)                                                                                                                                                                                                                                                                                                                                                                                                | Claim 3 (in Petition)                                                                                                                                                                                                                                                                                                                                                                                                  |
|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <p>2. The light emitting device as claimed in claim 1, wherein the refractive surface [1123] comprises:</p> <p style="padding-left: 40px;">a <u>linear refractive surface</u> [1123a] formed by being bent at the periphery of the total reflection surface; and</p> <p style="padding-left: 40px;">a <u>curved refractive surface</u> [1123b] formed to extend from a periphery of the linear refractive surface.</p> | <p>3. The light emitting device as claimed in claim 1, wherein the refractive surface [2123] comprises:</p> <p style="padding-left: 40px;">a <u>curved refractive surface</u> [2123a] formed to extend from the periphery of the total reflection surface; and</p> <p style="padding-left: 40px;">a <u>linear refractive surface</u> [2123b] formed by being bent at a periphery of the curved refractive surface.</p> |



As shown above, the district court’s resolution of claim 2 will resolve the key issues required to resolve claim 3. Resolving whether the prior art discloses the key elements of claim 2, namely “linear refractive surface,” “curved refractive surface,” “formed by being bent at the periphery of the total reflection surface,” and “formed to extend from a periphery of the [linear/curved] refractive surface,” will likewise resolve claim 3 as it contains the same terms. Claim 2 and claim 3 are substantially similar in that the structural limitations of the lens surface having a linear and curved element are simply inverted.

Claim 9, subject to the Petition but not asserted in the Litigation, is the same as claim 8, which is in the Litigation, except claim 9 depends from claim 3 and claim 8 depends from claim 2. As noted above, resolution of claim 2 will resolve claim 3. Likewise, the district court’s resolution of claim 8 will resolve the key issues required to resolve claim 9. And the same goes for claim 11, which is the same as claim 10, except claim 11 depends from claim 3 and claim 10 depends from claim 2.

## 2. IPR would not be a true alternative to the Litigation

This factor also weighs in favor of denial because Petitioner's untimely *Sotera* stipulation, to the extent it is considered,<sup>8</sup> does not ensure that this IPR proceeding would be a "true alternative" to the district court proceeding. Petitioner's stipulation states that Petitioner will not pursue in the Litigation "any ground that could be raised [in an IPR] under §§ 102 or 103 *on the basis of prior art patent or printed publications.*" Petitioner's *Sotera* Stipulation, Ex. 1015 (emphasis added). Yet Petitioner's invalidity contentions assert at least three products it alleges anticipate or render obvious, alone or in combination with other references, all asserted claims of the '113 Patent. Excerpts of Petitioner's Invalidity Contentions, Ex. 2005 at 2-10 (originally pp. 83-88, 490-492) ("[The Lumileds Luxeon Side Emitter/Carclo Optics Side-Emitting Optic/Samsung LN-R460D] was sold, offered for sale, and was known or used by others in this country before either the claimed or proper priority date of the '113 Patent."). Indeed, Petitioner has argued in the Litigation that it intends to rely on product prior art at trial. *See, e.g.,* Petitioner's Motion to Transfer, Ex. 2012 at 11-12 ("Sarnoff, EMCORE, and at least eleven prior art inventors (including Dr. Eliashevich, EMCORE's Director of R&D at the relevant time) are in NJ or within its subpoena power, and they have

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<sup>8</sup> Petitioner's *Sotera* stipulation should be considered untimely because it was filed over one month after the accorded filing date. *See* Y. Ha's April 17, 2025 Email, Ex. 2011 (the Board clarifying that "a *Sotera* stipulation should be filed within one month of the Notice of Filing Date Accorded").

crucial information concerning prior art to the asserted patents ... And their work on products or prototypes (*see, e.g.*, Exs. 19-22) will be critical at trial because product prior art cannot be raised in an IPR.”).

