

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG DISPLAY CO., LTD.,
Petitioner,

v.

PICTIVA DISPLAYS INTERNATIONAL LTD.,
Patent Owner.

Case IPR2026-00129
U.S. Patent No. 12,158,250

**PETITIONER'S OPPOSITION TO PATENT OWNER'S
STATEMENT ON DISCRETIONARY DENIAL**

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I. Introduction

Discretionary denial is unwarranted here. Pictiva's own Introduction explains why: "as against materially the same claim 2 of the parent '425 patent, the Board has already considered the same art and arguments in IPR2024-01095 ('the '425 IPR')" and determined the claim is unpatentable, along with all other challenged claims in the '425 IPR. *See* Paper 7 ("DD Br."), 1; Ex.1052 ("'425 FWD"). It would be illogical and inconsistent to permit the challenged claims of the '250 patent to remain in force when they are "materially the same" as the claims held unpatentable in the '425 IPR.

Pictiva's argument that the Petition should be denied under 35 U.S.C. §325(d) has no merit. The examiner did not make even a single prior-art rejection and did not consider the Board's institution and final written decisions in the '425 IPR, which demonstrate the examiner's material error in allowing the claims. *See, e.g., Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12, at 3 (PTAB July 16, 2025) (informative) ("[T]he patent examiner's conclusion directly contradicts the Board's determination[s] and raises concerns of material error such that review of the challenged patent[] is an appropriate use of Office resources.").

Likewise, that a jury found a *different* invalidity challenge to claim 2 of the '425 patent to be unsuccessful does not alter the fact that the Board determined unpatentability of what Pictiva itself describes as "substantially similar claims" in

the '425 IPR, even if Pictiva asserts that the other challenge in district court is “cumulative” (it is not).

Pictiva also lacks any basis that the Petition is “inconsistent” with any “claim construction” (DD Br. 10-18). Notably absent from Pictiva’s argument—across nearly eight pages of its 20-page brief—is any “claim construction” of the term “n-doped,” because no party proposed a construction and neither the district court nor the Board construed that term. *See id.* Pictiva points to only the district court defendants’ arguments that the accused products do not infringe because they are not n-doped with Liq (and why) as Pictiva contends. These arguments are not inconsistent with the argument—in both the Petition and the '425 IPR—that prior art references here that describe their electron transport layers (ETLs) as “n-doped” indeed disclose n-doping those layers, including with Liq. *See, e.g.,* Pet., 23-29, 56-62; Ex.1052, 11-12. The record and arguments highlight factual differences between the accused products and the prior art disclosures, not a claim construction inconsistency, and Pictiva’s attempt to manufacture an inconsistency fails.

Moreover, Pictiva’s argument that Petitioner “disregard[ed]” the “Board’s rules” (DD Br. 18) is misplaced. Rather, it is Pictiva that has been “cautioned ... that the Board will consider punitive/protective measures if Patent Owner does not abide by [its] rules or instructions in the future.” Ex.1053, 1. This caution even cites the Board’s correspondence rejecting *the same argument* that Pictiva now makes

regarding Ms. Garland’s declaration (DD Br. 19). *Id.* (citing Ex.1054, 1 (“While Dr. Garland’s unavailability for cross examination may impact the testimony’s weight, it does not mean the testimony must be withdrawn.”)). Pictiva’s other assertions of purported rule violations fare no better.

Finally, none of the common reasons for discretionary denial apply here. Pictiva has no settled expectations that the ’250 patent is immune from challenge, as the Petition was filed less than one year after the patent issued. There is no copending litigation involving the ’250 patent with a competing schedule, no national security concerns, no serial petition, no mistreatment of Pictiva, no improper use of expert testimony, and so forth. Pictiva does not argue to the contrary, and discretionary denial is unwarranted.

II. Background

The ’250 patent is the direct child of the ’425 patent. Pictiva asserts the ’425 patent against Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (“Defendants”), but not Petitioner, in *Pictiva Displays International Ltd. v. Samsung Electronics Co., Ltd.*, Case No. 2:23-cv-00495 (E.D. Tex.) (“the EDTX action”). Pictiva sought to assert the ’250 patent during litigation but subsequently decided not to. *See* Pet. 2. After a trial, the jury found that Defendants had not proved by clear and convincing evidence invalidity of claim 2 of

the '425 patent based on product prior art Clix2 and the Wei and Kondakova references. Ex.2033, 6; Ex.2042, 2.

