

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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BOE TECHNOLOGY GROUP CO., LTD.,  
Petitioner,

v.

PANELTOUCH TECHNOLOGIES LLC,  
Patent Owner.

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U.S. Patent No. 11,126,025  
Original Issue Date: September 21, 2021  
Title: IN-CELL TOUCH PANEL

Case No. IPR2025-01267

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**OPPOSITION TO PATENT OWNER'S  
REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION**

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**LISTING OF PETITIONER’S EXHIBITS**

| <b>Exhibit</b> | <b>Description</b>                                                                                           |
|----------------|--------------------------------------------------------------------------------------------------------------|
| 1001           | U.S. Patent No. 11,126,025 (the “’025 patent”)                                                               |
| 1002           | Prosecution History of U.S. Patent No. 11,126,025                                                            |
| 1003           | Declaration of Richard A. Flasck, M.S. (“Flasck Decl.”)                                                      |
| 1004           | <i>Curriculum Vitae</i> of Richard A. Flasck, M.S. (“Flasck C.V.”)                                           |
| 1005           | U.S. Patent Application Publication No. 2016/0224155 A1 (“Kim”)                                              |
| 1006           | U.S. Patent Application Publication No. 2017/0192568 A1 (“Kim II”)                                           |
| 1007           | U.S. Patent Application Publication No. 2018/0113541 A1 (“Xie”)                                              |
| 1008           | U.S. Patent Application Publication No. 2019/0294273 A1 (“Yoshida”)                                          |
| 1009           | Japanese Patent Application No. 2018-058356 and Certified Translation (“Translation”)                        |
| 1010           | U.S. Patent No. 3,824,003                                                                                    |
| 1011           | Willem den Boer, <i>Active Matrix Liquid Crystal Displays: Fundamentals and Applications</i> (Elsevier 2005) |
| 1012           | U.S. Patent No. 4,582,395                                                                                    |
| 1013           | Excerpt from <i>Wiley Electrical and Electronics Engineering Dictionary</i> (2004)                           |
| 1014           | Redline comparing Claims 10 and 18 of U.S. Patent No. 11,126,025                                             |
| 1015           | U.S. Patent Application Publication No. 2016/0054627 A1                                                      |
| 1016           | Declaration of Will Melehani In Support of Petitioner’s Motion for Admission <i>Pro Hac Vice</i>             |

| <b>Exhibit</b> | <b>Description</b>                                                                                                                                              |
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| 1017           | Assignment of '025 patent to Paneltouch                                                                                                                         |
| 1018           | District Court Complaint                                                                                                                                        |
| 1019           | Waiver of Service                                                                                                                                               |
| 1020           | <i>Intentionally Omitted</i>                                                                                                                                    |
| 1021           | Email between BOE and Paneltouch regarding Waiver of Service, dated July 23, 2025                                                                               |
| 1022           | Docket Control Order, <i>Netlist Inc. v. Samsung Elecs. Co., Ltd.</i> , No. 2:25-CV-00557-JRG, Dkt. No. 29 (E.D. Tex. July 25, 2025)                            |
| 1023           | Docket Control Order, <i>Resonant Sys., Inc. v. Nintendo Co., Ltd.</i> , No. 2:25-cv-00090-JRG, Dkt. No. 32 (E.D. Tex. May 30, 2025)                            |
| 1024           | Docket Sheet, <i>CLO Virtual Fashion Inc. v. Zhejiang Lingdi Digital Tech. Co., Ltd.</i> , No. 2:23-cv-00274-JRG-RSP (Printed October 24, 2025)                 |
| 1025           | Docket Control Order, <i>CLO Virtual Fashion Inc. v. Zhejiang Lingdi Digital Tech. Co., Ltd.</i> , No. 2:23-cv-00274-JRG-RSP, Dkt. 32 (E.D. Tex. Dec. 19, 2023) |
| 1026           | Docket Sheet, <i>Multimedia Techs. Pte. Ltd. v. LG Elecs. Inc.</i> , No. 2:22-cv-00494-JRG (Printed October 24, 2025)                                           |
| 1027           | Docket Control Order, <i>Multimedia Techs. Pte. Ltd. v. LG Elecs. Inc.</i> , No. 2:22-cv-00494-JRG, No. 2:23-cv-00274-JRG-RSP, Dkt. 20 (E.D. Tex. Feb. 7, 2024) |
| 1028           | Docket Sheet, <i>Headwater Research LLC v. Samsung Electronics Co. Ltd.</i> , No. 2:23-cv-00103-JRG-RSP (Printed October 24, 2025)                              |
| 1029           | Docket Control Order, <i>Headwater Research LLC v. Samsung Electronics Co. Ltd.</i> , No. 2:23-cv-00103-JRG-RSP, Dkt. 63 (E.D. Tex. Dec. 1, 2023)               |

