

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

CORETRONIC CORPORATION and
OPTOMA CORPORATION,
Petitioners,

v.

MAXELL, LTD.,
Patent Owner.

Case No.: IPR2025-00476

U.S. Patent No. 9,547,226

**BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL**

Mail Stop **Patent Board**
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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PATENT OWNER’S EXHIBIT LIST

Description	Exhibit No.
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March 26, 2025, Memorandum to All PTAB Judges from Coke Morgan Stewart, Acting Secretary of Commerce for Intellectual Property, Regarding the Interim Processes for PTAB Workload Management (“Memo”)	EX2002
First Amended Docket Control Order, <i>Maxell, Ltd. v. Coretronic Corp., et al.</i> , No. 5:24-cv-00088-RWS-JBB (E.D. Tex.) (Dkt. 91) (April 24, 2025)	EX2003
Order Resetting <i>Markman</i> Hearing, <i>Maxell, Ltd. v. Coretronic Corp., et al.</i> , No. 5:24-cv-00088-RWS-JBB (E.D. Tex.) (Dkt. 91) (April 24, 2025)	EX2004
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Plaintiff’s Preliminary Election of Asserted Claims, <i>Maxell, Ltd. v. Coretronic Corp., et al.</i> , No. 5:24-cv-00088-RWS-JBB (E.D. Tex.) (Dkt. 78) (March 11, 2025)	EX2007
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U.S. Pub. No. 2010/0328632 (“Kurosaki ’632”)	EX2012

USPTO Rescinds Memorandum Addressing Discretionary Denial Procedures (February 28, 2025), https://www.uspto.gov/about-us/news-updates/uspto-rescinds-memorandum-addressing-discretionary-denial-procedures	EX2013
March 24, 2025, Memorandum to Members of the Patent Trial and Appeal Board from Scott R. Boalick, Chief Administrative Patent Judge, Guidance on USPTO’s Recission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” (“Memo 2”)	EX2014
USPTO, <i>FAQs for Interim Processes for PTAB Workload Management</i> , https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management (last visited May 7, 2025)	EX2015

I. INTRODUCTION

Patent Owner Maxell, Ltd. ("Patent Owner") respectfully requests that the Board deny institution of the Petition filed by Coretronic Corporation and Optoma Corporation (hereinafter "Petitioners" or "Coretronic") challenging the patentability of claims 8, 10, 12 ("Challenged Claims") of U.S. Patent No 9,547,226 ("the '226 Patent") (EX1001).

The Board should exercise its discretion pursuant to 35 U.S.C. §325(d) and/or 35 U.S.C. § 314(a) and deny the Petition. Application of the *Advanced Bionics / Becton, Dickinson* factors weighs strongly in favor of denying institution under § 325(d) because the Petition relies on art that was previously presented to or considered by the Office, or is merely cumulative to such art, and Petitioners fail to demonstrate any material error by the Examiner.

Application of the *Fintiv* factors under § 314(a) weighs in favor of denial given the state of the parallel District Court litigation in the Eastern District of Texas, where validity challenges utilizing the majority of the Petition's references are being adjudicated. The Board has discretion to deny institution under these circumstances to promote fairness and efficiency and manage its docket, potentially considering factors beyond the established frameworks. Instituting an IPR here would contradict the goal of IPRs as an "effective and efficient alternative" to litigation, particularly given the substantial overlap and the finite resources of the Board. *Gen. Plastic Indus.*

Co., Ltd. v. Canon Kabushiki Kaisha, IPR2016-01357, Paper 19 at 16-17 (P.T.A.B. Sept. 6, 2017) (precedential).

Additionally, Petitioners improperly rely on an expert declaration (EX1004) that parrots attorney arguments with almost no additional independent analysis or supporting evidence. As such, under 37 C.F.R. § 42.65(a), Declaration of Dr. Sasian (EX1004) is entitled to little or no weight.

Accordingly, the Board should decline to institute the Petition.

II. THE MARCH 26, 2025 ACTING DIRECTOR'S MEMORANDUM

Pursuant to the March 26, 2025, Acting Director's Memorandum ("Memo"), which outlines "Interim Processes for PTAB Workload Management" including a bifurcated approach for considering discretionary denial. Patent Owner respectfully submits that the Director should deny institution of the Petition based on discretionary factors. This filing is being made within two months of the Notice of Filing Date dated March 10, 2025 (Paper #5), in accordance with the standard briefing schedule for discretionary denial arguments set forth in the Memo.

The Memo outlines relevant considerations for discretionary denial:

- Whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims;
- Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;

- The strength of the unpatentability challenge;
- The extent of the petition's reliance on expert testimony;
- Settled expectations of the parties, such as the length of time the claims have been in force;
- Compelling economic, public health, or national security interests; and
- Any other considerations bearing on the Director's discretion.

As explained below, denial is warranted under 35 U.S.C. § 325(d) and 35 U.S.C. § 314(a). Additionally, other factors highlighted in the Memo—strength of Petitioners' Unpatentability Challenges, Petitioners' undue delay in filing this challenge despite years of notice (EX2001 (Complaint) ¶ 36), the nature of its expert testimony (EX1003)—further support discretionary denial. Thus the petition is ripe for discretionary denial in light of the Memo's aim to “improve PTAB efficiency, maintain PTAB capacity to conduct AIA proceedings, ... and promote consistent application of discretionary considerations in the institution of AIA proceedings.” EX2002 (Memo) at 3.

III. SUMMARY OF PETITIONERS' PROPOSED GROUNDS FOR UNPATENTABILITY

Petitioners allege that claims 8, 10, and 12 are unpatentable based on four grounds. See Pet. at 12. Ground 1 includes a challenge to claims 8, 10, and 12 under pre-AIA 35 U.S.C. §§ 102(e)(2) and/or 103(a) as being anticipated by, or obvious

over, Kurosaki '087 (EX1005). Ground 2 includes a challenge to claims 8 and 10 under pre-AIA 35 U.S.C. § 102(a) and/or 103(a) as being anticipated by, or obvious over, Miyamae (EX1006a, EX1006b, EX1006c). Ground 3 includes a challenge to claim 12 under pre-AIA 35 U.S.C. § 103(a) as being obvious over Miyamae in view of Kurosaki '087 (EX1005). Ground 4 includes a challenge to claims 8, 10, and 12 under pre-AIA 35 U.S.C. § 103(a) as being obvious over Kitano (EX1007) in view of Kurosaki '087 (EX1005).

The alleged invalidity grounds are summarized as follows:

Ground	Patent Claims	Type of Challenge	Primary Reference	Secondary References
1	8, 10, 12	pre-AIA 35 U.S.C. §§ 102(e)(2) and/or 103(a)	Kurosaki '087	
2	8, 10	pre-AIA 35 U.S.C. § 102(a) and/or 103(a)	Miyamae	
3	12	pre-AIA 35 U.S.C. § 103(a)	Miyamae	Kurosaki '087
4	8, 10, 12	pre-AIA 35 U.S.C. § 103(a)	Kitano	Kurosaki '087

IV. DISCRETIONARY FACTORS FAVOR DENIAL OF INSTITUTION

The Petition should be denied pursuant to the Director's discretion to deny institution of petitions. **First**, the Petition should be denied pursuant to 35 U.S.C. § 314(a) and the factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020), given the progress of the parallel District Court

litigation. **Second**, the Petition should be denied pursuant to 35 U.S.C. § 325(d) because the petition argues the “same or substantially the same art previously presented to the Office” and fails to demonstrate “that the Office erred in a manner material to the patentability of the challenged claims.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, 8 (P.T.A.B. Feb. 3, 2020) (precedential); *see also Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, pp. 17-18 (P.T.A.B. Dec. 15, 2017) (Precedential). **Finally**, other consideration such as Petitioners’ expert testimony that merely parrots the petition also favors discretionary denial.

A. Application of 35 U.S.C. § 314(a) Weighs in Favor of Denying Institution

The Petition should be denied pursuant to 35 U.S.C. § 314(a) because the factors established in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (precedential), weigh strongly in favor of denial due to the parallel District Court Litigation. *Maxell, Ltd. v. Coretronic Corp.*, No. 5:24-cv-00088-RWS-JBB (E.D. Tex.) (filed July 9, 2024) (“District Court Litigation”). Petitioners’ analysis of these factors is self-serving and ignores the actual progress and status of the District Court Litigation. In so doing, they minimize the substantial inefficiencies and prejudice inherent in instituting this duplicative proceeding, particularly given Petitioners’ failure to file a *Sotera* stipulation. When properly analyzed based on the

court docket, the *Fintiv* factors favor denial. Institution would be inconsistent with the AIA's goal of providing an "effective and efficient alternative" where, as here, the District Court is actively adjudicating the same core validity issues. *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, at 20 (P.T.A.B. Sept. 12, 2018).

1. Status of Motion to Stay in District Court Litigation (Factor 1)

No stay has been requested in the District Court Litigation. Pet. 9. Further, circumstances indicate that a stay would be unlikely in the event of institution. For example, even if the Petition is instituted and Petitioners filed a motion to stay the District Court Litigation, prejudice, tactical disadvantage to Patent Owner, the late stage of litigation, and the lack of potential simplification of the issues would weigh strongly against such a motion. *See Lennon Image Techs., LLC v. Macy's Retail Holdings, Inc.*, 2:13-CV-00235-JRG, 2014 WL 4652117, at *1 (E.D. Tex. Sept. 18, 2014). The statutory deadline for institution is not until after fact discovery closes. Ex. 2003 (First Amended Docket Control Order) at 4; *see Intell. Ventures II v. FedEx Corp.*, No. 2:16-cv-00980-JRG, Dkt. 141 at 5 (E.D. Tex. Oct. 24, 2017) ("The Court agrees that the Parties have already invested substantial effort and resources during discovery and in preparing claim construction briefing. . . . These circumstances weigh against staying this case.").

Thus, the first factor weighs against institution.

2. Proximity Of The District Court's Trial Date (Factor 2)

Trial in the District Court Litigation is scheduled to begin on March 23, 2026, over **five** months before the statutory deadline for issuing a Final Written Decision in this matter on September 10, 2026.¹ The Board has found that scheduled jury selection even three and a half months before the statutory deadline to weigh in favor of denying institution. *See Int'l Business Machines Corp. v. Digital Doors, Inc.*, IPR2023-00969, Paper 8, at 10-11 (P.T.A.B. Dec. 5, 2023).

Rather than looking at the actual date trial is scheduled, the Petition relies on the median time from filing to case disposition in the Eastern District of Texas. Pet. 9-10. The Petition fails to provide any rationale or support for rejecting the actual trial date and only speculates the trial date “could get pushed back.” *Id.*; *see Dell Inc. v. Universal Connectivity Techs., Inc.*, IPR2024-01480, Paper 12, at 9 (P.T.A.B. Apr. 24, 2025) (“We are not persuaded by Petitioner’s unsupported argument that the trial date is speculative.”).

