

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BOE TECHNOLOGY GROUP CO., LTD.,
Petitioner,

v.

PANELTOUCH TECHNOLOGIES LLC,
Patent Owner.

U.S. Patent No. 9,507,477
Issue Date: November 29, 2016
Title: DISPLAY DEVICE

Case No. IPR2025-01483

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

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1058	Docket Sheet, <i>Collision Communications, Inc. v. Samsung Electronics Co. Ltd.</i> , No. 2:23-cv-00587-JRG (Printed October 24, 2025)
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1060	U.S. Patent No. 8,704,762 (“Anno ’762”)
1061	U.S. Patent Publication No. 2009/0322704A1 (“Anno ’704”)

I. INTRODUCTION

This IPR should be instituted. A merits review is warranted under § 314, as the Director has already ruled in three related IPRs; all *Fintiv* considerations weigh against discretionary denial. Patent Owner Paneltouch Technologies (“Paneltouch” or “Patent Owner”) is not entitled to settled expectations because the lead inventor withheld his own material prior art from the PTO, and Paneltouch acquired the patent just last year to monetize it through litigation. Petitioner BOE Technology Group (“BOE” or “Petitioner”), a publicly traded company, not a foreign state actor, correctly identified itself as the real party in interest. As Paneltouch admits, the co-pending district court litigation has only just begun, and the court set the trial in April 2027, after the date by which a final written decision (“FWD”) will issue here, achieving the desired efficiencies of the IPR process. Moreover, for the same reason, the court will likely grant a stay, which, if Paneltouch consented, would fully alleviate its efficiency concerns. Additionally, the court has not invested any meaningful resources into the case, and the parties have only devoted limited resources in this early stage of litigation.

In view of these and additional circumstances explained below, discretionary denial is not appropriate. The Director should refer the Petition to the Board.

II. BACKGROUND**A. The Lead Inventor Failed to Disclose, and Examiner Failed to**

**Find, the Lead Inventor's Own Prior Art that Would Have
Rendered Claims of the '477 Patent Family Unpatentable**

U.S. Patent No. 8,704,762 (“Anno ’762”), through which the ’477 patent claims priority, was filed in 2011. Ex. 1001, (63). Two years before that, the lead inventor, Kouichi Anno, had filed Anno ’704. Ex. 1061, (22). Anno ’704 published in December 2009. *Id.*, (43). During the prosecution of Anno ’762, Mr. Anno never disclosed, and the Examiner didn’t find, Anno ’704. Ex. 1060, (56).

The highly material relevance of prior-art Anno ’704 was demonstrated during the prosecution of Anno ’631, the parent application to the ’477 patent. Ex. 1001, (63). In that case, the Applicant disclosed Anno ’704 in an IDS. Ex. 1029 at 107. The Examiner then rejected all pending claims 1–12 as being obvious over Anno ’704 in view of Hasegawa. *Id.* at 188. In response, Applicant conceded that “[Anno ’704] describes a general structure of a touch panel,” and “Hasegawa describes the substrate crack diagnostic conductive pattern 83 ... connected to bumps ... of IC 5...” and canceled all twelve claims and presented new claims for examination. *Id.* at 213. These admissions would have been highly material in the prosecution of Anno ’762.

**B. Patent Owner Acquired the '477 Patent in 2024 and Promptly
Filed the Co-Pending Litigation**

The ’477 patent was originally assigned to Japan Display Inc. and Panasonic Liquid Crystal Display Co., Ltd. Ex. 1001, (73). The original assignees never

asserted the '477 patent in litigation.

