UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD., AND
SAMSUNG ELECTRONICS AMERICA, INC.
Petitioner

v.

SINOTECHNIX LLC
Patent Owner

Case No. IPR2025-00335
U.S. PATENT No. 8,132,952

PETITIONER'S DISCRETIONARY DENIAL OPPOSITION BRIEF

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Throughout the Petition, all annotations, coloring, and emphases have been added unless indicated otherwise.

I. INTRODUCTION

Patent Owner's request for discretionary denial of institution under 35 U.S.C. §§ 314(a) and/or 325(d) should be rejected. The Petition was diligently prepared and filed on January 6, 2025, less than three months after Patent Owner served its initial infringement contentions (on October 24, 2024) that for the first time identified the claims asserted in the underlying litigation. The Petition presents strong invalidity grounds, coupled with a stipulation that goes well beyond a typical *Sotera* stipulation, and which eliminates any potential overlapping invalidity issues between the litigation and the IPR upon institution. Accordingly, Petitioner submits that the Director should not discretionarily deny institution.

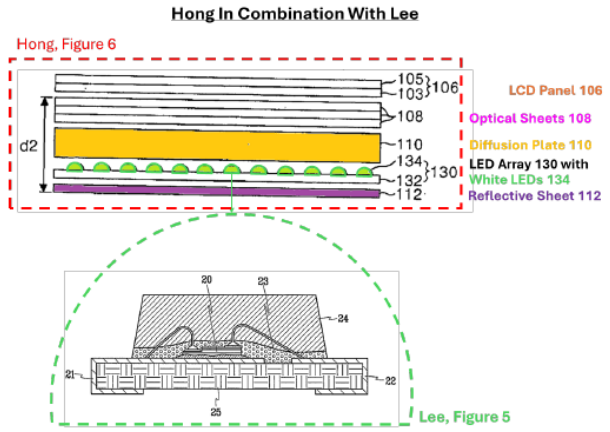
Although Patent Owner relies heavily on the currently scheduled District Court trial four months before the expected Final Written Decision (Patent Owner's Discretionary Denial Brief ("DD Brief") at 2), the underlying Court's trial dates are far from immutable, and in fact are more likely than not to slip. ***First***, recent data from the Court demonstrates that patent trials are commonly delayed—sometimes by as much as six months—from the date scheduled in the Court's initial Docket Control Order. *See* Section II.2. ***Second***, where (as here) significant discovery and substantive deadlines remain, the District Court has repeatedly granted stay motions renewed after IPR institution, even though "the final written decisions for the IPRs could issue after the scheduled trial." *Harbor Island Dynamic, LLC v. Samsung*

Elecs. Co., No. 2:24-cv-00140-JRG-RSP, Dkt. 81 (E.D. Tex. May 19, 2025); *see also Arbor Global Strategies LLC v. Samsung Elecs. Co.,* No. 2:19-cv-00333-JRG-RSP, 2021 WL 66531, at *1 (E.D. Tex. Jan. 7, 2021). *See* Section II.1. Indeed, ***every*** major event in the underlying case will take place ***after*** the expected date for institution. By the time of an institution decision on the merits (due around September 6, 2025), not even the opening claim construction brief (due September 19, 2025) will have been filed. EX1021 at 4 [Docket Control Order]. The *Markman* hearing will not take place for another 2 months (November 7, 2025), and fact discovery will not close for another 3 months (December 9, 2025). *Id*. at 3. Moreover, no expert reports will have been served. *Id.* In fact, the only substantive Court investment thus far simply resolved disputes concerning the sufficiency of Plaintiff's infringement contentions, and related discovery issues. Not a single non-venue deposition has been scheduled or taken. ***Third***, Petitioner has a factually strong pending motion to transfer the case from the Eastern District of Texas to the District of New Jersey, which, if granted, will surely vacate the currently scheduled trial. *See* Section II.2.

But even if trial proceeds on the currently scheduled trial date, the Director should not discretionarily deny institution. ***First***, recent Board precedent demonstrates that discretionary denial is not warranted where only a four-month gap exists between the currently scheduled trial date and the Final Written Decision

("FWD") date. *See, e.g.*, *MediaTek Inc. v. Daedalus Prime LLC*, IPR2025-00100, Paper 10 at 27-28, 34 (PTAB May 19, 2025). ***Second***, Petitioner's stipulation ensures that this IPR proceeding will serve as a true alternative to litigation for the purposes of a patentability determination, because Petitioner has agreed to a stipulation that goes above and beyond a typical *Sotera* stipulation. In particular, Petitioner has stipulated to eliminate all overlapping invalidity issues between the District Court litigation and this proceeding, including by not relying on "any ground that was raised or could have been reasonably raised" in the IPR ***and*** not "rely[ing] on ***any product or system art that is 'based on the same evidence presented' in this IPR***." *Cf. SAP America, Inc. v. Cyandia, Inc.,* IPR2024-01496, Paper 13 at 9 (PTAB Apr. 7, 2025)." EX1022. *See* Section II.4.

Discretionary denial is also unwarranted because the Petition presents a compelling invalidity challenge that covers ***more*** claims than are currently asserted in the pending litigation. Discretionary denial would deprive Petitioner of pursuing challenges of additional claims presented in the Petition that would not otherwise be litigated in the District Court. Moreover, even a cursory comparison between the challenged claims of U.S. Patent No. 8,132,952 (the "'952 Patent") and the Petition's leading combination—Hong in combination with Lee—shows that the Petition presents a compelling case of unpatentability. *See* Section II.6.

'952 Patent	Hong+Lee
1. A backlight panel, comprising: a **diffusion plate** comprising a top surface and a bottom surface; a **plurality of white light emitting diodes** arranged below the bottom surface of the **diffusion plate**, the **white light emitting diodes** to emit light directly onto the bottom surface of the **diffusion plate**; a **reflection sheet** arranged below light exit surfaces of the **white light emitting diodes**, **the reflection sheet** to reflect light toward the **diffusion plate**, wherein each **white light emitting diode** comprises a blue light emitting diode chip and a red phosphor and a green phosphor arranged on the blue light emitting diode chip.	

II. THE DIRECTOR-IDENTIFIED FACTORS UNDER 35 U.S.C. § 314 DO NOT WARRANT DISCRETIONARY DENIAL

As summarized below, the *Fintiv* factors—as well as the additional considerations enumerated in the Memorandum on Interim Processes for PTAB

Workload Management ("Memo") [1] —collectively weigh against discretionary denial.

	Conclusion	Explanation
Factor 1	Favors institution	Stay is likely if IPR is instituted, because the Court grants renewed stay motions filed post-institution under similar facts
Factor 2	Neutral	Trial date will likely change given the forthcoming renewed motion to stay upon institution of IPRs, the court's current and increasing congestion on the scheduled trial date, and the likelihood of transfer to the District of New Jersey
Factor 3	Favors institution	No significant investment in substantive issues has occurred; venue discovery and defining the scope of accused products have been the primary investment to date
Factor 4	**Strongly favors institution**	Petitioner's stipulation removes all potential overlapping invalidity issues—including any product or system art that is "based on the same evidence presented" in this IPR

[1] FAQs for Interim Processes for PTAB Workload Management, available at https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management (last accessed June 6, 2025).

Factor 5	Slightly favors denial	Same parties in the IPR and litigation, but should be afforded little to no weight
Factor 6	**Strongly favors institution**	Compelling merits and other factors favor institution

1. The Court Will Likely Grant A Stay If The Board Institutes IPR.

Factor 1 favors institution because the Court has stayed parallel district court cases with similar facts ***after*** the Board institutes *inter partes* review. Patent Owner argues that Factor 1 "favors denial" because, according to Patent Owner, the Court will likely deny Petitioner's pending pre-institution motion to stay and any renewed post-institution motion to stay. DD Brief at 5-7. That argument is mistaken.

Factor 1 favors institution because, although it may be true that the EDTX Court does not typically grant ***pre***-institution stays, it is likely that the Court will grant a ***post***-institution stay on the facts present here. For example, both Judge Gilstrap and Magistrate Judge Payne[2] have recently granted motions to stay after institution where—as here—substantial portions of discovery remained and a *Markman* hearing had not yet been held at the time of institution. *See Broadphone*

[2] Pretrial proceedings including the *Markman* hearing and pre-trial conference have been referred to Magistrate Judge Payne. EX1021 [Docket Control Order].

