

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BOE TECHNOLOGY GROUP CO., LTD.

Petitioner

v.

BISHOP DISPLAY TECH LLC

Patent Owner

Case IPR2025-01330

U.S. Patent 7,995,047

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

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EXHIBIT LIST

Exhibit No.	Description
2001	Plaintiff's Complaint for Patent Infringement against BOE, No. 2:25-cv-00310, Dkt. 1 (E.D. Tex. Mar. 20, 2025)
2002	Plaintiff's Complaint for Patent Infringement against BOE, No. 2:25-cv-00309, Dkt. 1 (E.D. Tex. Mar. 20, 2025)
2003	Consolidation Order in Bishop v. BOE, No. 2:25-cv-00310, Dkt. 42 (E.D. Tex. Aug. 27, 2025)
2004	Correspondence with BOE regarding the '047 patent (July 29, 2020)
2005	Correspondence with BOE regarding the '047 patent (July 29, 2020)
2006	<i>MyPort, Inc. v. Samsung Elecs. Co., Ltd.</i> , Case No. 2:22-cv-00114-JRG, Order, Dkt. 73 (E.D. Tex. June 13, 2023)
2007	BOE's Disclosure of Invalidity Contentions Under Patent Rules 3-3 and 3-4, No. 2:24-cv-00195 (E.D. Tex. Sep. 24, 2025)
2008	Plaintiff's Complaint in <i>Bishop Display Tech LLC v. Samsung Electronics Co., Ltd. et al.</i> , C.A. No. 2:21-cv-00139 (E.D. Tex. 2021)
2009	Plaintiff's Complaint in <i>Bishop Display Tech LLC v. Innolux Corporation</i> , C.A. No. 2:22-cv-00385 (E.D. Tex. 2022)
2010	Plaintiff's Complaint in <i>Bishop Display Tech LLC v. LG Electronics Inc. et al.</i> , C.A. No. 2:24-cv-00085 (E.D. Tex. 2024)
2011	Samsung's IPR Petition in <i>Samsung Electronics Co., Ltd. V. Bishop Display Tech LLC</i> , IPR2022-00501 (PTAB Jan. 31, 2022)

I. INTRODUCTION

Pursuant to Director Stewart’s March 26, 2025, Memorandum titled “Interim Processes for PTAB Workload Management” (“Workload Memo”), Patent Owner Bishop Display Tech LLC (“Patent Owner”) respectfully requests that the Director exercise discretion and deny institution of *inter partes* review under 35 U.S.C. § 314(a).

Given the circumstances presented here, discretionary denial is warranted based on these and other considerations. Indeed, the challenged patent has been in force for over thirteen years with Petitioner BOE having actual knowledge of the challenged patent at least since July 29, 2020. Denial is warranted in view of the district court trial between Patent Owner and the Petitioner with respect to the validity of the challenged patent that will commence on January 11, 2027, which is *before* the February 2027 date of the Board’s final decision here. If instituted, the Board would have to expend substantial resources to decide issues that will have already been addressed and decided by the district court. Furthermore, the district court is highly unlikely to grant a stay.

II. BACKGROUND

Patent Owner filed a complaint accusing Petitioner of infringing claim 1 of

U.S. Patent No. 7,995,047 (the “’047 patent”)¹ on March 20, 2025 in one complaint. Ex. 2001. Patent Owner filed another complaint accusing Petitioner of infringing six other patents. Ex. 2002. The district court consolidated those cases for all pretrial issues on August 27, 2025. Ex. 2003. A schedule for the parallel proceeding was entered on July 23, 2025. Ex. 1008 at 1.

Since then, the parties to the parallel proceeding have exchanged infringement contentions and invalidity contentions. Further, the parties have conducted substantial discovery, including thousands of pages of document productions, as well as source code files that will be reviewed, and 34 interrogatory requests and responses.