Paneltouch did not acquire the '477 patent until April 2024. *See* Ex. 1030 at 1. Within less than a year, Paneltouch filed suit against BOE in the Eastern District of Texas ("EDTX"). *See generally* Ex. 1031 (EDTX Complaint). The Complaint asserts five patents that Paneltouch acquired in the same transaction. *See id.*

The EDTX litigation is only just beginning. Petitioner filed its Answer to the Complaint on October 21, 2025. Ex. 1032. Afterward, the court has merely held a scheduling conference, issued a docket control order setting claim construction hearing on October 1, 2026 and trial on April 5, 2027, and issued discovery and protective orders identical to those in another case between Petitioner and another party represented by Paneltouch's counsel. Exs. 1032–33. Beyond these activities, the court has not invested in the litigation in any way. Paneltouch only recently served its infringement contentions, which merely parrot the charts attached to its Complaint. No discovery requests or responses have been made, nor has any deposition taken place. The parties have not begun the claim construction process, and expert discovery does not begin for almost another year, in November 2026.

C. The *Inter Partes* Review Petitions

Petitioner promptly filed IPRs challenging all five patents asserted in EDTX. Importantly, IPRs against three of the five asserted patents, IPR2025-01267, -01245, -01246, have already survived discretionary denial challenges and have been passed

to merits review. The fifth petition, IPR2025-01482, was filed contemporaneously with the present case and challenges Anno '762.

The Petition in this proceeding was filed and served on September 18, 2025, and was accorded that filing date on September 24, 2025. *See* Papers 1, 3. Thus, the institution decision is expected on March 24, 2026, and the FWD is expected on March 24, 2027, before the start of the EDTX trial, currently scheduled on April 5, 2027. BOE submitted a *Sotera* stipulation on October 14, 2025. *See* Paper 6.

III. INSTITUTION UNDER § 314 IS WARRANTED

None of the § 314 considerations Patent Owner's Request for Discretionary Denial of Institution (Paper 7) ("Brief") cited favor discretionary denial.

Preliminarily, Paneltouch simply ignores several considerations because they clearly favor referring this case to a merits review. The validity of the '477 patent has never been adjudicated at the PTAB or another forum; there are no compelling economic, public health, or national security interests favoring discretionary denial.

A. Existing Law Supports Reviewing Validity of the '477 Patent

Paneltouch alleges "no changes in the law support reconsideration of the validity of the '477 patent claims." Brief at 3. But existing law supports that reconsideration. *See Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC*, 584 U.S. 325, 337 (2018) ("Patent claims are granted subject to the qualification that the PTO has 'the authority to reexamine—and perhaps cancel—a patent claim' in an

inter partes review.”). That is especially true here because the Applicant failed to disclose highly relevant art.

B. Patent Owner Is Not Entitled to Settled Expectations

Settled expectations is an equitable doctrine intended to preserve fairness where a patent owner has relied on long-standing, unchallenged rights. Paneltouch is not entitled to settled expectations because of the omission of material prior art from the prosecution of Anno ’762 and because Paneltouch, well aware of the prevalence of IPR defenses, acquired the patent to monetize it.

1. The inventor’s failure to disclose and Examiner’s failure to find material prior art warrant review of the patent

In considering discretionary denial, an examiner’s error in overlooking material prior art trumps a patent owner’s settled expectations even for patents issued almost twenty years ago. *Anthony Inc. v. ControlTec LLC*, IPR2025-00559, Paper 12 & IPR2025-00636, Paper 9 at 2 (Dir. July 16, 2025). Here, not only did the Examiner overlook material U.S. patent publication prior art, but the lead inventor affirmatively failed to disclose it, making a merits review highly equitable.

The high materiality of the undisclosed Anno ’704 reference has already been confirmed by PTO findings and Applicant admissions. When Anno ’704 was finally cited in an IDS, the examiner promptly relied on it to reject all pending claims and the Applicant admitted the validity of the examiner’s findings. *Supra* § II.A. The

related Petition against Anno '762 relies on exactly the admitted similarities to show that claims of Anno '762 are unpatentable for obviousness in view of Anno '704. IPR2025-01482, Paper 1, 63–81. Simply put, the inventor's omission led to Anno '762's erroneous issuance and taints the '477 patent. *See Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276, 1288–89 (Fed. Cir. 2011) (*en banc*) (finding that inequitable conduct can render related patents unenforceable).