Petitioner filed IPR2024-01095, challenging all claims of the '425 patent based on grounds including Suzuki/Ma and Diekmann/Ma combinations. Ex.1049, 3-4. Pictiva then disclaimed claims 1, 3, 5-8, 13-16, and 18-19 of the '425 patent. Ex.1055, 1. Based on the same arguments raised here in Paper 7, Pictiva requested termination of the IPR in light of the EDTX trial. Ex.1053, 3-5; Ex.2046; Ex.2042. The Board, however, rejected Pictiva's arguments and held that all remaining claims of the '425 patent are unpatentable. *See generally* Ex.1052.

The Petition here challenges all claims of the '250 patent based on the same prior art in the '425 IPR. Similar to the '425 patent, Pictiva disclaimed claims 6-8, 10-11, and 13-15 of the '250 patent here. Ex.2001. As a result, all remaining claims of the '250 patent recite the limitations “the organic layer sequence comprises an electron transport layer that is n-doped” and “the electron transport layer comprises 8-hydroxyquinolinolato-lithium [(i.e., Liq)]” corresponding to limitations [1G] and [1I] in the Petition and which the parties addressed in the '425 IPR. In its discretionary denial request, Pictiva argues that the remaining claims present “substantially similar claims based on the same art and argument” and should not be challenged (DD Br. 6), but the challenge should be permitted because the Board

already determined that such claims are unpatentable in the '425 IPR (Ex.1052, 8-15, 25-26).

III. Pictiva's Request for Discretionary Denial Should be Rejected

A. The examiner materially erred in allowing the '250 patent, as shown by the Board's determination that the parent '425 patent claims are unpatentable

The examiner materially erred in allowing the '250 patent. Pictiva argues that the '250 patent claims are “substantially similar” to the parent '425 patent claims, which “include[] all the material limitations.” DD Br. 6; *id.*, 2-4. The Board instituted the '425 IPR and further determined that the '425 patent claims are unpatentable based on the same prior art that is presented in this Petition. *See* Ex.1048; Ex.1052, 25-26. The Board's institution and final written decisions in the parent patent IPR demonstrate that the examiner materially erred in allowing the '250 patent to issue. The examiner's allowance “contradicts the Board's determination[s] and raises concerns of material error such that review of the patent[] is an appropriate use of Office resources.” *Padagis*, IPR2025-00464, Paper 12, at 3.

Although Pictiva contends that the examiner “considered ... Suzuki, Diekmann, Ma and Lee” (DD Br. 5), the material error is amplified by the examiner's failure to discuss those references or the successful unpatentability arguments in the '425 IPR petition (*see* Pet. 7). That those “asserted prior art [references were] not a basis for rejection during examination” and that the examiner

“did not issue any prior art rejections during examination” show that he “erred by overlooking certain teachings in the prior art on the IDS.” *Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13, at 5-6 (PTAB May 19, 2025) (precedential). Indeed, the examiner’s “consider[ation]” of the references is entirely “silent” (*see* Ex.1002, 491-505) and his “reasons for allowance” merely referred back to his reasons from the July 19, 2024, allowance that pre-dated the IDS submission that included Suzuki, Diekmann, Ma, and Lee (*see* Pet. 6-7). He therefore “overlook[ed]” persuasive arguments in the ’425 IPR petition that the Board adopted in the ’425 FWD. *See Advanced Bionics LLC v. MED-EL Elektromedizinische Geräte GMBH*, IPR2019-01469, Paper 6, at 10 (PTAB Feb. 13, 2020) (precedential).