The language in Petitioner’s stipulation concerning product or system art (“if the PTAB institutes inter partes review, Petitioner will not, in the Litigation, rely on any product or system art that is ‘based on the same evidence presented’ in this IPR”) is toothless. Petitioner’s *Sotera* Stipulation, Ex. 1015. To begin with, the stipulation does not appear to address any of the product or system art asserted in the Litigation (as part of an obviousness combination involving IPR-asserted prior art or otherwise). Indeed, Samsung does not point to any of the references asserted in the Petition as evidence for its product and system-based invalidity contentions in the Litigation. *See* Excerpts of Petitioner’s Invalidity Contentions, Ex. 2005 at 12-17. Moreover, Petitioner’s invalidity contentions in the parallel Litigation contemplate combining the alleged product art (The Lumileds Luxeon Side Emitter, Carclo Optics Side-Emitting Optic, Samsung LN-R460D) with *any* of the cited references, including those cited in this proceeding. *See id.* at 12-19. Notably, Petitioner does not stipulate that it will not assert product or system prior art in combination with prior art that it has raised or could have raised before the Board. *See Motorola Solutions*, Paper 19 at 3-4 (“Petitioner’s [*Sotera*] stipulation does not ensure that these IPR proceedings would be a ‘true alternative’ to the district court proceeding. Petitioner’s invalidity arguments in the district court are more expansive and include combinations of the prior art asserted in these proceedings

with unpublished system prior art, which Petitioner’s stipulation is not likely to moot.”) (citation omitted).

Ultimately, the Court will address the same validity issues raised by the Petition (and more) well before the Board is scheduled to reach a final decision if *inter partes* review is instituted. There is no reason why the Board should redo the work of another tribunal regarding the same issues. Accordingly, this factor weighs in favor of denial.

**E. *Fintiv* Factor 5: Petitioner is the Defendant in the Litigation**

Petitioner and Patent Owner agree that “Petitioner is the defendant in the litigation.” Petition at 77. Accordingly, this factor weighs in favor of denying institution. *See SAP America, Inc. v. Cyandia, Inc.*, IPR2024-01496, Paper 13 at 9 (PTAB April 7, 2025) (“The fact that Petitioner is also the defendant in the Litigation weighs in favor of discretionarily denying institution.”).

**F. *Fintiv* Factor 6: Other Circumstances, Including the Merits, Weigh in Favor of Discretionary Denial**

“The final *Fintiv* factor takes into account other circumstances that may bear on the decision to exercise discretion to deny institution, such as the merits of the patentability challenges.” *Google-Cerence*, Paper 15 at 15. At this stage, “a full analysis of the merits is not necessary; rather, the parties may point out particular strengths and weaknesses to aid [the Director] in deciding whether the merits tip

the balance [of considerations] one way or another.”<sup>9</sup> *Id.* at 15; *see also Fintiv*, Paper 11 at 15 (“[I]f the merits of the grounds raised in the petition are a close[] call, then that fact has favored denying institution when other factors favoring denial are present. This is not to suggest that a full merits analysis is necessary to evaluate this factor.”). Weakness on the merits weighs in favor of denying institution. *See E-One v. Oshkosh Corp.*, IPR2019-00162, Paper 16 at 13-20 (PTAB June 5, 2019) (weakness on the merits weighed heavily in favor of denying institution). But the strength of the merits is not dispositive. *See* Guidance Memo at 3 (“compelling merits alone is not dispositive” in considering whether to exercise discretion); *see also SAP America, Inc. v. Cyandia, Inc.*, IPR2024-01432, Paper 14 at 10-11 (PTAB April 7, 2025) (denying institution finding this factor to be neutral and that the strength of the merits did not outweigh the other *Fintiv* factors even though petitioner’s challenge “definitely satisfies the institution standard”). Here, the strength of the merits does not warrant institution.

### **1. Claim Construction**

To begin with, the merit of the Petition is undercut by its reliance on questionable claim constructions. *See Samsung Display Co., Ltd. v. Pictiva*

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<sup>9</sup> Consistent with this view, and as can be appreciated, this Discretionary Denial Brief only highlights certain weaknesses of the Petition. Patent Owner will more fully address Petitioner’s arguments and the asserted references’ shortcomings in its POPR merit-based briefing.