The Applicant's own recognition of the relevance of Anno '704, and its failure to disclose it during the prosecution of Anno '762, contradict any expectations, let alone *settled* expectations, regarding the validity of the patent. The Applicant apparently decided to live with this impairment to the patent, rather than fix the problem via reissue.

And, regardless, the public's interest in correcting examination errors outweighs any settled expectations. *See, e.g., TSMC Ltd. v. Marlin Semiconductor Ltd.*, IPR2025-00847, Paper 11 (Dir. Sept. 3, 2025) at 4 (“Although the challenged patent has been in force for fifteen years, Petitioner appears to show a material error by the Office, and it is an appropriate use of Office resources to review the potential error”); *Volkswagen Grp. of Am., Inc. v. Longhorn Auto. Grp. LLC*, IPR2025-01064, Paper 9 (Dir. Oct. 10, 2025) at 2–3 (although the “patent has been in force for over thirteen years,” any Patent Owner's settled expectations are outweighed when “Patent Owner and its predecessors never attempted to correct [a] known error”).

2. Any settled expectations of the original patent owner do not inure to a nonpracticing entity

As explained above, the original patent owner is not entitled to any expectations of secured rights in the '477 patent. *Supra* § III.B.1. Even if it did, those expectations do not inure to Paneltouch for two reasons.

First, Paneltouch purchased the patent with all its flaws just last year. *Supra* § II.B. A new owner is not entitled to the expectations of long-term ownership. *See Nordlinger v. Hahn*, 505 U.S. 1, 12–13 (1992) (“[A]n existing owner rationally may be thought to have vested expectations in his property or home that are more deserving of protection than the anticipatory expectations of a new owner at the point of purchase.”).

Second, Paneltouch, a nonpracticing entity purchasing previously unenforced patents for monetization, is not entitled to expectations, much less *settled* expectations, that its patent rights remain unchallenged—or even unchallengeable. *Intel Corp. v. Proxense LLC*, IPR2025-00327, 00328, 00329, Paper 12 (Dir. June 26, 2025) at 2–3 (“a patent may have been in force for years but may not have been ... asserted, ... [which] weigh[s] against a patent owner’s claim of settled expectations....”). Having acquired a portfolio including the '477 patent, Paneltouch quickly asserted them, knowing that patentability challenges at the PTAB are routine. Having to defend their patentability is Paneltouch’s only

reasonable expectation. *See Oil States*, 584 U.S. at 337.

Instead, Paneltouch attempts to manufacture settled expectations based on the readily distinguishable *Irythm Techs., Inc. v. Welch Allyn, Inc.* *Irythm* explained that settled expectations exist and weigh in favor of discretionary denial when a challenged patent had been in force for 13 years and the petitioner knew about *the challenged patent* for 12 years. IPR2025-00363, Paper 10 at 3 (Dir. June 6, 2025).

Nothing like that occurred here. Paneltouch instead highlights seven family-to-family forward citations by BOE patent applications. Brief at 4 (citing Ex. 2005). But this evidence shows that BOE was not aware of the '477 patent, but only related patents with different claims. Indeed, for example, five of the forward citations are directed to a single '477 family member, Chinese publication CN102269886A. Ex. 1034 at 7–8. Further, at that time, the '477 patent was owned by a previous assignee and had never been asserted. Paneltouch provides no reason as to why BOE should have challenged the '477 patent based on its awareness of a foreign family member owned by a nonlitigious peer in display technology. In any event, these facts fail to show that BOE was aware of the '477 patent's claims for over a decade and did nothing about it, as was the case in *Irythm Technologies*.

C. Petitioner, a Public Company, Correctly Identified Itself as the Real Party in Interest (“RPI”)

BOE's RPI identification is correct. *See* Paper 1 at 17. Paneltouch did not do

its diligence before making its RPI allegations—all of its alleged facts are wrong or irrelevant. As the newly precedential *Corning* decision explains, “[a] patent owner challenging a petitioner’s RPI disclosure must provide sufficient evidence to show the disclosure is inadequate.” *Corning Optical Communications RF, LLC v. PPC Broadband Inc.*, IPR2014-00440, Paper 68 at 13 (PTAB Aug. 18, 2015) (precedential). Paneltouch failed to meet its burden.

