

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HISENSE USA CORP.,

Petitioner,

v.

LIGHT GUIDE INNOVATIONS LLC,

Patent Owner.

Patent No. 8,408,778

Filing Date: February 2, 2010

Issue Date: April 2, 2013

Inventor: Hyung Hwa Park

Title: LIGHT SOURCE AND DISPLAY DEVICE HAVING THE SAME

PATENT OWNER'S PRELIMINARY RESPONSE

Case No. IPR2025-01526

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LIST OF EXHIBITS

Exhibit No.	Description of Document
2001	Docket Control Order (Dkt. 31) in <i>Light Guide Innovations LLC v. Walmart Inc.</i> , Case No. 2-25-cv-00312-RWS-RSP (Lead Case); <i>Light Guide Innovations v. Hisense Co.</i> , Case No. 2:25-cv-00051-RWS-RSP (Member Case) dated August 4, 2025 (E.D. Tex.)
2002	Complaint for Patent Infringement (Dkt. 1) in <i>Light Guide Innovations v. Hisense Co.</i> , Case No. 2:25-cv-00051-RWS-RSP dated January 17, 2025 (E.D. Tex.)
2003	Hisense Defendants' Invalidity and Subject Matter Eligibility Contentions in <i>Light Guide Innovations LLC v. Walmart Inc.</i> , Case No. 2-25-cv-00312-RWS-RSP (Lead Case); <i>Light Guide Innovations v. Hisense Co.</i> , Case No. 2:25-cv-00051-RWS-RSP (Member Case) dated September 22, 2025

I. INTRODUCTION

On September 10, 2025, Hisense USA Corp. (“Petitioner”) submitted a Petition (Paper 3, “Petition” or “Pet.”) requesting *inter partes* review (“IPR”) of U.S. Patent No. 8,408,778 (Ex. 1001, the “’778 Patent”). The Declaration of Dr. Michael Krames (Ex. 1003) accompanied the Petition. On September 22, 2025, the Board issued a Notice of Filing Date Accorded for the Petition and set the time for filing patent owner’s preliminary response. Paper 4.

The Board should deny Hisense’s Petition because it fails to articulate any reason or motivation to combine Japanese Patent Publication. No. 2005-332963 (Ex. 1019, translated at Ex. 1004) (“Asada”) and Japanese Patent Publication. No. 2008-117879 (Ex. 1020, translated at Ex. 1005) (Kinoshita), and thus fails to show that the proposed combination discloses or renders obvious the claimed “at least one light emitting module positioned so as to emit light incident on the light guide plate, wherein the at least one light emitting module comprises a plurality of light emitting diodes.”

II. ARGUMENT

A. **Ground 1 – Petitioner Fails to Show That Asada in View of Kinoshita Discloses or Renders Obvious “at least one light emitting module positioned so as to emit light incident on the light guide plate, wherein the at least one light emitting module comprises a plurality of light emitting diodes”**

Petitioner admits that Asada does not disclose the claimed “light emitting module” of Claim 1, and relies on the same arguments for the parallel limitation of independent Claim 23. Pet. at 29 and 52. Instead, Petitioner relies on a combination adding Kinoshita’s light emitting modules to Asada’s system for this limitation. But Petitioner fails to show that a POSITA would have any reason or motivation to combine Asada and Kinoshita in this context.

Asada and Kinoshita each disclose independently operative backlight systems, and Petitioner fails to identify any deficiency in Asada’s LEDs that would cause a POSITA to look to Kinoshita. At most, Petitioner’s arguments amount to an assertion that a POSITA *could* use Kinoshita’s LED element in Asada’s system – not that they *would* do so.

Petitioner advances two sets of arguments regarding motivation to combine, both of which fail.