Pictiva incorrectly asserts that *Advanced Bionics* Part 2 favors denial on the basis that “the Petition identified no material errors made by the examiner” (DD Br. 5). Under the March 26, 2025 Memorandum, the “petitioner ... should not present discretionary considerations [such as *Advanced Bionics*] in the petition” but rather in (this) separate briefing.¹ *See* Ex.1056; <https://www.uspto.gov/patents/ptab/>

¹ Moreover, the Petition could not have relied on the ’425 FWD (or any final agency determination of unpatentability) as demonstrating material error because the Board did not issue the ’425 FWD until after the Petition was filed.

interim-director-discretionary-process. And as explained in the Petition, the examiner materially erred in allowing the '250 patent because Suzuki, Diekmann, and Ma provide both a motivation to use Liq as the dopant in the prior art n-doped ETLs and a reasonable expectation of success in doing so. *See, e.g.*, Pet. 23-29, 56-62; Ex.1003, ¶¶124-27, 131-51, 251-56, 259-79. This obviousness is the only issue Pictiva raises as a basis for discretionary denial; but the Board rejected Pictiva's argument in the '425 IPR. *See* Ex.1052, 10-15.

Pictiva's final assertion that §325(d) denial is "appropriate because the Board has already instituted a trial against the [parent] 425 patent" (DD Br. 6) has it backwards. The Board's determination in the '425 IPR that "substantially similar claims" (DD Br. 6) are unpatentable "tips the balance against discretionary denial," not in favor of it. *POSCO Co., Ltd. v. ArcelorMittal*, IPR2025-00370, Paper 10, at 3 (PTAB June 25, 2025). "It is an appropriate use of Office resources" to grant IPR in this situation "to provide consistency and predictability to the public." *Id.*

Accordingly, discretionary denial under §325(d) is not warranted.

B. The EDTX jury was not presented with and thus did not reject prior art arguments cumulative to grounds in the '250 patent petition

Pictiva argues that Defendants in the EDTX action presented two invalidity grounds against the '425 patent that are "cumulative of the theories" presented in the Petition. DD Br. 7. That is beside the point when determining whether to deny

institution of an IPR challenging “substantially similar claims based on the same art” (DD Br. 6) that the Board has held successful, but Pictiva is wrong nevertheless.

Each of the prior art references presented to the EDTX jury is different from the references relied on in this Petition. In the EDTX action, Defendants presented invalidity grounds based on (1) a combination of *product prior art* Clix2 with Wei under §103 and (2) Kondakova alone under §§102 and 103. Ex.2042, 2. In contrast, the Petition presents grounds based on (A) a combination of Suzuki and Ma (or further with Lee) and (B) a combination of Diekmann and Ma (or further with Lee). *See, e.g.*, Pet. 3.

The EDTX Clix2/Wei combination is materially different from the Petition’s Suzuki/Ma and Diekman/Ma combinations. Pictiva admits that the Clix2 product was not shown to have an n-doped ETL (DD Br. 7; Ex.2034, 917:1-8), and the Clix2-theory presented in the EDTX action was to add an n-dopant to the otherwise undoped ETL in the Clix2 product (Ex.2034, 920:8-14). In contrast, the Petition relies on using Liq (which Ma uses as an n-dopant) as the n-dopant in Suzuki’s and Diekmann’s OLEDs that are *already taught to have n-doped ETLs*. *See, e.g.*, Pet. 23-25, 56-58; Ex.1007, [0333]; Ex.1009, 10, 91. The Petition’s combinations thus are different from Clix2/Wei and involve a materially different obviousness analysis from that presented in the EDTX action.

The Kondakova reference in the EDTX action is also materially different from the prior art in the Petition. Pictiva’s assertion that the Kondakova ground was to “replace known n-dopants such as Cs [(cesium)] with Liq” (DD Br. 9) mischaracterizes the record. Rather, Kondakova teaches to add (not replace) an additional dopant such as Cs to (not with) an ETL made of Liq. Ex.2036, [0332]-[0336], [0355] (“The [ETL] ... may *further* be doped with an alkali metal ... [such as] cesium.”); Ex.2042, 3. Kondakova has no bearing on the motivation to n-dope a non-Liq ETL *with Liq* (as the n-dopant) or whether there was a reasonable expectation of success in doing so.

As explained above, this Petition challenging the ’250 patent contains prior art grounds based on the same references that rendered the challenged claims in the ’425 patent unpatentable, *not* those presented to the EDTX jury. Discretionary denial of this IPR would result in the Office treating the “substantially similar” challenged claims inconsistently, contrary to Pictiva’s argument (DD Br. 6, 10).