Paneltouch’s allegation that BOE is on the Department of Commerce’s “entity list” is simply wrong. Brief at 5. BOE is not. Ex. 1035 (Zhang Decl.) ¶¶ 3–4. Paneltouch does not identify BOE’s name on the list because BOE is not on the list. Instead, Paneltouch apparently tries to sow confusion based on an unrelated entity named “Beijing Opto-Electronics Technology Company” (“Beijing Opto”). Ex. 2008 at 2. Beijing Opto is not Petitioner BOE, nor is it related to BOE. Ex. 1035 (Zhang Decl.) ¶ 3. Beijing is commonly used in the name of companies from Beijing. *Id.* ¶ 4. Paneltouch cites nothing to the contrary. Brief at 5–7. BOE is a public company traded on the Shenzhen Stock Exchange—not a government entity. *See, e.g.*, Ex. 2011 at 10. In fact, BOE is a world leader in the semiconductor display and smart system industries. Ex. 1036. BOE values intellectual property and has filed more than 100,000 patent applications worldwide, making it the 12th highest U.S. patent assignee in 2024. Ex. 1035 (Zhang Decl.) ¶ 6; Ex. 1037.

Investment in a public company is not an exercise of government control. By

analogy, the U.S. government recently announced that it will purchase approximately 10% of Intel's stock and invest billions in Micron. *See* Exs. 1039, 1040. This does not make Intel or Micron an arm of the U.S. government. Moreover, the U.S.'s treaty obligations prevent treating foreign companies differently than U.S. companies. *See* Ex. 1041 (TRIPS Article 3); Ex. 1042 (Paris Convention Article 2(1)). While the parties' nationality should not matter, the '477 patent comes from Japanese companies. *See* Ex. 1001, (73). And, for all we know, Paneltouch's undisclosed ownership scheme could be dominated by foreign entities. Similarly, Paneltouch's reliance on a letter submitted in a now amicably resolved ITC dispute—between Samsung Display of Korea and BOE of China—(Ex. 1043) misses the mark. Like any large company, BOE gets involved in patent disputes from time to time, both as plaintiff and defendant. Importantly, the letter Paneltouch cites, at most, reflects the views of a House Select Committee. But the Executive Branch has never credited nor relied on these findings to take action against BOE.

Finally, Paneltouch misstates the role of BOE's "actual controller," both misidentifying who the "actual controller" is and the nature of its responsibility over BOE. Brief at 6–7. First, Paneltouch misidentifies BOE's "actual controller" as the PRC, whereas Paneltouch's evidence identifies "Beijing Electronics Holdings Co., Ltd" ("BEH"). Ex. 2011 at 111–112; *see also* Ex. 1035 (Zhang Decl.) ¶ 5. Moreover, BEH is not owned by the PRC. It is indirectly owned by the Beijing City

government. Second, as BOE's annual report that Paneltouch cites expressly states, the "actual controller" does not control BOE in any way relevant to the RPI analysis. The RPI analysis involves showing that a non-party funds, directs, and controls an IPR petition or proceeding and not merely that it has some relationship with the petitioner. *Corning*, IPR2014-00440, Paper 68 at 14 (citing Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48759 (Aug. 14, 2012); *Taylor v. Sturgell*, 533 U.S. 880 (2008)). The BOE annual report Paneltouch relies on demonstrates that BOE is "independent from the controlling shareholder and the actual controller in terms of business, personnel, assets, organization and financing, with independent & complete business and capability to operate independently." Ex. 2011 at 46; *see also* Ex. 1035 (Zhang Decl.) ¶ 5. BEH does not fund, direct, or control this IPR petition or proceeding. *Id.* Paneltouch's generalized attorney argument of control does not show otherwise.