| <b>Exhibit</b> | <b>Description</b>                                                                                                                                     |
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| 1030           | Docket Sheet, <i>General Access Solutions, Ltd. v. T-Mobile USA, Inc.</i> , No. 2:23-cv-00158-JRG (Printed October 23, 2025)                           |
| 1031           | Docket Control Order, <i>General Access Solutions, Ltd. v. T-Mobile USA, Inc.</i> , No. 2:23-cv-00158-JRG, Dkt. 34 (E.D. Tex. Aug. 11, 2023)           |
| 1032           | Docket Sheet, <i>Video Solutions Pte. Ltd. v. Cisco Systems, Inc.</i> , No. 2:23-cv-00222-RWS-RSP (Printed October 24, 2025)                           |
| 1033           | Docket Control Order, <i>Video Solutions Pte. Ltd. v. Cisco Systems, Inc.</i> , No. 2:23-cv-00222-RWS-RSP, Dkt. 36 (E.D. Tex. Aug. 18, 2023)           |
| 1034           | Docket Sheet, <i>Daingean Technologies Ltd. v. T-Mobile USA, Inc.</i> , No. 2:23-cv-00347-JRG-RSP (Printed October 24, 2025)                           |
| 1035           | Docket Control Order, <i>Daingean Technologies Ltd. v. T-Mobile USA, Inc.</i> , No. 2:23-cv-00347-JRG-RSP, Dkt. 55 (E.D. Tex. Jan. 26, 2024)           |
| 1036           | Docket Sheet, <i>Ravikumar MD v. Memorial Health System of East Texas</i> , No. 2:23-cv-00560-JRG-RSP (Printed October 24, 2025)                       |
| 1037           | Docket Control Order, <i>Ravikumar MD v. Memorial Health System of East Texas</i> , No. 2:23-cv-00560-JRG-RSP, Dkt. 29 (E.D. Tex. Jan. 24, 2024)       |
| 1038           | Docket Sheet, <i>Collision Communications, Inc. v. Samsung Electronics Co. Ltd.</i> , No. 2:23-cv-00587-JRG (Printed October 24, 2025)                 |
| 1039           | Docket Control Order, <i>Collision Communications, Inc. v. Samsung Electronics Co. Ltd.</i> , No. 2:23-cv-00587-JRG, Dkt. 36 (E.D. Tex. Apr. 17, 2024) |
| 1040           | Decision Referring the Petitions to the Board, <i>Geotab Inc. v. Fractus, S.A.</i> , IPR2025-01026, Paper 14 (P.T.A.B. Oct. 17, 2025)                  |

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| Exhibit | Description                                                                                                                                       |
|---------|---------------------------------------------------------------------------------------------------------------------------------------------------|
| 1041    | Decision Referring the Petitions to the Board, <i>Apple Inc. v. Apex Beam Technologies LLC</i> , IPR2025-00896, Paper 10 (P.T.A.B. Sept. 3, 2025) |
| 1042    | January 2024 IDS in the prosecution history of U.S. Patent No. 12,436,639                                                                         |

**I. INTRODUCTION**

This *inter partes* review should be instituted because all considerations relating to the *Fintiv* factors weigh against discretionary denial here. As Patent Owner Paneltouch Technologies LLC (“Paneltouch” or “Patent Owner”) admits, the co-pending district court litigation has only just begun, and the Court has not yet entered a scheduling order. Moreover, neither the parties nor the Court has invested any meaningful resources into the case. Given the Court’s recent scheduling orders, the final written decision in this case will come before any trial before the court and achieve the desired efficiencies of the IPR process.