LLC v. Samsung Elecs. Co., No. 2:23-cv-00001-JRG-RSP, 2024 WL 3524022, at *2 (E.D. Tex. July 24, 2024) (granting motion to stay because "[a] significant amount of discovery remains, the claim construction hearing has not occurred, and trial is currently set for February 10, 2025. Further, the Court does not find that Samsung filed the IPR at such a late stage in the case that it would weigh against a stay.") (FWD due May 2025); *Cobblestone Wireless, LLC v. Cisco Sys., Inc.*, No. 2:23-cv-00454-JRG-RSP, 2024 WL 5047854, at *2 (E.D. Tex. Dec. 9, 2024) (granting motion to stay where "case ha[d] been pending for nearly 10 months, with many documents produced and interrogatories answered," but "large parts of discovery and many other important deadlines were still left"); *Vill. Green Techs., LLC v. Samsung Elecs. Co.*, No. 2:22-cv-00099-JRG, 2023 WL 416419, at *3 (E.D. Tex. Jan. 25, 2023) (granting motion to stay where "the close of discovery, the claim construction hearing, and the trial setting" remained); *Commc'n Techs., Inc. v. Samsung Elecs. Am., Inc.*, No. 2:21-cv-00444-JRG, 2023 WL 1478447, at *3 (E.D. Tex. Feb. 2, 2023) (same); *Scorpcast, LLC d/b/a HaulStars v. Boutique Media*, No. 2:20-cv-00193, D.I. 177 at *5 (E.D. Tex. June 8, 2021) (granting motion to stay where motion was filed even after the *Markman* hearing); *Resonant Sys., Inc. v. Samsung Elecs. Co.*, No. 2:22-cv-00423-JRG, 2024 WL 1021023, at *4 (E.D. Tex. Mar. 8, 2024) (granting motion to stay where *Markman* hearing had not occurred and "the bulk of depositions" remained).

Moreover, even if the Court denies Petitioner's pre-institution motion to stay as a matter of course, the primary case upon which Patent Owner relies demonstrates that filing a pre-institution stay motion only ***increases*** the likelihood of a stay after renewal post-institution. In *Arbor Global Strategies LLC v. Samsung Electronics Co.* (cited at DD Brief at 6), just like in the instant case (*see infra* Section II.6.i), the petitioner filed IPR petitions almost three months after Plaintiff served its infringement contentions. No. 2:19-cv-00333-JRG-RSP, 2021 WL 66531, at *1 (E.D. Tex. Jan. 7, 2021). One month later—***before*** institution of the IPRs—the petitioner moved to stay the parallel litigation. *Id.* Although that pre-institution stay motion was denied (without prejudice) and the case continued to progress towards trial, the petitioner renewed its motion ***after*** the IPRs were instituted, and the court then ***granted*** the motion. *Id.* In granting the stay, the court credited the petitioner's diligence as evidenced by the pre-institution motion, noting that "Defendant did not delay in notifying the Court of its desire to seek a stay of the litigation while the IPR proceeds." *Arbor Glob. Strategies LLC*, 2021 WL 66531, at *3.

That was not an isolated incident. The same scenario played out in *Harbor Island Dynamic, LLC., v. Samsung Electronics Co.* as recently as May 19, 2025, where Magistrate Judge Payne granted a renewed motion to stay after the Board instituted the IPRs. *Harbor Island Dynamic, LLC v. Samsung Elecs. Co.*, No. 2:24-cv-00140-JRG-RSP, Dkt. 81 (E.D. Tex. May 19, 2025). Despite acknowledging

that "the final written decisions for the IPRs could issue after the scheduled trial, [and] this factor weighs against a stay," because "Defendants had earlier filed a motion to stay [pre-institution]," and "large parts of discovery and many other important deadlines were still left," Magistrate Judge Payne ***stayed the case*** "pending final written decision by the PTAB." *Id.*; *see also Twitch Interactive, Inc. v. Razdog Holdings LLC,* IPR2025-00307, Paper 18 at 2-3 (PTAB May 16, 2025) (Director's discretionary denial decision crediting Petitioner's argument regarding granting of post-institution stay motions).[3]

[3] Even if the Director declines to weigh the factual circumstances present here—which, for the reasons explained, demonstrate that a post-institution stay is likely—this Factor should be at worst considered neutral. In particular, the Board has in the past routinely found Factor 1 neutral when a pending motion to stay had not yet been decided. *Liberty Energy, Inc. v. U.S. Well Servs., LLC*, IPR2025-00031, Paper 9 at 9 (PTAB Apr. 29, 2025) ("We conclude *Fintiv* factor 1 is neutral, because it is unknown at this time whether the Court will grant Petitioner's motion to stay the District Court Litigation."); *Solus Advanced Materials Co. v. SK Nexilis Co.,* IPR2024-01463, Paper 14 at 13 (PTAB Apr. 25, 2025) ("We decline to speculate on how the court may rule on the pending motion to stay. Accordingly, this factor is neutral.").

Patent Owner's cited cases asserting a likelihood of denial of a renewed post-institution motion to stay (DD Brief at 7) are easily distinguishable. In *MyPort, Inc. v. Samsung Elecs. Co.*, discovery was far more advanced, as the plaintiff had taken multiple fact depositions in Korea. No. 2:22-cv-00114-JRG, 2023 WL 5612445 (E.D. Tex. Aug. 30, 2023). *See* EX2003, 4-5; *see infra* Section II.3. Additionally, the institution decision in that case "question[ed] whether Petitioner demonstrate[d] a reasonable likelihood of prevailing in showing that [all asserted claims] would have been obvious." EX2003, 5-7. Here, there have been no non-venue depositions, and opening expert reports are not due until 3 months ***after*** the expected institution decision, showcasing Samsung's diligence. *See infra* Section II.3 [Factor 3]. Moreover, the Petition compellingly demonstrates the unpatentability of the challenged claims. *See infra* Section II.6.i [Factor 6].

Likewise, in *Solas OLED Ltd. v. Samsung Display Co.*, the case was much more advanced: the District Court had "issued a claim construction order and all discovery ha[d] closed" prior to institution of the IPR. No. 2:19-cv-00152-JRG, 2020 WL 4040716, at *2 (E.D. Tex. July 17, 2020). Here, the *Markman* hearing will not take place until 2 months ***after*** the institution decision and fact discovery will not close until 3 months after the institution decision. *See infra* Section II.3 [Factor 3].

Likewise, in *General Access Solutions, Ltd. v. Cellco Partnership et al.*, the parties had already exchanged expert reports and the court had conducted a *Markman* hearing before the motion to stay was fully briefed. *See* EX2004, 4. In sharp contrast, here—even assuming that the pending pre-institution stay motion will be denied—if the Board institutes the IPR by September 6, 2025, Petitioner will be able to renew its stay motion well before the scheduled *Markman* hearing (November 7, 2025), and well before any opening expert reports are due (December 9, 2025). EX1021, 3; *see also infra* Section II.3.

Notably, the Petition challenges ***all*** claims asserted in the parallel litigation, which will greatly simplify the issues for the District Court should the Board institute. *See Harbor Island*, Dkt. 81 at 5 ("Here, the Board has instituted a trial covering all asserted claims. … Accordingly, the simplification factor weighs in favor of a stay."). Indeed, as Magistrate Judge Payne noted, "[w]hether a stay 'will result in simplification of the issues before a court is viewed as the most important factor when evaluating a motion to stay.'" *Id*. at 4.

Accordingly, given the Court's past practice of staying parallel District Court litigations after IPR institution—and, in particular, doing so in analogous factual circumstances—Factor 1 favors institution. *See Twitch Interactive Inc. v. Razdog Holdings LLC*, IPR2025-00307, Paper 18 at 2-3 (finding institution is favored

because "Petitioner has provided persuasive evidence that '[t]here is good reason to believe that a stay will be granted.'").

2. The Currently Scheduled Trial Is More Likely To Change Than It Is To Hold, And The Board Has Often Instituted Proceedings Even If The Court's Scheduled Trial Date Precedes The Board's Expected Final Written Decision By Four Months or More.

Factor 2 is neutral. Contrary to Patent Owner's arguments, real-world factors indicate that the currently scheduled trial date is unlikely to hold as set. In particular, and in addition to the fact that a renewed motion to stay is highly likely to be granted if the IPRs are instituted (*see supra* Section II.1): (1) the Court is heavily congested; (2) initially scheduled trial dates more often than not get delayed; (3) the average median time-to-trial for the entire EDTX is increasing; (4) the Board's earlier precedents declined to exercise discretion under similar timelines; and (5) there is a factually compelling pending motion seeking transfer to the District of New Jersey, which will certainly reset the trial schedule if granted.

First, there are currently ***eleven*** cases set for trial on May 4, 2026, and that number is steadily growing—just four months ago, only eight cases were set for trial on that date. *See* EX1027 and EX1013. Contrary to Patent Owner's arguments, it is entirely speculative that this case alone will proceed to trial on the currently scheduled trial date rather than one of the other ten cases currently set for trial on that very same date. *See BOE Tech. Group Co. v. Optronic Sciences LLC,* IPR2024-

01130, Paper 16 at 10 (PTAB Jan. 27, 2025) (finding Factor 2 neutral or weighing slightly in favor of institution "[b]ecause a number of cases are scheduled for jury selection on January 5, 2026 in addition to the parallel proceeding, there is some uncertainty whether the trial in that proceeding would actually begin on that date."). Indeed, one of the other ten cases currently scheduled for trial before Judge Gilstrap on the same date (May 4, 2026) is another case—*Secure Communication Technologies, LLC v. Samsung Electronics Co.*, 2:24-cv-00484-JRG-RSP—in which Patent Owner's counsel represents a plaintiff suing ***Petitioner***. EX1027, 2. Judge Gilstrap would not be able to sit for two different trials involving the same Petitioner and Patent Owner's counsel on the same date.

