

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BOE TECHNOLOGY GROUP CO., LTD.,
Petitioner,

v.

PANELTOUCH TECHNOLOGIES LLC,
Patent Owner.

Case No. IPR2025-01245
U.S. Patent No. 9,250,758

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

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LISTING OF PETITIONER'S EXHIBITS

Exhibit	Description
1001	U.S. Patent No. 9,250,758 (the "'758 patent")
1002	Prosecution History of U.S. Patent No. 9,250,758
1003	Declaration of Dr. Vivek Subramanian
1004	U.S. Patent Publication No. 2008/0303798 A1 ("Nakamura")
1005	U.S. Patent Publication No. 2008/0246741 A1 ("Hinata '741")
1006	Prosecution History of U.S. Patent No. 9,639,229 (excerpted)
1007	JP-A-2002-342014 to Takaya ("Takaya")
1008	Prosecution History of U.S. Patent No. 8,803,836 (excerpted)
1009	U.S. Patent Publication No. 2009/0096763 A1 ("Hinata '763")
1010	3/22/2024 Assignment of '758 Patent to Paneltouch
1011	District Court Complaint
1012	Waiver of Service

I. INTRODUCTION

This *inter partes* review should be instituted because Patent Owner Paneltouch Technologies LLC (“Paneltouch” or “Patent Owner”) seeks to take advantage of patent owner misconduct and PTO error during prosecution of the challenged patent, U.S. Patent No. 9,250,758 (“the ’758 Patent”).¹ Absent the error and misconduct, this patent would never have issued, which is objectively demonstrated by the PTO’s handling of the child of the ’758 Patent.

Paneltouch does not dispute BOE Technology Group Co., Ltd.’s (“BOE’s” or “Petitioner’s”) extensive showing of invalidity over *the inventors’ own prior art*, Nakamura. *See, e.g.*, Petition, 9-17, 31, 33, 35-39, 41, 43, 46, 48, 50, 53-54 (showing the ’758 Patent claims’ repeated express copying of Nakamura). Indeed, the ’758 Patent expressly admits that the “applicants of the present application” disclosed a touch panel with the claimed “new detection structure” in Nakamura. Ex. 1001, 2:57-59; *see also* 4:53-60, 6:39-48 (“adopt[ing]” Nakamura’s touch panel).

¹ Petitioner also currently challenges U.S. Patent No. 8,803,836 (“the ’836 Patent”), which is the continuation parent of the ’758 Patent, in co-pending IPR2025-01246. The content of the present brief is largely the same as that of the simultaneously filed IPR2025-01246 brief.

Paneltouch also does not dispute that the applicant did *not* disclose Nakamura to the examiner during prosecution, and that the '758 Patent would not have issued but for the applicant's failure to disclose Nakamura (and the examiner's error in not independently applying Nakamura), the '758 Patent would not have issued.

All other considerations relating to the *Fintiv* factors weigh against discretionary denial here. For example, Paneltouch admits that the corresponding district court litigation has only just begun, that no scheduling order has issued, and that none of the parties or the Court have invested any resources into the case.

In view of these circumstances (as discussed in detail below), discretionary denial is not appropriate here. BOE's Petition should be referred to the Board.

II. BACKGROUND

A. Misconduct and PTO Error During Prosecution of the '758 Patent and its Assignment to Paneltouch Only Last Year

The '758 Patent was prosecuted in the United States as Application No. 14/451,769, which was filed on August 5, 2014, and issued on February 2, 2016. Ex. 1001. Despite the fact that Nakamura admittedly discloses the touch panel structure claimed in the '758 Patent, the applicant did not disclose Nakamura in an IDS during prosecution, and the examiner failed to find or apply it. *See* Ex. 1002.

The '758 Patent was originally assigned to Japan Display Inc. and Panasonic

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Liquid Crystal Display Co., Ltd. Following prosecution, neither of these entities sued anyone for allegedly infringing the '758 Patent. Paneltouch did not acquire the '758 Patent until 2024. *See* Ex. 1010 (3/22/2024 Assignment to Paneltouch).

B. The Co-Pending Litigation

Following its acquisition of the '758 Patent last year, Paneltouch filed suit in the Eastern District of Texas this year. *See generally* Ex. 1011 (District Court Complaint). The complaint asserts five patents. *Id.* Despite having no obligation to do so, BOE relieved Paneltouch of the burdens of service and submitted a waiver of service on July 24, 2025. Ex. 1012 (Waiver of Service).