The ’047 patent issued on August 9, 2011, allowing expectations to settle for over thirteen years. Ex. 1001. Petitioner has also known of the ’047 patent as well as all other asserted patents since at least July 29, 2020. See Exs. 2004 and 2005.

¹ The complaint also alleged infringement of three other United States Patents: Nos. 7,583,347 (“’347 patent”); 7,414,682 (“’682 patent”); and 8,093,830 (“’830 patent”) (collectively, with the patent in this proceeding, the “Asserted Patents”). Of those additional patents, Petitioner only challenged the ’830 patent in co-pending *inter partes* review petition IPR2025-01331 (the “Co-Pending IPR”). Petitioner has not challenged the ’347 patent or the ’682 patent that are also asserted in the district court case.

The Petitioner did not file this Petition until July 28, 2025, which is five years since Petitioner has definitively known about the '047 patent. In the interim, the parties spent significant resources in the parallel proceeding as detailed herein. Furthermore, the Petitioner has not filed a motion to stay the parallel proceeding, nor have they indicated any intent to do so. In any event, it is the district court's "universal practice" "to deny a motion to stay when the Board has not yet acted on the IPR petition." *Arbor Global Strategies v. Samsung Elecs. Co.*, No. 2:19-cv-333-JRG-RSP, 2021 U.S. Dist. LEXIS 2434, at *7 (E.D. Tex. Jan. 7, 2021).

Furthermore, the district court trial is scheduled for January 11, 2027, which would occur prior to a final written decision on the Petition expected in February 2027.

III. DISCRETIONARY DENIAL IS WARRANTED

In determining whether to exercise discretion to deny institution, the Director "consider[s] the effect of any such regulation [under this section] on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter." 35 U.S.C. § 316(b).

The Director may exercise discretion under § 314(a) to deny institution of an *inter partes* review when the parties have a parallel district court proceeding scheduled to finish before the Board's deadline to issue a final written decision in an

instituted proceeding. *See, e.g., Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 3 (PTAB Mar. 20, 2020) (“*Fintiv*”) (precedential, designated May 5, 2020); *Intel Corp. v. VLSI Tech. LLC*, IPR2019-01192, Paper 15 at 11 (PTAB Jan. 9, 2020) (“When considering the impact of parallel litigation in a decision to institute, the Board seeks, among other things, to minimize the duplication of work by two tribunals to resolve the same issue.”).

The Director frequently evaluates at least six factors in determining whether “to deny institution in view of an earlier trial date in the parallel proceeding.” *Fintiv*, Paper 11 at 5-6. Consistent with this authority, the Workload Memo makes clear that the Director will consider “all relevant considerations” in determining whether discretionary denial is warranted, including but not limited to the strength of the unpatentability challenge, the extent of the petitioner’s reliance on expert testimony, settled expectations of the parties, compelling economic interests, and the ability of the PTAB to comply with its statutory deadlines. Workload Memo, 2-3. Discretionary denial is warranted here based on these and other relevant discretionary considerations.

A. *Fintiv* Factor 1 - Petitioner has not sought a stay, and a stay is unlikely to be granted.

This factor weighs against institution because Petitioner has not requested a stay, and a stay is unlikely. Indeed, the district court’s established practice is to deny

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

Even if Petitioner was to move to stay post-institution, the district court is unlikely to stay the case. First, a final written decision from the Board would not be

expected until February 2027, which occurs after the trial date of the district court case scheduled for January 11, 2027. Judge Gilstrap (the judge presiding over the parallel proceeding) routinely denies motions to stay district court litigation pending IPRs when the district court trial is scheduled before the Board’s final decision. *See, e.g., MyPort, Inc. v. Samsung Elecs. Co., Ltd.*, Case No. 2:22-cv-00114-JRG, Order, Dkt. 73 (E.D. Tex. June 13, 2023) (Ex. 2006 at 4-5 (denying a motion to stay when trial was scheduled and “the PTAB [final written] decision is not due until over two months after jury trial is set to begin”); *Solas OLED Ltd. v. Samsung Display Co., Ltd.*, Case No. 2:19-CV-00152-JRG, 2020 U.S. Dist. LEXIS 125973 (E.D. Tex. July 17, 2020).