Paneltouch’s suggestion that the district court will reach trial before the final written decision relies on a misleading application of statistics that fail to account for Paneltouch’s significant delay in serving the Complaint and the eight-month gap between the date the Complaint was filed and the date of Petitioner’s Answer. Moreover, given the incredibly early stage of this case, a stay is also likely, which further adds to the efficiency.

Discretionary denial is also inappropriate here because Paneltouch has no basis for settled expectations concerning the claims of the ’025 patent. The patent is only four years old, far younger than the patents that the former Acting Director found would lead to settled expectations in the validity of its claims. Moreover, the ’025 patent has never been asserted in litigation and, as far as BOE can tell, has

never even been the subject of an offer to license. Thus, in the four short years it has been in force, no one has had a strong reason to challenge the validity of the '025 patent, and the only reasonable expectation Paneltouch could have held is that that validity of these young and untested claims would be called into question when asserted.

In view of these circumstances (as discussed in detail below), discretionary denial is not appropriate here. BOE's Petition should be referred to the Board.

## **II. BACKGROUND**

### **A. The '025 Patent Issued Only Four Years Ago**

The '025 patent was prosecuted in the United States as Application No. 16/784,806, which was filed on February 7, 2020, and issued on September 21, 2021. Ex. 1001, (21) (22) (45). The '025 patent claims priority to two Japanese patent applications and is not related to any other U.S. patents or applications.

The '025 patent was originally assigned to Panasonic Liquid Crystal Display Co., Ltd. ("Panasonic"). Panasonic never filed any lawsuits asserting the '025 patent. Paneltouch did not acquire the '025 patent until 2024. *See* Ex. 1017 at 1 (Assignment to Paneltouch, recorded Apr. 27, 2024).

### **B. The Co-Pending Litigation**

Following Paneltouch's acquisition of the '025 patent last year, Paneltouch filed suit in the Eastern District of Texas in February 2025. *See generally* Ex. 1018

(District Court Complaint). The Complaint asserts five patents. *Id.*

Petitioner is a foreign company and, by default, must be served through specific procedures, typically involving the very lengthy Hague Convention process. Despite having no obligation to do so, Petitioner relieved Paneltouch of the burdens of service and submitted a waiver of service on July 24, 2025. Ex. 1019 (Waiver of Service).

This co-pending Texas litigation is only just beginning. Petitioner filed its Answer to the Complaint on October 21, 2025, and on that same day, the Court issued an order setting the scheduling conference for November 24, 2025. Beyond issuing that order, the Court has not invested in the litigation in any way.

Paneltouch only recently served its infringement contentions, which merely parrot the charts it included with its Complaint. No discovery requests have been made, and no discovery responses or documents have been produced. There have been no depositions. The parties have not begun any part of the claim construction process, and expert discovery is likely many months away, if not over a year.

### **C. The *Inter Partes* Review Petitions**

Petitioner promptly filed *inter partes* reviews challenging all five patents asserted in the Texas case, each of which are invalid for the reasons explained in the Petitions submitted in IPR2025-01267 (this proceeding), IPR2025-01245, IPR2025-01246, IPR2025-01482, and IPR2025-01483.

The Petition challenging the '025 patent was filed and served on August 5, 2025, and was accorded that filing date on August 18, 2025. *See* Papers 1, 3.

Thus, the institution decision for the '025 patent is expected on February 18, 2026, and, if instituted, the final written decision is expected on February 18, 2027. BOE submitted a *Sotera* stipulation in this proceeding on August 28, 2025. *See* Paper 7.

### **III. EVERY *FINTIV* FACTOR WEIGHS AGAINST DISCRETIONARY DENIAL**

Paneltouch articulates no compelling reason why the Director should exercise discretionary denial in this IPR. Every *Fintiv* factor weighs against denial under 35 U.S.C. § 314 and none of the “additional considerations” that Paneltouch raises favors denial.

#### **A. The *Fintiv* Factors Weigh Against Discretionary Denial**

As discussed in detail below, all six *Fintiv* factors weigh against denial, with Factors 2, 3, 4, and 6 strongly weighing against denial.

##### **1. Factor 1: Evidence Exists That a Stay May be Granted if a Proceeding is Instituted**

Neither party has yet moved to stay the district court case. But consistent with EDTX practice, Petitioner intends to move for a stay after the five IPRs challenging all of the asserted patents are instituted, and expects that the motion to stay will be granted.