¹ Petitioners’ reliance on July 2026 as the Final Written Decision date in their Petition is incorrect. *See* 35 U.S.C. §316(a)(11) (requiring that the final determination in an inter partes review be issued not later than 1 year after the date on which the Director notices the institution).

Regardless, the statistics similarly favor discretionary denial. Petitioners contend a theoretical trial date based on statistics would occur around May 2026. Pet. 10. Even the theoretical trial date precedes the statutory deadline for issuing a Final Written Decision by **four** months.

Eastern District of Texas	Trial Date	Months before FWD (Sept. 10, 2026)
Docket Control Order	March 23, 2026	More than five months
US Courts Statistics	May 2026	Approximately four months

Given that the actual and “statistical” trial dates are **well before** the due date for the Final Written Decision, the second factor strongly favors discretionary denial. *See Dell Inc.*, Paper 12, at 10 (finding this factor “strongly favors exercising discretionary denial” when both scheduled and statistical trial dates preceded expected final written decision date by several months); *Charter Comms., Inc. v. Adaptive Spectrum & Signal Alignment, Inc.*, IPR2024-01379, Paper 16, at 10-11 (P.T.A.B. Apr. 17, 2025) (finding this factor favors exercising discretionary denial when “regardless of which trial date estimate is considered, they all provide for a trial date months before a projected statutory deadline for a final written decision in this proceeding”).

3. Significant Investment In The Parallel Proceeding (Factor 3)

The parties’ and the court’s investment in the parallel District Court Litigation **weighs heavily in favor of discretionary denial**. This factor is judged from the date

of the institution decision, which is expected to be no later than September 10, 2025.

Fintiv, Paper 11 at 9.

By the time of the institution decision, fact discovery will be complete on August 7, 2025, and opening expert reports will have been served on August 28, 2025, after substantial expense and effort by counsel and experts on both sides. EX2003 (First Amended Docket Control Order) at 4; EX2004 (Order Resetting *Markman*) at 1. Further, the District Court conducted a *Markman* hearing on May 9, 2025, issued preliminary claim constructions, and invested many hours in reviewing parties' arguments and issuing numerous rulings on Petitioners' motions to dismiss and the parties' other various motions. EX2003 (First Amended Docket Control Order) at 4. As another example, the parallel District Court has already considered and denied a motion to transfer to the Northern District of California, and a district court in the Northern District of California has already dismissed a related declaratory judgment action filed by Petitioners' subsidiary, Optoma Technology, Inc. EX2005 (Order Denying Motion to Transfer in the parallel District Court Litigation); EX2006 (Order Granting Motion to Dismiss in N.D. Cal.). This extensive activity shows a significant investment by both the parties and the courts. *See Motorola Sols., Inc., v. Stellar, LLC*, IPR2024-01205, IPR2024-01206, IPR2024-01207, IPR2024-01208, Paper 19, at 3 (P.T.A.B. Mar. 28, 2025) (finding "substantial time and effort" invested by parties and the district court, where the

district court held a claim construction hearing, parties had served extensive infringement and invalidity contentions, parties had served opening expert reports, and conducted several depositions).

The Petition was filed on January 17, 2025. At that time, Petitioners asserted that “[t]he court proceeding is at an early stage, with relatively little investment from the court and parties.” Pet. 10. Patent Owner disagrees, but Petitioners’ characterization about the state of affairs in January is irrelevant. As explained in *Fintiv*, the investment in the District Court Litigation by the District Court and the parties is judged from the date of the anticipated institution decision, which is expected to be about September 10, 2025, not January 17, 2025. *Fintiv*, Paper 11 at 9. As presented above, the District Court and the parties will have made a substantial investment in the District Court Litigation. As explained, the parties have already done so, and those investments will continue to compound in the four months between now and the due date for an institution decision. This *Fintiv* factor strongly weighs in favor of denial.

4. There Is Significant Overlap Between Issues Raised In The Petition And In The District Court Litigation (Factor 4)

The issues in this proceeding are substantially the same as in the District Court Litigation. Here, Petitioners assert that Claims 8, 10, and 12 of the '226 Patent are unpatentable. Pet. 2. These claims fully overlap with the claims asserted by Maxell

against Petitioners in the District Court Litigation. EX2007 (Plaintiff's Preliminary Election of Asserted Claims) at 1. Furthermore, the references that Petitioners rely upon in supporting its Petition include substantially the same references Petitioners rely upon to challenge the validity of the '226 Patent in the District Court Litigation. These references are explicitly listed in Petitioners' (as Defendants) own Invalidity Contentions served in the district court case on December 27, 2024. EX2008 (Petitioners' Invalidity Contentions) at 8.

Petitioners make a half-hearted attempt at a *Sotera* stipulation, claiming that "Petitioners stipulate that they will not pursue the grounds identified in this Petition before the district court." This is not a *Sotera* stipulation, and the statement does nothing to mitigate concerns regarding "potentially conflicting decisions and duplicative efforts between the district court and the PTAB." *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, at 18-19 (P.T.A.B. Dec. 1, 2020).

Indeed, near-identical attempts have been given little weight by the Board when considering *Fintiv* Factor 4. *See, e.g., Samsung Elecs. Co. v. Cal. Inst. of Tech.*, IPR2023-00130, Paper 10, at 19-20 (P.T.A.B. May 4, 2023) (denying institution of petition that included stipulation "broader to some degree than the stipulation discussed in *Sand Revolution*"); *Roku, Inc. v. IOENGINE, LLC*, IPR2022-01554, Paper 11, at 14 (P.T.A.B. May 5, 2023) (denying institution of petition that "falls far short of a *Sotera*-type stipulation that would bar [Petitioner] from pursuing any

grounds in the parallel district court proceeding that could have reasonably been raised before the Board”).

Petitioners’ attempted “stipulation” purports to forego only a substantive overlap of the IPR prior art grounds in the District Court Litigation. Yet the parties would still be left with duplicative efforts in the District Court Litigation because the Court would still make determinations regarding the references cited in the Petition. EX2008 (Petitioners’ Invalidity Contentions) at 18. For example, the following annotated tables show which grounds in the District Court Litigation involve the same references at issue in this Petition (red box) and which ground would be cover the same combination of references by Petitioners’ stipulation (greyed out). *Id.* at 18 (annotated; “Miyamae” reference no longer being asserted by Petitioners in the District Court Litigation); *see also* EX2009 at 2-3 (Petitioners’ Preliminary Asserted Prior Art).

'226 Patent		
Asserted Claim(s)	Prior Art Combination	Claim Chart
Claims 8, 10 and 12	Claims 8, 10 and 12 are unpatentable under 35 U.S.C. § 103(a) as obvious over Hirata '999 in view of Kurosaki '087.	Exhibit E Ground 1
Claim 12	Claim 12 is unpatentable under 35 U.S.C. § 103(a) as obvious over Miyamae in view of Kurosaki '087.	Exhibit E Ground 2
Claims 8, 10 and 12	Claims 8, 10 and 12 are unpatentable under 35 U.S.C. § 103(a) as obvious over Kitano '471 in view of Kurosaki '087.	Exhibit E Ground 3
Claims 8 and 10	Claims 8 and 10 are unpatentable under 35 U.S.C. § 103(a) as obvious over Hirata '999 in view of Masuda.	Exhibit E Ground 4
Claim 12	Claim 12 is unpatentable under 35 U.S.C. § 103(a) as obvious over Hirata '999 in view of Masuda and Kurosaki '087.	Exhibit E Ground 4
Claims 8, 10 and 12	Claims 8, 10 and 12 are unpatentable under 35 U.S.C. § 103(a) as obvious over Kitano '471 in view of Masuda.	Exhibit E Ground 5
Claims 8 and 10	Claims 8 and 10 are unpatentable under 35 U.S.C. § 103(a) as obvious over Akiyama '904 in view of Hirata '999.	Exhibit E Ground 6
Claim 12	Claim 12 is unpatentable under 35 U.S.C. § 103(a) as obvious over Akiyama '904 in view of Hirata '999 and Kurosaki '087.	Exhibit E Ground 6(a)
Claim 12	Claim 12 is unpatentable under 35 U.S.C. § 103(a) as obvious over Akiyama '904 in view of Hirata '999 and Kitano '471.	Exhibit E Ground 6(b)
Claims 8 and 10	Claims 8 and 10 are unpatentable under 35 U.S.C. § 103(a) as obvious over Akiyama '904 in view of Miyamae.	Exhibit E Ground 7
Claim 12	Claim 12 is unpatentable under 35 U.S.C. § 103(a) as obvious over Akiyama '904 in view of Miyamae and Kurosaki '087.	Exhibit E Ground 7(a)
Claim 12	Claim 12 is unpatentable under 35 U.S.C. § 103(a) as obvious over Akiyama '904 in view of Miyamae and Kitano '471.	Exhibit E Ground 7(b)

As seen above, both the Board and District Court would make determinations regarding on the same references regardless of Petitioners' stipulation. The Board and District Court will also be make determinations based on the *same* combination of references despite Petitioners' stipulation. For example, Ground 3 in the District Court Litigation includes a combination of Kitano '471 and Kurosaki '087 for claims 8, 10, and 12. This is the exact ground at issue in this Petition as Ground 4. Pet. 12. Ground 2 in the District Court Litigation uses Kurosaki '087 as the only reference

for § 103(a). This is the exact use of Kurosaki '087 for the same claim is at issue in this Petition as Ground 1. Pet. 12.

Thus, Petitioners' statement (Pet. 11) that "[t]here will be no overlap of issues between the two proceedings" is false.

This factor strongly favors denial of institution because the Petition is directed toward the same patent, encompasses the claims at issue in the parallel District Court Litigation, involves overlapping prior art and arguments, and does not seek to mitigate concerns regarding duplicative efforts or potentially conflicting decisions via a *Sotera* stipulation.

5. The District Court Litigation And The Petition Involve The Same Parties (Factor 5)

As noted in Patent Owner's Mandatory Notice, there exists a parallel District Court Litigation between the same parties regarding the same subject patent (the '226 Patent). Petitioners are both parties to the District Court Litigation. Accordingly, this factor weighs in favor of discretionary denial. *See Sotera*, IPR2020-01019, Paper 12 at 19 (stating that this factor supports denying institution when the "parties are the same in the *inter partes* proceeding and in the parallel proceeding"). Petitioners' assertion that *Fintiv* factor five is neutral based on these facts is unsupported. *See id.*

6. Other Factors Favor Discretionary Denial (Factor 6)

The challenges set forth in the Petition are flawed. For example, the Petition extensively relies on an expert declaration that largely parrots verbatim the wording of the Petition. EX1004; *see also infra* Section IV.C.3.

Although Petitioners filed the Petition prior to the statutory deadline (July 2025), they did not do so as quickly as they might have. Indeed, rather than prioritize this proceeding, Petitioners filed three motions to dismiss (including two based on invalidity) in the District Court Litigation, a motion to transfer venue, and a declaratory judgment action. Plainly, the Petition was not a priority for Petitioners. This factor is (at best) neutral.