Moreover, if the currently scheduled trial date gets delayed, it is entirely uncertain how soon a new trial can be scheduled. Judge Gilstrap's caseload shows ***45 other trials*** that are currently scheduled over the following two months. EX1023. In addition, Judge Gilstrap currently has ***19 trials*** scheduled for the four weeks of April 2026, any of which may shift into May and bump the currently scheduled trial date in this case. EX1044. That is all to say that the currently scheduled May 4, 2026 trial date is entirely speculative.

Second, the data from not only EDTX generally—but more specifically from Judge Gilstrap's cases—demonstrate that the trial is more likely to move. Patent Owner argues that the vast majority of the cases that are scheduled to go to trial in

EDTX do not actually go to trial. DD Brief at 9 (citing EX1012 to argue that in a 12-month period ending in September 2024, only 13 out of 809 total cases pending in EDTX went to trial). But as summarized below, Patent Owner omits that over half of the cases that proceeded to trial—seven of thirteen—***were rescheduled for a later date***. *See* EX1043.

Case Name	Docket No.	Trial Date Set Forth In Initial Scheduling Order	Actual Trial Date	Delay (Days)
Pardalis Tech. Licensing, LLC v. IBM	2:22-cv-00452	8/19/2024	9/20/2024	32
Mojo Mobility Inc v. Samsung Elecs. Co.	2:22-cv-00398	8/5/2024	9/6/2024	32
Netlist, Inc. v. Micron Tech. Texas, LLC	2:22-cv-00294	4/15/2024	5/20/2024	35
Smart Path Connections, LLC v. Nokia Corp.	2:22-cv-00296	3/18/2024	4/1/2024	14
G+ Comms., LLC v. Samsung Elecs. Co.	2:22-cv-00078	11/13/2023	1/19/2024	67
Evolved Wireless, LLC v. Samsung Elecs. Co.	2:21-cv-00033	10/16/2023	11/9/2023	24
Ollnova Techs. Ltd. v. Ecobee, Inc.	2:22-cv-00072	9/11/2023	10/1/2023	20

And other trials were similarly delayed. For example, just outside Patent Owner's arbitrary cut-off date of September 2024—and thus curiously hidden from the statistics Patent Owner chose to present to the Board—was a trial that was initially scheduled for November 18, 2024. That initially scheduled trial date was

rescheduled ***eight*** times to May 19, 2026—causing a delay of more than ***six months***. *See Multimedia Techs. Pte. Ltd. v. LG Elecs. Inc. et al.*, Case No. 2:22-cv-00494-JRG-RSP (E.D. Tex). Thus, based on real-world data, and contrary to Patent Owner's assertion, there is a greater than 50% chance that the currently scheduled trial date will move, and as discussed in more detail below, the congestion has only increased since then.

Patent Owner also leans heavily on the standard language in the Docket Control Order ("DCO") that the trial date "cannot be changed without an acceptable showing of good cause." DD Brief at 9 (citing DCO at 1, 5). But each of the seven cases cited above similarly included the "good cause" language in their corresponding DCOs, yet they nevertheless moved. EX1043, 3, 7, 13, 16, 22, 25, 32, 37, 43, 47, 53, 56, 62, 66. In any event, the "good cause" provision plainly attaches to party requests to adjourn a date—not court congestion or the Court's own management of its docket.

Thus, unlike *HP Inc. v. Universal Connectivity Technologies, Inc.*, in which the petitioner's "unsupported argument" that the "trial date is speculative" was said to have rung hollow, (DD Brief at 9 (citing IPR2024-01428, Paper 12 at 6)), Petitioner here provides real-world evidence of cases in EDTX—and, particularly, in front of Judge Gilstrap—to show that the scheduled trial date is more likely than not to move.

Third, even the median time-to-trial statistics show increasing delays. Patent Owner relies on Exhibit 1012 to argue that the Court's May 4, 2026 trial setting is consistent with the Court's median time-to-trial date of 21.9 months." DD Brief at 9. But updated statistics released on December 31, 2024, show that the median time-to-trial has increased to 23 months. EX1024. Indeed, there has been a steady increase in the median time-to-trial over the last two years, increasing from 19.0 to 23.0 months. *Id.* That is undoubtedly due to increasing congestion in the district. *Compare* EX1012 vs. EX1024.

Fourth, the Board has repeatedly—and recently—declined to exercise its discretion to deny institution with a similar (nominal) 4-month gap[4] between the initially scheduled trial date and expected FWD date. *See MediaTek Inc. v. Daedalus Prime LLC*, IPR2025-00100, Paper 10 at 27-28, 34 (PTAB May 19, 2025); *Samsung Elecs. Co. et al. v. Harbor Island Dynamic, LLC*, IPR2024-01404, Paper 9 at 8-9 (PTAB Apr. 4, 2025) (declining to discretionarily deny institution when trial was scheduled for four months before FWD); *Samsung Elecs. Co. v. Headwater Research LLC*, IPR2024-01407, Paper 9 at 7 (PTAB Mar. 20, 2025) (declining to discretionarily deny institution when trial was scheduled for five months before

[4] As noted above, given the substantial likelihood that the actual trial date will be later, the nominal gap is likely to be substantially less than 4 months.

FWD). In fact, the Board has refused to discretionarily deny petitions with a trial date that exceeds the expected FWD date even more than four months. *See, e.g., Solus Advanced Materials Co. v. SK Nexilis Co.,* IPR2024-01463, Paper 14 at 14 (PTAB Apr. 25, 2025) (declining to discretionarily deny institution even when trial was scheduled for ***six months*** before the statutory FWD deadline); *Google LLC v. Mullen Indus. LLC*, IPR2025-00021, Paper 14 at 9 (PTAB May 14, 2025) (similarly declining to discretionarily deny institution when trial was scheduled for ***six months*** before the statutory FWD deadline).

Most of Patent Owner's cases reflect a much longer lag between the expected FWD date and the District Court trial date, and should receive no weight here. For example, Patent Owner cites *Ericsson Inc. v. Active Wireless Techs. LLC* and its collection of supporting cases. IPR2024-00886, Paper 8 at 8-9 (PTAB Nov. 12, 2024). DD Brief at 8. But *Ericsson* had an ***eight-month gap***—double the nominal time here—between the District Court trial and the expected FWD date. *Id*. In fact, the majority of cases cited in *Ericsson*'s Factor 2 analysis had much more than four months between the scheduled District Court trial and the expected FWD. *Id.* (citing *Edward LifeSciences Corp. v. Evalve, Inc.*, IPR2019-01479, Paper 7 at 6–13 (PTAB Feb. 26, 2020) (denying institution where jury trial would conclude more than ***nine months*** before a final decision would be due); and *Samsung Elecs. Am., Inc. v. Uniloc 2017 LLC*, IPR2019-01218, Paper 7 at 7–10 (PTAB Jan. 7, 2020) (denying

institution where jury selection was scheduled for approximately ***six months*** before trial in the Board proceeding would conclude)). And in *Google LLC v. Cerence Operating Co*., the District Court had set a trial date of "almost ***seven months*** before the final written decision," in contrast to the four-month gap that currently exists here. IPR2024-01465, Paper 15 at 9 (PTAB April 23, 2025).

Likewise, Patent Owner's reliance on *AT&T Servs. Inc. v. ASUS Tech. Licensing Inc.* is misplaced. DD Brief at 8. Although it is true that the "trial in the parallel district court proceedings [was set] to begin four to five months prior to the deadline for [the] final written decision, based on the scheduled trial date and the median time-to-trial statistics," the petitioner had only submitted a *Sand Revolution* stipulation and not the strengthened *Sotera*-type stipulation Petitioner has submitted here. *AT&T Servs. Inc. v. ASUS Tech. Licensing Inc.*, IPR2024-00997, Paper 15 at 9, 12 (PTAB Dec. 16, 2024). Moreover, unlike here, the petitioner's IPR in that case did not show a "compelling meritorious challenge." *Id.* at 20.

EClinicalWorks, LLC v. Decapolis LLC is also distinguishable. DD Brief at 8. In that proceeding, the Board found that even though trial was scheduled "roughly one to two months before any final decision," it only weighed "***somewhat*** in favor of denial." IPR2022-00229, Paper 10 at 9 (PTAB Apr. 13, 2022). And more important, the petitioner's IPR lacked "any indication that Petitioner has stipulated to not assert the grounds in the Petition in the parallel litigation." *Id.* at 12.

The instant case is also distinguishable from the two recent decisions denying institution under the new bifurcated discretionary denial process. In *ARM Ltd. and MediaTek Inc. v. Daedalus Prime LLC*, even though the time-to-trial statistics suggested that the trial date would precede the expected FWD by only ***one to three*** months, the district court scheduled a trial approximately ***six months*** before the expected FWD date. IPR2025-00207, Paper 10 at 2 (PTAB May 16, 2025). In *Ericsson Inc. et al. v. Procomm Int'l PTE. Ltd.*, both the median time-to-trial and scheduled trial date "precede[d] the projected final written issuance date … by ***nine months***." IPR2024-01455, Paper 15 at 2 (PTAB May 16, 2025). In contrast, in this case both the time-to-trial statistics ***and*** the scheduled trial date reveal that trial (if the current date holds) would precede the expected FWD by only ***four months***. Moreover, Petitioner in those cases never demonstrated any evidence that the trial date is likely to be further delayed, as the Petitioner has shown here.