Paneltouch argues that this factor favors discretionary denial because it

believes that the Court will deny any motion to stay. However, Paneltouch's basis for this assertion is a misreading of generalized and misleading statistics extending all the way back to 2014. Paper 8, Patent Owner's Request for Discretionary Denial of Institution ("Brief") at 3-5. In particular, because Paneltouch's statistics include pre-institution motions, they are skewed and heavily weighted against denial. *See id.* at 3 (referring to pre-institution denial as a "universal practice" in EDTX).

Correcting for Paneltouch's overinclusion of pre-institution motions shows that Judge Gilstrap is very likely to grant a stay here. More specifically, the statistics in Paneltouch's brief indicate that in 2025, the Court granted only three motions to stay, but denied twelve such motions. *Id.* at 4. Paneltouch neglects to mention, however, that nine of those twelve decisions concerned pre-institution motions and were denied *without* prejudice. *See Advanced Integrated Circuit Process LLC v. Taiwan Semiconductor Mfg. Co., Ltd.*, No. 2:25-cv-00324-JRG, Dkt. No. 71 (E.D. Tex.); *Telcom Ventures LLC v. Samsung Elecs. Co., Ltd.*, No. 2:24-cv-00691-JRG, Dkt. No. 53 (E.D. Tex.); *Keyless Licensing LLC v. Samsung Elecs. Am., Inc.*, No. 2:24-cv-00464-JRG, Dkt. No. 52 (E.D. Tex.); *Four Batons Wireless, LLC v. Samsung Elecs. Co., Ltd.*, No. 2:24-cv-00284-JRG, Dkt. No. 74 (E.D. Tex.); *iCashe, Inc. v. Samsung Elecs. Co., Ltd.*, No. 2:24-cv-00429-JRG, Dkt. No. 38 (E.D. Tex.); *Truesight Commc'ns LLC v. Samsung Elecs. Co., Ltd.*,

No. 2:23-cv-00643-JRG, Dkt. No. 85 (E.D. Tex.); *Lionra Techs. Ltd. v. Cisco Sys., Inc.*, No. 2:24-cv-00097-JRG, Dkt. No. 36 (E.D. Tex.); *Emerging Automotive LLC v. Kia Corp.*, No. 2:23-cv-00437-JRG, Dkt. No. 162 (E.D. Tex.); *Mullen Indus. LLC v. Samsung Elecs. Co., Ltd.*, No. 2:24-cv-00049-JRG, Dkt. No. 71 (E.D. Tex.). Of the three remaining motions, one was denied because IPR was not ultimately instituted. *Advanced Integrated Circuit Process LLC v. United Microelectronics Corp.*, No. 2:24-cv-00730-JRG, Dkt. No. 127 (E.D. Tex.). As to the two other decisions, both involved cases where the final written decision would be due *several months* after trial. *See Lionra Techs. Ltd. v. Cisco Sys., Inc.*, No. 2:24-cv-00097-JRG, Dkt. No. 58 (E.D. Tex.) (denying stay when FWD was “not due until a date more than five months after the jury trial is set to begin”); *Croga Innovations Ltd. v. Cisco Sys., Inc.*, No. 2:24-cv-00065-JRG, Dkt. No. 108 (E.D. Tex.) (FWD due four months after trial).

By contrast, the facts of the cases where Judge Gilstrap granted a stay are very similar to those at issue here. In *Resonant Sys., Inc. v. Nintendo Co.*, the Court granted a stay, noting that it was appropriately requested early in the case and that the final written decision would be due before trial. No. 2:25-CV-90-JRG,