B. Application of 35 U.S.C. § 325(d) Weighs In Favor Of Denying Institution

The Petition should be denied pursuant to 35 U.S.C. § 325(d) because the Petition improperly seeks reconsideration of validity based on art and arguments already reviewed by the Office. Under the framework established in *Advanced Bionics*, denial is warranted where “(1) the same or substantially the same prior art was previously presented to the Office or (2) the same or substantially the same arguments were previously presented to the Office.” *Advanced Bionics*, IPR2019-01469, Paper 6 at 8 (P.T.A.B. Feb. 3, 2020) (precedential). “Previously presented art includes art made of record by the Examiner, and art provided to the Office by an

applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent.” *Id.* at 7-8. Further, the Board has construed “previously presented” in 35 U.S.C. § 325(d) to refer to art and arguments presented to the Office prior to the filing of the petition at issue. *Ironsource Ltd. v. Digital Turbine Inc.*, PGR2021- 00096, Paper 14 at 52 (P.T.A.B. Jan. 6, 2022). If this condition regarding prior presentation is met, the Board then considers whether the petitioner has demonstrated material error by the Office. *Advanced Bionics*, Paper 6 at 8.

Here, the first part of the framework is satisfied because the Petition relies on a reference—Kitano—that was previously presented to the Office during prosecution of the ’226 Patent. The remaining references—Kurosaki and Miyamae—are cumulative to art already considered during the prosecution of the ’226 Patent. Furthermore, Petitioners fail to meet the second part of the framework, as Petitioners are entirely silent regarding how the Office materially erred in allowing the ’226 Patent claims. Because the Petition relies on previously presented or cumulative art and fails to demonstrate material error, denial is appropriate. *See Albany Int’l Corp. v. Kimberly-Clark Worldwide, Inc.*, PGR2021- 00019, Paper 22 at 8-9 (P.T.A.B. June 22, 2021) (denying institution because “[i]f a condition in the first part of the framework is satisfied and the petitioner fails to

make a showing of material error, the Director generally will exercise discretion not to institute review.”)

1. The Same Or Substantially The Same Art Was Previously Presented To The Office

The first part of the *Advanced Bionics* framework is met because a prior art reference (Kitano) underpinning Petitioners' ground four was considered during the prosecution of the '226 Patent. *See Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (Feb. 13, 2020).

Additionally, substantially the same art was previously presented to the Examiner because the remaining references—Kurosaki and Miyamae—are cumulative to prior art considered during the prosecution of the '226 Patent. *See* EX1002 (Prosecution History of the '226 Patent). Although the examiner did not specifically discuss Matsubara and Kurosaki '632 (to which Kurosaki '087 and Miyamae are cumulative) in the office actions, the Examiner's consideration of Matsubara and Kurosaki '632 during the prosecution history should be given the same weight as Kitano. *See Clim-A-Tech Ind., Inc. v. William A. Ebert*, IPR2017-01863, Paper 13 at 18-19 (P.T.A.B. Feb. 12, 2018) (denying institution even though the 'Examiner did not base a rejection' on the reference asserted in the petition); *Biocon Pharma Ltd. v. Novartis Pharm. Corp.*, IPR2020-01263, Paper 12 at 9 (P.T.A.B. Feb. 16, 2021) (holding that cited but unapplied references supported

denying institution); *Sony Interactive Entm't LLC v. Terminal Reality, Inc.*, IPR2020-00711, Paper 15 at 11 (P.T.A.B. Oct. 13, 2020) (finding reference was previously considered by the PTO because it was listed in the Examiner's Notice of References Cited); *Agrinomix, LLC v. Mitchell Ellis Prods., Inc.*, IPR2017-00525, Paper 6 (P.T.A.B. Jun. 14, 2017) (denying institution for grounds based on prior art that was considered during prosecution even though the prior art reference was not relied upon to reject all the challenged claims).

a. Kitano

Petitioners' main reference for Ground 4—Kitano (EX1007)—was previously presented to and considered by the Examiner during prosecution of the '226 Patent. Petitioners acknowledges that “Kitano was cited and considered by the Examiner during prosecution of the '226 Patent,” Pet. 50, fulfilling the threshold requirement for § 325(d) because art considered by the Examiner during prosecution constitutes art “previously presented to the Office” under § 325(d). *See Advanced Bionics*, Paper 6 at 7-9.

Kitano was considered by the Examiner under pre-AIA 35 U.S.C. § 102 and under pre-AIA 35 U.S.C. § 103 alongside Okamoto (U.S. Pub. No. 2011/0128505) and Masuda (U.S. Pub. No. 2010/0328628) (EX2010).

Notice of References Cited	Application/Control No. 14/439,931	Applicant(s)/Patent Under Reexamination KIMURA ET AL.	
	Examiner DANELL L. OWENS	Art Unit 2882	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	CPC Classification	US Classification
*	A	US-2013/0088471 A1	04-2013	KITANO; Hiroshi	H04N9/3114	345/208
*	B	US-2011/0128505 A1	06-2011	OKAMOTO; Junichi	G02B27/102	353/31
*	C	US-2010/0328628 A1	12-2010	MASUDA; Hiroki	G02B26/008	353/85
	D	US-				
	E	US-				
	F	US-				
	G	US-				
	H	US-				
	I	US-				
	J	US-				
	K	US-				
	L	US-				
	M	US-				

EX1002 at 63.

The Examiner issued a non-final office action on June 23, 2016. Claims 1, 6, 7, 9, 11, 14, 15, and 18 were rejected under pre-AIA 35 U.S.C. 102(e) as being anticipated by Kitano.

3. Claims 1, 6, 7, 9, 11, 14, 15 and 18 are rejected under pre-AIA 35 U.S.C. 102(e) as being anticipated by Kitano (US PG Pub. 20130088471).

EX1002 at 53.

The Examiner's non-final rejection mapped the elements of the art against elements of Claims 1, 6, 7, 9, 11. The Examiner also found that Claim 14 requires a

slightly different but similar structure as Claim 9, and Claim 18 requires a slightly different but similar structure as Claim 1. EX1002 at 53-58.

The Examiner's non-final office action on June 23, 2016 also addressed pre-AIA 35 U.S.C. 103. Claims 10 and 17 were rejected as being unpatentable over Kitano in view of Okamoto. Claims 19 and 20 were rejected as being unpatentable over Kitano in view of Masuda.

5. Claims 10 and 17 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Kitano in view of Okamoto (US PG Pub. 20110128505).

EX1002 at 58.

6. Claims 19 and 20 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Kitano in view of Masuda (US PG Pub. 20100328628).

EX1002 at 59.

The Examiner's non-final rejection mapped Kitano and Okamoto against elements of Claims 10 and 17 and mapped Kitano and Masuda against elements of Claims 19 and 20. EX1002 at 58-60.

Upon amendments of Claims 1, 9 and 13, the Examiner allowed Claims 1, 6, 8, 9, 10, 13-15 and 17-20. EX1002 at 4. The examiner found that Kitano—"the closest available prior art"—"fails to teach or render obvious an excitation light

source for emitting excitation light with an optical member for directing the excitation light to the fluorescent material,” wherein an area of the luminance distribution of the excitation light irradiated onto the fluorescent material. EX1002 at 4-6. Specifically, the Examiner found Claim 9 (issued as Claim 8 which the Petitioners challenge) to be allowable for the following reason:

4. Claim 9 was found to be allowable because an optical member for directing the excitation light to the fluorescent material, and the optical member has a curvature that is set such that a light-condensing position of the excitation light is positioned on an emission side of the excitation light relative to the fluorescent material a dichroic mirror disposed between the excitation light source and the fluorescent material and a condenser lens for condensing the excitation light disposed between the fluorescent material and the dichroic mirror, wherein the optical member is disposed between the excitation light source and the dichroic mirror, and wherein the optical member is a convex lens and a concave lens, with the convex lens and the concave lens being disposed in this order from the excitation light source toward the dichroic mirror.

EX1002 at 4-5.

Petitioners' combination of Kitano with Kurosaki '087 is substantially the same art that was previously presented to the office as Kitano was already considered as demonstrated above and Kurosaki '087 is cumulative to art already considered during the prosecution as demonstrated as discussed in Section IV.B.1.b. Additionally, as addressed in Section IV.C.3, the Declaration of Dr. Sasian is

presented without sufficient independent analysis, supporting data, or reasoning grounded in specific evidence beyond the Petition's attorney argument. This also supports denial of institution of this Petition. *See* 37 C.F.R. § 42.65(a) ("Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.")

Because the primary reference for Ground 4 was previously presented and considered, the current challenge is duplicative. Ground 4 should be denied under § 325(d).

b. Kurosaki '087

Petitioners use Kurosaki '087 (EX1005) as the primary reference of Ground 1 and in combination for Grounds 3 and 4. Kurosaki '087 is cumulative of art previously considered by the Office during prosecution, such as Matsubara (EX2011) and Kurosaki '632 (EX2012). Both Matsubara and Kurosaki '632 are listed in the Information Disclosure Statements; the Examiner considered them in allowing the Challenged Claims of the '226 Patent as both Matsubara and Kurosaki '632 are not "lined through." *See* EX1002 at 64-65.

Patent No. 9,547,226

Brief in Support of Patent Owner's Request for Discretionary Denial

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number		
	Filing Date		2015-04-30
	First Named Inventor	Nobuyuki KIMURA	
	Art Unit		
	Examiner Name		
	Attorney Docket Number		HITACHI5-211250474US01

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Examiner Initial*	Cite No	Patent Number	Kind Code ¹	Issue Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear		
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Examiner Initial*	Cite No	Publication Number	Kind Code ¹	Publication Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear		
	1	20130222772	A1	2013-08-29	Masateru MATSUBARA			
	2	20100328632	A1	2010-12-30	Kurosaki et al.			
	3	20110280032	A1	2011-11-17	Katsuhiko KISHIMOTO			
If you wish to add additional U.S. Published Application citation information please click the Add button.							Add	
FOREIGN PATENT DOCUMENTS							Remove	
Examiner Initial*	Cite No	Foreign Document Number ³	Country Code ² j	Kind Code ⁴	Publication Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear	T ⁵
	1	2012/066654	WO	A1	2012-05-24	NEC DISPLAY SOLUTIONS, LTD.	Equivalent to US Publication No. 2013/0222772.	☒

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ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH Petitioner Ex 1002 064

EX1002 at 64 (annotated).

