

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

**PETITIONERS' OPPOSITION TO PATENT OWNER'S
REQUEST FOR DISCRETIONARY DENIAL**

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	PATENT OWNER’S REQUEST FOR DISCRETIONARY DENIAL SHOULD BE REJECTED.....	2
A.	The <i>Fintiv</i> Factors Do Not Support Discretionary Denial	2
1.	Status of Motion to Stay (Factor 1)	2
2.	Proximity of the District Court Trial Date (Factor 2)	4
3.	Investment in the Parallel Proceeding (Factor 3)	6
4.	Overlap of Issues (Factor 4).....	8
5.	Same Parties (Factor 5).....	10
6.	Other Circumstances (Factor 6).....	10
B.	The <i>Advanced Bionics</i> Framework Under 35 U.S.C. § 325(d) Does Not Warrant Denial.....	11
1.	The Prior Art is Not Substantially the Same.....	11
2.	Petitioners Have Demonstrated Material Error by the Office.....	18
C.	Additional Factors Set Forth in the March 26, 2025 Memorandum Do Not Support Denial.....	21
1.	The Unpatentability Challenges Are Strong	21
2.	There Is No Undue Delay or Gamesmanship	25
3.	The Petition is Properly Supported by Dr. Sasian’s Declaration	26

4.	A <i>Sotera</i> Stipulation Remains Available.....	27
III.	CONCLUSION.....	29

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GMBH,</i> IPR2019-01469, Paper 6.....	20
<i>Amgen Inc. v Alexion Pharmaceuticals, Inc.,</i> IPR2019-00740, Paper 15 (PTAB Aug. 30, 2019).....	12
<i>Apple Inc. v. Fintiv, Inc.,</i> IPR2020-00019, Paper 15 (PTAB May 13, 2020)	<i>passim</i>
<i>Becton, Dickinson & Co. v. B. Braun Melsungen AG,</i> IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017)	18, 19, 21
<i>BMW of North America, LLC v. Northstar Systems LLC,</i> IPR2023-01017, Paper 12 (PTAB Dec. 8, 2023)	28
<i>Digital Check Corp. d/b/a ST Imaging v. E-Imagedata Corp.,</i> IPR2017-00178, Paper 6 (PTAB Apr. 25, 2017)	12
<i>Dish Network LLC v. Broadband iTV, Inc.,</i> IPR2020-01359, Paper 15 (PTAB Feb. 12, 2021).....	5
<i>Ecto World, LLC v. RAI Strategic Holdings, Inc.,</i> IPR2024-01280, Paper 13 (PTAB May 19, 2025)	18, 20
<i>Green Revolution Cooling, Inc. v. Midas Green Technologies, LLC,</i> IPR2025-00196, Paper 7 (PTAB May 23, 2025)	5
<i>In re Keller,</i> 642 F.2d 413 (CCPA 1981).....	25
<i>KSR International Co. v. Teleflex Inc.,</i> 550 U.S. 398 (2007).....	22, 25
<i>Liberty Energy, Inc. et al. v. U.S. Well Services, LLC,</i> IPR 2025-00031	8

<i>Markforged Inc. v. Continuous Composites, Inc.</i> , IPR2022-00679, Paper 7 (PTAB Oct. 25, 2022)	8
<i>Maxell, Ltd. v. Coretronic Corp.</i> , No. 5:24-cv-00088-RWS-JBB (E.D. Tex.)	1
<i>MediaTek Inc. v. Daedalus Prime LLC</i> , IPR2025-00100, Paper 10 (PTAB May 19, 2025)	4
<i>Meta Platforms, Inc. v. Mobile Data Techns., LLC</i> , IPR2024-00246, Paper 12 (PTAB June 11, 2024)	11
<i>Micron Tech., Inc. v. Yangtze Memory Techs. Co., Ltd.</i> , IPR2025-00034, Paper 19 (PTAB May 16, 2025)	10
<i>Nikon Corp. et al. v. Optimum Imaging Techs., LLC</i> , IPR2024-01374, Paper 19 (PTAB April 29, 2025)	3
<i>Optoma Tech. Inc. v. Maxell Ltd.</i> , No. 3:24-cv-08147-TLT, Dkt. 49 (N.D. Cal.)	5
<i>Profrac Holding Corp. v. Halliburton Energy Services, Inc.</i> , IPR2023-01318, Paper 7 (PTAB Apr. 15, 2024)	12
<i>Samsung Elecs. Co., Ltd. et al. v. Mullen Indus. LLC</i> , IPR2025-00021, Paper 14 (PTAB May 14, 2025)	4, 10
<i>Samsung Elecs. Co., Ltd. v. Maxell, Ltd.</i> , IPR2024-00777, Paper 12 (PTAB Nov. 8, 2024)	15, 16, 17
<i>Sand Revolution II, LLC v. Cont'l Intermodal Grp. - Trucking LLC</i> , IPR2019-01393, Paper 24 (PTAB June 16, 2020)	7
<i>Sotera Wireless, Inc. v. Masimo Corp.</i> , IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020)	<i>passim</i>
<i>TCL Elecs. Holdings Ltd. v. Maxell, Ltd.</i> , IPR2025-00120, Paper 9 (PTAB May 20, 2025)	10, 11
<i>Trover Grp., Inc. v. Dedicated Micros USA</i> , No. 2:13-CV1047-WCB, 2015 WL 1069179 (E.D. Tex. Mar. 11, 2015) (Bryson, J.)	3

<i>Viavi Sols. Inc. v. Zhejiang Crystal-Optech Co.,</i> No. 2:21-CV-00378-JRG, 2022 WL 16856099 (E.D. Tex. Nov. 10, 2022)	3
<i>VMWare, Inc. v. Intell. Ventures II LLC,</i> IPR2020-00859, Paper 13 (PTAB Nov. 5, 2020).....	3
<i>Xerox Corp. v. Bytemark, Inc.,</i> IPR2022-00624, Paper 12 (PTAB Feb. 10, 2023).....	27
<i>Zynga Inc. v. IGT,</i> IPR2022-00368, Paper 7 (PTAB July 8, 2022).....	6
Statutes	
35 U.S.C. § 314(a)	1, 2
35 U.S.C. § 315(b)	26
35 U.S.C. § 315(e)(2).....	9
35 U.S.C. § 325(d)	1, 11, 12, 18

I. INTRODUCTION

Petitioners Coretronic Corporation and Optoma Corporation (“Petitioners”) respectfully submit this Opposition to Patent Owner Maxell, Ltd.’s (“Patent Owner”) Request for Discretionary Denial of the Petition for *inter partes* review (“IPR”) of U.S. Patent No. 9,547,226 (“the ’226 Patent”). Patent Owner’s request, filed on May 12, 2025, seeks to avoid a merits-based review of the Petition’s well-supported grounds of unpatentability under 35 U.S.C. § 314(a) and § 325(d), as well as the March 26, 2025 Acting Director’s Memorandum (“Memo”). Patent Owner’s arguments lack merit, and discretionary denial is unwarranted.