*Displays International Ltd.*, IPR2024-00855, Paper 12 at 13 (PTAB Nov. 19, 2024) (“Petitioner’s challenges do not meet the compelling merits standard because a genuinely-disputed issue surrounds the correct construction of [a] limitation. That genuine dispute, in turn, casts doubt upon whether Petitioner ‘is highly likely’ to prevail in showing that [another] limitation would have been obvious over the asserted prior art references.”). This is illustrated, for example, by Petitioner’s construction for “total reflection surface” as a “surface that totally reflects light.” Petition at 22. Indeed, the Petition itself calls into question this construction. *See* Petition at 25 (acknowledging that “total reflection” may refer to total internal reflection); *see also* Petition at 22-23 (discussing support for total *internal* reflection). Petitioner’s equivocation on claim construction confirms that the Petition not only fails to meet the “reasonable likelihood” standard under 35 U.S.C. § 314(a) but fails to meet the higher “compelling merits” standard under *Fintiv* factor 6.

## **2. The Petition’s Merits are Weak**

Setting aside claim construction, Petitioner is unlikely to prevail on the merits because the references the Petition relies on do not disclose each limitation of the challenged claims.

### Grounds I and II (Claims 1, 2, 4, 5, 7, 8, 10)

Grounds I and II, which challenge independent claim 1 and claims depending therefrom, rely on Odawara (Ex. 1004) as disclosing the portion of claim 1 that recites “a total reflection surface with a total reflection slope with

respect to a central axis of the light emitting diode.” *See* Petition at 22-26.

Petitioner cannot show that Odawara discloses “a total reflection surface with a total reflection slope with respect to a central axis of the light emitting diode” as required by independent claim 1.

The Petition asserts, “As shown below in Figure 1 and 3, Odawara teaches a recessed part in which the ‘light emitted from the LED chip upward in the optical axis direction is totally reflected by the inner surface of the recessed part and travels along the entire periphery in the lateral direction.’” Petition at 23-24 (citing EX1004, [0034]). Petitioner’s characterization of Odawara is incorrect for various reasons. As an initial matter, Petitioner completely misrepresents Figure 3. Figure 3 does not illustrate a different embodiment. Figure 3 “is a graph depicting the light distribution characteristics of the surface mounted LED of FIG. 1.” Ex. 1004, Brief Description of Drawings (emphasis added). As explained by the patent, the distorted LED profile in Figure 3 is intended to represent the LED of Figure 1. *See id.*; *see also id.* at [0032]. Notably, Odawara does not provide any disclosure related to the lens profile shown in Figure 3. Nonetheless, Petitioner and their expert take the rough representation of Figure 1 included with Figure 3, add misleading annotations to the representative lens profile and make misleading, self-serving descriptions of the annotated profile, including suggesting it is a separate embodiment, in a misguided attempt to improperly supplement what Odawara actually discloses. Petition at 23-25. Petitioner’s characterization and discussion of Figure 3 should be disregarded in its entirety.

With respect to FIG. 1, Odawara explains that the lens includes a recessed part 14a, which the Odawara application describes as a truncated cone. *See* Ex. 1004 at [0033]; *see also id.* at [0013], [0018]. But Odawara does not describe the features or configuration of this “truncated cone.” It is silent as to how the recessed portion is configured, much less its optical properties. Consequently, Petitioner cannot meet its burden of showing that the reference describes “a total reflection surface with a total reflection slope with respect to a central axis of the light emitting diode.” *See Krippelz v. Ford Motor Co.*, 667 F.3d 1261, 1268 (Fed. Cir. 2012) (“This court has repeatedly cautioned against overreliance on drawings that are neither expressly to scale nor linked to quantitative values in the specification.”). Ground III of the Petition, which relies on the combination of Odawara with West, implicitly acknowledges that Odawara does not disclose “a total reflection surface with a total reflection slope with respect to a central axis of the light emitting diode.” Petition at 37-38 (“West teaches a ‘[l]ens 44 [that] includes ... a total internal reflection (TIR) funnel portion 58’”). Thus, for Ground III, the Petitioner relies on West (rather than Odawara) as allegedly satisfying the portion of claim 1 (and claims depending therefrom) that recites “a total reflection surface with a total reflection slope with respect to a central axis of the light emitting diode.” *Id.*

Ground III (Claims 1, 2, 4-8, 10)

Ground III relies on the combination of Odawara (Ex. 1004) and West (Ex. 1005). As discussed above, Petitioner relies on West as allegedly satisfying “a total

reflection surface with a total reflection slope with respect to a central axis of the light emitting diode.” Notably, the USPTO considered West in view of these limitations during prosecution of the ’113 Patent’s parent, U.S. Patent No. 7,748,873 (the “’873 Patent”), and the claims were allowed in view of West. *See* ’873 Prosecution History, Ex. 1008 at 395, 421-422, 1438-1443. What is more, a POSITA would not have been motivated to combine West with Odawara as proposed by Petitioner. The Petition glosses over technical incompatibilities, conflicting design objectives, and distinct fields of endeavor of these references to piece prior art together without a clear, articulated rationale explaining why a POSITA would have been motivated to combine them.