Judge Gilstrap considers three factors when determining whether to grant a stay pending IPR of asserted patents: (1) whether the stay will unduly prejudice the nonmoving party, (2) whether the proceedings before the court have reached an advanced stage, including whether discovery is complete and a trial date has been set, and (3) whether the stay will likely result in simplifying the case before the court.

Judge Gilstrap typically finds that the first factor weighs against a stay because any delay to trial prejudices the patent owner plaintiff. *See, e.g., Polaris Powered Techs., LLC v. Samsung Elecs. Am., Inc.*, Case No. 2:22-cv-00469-JRG, 2024 U.S. Dist. LEXIS 218301 at *6-7 (E.D. Tex. Dec. 3, 2024) (finding that the first factor weighed against a stay where plaintiff would be prejudiced by an indefinite stay

while plaintiff appealed an adverse IPR final written decision to the Federal Circuit); *Croga Innovations Ltd. v. Cisco Sys.*, Case No. 2:24-CV-00065-JRG, 2025 U.S. Dist. LEXIS 71092 at *5-6 (E.D. Tex. Apr. 14, 2025) (finding that the first factor weighed against a stay where plaintiff, a non-practicing entity, would be prejudiced by a stay where the IPR final written decision was scheduled to issue four months after the scheduled trial). In the parallel proceeding here, Judge Gilstrap would likely find that this factor weighs against staying the case because Patent Owner would be prejudiced by a delay to trial, especially when the IPR final written decision is expected to occur after the scheduled trial date.

Judge Gilstrap typically finds that the second factor weighs against a stay if the district court litigation has reached an advanced stage of the case. Furthermore, Judge Gilstrap evaluates the stage of the case at the time the motion for stay was filed and also post motion to stay facts. *Croga Innovations Ltd. v. Cisco Sys.*, Case No. 2:24-CV-00065-JRG, 2025 U.S. Dist. LEXIS 71092 at *7 (E.D. Tex. Apr. 14, 2025). As detailed herein, Judge Gilstrap will likely find that the advanced stage of the district court case weighs against a stay as to the second factor.

As to the third factor, Judge Gilstrap typically finds that this factor weighs against a stay unless the movant can show that every asserted claim of all asserted patents has a reasonable likelihood of being invalidated. *Croga Innovations Ltd. v. Cisco Sys.*, Case No. 2:24-CV-00065-JRG, 2025 U.S. Dist. LEXIS 71092 at *8 (E.D.

Tex. Apr. 14, 2025). Even if all challenged claims from this IPR and the Co-Pending IPR filed by Petitioner are instituted, Petitioner cannot show that every asserted claim has a reasonable likelihood of being invalidated because Petitioner did not challenge any asserted claims of U.S. Patent Nos. 7,583,347 or 7,414,682. See Ex. 2001 at 1. Judge Gilstrap denies motions to stay (and any accompanying requests to sever/bifurcate a case or a subset of patents) if only a subset of the asserted patents have received adverse rulings in institution decisions or final written decisions. *See, e.g., Polaris Powered Techs., LLC v. Samsung Elecs. Am., Inc.*, Case No. 2:22-cv-00469-JRG, 2024 U.S. Dist. LEXIS 218301 (E.D. Tex. Dec. 3, 2024) (denying a motion to sever and stay where only a subset of the asserted patents received an adverse final written decision); *RF Cyber Corp. v. Google LLC*, Case No. 2:20-cv-00274-JRG, 2022 U.S. Dist. LEXIS 250095 (E.D. Tex. Jan. 4, 2022) (denying a motion to stay where two of the four asserted patents were instituted). For these reasons, a stay is highly unlikely.