In sum, under factual circumstances most similar to those presented here, the Board has more often chosen institution over discretionary denial.

Fifth, Petitioner has moved to transfer the case to the District of New Jersey, which, if granted, will vacate the currently scheduled trial date. Petitioner submits that transfer from EDTX to DNJ is likely under controlling law because venue discovery has revealed, among other things, that: (1) Plaintiff indisputably has ***no connection*** to EDTX; (2) all of Defendant's relevant domestic operations

concerning the accused products[5] are centered at Defendant's U.S. headquarters in New Jersey; (3) the New Jersey community (in particular, the Newark vicinage where the case would be assigned) has the strongest local interest in the case because all of the relevant domestic decision-makers are based there; and (4) DNJ—but not EDTX—can compel relevant unwilling third parties to testify at trial. EX1031, 1, 4-5. *See Samsung Elecs. Co. v. Mullen Indus. LLC*, IPR2024-01472, Paper 9 at 9 (PTAB Mar. 31, 2025) (finding this factor neutral because of the likelihood of transfer despite the trial date set for 5-6 months before the earliest expected FWD date).

* * *

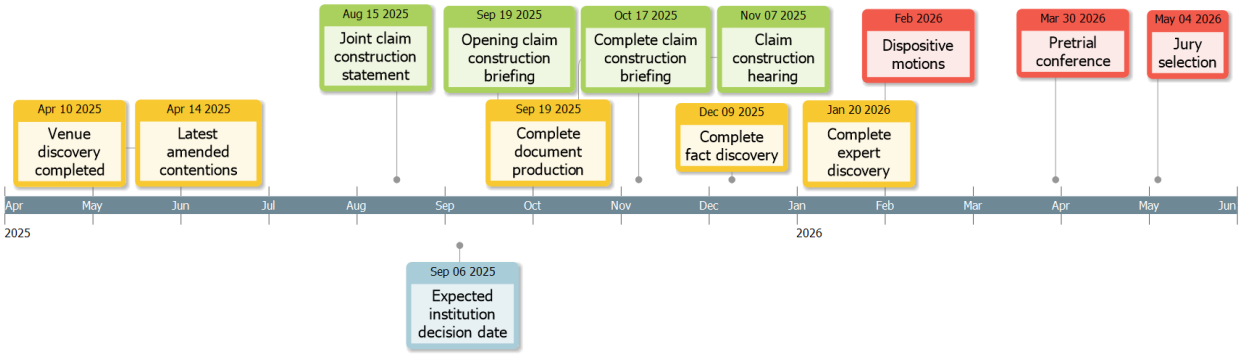
For the foregoing reasons, the Director should not accept Patent Owner's assertions regarding the currently scheduled trial date. On the contrary, the Director should consider the numerous real-world circumstances that make a postponed trial date more than likely. But even ignoring that reality, the Board's historic determinations in similar situations counsel against discretionary denial here. Thus,

[5] The underlying litigation involves only Samsung TVs and monitors for which Samsung's domestic operations are centralized at Samsung's New Jersey headquarters—as opposed to Samsung's Texas offices, which primarily handle Samsung's mobile products (*e.g.*, smartphones), unaccused here. *See* EX1031 at 1.

at worst, Factor 2 should be treated as neutral, and cannot overcome the multiple other factors favoring institution.

3. The Parallel Litigation Is Still In Its Infancy and *Every* Substantial Deadline Will Occur After The Expected Institution Decision Date.

Factor 3 favors institution because the co-pending litigation is in its early stages with respect to all substantive issues. Patent Owner primarily points to venue discovery and early document production disputes as purportedly showing that the Court has "invested substantial time and resources into the Litigation." DD Brief at 11-12. But in reality, every substantive Court deadline and activity will occur only ***after*** the expected institution decision date.



First, as illustrated in the timeline above, all of the most significant deadlines in the case will occur ***after*** the expected institution decision date. Opening *Markman* briefs are not due until September 19, 2025, and briefing will not finish until October 17, 2025—all after the institution deadline. EX1021. The *Markman* hearing is scheduled for November 7, 2025. *Id.* Fact Discovery does not close until December

9, 2025. *Id.* Opening expert reports are not due until December 9, 2025, and expert discovery does not close until January 20, 2026. *Id.* Dispositive motions will be briefed in January and February 2026, with all pre-trial deadlines (including pre-trial disclosures, motions *in limine*, and the pre-trial conference) following in February and March 2026. *Id.* Each of those events is far more significant than anything that has taken place to date, and each of those events will occur after the institution deadline. Because those significant events—related to ***substantive*** issues, including ***invalidity*** issues—will not occur until after the institution deadline, this factor favors institution. *See PEAG LLC v. Varta Microbattery GmbH*, IPR2020-01214, Paper 8 at 17 (PTAB Jan. 6, 2021) ("Although the parties in the District Court Action have completed some work, for example, served preliminary infringement and invalidity contentions, responded to each other's requests for documents and interrogatories, and exchanged proposed terms for claim construction, discovery is far from over and much remains to be completed in advance of trial… Thus, the evidence shows that the investment in the parallel proceeding related to the validity issue is minimal. This fact weighs in favor of not exercising discretion to deny institution.").

Second, the parties have performed only preliminary discovery, primarily directed to venue. No substantive depositions have been taken or scheduled. Patent Owner cites six depositions as evidence of the parties' investment in the case. DD Brief at 11. But each of those depositions was limited solely to venue. EX1030, 2

("Moreover, venue-related discovery shall be limited to issues related to Defendants' motion to transfer . . . ."). Patent Owner only recently served a 30(b)(6) notice in the parallel litigation, and no non-venue 30(b)(1) notices have been served by either party. Patent Owner also points to the fact that Petitioner has produced nearly 300,000 pages of documents. *Id.* Yet incongruously, Patent Owner just last month complained that Petitioner "has not promptly produced technical information on the 514 products currently in discovery," which shows that parties' discovery disputes are ongoing and far from over. *See*, *e.g.*, EX1040 (PO's Email dated May 20, 2025, stating that "Plaintiff expects that it will need to move [to amend its infringement contentions] at least once more (and likely several times more) after Samsung produces more information on those products").

The present stage of the litigation—in which the Patent Owner is still struggling to define the scope of the accused products and plans to amend its contentions "likely several times more"—stands in sharp contrast to *Motorola Sols., Inc. v. Stellar, LLC*, on which Patent Owner relies. In that case, the parties had finished exchanging expert reports and the court had issued its claim construction order before the patent owner filed its preliminary response. IPR2024-01205, Paper 19 at 3 (PTAB March 28, 2025) ("[B]y the time Patent Owner filed its Preliminary Response (Paper 8, 'POPR'), the parties had served extensive infringement and invalidity contentions, served opening and rebuttal expert reports, filed claim

construction briefs, and conducted several depositions. The court also had held a claim construction hearing and construed the disputed claim terms."). This case is not remotely similar to that situation; to the contrary, those litigation milestones have yet to occur.

Third, thus far the Court has only invested minimal resources into resolving certain procedural issues, and has not yet made ***any*** substantive determinations related to validity issues. Patent Owner makes much of commonplace procedural disputes related to the protective and discovery orders—which the Court resolved without full-scale briefing or rendering an opinion—as well as Petitioner's motions to dismiss and transfer venue, neither upon which the Court has ruled nor even set a hearing date. DD Brief at 10-13; EX2012; EX1025; EX1026; EX1041; EX1045; EX1046.

Patent Owner also refers to two discovery hearings as demonstrating the Court's purportedly substantial investment. DD Brief at 13. But at those hearings, the Magistrate Judge addressed Patent Owner's deficient infringement contentions on largely procedural grounds, determining that Patent Owner had failed to properly accuse over 1,200 products for which it failed to include a claim chart or provide a representative analysis as required by the local Patent Rules. EX1028. Thus, the Court's actual involvement has been minimal thus far.

Patent Owner also relies on a November 7, 2024 scheduling conference held by the Court. DD Brief at 13. But that scheduling conference was simply a "cattle call," regularly held by the Court to provide trial dates to dozens of cases at once. *Compare* EX1032 [Minute entry for November 7, 2024 conference] *with* EX1033 [Lex Machina search for identical minute entry] (showing 31 cases with identical minute entry for November 7, 2024 conference).

Fourth, although Patent Owner argues that "twenty third-party subpoenas have been issued," DD Brief at 3, those third parties have thus far produced only preliminary documents. All but one of those third-party subpoenas were served by Petitioner, demonstrating Patent Owner's minimal investment in third-party discovery.[6] And no third-party depositions have yet been scheduled or taken.