In fact, a POSITA would not have been inclined to combine Odawara and West given the distinct objectives, technical incompatibilities, and lack of motivation in the prior art. Such a hindsight-driven combination would undermine the specific objectives and technical advantages of the light emitting devices of Odawara and West. For example, Odawara and West have competing objectives and solutions. The “object of [Odawara] is to provide a surface mounted LED having wide directivity using a simple configuration” such that “the light has wide directivity of approximately 180 degrees” whereas West’s objective is to provide a “side emitting light emitting diodes” so that “the light exits from the lens 44 as close to 90 degrees to the longitudinal package axis 43 as possible.” Odawara, Ex. 1004 at [0008], [0032], Fig. 3 (emphasis added); West, Ex. 1005 at 1:10-12, 4:2-5 (emphasis added). A POSITA would not be motivated to combine the features of

the *side* emitting device of West with the *wide directivity* emitting device of Odawara. West's sawtooth side surface design is incompatible with Odawara and does not align with Odawara's objective to use "a simple configuration." Odawara, Ex. 1004 at [0008] (emphasis added). As shown in the figure below, not only does West's "sawtooth" shaped surfaces (in green) fail to achieve Odawara's objective of wide directivity (narrow directivity shown in purple) but is also not a simple configuration:

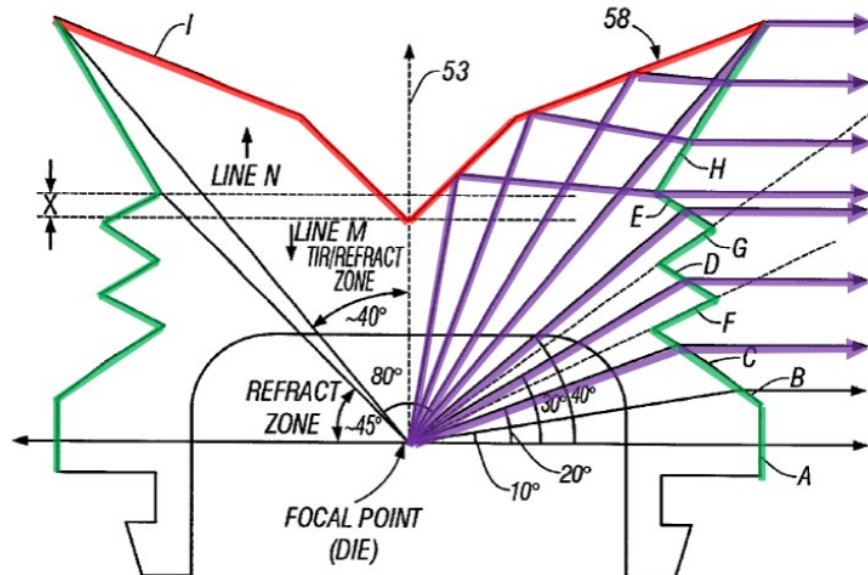


FIG. 5F

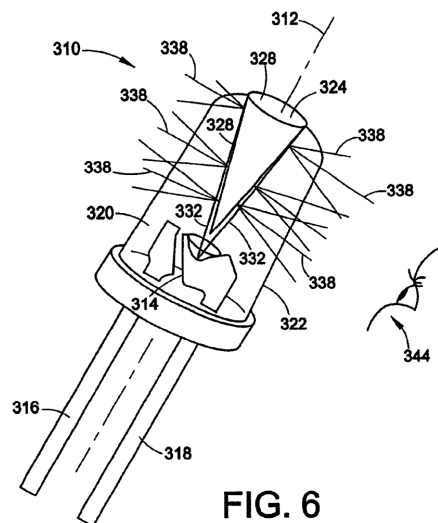
Petition at 16 (Ex. 1005, Fig. 5F annotated).