The Petition, filed on January 17, 2025, challenges claims 8, 10, and 12 of the ’226 Patent based on four grounds, relying on prior art such as Kurosaki ’087, Miyamae, and Kitano, which reveal significant deficiencies in the patentability of the challenged claims. Petitioners have not been involved in any previous review of the ’226 Patent, and the Office has not previously considered the cited references or their combinations. The *Fintiv* factors do not favor denial, as the parallel district court litigation in *Maxell, Ltd. v. Coretronic Corp.*, No. 5:24-cv-00088-RWS-JBB (E.D. Tex.) remains at an early stage, with Petitioners committing to file a motion to stay upon institution and offering a *Sotera*-style stipulation to eliminate overlap between the two proceedings. In addition, the *Advanced Bionics* framework does not apply because the prior art and arguments relied on in the Petition are not

substantially the same as that previously presented to the Office. Finally, the additional factors in the Memo, including the strength of the unpatentability challenges and the propriety of expert testimony, further support institution. Accordingly, the Board should reject Patent Owner's request and institute trial in this proceeding.

II. PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL SHOULD BE REJECTED

A. The *Fintiv* Factors Do Not Support Discretionary Denial

Patent Owner argues that the Board should exercise discretion under 35 U.S.C. § 314(a) and *Fintiv* to deny institution due to parallel district court litigation. However, a comprehensive analysis of the *Fintiv* factors shows that discretionary denial is unwarranted. The parallel litigation is not sufficiently advanced to prejudice efficient resolution by the Board, and Petitioners' proactive measures mitigate any potential overlap or inefficiency.

1. Status of Motion to Stay (Factor 1)

Patent Owner asserts that no stay has been requested in the district court litigation and surmises that "a stay would be unlikely in the event of institution." Paper 6 at 6. This argument is both speculative and premature. As of the date of this Opposition, fact discovery is ongoing with a deadline of August 7, 2025 (EX2003), and no final pretrial conference, trial preparations, or substantive rulings have occurred.

Requesting a stay of district court proceedings pending an IPR that has not been instituted is premature. *See Trover Grp., Inc. v. Dedicated Micros USA*, No. 2:13-CV1047-WCB, 2015 WL 1069179, at *6 (E.D. Tex. Mar. 11, 2015) (Bryson, J.) (“In this district . . . it is the universal practice” to deny stay requests before the PTAB has acted on a petition for review); *Viavi Sols. Inc. v. Zhejiang Crystal-Optech Co.*, No. 2:21-CV-00378-JRG, 2022 WL 16856099, at *5 (E.D. Tex. Nov. 10, 2022) (“It 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.”).

In addition, Petitioners will promptly file a motion to stay the parallel litigation upon institution of this IPR. Courts frequently grant such stays, and the Board has not found that this factor weighs against institution where a Patent Owner offers only self-serving conjecture. *See, e.g., VMWare, Inc. v. Intell. Ventures II LLC*, IPR2020-00859, Paper 13 at 12 (PTAB Nov. 5, 2020) (“In the absence of any evidence specific to this case, we decline to speculate about the presiding judge’s inclinations.”) (*citing Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12 (PTAB May 13, 2020) (informative) (“We decline to infer, based on actions taken in different cases with different facts, how the District Court would rule should a stay be requested by the parties in the parallel case here.”)); *Nikon Corp. et al. v. Optimum Imaging Techs., LLC*, IPR2024-01374, Paper 19 at 10 (PTAB April 29, 2025) (“We

will not attempt to predict how the court in the parallel district court proceedings would proceed if a stay is requested because the court may determine whether or not to stay any individual case based on a variety of circumstances and facts beyond our control and to which the Board is not privy.”) (citing *Sand Revolution II, LLC v. Cont’l Intermodal Grp. - Trucking LLC*, IPR2019-01393, Paper 24 at 7 (PTAB June 16, 2020) (informative)); *MediaTek Inc. v. Daedalus Prime LLC*, IPR2025-00100, Paper 10 at 27 (PTAB May 19, 2025) (“The Board’s decision in [*Fintiv*] cautions against speculating whether the district court would grant a stay if one were requested. Therefore, this factor has a neutral effect on the overall balancing of the *Fintiv* factors.”); *Samsung Elecs. Co., Ltd. et al. v. Mullen Indus. LLC*, IPR2025-00021, Paper 14 at 8-9 (PTAB May 14, 2025) (“Given that the district court denied Samsung’s motion to stay ‘WITHOUT PREJUDICE to refiling of the same within fourteen (14) days following the PTAB’s institution decision on the last of the pending IPRs’ . . . we decline to speculate whether the district court will grant a stay. Thus, we find that factor 1 is neutral.”) Patent Owner provides no evidence specific to this case of judicial resistance to a stay. Thus, this factor is neutral.

2. Proximity of the District Court Trial Date (Factor 2)

Patent Owner contends that the scheduled trial date of March 23, 2026, over five months before the statutory Final Written Decision deadline of September 10, 2026, favors denial. Paper 6 at 7. However, this timeline provides the Board with

sufficient opportunity to issue a decision before trial, aligning with the America Invents Act's (AIA) goal of efficient patentability resolution since "the currently scheduled trial date is more than nine months away and much can change during this time." *Dish Network LLC v. Broadband iTV, Inc.*, IPR2020-01359, Paper 15 at 15 (PTAB Feb. 12, 2021) (granting institution). As stated above, Petitioners will promptly file a motion to stay the parallel litigation upon institution of this IPR. If the motion to stay is granted, the trial date will be after the deadline for a Final Written Decision.