B. *Fintiv* Factor 2 - The district court trial date is before the Board's projected statutory deadline.

This factor weighs heavily in favor of denying institution. “If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under *NHK*.” *Fintiv*, Paper 11 at 9. Here the district court trial is scheduled to commence on January 11,

2027 before the projected deadline for the Board’s final written decision on February 5, 2027. The Director has exercised discretion to deny institution in matters in similar situations. *See Linkplay Tech. Inc. v. Sonos, Inc.*, IPR2025-00509, 510, 511, Paper 10 (PTAB July 31, 2025) at 2 (granting discretionary denial based in part on the trial in the district court proceeding being scheduled two months before the projected final written decision date); *NVIDIA Corp. v. Neural AI, LLC*, IPR2025-00606, 608, Paper 18 (PTAB July 31, 2025) at 2 (granting discretionary denial based in part on the trial in the district court proceeding being scheduled shortly over one month before the projected final written decision date); *Zhuhai Cosmox Battery Co., Ltd. v. Ningde Amperex Tech. Ltd.*, IPR2025-00385, 389, 405, 431, 432, Paper 9 (PTAB July 2, 2025) at 2 (discretionary denial favored where the projected due date for the final written decision was August 2026, whereas trial in the parallel district court proceeding was scheduled for July 2026).

Even before the Workload Memo, the Board found this factor favored denial in cases where the trial date was expected to occur prior to the deadline of the final written decision. *See EClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10 at 9 (PTAB Apr. 13, 2022) (finding this factor weighed in favor of discretionary denial and denying institution where “the beginning of the jury trial in the WDTX Cases is roughly one to two months before any final decision would have been due had inter partes review been instituted”); *Apple Inc. v. Fintiv, Inc.*,

IPR2020-00019, Paper 15 at 13 (PTAB May 13, 2020) (finding this factor weighed in favor of discretionary denial and denying institution where the district court trial was scheduled to occur two months before the deadline for the Board to reach a final written decision).

Because trial in the district court proceeding is scheduled to begin before the projected deadline for the Board’s final written decision if *inter partes* review is instituted, this factor weighs in favor of denial. *See Google LLC v. Cerence Operating Co.*, IPR2024-01465, Paper 15 (PTAB April 23, 2025) (“*Google-Cerence*”) at 9 (“Because the District Court Litigation will address the issues relating to the validity of the [challenged] patent in a trial scheduled to occur several months before we would issue a final written decision, we weigh the second *Fintiv* factor as favoring discretionary denial.”).

C. *Fintiv* Factor 3 – The district court and the parties have heavily invested time and resources in the parallel proceeding.

This factor asks the Director to “consider [] the amount and type of work that the court and the parties will have completed in the parallel litigation by the time of [an] institution decision.” *See Google-Cerence*, Paper 15 at 9. It “is related to the trial date factor, in that more work completed by the parties and court in the parallel proceeding tends to support the arguments that the parallel proceeding is more

advanced, a stay may be less likely, and instituting would lead to duplicative costs.”

Fintiv, Paper 11 at 10. This factor weighs in favor of discretionary denial.

The parties have prepared and exchanged infringement contentions, invalidity contentions, and initial and additional disclosures. Ex. 1008 at 4-5. This weighs in favor of denial. *See Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3 (“*Motorola Solutions*”) (PTAB March 28, 2025) (holding this factor strongly favors denial because, among other things, “the parties had served extensive infringement and invalidity contentions”).

By the time of the institution decision, the parties’ ongoing investment in the parallel proceeding will be even more substantial. The parties’ efforts and costs with the production and review of all technical discovery, including source code files, will be well underway with the expectation that document production should be substantially complete by the time of the institution decision. Given the substantial time and effort the parties will have already invested in parallel litigation, this factor weighs in favor of denial.