C. Contrary to Pictiva’s argument, there are no inconsistent claim constructions

Pictiva suggests that Petitioner presents an “inconsistent” “claim construction” of the term “n-doped.” DD Br. 18. Not so.

Foremost, neither Defendants nor Pictiva proposed claim constructions of the term “n-doped” in the EDTX action, so the district court did not construe that term.

See Ex.1045. Nor did Petitioner or Pictiva propose claim constructions of “n-doped” in the ’425 IPR, so the Board likewise did not construe the term. *See* Ex.1052.

Consistent with the other proceedings, the Petition is based on “the ordinary and customary meaning of [the] claim term” as understood by “a person of ordinary skill in the art.” *See, e.g., Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-13 (Fed. Cir. 2005); Pet. 8. And having no claim constructions for “n-doped” in other proceedings, there is no “inconsistency” for Petitioner to address. Petitioner has fully complied with Rule 104.

Pictiva unsuccessfully raised the same “inconsistency” argument in the ’425 IPR in attempt to terminate that proceeding. *See* Ex.1053 (emails on “litigation developments”); Ex.2046 (Pictiva’s statement on EDTX trial); Ex.2042 (Petitioner’s response on EDTX trial). But the Board rejected that argument in that proceeding. The same result should follow for this Petition, which presents *different* prior art grounds and issues than the EDTX action.

Like in the ’425 IPR, Pictiva appears to argue that it is “inconsistent” for Defendants in the EDTX action to argue that the accused products do not meet the “n-doped” limitation, while Petitioner argues that prior art references that describe their ETLs as “n-doped” indeed disclose n-doping those layers, including with Liq. Pictiva launches into a complicated argument over eight pages of its brief about testimony and briefing regarding various ways in which n-dopants may act, and how

various accused and prior art products in fact act, all the while acknowledging that n-doping is context specific. DD Br. 10-18 & n.3; Ex.2034, 425:16-22, 428:9-17, 472:11-15. But Pictiva cannot obfuscate the fact that, at bottom, there is no inconsistency in arguing that an accused product is not n-doped (and explaining why) as Pictiva contends, while a (different) device taught by the prior art is, particularly where the prior art teaches (and the Board found) it is “n-doped” with Liq. What would be inconsistent would be to reject the Board’s holding in the ’425 IPR challenging a related patent with “substantially similar” claims, and the Office should not accept Pictiva’s invitation to do so. At a minimum, Pictiva’s proposed inconsistency does not provide a legitimate basis for discretionary denial of the Petition. The Board can resolve the purported inconsistency, if any exists, during the course of the IPR.

Nevertheless, this is simply not the case where the district court has adjudicated the same patent, prior art, and asserted grounds. There would be no inconsistent results stemming from the EDTX action.

D. Petitioner did not disregard any rules

Having no meritorious basis, Pictiva resorts to scattershot challenges as its final point. But none have any merit.

Pictiva argues that the Petition’s explanation of Ma’s prior art status at pages 13-14 improperly incorporates by reference Ms. Munford’s librarian

declaration. DD Br. 18-19. Not so. The Petition describes Ms. Munford’s analysis that Elsevier “made Ma available online on August 29, 2008, as shown in its cover,” (Pet. 13) and that Ma was “readily accessible once being published online” by Elsevier (*id.*, 14). The Petition goes on to explain that Elsevier is “a well-established publisher” and refers to evidence including the “‘Articles in Press Listing’ of the Elsevier ScienceDirect webpage.” *Id.* Indeed, the Board determined that “Ma qualifies as prior art” because “the record evidence supports what Ma says on its face—that it was published online on August 29, 2008,” by Elsevier. Ex.1052, 11; Ex.1057 (’223 FWD), 10-13. The Petition’s discussion of Ms. Munford’s declaration properly cites portions of her analysis on supporting facts and conclusions. *See, e.g., Sumitomo Elec. Indus., Ltd. v. United Techs. Corp.*, IPR2017-00966, Paper 7, at 11 (PTAB Sept. 13, 2017) (“Not every statement made by [a declarant] need be repeated in a brief to avoid incorporation by reference; otherwise, separate declarations would be unnecessary.”). And Pictiva does not point to other portions of the Petition as improper.