The Petition also cites median disposition times in the Eastern District of Texas that suggest a potential trial around May 2026 (Pet. at 9-10), preceding the statutory Final Written Decision deadline here by only three to four months.¹ Patent Owner's dismissal of this statistical evidence as speculative overlooks the Board's reliance on such data. *See Green Revolution Cooling, Inc. v. Midas Green Technologies, LLC*, IPR2025-00196, Paper 7 at 11 (PTAB May 23, 2025) ("We 'may consider any evidence that the parties make of record that bears on the proximity of the district court's trial date . . . , including *median time-to-trial*

¹ Petitioners filed a motion to transfer the district court case to the Northern District of California, where they had filed a declaratory judgment action and trial was scheduled for July 2027, well after the Final Written Decision deadline. *See Optoma Tech. Inc. v. Maxell Ltd.*, No. 3:24-cv-08147-TLT, Dkt. 49 (N.D. Cal.). Although the motion was denied, Petitioners plan to file a petition for writ of mandamus with the Federal Circuit.

statistics for civil actions in the district court in which the parallel litigation resides.””) (quoting Guidance on USPTO’s rescission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,” issued on March 24, 2025, by Chief APJ Boalick) (emphasis in original).

Moreover, Patent Owner overstates its argument that this factor “strongly favors discretionary denial.” Paper 6 at 8. In similar cases where the scheduled trial date is five months before the statutory Final Written Decision deadline but subject to change, the Board has found that this factor only weighs “slightly in favor of discretionary denial.” *Zynga Inc. v. IGT*, IPR2022-00368, Paper 7 at 10 (PTAB July 8, 2022). Such is the case here.

3. Investment in the Parallel Proceeding (Factor 3)

Patent Owner argues that investment in the district court litigation, including a Markman hearing on May 9, 2025, and ongoing discovery, weighs against institution. Paper 6 at 8-10. However, as of the anticipated institution decision date (September 10, 2025), the parallel litigation will remain in its early stages. Fact discovery closes on August 7, 2025 and expert discovery closes on October 9, 2025 (EX2003), and no dispositive motions (beyond the pending 12(b) motions) or trial preparations have been completed. Petitioners just filed their answers to the complaint on June 2, 2025, no fact depositions have been taken, no expert reports have been exchanged, and the court has not engaged in claim construction beyond

conducting a Markman hearing, with document production still ongoing. Thus, this case stands in stark contrast to *Motorola Sols., Inc. v. Stellar, LLC* cited by Patent Owner, where extensive expert discovery and trial preparation had occurred. The court’s denial of Petitioners’ motion to transfer (EX2005) and related dismissals (EX2006) reflect routine case management, not “significant investment” in the parallel proceeding. In *Sand Revolution II*, the Board observed that “aside from the district court’s Markman Order, much of the district court’s investment relates to ancillary matters untethered to the validity issue itself. . . . Also, we recognize that much work remains in the district court case as it relates to invalidity: fact discovery is still ongoing, expert reports are not yet due, and substantive motion practice is yet to come. Thus, although the parties and the district court have invested effort in the related district court litigation to date, further effort remains to be expended in this case before trial.” IPR2019-01393, Paper 24 at 10-11 (finding factor 3 “weighs only marginally, if at all, in favor of exercising discretion to deny institution . . .”).

Moreover, under *Fintiv*, the Board recognizes that “it is often reasonable for a petitioner to wait to file its petition until it learns which claims are being asserted against it in the parallel proceeding,” and that if the petition is filed “promptly after becoming aware of the claims being asserted, this fact has weigh[s] against exercising the authority to deny institution” *Id.* at 11. Here, Petitioners diligently prepared and filed the Petition less three months after receiving Patent Owner’s

infringement contentions on October 28, 2024, and less than seven months after being served with the complaint asserting seven patents against Petitioners. In similar circumstances, the Board has found that this factor weighs against discretionary denial. *Markforged Inc. v. Continuous Composites, Inc.*, IPR2022-00679, Paper 7 at 32 (PTAB Oct. 25, 2022) (“[A]lthough the parties have invested some effort in the parallel district court proceeding, the majority of the work to prepare the invalidity case for trial remains to be done. We also acknowledge Petitioner’s diligence in filing the Petition less than 10 months after being served the complaint.”) (internal citations omitted). *See also Liberty Energy, Inc. et al. v. U.S. Well Services, LLC*, IPR 2025-00031, Paper 9 at 12-15 (PTAB Apr. 29, 2025) (finding that “Petitioner was reasonably diligent in filing the Petition” less than three months after receiving infringement contentions, which “play an important role in that regard. They inform Petitioner of the claims that are in fact at issue, as well as how Patent Owner views the scope of the claims, both of which are material considerations in preparing a petition.”)

Based on the foregoing, this factor is neutral or weighs against discretionary denial.

4. Overlap of Issues (Factor 4)

Patent Owner claims “significant overlap” between the issues raised in the Petition and district court litigation because the same claims and prior art are at issue.

Paper 6 at 10-14. While claims 8, 10, and 12 are challenged in both forums, Petitioners' invalidity contentions (EX2008) include additional references (*e.g.*, Hirata '999, Akiyama '904) not relied on in the Petition.

Moreover, Petitioners have proposed a *Sand*-style stipulation not to pursue the Petition's grounds in district court (Pet. at 11) and commit to a broader *Sotera*-style stipulation (filed concurrently herewith, EX1009), *i.e.*, upon institution, Petitioners will not (i) pursue the grounds presented in the Petition in the parallel district court case, or (ii) pursue any other ground that reasonably could have been raised in the Petition in the parallel district court case. *Sotera* endorses such stipulations to eliminate overlap in proceedings, noting that they prevent duplicative efforts and conflicting rulings. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 13-14 (PTAB Dec. 1, 2020).

Patent Owner's assertion that such a stipulation "does nothing" to mitigate potentially duplicative efforts and conflicting rulings ignores the stipulation's binding nature and the Board's precedent in *Sotera*. In fact, where such a stipulation and the estoppel provision of 35 U.S.C. § 315(e)(2) simply "reduces, but does not eliminate, the risk of significant overlap between the assertions in the Petition and those that may be raised in the parallel litigation," the Board has recently found that "[t]his minimized risk of overlap alleviates concerns of inefficiency and the possibility of conflicting decisions" and "determine[d] that this factor weighs against

exercising discretion to deny institution.” *Micron Tech., Inc. v. Yangtze Memory Techs. Co., Ltd.*, IPR2025-00034, Paper 19 at 10 (PTAB May 16, 2025).