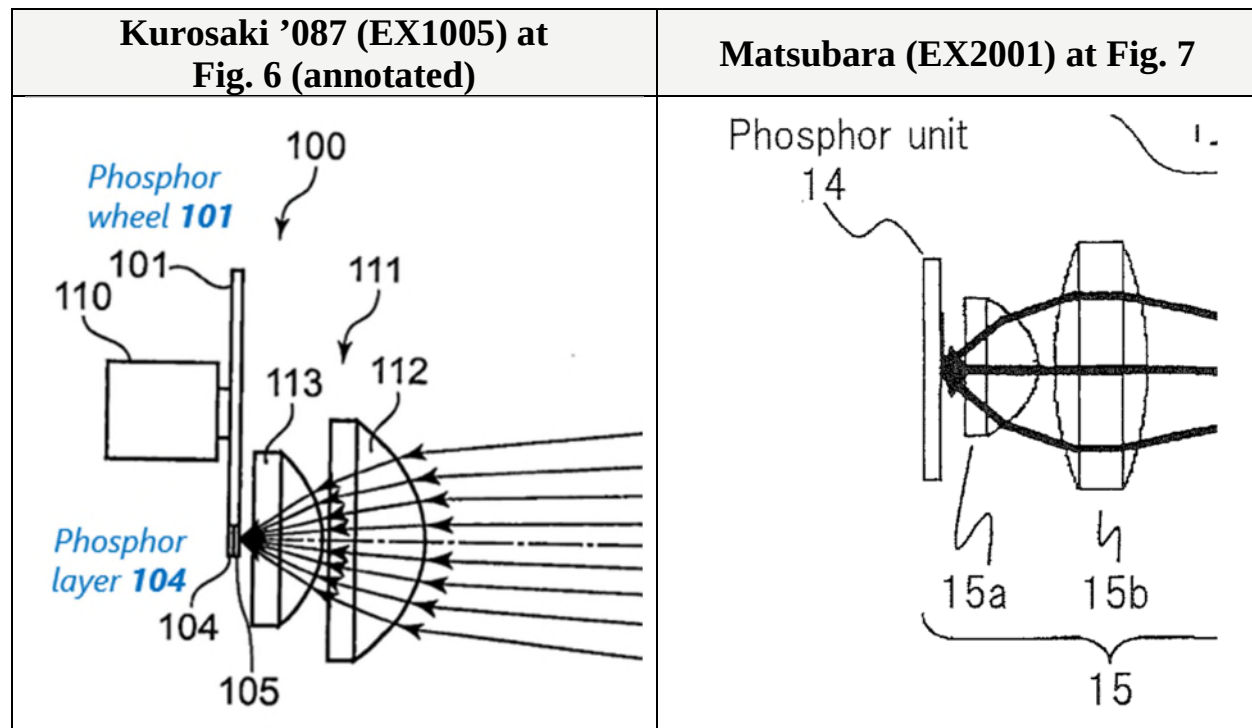
Kurosaki '087 generally discloses a light source device with a phosphor wheel that allows to provide a high-luminance light that is simple in structure and low in manufacturing cost. *See* EX1005 at 1, 14. Similarly, Matsubara also generally discloses a compact and low-cost light source apparatus with a phosphor unit (i.e., a phosphor wheel) that prevents the reduction of the optical utilization efficiency. *See* EX2011 at [0001], [0013], [0073].

The '226 Patent (and specifically the Challenged Claims) overcame issues related to high luminance in the center of the irradiation region that caused the fluorescent material to generate excessive heat that reduced the fluorescent material's efficiency and lifespan through re-arrangements of the optical members. EX1001 at 1:46-62; 2:58-3:3.

The disclosures in Kurosaki '087 do not introduce any substantial differences compared to the disclosures in Matsubara concerning the phosphor wheel/unit and the phosphor layer (i.e., fluorescent material), which the Examiner evaluated when allowing the Challenged Claims of the '226 Patent. Kurosaki '087 provides an example of illumination distribution of excitation lights on the phosphor layer including details in size and shape of such area. EX1005 at 5:66-6:21; Fig. 5. Matsubara also provides schematic representations of region of the phosphor unit that is irradiated by excitation light, *see* EX2011 (Matsubara) at [0074]-[0085], Fig. 3A-3H, and describes calculation of maximum utilization efficiency on irradiated

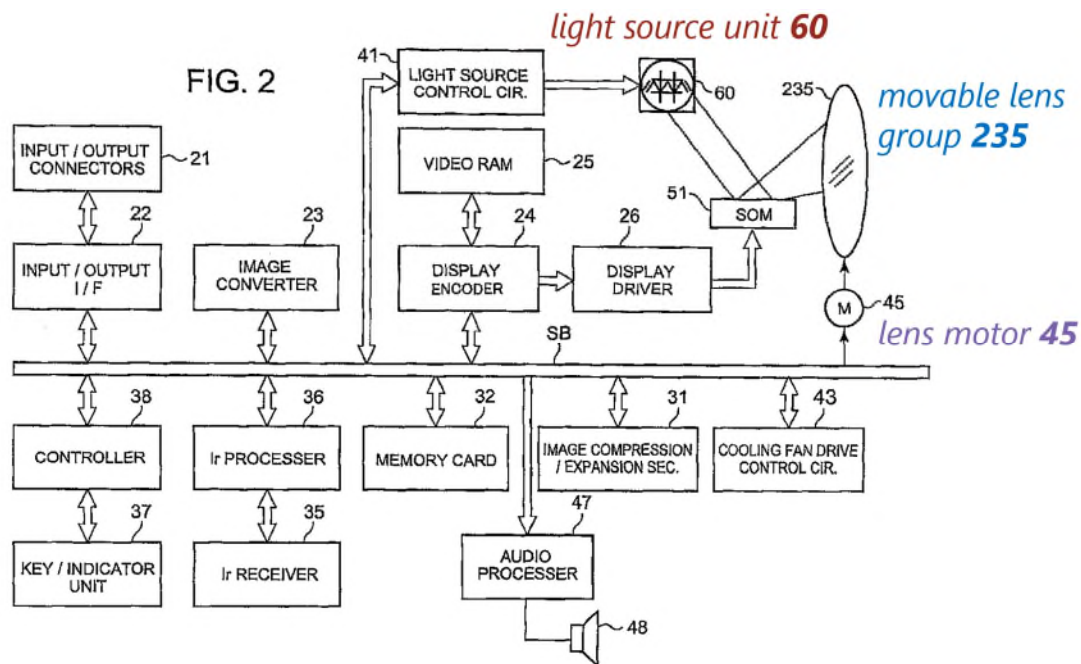
regions of the phosphor unit including details regarding the size of such irradiation region. See EX2011 (Matsubara) at [0086], Fig. 4.

Moreover, as demonstrated below, both Kurosaki '087 and Matsubara include similar and analogous structures of the lenses and phosphor unit/wheel.

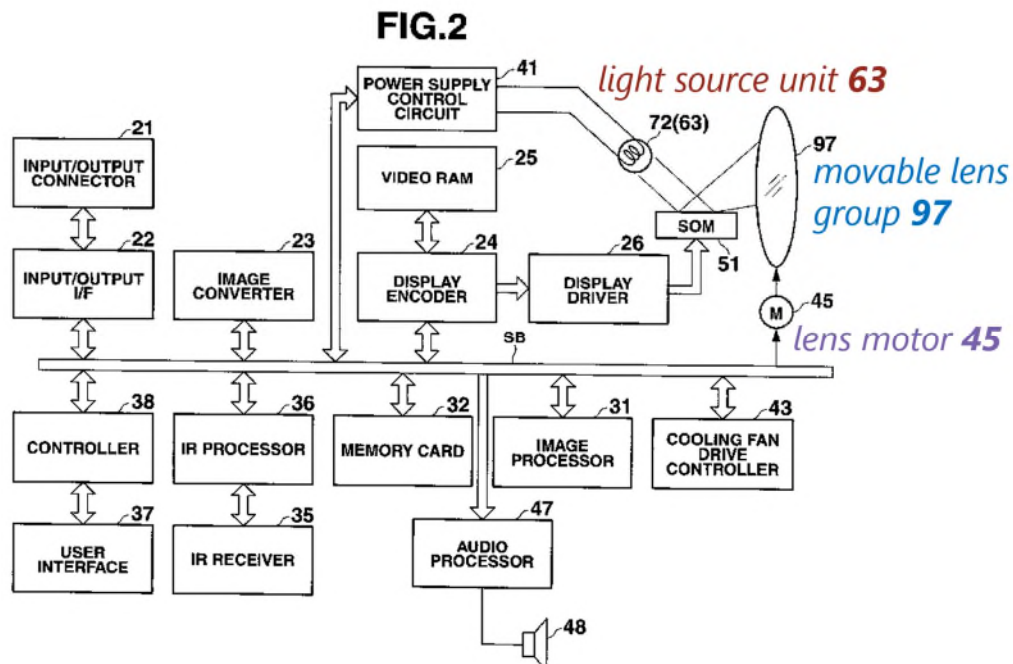


Additionally, Kurosaki '087 (EX1005) and Kurosaki '632 (EX2012) share a common inventor (Kurosaki) and both disclose similar light source devices featuring analogous components, configurations, and circuit blocks. For instance, both embodiments in Kurosaki '087 (EX1005) and Kurosaki '632 (EX2012) also include fluorescent wheel (*i.e.*, phosphor wheel) wherein excitation light (e.g., blue light source) interacts with the fluorescent material to reflect fluorescent light. And, both

embodiments in Kurosaki '087 (EX1005) and Kurosaki '632 (EX2012) have almost identical circuit blocks as shown below:



Kurosaki '087 (EX1005) at Fig. 2



Kurosaki '632 (EX2012) at Fig. 2

Thus, Kurosaki '087's disclosures add nothing new to what was already encompassed by the art and arguments considered during prosecution. Because substantially the same prior art as the primary reference for Ground 1 was previously presented and considered, the current challenge is duplicative. Ground 1 should be denied under § 325(d). Combinations involving Kurosaki '087 in Grounds 3 and 4 also do not present art or arguments that are materially different from what the Office had already considered, further supporting denial of Grounds 3 and 4 under § 325(d).

c. Miyamae

Petitioners use Miyamae (EX1006a, EX1006b, EX1006c) as the primary reference for Grounds 2 and 3. Miyamae is cumulative to art cited and considered by the Examiner during prosecution of the '226 Patent, such as Matsubara (EX2011) and Masuda (EX2010). Matsubara is listed in the Information Disclosure Statements; the Examiner considered it in allowing the Challenged Claims of the '226 Patent as Matsubara is not "lined through." See EX1002 at 64-65. Masuda is in the Notice of References Cited, and was considered by the Examiner and specifically mentioned in the non-final office action. EX1002 at 59-60, 63.