Dkt. No. 57 (E.D. Tex. July 25, 2025).<sup>1</sup> Similarly, in *Maxeon Solar Pte. Ltd. v. Canadian Solar Inc.*, the Court granted a stay where the petitioner promptly filed and, at the time it moved to stay, “the parties ha[d] yet to notice or take a single deposition and discovery remain[ed] at a relatively early stage,” and the “Court ha[d] not yet begun the claim construction process.” No. 2:24-CV-210-JRG, 2025 WL 1811321, at \*2 (E.D. Tex. July 1, 2025). *See also Veraseal LLC v. Wal-Mart Stores, Inc.*, No. 2:17-CV-527-JRG, 2018 WL 2183235, at \*2 (E.D. Tex. May 11, 2018) (“the benefits of a stay outweigh the costs of postponing resolution ... in this particular case” because “the patent claims have not yet been construed by the Court, and discovery is not yet complete”); *Commc’ns Techs., Inc. v. Samsung Elecs. Am., Inc.*, No. 2:21-CV-444-JRG, 2023 WL 1478447, at \*3 (E.D. Tex. Feb. 2, 2023) (“with the close of discovery, the claim construction hearing, and the trial setting all in the future,” this “weighs in favor of a stay”). As mentioned, this case has barely just begun, has had essentially no substantive litigation, and (as explained below) will almost certainly have a trial date after the final written decision is due. Thus, contrary to Paneltouch’s misleading use of inapplicable statistics, an analysis of the facts of the cases before Judge Gilstrap demonstrates

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<sup>1</sup> One of the three cases where a stay was granted is actually just this same order filed in error in another matter. *See Analytical Techs., LLC v. Little Caesar Enters., Inc.*, No. 2:24-cv-00090 (E.D. Tex.).

that this matter has far more in common with the cases where he granted a stay pending IPR than with the few cases where he declined to do so.

**2. Factor 2: No Court Trial Date Has Been Set, and Any Trial Date Would Fall After the Board's Final Written Decision**

This factor weighs strongly against denial. Paneltouch delayed serving its Complaint for several months and the case is still at its earliest stages. No case schedule has been entered in the Texas district court action, and no trial date has been set. When a trial date is set, it will fall after the projected February 18, 2027 final written decision date for this IPR.

Paneltouch's use of time-to-trial statistics to suggest this case will be tried in December 2026 is misleading and irrelevant. These statistics focus on the time between the filing of the Complaint and the trial. That metric provides an artificial and unhelpful data point, because it is the *response* to the Complaint, rather than its mere filing, that triggers the case deadlines that ultimately lead to the trial. This distinction makes Paneltouch's statistics particularly misleading, because although Paneltouch filed its case in February 2025, it did not serve BOE or send BOE a waiver of service until July 19, 2025 (to which BOE promptly agreed). Ex. 1019. As a result of Paneltouch's delay, BOE's response to the Complaint was due on October 21, 2025, a full eight months after this case was filed. Indeed, Paneltouch appears to acknowledge that its statistics do not account for its several-month delay

in serving the Complaint, noting that it expects Petitioner will “disagree[] as to the likely trial date” based on this gap. Brief at 16.

Paneltouch attempts to refute this reality by baselessly alleging that its delay in serving Petitioner was somehow the result of Petitioner’s gamesmanship. Brief at 15-16. Yet Paneltouch provides no evidence that it “notified” Petitioner of its Complaint when it was filed, nor would such notice constitute effective service in any event. The actual correspondence, which Paneltouch did not provide, shows that Paneltouch did not approach Petitioner with a request to waive service until July 19, 2025, to which Petitioner immediately agreed. *See* Ex. 1021.

This is the opposite of gamesmanship. Petitioner is a foreign entity, and Paneltouch would otherwise likely have had to serve Petitioner through the Hague Convention, a process that, as Paneltouch describes, “can take a year or longer.” Brief at 15. If Petitioner were attempting to engage in gamesmanship, it would have refused to waive service and required Paneltouch to use the Hague Convention process. Instead, by waiving service, Petitioner surrendered any potential tactical advantage due to its status as a foreign entity and voluntarily made Paneltouch’s task far easier than it otherwise would have been.

In any event, given the significant gap between when Paneltouch served the Complaint and when Petitioner provided its Answer, it is necessary to adjust Paneltouch’s statistics. If Paneltouch’s own alleged 22-months-to-trial statistic is