Accordingly, “[t]his factor weighs strongly against discretionary denial.” *TCL Elecs. Holdings Ltd. v. Maxell, Ltd.*, IPR2025-00120, Paper 9 at 8 (PTAB May 20, 2025) (granting institution).

5. Same Parties (Factor 5)

Patent Owner notes that the parallel district court litigation involves the same parties. Paper 6 at 14. However, Optoma Technology, Inc. is identified as a real party-in-interest (Pet. at 1), but is not a party to the parallel litigation. Therefore, this factor is neutral. *See Google LLC et al. v. Mullen INDUS. LLC*, IPR2025-00021, Paper 14 at 11 (PTAB May 14, 2025) (“Because of the involvement of a non-defendant, even if a named real party in interest in this proceeding, we find that this factor is neutral.”)

6. Other Circumstances (Factor 6)

Patent Owner alleges that the Petition is “flawed” because it relies on an expert declaration that “largely parrots” the wording in the Petition, and because Petitioners filed motions to dismiss in the parallel litigation before the Petition was filed in this action. Paper 6 at 15. These issues are addressed in Sections II.C.2-3 below and do not constitute “other circumstances” warranting denial.

* * * * *

Based on a holistic evaluation of the above factors, the Board should not discretionarily deny institution. *See TCL*, IPR2025-00120, Paper 9 at 9 (instituting trial where factor 1 weighs slightly in favor of discretionary denial, factor 2 strongly favors discretionary denial, factor 3 weighs in favor of discretionary denial, factor 4 weighs strongly against discretionary denial because of *Sotera* stipulation, factor 5 supports discretionary denial, and factor 6 strongly supports institution).

B. The *Advanced Bionics* Framework Under 35 U.S.C. § 325(d) Does Not Warrant Denial

Patent Owner argues that denial is justified under 35 U.S.C. § 325(d) because the Petition relies on prior art previously presented to the Office and fails to show material error. Paper 6 at 15-31. This argument misapplies the *Advanced Bionics* framework because the prior art references or the combination thereof relied on in the Petition are not the same as those presented to the Office and there is at least a material error by the Examiner during prosecution, as explained below.

1. The Prior Art is Not Substantially the Same

Patent Owner argues that Kitano (Ground 4) was considered during prosecution, and Kurosaki '087 and Miyamae (Grounds 1-3) are cumulative to art that was considered during prosecution. Paper 6 at 17-30. However, while Kitano was cited by the Examiner, it was not analyzed in combination with Kurosaki '087 and Miyamae—a critical distinction. *See, e.g., Meta Platforms, Inc. v. Mobile Data Techs., LLC*, IPR2024-00246, Paper 12 at 14-16 (PTAB June 11, 2024) (*Advanced*

Bionics factor 1 not satisfied, even though two references were considered by Examiner, where petition sets forth new combination of references); *Profrac Holding Corp. v. Halliburton Energy Services, Inc.*, IPR2023-01318, Paper 7 at 23 (PTAB Apr. 15, 2024) (*Advanced Bionics* factor 1 not satisfied, even though primary reference considered by Examiner, where petition sets forth new combination of references).

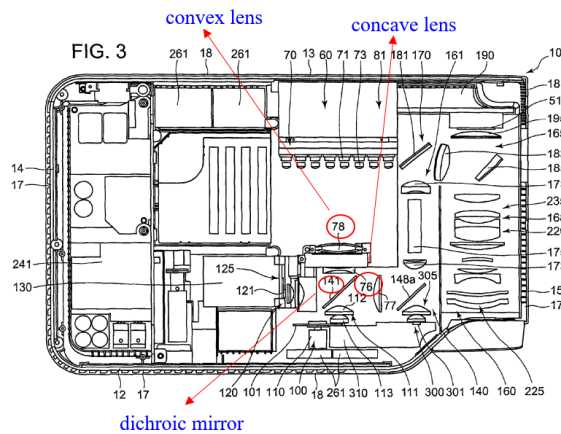
Moreover, Patent Owner concedes that not only were Kurosaki '087 and Miyamae not of record, but the references they are allegedly cumulative of—Matsubara and Kurosaki '632—were not relied on by the Examiner. Paper 6 at 17. The Board has denied application of § 325(d) where a petition relies on references that were before the Examiner but were not the basis for prior art rejections. *See, e.g., Digital Check Corp. d/b/a ST Imaging v. E-Imagedata Corp.*, IPR2017-00178, Paper 6 at 12-13 (PTAB Apr. 25, 2017) (granting institution where there was no indication that Examiner substantively considered asserted references cited in IDS); *Amgen Inc. v Alexion Pharmaceuticals, Inc.*, IPR2019-00740, Paper 15 at 65 (PTAB Aug. 30, 2019) (“The Board has consistently declined exercising its discretion under Section 325(d) when the only fact a Patent Owner can point to is that a reference was disclosed to the Examiner during the prosecution.”).

Patent Owner argues that Kurosaki '087 does not “introduce any substantial differences compared to the disclosures in Matsubara” because both references

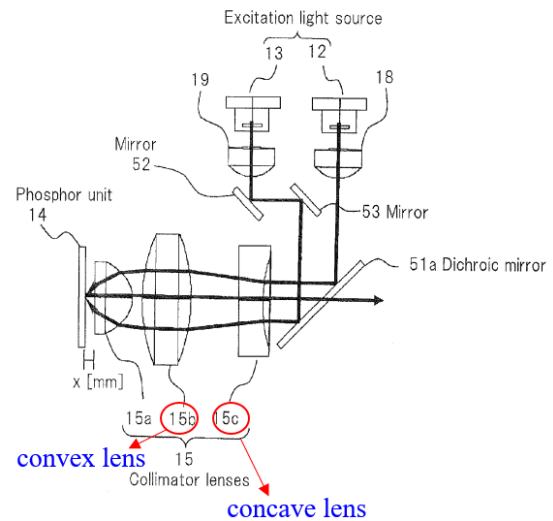
generally disclose a light source device with a phosphor unit/wheel and phosphor layer (fluorescent material), and both references “include similar and analogous structures of the lenses and phosphor unit/wheel.” Paper 6 at 24-25. However, the arrangements of optical components of Kurosaki ’087 are materially different from those of Matsubara.