Ground IV and V (Claims 1, 3, 4, 7, 9)

Petitioner is unlikely to prevail on grounds IV and V, which challenge independent claim 1 and claims depending therefrom based on Sommers (Ex. 1006). Petitioner contends that encapsulant 320, as described in connection with Figure 6 of Sommers, is a "lens" with a "total reflection surface" as described by

claim 1. To begin, it is disputable that Sommers describes a “lens,” as is required by independent claim 1 (and claims depending therefrom). Sommers describes “a light emitting diode (LED) package” wherein “[a] transparent encapsulant surrounds the LED die,” and “[a] reflective surface is disposed on the encapsulant surface essentially opposite the LED die surface.” Sommers, Ex. 1006, 2:5-10.

But assuming the disclosed encapsulant can be fairly characterized as a lens, Sommers does not disclose that the encapsulant also has “a total reflection surface with a total reflection slope with respect to a central axis of the light emitting diode” as is required by claim 1. Petitioner argues that these limitations are satisfied by disclosure in Sommers that describes “filling depression 324 with a metal or other reflective filling material which is pressed against outer surface 328.” Petition at 55.



Sommers, Ex. 1006 at FIG. 6

Petitioner's argument cannot be correct. Claim 1 requires "a lens ... comprising a total reflection surface ...." A metal or other reflective material within depression 324 in the encapsulant is separate from the encapsulant itself, which Petitioner argues satisfies the claimed lens. In other words, the metal or other reflective material is not part of the alleged lens and, thus, cannot satisfy the portion of the claims that requires "a lens ... comprising a total reflection surface."

Ground VI (Claims 1, 3-7, 9, 11)

Petitioner is unlikely to prevail on ground VI. Ground VI relies on the combination of Sommers (Ex. 1006) and West (Ex. 1005). Petitioner relies on West as allegedly satisfying "a total reflection surface with a total reflection slope with respect to a central axis of the light emitting diode." Notably, as discussed above, the USPTO considered West in view of these limitations during prosecution of the parent '873 Patent, and the claims were allowed in view of West. *See* '873 Prosecution History, Ex. 1008 at 395, 421-422, 1438-1443. What is more, a POSITA would not have been motivated to combine West with Sommers as proposed by Petitioner. The Petition glosses over technical incompatibilities, conflicting design objectives, and distinct fields of endeavor of these references to piece prior art together without a clear, articulated rationale explaining why a POSITA would have been motivated to combine them.

In fact, a POSITA would not have been motivated to combine Sommers with West. Although both references are directed towards guiding emitted light, the purpose and objective are exactly the opposite: Sommers directionally *distributes*

light and West directionally *concentrates* light. As show (in purple) in the figure above (West, Ex. 1005, Fig. 5F annotated), in West “the light exits from the lens 44 as close to 90 degrees to the longitudinal package axis 43 as possible” (West, Ex. 1005 at 1:10-12, 4:2-5 (emphasis added)) whereas Sommers “emits light in a non-directional manner within a certain viewing range” (Sommers, Ex. 1006 at 4:31-35). As such, combining them would not yield predictable, functional results. A POSITA would recognize that these devices are not interchangeable and are purpose-built for very different lighting challenges. Combining them would dilute their performance without any design benefit. Further, the design of Sommers is incompatible with the solution of West in that the bulky design of Sommers will not satisfy a “need [] for an LED package to couple efficiently to shallow reflectors and thin light guides.” West, Ex. 1005 at 1:58-59.

### **3. Other Circumstances Favor Denial**

Petitioner’s over-reliance on its 107-page expert declaration also weighs in favor of denial. *See* Memorandum at 2 (“[T]he parties are permitted to address all relevant considerations, which may include: ... [t]he extent of the petition’s

reliance on expert testimony.”);<sup>10</sup> *see also* FAQs for Interim Processes for PTAB Workload Management<sup>11</sup>:

While the Board may consider expert testimony, as a matter of efficiency, extensive reliance on expert testimony and/or reasonable disputes between experts on dispositive issues may suggest that the questions are better resolved in an Article III court. The statute and our reviewing court require that petitions be based on prior art patents and printed publications. As the judges have technical and legal expertise, it is not necessary for an expert to explain every aspect of the prior art. It is most helpful if an expert is providing focused testimony, for example to provide helpful context or to explain terms of art. The failure to provide focused expert testimony may weigh against institution.