instead—more accurately—applied to the case’s October Answer date, the expected trial date would be in August 2027, well after the February 2027 final written decision date. And, notably, with the final written decision date set for fifteen months from now, Paneltouch has not identified a single scheduling order from Judge Gilstrap where he set trial for a date less than fifteen months out. A review of Judge Gilstrap’s scheduling orders instead shows that he tends to set trial much further out than that. *See* Ex. 1022 (*Netlist Inc. v. Samsung Elecs. Co., Ltd.*, No. 2:25-CV-00557-JRG) (trial set for nearly twenty months after scheduling conference); Ex. 1023 (*Resonant Sys., Inc. v. Nintendo Co., Ltd.*, No. 2:25-cv-00090-JRG) (trial set for seventeen months after scheduling conference). Nor has Paneltouch addressed Judge Gilstrap’s practice of double or triple booking trial dates, leading to many cases having their trials delayed beyond the date set by the initial scheduling order. *See, e.g.*, Ex. 1024 (*CLO Virtual Fashion* Docket Sheet) at 9, 30, 32, 35-38 (resetting trial, for the ninth time, to October 27, 2025, after it was initially set for April 7, 2025); Ex. 1026 (*Multimedia Techs.* Docket Sheet) at 12, 28, 31-35 (resetting trial, the eighth time, to May 19, 2025, after it was initially set for November 18, 2024).

Thus, based on Paneltouch’s own statistics, as well as Judge Gilstrap’s scheduling orders in other recent patent cases and trial-setting practices, it is far more likely that this case will not go to trial until well after the expected final

written decision date of February 18, 2027. Thus, this factor strongly weighs against denial.

**3. Factor 3: There Has Been No Investment in the Parallel Proceeding by the Court and the Parties**

This factor weighs strongly against denial. Paneltouch admits that there has been no meaningful investment in the Texas litigation by any of the parties or the Court, that a scheduling order has not been entered, and that claim construction has not occurred. Brief at 6-7. Petitioner has only answered the Complaint, and Patent Owner has recently provided infringement contentions that merely parrot the charts included in its Complaint. The case has otherwise not yet had a scheduling conference, claim construction proceedings, invalidity contentions, document production, fact discovery, expert discovery, or anything else.

As the *Fintiv* panel noted, if “the district court has not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution,” while “claim construction orders may indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial.”

*Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 9-10 (PTAB Mar. 20, 2020).

Here, the District Court has not made a single substantive ruling on the challenged patent, and so obviously has not issued a claim construction order. This factor thus weighs strongly against discretionary denial.

**4. Factor 4: There is No Evidence of Overlap Between Issues Raised in the Petition and in the Parallel Proceeding**

This factor strongly weighs against denial. As discussed above, under all realistic timeframes for the Texas litigation, the Board would issue a final written decision in this IPR well before any potential, currently unscheduled, trial date. Thus, the estoppel arising from the final written decision will ensure that the grounds addressed in the IPR will differ from any grounds of invalidity of the challenged patent that may ultimately be presented during a theoretical Texas trial.

Petitioner has also filed a *Sotera* stipulation to ensure that any potential concerns regarding any speculative overlap have been resolved in advance. *See* Paper 7. Paneltouch complains that this *Sotera* stipulation is not sufficient here, but its argument is based on a misreading of *Motorola v. Stellar*, IPR2024-01205, Paper 19 (PTAB March 28, 2025). Brief at 7-11. Institution was not denied in *Motorola* because a *Sotera* stipulation is categorically insufficient, as Paneltouch argues. Rather, institution was denied in *Motorola* because there had already been a “substantial investment in the district court proceeding” that outweighed the stipulation in that case. *Motorola*, Paper 19 at 2-4. Specifically, the parties had already “served extensive infringement and invalidity contentions, served opening and rebuttal expert reports, filed claim construction briefs, and conducted several depositions” and the Court had already “held a claim construction hearing and

construed the disputed claim terms,” all while preparing for a trial date “eleven months before the Board’s projected final written decision date.” *Id.* at 3.

In contrast, virtually nothing has occurred in the Texas case, and a scheduling order has not even issued. Paneltouch’s reliance on *Motorola* is thus misplaced, as there has been zero district court investment to outweigh the *Sotera* stipulation here.

Paneltouch’s suggestion—based on the proposed revisions to the USPTO’s Rules of Practice—that the Petition should be discretionarily denied because of the possibility that Petitioner will nonetheless present an invalidity case at trial is also without merit. It is true that the IPR process is designed to increase efficiency. Congress expressly set out the scope of estoppel warranted by resolution of an IPR, and Petitioner’s stipulation is consistent with that. Indeed, the IPR process as defined by statute increases efficiency regardless of whether the Petitioner maintains validity challenges in district court, by reducing issues. It is this efficiency, rather than the proposed efficiency of fully eliminating validity challenges before district court, that the statutory scheme enacted by Congress achieves. If Congress had instead intended for the IPR process to be a complete substitute for any and all validity challenges in court or other fora, it would not have drafted 35 U.S.C. § 315(e)(1) to apply estoppel only to those “ground[s] that the petitioner raised or reasonably could have raised during that inter partes

review.” *See 14 Penn Plaza LLC v. Pyett*, 556 U.S. 247, 259 n.6 (2009) (J.