For example, as shown by the comparison of annotated figures below, Kurosaki ’087 discloses *a convex lens and a concave lens disposed in the order from the excitation light source toward the dichroic mirror* for the excitation light passing through *before* the excitation light incident into the dichroic mirror (*see, e.g.,* EX1005 at 6:22-30, Fig. 3, Fig. 6). Matsubara, in contrast, discloses *a concave lens and a convex lens disposed in the order from the dichroic mirror toward the phosphor unit/wheel* for the excitation light passing through *after* the excitation light reflected from the dichroic mirror. *See, e.g.,* Matsubara at [0064], [0068]-[0070], Fig. 1. These differences are material because all Challenged Claims include a limitation that is disclosed in Kurosaki ’087 but not in Matsubara: “an optical member [that] 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.”

Fig.1

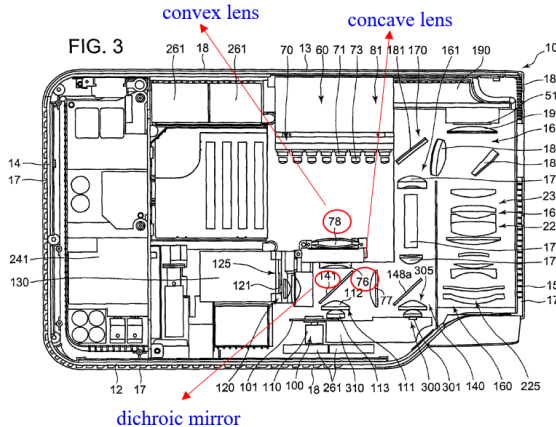


Annotated Fig. 3 of Kurosaki '087

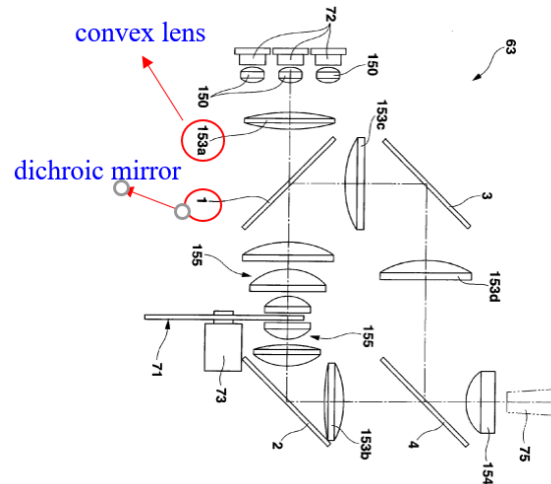


Annotated Fig. 1 of Matsubara

Patent Owner also argues that Kurosaki '087 adds “nothing new” to the disclosure of Kurosaki '632 because both references share a common inventor and “disclose similar light source devices featuring analogous components, configurations, and circuit blocks.” Paper 6 at 25-27. However, as shown from the comparison of annotated figures below, Kurosaki '087 is materially different from Kurosaki '632: Kurosaki '632 does not have a concave lens between the excitation light source and the dichroic mirror, and therefore does not disclose *a convex lens and a concave lens disposed in the order from the excitation light toward the dichroic mirror* for the excitation light passing through *before* the excitation light incident into the dichroic mirror as Kurosaki '087 does:



Annotated Fig. 3 of Kurosaki '087



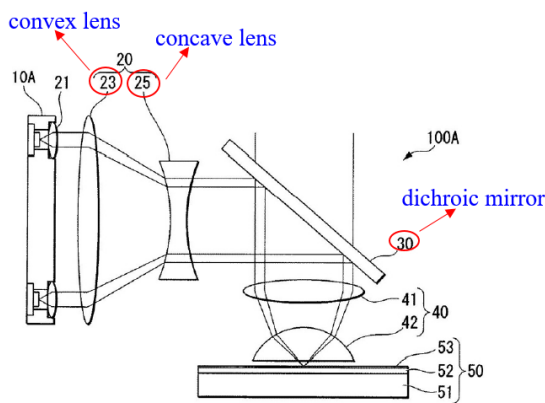
Annotated Fig. 6 of Kurosaki '632

Patent Owner asserts that “both embodiments in Kurosaki '087 [] and Kurosaki '632 [] have almost identical circuit blocks.” PO Brief at 25-26. This argument is irrelevant since the '226 Patent is not directed to the circuit. *See Samsung Elecs. Co., Ltd. v. Maxell, Ltd.*, IPR2024-00777, Paper 12 at 9 (PTAB Nov. 8, 2024) (“Patent Owner provides figures from . . . a reference considered in a related prosecution . . . but those figures alone do not suffice to demonstrate sufficient similarity between the two references’ disclosures.”) Furthermore, regardless of whether the characterization “almost identical” is reasonable, the difference, as explained above, is material.

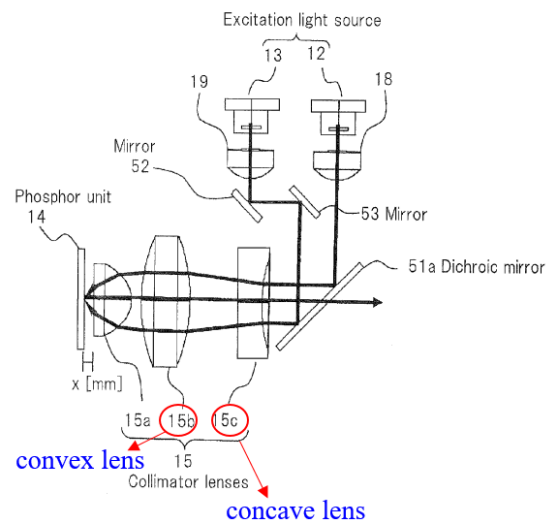
Patent Owner further argues that Miyamae is cumulative of Matsubara because both references generally disclose a light source device and “include similar and analogous structures of the lenses and phosphor unit/wheel.” Paper 6 at 29-30.