Apart from this waiver of service, there has been no activity in the Texas case. BOE will answer the complaint alongside the submission of this brief. The case has not had a scheduling conference and there is no case schedule in place for any contentions, hearings, pre-trial events, or trial. The Court has not invested in the litigation in any way. There also has been no discovery of any kind in the Texas case. No documents have been produced, and no claim construction, depositions, fact discovery, or expert discovery has occurred.

C. The *Inter Partes* Review Petitions

BOE promptly filed *inter partes* reviews challenging all five of the patents asserted in the Texas case, all of which are invalid for the reasons explained in the Petitions submitted in IPR2025-01245 (this proceeding), IPR2025-01246,

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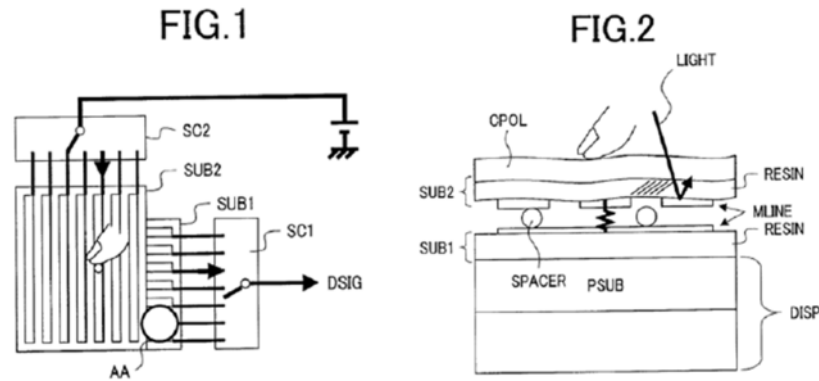
IPR2025-01267, IPR2025-01482, and IPR2025-01483.

The Petitions challenging the '758 Patent and its related '836 Patent were filed and served on July 10, 2025, and both were accorded filing dates on July 21, 2025. *See* Papers 1, 3; IPR2025-01246, Papers 1, 3. Thus, institution decisions for the '758 and '836 Patents are expected on January 21, 2026, and, if instituted, the expected date for final written decisions is January 21, 2027. BOE submitted a *Sotera* stipulation in this proceeding on August 28, 2025. *See* Paper 6.

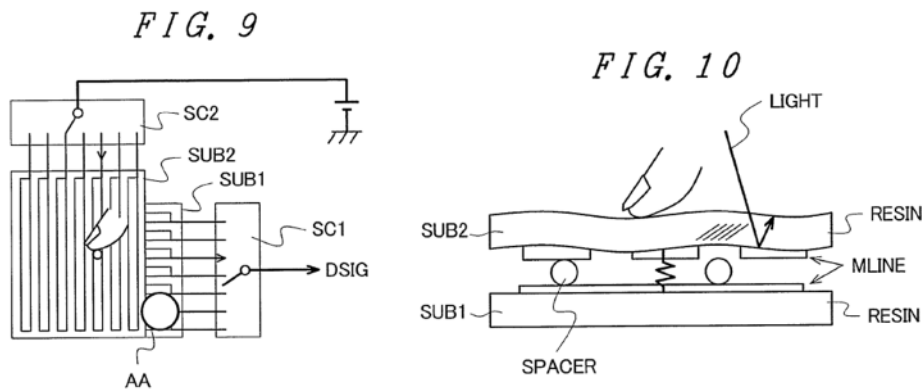
III. INSTITUTION IS APPROPRIATE HERE DUE TO PATENT OWNER MISCONDUCT AND PTO ERROR

Discretionary denial is not appropriate here, as Paneltouch seeks to take advantage of patent owner misconduct and PTO error during prosecution.

The '758 Patent explains that the “applicants of the present application” had already disclosed a touch panel with the claimed “new detection structure” in Nakamura. Ex. 1001, 2:57-59. Figs. 1 and 2 of the '758 Patent purport to be a touch panel 10 according to an embodiment of the present invention. *Id.* 3:47-52. But the patent further admits that the “detail of the touch panel 10 is described in the specification and drawings” of Nakamura. *Id.*, 4:53-60; *see also id.*, 6:39-48 (“adopt[ing]” Nakamura’s touch panel). For example, below are the key figures in Nakamura. Ex. 1004 (Nakamura), Figs. 1-2:



Consistent with the '758 Patent's admissions, its key figures, Figs. 9 and 10, are, respectively, identical and *less detailed* versions of Nakamura's Figs. 1 and 2. Ex. 1001 ('758 Patent), Figs. 9-10:



Critically, while the '758 Patent's specification argues that Nakamura's touch panel had an uneven surface feeling and that the disclosed panel "gives further excellent touch feelings" (*id.* 2:59-67), the patent's claims merely recite Nakamura's same structure, with no limitations directed to the surface feel.