D. The Petition Properly Relies on Expert Testimony and Presents a Strong Challenge

Paneltouch does not identify even a single flaw in the Petition's merits. Brief at 8. 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.* Beyond this bombastic language, however, Paneltouch does not provide a single example of a

so-called “gap” allegedly filled by expert testimony, nor does it identify any expert testimony that is purportedly “unreliable.” *Id.* Paneltouch’s failure to identify any criticism of the Petition proves the strength of the Petition’s merits.

IV. EVERY *FINTIV* FACTOR WEIGHS AGAINST DISCRETIONARY DENIAL

Every *Fintiv* factor weighs against denial, with factors 2, 3, 4, and 6 strongly weighing against denial.

A. Factor 1: a Stay May Be Granted If a Proceeding Is Instituted

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 will be granted.

Paneltouch argues that this factor favors discretionary denial because it believes that the court will deny a motion to stay. Paneltouch, however, misreads generalized and misleading statistics stretching back to 2014. Brief at 9–12. In particular, because Paneltouch’s statistics include pre-institution motions, the post-institution grant rate is demonstrably and significantly higher. *See id.* at 10 (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. Specifically, Paneltouch’s statistics indicate that in 2025, the court granted three motions to stay and denied

fourteen. *Id.* at 11. Paneltouch neglects to mention, however, that ten of those fourteen denials 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, Dkt. No. 71;¹ *Telcom Ventures LLC v. Samsung Elecs. Co., Ltd.*, No. 2:24-cv-00691, Dkt. No. 53; *Keyless Licensing LLC v. Samsung Elecs. Am., Inc.*, No. 2:24-cv-00464, Dkt. No. 52; *Four Batons Wireless, LLC v. Samsung Elecs. Co., Ltd.*, No. 2:24-cv-00284, Dkt. No. 74; *iCashe, Inc. v. Samsung Elecs. Co., Ltd.*, No. 2:24-cv-00429, Dkt. No. 38; *Truesight Commc'ns LLC v. Samsung Elecs. Co., Ltd.*, No. 2:23-cv-00643, Dkt. No. 85; *Lionra Techs. Ltd. v. Cisco Sys., Inc.*, No. 2:24-cv-00097, Dkt. No. 36; *Emerging Automotive LLC v. Kia Corp.*, No. 2:23-cv-00437, Dkt. No. 162; *Mullen Indus. LLC v. Samsung Elecs. Co., Ltd.*, No. 2:24-cv-00049, Dkt. No. 71; *W&Wsens Devices Inc., v. Samsung Elecs. Co., Ltd.*, No. 2:24-cv-00854, Dkt. No. 90. Of the four remaining denials, one was denied because IPR was not ultimately instituted. *Advanced Integrated Circuit Process LLC v. United Microelectronics Corp.*, No. 2:24-cv-00730, Dkt. No. 127. Another was denied because some claims were subject to *ex parte* review, not IPR. *WellcomeMat LLC v. Aylo Holdings*, No. 2:23-cv-00483, Dkt. Nos. 228, 277, 328.

¹ Case citations in this subsection omit Judge Gilstrap's initials "-JRG" from the case numbers and the jurisdiction parenthetical "(E.D. Tex.)."

The two remaining decisions both involved cases where the FWD would be *due several months after trial*. See *Lionra Techs. Ltd. v. Cisco Sys., Inc.*, No. 2:24-cv-00097, Dkt. No. 58 (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, Dkt. No. 108 (FWD due four months after trial).

In contrast, the facts of the cases where Judge Gilstrap granted a stay are 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 FWD would be due before trial. No. 2:25-CV-90, Dkt. No. 57 (July 25, 2025).² 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, 2025 WL 1811321, at *2 (July 1, 2025). See also *Veraseal LLC v. Wal-Mart Stores, Inc.*, No. 2:17-CV-527, 2018 WL 2183235, at *2 (May 11, 2018) (“the benefits of a stay outweigh the costs of postponing resolution ... in this

² 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.