Finally, Patent Owner refers to the parties' initial claim construction exchanges as a "substantial investment" the Court will undertake before the institution decision. DD Brief at 13-14. But those exchanges do not demonstrate ***any*** Court investment because: (1) the Court does not even receive the parties' exchange of disputed terms and constructions (they are only exchanged between the

[6] With respect to the sole third-party subpoena Patent Owner served, no documents have been (or will be) produced. *See, e.g.*, EX1037 [Molex, LLC response, Feb. 17, 2025].

parties); and (2) there is no evidence (nor reasonable expectation) that the Court will review the joint claim construction statement when it is filed on August 15, 2025, rather than much closer to the November 7, 2025 *Markman* hearing. In fact, the Court's claim construction investments will undoubtedly occur only ***after*** the parties complete *Markman* briefing (on October 17, 2025) and provide the Court with their technology tutorials—both of which will occur ***after*** the institution decision date. EX1021.

In sum, all major events in the parallel litigation have yet to occur, including: all non-venue fact depositions, claim construction briefing and the *Markman* hearing, expert discovery, and dispositive motions. As of the anticipated institution decision (September 6, 2025), not even the opening claim construction brief will have been filed (due September 19, 2025), the *Markman* hearing will not take place for another 2 months (November 7, 2025), and fact discovery will not close for another 3 months (December 9, 2025). EX1021 at 3 [Docket Control Order]. And no expert reports will have been served. *Id.* Accordingly, Factor 3 favors institution because the parallel District Court litigation is still only in its early stages.

4. Upon Institution, Petitioner's Stipulation Will Remove All Potential Overlapping Issues With The Parallel Litigation.

Factor 4 strongly favors institution because Petitioner timely filed a stipulation above and beyond the typical *Sotera* stipulation, thereby removing all potential overlapping issues with the parallel litigation.

As an initial matter, contrary to Patent Owner's argument that the "stipulation should be considered untimely because it was filed over one month after the accorded filing date" (DD Brief at 18, n.8), Petitioner timely filed the stipulation. On March 19, 2025—less than two weeks from the accorded filing date of March 6, 2025—Petitioner asked the Board for permission to submit a stipulation. Moreover, when the new stipulation-submission timing expectations by the Board were announced at the PTAB Boardside Chat on April 17, 2025, Petitioner acted expediently and diligently to renew that earlier pending request *on the very same day* (EX 2011).[7]

[7] *Cf. NXP USA, Inc. v. Impinj, Inc.*, IPR2021-01556, Paper 13 at 4 (PTAB Sept. 7, 2022) (De-designated: April 25, 2025) ("the only appropriate time for a petitioner to offer a stipulation related to the Fintiv factor 4 analysis is prior to the Board's decision of whether to institute review."); *BMW of North America, LLC v. NorthStar Systems LLC*, IPR2023-01017, Paper 12 at 10 (PTAB Dec. 8, 2023) ("Patent Owner

After receiving authorization, on April 21, 2025, Petitioner provided a stipulation that goes well beyond a typical *Sotera* stipulation. As a starting point, Petitioner's stipulation provided the typical *Sotera* protections, specifying that Petitioner will not pursue "the specific grounds [asserted in IPR2025-00335], or … any other ground … that was raised or could have been reasonably raised in an IPR (i.e., any ground that could be raised under §§ 102 or 103 on the basis of prior art patent or printed publications)." EX1022. But Petitioner went further: Petitioner's stipulation also stated that "if the PTAB institutes *inter partes* review, Petitioner will not, in the Litigation, rely on ***any product or system art that is 'based on the same evidence presented' in this IPR***. *Cf. SAP America, Inc. v. Cyandia, Inc.,* IPR2024-01496, Paper 13 at 9 (PTAB Apr. 7, 2025)." EX1022. Thus, the protections afforded by Petitioner's stipulation here exceed the classic *Sotera* stipulation provisions found insufficient by the Board in *SAP*, and ensure that product or system art "based on the same evidence" to those used in the IPR will not be relied upon in the underlying litigation. Notably, Petitioner's stipulation is broader than what the Federal Circuit recently found permissible in *Ingenico Inc. v. IOENGINE, LLC*. 136 F.4th 1354,

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has not brought to our attention any binding precedent that establishes a time limit by which a Sotera stipulation must be submitted before we enter our decision on institution, and we are not aware of any such precedent.").

1366 (Fed. Cir. 2025) (holding that Congress did not "preclude a petitioner from relying on the same patents and printed publications ***as evidence*** in asserting a ground that could not be raised during the IPR, such as that the claimed invention was known or used by others, on sale, or in public use."). Indeed, in that case the Federal Circuit authorized defendant/petitioner Ingenico to "rely[] on the DiskOnKey System with related printed publications at trial to prove the claimed invention was known or used by others, on sale, or in public use." *Id*. at 1367. Here, however, Petitioner's stipulation ensures that the IPR will serve as a true alternative to the parallel litigation if the Board institutes review. No product or system art will be introduced at trial that is "***based on the same evidence***" presented in this IPR. Accordingly, this factor strongly favors institution.

Patent Owner nonetheless argues that "this IPR proceeding would not be a 'true alternative' to the district proceeding," (DD Brief at 16), and raises two arguments in support of its position. Neither argument has merit.

i. There Is No Substantial Overlap And The IPR Even Addresses A Claim Not At Issue In Litigation.

Patent Owner argues that "the same art and arguments are at issue in the Litigation." DD Brief at 16. Not so. Although Petitioner's District Court invalidity contentions included the paper art (*Hong, Lee*) and the Applicant Admitted Prior Art relied on in the Petition, Petitioner did so only to preserve them in the event of denial

of institution. In other words, if the Board institutes the IPR proceeding, there will be no overlap between the grounds that ***were actually*** raised. Moreover, the classic *Sotera*-type stipulation (included in Petitioner's stipulation here) ensures that there will be no overlap between grounds that ***could have been*** raised in the Petition and the parallel litigation with respect to the paper art.

In addition, Patent Owner admits that the Petition challenges one additional dependent claim—claim 2—that is not at issue in the parallel litigation. DD Brief at 16. Although Patent Owner argues that this is a "hollow" distinction, and that any alleged similarity between the additional challenged claims and those in the litigation somehow favors discretionary denial, Patent Owner is incorrect on both counts. DD Brief at 17. Instead, as the Board has previously explained, the inclusion of additional claims that are not being litigated in district court favors institution, particularly when paired with a strong stipulation. *Zynga Inc. v. IGT*, IPR2022-00368, Paper 7 at 13–14 (PTAB Jul. 8, 2022) ("Given Petitioner's stipulation and the fact that more claims are challenged in this proceeding than in the district court litigation, we weigh this factor against exercising discretion to deny institution.").

ii. IPR Will Be A True Alternative To The Litigation.

Patent Owner's reliance on *Motorola Sols.* to argue that an IPR would not be a "true alternative" (and that Factor 4 favors denial) is misguided. Patent Owner argues that Petitioner's stipulation is "toothless" because "Samsung does not point

to any of the references asserted in the Petition as evidence for its product and system-based invalidity contentions in the Litigation." DD Brief at 20. In other words, Patent Owner complains that ***all*** product/system art must be stipulated away to provide a true alternative to litigation. But that argument was squarely rejected by the Federal Circuit. In *Ingenico Inc. v. IOENGINE, LLC*, the Federal Circuit explained that "Congress intentionally limited an IPR's scope to invalidity challenges based on 'prior art consisting of patents or printed publications… By design, a petitioner has no opportunity to challenge that the claimed invention was known or used by others, on sale, or in public use at an IPR.'" *Ingenico*, 36 F.4th at 1365. Hence, the Federal Circuit blessed even "relying on the same patents and printed publications as evidence in asserting a ground that could not be raised during the IPR, such as that the claimed invention was known or used by others, on sale, or in public use." *Id*. at 1366. Notwithstanding that Federal Circuit imprimatur, Petitioner's stipulation here provides even more protection against duplication, forgoing art that is "'based on the same evidence presented' in this IPR" (EX1022) ensuring that system art in the Litigation will be necessarily different, and will serve as a true alternative to the instant IPR proceeding.

Finally, in *Motorola Sols.*, although the Director determined that the petitioner's stipulation did not outweigh other factors and discretionarily denied the petition, the Director nonetheless confirmed that the petitioner's even more limited

Sotera-type stipulation "mitigate[d] some concern of duplication. under Factor 4. IPR2024-01205, Paper 19 at 4. Petitioner's stipulation provides even more protection against concern of duplication.

Accordingly, Factor 4 strongly favors institution in this case. Petitioner has gone beyond the requirements that the Board has found favors institution by agreeing to avoid relying on (1) "any ground that was raised or could have been reasonably raised" in the IPR ***and*** (2) "***any product or system art that is 'based on the same evidence presented' in this IPR***." EX1022. And the Petition challenges one additional claim not being asserted in the Litigation.