Despite the admitted relevance of Nakamura's touch panel structure, the applicant did *not* disclose any version of the inventors' own Nakamura art—the

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Nakamura “Japanese Patent Application 2007-149884” discussed in the ’836 Patent, the subsequent U.S. Patent Publication No. 2008/0303798 A1 claiming priority to that Japanese application that is the focus of the present Petition (Ex. 1004), or any other related reference—to the examiner during prosecution. *See generally* Ex. 1002. For the Japanese language priority application mentioned in the specification, the applicant was obligated to provide an English translation or an explanation of its relevance. *See* MPEP 609.04(A). But for the applicant’s misconduct in failing to disclose Nakamura (and the examiner’s error in not independently applying Nakamura), the ’758 Patent would not have issued. *See* Petition at 9-17, 26-59.

You do not need to take Petitioner’s word for this. Nakamura was used to repeatedly reject the ’758 Patent’s child patent, U.S. Patent No. 9,639,229 (“the ’229 Patent”), which originally had claims like the issued ’758 Patent claims. As a result, the claims of the ’229 Patent, which has not been asserted against BOE, were substantially narrowed to obtain allowance. *See, e.g.*, Petition at 33-34, 36, 38, 40, 42, 45, 47, 49, 54-55; Ex. 1006 (’229 File History) at pp. 25-40 (examiner

rejecting the pending '229 Patent claims in view of Nakamura).² Indeed, these rejections resulted in the '229 Patent including limitations that actually relate to the improved “touch feeling” that the specification describes as the improvement over Nakamura. Ex. 1006 ('229 File History) at p. 43 (claim amended to add “the lines include metal lines which overlap the predetermined layer, and the predetermined layer *is softer than the circular polarizing plate*”).

In light of the PTO error—demonstrated by the Patent Owner’s narrowing of its claims to overcome Nakamura during prosecution of the '229 Patent—there should be no settled expectations that the '758 Patent is valid. And, in such a case of material error, the PTO should undertake this review. *TSMC Ltd. et al. v. Marlin Semiconductor Ltd.*, IPR2025-00847, Paper 11 (September 3, 2025) at 4 (“[a]lthough the challenged patent has been in force for fifteen years, Petitioner appears to show a material error by the Office, and it is an appropriate use of Office resources to review the potential error”); *Volkswagen Group of America, Inc. v. Longhorn Auto. Grp. LLC*, IPR2025-01064, Paper 9 (October 10, 2025) at

² As discussed in the Petition, while the examiner refers to Nakamura as “Matsudate” during the '229 Patent’s prosecution, BOE refers to the reference as Nakamura to avoid confusion because Mr. Matsudate is a named inventor on the face of the '758 Patent while Mr. Nakamura is not.

2-3 (although the “patent has been in force for over thirteen years,” any Patent Owner settled expectations are outweighed when “Patent Owner and its predecessors never attempted to correct [a] known error”).

IV. EVERY *FINTIV* FACTOR WEIGHS AGAINST DISCRETIONARY DENIAL

Paneltouch articulates no compelling reason why the Director should exercise discretionary denial in this IPR. The ’758 Patent only issued because the patent owner failed to disclose Nakamura and the examiner failed to independently review and apply it. Every *Fintiv* factor weighs against denial under 35 U.S.C. § 314 and no “additional consideration” Paneltouch raises favors denial.

A. The *Fintiv* Factors Weigh Against Discretionary Denial

As discussed in detail below, all six *Fintiv* factors weigh against denial, with Factors 2, 3, 4, and 6 strongly weighing against denial.

1. Factor 1: Evidence Exists That a Stay May be Granted if a Proceeding is Instituted

Neither party has yet moved to stay the district court case. But consistent with EDTX practice, BOE intends to move for a stay after the five IPRs challenging all of the asserted patents are instituted. BOE respectfully submits that it is likely that motion to stay will be granted. Paneltouch’s brief relies entirely on generalized statistics extending all the way back to 2014. Paper No. 7, Patent Owner’s Request for Discretionary Denial of Institution (“Brief”) at 3-4. This is a

conclusory approach that fails to consider present-day operations or the specifics of this case. For one thing, because Paneltouch's statistics include pre-institution motions, the post-institution grant rates will admittedly be higher. *See id.* (referring to pre-institution denial as a "universal practice" in EDTX).

