

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

BOE TECHNOLOGY GROUP CO., LTD.,

Petitioner,

v.

OPTRONIC SCIENCES LLC,

Patent Owner.

---

Case IPR2025-00238  
U.S. Patent No. 8,604,471

**PATENT OWNER'S SUPPLEMENTAL BRIEF IN SUPPORT OF  
DISCRETIONARY DENIAL**

**TABLE OF AUTHORITIES**

**Cases**

*Dabico Airport Solutions Inc. v. Axa Power Aps*,  
IPR2025-00408, Paper 21 (P.T.A.B., June 18, 2025)..... 1, 2

*Irythm Technologies, Inc. v. Welch Allyn, Inc.*,  
IPR2025-00363 (Paper 10) (P.T.A.B., June 6, 2025)..... 2

**Statutes**

35 U.S.C. § 286..... 1

**PATENT OWNER'S UPDATED EXHIBIT LIST**

<b>No.</b>	<b>Description</b>
2001	Docket Navigator Stay Statistics
2002	February 14, 2025, DCO
2003	BOE's April 1, 2025, Invalidity Contentions
2004	Exhibit D-8 to BOE's April 1, 2025, Invalidity Contentions
2005	Exhibit D-2 to BOE's April 1, 2025, Invalidity Contentions
2006	Exhibit 2026 of IPR2024-01133, Dr. Bretschneider's Declaration
2007	Exhibit 2020 of IPR2024-01130, Dr. Bretschneider's Declaration
2008	Docket Navigator Median Time-to-Trial Statistics for the Eastern District of Texas
2009	<i>Dabico Airport Solutions Inc. v. Axa Power Aps</i> , IPR2025-00408 (Paper 21)
2010	Information Disclosure Statement filed in U.S. Patent Application No. 17/428,969 (Jan. 30, 2022).
2011	U.S. Pat. No. 11,974,463 to Wang et al.

Patent Owner filed its request for discretionary denial on June 11, 2025. (Paper 7). On June 18, 2025, the Director published a decision granting Patent Owner's Request for Discretionary Denial and Denying Institution of *Inter Partes* Review in *Dabico Airport Solutions Inc. v. Axa Power Aps* (“*Dabico*”). Ex. 2009. Patent Owner submits that *Dabico* further supports its request that the Director deny institution in the instant proceeding.

In *Dabico*, the Director denied institution after reviewing the totality of the evidence, holding that the Office is “disinclined to disturb the settled expectations” of the patent owner in the absence of persuasive reasons why the Office should review the challenged patent. Ex. 2009 at 3. The Director held that settled expectations were created because “the challenged patent has been in force almost eight years[.]” *Id.* at 2. The Director further stated, “[a]lthough there is no bright-line rule on when expectations become settled, in general, the longer the patent has been in force, the more settled expectations should be.” *Id.* at 3. The Director emphasized consistency with the “other approaches to settled expectations and incentives, for example, for filing infringement lawsuits.” *Id.* (citing, *cf.* 35 U.S.C. § 286) (“Except as otherwise provided by law, no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action.”). *Dabico* further explains that “actual notice of a patent or of possible infringement is not necessary to create settled

expectations.” *Id.* at 3. *Dabico* builds on *Irythm Technologies, Inc. v. Welch Allyn, Inc.*, IPR2025-00363 (Paper 10) . In *Irythm*, the USPTO denied institution because the Petitioner had long been aware patents being challenged. *Id.* at 3. The *Irythm* petitioner “cited the then-pending application . . . in an Information Disclosure Statement. . . . Petitioner’s awareness of Patent Owner’s applications and failure to seek early review of the patents favors denial and outweighs the above-discussed considerations.” *Id.*

The settled expectations of the ’471 Patent are stronger than those in *Dabico*. As highlighted in Patent Owner’s discretionary denial brief (Paper 7), the ’471 Patent has been in force since 2013 and was filed in 2011. Ex. 1001 at 1. The ’471 Patent has therefore been in force for ***over eleven (11) years***—more than three years longer than the patent in *Dabico* and nearly double the length of statutory damages for infringement actions, as cited by the Director in *Dabico*. See Ex. 2009 at 3 (“in general, the longer the patent has been in force, the more settled expectations should be”). Indeed, the ’471 Patent was filed before the America Invents Act was signed into law. Further, Patent Owner’s settled expectations are even stronger than those in *Dabico* because Petitioner had knowledge of the patents no later than January 2022, when BOE cited the ’471 Patent in an Information Disclosure Statement in U.S. Patent Application No. 17/428,969. Ex. 2010 at 2 line 8 (citing U.S. Publication

20120298983A1, which became the '471 Patent); Ex. 2011 at cover (BOE is an “Applicant” of application number 17/428,969 that the IDS was filed in).

When a patent has strong settled expectations like the '471 Patent, a petitioner must provide “persuasive reasoning” to disturb those settled expectations. *See* Ex. 2009 at 3. As described in Patent Owner’s request for discretionary denial (Paper 7), no such reasoning exists here.

Accordingly, Patent Owner respectfully requests that the Director exercise discretion under Section 314(a) to deny institution for the reasons set forth in Patent Owner’s request for discretionary denial (Paper 7) and in light of additional reasons submitted herein.

Date: July 3, 2025

Respectfully submitted,

*Jefferson Cummings*  
Jefferson Cummings (Reg. No. 81,926)  
RUSS AUGUST & KABAT  
12424 Wilshire Boulevard, 12<sup>th</sup> Floor  
Los Angeles, CA 90025  
(310) 826-7474  
*Attorney for Patent Owner*

**CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))**

The undersigned hereby certifies that the above document was served on July 3, 2025, by filing this document through the P-TACTS system as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioner:

Brian Erickson

[Brian.Erickson@us.dlapiper.com](mailto:Brian.Erickson@us.dlapiper.com)

Michael Saulnier

[michael.saulnier@us.dlapiper.com](mailto:michael.saulnier@us.dlapiper.com)

[DLA-BOE-Optronicsciences@us.dlapiper.com](mailto:DLA-BOE-Optronicsciences@us.dlapiper.com)

Date: July 3, 2025

Respectfully submitted,

*/Jefferson Cummings/*

Jefferson Cummings (Reg. No. 81,926)  
RUSS AUGUST & KABAT  
12424 Wilshire Boulevard, 12<sup>th</sup> Floor  
Los Angeles, CA 90025  
(310) 826-7474

*Attorney for Patent Owner*