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<sup>10</sup> Whether the additional considerations outlined in the Memorandum are considered to be a part of *Fintiv* factor 6 analysis or separate, the Director may consider such additional consideration in discretionarily denying institution.

<sup>11</sup> FAQs for Interim Processes for PTAB Workload Management, *available at* <https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management> (last accessed May 1, 2025)

Dr. Milster’s declaration provides anything but focused testimony. Further, the Petition relies heavily on conclusory expert testimony that does not articulate a clear rationale explaining why a POSITA would have been motivated to combine references. *See, e.g.*, Milster Declaration, Ex. 1002 at ¶¶ 116-119, 169-172; *see also* discussion on motivations to combine at § III.F.2 above. Moreover, the Petition relies heavily on Petitioner having its expert fill in gaps in the asserted prior art references. The phrase “a POSITA would have” appears 28 times in the Petition.

The Director may also consider the “[s]ettled expectations of the parties, such as the length of time the claims have been in force.” Memorandum at 2. Here, the claims of the ’113 Patent have been in force for over 14 years, and the owners of the patent have paid three maintenance fees. The well-settled expectations regarding the presumed validity and enforceability of the ’113 Patent favors denial.

There are several additional considerations that relate to efficiency and weigh in favor of discretionary denial. *See* Memorandum at 2-3 (“[T]he parties are permitted to address all relevant considerations, which may include ... [a]ny other considerations bearing on the Director’s discretion ... These processes aim to improve PTAB efficiency ....”). To begin, the ’113 Patent will expire in October 2025, well before the Board issues a final written decision if *inter partes* review is instituted. From an efficiency perspective, it makes no sense for the Board to undertake review of a patent that will expire before a final written decision will be issued, particularly where, as here, the validity of the patent will also be addressed

at an earlier trial in parallel district court proceedings. Additionally, and as discussed further below, the USPTO considered West during examination of the application that issued as the '873 Patent, parent to the '113 Patent. *See* § IV.A below. This reference is relied upon as the basis for two of the six grounds asserted in the Petition.

Accordingly, based on the merits and other circumstances, *Fintiv* Factor 6 favors denial.

\* \* \*

Considering the relevant factors as a whole, the efficiency and integrity of the system are best served by denying review. The Director should exercise her discretion to deny institution under § 314(a).

#### **IV. THE BOARD SHOULD DENY THE PETITION BY EXERCISING DISCRETION UNDER § 325**

The Board also has the discretion to deny institution of a trial based on 35 U.S.C. § 325(d) when “the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d). Here, denial is proper because, during the prosecution of the '113 Patent, the examiner considered one of the three references (West) relied upon by the Petition, and many other light emission references. Moreover, Petitioner failed to demonstrate a material error by the Office.

In *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, Case IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (“*Advanced Bionics*”)

(precedential, designated March 24, 2020), the Board sets forth a two-part framework for determining whether denial under § 325(d) is proper. The Board determines: “(1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Id.* at 8. Factors to provide guidance to this determination are set forth in *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017): “(a) the similarities and material differences between the asserted art and the prior art involved during examination; (b) the cumulative nature of the asserted art and the prior art evaluated during examination; (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art; (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.” *Id.* at 17-18. “If, after review of factors (a), (b), and (d), it is determined that the same or substantially the same art or arguments previously were presented to the Office, then factors (c), (e),

and (f) relate to whether the petitioner has demonstrated a material error by the Office.” *Advanced Bionics*, Paper 6 at 10.

**A. The Same or Cumulative Art and Arguments were Previously Presented to the Office**

As to *Becton, Dickinson* factor (a), one of the three references relied upon by the Petition were considered by the Office. One reference, West (Ex. 1005), was “presented to the Office” to the fullest extent. Not only was West disclosed to the examiner in an Information Disclosure Statement (IDS), but it was specifically referenced and discussed in the background art of the application’s specification.

