

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BOE TECHNOLOGY GROUP CO., LTD.

Petitioner

v.

138 EAST LCD ADVANCEMENTS LIMITED,

Patent Owner.

PTAB Case No. IPR2025-01413

Patent No. 8,319,512

**DECLARATION OF YUANYUAN LIU IN SUPPORT OF PETITIONER'S
OPPOSITION TO PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL**

I, Yuanyuan Liu, declare as follows:

1. I am an IP Counsel at Petitioner BOE Technology Group Co., Ltd. (“BOE”). I submit this declaration in support of BOE’s opposition to Patent Owner’s (“138 East”) request for discretionary denial. I am over 18 years of age. I have personal knowledge of the facts stated herein and could testify competently to them if asked to do so.

2. Seiko Epson (“Seiko”) decided to leave the LCD display market.¹ Seiko later sold to BOE a substantial number of patents. The patents that BOE purchased from Seiko did not include U.S. Patent No. 8,319,512 (“the ’512 patent”) or certain other Seiko patents relating to LCD display technology.

3. During the negotiation, Seiko proposed adding to the deal a royalty-free cross-licensing arrangement that would provide BOE with a royalty-free license to additional Seiko patents in exchange for BOE providing Seiko a royalty-free license to certain of BOE’s patents. BOE found this acceptable because there would be essentially no cost to BOE. BOE did not need to look into the large

¹ See, e.g., <https://www.sonyinsider.com/2009/07/06/epson-gives-its-small-and-medium-sized-lcd-operations-to-sony-for-free/?amp=1> (“Epson Gives its Small and Medium-Sized LCD Operations to Sony for Free.”).

portfolio of patents Seiko cross-licensed. BOE believed at the time that BOE was foregoing little to none substantial royalties in cross-licensing its patents to Seiko anyways, given that Seiko was leaving the LCD display business. Thus, BOE did not need to investigate into the large portfolio of patents Seiko cross-licensed to BOE to determine that Seiko must have believed that the value of its cross-licensed patents was low—otherwise, Seiko would not have exchanged the license to its portfolio for something of little to none value.

4. Therefore, on November 18, 2014, BOE and Seiko entered into a royalty-free cross licensing agreement. (See Ex. 2006 at ¶12.) As a result, BOE had a royalty-free license under Seiko’s ’512 patent and other Seiko patents from 2014 (when the cross-license agreement was executed) until 2019 (when the cross-license agreement expired).

5. Unknown to BOE at the time, 138 East purchased the ’512 patent and other patents from Seiko some time before the cross-license agreement expired. (See Ex. 2006 at ¶¶12-25; see also <https://ipvalue.com/news/ipvalue-management-affiliate-acquires-additional-portfolio-from-seiko-epson> (IPValue Management press release announcing that its affiliate 138 East had acquired “over 2,500 worldwide patents . . . from Epson in multiple transactions since April 2018.”).)

6. Then, after the BOE-Seiko cross-license expired, 138 East notified BOE of the ’512 patent during a technical presentation on April 8, 2021. In that

presentation, 138 East alleged that BOE's LCD products infringed certain claims of the '512 patent, which previously had been covered under the BOE–Seiko cross-license. This was the first time BOE became specifically aware of the '512 patent, as the cross-license did not identify individual patent numbers. 138 East then engaged in additional correspondence and infringement allegations, ultimately culminating in a demand for a substantial payment from BOE.

7. Over the course of several meetings and exchanges of information, BOE provided proof to 138 East that BOE's LCD displays do not infringe claims 10–12² of the '512 patent. For example, in BOE's August 10, 2021 response to 138 East's allegations, BOE informed 138 East that, in BOE's LCD products, there were no wirings or lines connecting the inspection electrode to the driver IC, as required by those claims. BOE further explained that the structures identified by 138 East as meeting this limitation do not, in fact, include any such connection and therefore cannot meet the claim limitation that the inspection electrode be electrically connected to an integrated circuit.

8. I declare under penalty of perjury of the laws of the United States of America that the foregoing is true and correct.

² At that time, 138 East had asserted only claims 10–12 of the '512 patent, rather than all claims of the '512 patent.

Executed on December 10, 2025 at Beijing, China.



Yuanyuan Liu