However, “those figures alone do not suffice to demonstrate sufficient similarity between the two references’ disclosures.” *Samsung*, IPR2024-00777, Paper 12 at 9. As shown from the comparison of annotated figures below, Miyamae discloses specific lens configurations such as *a convex lens and a concave lens disposed in the order from the excitation light source toward the dichroic mirror* for the excitation light passing through *before* the excitation light incident into the dichroic mirror, while Matsubara, by contrast, discloses *a concave lens and a convex lens disposed in the order from the dichroic mirror toward the phosphor unit/wheel* for the excitation light passing through *after* the excitation light reflected from the dichroic mirror.

Fig.1



Annotated Fig. 3 of Miyamae



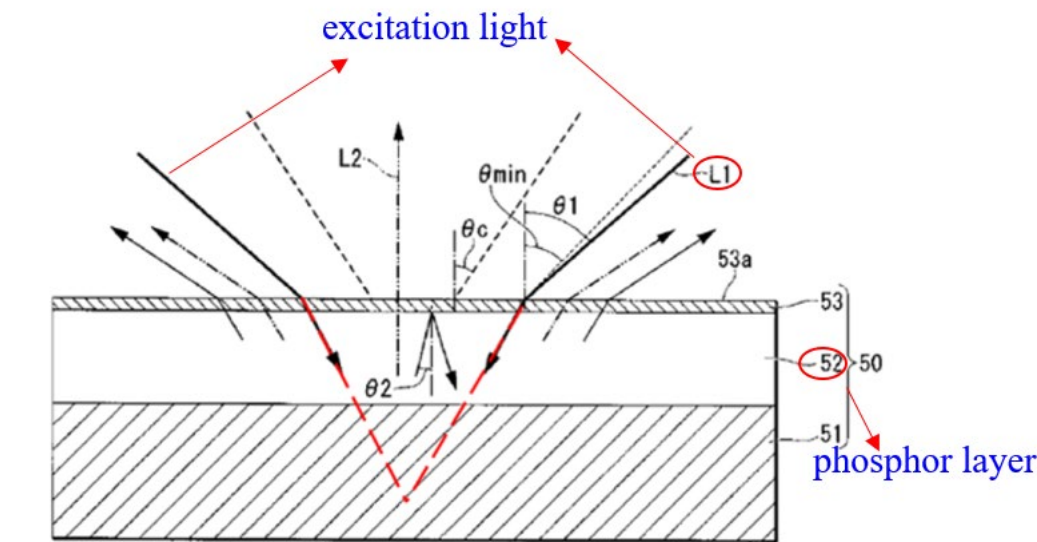
Annotated Fig. 1 of Matsubara

Thus, like Kurosaki '087, Miyamae is materially different from Matsubara.

Patent Owner further argues that Miyamae is cumulative of Masuda because both references disclose a light source unit with an optical/phosphor wheel and discuss “how the wavelength of the light changes when the excitation light is incident on the fluorescent material.” Paper 6 at 30. However, “those figures alone do not suffice to demonstrate sufficient similarity between the two references’ disclosures” *Samsung*, IPR2024-00777, Paper 12 at 9.

Further, Patent Owner’s assertion that Miyamae discloses a light source unit with an optical wheel, and teaches how the wavelength of the light changes when the excitation light is incident on the fluorescent material, does not demonstrate sufficient similarity between the two references’ disclosures, as these are basic elements of the projector using the excitation light to excite the fluorescent material, and not related to the notice of allowance for issued claim 8 and its dependent claims.

Moreover, as shown from annotated Figure 5 of Miyamae, Masuda does not disclose the excitation light passing through the front surface of the phosphor wheel and does not discuss 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].



Annotated Fig. 5 of Miyamae

The new, non-cumulative references and combinations of references asserted in the Petition, which are properly supported by Dr. Sasian’s declaration (discussed in Sections II.C.2-3 below), present fresh challenges to the Challenged Claims. Discretionary denial under § 325(d) is not justified.

2. Petitioners Have Demonstrated Material Error by the Office

The Board has required a petitioner to provide an analysis under part two of *Advanced Bionics* “when the asserted prior art is on an IDS, but the Examiner did not apply the reference.” *Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 at 5 (PTAB May 19, 2025). “In that analysis, a petitioner must explain, with reference to *Becton Dickinson* factors (c), (e), and (f), how the Examiner erred in overlooking the prior art.” *Id.*

Factor (c) is “the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for the rejection.” *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17 (PTAB Dec. 15, 2017). As explained above, Kitano was cited by the Examiner, but it was not analyzed in combination with Kurosaki '087 and Miyamae, which were not of record during prosecution (and the references they are allegedly cumulative of—Matsubara and Kurosaki '632—were not relied on by the Examiner). Thus, this factor weighs in favor of institution.

Factor (e) is “whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art.” *Id.* Patent Owner claims that “Petitioners make no argument regarding error that would be material to the patentability of the challenged claims.” Paper 6 at 31. To the contrary, the Petition highlights that “[i]n a June 23, 2016, Office Action, the Examiner rejected claims *1*, 6, 7, *9*, 10, *11*, 14, 15 and *17-20* over prior art references but deemed claims 8, *12*, *13*, and 16 as including allowable subject matter” and “claim 9 was amended to incorporate the limitations of claims 11 and 12, which are also found in the rejected claim 19, and was issued as the challenged claim 8.” Pet. at 7-8 (emphasis added).

Claims 1, 9, 11, and 18 were rejected due to anticipation by Kitano, which the Examiner recognized discloses “allow[ing] the excitation light that has passed through the optical member to be made incident on the fluorescent material at a front

side of the fluorescent material as a light-condensing position” (claim 1) and “a light-condensing position of the excitation light is positioned on an emission side of the excitation light relative to the fluorescent material” (claim 9). EX1002, at 53-55. Claims 19 and 20 were rejected as unpatentable over Kitano in view of Masuda. *Id.* at 59-60.