Patent No. 9,547,226

Brief in Support of Patent Owner's Request for Discretionary Denial

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number		
	Filing Date		2015-04-30
	First Named Inventor	Nobuyuki KIMURA	
	Art Unit		
	Examiner Name		
	Attorney Docket Number		HITACHI5-211250474US01

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	3	20110280032	A1	2011-11-17	Katsuhiko KISHIMOTO			
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Examiner Initial*	Cite No	Foreign Document Number ³	Country Code ² j	Kind Code ⁴	Publication Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear	T ⁵
	1	2012/066654	WO	A1	2012-05-24	NEC DISPLAY SOLUTIONS, LTD.	Equivalent to US Publication No. 2013/0222772.	☒

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ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH Petitioner Ex 1002 064

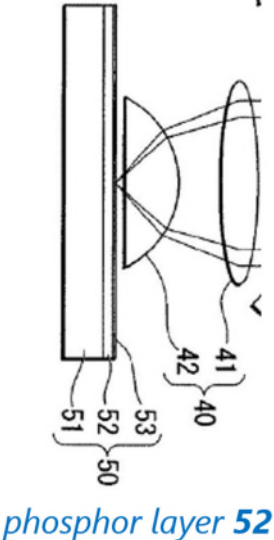
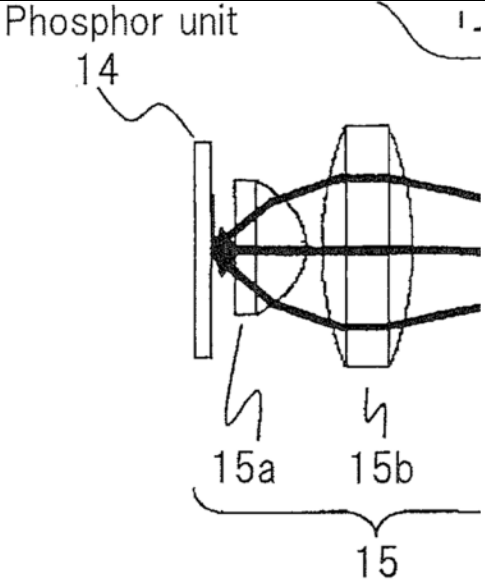
EX1002 at 64 (annotated).

Notice of References Cited		Application/Control No. 14/439,931		Applicant(s)/Patent Under Reexamination KIMURA ET AL.	
		Examiner DANELL L. OWENS		Art Unit 2882	Page 1 of 1

U.S. PATENT DOCUMENTS						
*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	CPC Classification	US Classification
*	A	US-2013/0088471 A1	04-2013	KITANO; Hiroshi	H04N9/3114	345/208
*	B	US-2011/0128505 A1	06-2011	OKAMOTO; Junichi	G02B27/102	353/31
*	C	US-2010/0328628 A1	12-2010	MASUDA; Hiroki	G02B26/008	353/85
	D	US-				
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	K	US-				
	L	US-				
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EX1002 at 63.

Miyamae generally discloses a light source device that improves luminous efficiency of a phosphor. *See* EX1006b at 3. Matsubara also generally discloses a light source apparatus with a phosphor unit (i.e., a phosphor wheel) that prevents the reduction of the optical utilization efficiency. *See* EX2011 (Matsubara) at [0001], [0013], [0073]. Additionally, as demonstrated below, both Miyamae and Matsubara include similar and analogous structures of the lenses and phosphor unit/wheel.

Miyamae (EX1006b) at Fig. 3 (annotated)	Matsubara (EX2011) at Fig. 7
	

Further, Masuda (EX2010), as also found in Miyamae, discloses a light source unit with an optical wheel (i.e., a phosphor wheel). See EX2010 at Abstract. Both Miyamae and Masuda discusses how the wavelength of the light changes when the excitation light is incident on the fluorescent material. *Compare e.g.*, EX1006b at [0099]-[0103] (discussing how the wavelength of the light changes when the light hits a phosphor layer) *with e.g.*, EX2010 (Masuda) at Figs. 7A, 7B, [0078] (demonstrating through graphs the peaks of an emission spectrum wavelengths once the light hits the optical wheel (i.e., fluorescent material)).

As such, Miyamae's disclosure is substantially the same art previously presented to the Office because Miyamae is cumulative to Matsubara and Masuda. Because substantially the same arts to the primary reference to Grounds 2 and 3 were

previously presented and considered, current challenge is duplicative. Grounds 2 and 3 should be denied under § 325(d).

2. Petitioners Fails To Demonstrate A Material Error By The Office

Petitioners entirely fail the second part of the *Advanced Bionics* framework because Petitioners did not show the Examiner materially erred in allowing the '226 Patent claims over the previously presented or cumulative art. *See* Pet. at 8-11. In fact, Petitioners make **no** argument regarding error that would be material to the patentability of challenged claims.² *See* Pet. at 8-11.

Accordingly, for reasons stated above, the petition should be denied pursuant to 35 U.S.C. § 325(d).

C. ADDITIONAL FACTORS SET FORTH IN THE MEMORANDUM SUPPORT DISCRETIONARY DENIAL

Beyond the established frameworks of 35 U.S.C. § 325(d) and 35 U.S.C. § 314(a), the Memo clarifies that the Director may weigh additional considerations relevant to fairness and efficiency. Such considerations further support denying institution here.

² The only error that was mentioned in the entirety of the Petition was a claim listing error—discussed in the context of the '226 Patent's prosecution history. *See* Pet. at 7.

1. Strength of Unpatentability Challenge: Petitioners Fail to Provide Sufficient Rationale for Asserted Combinations

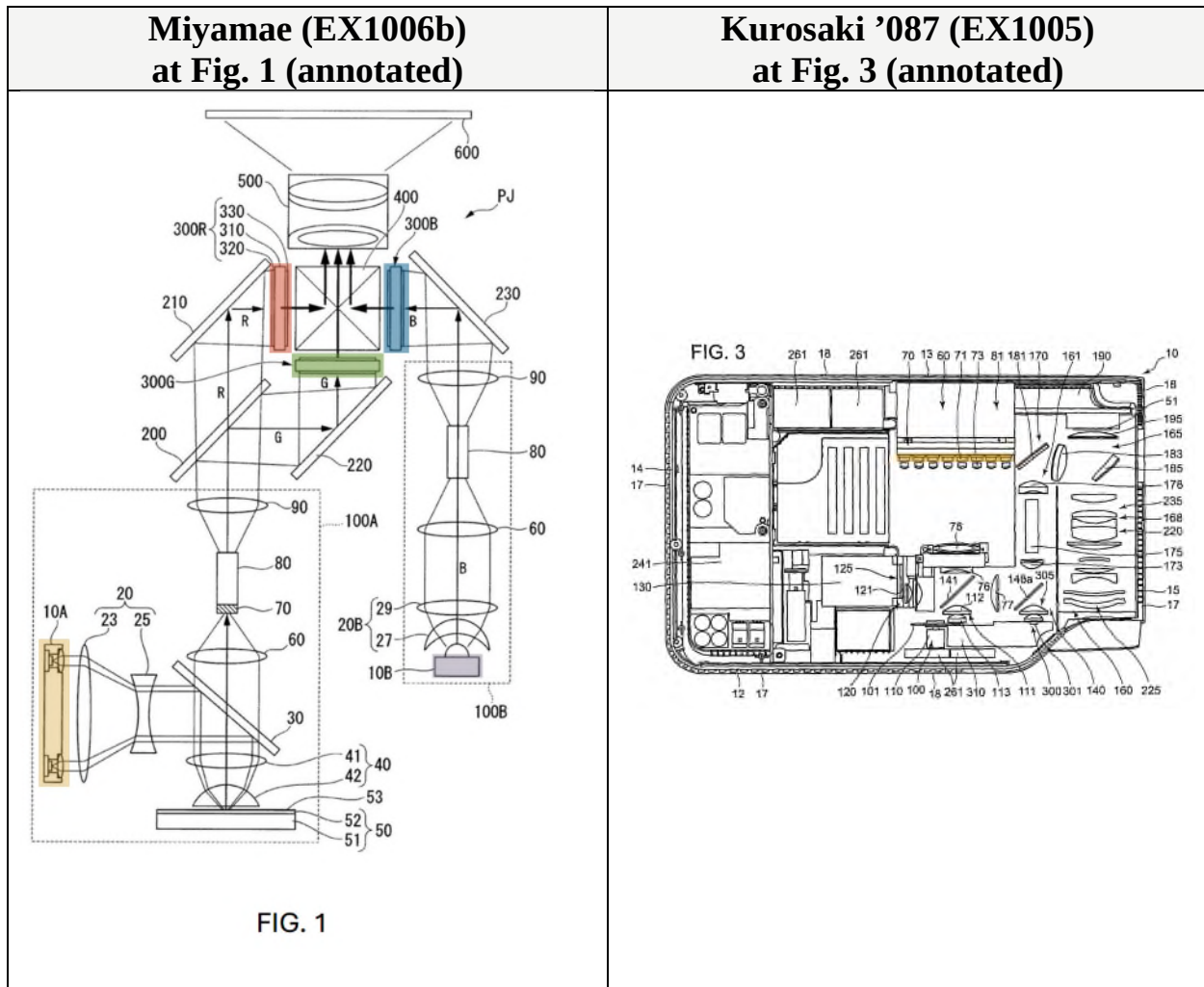
a. Ground 3: Miyamae and Kurosaki '087

Petitioners must provide evidence of sufficient rationale for its proposed combinations. *Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 993-994 (Fed. Cir. 2017). However, Petitioners fail to meet this burden for Ground 3 in the Petition because Petitioners' alleged motivations fail to meet Petitioners' "burden to explain specifically how the references would be combined to produce the claimed invention." *Lowe's Home Centers, LLC v. Epistar Corp.*, IPR2018-00932, Paper 7 at 19 (P.T.A.B. Nov. 1, 2018).

For example, Petitioners contend that a "combination of Miyamae and Kurosaki ['087] would have been a simple substitution of light source of Kurosaki ['087] for the light source of Miyamae." Pet. 48. Yet, such substitution of light sources would not have been "simple" because the remainder of the structures for both Miyamae and Kurosaki '087 are designed specifically for its specific light source(s). *Compare, e.g.*, EX 1006b (Miyamae) at Fig. 1 with EX 1005 (Kurosaki '087) at Fig. 3.

Further, Miyamae includes two separate and different types of light sources that are located at two separate parts of the projector—(1) laser light source array 10A and (2) Light Emitting Diode (LED) light source 10B; these combination of

laser and LED light sources are designed to work with liquid crystal light valves 300R, 300G, and 300B. See EX1006b (Miyamae) at Fig. 1. In contrary, Kurosaki '087 does not include the LED light sources and only includes one type of light source (i.e., laser) where the laser diodes are “arranged at regular intervals and in rows and columns in a plane and their optical axes 71a are parallel with each other.” See EX1005 (Kurosaki '087) at 12:55-58 with Fig. 7; see also *id.* at Fig. 3.



Petitioners do not identify which specific component of Miyamae's light source would be subject to "a simple substitution of light source of Kurosaki '087"—whether the laser light source 10A would be replaced with a light source of Kurosaki '087 or the LED light source of 10B would be replaced with light source of Kurosaki '087. *See* Pet. 47-48. This lack of specificity fails to meet Petitioners' burden to explain "how...the references would be combined to produce the claimed invention." *TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1066 (Fed. Cir. 2016); *In re Magnum Oil Tools Int'l, Ltd.*, 829 F. 3d 1364, 1380 (Fed. Cir. 2016) ("The petitioner must...articulate specific reasoning based on evidence of record, to support legal conclusion of obviousness").

Petitioners also provide no rationale regarding why there would be a motivation to incorporate the light source of Kurosaki '087 with Miyamae's system when the Miyamae already includes the laser light source. *See e.g., Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d at 994 (finding that even if skilled artisan, once presented with two references, would understand that the two references *could be* combined is not enough because obviousness concerns whether a skilled artisan *would have been motivated to make* the combinations or modifications of prior art to arrive at the claimed invention) (emphasis in original).