D. *Fintiv* Factor 4 – The IPR is not a “true alternative” to the parallel proceeding.

“This factor evaluates ‘concerns of inefficiency and the possibility of conflicting decisions’ when substantially identical prior art is submitted in both the district court and the *inter partes* review proceeding.” *Google-Cerence*, Paper 15 at 11 (quoting *Fintiv*, Paper 11 at 12). In the Memorandum regarding “Guidance on

USPTO’s recission of ‘Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,’” issued by the Chief Administrative Patent Judge of the Patent Trial and Appeal Board on March 24, 2025 (hereinafter, “Guidance Memo”),² the Chief Judge stated that “[a] timely-filed *Sotera* stipulation ... is highly relevant, but will not be dispositive by itself.” Guidance Memo, 2-3. In considering this factor, the Director should consider whether *inter partes* review would be a “true alternative” to parallel district court litigation. *See Motorola*, Paper 19 at 3-4 (Director vacating decision granting institution where the petitioner’s “stipulation does not ensure that these [*inter partes* review] proceedings would be a ‘true alternative’ to the district court proceeding”).

This factor weighs in favor of discretionary denial because Petitioner’s *Sotera* stipulation does not ensure that these IPR proceeding would be a “true alternative” to the parallel proceeding. Indeed, as discussed below, “Petitioner’s invalidity arguments in the district court are more expansive and include” system prior art and “combinations of the prior art asserted in these proceedings with unpublished system prior art, which Petitioner’s stipulation is not likely to moot.” *Motorola Solutions*,

²https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf

Paper 19 at 4. In short, this IPR proceeding would not be a “true alternative” to the district proceeding. *See id.* at 3-4.

Petitioner’s stipulation does not ensure that this proceeding would be a “true alternative” to the district court proceeding because Petitioner’s stipulation does not address system art. See Petition at 19. In their Invalidity Contentions, Petitioner intends to rely on various prior art systems against the ’047 patent. Ex. 2007 at 45 (“Where multiple references discuss or relate to the same or related underlying projects, systems, or other subject matter, it would have been obvious to combine the discussions and disclosures of the references as they would be understood to describe features or potential features of the underlying project, system, or subject matter.”); 192; and 235 (“On information and belief, electronic devices, including LCDs, made by Hitachi, Sharp, Samsung Display, Sanyo Electric, Motorola, Fujitsu, Sony, Seiko Epson, Matsushita, Panasonic, or Citizen Watch, anticipate or render obvious the asserted claims of the patents in suit.”). Because Petitioner reserves the right to rely upon system art alone, and in combination with the same references in this IPR, it raises “concerns of inefficiency and the possibility of conflicting decisions,” which weighs in favor of discretionary denial. *Fintiv* at 12. Petitioner’s *Sotera* stipulation leaves open the possibility that the Board may reach decisions on the overlapping prior art that conflict with the district court’s decisions on system art with that overlapping prior art in the Petition. Accordingly, Petitioner’s *Sotera*

Stipulation does not ensure that this proceeding would be a true alternative to the parallel proceedings. *Samsung Electronics Co., Ltd. v. Sionyx, LLC*, IPR2025-00064, Paper 15 (PTAB June 6, 2025) at 14-15. Petitioner will undoubtedly argue in the district court proceeding that its identified prior art systems fall outside of its stipulation not to pursue “any ground raised or that could have been reasonably raised in the IPR.” And further inefficiency will result in the event that Petitioner raises system art during the district court proceeding.

In addition, Petitioner only filed IPR petitions against two of the four patents asserted in the district court case. Accordingly, even if this IPR and the Co-Pending IPR result in cancelling all of the claims of the '047 patent and the '830 patent (the other challenged patent), the district court would still need to proceed on the other two patents.

The district court will address the same validity issues raised by the Petition (and more) before the Board is scheduled to reach a final written decision if *inter partes* review is instituted. Petitioner's Invalidity Contentions in the parallel proceeding cover the same grounds of asserted claim 1 as those in the Petition, i.e., Baek under §102 or §103 (Grounds 1 and 2). *See* Pet. at 13; Ex. 2007 at 31. Claim 1 is the only claim from the '047 patent asserted in the district court proceeding. The Board should not use its resources to redo the work of another tribunal regarding the same issues. Accordingly, this factor weighs in favor of denial.