Paneltouch also ignores the fact that Judge Gilstrap, who is presiding over the Texas case, has recently advised that because "a proper analysis regarding a requested stay is a highly fact-intensive exercise and that the facts considered (in their totality) vary widely from case to case," "parties are ill advised to see trends and patterns [] that might prevail in future cases under dissimilar facts and involving disparate conduct." *Resonant Sys., Inc. v. Nintendo Co.*, No. 2:25-CV-90-JRG, 2025 WL 2097883, at *3 n.2 (E.D. Tex. July 25, 2025).

An examination of Judge Gilstrap's recent opinions in cases involving comparable facts, rather than looking at "trends and patterns," reveals that post-institution stays are routinely granted in situations like this one, where the district court case has not meaningfully begun. *See, e.g., id.* at *2 (granting stay where petitioner promptly filed and the "parties had not yet invested resources into the discovery process, nor had the Court yet invested resources into claim construction"); *Maxeon Solar Pte. Ltd. v. Canadian Solar Inc.*, No. 2:24-CV-210-JRG, 2025 WL 1811321, at *2 (E.D. Tex. July 1, 2025) (granting stay where petitioner promptly filed and, at the time it moved to stay, "the parties ha[d] yet to

notice or take a single deposition and discovery remain[ed] at a relatively early stage” and the “Court ha[d] not yet begun the claim construction process”);

Veraseal LLC v. Wal-Mart Stores, Inc., No. 2:17-CV-527-JRG, 2018 WL 2183235, at *2 (E.D. Tex. May 11, 2018) (“the benefits of a stay outweigh the costs of postponing resolution in this particular case” because “the patent claims have not yet been construed by the Court, and discovery is not yet complete”);

Communication Techs., Inc. v. Samsung Electronics America, Inc., No. 2:21-CV-444-JRG, 2023 WL 1478447, at *3 (E.D. Tex. Feb. 2, 2023) (“with the close of discovery, the claim construction hearing, and the trial setting all in the future,” this “weighs in favor of a stay”).

BOE will move to stay post-institution. Comparable case law shows that motion likely will be granted. Paneltouch’s outdated, generalized “trends and patterns” that do not apply to the facts of this case, cannot outweigh this, per Judge Gilstrap’s recent admonition. *Resonant*, 2025 WL 2097883, at *3 n.2.

As the evidence suggests it is likely a stay will be granted when requested at the appropriate time, this factor supports institution or is at worst neutral.

2. Factor 2: No Court Trial Date Has Been Set, and Any Trial Date Would Fall After the Board’s Final Written Decision

This factor weighs strongly against denial. There is no case schedule entered in the Texas action, and no trial date has been set. A trial date will be after

the January 21, 2027 projected final written decision date for this IPR.

Paneltouch's focus on its February 2025 filing date ignores the fact that Paneltouch did not actively pursue its case for months. Indeed, Paneltouch did not serve or send BOE a waiver of service until July 19, 2025. Ex. 1012 (Waiver of Service). Contrary to Paneltouch's claim of alleged gamesmanship, BOE promptly waived service. The Texas court will not set the trial date until after the pleadings are complete and the parties attend a scheduling conference, which is yet to come.

In these circumstances, Paneltouch's alleged median time-to-trial statistics purporting to indicate a December of 2026 trial (Brief at 5) are simply not relevant here. *See* Ex. 2002. Paneltouch delayed serving its Complaint for months and the case is still at its earliest stages—a schedule has not even issued. It will be nine months after the February 2025 date Paneltouch focuses on before the complaint begins to be litigated.

Applying Paneltouch's own alleged 22 months-to-trial statistic to the case's October answer date, the expected trial date would be in August 2027. This is well after the expected final written decision date of January 21, 2027. Thus, the facts of this case, both on their own merits and as applied to Paneltouch's own median statistics, strongly weigh against denial.

3. Factor 3: There Has Been No Investment in the Parallel Proceeding by the Court and the Parties

This factor weighs strongly against denial. Paneltouch admits that there has been no meaningful investment in the Texas litigation by any of the parties or the Court, that a scheduling order has not been entered, and that claim construction has not occurred. Brief at 6-7. BOE is only now answering the complaint, and none of the following case events have occurred: a scheduling conference, claim construction proceedings, infringement contentions, invalidity contentions, document production, fact discovery, expert discovery, or anything else.