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, 2023 WL 1478447, at *3 (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, the EDTX case has barely just begun, has had essentially no substantive litigation, and (as explained below) will have a trial date after the FWD is due. Thus, contrary to Paneltouch’s misleading use of inapplicable statistics, an analysis of the facts of the cases before Judge Gilstrap demonstrates that this matter has far more in common with the cases where he granted a stay pending IPR than with the cases where he declined to do so.

B. Factor 2: the Trial Will Occur After the Board’s FWD

As Paneltouch admits, the court has set a trial date of April 5, 2027, after the deadline for a FWD. Brief at 12. Thus, this factor weighs strongly against denial.

Paneltouch speculates that the deadline for a FWD may be extended to September 2027. *Id.* But Paneltouch ignores Judge Gilstrap’s practice of double or triple booking trial dates, resulting in many trials delayed to long after the date set by the initial scheduling order. *See, e.g.*, Ex. 1044 (*CLO Virtual Fashion Docket Sheet*) at 9, 30, 32, 35–38 (resetting trial, for the ninth time, to October 27, 2025, which was initially set for April 7, 2025 (Ex. 1045)); Ex. 1046 (*Multimedia Techs. Docket Sheet*) at 12, 28, 31–35 (resetting trial, the eighth time, to May 19, 2025,

which was initially set for November 18, 2024 (Ex. 1047)); *see also* Exs. 1048–59 (docket sheets and control orders of other cases showing similar delays).

Thus, based on the scheduled trial date and Judge Gilstrap’s trial-setting practices, it is certain that this case will not go to trial until after the expected FWD date of March 24, 2027. This factor strongly weighs against denial.

C. Factor 3: There Has Been Insignificant Investment in the Parallel Proceeding by the Court and the Parties

This factor weighs strongly against denial. Paneltouch asserts this factor is neutral without any explanation. Brief at 12–13. Paneltouch’s silence is a tacit admission that there has been no significant investment in the Texas litigation by any of the parties or the court. 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 claim construction proceedings, invalidity contentions, document production, fact discovery, expert discovery, or anything else. *See* Ex. 1033 (Docket Control Order).

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.” *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, such as claim

construction, on the challenged patent. This factor thus weighs strongly against discretionary denial.

D. 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 the court's schedule, the Board will issue a FWD in this IPR before the currently set trial date, which may be further delayed under Judge Gilstrap's practice. Thus, the estoppel arising from the FWD 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 6. 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 (Dir. March 28, 2025). Brief at 13–16. 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 EDTX case to outweigh the *Sotera* stipulation here. Paneltouch’s reliance on *Motorola* is thus misplaced.

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. Brief at 14. 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) (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) (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 argument that the patent “may subsequently be challenged again during any potential *ex parte* reexamination process” is purely speculative and ignores the estoppel effect of the FWD. Brief at 16; 35 U.S.C. § 315(e)(1). 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 will be rendered invalid by the art presented in the Petition.

E. 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 EDTX litigation and this IPR. Because the Board will issue a FWD before the EDTX 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 FWD “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) (holding that

even decisions expected “around the same time” weigh against discretionary denial).

F. Factor 6: Other Circumstances Weigh Against the Board’s Exercise of Discretion

This factor weighs strongly against denial. As explained above, the “additional considerations” weigh against discretionary denial. *Supra* § III.

Further, the fact that Paneltouch is asserting five patents against BOE also weighs against discretionary denial. As *Tesla Inc. v. Intell. Ventures II LLC* recognized, when the district court proceeding at issue includes 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.” IPR2025-00217, Paper 9 at 2–3 (Dir. June 13, 2025). The EDTX litigation involves five patents directed to highly technical and discrete features of display technology, ranging from crack detection, capacitance reduction, to electromagnetic field shielding and the arrangement and interaction of components in a touch panel stack. Thus, as in *Tesla*, the range of patents, all of which are challenged by BOE in IPRs, weighs against discretionary denial—as the Director has found so in three related IPRs.

V. CONCLUSION

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

IPR2025-01483

U.S. Patent No. 9,507,477

Dated: December 23, 2025

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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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