[0006] Accordingly, studies on development of a device capable of emitting light in side directions of a lens have been actively conducted using the total internal reflection (TIR) property of light. Conventional lenses using TIR are disclosed in U.S. Pat. Nos. 6,679,621, 6,607,286 and 6,598,998. In the patents, a lens comprises a total reflection surface which is formed on the lens and has a predetermined slope, and a plurality of refractive surfaces which have different slopes and through which light reflected by the total reflection surface is emitted to the outside. Since the conventional lens has the plurality of refractive surfaces formed on right and left sides of the total reflection surface, there is a problem in that a process of fabricating the lens is complicated and fabricating costs increase. That is, there are the following problems: if a lens is fabricated using a mold, upper and lower mold parts and right and left mold parts are required; and if a lens is fabricated by means of a casting or grinding method, it cannot be easily fabricated in view of its shape.

’113 Prosecution History, Ex. 1003 at 35 (annotations in red added); *see also id.* at 13 (applicant disclosing West in an IDS). Further, the examiner verified that West was specifically considered.

| Cite No | Patent Number | Kind Code <sup>1</sup> | Issue Date | Name of Patentee or Applicant of cited Document |
|---------|---------------|------------------------|------------|-------------------------------------------------|
| 1       | 6274924       |                        | 2001-08-14 | Carey et al.                                    |
| 2       | 6598998       |                        | 2003-07-29 | West et al.                                     |

ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /M.D./

|                                                                                                     |                        |                                            |            |
|-----------------------------------------------------------------------------------------------------|------------------------|--------------------------------------------|------------|
| <b>INFORMATION DISCLOSURE<br/>STATEMENT BY APPLICANT</b><br>( Not for submission under 37 CFR 1.99) | Application Number     |                                            | 12/730856  |
|                                                                                                     | Filing Date            |                                            | 2010-03-24 |
|                                                                                                     | First Named Inventor   | Do-Hyung KIM                               |            |
|                                                                                                     | Art Unit               | 2875                                       |            |
|                                                                                                     | Examiner Name          | <del>To be assigned</del> Meghan Dunwiddie |            |
|                                                                                                     | Attorney Docket Number | P2745USC1                                  |            |

| EXAMINER SIGNATURE |                    |                 |            |
|--------------------|--------------------|-----------------|------------|
| Examiner Signature | /Meghan Dunwiddie/ | Date Considered | 11/02/2010 |

*Id.* at 150-152 (annotations in red added). More importantly, the examiner considered a rejection that was based on West during prosecution of the parent '873 Patent.

| Cite No | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published. |
|---------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 1       | Non-Final Rejection issued June 1, 2009 in co-pending Application No. 11/576,882                                                                                                                                                                                |

ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /M.D./

|                                                                                                     |                        |                                            |
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|                                                                                                     | Attorney Docket Number | P2745USC1                                  |

| EXAMINER SIGNATURE |                    |                 |            |
|--------------------|--------------------|-----------------|------------|
| Examiner Signature | /Meghan Dunwiddie/ | Date Considered | 11/02/2010 |

*Id.* at 151-152 (annotations in red added). And in that rejection considered by the examiner, West was used by the examiner as a § 102 and § 103 reference to reject claims.

4. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by **West** et al. (US 6598998).

13. Claims 8-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Carey** et al. (US 6274924) in view of **West** et al. (US 6598998).

'873 Prosecution History, Ex. 1008 at 394-400. Although the applicant eventually added limitations to the claims to overcome West, the examiner applied West to substantially similar claims challenged in this Petition. West, considered by the examiner, is asserted in two of the six Grounds of the Petition.

As to *Becton, Dickinson* factor (b), the other two references in the Petition, Odawara (Ex. 1004) and Sommers (Ex. 1006), are cumulative of the light guidance prior art references considered by the examiner. The examiner verified that she substantively reviewed at least 90 different prior art references in the field of light emission, a substantial portion of which are directed to light guidance. Odawara “provide[s] a surface mounted LED having wide directivity” (Odawara, Ex. 1004

at Abstract) and Sommers is entitled “Light-emitting diode (LED) package and packaging method for shaping the external light intensity distribution” (Sommers, Ex. 1006). Both Odawara and Sommers are directed to light emission and more specifically light guidance, which are cumulative of the references considered by the Office during prosecution. For example, Odawara, Sommers, and nearly all of the references listed in the applicant’s information disclosure citation form relate to a lens guiding light with emphasis on guiding the light emissions to the side of the device.<sup>12</sup> ’113 Prosecution History, Ex. 1003 at 140-152.