As the *Fintiv* panel noted, if “the district court has not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution,” while “claim construction orders may indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) at 9-10.

Here, the district court has not made a single substantive ruling on the challenged patent, and so obviously has not issued a claim construction order. This factor thus weighs strongly against discretionary denial.

4. Factor 4: There is No Evidence of Overlap Between Issues Raised in the Petition and in the Parallel Proceeding

This factor strongly weighs against denial. As discussed above, under all realistic timeframes for the Texas litigation, the Board would issue a final written

decision in this IPR well before any potential, currently unscheduled trial date.

Thus, the estoppel arising from the final written decision will ensure that the grounds addressed in the IPR will differ from any grounds of invalidity of the challenged patent that may ultimately be presented during a theoretical Texas trial.

BOE even filed a *Sotera* stipulation to ensure that any potential concerns regarding any speculative overlap have been resolved in advance. *See* Paper 6. Paneltouch complains that this *Sotera* stipulation is not sufficient here, but its argument is based on a misreading of *Motorola v. Stellar*, IPR2024-01205, Paper 19 (March 28, 2025). Brief at 7-9. Institution was not denied in *Motorola* because a *Sotera* stipulation is categorically insufficient, as Paneltouch argues. Rather, institution was denied in *Motorola* because there had already been a “substantial investment in the district court proceeding” that outweighed the stipulation in that case. *Motorola*, Paper 19 at 2-4. Specifically, the parties had already “served extensive infringement and invalidity contentions, served opening and rebuttal expert reports, filed claim construction briefs, and conducted several depositions” and the Court had already “held a claim construction hearing and construed the disputed claim terms,” all while preparing for a trial date “eleven months before the Board’s projected final written decision date.” *Id.* at 3. In contrast, nothing has occurred in the Texas case, and a scheduling order has not even issued. Paneltouch’s reliance on *Motorola* is thus misplaced, as there has

been zero district court investment to outweigh the *Sotera* stipulation here.

Paneltouch’s remaining comments—its “expectation” that currently unscheduled invalidity contentions will “include combinations of any art (including the art asserted in this IPR) with unpublished system art” and that the challenged claims “may subsequently be challenged again during any potential *ex parte* reexamination process”—are purely speculative and should not influence the discretionary denial analysis. Brief at 9-10.

BOE’s submission of a *Sotera* stipulation, without any investment in the Texas litigation at all that could outweigh it, strongly weighs against denial.

5. Factor 5: Because the PTAB Will Rule Before the District Court, the Same Party Factor Weighs Against Denial

BOE and Paneltouch are the parties in both the district court litigation and this IPR. Because, as discussed above, under all realistic timelines here, the Board will issue a final written decision before any possible district court trial, this factor weighs against discretionary denial. *See BMW of N. Am., LLC v. Mich. Motor Techs. LLC*, IPR2023-01234, Paper 11, 14-15 (Jan. 26, 2024) (collecting cases, explaining when a final written decision “is likely to issue before the district court trial,” the Board has “weigh[ed] this factor against exercising discretion”); *see also NVIDIA Corp. v. Invensas Corp.*, IPR2020-00603, Paper 11, at 23 (Sept. 3, 2020) (this factor weighs against discretionary denial even where decisions are expected

“around the same time”).

6. Factor 6: Other Circumstances, Including the Merits, Weigh Against the Board’s Exercise of Discretion

This factor weighs strongly against denial.

a) Patent Owner Misconduct and PTO Error During Prosecution Weigh Strongly Against Denial

Paneltouch does not dispute that the applicant did *not* disclose the inventors’ own Nakamura art to the examiner in an IDS during prosecution of the ’758 Patent or that there was resulting PTO error in not applying Nakamura to the ’758 Patent. *See generally* Ex. 1002. As discussed at length above, but for this misconduct, Nakamura would have been considered by the examiner and the ’758 Patent would not have issued.