5. Defendants In The Parallel Litigation Are Unremarkably The Same As Petitioner.

Factor 5 slightly favors denial but should be afforded little to no weight. Patent Owner notes that "Petitioner and Patent Owner agree that 'Petitioner is the defendant in the litigation.'"[8] DD Brief at 21. Patent Owner then argues that "this factor weighs in favor of denying institution." *Id.* However, when the Petitioner is

[8] For avoidance of doubt, Petitioner clarifies that the parallel litigation originally named Samsung Display Co. Ltd. ("SDC") as a co-defendant. EX1027. The Court granted a joint stipulation of dismissal and dismissed SDC from the case (without prejudice), leaving only Petitioner. EX1042.

the same as the named defendants in the litigation, the Board has found that this factor adds "little if anything to the discretionary denial analysis." *See Aylo Freesites Ltd. f/k/a MG Freesites Ltd. v. WellcomeMat, LLC*, IPR2024-00710, Paper 13 at 17-18 (PTAB Sep. 05, 2024) ("We make the unremarkable observation that an IPR petitioner and patent owner are very often named parties in parallel district court litigation regarding the same patent. In our view, this factor adds little if anything to the discretionary denial analysis unless the petitioner is not named as a defendant (or declaratory judgment plaintiff) in parallel district court patent litigation.").

6. Other Circumstances, Particularly The Compelling Merits, Strongly Favor Institution.

Factor 6 strongly favors institution. The Memo noted that "the parties are permitted to address all relevant considerations." Memo at 2. Among the considerations explicitly listed in the Memo, at least the following additional circumstances are critically relevant to this factor: (1) the strength of the unpatentability challenge; (2) the extent of the petition's reliance on expert testimony; and (3) settled expectations of the parties, such as the length of time the claims have been in force. Patent Owner also argues that the expiration date of the patent should be considered. DD Brief at 27. Collectively, those considerations strongly favor institution.

i. The Petition Was Diligently Prepared And Filed.

The Petition was expeditiously and diligently prepared and filed as soon as possible—less than three months after receiving Plaintiff's initial infringement contentions in the underlying litigation. In particular, Patent Owner filed its complaint in the Eastern District of Texas on July 17, 2024. Patent Owner did not serve its initial infringement contentions until October 24, 2024, which was the first time Patent Owner identified the full set of claims it intends to assert. Petitioner filed the instant IPR less than three months later, on January 6, 2025. The Board has found that similar timeframes showed diligence and found that Factor 3 favored institution. *See Samsung Elecs. Co. v. Mullen Indus. LLC*, IPR2024-01472, Paper 9 at 10 (finding Factor 3 favors institution due to "Petitioner's diligence in filing its Petition (a) less than five months after receiving Patent Owner's infringement contentions and (b) prior to the parties briefing claim construction issues").

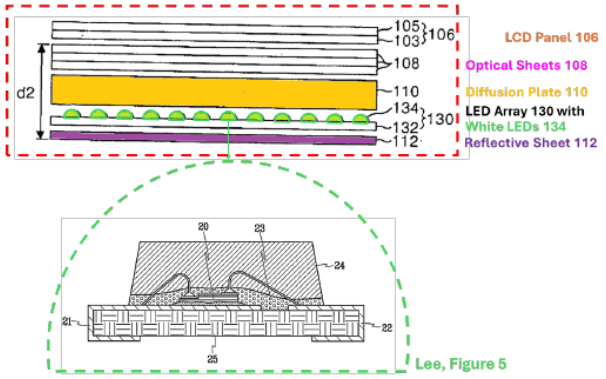
Critically, all of these events occurred before former Director Vidal's 2022 Memorandum was rescinded on February 28, 2025, altering the landscape and past practice with respect to IPR submission and institution decisions. Shortly after Notice of Filing Date Accorded (NOFDA) was issued on March 6, 2025, Petitioner sought authorization to submit a *Sotera* stipulation on March 19, 2025. Then, Petitioner renewed that request on April 17, 2025—the very same day the PTAB

Boardside Chat clarified that a *Sotera* stipulation should be filed within one month of the Notice of Filing Date Accorded," (EX2011).

In sum, given that Petitioner acted diligently and timely to prepare and file the IPR petitions and respond to the changed circumstances, institution is appropriate.

ii. The Petition Presents A Compelling Challenge To Patentability.

The Petition demonstrates that the cited prior art discloses each and every element of the challenged claims. Even a cursory comparison between the challenged claims of the '952 Patent and the leading combination—Hong in combination with Lee—shows that the Petition presents a compelling case of unpatentability:

'952 Patent	Hong+Lee
1. A backlight panel, comprising: a **diffusion plate** comprising a top surface and a bottom surface; a **plurality of white light emitting diodes** arranged below the bottom surface of the **diffusion plate**, the **white light emitting diodes** to emit light directly onto the bottom surface of the **diffusion plate**; a **reflection sheet** arranged below light exit surfaces of the **white light emitting diodes**, **the reflection sheet** to reflect light toward the **diffusion plate**, wherein each **white light emitting diode** comprises a blue light emitting diode chip and a red phosphor and a green phosphor arranged on the blue light emitting diode chip.	**Hong In Combination With Lee** Hong, Figure 6 

Faced with that strong showing of unpatentability, Patent Owner argues primarily that "Petitioner improperly uses the claims of the '952 Patent as a roadmap

for its obviousness combination" and that Petitioner "relies on applicant admitted prior art (or 'AAPA')." DD Brief at 22-24. Neither has any merit.

Patent Owner's Merits Arguments Are Weak and Easily Rebutted. The Petition presents two focused grounds against four claims based on obviousness. *See* Pet. at 4-5; 15-51. Patent Owner contends that "Petitioner's failure to identify any anticipatory art serves as an initial indication of the weakness of the Petition's merits." DD Brief at 22-23. Not so. The Board routinely cancels claims based on obviousness—especially when the evidence of obviousness is particularly strong, as is the case here.

Ground I: Ground I shows that all challenged claims are obvious over Hong and Lee. Patent Owner's primary criticism against Ground I—that "Petitioner improperly uses the claims of the '952 Patent as a roadmap for its obviousness combination," (DD Brief at 23)—misses the mark because the Petition clearly demonstrates that Hong and Lee themselves provide the motivation for the combination. For example, the Petition explains:

- "Hong explains that each LED in the backlight unit 'emits white light' (EX1003, [0054]), but it does not specifically disclose how such white LED is implemented. Accordingly, a POSITA would have been motivated to look for teachings of white LEDs for backlight panels, and would have understood that Lee teaches

white LEDs that would be readily incorporated into Hong's backlight unit for an LCD display." Pet. at 21-22.

- "Lee specifically motivates using Lee's white LEDs in Hong's backlight unit" because "Lee [] explains that its inventive white LED—made using a blue LED and overlying green and red phosphors—'is more appropriate for the backlight of a LCD' than the alternative designs." Pet. at 22.

In other words, it is the teachings of the combined references themselves that motivates the combination.

Patent Owner also argues that "a POSITA would have been motivated to use [the widely available prior art LEDs described in Lee] because of the ease of implementation associated with using a currently widely available LED instead of having to endure the difficulty of fabricating an entirely new kind of LED according to Lee's purported invention." DD Brief at 24. Patent Owner appears to argue that the proposed combination of Hong and Lee (using Lee's inventive LEDs in Hong's backlight unit) would not have been obvious because a POSITA might have used other combinations (using other prior art LEDs (described in Lee) in Hong's backlight unit, rather than the improved white LEDs advanced in Lee).

Patent Owner's argument is flawed for three reasons. ***First***, as of the priority date of the '952 Patent, all LEDs described in Lee—including Lee's inventive white LEDs—were known in the prior art. Patent Owner presents no evidence—or even argument—as to why the purportedly "new kind of LED according to Lee's

purported invention" would not have been just as well known as those "widely available LED" described as prior art in Lee. *See* DD Brief at 24; *see also EWP Corp. v. Reliance Uniiv. Inc.,* 755 F.2d 898, 907 (Fed. 1985) ("A reference must be considered for everything it teaches by way of technology…").

Second, even if it were obvious to combine Hong with other prior art LEDs described in Lee, as Patent Owner suggests, that does not undermine the proposed combination. Mere "availability of alternatives does not negate an otherwise-supported motivation to combine reference teachings." *Roku, Inc. v. Universal Electronics Inc.*, IPR2019-01614, Paper 31, at 70 (PTAB August 18, 2023) (citing to *In re Mouttet*, 686 F.3d 1322, 1334 (Fed. Cir. 2012)); *see also Elekta Ltd. v. ZAP Surgical Sys., Inc*., 81 F.4th 1368, 1374 (Fed. Cir. 2023) ("Nor does an obviousness showing 'require that a particular combination must be the preferred, or the most desirable, combination described in the prior art in order to provide motivation for the current invention.'") (quoting *Novartis Pharms. Corp. v. West-Ward Pharms. Int'l Ltd*., 923 F.3d 1051, 1059 (Fed. Cir. 2019)).

Third, a POSITA would have had no reason to choose prior art LEDs described in Lee over Lee's inventive LED, as Patent Owner suggests, because Lee expressly teaches that those prior art LEDs suffer from performance issues that are addressed by Lee's inventive LED. *See, e.g.,* EX1004, 2:5-7 ("However, the phosphor material used for the white LED using the blue LED having the frequency

range of 450-470 nm is limited to YAG:Ce, ***which has a color purity problem***."); EX1004, 2:8-12 ("In order to make a white light semiconductor light emitting device using the red, green, and blue LEDs, a variety of substrates such as GaAS, ALGalnP, lnGaN, and GaN should be separately prepared, utilizing different semiconductor layers. ***This causes the manufacturing costs to be increased, while complicating the manufacturing process***."). *See also* Pet. at 22-23 (explaining that a POSITA would have been motivated to use Lee's inventive LED over prior art LEDs described in Lee).