As to *Becton, Dickinson* factor (d), “the same or substantially the same arguments previously were presented to the Office.” *Advanced Bionics*, Paper 6 at 8. Each of Odawara, Sommers, and West falls in the light guidance art and is cumulative over the multiplicity of references presented to and considered by the Office. For example, the examiner applied West in a rejection substantially similar

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<sup>12</sup> See, e.g., U.S. Pat. No. 6,598,998 entitled “Side emitting light emitting device” (West (Ex. 1005)); U.S. Pat. No. 6,607,286 directed to “side emitting light emitting diodes (LEDs)” (Ex. 2013 at 1:11-13); U.S. Pat. No. 6,679,621 entitled “Side emitting LED and lens” (Ex. 2014); U.S. Pat. Pub. No. 2002/0044454 directed to a “lamp ... to produce the [desired] light intensity and angular distribution” (Ex. 2015 at Abstract); Japanese Pub. No. JP6-201996 directed to “a wide angle condensing lens [having] light from the side of the lens” (Ex. 1008 at 137).

to Petitioner's application of Odawara and Sommers to the claims of the '113 Patent. '873 Prosecution History, Ex. 1008 at 394-400.

Thus, *Becton, Dickinson* factors (a), (b), and (d) weigh in favor of denying institution because the same—or at least cumulative—art cited in the Petition was previously presented to the Office and the same or substantially the same arguments were previously presented to the Office. Therefore, the first prong of *Advanced Bionics* favors denial.

**B. Petitioner has not Demonstrated that the Office Erred in a Manner Material to the Patentability of Challenged Claims**

*Becton, Dickinson* factors (c), (e), and (f) also weigh in favor of denying institution. Thus, under the second prong of *Advanced Bionics*, Petitioner fails to show that the examiner erred in a manner material to patentability. Petition at 93-95.

As to *Becton, Dickinson* factor (c), as discussed above, the Examiner was aware of West. '113 Prosecution History, Ex. 1003 at 13, 35, 150-152. In fact, the examiner was aware that in the parent '873 Patent prosecution West was used as a § 102 and § 103 reference to reject claims. '873 Prosecution History, Ex. 1008 at 394-400. Further, as discussed above, Odawara and Sommers are cumulative of the multiplicity of other cumulative light emission references considered over the span of the '113 Patent prosecution. '113 Prosecution History, Ex. 1003 at 140-152.

As to *Becton, Dickinson* factors (e) and (f), the Petitioner fails to sufficiently explain how the examiner erred in her evaluation of the asserted prior art.

Petitioner merely asserts that the Office’s failure to apply Odawara and Sommers against the pending claims was an error. Petition at 74. That conclusory assertion is pure speculation, supported by no evidence. Nothing in the prosecution history suggests the examiner overlooked the teachings of Odawara, Sommers, or the other prior art of record, including because Odawara and Sommers each fail to disclose a “a total reflection surface with a total reflection slope with respect to a central axis of the [body/light emitting diode].” *See* § III.F.2 above. The record shows the Office understood the importance of these limitations and their construction and chose references to cite in the rejection accordingly. *See* §§ III.F.1, III.F.2 above.

Accordingly, the Board should deny institution under § 325(d) because the references presented in the Petition are the same, substantially the same, or at the very least cumulative of those the Office considered during prosecution and Petitioner has failed to demonstrate a material error by the Office. *See* Advanced Bionics, Paper 6 at 8.

## **V. CONCLUSION**

For the reasons discussed above, Patent Owner respectfully requests that the Director exercise her discretion to deny institution of this *inter partes* review proceeding.

Dated: May 6, 2025

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**CERTIFICATE OF COMPLIANCE WITH WORD COUNT**

Pursuant to the March 26, 2025, memorandum entitled “Interim Processes for PTAB Workload Management” and consistent with 37 C.F.R. § 42.24, I certify that this Brief in Support of Discretionary Denial complies with the type-volume limits of the March 26, 2025, memorandum because it contains 9,198 words, excluding the parts of this brief that are exempted by 37 C.F.R. § 42.24(a)(1), according to the word processing system used to prepare this brief.

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**CERTIFICATE OF SERVICE**

I hereby certify that on May 6, 2025, a copy of Patent Owner's Brief in Support of Discretionary Denial has been served in its entirety via email on the following:

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