Not only do Petitioners fail to explain how such substitution would help to "obtain an efficient light source device," Petitioners' assertion of a "simple"

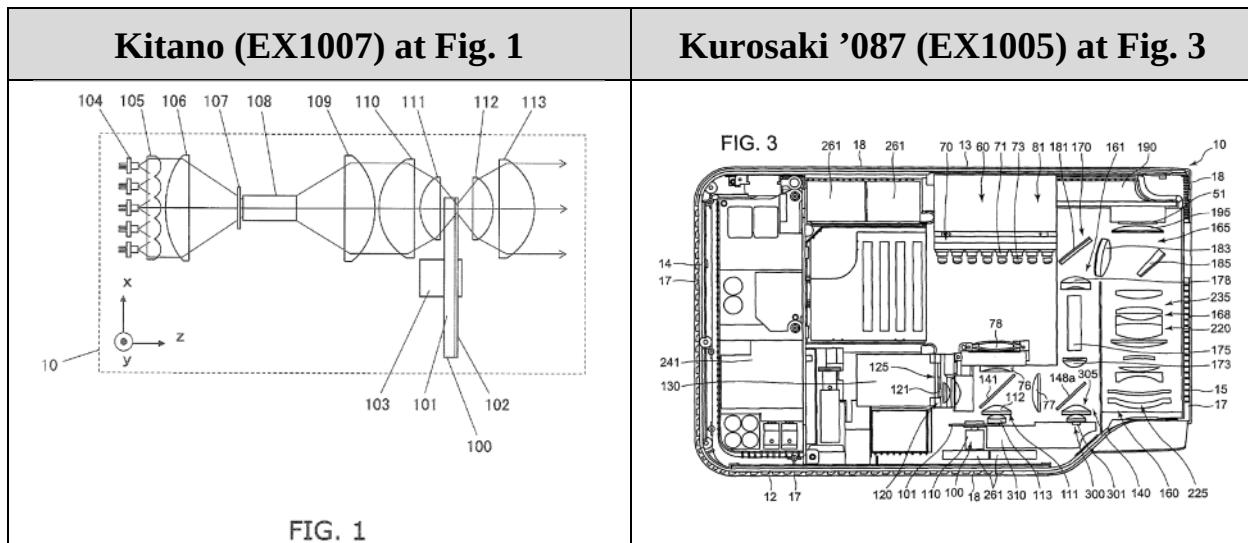
substitution fails to explain and support how a person of ordinary skill in the art would reasonably expect success in making that substitution of the light source. *See Schwendimann v. Neenah, Inc.*, 82 F.4th 1371, 1380 (Fed. Cir. 2023), *cert. denied sub nom. Schwendimann v. Neenah, Inc.*, 144 S. Ct. 1059, 218 L. Ed. 2d 241 (2024) (finding that the petitioner must demonstrate both that a skilled artisan would have been motivated to combine the prior art references and that there is a reasonable expectation of success in making such a combination).

Petitioners' analysis of Ground 3 is also deficient because Petitioner only relies on disclosures of Kurosaki '087 for dependent claim 12. Petitioners fail to assert, much less present supporting evidence, how the modified Miyamae in view of Kurosaki '087 would affect how the excitation light irradiated onto the fluorescent material. Nor do Petitioners present any evidence or argument how such a modified projector would meet claim 10 of the '226 Patent. Petitioners' conclusory statements are "insufficient articulations of motivations to combine" and thus Petitioners have failed to establish any reasonable likelihood of success in Ground 3. *See In re Nuvasive, Inc.*, 842 F.3d 1376, 1383 (Fed. Cir. 2016).

b. Ground 4: Kitano and Kurosaki '087

Petitioners suffer from similar shortcomings in demonstrating the motivation to combine Kitano and Kurosaki '087. For example, Petitioners fail to provide sufficient explanation as to why a person of ordinary skill in the art would have been

motivated to incorporate the combination of convex and concave lenses as taught by Kurosaki '087 when Kitano already discloses convex and concave lenses specifically designed for its system. *See* Pet. 55. Further, Kitano and Kurosaki '087 both include numerous types of lenses that are specifically arranged for each configuration. Petitioners' broad assertion to combine the two references never indicates which parts of the lenses the Petitioners are referring to in either reference. *Compare* EX1007 at Fig. 1, 3, 4, 7, 9, 10 with EX1005 at Fig. 3.



Kitano also already discloses a fluorescent wheel, yet Petitioners fail to explain why a person of ordinary skill in the art would be motivated to incorporate the fluorescent material of Kurosaki '087 with Kitano. *See id.*

Additionally, for example, even if “fluorescent-material (phosphor)-based light sources” of Kurosaki '087 are compatible with the system described in Kitano, Petitioners do not provide any further reasoning on whether a skilled artisan *would*

have been motivated to make the combinations or modifications of prior art to arrive at the claimed invention. *Personal Web.*, 848 F.3d at 994.

Petitioners' rationale that Kitano and Kurosaki '087 are in "the same field of endeavor" also does not provide sufficient evidence to support the motivation to combine. Pet. 55; *see Securus Techs., Inc. v. Global Tel*Link Corp.*, 701 F. App'x 971, 977 (Fed. Cir. 2017) ("a broad characterization of [references] as both falling within the same alleged field ... without more, is not enough for [Petitioners] to meet its burden of presenting a sufficient rationale to support an obviousness conclusion"). Petitioners' conclusory statements are "insufficient articulations of motivations to combine" and thus Petitioners have failed to establish any reasonable likelihood of success in Ground 4. *See In re Nuvasive, Inc.*, 842 F.3d at 1383.

2. Petitioners' Undue Delay and Gamesmanship

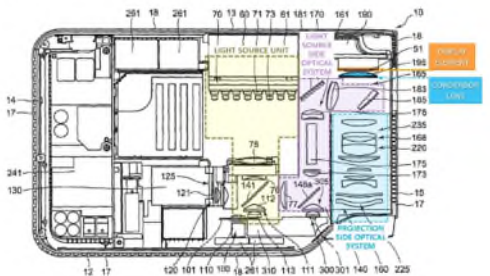
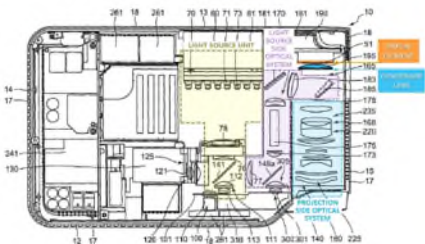
The Memo permits consideration of factors bearing on the efficient use of Board resources and potential abuse of process. Here, Petitioners waited nearly two years to file this Petition after first learning of Maxell's infringement allegations in April 2023. EX2001 (Complaint) at ¶ 36.

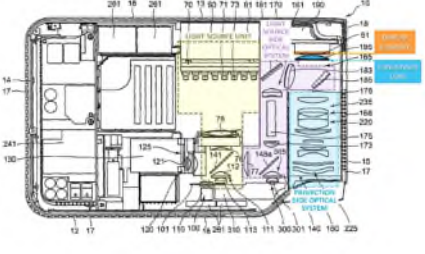
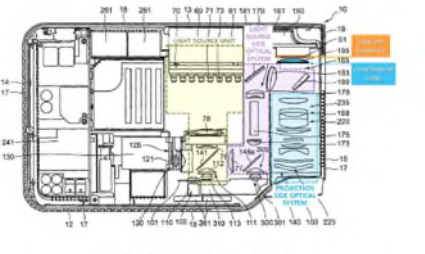
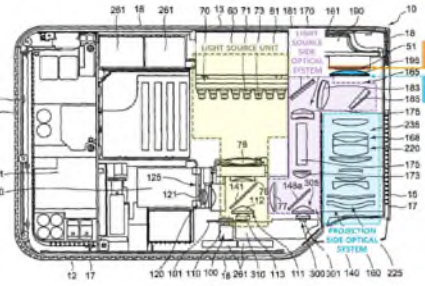
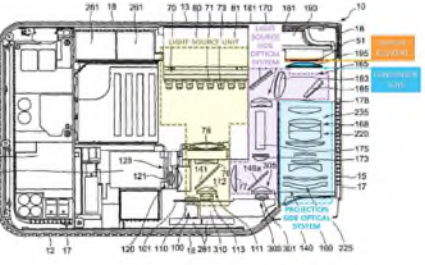
This IPR was filed only after substantial progress had been made in the parallel District Court Litigation, including extensive motion practice and exchange of contentions. Such a lengthy and unexplained delay strongly suggests tactical gamesmanship aimed at disrupting the District Court Litigation rather than seeking

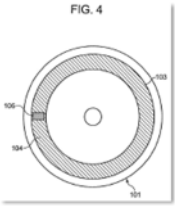
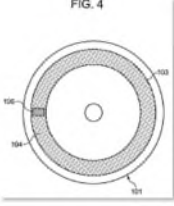
an efficient alternative to litigation early in the dispute. This weighs in favor of discretionary denial.

3. Petitioners' Improper Reliance on Expert Testimony

Significant portions of Dr. Sasian's declaration mirror the Petition's language, restating arguments and assertions made by Petitioners' counsel often nearly verbatim with the same annotated figures, without offering sufficient independent analysis, supporting data, or reasoning grounded in specific evidence beyond the Petition's attorney assertions. The following are few, non-exhaustive, examples of such that pervade Dr. Sasian's declaration.