Pictiva next takes issue with the declaration by Ms. Garland (from Elsevier) that Ms. Munford reviewed to confirm that it comports with the many pieces of evidence that she analyzed (*see* Ex.1005, ¶16). Pictiva contends that a declaration from an “unavailable witness ... is nothing more than inadmissible hearsay, warranting discretionary denial.” DD Br. 19. Setting aside the fact that experts like

Ms. Munford may rely on inadmissible evidence, including hearsay (Fed. R. Evid. 703), the Board already rejected Pictiva’s argument in IPR2024-01094 and IPR2024-01095, explaining that “[w]hile Dr. Garland’s unavailability for cross examination may impact the testimony’s weight, it does not mean the testimony must be withdrawn.” Ex.1054, 1 (“Patent Owner is not authorized to file a motion to strike or terminate.”).

Pictiva does not show that CTPG §1.F.1.b requires production of a non-party witness, rather than prescribing which party will normally bear the expenses of production. *OpenSky* also does not help Pictiva because it concerned a technical expert’s declaration that was the “sole support” for prior art grounds. IPR2021-01056, Paper 18, at 6 (PTAB Dec. 23, 2021). That case rather undercuts Pictiva because there the Board took no issue with Dr. Hall-Ellis’s librarian declaration from another proceeding. *Id.* at 5. Here, Pictiva does not dispute the deposition availability of Ms. Munford, who provides an independent, comprehensive analysis of Ma’s public accessibility. In fact, Pictiva did take her deposition and examined her on Ma’s prior art status. Ex.1058.

Pictiva asserts that Petitioner is required but “fails to inform the Board that its engineers failed to obtain an n-doped ETL” as purportedly “inconsistent” with the Suzuki/Ma and Diekman/Ma grounds in the Petition (*see* DD Br. 20). But there is no inconsistency, as explained above. The purported “failure” that Pictiva cites

concerns testimony on *product prior art Clix2* and nothing about Suzuki, Diekmann, or Ma in this Petition. *See* Ex.2034, 917:1-8, 920:8-14. Pictiva itself acknowledges that n-doping by Liq is context dependent. *See, e.g.*, DD Br. 12 & n.3; Ex.2034, 472:11-15. Moreover, although Pictiva refers to Rule 41.51(b)(iii), that rule concerns discovery between the parties (not about “informing” the Board), and Pictiva acknowledges that it has the testimony from the EDTX action subject to the district court’s protective order.

Pictiva’s scattershot arguments show no “disregard of [the] Board’s rules” (DD Br. 7, 18), unlike its own conduct that repeatedly “improperly circumvent[ed] [the Board’s] rules and procedures....” Ex.1053, 1.

E. Other factors favor institution

Pictiva served Defendants (real-parties-in-interest in this IPR) with a motion attaching a complaint alleging infringement of the ’250 patent before it even issued (*see* Pet. 2), and Petitioner filed this challenge. Nevertheless, Pictiva withdrew its request to add the ’250 patent to the EDTX action, so there is no copending litigation that may result in wasted expenditure of resources or inconsistent results from litigating in two forums. Pictiva also has no settled expectations in the ’250 patent, which the Petition challenged less than one year after the patent issued. Nor are there any national security concerns, serial petitions, mistreatment of Pictiva, or improper use of expert testimony. Pictiva does not argue to the contrary.

Pictiva has repeatedly (including here) disclaimed many, but not all, claims in the '425 and '250 patents, and the Office has adjudged the remaining claims of the '425 patent unpatentable. It should do the same for the remaining “substantially similar” '250 patent claims challenged here.

Under these circumstances, “it is an efficient use of Board resources to address the related ['250 patent].” *Padagis*, IPR2025-00464, Paper 12, at 3-4.

IV. Conclusion

The Office should not exercise the discretion to deny the Petition in this *inter partes* review.

Date: March 2, 2026

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6, I hereby certify that the foregoing Petitioner's Opposition to Patent Owner's Statement on Discretionary Denial was served by electronic mail today on the following counsel of record for Patent Owner:

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