The features of rejected claims 19 and 20, however, are the same as the claimed features of “the light source device” in claims 12 and 13, which means that if claims 1, 9, 11, and 18-20 were rejected during prosecution, then claims 12 and 13 should have been rejected as well, and “no reasonable examiner could have found otherwise.” *Ecto World*, IPR2024-01280, Paper 13 at 6 (vacating decision denying institution). This is a clear oversight that constitutes a material error in assessing patentability. *See id.* at 4-7. *Advanced Bionics* supports denial of institution only where prior art and arguments are duplicative and error-free. IPR2019-01469, Paper 6 at 8. Here, the Examiner’s failure to explain why certain claims were rejected while other claims having the same features disclosed by the same cited prior art references were allowed is a clear and material error. Thus, *Becton Dickinson* factors (e) weighs in favor of institution. Additionally, as discussed above, the Office did not previously address the grounds in the Petition, further evidencing the need for review. Accordingly, the Board should grant institution on the grounds set forth in the Petition. Factor (f) is “the extent to which additional evidence and facts presented in

the Petition warrant reconsideration of the prior art or arguments.” *Becton Dickinson*, IPR2017-01586, Paper 8 at 25. The Petition is supported by the declaration of Dr. Sasian, whose testimony was not considered by the Examiner. Dr. Sasian’s declaration explains in detail, *inter alia*, why a POSITA would be motivated to combine the teachings of Miyamae with Kurosaki ’087 (neither of which were of record during prosecution) (EX1004, ¶¶ 149-156), and why a POSITA would be motivated to combine the teachings of Kitano with Kurosaki ’087. *Id.* ¶¶ 159-164, 186, 216. Therefore, this factor weighs in favor of institution.

C. Additional Factors Set Forth in the March 26, 2025 Memorandum Do Not Support Denial

The Memo’s additional considerations do not justify denying institution for the reasons discussed below.

1. The Unpatentability Challenges Are Strong

Patent Owner disputes the rationale for combining Miyamae and Kurosaki ’087 (Ground 3) and Kitano and Kurosaki ’087 (Ground 4). Paper 6 at 32-37. But the Petition and the expert declaration provide clear motivation for combining Miyamae and Kurosaki ’087: both references are directed to projection-type image display devices; combining them would have amounted to simple substitution of one known element (Kurosaki’s fluorescent-material (phosphor)-based light source) for another (Miyamae’s light source) to obtain predictable results; and doing so offers certain advantages (improving the efficiency of the light source due to the shape of

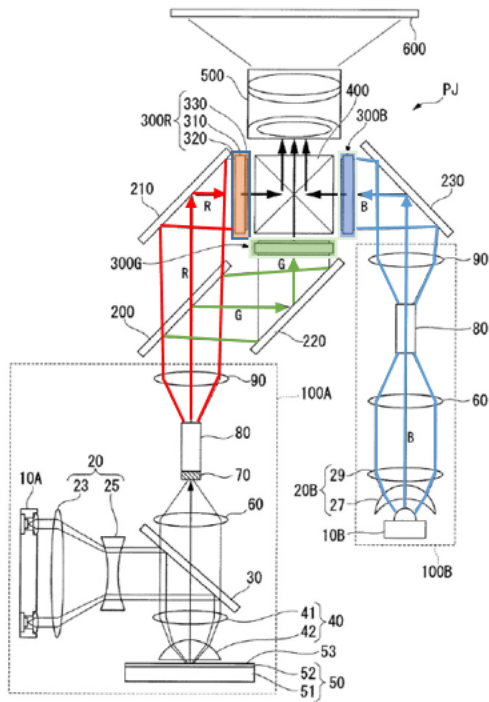
the emission face of the phosphor being substantially equivalent to the shape of the rod integrator). Pet. at 47-49.

The expert declaration points out that “Miyamae describes a rod integrator 80 having a cross-sectional shape similar to the external shape of the image forming area of liquid crystal light valves 300R, 300G, 300B.” EX1006, [0051]. Similarly, Kurosaki describes the display element and the light tunnel as having the same shape and, additionally, a region illuminated with excitation light beams as having the same shape as both the display element and light tunnel.” EX1004, ¶ 156. To “***obtain an efficient light source device*** in which a phosphor is used as the light source, it is effective for the shape of the emission face of the phosphor to be substantially equivalent to the shape of the rod integrator.” EX1004, [0014] (emphasis added).

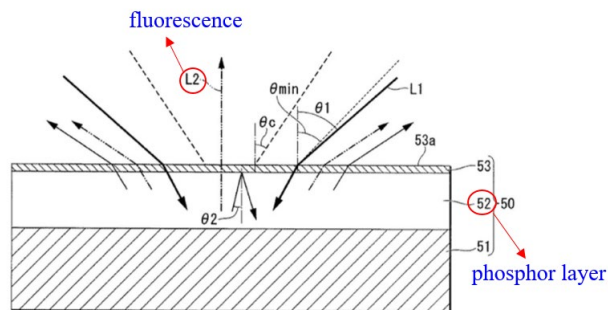
As taught by Kitano and pointed out in the Petition (at 48), a POSITA would have recognized that the excitation light irradiated onto the phosphor layer 52 of Miyamae would have luminance distribution having the same shape as that of the cross section of rod integrator 80 as taught by Kurosaki in order that the light from the phosphor would substantially enter into the rod integrator 80. *See KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 401 (2007) (“If a person of ordinary skill in the art can implement a predictable variation, and would see the benefit of doing so, § 103 likely bars its patentability. Moreover, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that

it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill.”)

Furthermore, Challenged Claim 12 concerns the excitation light irradiated on to the fluorescent material. As shown below in the annotated Miyamae Figs. 1 and 5, the light from LED 10B does not interact with the fluorescent material, *i.e.*, phosphor layer 52; LED 10B is thus irrelevant to the limitation recited in Challenged Claim 12. The Petition describes the light source device 100A, which include light source 10A and fluorescent layer 52 and points out that a POSITA would have recognized that Kurosaki describes a ***fluorescent-material (phosphor)-based*** light sources that is compatible with system described in Miyamae, and that combining Miyamae and Kurosaki would have amounted to simple substitution of one known element for another to obtain predictable results. Paper at 32 and at 47. The Petition thus makes it abundantly clear that the simple substitution is for light source 10A of Miyamae. Patent Owner’s assertion that the Petition fails to identify the light source being substituted is groundless.



Annotated Fig. 1 of Miyamae



Annotated Fig. 5 of Miyamae

The Petition also provides a clear reason for combining Kitano and Kurosaki '087: both references are directed to projection-type image display devices; combining them would have amounted to simple substitution of one known element (Kurosaki's convex and concave lenses) for another (Kitano's optical elements between the laser light source and the dichroic mirror) to obtain predictable results; and doing so offers certain advantages (enhancing lens systems for better illumination and/or reducing the cost). *Id.* at 54-55.