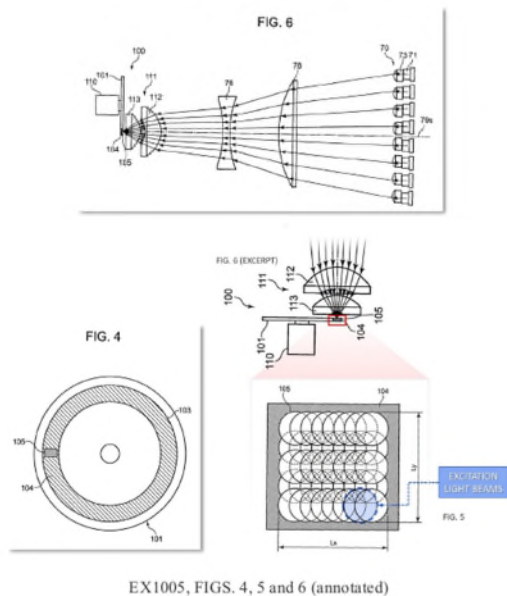
Petition (Paper 2 at 16)	Sasian Decl. (EX1004 at ¶ 71)
Kurosaki discloses that one or more embodiments of the present invention relate to a light source device and a projector. EX1005, 1:14-15. FIG.3 of Kurosaki shows a schematic plan view showing the internal structure of the projector. <i>Id.</i> 2:35-37.  EX1005, FIG 3 (annotated)	71. Kurosaki discloses that one or more embodiments of the present invention relate to a light source device and a projector. EX1005, 1:14-15. FIG.3 of Kurosaki shows a schematic plan view showing the internal structure of the projector. <i>Id.</i> 2:35-37.  EX1005, FIG. 3 (annotated)

Petition (Paper 2 at 17) Kurosaki discloses that "[t]he image generation block 165 is also provided with the display element 51 which is a DMD." <i>Id.</i>, 8:8-10.  EX1005, FIG. 3 (annotated)	Sasian Decl. (EX1004 at ¶ 75) 75. Kurosaki discloses that "[t]he image generation block 165 is also provided with the display element 51 which is a DMD." EX1005, 8:8-10.  EX1005, FIG. 3 (annotated)
Petition (Paper 2 at 18-19) Kurosaki discloses that "[l]ight beams emitted from a light source unit 60 are applied to the display element 51 via a guiding optical system, whereby an optical image is formed by light reflected from the display element 51."  EX1005, FIG. 3 (annotated) Kurosaki further discloses that "[t]he guiding optical system 140 consists of condenser lenses for condensing light beams in red, green, and blue wavelength ranges, dichroic mirrors for changing the optical paths of light beams in respective wavelength ranges so that they come to travel along the same optical axis, and other components." <i>Id.</i>, 7:20-25. <i>See, further, Id.</i>, 7:36-8:8 and Fig. 3.	Sasian Decl. (EX1004 at ¶ 77) 77. Kurosaki discloses that "[l]ight beams emitted from a light source unit 60 are applied to the display element 51 via a guiding optical system, whereby an optical image is formed by light reflected from the display element 51." EX1005, 3:52-56.  EX1005, FIG. 3 (annotated) Kurosaki further discloses that "[t]he guiding optical system 140 consists of condenser lenses for condensing light beams in red, green, and blue wavelength ranges, dichroic mirrors for changing the optical paths of light beams in respective wavelength ranges so that they come to travel along the same optical axis, and other components." <i>Id.</i>, 7:20-25. <i>See, further, Id.</i>, 7:36-8:8 and Fig. 3.
Petition (Paper 2 at 19) Kurosaki discloses that "[t]he light source unit 60 is equipped with an excitation light illumination device 70" EX1005, 4:61-62. "The excitation light illumination device 70 is equipped with excitation light sources 71, ..." <i>Id.</i>, 5:16-20.	Sasian Decl. (EX1004 at ¶ 81) 81. Kurosaki discloses that "[t]he light source unit 60 is equipped with an excitation light illumination device 70" EX1005, 4:61-62. "The excitation light illumination device 70 is equipped with excitation light sources 71, ..." <i>Id.</i>, 5:16-20.

Petition (Paper 2 at 20-21)	Sasian Decl. (EX1004 at ¶ 84)
Kurosaki further discloses, "The fluorescent light emitting device 100 is equipped with the phosphor wheel 101 (phosphor plate)" <i>Id.</i>, 5:35-36. "[T]he phosphor wheel 101 functions as a phosphor plate for emitting fluorescent light when receiving excitation light. The excitation-light-sources-71-side surface, including the fluorescent light emitting area, of the phosphor wheel 101 is a reflection surface capable of reflecting light because it is mirror-finished by silver evaporation, for example. A green phosphor layer 104 ("illumination subject body") is formed on this reflection surface." <i>Id.</i>, 5:47-59. "As shown in FIG. 3, light beams that are emitted from the excitation light sources 71 and applied to the green phosphor layer 104 of the phosphor wheel 101 via the collimator lenses 73, the condenser lens 78, the concave lens 76, and a dichroic mirror 141 excite the green phosphor of the green phosphor layer 104. As a result, fluorescent light that is emitted from the green phosphor in all directions goes toward the side of the excitation light sources 71 directly or after being reflected by the reflection surface of the phosphor wheel 101." <i>Id.</i>, 6:22-30. 	84. Kurosaki further discloses, "The fluorescent light emitting device 100 is equipped with the phosphor wheel 101 (phosphor plate)" <i>Id.</i>, 5:35-36. "[T]he phosphor wheel 101 functions as a phosphor plate for emitting fluorescent light when receiving excitation light. The excitation-light-sources-71-side surface, including the fluorescent light emitting area, of the phosphor wheel 101 is a reflection surface capable of reflecting light because it is mirror-finished by silver evaporation, for example. A green phosphor layer 104 ("illumination subject body") is formed on this reflection surface." <i>Id.</i>, 5:47-59. "As shown in FIG. 3, light beams that are emitted from the excitation light sources 71 and applied to the green phosphor layer 104 of the phosphor wheel 101 via the collimator lenses 73, the condenser lens 78, the concave lens 76, and a dichroic mirror 141 excite the green phosphor of the green phosphor layer 104. As a result, fluorescent light that is emitted from the green phosphor in all directions goes toward the side of the excitation light sources 71 directly or after being reflected by the reflection surface of the phosphor wheel 101." <i>Id.</i>, 6:22-30. 

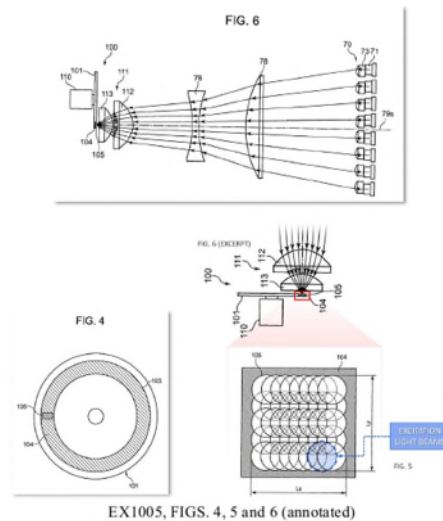
Petition (Paper 2 at 22-23)

Kurosaki discloses the optical member having a curvature that is set such that a light-condensing position of the excitation light is positioned on an emission side of the excitation light relative to the fluorescent material: At least the condenser lens 78 and the concave lens 76 each have a curvature. EX1004, ¶ 87. Because beams converge toward the phosphor layer 104 due to the combined effects of the curvatures of the lenses 78, 76, 112, and 113, the fact that at least some of the beams do not coincide (i.e., completely lie on each other) as explicitly shown in Fig. 5 means that the beams from the excitation light sources 71 are more concentrated in the rectangular area $L_x \times L_y$ on the phosphor layer 104 with an approximately uniform illumination intensity distribution. Therefore, the excitation light is incident on the fluorescent material 1 as a light-condensing position that is an emission side of the excitation light relative to the fluorescent material. *Id.*

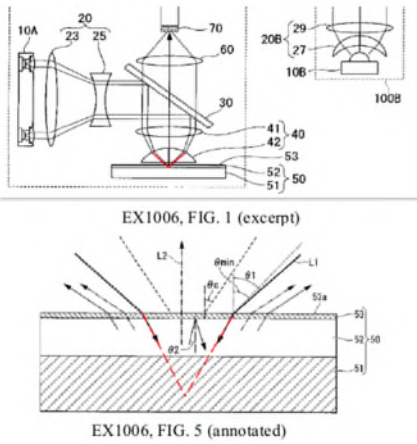
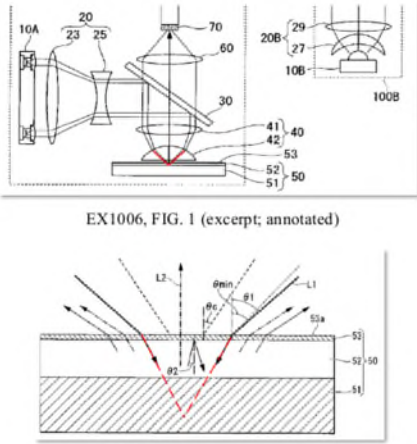


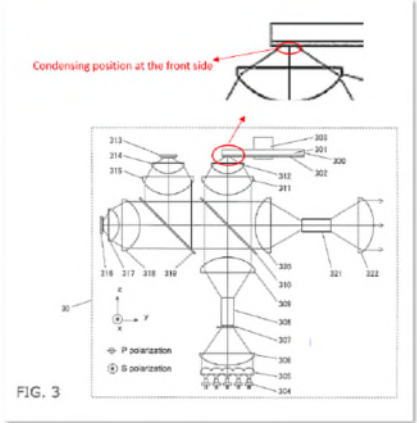
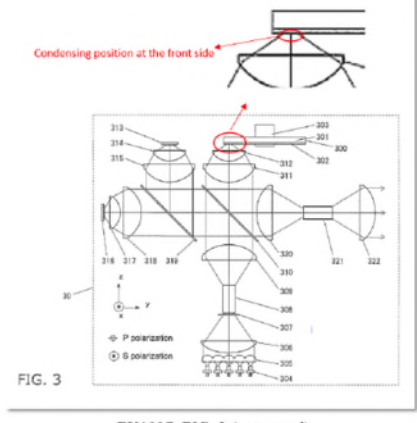
Sasian Decl. (EX1004 at ¶ 87)

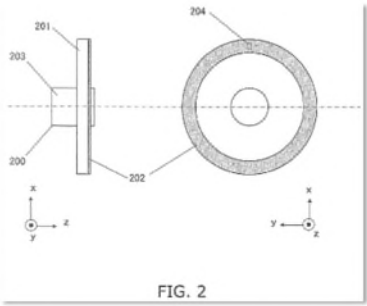
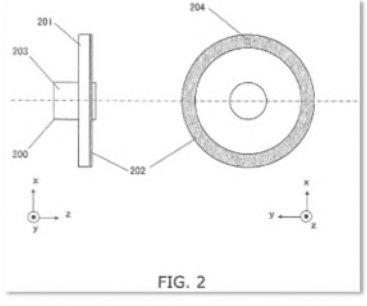
87. Kurosaki discloses the optical member having a curvature that is set such that a light-condensing position of the excitation light is positioned on an emission side of the excitation light relative to the fluorescent material: At least the condenser lens 78 and the concave lens 76 each have a curvature. Because beams converge toward the phosphor layer 104 due to the combined effects of the curvatures of the lenses 78, 76, 112, and 113, the fact that at least some of the beams do not coincide (i.e., completely lie on each other) as explicitly shown in Fig. 5 means that the beams from the excitation light sources 71 are more concentrated in the rectangular area $L_x \times L_y$ on the phosphor layer 104 with an approximately uniform illumination intensity distribution. Therefore, the excitation light is incident on the fluorescent material 1 as a light-condensing position that is an emission side of the excitation light relative to the fluorescent material.