Accordingly, Ground I presents a compelling case that all challenged claims would have been obvious over Hong and Lee.

Ground II: Ground II builds on Ground I and demonstrates that challenged ***dependent*** claims 2, 4, and 5 would have been obvious over the references used in Ground I in view of Applicant Admitted Prior Art (AAPA). Patent Owner contends that "the Petition fails because it relies on applicant admitted prior art (or 'AAPA') as part of its basis for a ground." DD Brief at 24 (citing *Qualcomm Inc. v. Apple Inc.*, Nos. 2023-1208, 2023-1209, 2025 U.S. App. LEXIS 9614, at *21 (Fed. Cir. Apr. 23, 2025) ("*Qualcomm II*")).

Patent Owner's argument is untenable for two reasons. ***First***, Ground II addresses dependent claims 2, 4, and 5—claims already challenged in Ground I. Pet. at 4-5. So even if Ground II were no longer viable in view of the recent *Qualcomm*

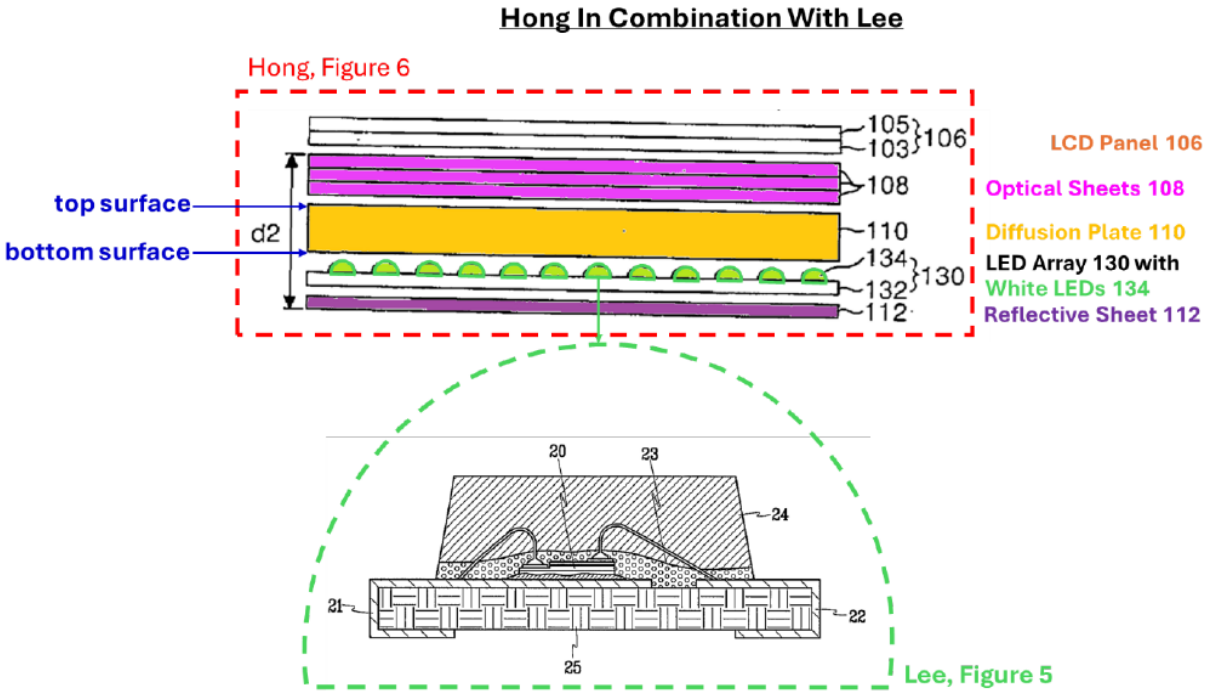
II decision (a conclusion Petitioner disputes, for the reasons explained below), the Petition remains sound because Ground I alone invalidates all challenged claims. *Bos. Sci. Scimed, Inc. v. Cook Grp. Inc.*, 809 F. App'x 984, 990 (Fed. Cir. 2020) (finding that "the Board need not address issues that are not necessary to the resolution of the proceeding" and agreeing that "[t]he Board has the discretion to decline to decide additional instituted grounds once the petitioner has prevailed on all its challenged claims").

Second, *Qualcomm II* does not foreclose Ground II because AAPA is not being used "as the basis, or part of the basis, of" Ground II. In *Qualcomm II*, the petitioner (Apple) filed an IPR petition stating that the "***Basis***" for an invalidity ground was "Applicants [sic] Admitted Prior Art (AAPA) in view of Majcherczak." *Qualcomm II*, 134 F.4th at 1359. The Federal Circuit took the petitioner's contention at face value, holding that "[i]t was [] error for the Board to determine that, despite [] express statements [that AAPA is included in the 'Basis' of Ground 2], the use of AAPA in Ground 2 complied with § 311(b)." *Qualcomm II*, 134 F.4th at 1368.

Here, unlike *Qualcomm II*, Ground II does not advance AAPA as its "***basis*** or part of the ***basis***." Rather, Ground II merely "***relies on***" AAPA for the narrow teaching that is "simple and … particularly straightforward." *Arendi S.A.R.LApple Inc*., 832 F.3d 1355, 1362-63 (Fed. Cir. 2016). Indeed, *Qualcomm II* expressly held that "there are instances in which a ***petition may rely in part on AAPA***, such as to

indicate the general knowledge of a person of ordinary skill in the art, without contravening § 311(b)." *Qualcomm II*, 134 F.4th at 1365; *see also Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330, 1339 (Fed. Cir. 2020) (in an inter partes review, "it is appropriate to rely on admissions in a patent's specification when assessing whether that patent's claims would have been obvious"). That is precisely how Ground II uses AAPA.

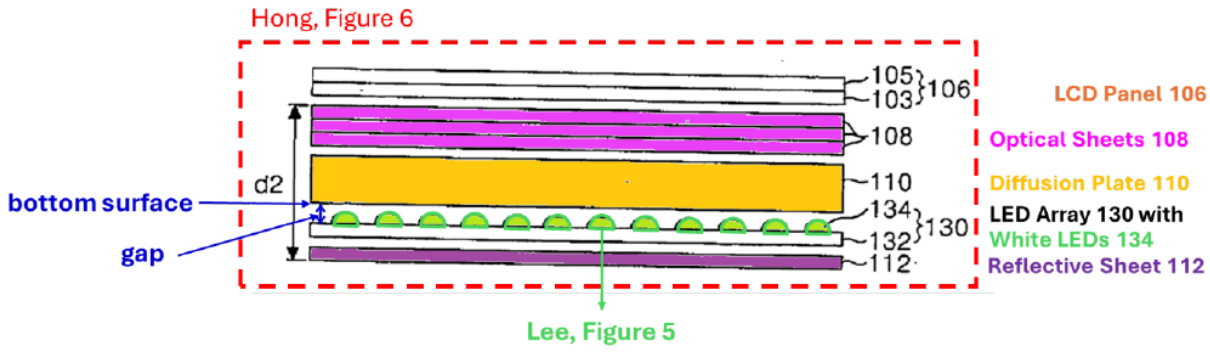
For instance, in Ground I, which presents a combination of Hong and Lee, the Petition explains with respect to claim 2 that "[t]he at least one optical sheet 108 is 'arranged on the top surface of the diffusion plate,' as shown" in the below figure. Pet. at 37.



Pet. at 38.

In Ground II, the Petition explains that "[t]o the extent Hong/Lee is found not to teach the optical sheets 108 'arranged on' the top surface of the diffusion plate because the optical sheets 108 do not physically touch the top surface of the diffusion plate, it would have been obvious to arrange Hong/Lee's optical sheets to touch the top surface of the diffusion plate as taught by AAPA." Pet. at 45. The Petition simply relies on AAPA to establish the "simple" and "straightforward" knowledge that a gap need not be present between the optical sheets 108 and the diffusion plate. *See* EX1002, ¶¶128-130.

As another example, in Ground I, the Petition explains with respect to claim 4 that "a POSITA would have understood that the 'gap between the diffusion plate 110 and the LED array 130' is an ***air*** gap." Pet. at 40. And in Ground II, the Petition states that "[t]o the extent Hong/Lee is found not to teach an '***air gap***,' that would have been obvious in view of Hong/Lee and AAPA." Pet. at 47. Once again, the reliance on AAPA is for knowledge that is "unusually simple and … particularly straightforward." *Arendi*, 832 F.3d at 1363. *See also* EX1002, ¶¶132-140.



Pet. at 40.

Critically, Patent Owner offers "no evidence to rebut the conclusion that a skilled artisan would have known" about adjusting the position of the optical sheets relative to the diffusion plate, or forming the gap between the diffusion plate and white LEDs using air. *Koninklijke Philips*, 948 F.3d at 1338-39.