Thomas) (explaining that legislative history cannot be used to contradict the plain language of a statute); *City of Chicago v. Environmental Defense Fund, Inc.*, 511 U.S. 328, 337 (1994) (J. Scalia) (explaining that it is the language of the statute, rather than any statement made in legislative committee reports, that is “the authoritative expression of the law”).

In addition to contradicting the express language of the statute, Paneltouch’s remaining comments—its “expectation” that currently unscheduled invalidity contentions will “include combinations of any art (including the art asserted in this IPR) with unpublished system art” and that the challenged claims “may subsequently be challenged again during any potential *ex parte* reexamination process”—are purely speculative and should not influence the discretionary denial analysis. Brief at 10-11. Indeed, given the strength of the Petition, it is far more likely that no such challenges would be possible or necessary, as the challenged claims are rendered invalid by the art presented in the Petition.

BOE’s submission of a *Sotera* stipulation, without any investment in the Texas litigation that could outweigh it, strongly weighs against denial.

**5. Factor 5: Because the PTAB Will Rule Before the District Court, the Same Party Factor Weighs Against Denial**

BOE and Paneltouch are the parties in both the district court litigation and

this IPR. Because, as discussed above, under all realistic timelines here, the Board will issue a final written decision before any possible district court trial, this factor weighs against discretionary denial. *See BMW of N. Am., LLC v. Mich. Motor Techs. LLC*, IPR2023-01234, Paper 11 at 14-15 (PTAB Jan. 26, 2024) (collecting cases, explaining when a final written decision “is likely to issue before the district court trial,” the Board has “weigh[ed] this factor against exercising discretion”); *see also NVIDIA Corp. v. Invensas Corp.*, IPR2020-00603, Paper 11 at 23 (PTAB Sept. 3, 2020) (this factor weighs against discretionary denial even where decisions are expected “around the same time”).

**6. Factor 6: Other Circumstances, Including the Merits, Weigh Against the Board’s Exercise of Discretion**

This factor weighs strongly against denial. The substantive merits of this IPR Petition are strong, and Paneltouch fails to identify even a single flaw on the merits.

Further, the fact that Paneltouch is asserting several patents against Petitioner in Court also weighs against discretionary denial. As the former Acting Director recently recognized, when the district court proceeding at issue involves many patents that “involve a diverse range of subject matter,” this “weighs against discretionary denial, as the Board is better suited to review a large number of patents involving diverse subject matter.” *Tesla Inc. v. Intell. Ventures II LLC*,

IPR2025-00217, Paper 9 at 2-3 (PTAB June 13, 2025). This case involves five patents directed to highly technical and discrete features of display technology, ranging from crack detection methods and capacitance reduction to electromagnetic field shielding and the arrangement and interaction of components in the layers of a touch panel stack. Thus, as in *Tesla*, the range of patents asserted in the Texas case here, all of which have been challenged in IPRs filed by BOE, weighs against discretionary denial.

Nor are there any “settled expectations” that weigh in favor of discretionary denial. The ’025 patent issued on September 21, 2021, merely four years ago. This patent is therefore as young or younger than those previously found to lack “settled expectations.” *See* Ex. 1040 (IPR2025-01026 Discretionary Decision) (refusing discretionary denial and finding that the patent owner had not developed strong settled expectations when a patent had been in force for four years); Ex. 1041 (IPR2025-00896 Discretionary Decision) (same). Further, to Petitioner’s knowledge, in its short life, the ’025 patent has never been asserted against anyone, either in Court or otherwise, such that its validity would be scrutinized.

Accordingly, when Paneltouch acquired the ’025 patent last year—when it was only three years old—there is no reason why, and Paneltouch has not articulated any reason why, it should have had strong settled expectations in the validity of these claims. *See* Ex. 1017; Ex. 1041 (IPR2025-00896 Discretionary Decision)

(finding no settled expectations in four-year-old patents when “Patent Owner has not sufficiently articulated” any reason why it might have strong settled expectations).