Patent Owner contends that because Kitano already has a phosphor wheel and associated lenses, it is incumbent upon Petitioners to explain the *motivation* to

substitute Kitano’s components with those disclosed in Kurosaki ’087. But Patent Owner’s assertion is contrary to law. Requiring a showing of motivation here is inconsistent with Supreme Court precedent. See *KSR*, 550 U.S. at 419. Obviousness can be found based on other rationales, such as simple substitution of one know element for another to obtain predictable results. *Id.* at 417-418; *see also In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (“The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.”) Patent Owner’s critiques amount to technical quibbles (*e.g.*, lens alignment differences) that are insufficient to justify discretionary denial.

2. There Is No Undue Delay or Gamesmanship

Patent Owner alleges a delay of “nearly two years” in filing the Petition, based on Petitioners purportedly “first learning of Maxell’s infringement allegations in April 2023.” Paper 6 at 37. But Maxell’s April 2023 correspondence asked Petitioners to evaluate a potential license to over forty patents, and did not explain which claims of each patent would be asserted against Petitioners or how Petitioners’ products allegedly satisfy the limitations of such claims. In reality, the Petition was filed a mere three months after Petitioners received Patent Owner’s infringement

contentions, and well within the one-year statutory deadline under 35 U.S.C. § 315(b). *Fintiv* explains that “it is often reasonable for a petitioner to wait to file its petition *until it learns which claims are being asserted against it in the parallel proceeding.*” IPR2020-00019, Paper 15 at 11 (emphasis added). And, contrary to Patent Owner’s specious assertion of bad faith, pre-litigation discussions and motion practice in district court (*e.g.*, motions to dismiss) were perfectly reasonable steps to resolve the parties’ dispute. In short, Patent Owner’s speculative claim of “undue delay and gamesmanship” is completely unsupported and should be rejected out of hand.

3. The Petition is Properly Supported by Dr. Sasian’s Declaration

Patent Owner criticizes Dr. Sasian’s declaration for supposedly “restating arguments and assertions made by Petitioners’ counsel” and therefore lacking independent analysis. Paper 6 at 38-44. However, the vast majority of examples cited by Patent Owner where the same language is used in the Petition and expert declaration are simply identifying features of and/or quoting from the prior art and therefore do not require extensive analysis or exposition by Dr. Sasian. *See id.* at 38 (Kurosaki discloses a light source device and projector), 39-40 and 42-44 (quoting excerpts from Kurosaki, Miyamae, and Kitano). The two remaining examples provide Dr. Sasian’s analysis of the prior art’s teachings and clearly explain his

reasoning based on specific figures and text in Kurosaki and Miyamae. *Id.* at 41-42; EX1004, ¶¶ 87 and 128.

In the *Xerox* case cited by Patent Owner, the expert declaration “merely offered conclusory assertions without underlying factual support and repeated, *verbatim*, Petitioner’s conclusory arguments.” IPR2022-00624, Paper 12 at 5 (PTAB Feb. 10, 2023). Here, by contrast, there are no such conclusory assertions in the Petition, which explains why the limitations of the challenged claims are necessarily present in the references or why they would have been obvious in light of the reference’s disclosure and the knowledge of a POSITA, and further, all of the statements in Dr. Sasian’s declaration are based on the teachings of the references he cited and the knowledge of a POSITA.

The fact that the Petition mirrors the analysis in the declaration (not the other way around, as Patent Owner baselessly alleges) shows that the Petition is supported by Dr. Sasian’s analysis and does nothing to diminish the weight that should be accorded to his testimony. Patent Owner’s flawed argument in this regard provides no support at all for discretionary denial.

4. A *Sotera* Stipulation Remains Available

Patent Owner objects that “Petitioners have not made a proper *Sotera*-style stipulation . . . which weighs further in favor of discretionarily denying institution.” Paper 6 at 45. Petitioners disagree. The stipulation set forth in the Petition—that

Petitioners “will not pursue the grounds identified in this Petition before the district court” (Pet. at 11)—is sufficient to mitigate any potential overlap of issues and conflicting rulings between the two proceedings. Further, as mentioned above, Petitioners commit to a broader *Sotera*-style stipulation (filed concurrently herewith, EX1009), *i.e.* upon institution, Petitioners will not (i) pursue the grounds presented in the Petition in the parallel district court case, or (ii) pursue any other ground that reasonably could have been raised in the Petition in the parallel district court case. *Sotera*, IPR2020-01019, Paper 12 at 13-14.

Patent Owner’s assertion that “[t]he Board should not accept any late *Sotera* stipulation potentially offered after [the] Request for Discretionary Denial” is contrary to Board precedent. *See BMW of North America, LLC v. Northstar Systems LLC*, IPR2023-01017, Paper 12 at 10 (PTAB Dec. 8, 2023) (“Patent Owner has not brought to our attention any binding precedent that establishes a time limit by which a *Sotera* stipulation must be submitted before we enter our decision on institution, and we are not aware of any such precedent.”) Patent Owner’s alleged prejudice—that it will be “forced to prepare overlapping validity defenses” in both proceedings if a “late” *Sotera* stipulation is accepted by the Board—can be asserted in most if not all cases, and therefore is not a persuasive reason to exercise discretionary denial. Indeed, the Board has noted that, as a practical matter, a petitioner need only “submit a *Sotera* stipulation well in advance of the Board’s deadline for entering its

institution decision, in order to ensure that the Board has the opportunity to consider it.” *Id.* n.11. Petitioners have done so here. Accordingly, this factor does not support discretionary denial.

III. CONCLUSION

For the foregoing reasons Patent Owner’s Request for Discretionary Denial should be rejected, and the Board should institute IPR to address the merits of the Petition’s unpatentability challenges.

Dated: June 10, 2025

Respectfully submitted,

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24, the undersigned attorney for the Petitioners declares that the argument section of this Petition has 6,180 words, according to the word count tool in Microsoft Word™.

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CERTIFICATE OF SERVICE

The undersigned certifies, in accordance with 37 C.F.R. §§ 42.105 and 42.6, that service was made via electronic mail on the Patent Owner's counsel as detailed below.

Date of service June 10, 2025

Manner of service Electronic Mail and UPS Mail Service

Documents served PETITIONERS' OPPOSITION TO PATENT OWNER'S
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