Accordingly, *Qualcomm II* is inapposite here and does not foreclose the strong showing of invalidity presented in Ground II.

iii. The Petition Provides Expert Testimony In Precisely The Way That An Obviousness Analysis Requires.

Patent Owner's argument that Dr. Kymissis's "declaration provides anything but focused testimony" and "relies heavily on Petitioner having its expert fill in gaps in the asserted prior art references" is simply untrue. DD Brief at 26. Rather, as discussed further below, Dr. Kymissis's opinions are thoroughly reasoned, supported by evidence, and consistent with the role of expert analysis in obviousness determinations before the Board.

Patent Owner mischaracterizes Dr. Kymissis's testimony as conclusory and asserts that it is improperly used to "fill in gaps" in the prior art. DD Brief at 26. To the contrary, Dr. Kymissis's opinions are well-supported. He offers detailed reasoning—grounded in the disclosures of the asserted references—and explains

precisely how and why a person of ordinary skill in the art (POSITA) would have been motivated to combine them. *See generally* EX1002.

Far from relying on generic assertions, Dr. Kymissis walks through the prior art references with specificity, highlighting how each teaches particular aspects of the claims. EX1002, ¶¶59-79. He identifies relevant figures and explains the design principles for backlight panels as color purity and weight. *See, e.g.,* EX1002, ¶¶ 60-62, 73-77, 120-122, 134-138. Dr. Kymissis places these teachings in historical and technical context, drawing on both the references and the '952 Patent's own admissions about backlight panels. EX1002, ¶¶ 35-39 (citing EX1001, 1:12-2:31).

The phrase "a POSITA would have…" used in the Petition does not render it improper. DD Brief at 26. That is an articulation of what the law requires in terms of rationale for finding obviousness, which should be and is supported by detailed references to the prior art and technical explanations. It is precisely the expert's role to explain how and why a POSITA would have understood, combined, and/or modified the prior art to arrive at the claims in a way that is grounded in the disclosures rather than hindsight. Dr. Kymissis's declaration does just that—it provides context, technical insight, and evidentiary support.

Accordingly, this is not a case where the Petitioner attempts to mask deficiencies in the prior art with conclusory expert opinion. Dr. Kymissis used technical knowledge and factual analysis (again, grounded in the explicit teaching

of the references themselves) to explain what the references themselves teach and why a POSITA would have combined them with a reasonable expectation of success. *See Unified Patents LLC, v. Togail Techs., Ltd.*, IPR2023-00338, Paper 7, at 11 (PTAB Aug. 18, 2023) (giving weight to expert's declaration where it was supported by factual determinations.).

iv. Patent Owner's Purported "Expectation" Of Validity Does Not Impact The Analysis.

Patent Owner argues that it has "well-settled expectations regarding the presumed validity and enforceability of the '952 Patent" because it has "been in force for over 13 years, and the owners of the patent have paid three maintenance fees." DD Brief at 26. The amount of time that has elapsed since the '952 Patent's issuance is not nearly as germane to "settled expectations" as the fact that the patent's validity has never been challenged in IPR.

Patent Owner cannot credibly argue that it has "well-settled expectations" of validity where (1) the patent has never been challenged in any post-grant proceedings (2) has not been asserted previously and (3) is now seeking damages against one of the world's most innovative consumer technology providers. EX1035, 39.

The only prior cases where the prior assignee of the '952 patent, Seoul Semiconductor Co., Ltd. ("SSC"), asserted it in litigation settled long before any

meaningful challenges—let alone resolutions on the merits—to the validity of the patent. Both cases settled before expert discovery or the resolution of any dispositive motions.[9] Indeed, in one case the defendant asserted an affirmative defense of invalidity in its answer, which should indicate to Patent Owner that parties targeted with infringement suits are likely to challenge the patent's validity.[10]

After purchasing the patent from Seoul Semiconductor Co., Ltd. ("SSC") two years ago, Patent Owner filed suit against Petitioner. EX1035, 1; EX1036. In its initial infringement contentions—deemed deficient by the District Court for their unjustified breadth and lack of technical analysis—Patent Owner accused over 1,200 Samsung products in conclusory fashion. EX1029 [Appendix A to 2024-10-24

[9] *Seoul Semiconductor Co. Ltd. v Fry's Elecs., Inc.*, 2:18-cv-00386-JRG, D.I. 38 (E.D. Tex. Mar. 27, 2019) at 3 (setting Oct. 15, 2019 deadline to serve expert disclosures and Nov. 25, 2019 deadline to file dispositive motions) and D.I. 48 (Oct. 7, 2019) (entry of stipulated consent judgment); *Seoul Semiconductor Co. Ltd. v. The Factory Depot Advantages, Inc.*, 2:19-cv-05065-GW-AS, D.I. 42 (C.D. Cal. July 28, 2020) at 2 (setting Sept. 8, 2020 deadline to serve opening expert reports and Nov. 23, 2020 deadline to hear motions) and D.I. 44 (Aug. 24, 2020) (entry of stipulated consent judgment).

[10] *Fry's*, D.I. 14 at 10-11.

Infringement Contentions]. Denying or disfavoring institution based on Patent Owner's purported expectation would set a perverse incentive for non-practicing entities like Patent Owner to purchase patents that have been lying dormant for years, and then sue companies on broad swaths of products under the cover of artificially manufactured "well-settled expectations." DD Brief at 26. Allowing this behavior would be especially unjustified in this case, considering that Patent Owner and its counsel should have been well aware that Petitioner would file an IPR against the '952 Patent. Under appropriate circumstances, such as those here, where the art manifestly demonstrates unpatentability, Petitioner routinely files IPRs against non-practicing entities' patents, including parties that were represented by Mr. Robert Katz (Patent Owner's sole principal). *Samsung Elecs. Co. et al. v. Lexington Luminance LLC*, IPR2017-00539, -00540, Paper 5 at 3. Mr. Katz—who signed the assignment recordation papers for the '952 Patent (EX1036) and sued Samsung at least twice (as counsel of record) (EX1039)—was identified in Patent Owner's initial disclosures as the single purportedly affiliated witness of the Patent Owner. EX1038, 3. The settled expectation of the Patent Owner should have been that IPR challenges would be forthcoming upon service of the infringement contentions.

v. Expiration Date Of The Patent

Patent Owner argues that because "the '952 Patent will expire … before the Board is likely to issue a final written decision," "it makes no sense for the Board to

undertake review." DD Brief at 27. Patent Owner provides no authority to support its arguments, and indeed, authority goes the other way. The Federal Circuit already addressed this issue in *Apple, Inc., v. Gesture Tech. Partners, LLC.* As the Federal Circuit explained, "although a patentee has fewer rights … when [its] patent has expired, … it nevertheless maintains some rights, such as bringing an action for past damages… The existence of those rights creates a live case or controversy, which can be adjudicated by an IPR." 127 F.4th 364, 369 (Fed. Cir. 2025). There is no justifiable reason why adjudication of validity at the District Court (May 4, 2026) a mere two months ***after*** the approximate expiration date of the '952 Patent (March 2026) warrants discretionary denial, even if the FWD is expected (September 6, 2026) about six months after the expiration date of the '952 Patent.

vi. The Patent Office Has Not Been Presented With Substantially The Same Art/Arguments.

Patent Owner argues that "the USPTO already considered a voluminous amount of prior art in the field of backlighting panels during examination." DD Brief at 27 (arguing "the examiner verif[ied] he considered over 80 prior art references"). But such superficial reference to a purportedly "voluminous amount of prior art" is irrelevant, particularly when Patent Owner does not even contend that Hong and Lee are cumulative over any of the references considered or cited during prosecution. *LG Elecs. Inc. v. Pantech Corp.*, IPR2023-01273, Paper 26 at 15

(PTAB Apr. 9, 2024) ("[A]lthough Patent Owner makes a high-level argument about the teachings of [the prior art references] ... Patent Owner does not provide a detailed analysis comparing the teachings to show that they are substantially the same. … We decline to perform the analysis that is missing from the Preliminary Response.").

* * * * *

Assessing all of these factors and considering them as a whole, Petitioner submits that the Director should not exercise her discretion to deny institution under § 314(a).

III. CONCLUSION

Petitioner respectfully requests that the Director institute *inter partes* review, hold the challenged claims unpatentable, and cancel the challenged claims.

Dated: June 6, 2025

Respectfully submitted,

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CERTIFICATION UNDER 37 C.F.R. § 42.24(d)

I hereby certify that this Petitioner's Discretionary Denial Opposition Brief for *Inter Partes* Review of U.S. Patent No. 8,132,952 has, excluding the portions exempted under 37 C.F.R. § 42.24(a), 10,953 words as counted by the word-processing system used to prepare this document, in compliance with 37 C.F.R. § 42.24(d).

Dated: June 6, 2025

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CERTIFICATE OF SERVICE

Under 37 C.F.R. §§ 42.6(e) and 42.105, the undersigned certifies that on June 6, 2025, complete copies of the foregoing and any accompanying exhibits were caused to be served to the following email addresses for Patent Owner:

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