Instead, Paneltouch attempts to manufacture settled expectations based on the former Acting Director’s decision in *Irythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 (PTAB June 6, 2025), which is readily distinguishable. In that case, the former Acting Director explained that there were settled expectations weighing in favor of discretionary denial when a challenged patent’s claims had been in force for *13 years* and the petitioner had cited the patent in an IDS 12 years ago. Brief at 13.

Nothing like that occurred here. Paneltouch instead notes only that an examiner had cited the ’025 patent and members of its family (presumably with different claims) against some of BOE’s patent applications sometime in the past few years. However, there are no U.S. patents related to the ’025 patent (and thus no family members that could be subject to IPR), and the only time the ’025 patent was cited in one of BOE’s applications was in connection with BOE’s U.S. Patent No. 12,436,639. That patent’s prosecution history shows that the ’025 patent was mentioned, along with dozens of other patents, in an IDS filed in January 2024, only a year before Paneltouch filed its case against BOE. Ex. 1042. Further, at that time, the ’025 patent was owned by Panasonic and had never been asserted,

and Paneltouch has provided no reason as to why BOE should have then raised a challenge to the '025 patent, among the many other patents cited in that IDS, based on its mere status as potentially relevant prior art. In any event, these facts fail to show that BOE was aware of the '025 patent's claims for over a decade and did nothing about it, as was the case in *Irythm Technologies*. Rather, because these claims are young and entirely untested, the only "settled expectations" Paneltouch could reasonably harbor would be that these claims could have their validity challenged using established statutory and judicial processes.

**B. None of the other "Additional Considerations" Patent Owner Discusses Favor Discretionary Denial**

After its discussion of *Fintiv* Factor 6, Paneltouch's Brief references certain "additional considerations." None of them weigh in favor of discretionary denial.

**First**, Paneltouch alleges "no changes in the law support reconsideration of the validity of the '025 patent claims." Brief at 13. But existing law supports reviewing the invalidity of the '025 patent.

**Second**, as explained above, Paneltouch should not benefit from any alleged settled expectations (Brief at 13-14) as the '025 patent is only about four years old.

**Third**, Paneltouch does not identify even a single flaw in the merits of the Petition. Brief at 14-15. Paneltouch instead simply declares that, because the Petition was accompanied (as it must be) by an expert declaration, it must therefore

be “overly reliant on unreliable expert testimony to gap-fill holes in the prior art.”

*Id.* But, beyond this bombastic language, Paneltouch does not provide even a single example of a so-called “gap” being filled by expert testimony, nor does it identify any expert testimony that is purportedly “unreliable.” *Id.* Paneltouch’s assertion is unsupported and its failure to identify any criticism of the Petition proves the strength of the Petition’s merits.

***Fourth***, Paneltouch misstates the facts regarding waiver of service in the Texas litigation. Brief at 15-16. As stated, BOE promptly and voluntarily waived service, relieving Paneltouch of having to comply with its Hague Convention obligations, which, in its own words, are “lengthy foreign service protocols that can take a year or longer.” *Id.*; Ex. 1019. Thus, contrary to Paneltouch’s assertions, BOE has not engaged in any gamesmanship to delay the Texas case, but instead significantly simplified matters for Paneltouch by waiving service and permitting this case to move forward much earlier than it otherwise would have. To rule otherwise would discourage waiving service.

#### **IV. CONCLUSION**

For the foregoing reasons, BOE respectfully requests that the Director not discretionarily deny institution.

IPR2025-01267

U.S. Patent No. 11,126,025

Date: November 17, 2025

Respectfully submitted,

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**CERTIFICATE OF PAGE COUNT**

The undersigned certifies that the foregoing paper complies with the page limit set forth on the Interim Director Discretionary Process webpage (<https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>). The foregoing is not more than 20 pages.

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IPR2025-01267

U.S. Patent No. 11,126,025

**CERTIFICATE OF SERVICE**

The undersigned hereby confirms that the foregoing paper and associated Exhibits 1017-1019, 1021-1042 were served via electronic mail upon the following counsel of record for Patent Owner:

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