E. *Fintiv* Factor 5 – The Petitioner is also the defendant in the parallel proceeding.

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

F. *Fintiv* Factor 6 – The weakness of the validity challenge favors exercising discretion.

The Workload Memo identifies “the strength of the unpatentability challenge” as a relevant consideration. Workload Memo, 2. This consideration favors discretionary denial because Petitioner’s patentability challenges are weak. Patent Owner’s preliminary response will identify numerous specific weaknesses in the Petition further favoring denial of institution.

G. The Petition’s heavy reliance on expert testimony favors exercising discretion.

“The extent of the petition’s reliance on expert testimony” is an enumerated consideration set forth in the Workload Memo. Since the memo issued, the Office has further explained that extensive reliance on expert testimony on dispositive issues may suggest that the questions are better resolved in an Article III court and further explaining that the failure to provide focused expert testimony may weigh

against institution. FAQs for Interim Processes for PTAB Workload Management, at #21 (published Apr. 25, 2025), <https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management> (last visited April 28, 2025) (“FAQ #21”).

This consideration favors discretionary denial because the Petition relies heavily on the unfocused declaration testimony of Petitioner’s purported technical expert, Alex Z. Kattamis. Indeed, Mr. Kattamis’s declaration consists of 232 paragraphs of testimony spanning 113 pages. *See generally* Ex. 1003. The Petition extensively cites to and relies upon his testimony, including attempting to plug holes by arguing that certain features not disclosed on the relied-on references would have been obvious. *See e.g.*, Pet. at 43 (“A POSITA would have understood or at least found obvious that”); 66 (“A POSITA would have understood or at least found obvious that”); 66 (“A POSITA would have understood or at least found obvious that”); 68-69 (“A POSITA would have understood that”); 72-73 (“A POSITA would have understood or at least found it obvious that”); and 73 (“A POSITA would have understood or at least found it obvious that”). Indeed, the word “POSITA” appears 37 times in the Petition.

Further, Mr. Kattamis’s declaration contains much of the same language as the Petition, even including the same annotations and color-coding used in the Petition. *Compare, e.g.*, Pet. 27-70 (analysis of Grounds 1-2), *with* Ex. 1003 at 30-69 (analysis of Grounds 1-2); Pet. 70-78 (Ground 3 analysis), *with* Ex. 1003 at 70-

78 (Ground 3 analysis); Pet. 79-84 (Ground 4 analysis), *with* Ex. 1003 at 79-86 (Ground 4 analysis); Pet. 84-112 (Ground 5 analysis), *with* Ex. 1003 at 87-111 (Ground 5 analysis). However, the Board has been skeptical of petition arguments repeated verbatim by a witness purporting to give expert testimony. *Kinetic Techs., Inc. v. Skyworks Solutions, Inc.*, IPR2014-00529, Paper 8, 14-15 (PTAB 2014) (denying institution). Such skepticism is warranted in reviewing the Petition, in light of Mr. Kattamis’s extensive repetition of the Petition in his declaration. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, at 15, 19 (P.T.A.B. Aug. 24, 2022) (denying institution). The Board’s resources would be better allocated to other petitions more grounded in substance.

H. The settled expectations favor discretionary denial.

The Director may consider the “[s]ettled expectations of the parties, such as the length of time the claims have been in force.” Workload Memo at 2. Here, the ’047 patent issued on August 9, 2011, allowing expectations to settle for over thirteen years. Thirteen years significantly exceeds other timeframes that the Board has found to create “strong settled expectations.” For example, the Board has found strong settled expectations for patents that have been in force for as little as six and seven years. *See, e.g., Kahoot! AS v. Interstellar Inc.*, IPR2025-00696, Paper 12 (PTAB July 31, 2025) at 2; *Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00601, 602, 603, Paper 9 (PTAB July 24, 2025) at 3; *Smartsky Networks LLC v.*

Gogo Business Aviation LLC, IPR2025-00672, Paper 10 (PTAB July 31, 2025) at 2; *Tanklogix, LLC v. Sitepro, Inc.*, IPR2025-00647-653, Paper 10 (PTAB July 31, 2025) at 3.