Petition (Paper 2 at 28)	Sasian Decl. (EX1004 at ¶ 103)
Kurosaki teaches that "as shown in FIG. 5, excitation light beams emitted from the respective excitation light sources 71 and refracted by the respective collimator lenses 73 overlap with each other or completely lie on each other in the certain region 105 of the phosphor layer 104. Settings are made so that excitation light beams have an approximately uniform illumination intensity distribution in the rectangular certain region 105 having a width Lx in the right-left direction and a width Ly in the top-bottom direction (see FIG. 5). [T]he projector 10 according to the embodiment is equipped with a rectangular DMD (display element 51) and the light tunnel 175 having a rectangular cross section. <i>The certain region 105 which is illuminated with excitation light beams is given a generally rectangular shape so as to have the same shape as the DMD and the light tunnel 175.</i>" EX1005, 5:66-6:13 (emphasis added).	103. Kurosaki teaches that "as shown in FIG. 5, excitation light beams emitted from the respective excitation light sources 71 and refracted by the respective collimator lenses 73 overlap with each other or completely lie on each other in the certain region 105 of the phosphor layer 104. Settings are made so that excitation light beams have an approximately uniform illumination intensity distribution in the rectangular certain region 105 having a width Lx in the right-left direction and a width Ly in the top-bottom direction (see FIG. 5). [T]he projector 10 according to the embodiment is equipped with a rectangular DMD (display element 51) and the light tunnel 175 having a rectangular cross section. <i>The certain region 105 which is illuminated with excitation light beams is given a generally rectangular shape so as to have the same shape as the DMD and the light tunnel 175.</i>" EX1005, 5:66-6:13 (emphasis added).

Petition (Paper 2 at 39-41)	Sasian Decl. (EX1004 at ¶¶ 126-28)
See annotated FIG. 1 and FIG. 5.  EX1006, FIG. 1 (excerpt) EX1006, FIG. 5 (annotated) Miyamae discloses that "[o]n light emitting element 50, the individual spots of the laser light sources 12 incorporated in light source portion 10A are set so that their focusing positions do not completely overlap" EX1006, [0046]. Thus, Miyamae discloses that a light-condensing position of the excitation light is positioned on an emission side of the excitation light relative to the fluorescent material. EX1004, ¶ 128. The imaginary extensions of the excitation light rays substantially meet at a point in annotated Fig. 5 on the opposite side of fluorescent layer 52 from the excitation light sources 102, just as shown in the Fig. 1 of the '226 Patent. <i>Id.</i>	126. See annotated FIG. 1 and FIG. 5.  EX1006, FIG. 1 (excerpt; annotated) EX1006, FIG. 5 (annotated) 127. Miyamae discloses that "[o]n light emitting element 50, the individual spots of the laser light sources 12 incorporated in light source portion 10A are set so that their focusing positions do not completely overlap" EX1006, [0046]. 128. Thus, Miyamae discloses that a light-condensing position of the excitation light is positioned on an emission side of the excitation light relative to the fluorescent material. The imaginary extensions of the excitation light rays substantially meet at a point in annotated Fig. 5 on the opposite side of fluorescent layer 52 from the excitation light sources 102, just as shown in the Fig. 1 of the '226 Patent.

Petition (Paper 2 at 64-66)	Sasian Decl. (EX1004 at ¶¶ 188-91)
Kitano discloses that the excitation light is condensed at a light-condensing position on an emission side of the excitation light relative to the fluorescent material, as shown in the annotated figure below. EX1004, ¶ 188.  FIG. 3 Specifically, in Kitano, “FIG. 2 shows a specific configuration of the phosphor wheel 100 [in the first embodiment] as seen in the z axis direction... The outermost peripheral portion of the substrate 201 is coated with a phosphor 202 ... The shape of a laser light irradiation spot 204 on the phosphor 202 is indicated by the broken line.” <i>Id.</i>, [0052]. “A laser light source 304 (an example of a first light source component), a collimator lens array 305, a focusing lens or a condensing lens 306, and a diffuser plate 307 are the same as in the first embodiment. Here again, the laser light flux that has passed through the diffuser plate 307 is incident on a first rod integrator 308 (an example of a first illuminance homogenizer)....The laser light flux emitted from the first rod integrator 308 is collimated by a collimator lens 309, after which it is incident on a dichroic mirror 310 (an example of a first color separator)....The laser light flux that has passed through the dichroic mirror 310 is condensed or focused by focusing lenses or condensing lenses 311 and 312 and is incident on the phosphor. ... The spot of the laser light flux formed on the phosphor measures 2×1.5 mm.” <i>Id.</i>, [0062]-[0070].	188. Kitano discloses that the excitation light is condensed at a light-condensing position on an emission side of the excitation light relative to the fluorescent material, as shown in the annotated figure below.  FIG. 3 EX1007, FIG. 3 (annotated) 189. Specifically, in Kitano, “FIG. 2 shows a specific configuration of the phosphor wheel 100 [in the first embodiment] as seen in the z axis direction... The outermost peripheral portion of the substrate 201 is coated with a phosphor 202 ... The shape of a laser light irradiation spot 204 on the phosphor 202 is indicated by the broken line.” <i>Id.</i>, [0052]. “A laser light source 304 (an example of a first light source component), a collimator lens array 305, a focusing lens or a condensing lens 306, and a diffuser plate 307 are the same as in the first embodiment. Here again, the laser light flux that has passed through the diffuser plate 307 is incident on a first rod integrator 308 (an example of a first illuminance homogenizer)....The laser light flux emitted from the first rod integrator 308 is collimated by a collimator lens 309, after which it is incident on a dichroic mirror 310 (an example of a first color separator)....The laser light flux that has passed through the dichroic mirror 310 is condensed or focused by focusing lenses or condensing lenses 311 and 312 and is incident on the phosphor. ... The spot of the laser light flux formed on the phosphor measures 2×1.5 mm.” <i>Id.</i>, [0062]-[0070].

Petition (Paper 2 at 64-66)	Sasian Decl. (EX1004 at ¶¶ 188-91)
 FIG. 2 Kitano further discloses that in the second embodiment, “The outermost peripheral portion of the substrate 301 is coated with the phosphor 302 ...” <i>Id.</i>, [0074]. Kitano further discloses that “the flux shape of the green fluorescent light, ... incident on the second rod integrator is adjusted to be substantially the same as the rod integrator incident end face shape. Therefore, each kind of light can be efficiently coupled to the rod integrator.” <i>Id.</i>, [0087].	 FIG. 2 190. Kitano further discloses that in the second embodiment, “The outermost peripheral portion of the substrate 301 is coated with the phosphor 302 ...” <i>Id.</i>, [0074]. 191. Kitano further discloses that “the flux shape of the green fluorescent light, ... incident on the second rod integrator is adjusted to be substantially the same as the rod integrator incident end face shape. Therefore, each kind of light can be efficiently coupled to the rod integrator.” <i>Id.</i>, [0087].

Such parroting of attorney argument diminishes the weight, if any, that should be accorded to the testimony. *See Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 12 (P.T.A.B. Feb. 10, 2023) (precedential) (according “little weight” to declaration testimony that contains a verbatim restatement of a petition’s conclusory assertions without additional supporting evidence or reasoning); *see also Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1340–41 (Fed. Cir. 2020) (affirming Board decision giving no weight to expert testimony that “merely repeated Petitioners’ argument, nearly verbatim, without citation to the basis for his testimony”); *see also Wowza Media Sys., LLC v. Adobe Sys. Inc.*, IPR2013-00054, Paper 12 at 12 (P.T.A.B. Apr. 8, 2013) (“The Declaration . . . appears, for the most part, simply to track and repeat the arguments for unpatentability presented in the

Petition [and] . . . is therefore no more helpful tha[n] the Petition in determining where the challenged recitation is found in the references.”). This practice also raises concerns under 37 C.F.R. § 42.65(a). *See* 37 C.F.R. § 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”).

Accordingly, Petitioners’ improper use of expert testimony further supports discretionary denial under 35 U.S.C. § 314(a).

4. The Board Should Reject Any Late Sotera Stipulation

Petitioners have not made a proper *Sotera*-style stipulation—that “if IPR is instituted, [Petitioners] will not pursue in the District Court Litigation any ground raised or that could have been reasonably raised in an IPR”—in its Petition, which weighs further in favor of discretionarily denying institution. *See Sotera*, IPR2020-01019, Paper 12, 13-14 (P.T.A.B. Dec. 1, 2020) (precedential).

As set forth above, Petitioners chose to make an insufficient stipulation in attempt to preserve a second bite at the apple in the district court. The Board should not accept any late *Sotera* stipulation potentially offered after this Request for Discretionary Denial. Any withholding of the *Sotera* stipulation in the Petition is gamesmanship and prejudicial to Patent Owner in this proceeding, and is inconsistent with 37 C.F.R. § 42.1(b)’s mandate to “secure the just, speedy, and inexpensive resolution of every proceeding.” Indeed, Petitioners’ gamesmanship in

this regard prejudices Patent Owner because Patent Owner is forced to prepare overlapping validity defenses in the District Court Litigation and this proceeding throughout the pendency of this Petition.

Additionally, on February 28, 2025, the Office *rescinded* former Director Vidal's 2022 memorandum on discretionary denials, which placed significant weight on *Sotera* stipulations. The announcement rescinding former Director Vidal's 2022 memorandum went on to state that decisions relying on the 2022 memo will be "neither binding or persuasive on the PTAB." EX2013 (USPTO rescinds memorandum).

On March 24, 2025 the Office released a memo providing guidance following the recension of Director Vidal's 2022 memo. That memo provided that a *Sotera* stipulation would be "highly relevant, but will not dispositive in itself." EX2014 ("Memo 2") at 2-3. Petitioners' failure to provide a *Sotera* stipulation along with its Petition has prejudiced and continues to prejudice Patent Owner. In view of the above and in the event the Petitioners file a late *Sotera* stipulation, the stipulation should not be considered persuasive.³

³ "A petitioner should file a *Sotera* or *Sand* stipulation as soon as practicable, so that a patent owner may address the impact of the stipulation in its discretionary denial brief." EX2015 (USPTO, *FAQs for Interim Processes for PTAB Workload*

These additional factors, highlighted by recent Office guidance, provide further independent bases for the Director to exercise discretion and deny institution of this IPR petition.

V. CONCLUSION

For at least the foregoing reasons, the Board should deny institution of the Petition.

Dated: May 12, 2025

Respectfully submitted,

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Management, <https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management> (last visited May 7, 2025)).

Patent No. 9,547,226

Brief in Support of Patent Owner's Request for Discretionary Denial

CERTIFICATE OF SERVICE

I hereby certify that on this 12th day of May, 2025, a copy of the attached BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL TO PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 9,549,226, together with all exhibits was served by electronic mail to the attorneys of record, at the following addresses:

Donald R. McPhail dmcphail@merchantgould.com

John S. Kern jkern@merchantgould.com

Tong Wu twu@merchantgould.com

With a courtesy copy by electronic mail to: coretronic226ipr@merchantgould.com

Respectfully submitted,

Date: May 12, 2025

By: /Robert G Pluta Reg No 50970/
Robert G. Pluta (Reg. No. 50,970)

Counsel for Maxell, Ltd.

CERTIFICATION PURSUANT TO 37 C.F.R. § 42.24(d)

Pursuant 37 CFR 42.24(d), the undersigned certifies that this Preliminary Response and complies with the type-volume limitation of 37 CFR §42.24(a). The word count application of the word processing program used to prepare this Preliminary Response indicates that the Preliminary Response contains 7,184 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

Respectfully submitted,

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