First, Petitioner argues that it would have been possible for a POSITA to add Kinoshita’s LED element to Asada. Petitioner’s arguments to this effect variously assert that Kinoshita’s LED element was conventional (Pet. at 25), that substitution

would have been simple (*id.*), and that a POSITA would expect to succeed (*id.* at 26). But while *necessary* to combine Asada and Kinoshita, these arguments at most support the premise that a POSITA *could* have used Kinoshita's LED element with Asada. Not that they *would* have done so. Petitioner's first set of arguments rely on pure hindsight.

Second, Petitioner argues that Kinoshita's LED element would have provided certain advantages to Asada's system. But these arguments conclusorily assume that deficiencies exist in Asada's system with no evidentiary support, and in contravention of Asada's own disclosure. These arguments also conclusorily assume that Kinoshita provides the stated benefits, with no evidentiary support. In reality, Petitioner fails to identify any benefit of Kinoshita which is not inherent to the use of the claimed LED modules, and these arguments therefore further suffer from the same hindsight problems as Petitioner's first set of arguments.

Petitioner specifically asserts that (1) "use of Kinoshita's LED substrates would have simplified the production of Asada's device,"; (2) "wiring of Asada's device may be simplified as the interconnects for the LEDs would already be included on the substrates in Kinoshita's modules,"; and (3) "Kinoshita's LED modules also facilitate higher luminance and increased brightness for larger devices." Petitioner cites only its expert for these assertions, which merely parrots

the Petition itself. Ex. 1003 ¶ 90. But there is no evidence that Asada’s LED elements are in any way inferior to Kinoshita’s as Petitioner improperly assumes. To the contrary, Asada expressly states that its lighting elements illuminate a surface without any variation in light emission (Ex. 1004 at [0008]), that they are “easy to mass produce and apply to various applications,” (*id.* at [0019], and that they provide good illumination across all necessary wavelengths. *Id.* at [0020]-[0022]. There is simply no support for Petitioner’s assertion that Asada’s LED elements are in any way inferior to Kinoshita’s, such that Kinoshita would offer any improvement. Moreover, these “advantages” that Petitioner identifies are all inherent to use of LED modules including LEDs on a substrate – Petitioner notably fails to identify any support in Kinoshita for these alleged advantages. Petitioner’s identification of advantages thus again relies on the mere existence of LED modules, and reflects the same improper application of hindsight as its first set of arguments.

Because Petitioner has failed to articulate any reason or motivation that a POSITA would combine Asada and Kinoshita, and has thus failed to show that the proposed combination discloses or renders obvious “at least one light emitting module positioned so as to emit light incident on the light guide plate, wherein the at least one light emitting module comprises a plurality of light emitting diodes,” institution should be denied.

B. Grounds 2-4 Have the Same Defects as Ground 1

Grounds 2-3 of the Petition are directed to dependent claims of independent Claims 1 and 23, and rely on the same arguments as Ground 1 discussed above. These Grounds therefore suffer from the same deficiencies, and should be denied for the same reasons discussed above.

Ground 4 challenges independent Claim 20 relying on a proposed combination of Asada in view of Kinoshita and a third reference, Cho. However, Ground 4 relies cites back to Ground 1's argument regarding limitation 1[B] and relies on the same argument as to the claimed "light emitting module comprising a plurality of LEDs." Pet. at 72. While Petitioner also references Cho in this limitation, it is only in the context of asserting that the light emitting module could be implemented on a cover, and does not modify the arguments as to the "light emitting module comprising a plurality of LEDs" itself. Nor does Petitioner's addition of Cho cure its failure to articulate a legitimate reason or motivation to combine Asada and Kinoshita. Accordingly, Ground 4 is also deficient for the same reasons as Ground 1 and institution should be denied for the same reasons

III. CONCLUSION

As discussed above, Hisense's combination fails to disclose or render obvious key limitations of the '778 Patent, and therefore, does not anticipate or render obvious any claims. Institution should be denied.

Respectfully submitted,

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CERTIFICATE OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION has 1,073 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24. This word count was prepared using Microsoft Word for Office 365.

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CERTIFICATE OF SERVICE

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