Petitioner was aware of the '047 patent and all of the other asserted patents in the district court case well before the underlying proceedings or the Petition were filed. For example, Petitioner has known of the '047 patent as well as all other asserted patents since at least July 29, 2020. See Exs. 2004 and 2005. On July 29, 2020, Parkside IP LLC ("Parkside") was the patent owner of the '047 patent. *Id.* Parkside's licensing agent sent an email, including an attached letter, (collectively, the "Parkside notice letter") to BOE on July 29, 2020 providing notice from Parkside of BOE's infringement of the '047 patent. *Id.* The Parkside notice letter was addressed to Wang Xin, IP Counsel for BOE, at wangxin@boe.com.cn and another BOE representative with an email address of tongguanshan@boe.com.cn. *Id.* Accordingly, Petitioner BOE has known about the '047 patent since at least July 29, 2020 (and likely earlier, from IP Bridge).

It is highly likely that BOE also knew of the '047 patent on or around April 20, 2021 when Patent Owner asserted the '047 patent against the Samsung defendants in *Bishop Display Tech LLC v. Samsung Electronics Co., Ltd. et al.*, C.A. No. 2:21-cv-00139 (E.D. Tex. 2021). See Ex. 2008. It is highly likely that BOE also learned of the '047 patent on or around October 3, 2022 when Patent Owner asserted

the '047 patent against Innolux in *Bishop Display Tech LLC v. Innolux Corporation*, C.A. No. 2:22-cv-00385 (E.D. Tex. 2022). See Ex. 2009. It is highly likely that BOE also learned of the '047 patent on or around February 8, 2024 when Patent Owner asserted the '047 patent against the LG defendants in *Bishop Display Tech LLC v. LG Electronics Inc. et al.*, C.A. No. 2:24-cv-00085 (E.D. Tex. 2024). See Ex. 2010. The named defendants in those district court proceedings are competitors to Petitioner BOE as to the accused technology, and Petitioner BOE was likely highly aware of the '047 patent being asserted in each of those cases.

Furthermore, the Samsung defendants previously challenged claims 1-4 and 9-10 of the '047 patent in IPR2022-00501 filed on January 31, 2022. See Ex. 2011. Indeed, Petitioner BOE relied on the same grounds, rationale, and prior art that Samsung previously relied on in IPR2022-00501. *Compare, e.g.*, Pet. 27-70 (analysis of Grounds 1-2 anticipation/obvious by Baek for claims 1-4, 9), *with* Ex. 2011 at 68-102 (analysis of Grounds 3-4 anticipation/obvious by Baek for claims 1-4, 9); Pet. 84-112 (Ground 5 analysis obvious by Sasaki for claim 10), *with* Ex. 2011 at 103-121 (Ground 6 analysis obvious by Sasaki for claim 10). Indeed, Petitioner BOE now relies on the same expert, Mr. Kattamis, as the Samsung defendants previously did in IPR2022-00501. Petitioner BOE should have joined in IPR2022-00501 and not waited until now to challenge the '047 patent. In these circumstances, the settled expectations of Patent Owner favors discretionary denial.

IV. CONCLUSION

For the reasons above, Patent Owner respectfully requests that the Director exercise discretion and deny institution of *inter partes* review.

Dated: October 6, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

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

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CERTIFICATE OF COMPLIANCE

The undersigned certifies that this document complies with the type-volume limitations set forth in 37 C.F.R. § 42.24 *et seq.* This document, excluding those portions excluded pursuant to § 42.24(a)(1), contains 20 pages and 4,524 words as calculated by the “Word Count” feature of Microsoft Word for Office 365, the program used in creating it.

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