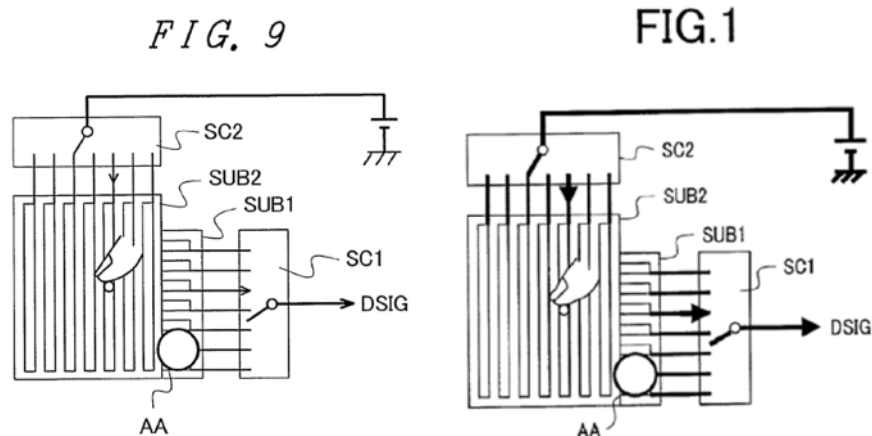
Because Nakamura was erroneously not applied to the ’758 Patent during prosecution, the PTO should apply it now. And the patent owner’s withholding of Nakamura during prosecution should prevent Paneltouch from taking advantage of any alleged settled expectations that the ’758 Patent would not be challenged.

b) Paneltouch Does Not Identify a Single Alleged Flaw on the Merits

The substantive merits of this IPR’s Petition are strong. As explained in detail in the Petition and discussed above in the Introduction, the claims are unpatentable because they claim touch panel structures that the ’758 Patent

expressly admits had already been disclosed in Nakamura, which the '758 Patent then expressly adopted. Ex. 1001 ('758 Patent), 2:57-59, 4:53-60, 6:39-48.

Indeed, the key figure in the '758 Patent (Ex. 1001, Fig. 9, below left) is copied from and identical to the key figure in Nakamura (Ex. 1004, Fig. 1, below right):



Paneltouch's failure to identify even a single purported issue is a tacit admission that the art identified in the Petition invalidates all challenged claims.

c) The Board is Better Suited to Review the Large Number of Patents at Issue

As the Director has recently recognized, when the district court proceeding at issue involves many patents that “involve a diverse range of subject matter,” this “weighs against discretionary denial, as the Board is better suited to review a large number of patents involving diverse subject matter.” *Tesla Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 10 at 2-3 (June 13, 2025). As in *Tesla*, the range of patents asserted in the Texas case here, all of which have been

challenged in IPRs filed by BOE, weighs against discretionary denial.

d) The Patent Owner Misconduct's and PTO Error Outweigh Any Alleged Settled Expectations

As discussed, Paneltouch should not be able to take advantage of any alleged settled expectations that the '758 Patent would not be challenged in view of the patent owner's withholding of Nakamura during prosecution, and the resulting PTO error in not applying it to the '758 Patent.

Additionally, the '758 Patent's life post-issuance shows that the settled expectations were that the '758 Patent would *not* be asserted. The '758 Patent issued in 2016 and was prosecuted by and originally assigned to Japan Display Inc. and Panasonic Liquid Crystal Display Co., Ltd. *See* Ex. 1001. From 2016 until last year, neither of these companies sued anyone based on the '758 Patent, and, to BOE's knowledge, neither threatened to do so. This, along with the serious defects of these patents, including the narrowing concessions the applicants needed to make in prosecuting the child '229 Patent, shows that the patent owner should have known the '758 Patent was overbroad and invalid. This created the expectation that the patent would not be asserted.

Just last year, Paneltouch acquired the '758 Patent as part of a portfolio. *See* Ex. 1010 (3/22/2024 Assignment of '758 Patent to Paneltouch). Paneltouch's argument that it should be entitled to nine years of alleged "settled expectations"

rings false, as it has only had the patent for a year. Brief at 12-14.

B. None of the “Additional Considerations” Patent Owner Discusses Favor Discretionary Denial

After its discussion of *Fintiv* Factor 6, Paneltouch’s Brief references certain “additional considerations.” None of them weigh in favor of discretionary denial.

First, Paneltouch alleges “no changes in the law support reconsideration of the validity of the ’758 patent claims.” Brief at 12. But existing law supports reviewing the invalidity of a patent that wrongly issued due to the patent owner’s undisputed failure to disclose Nakamura.

Second, Paneltouch should not benefit from any alleged settled expectations (Brief at 12-14) arising from the failure to submit Nakamura during prosecution.

Third, Paneltouch does not identify even a single alleged flaw in the merits of the Petition. Brief at 14. Again, its failure to do so is proof that the merits are strong.

Fourth, Paneltouch misstates the facts regarding waiver of service in the Texas litigation. Brief at 14-15. BOE promptly and voluntarily waived service, relieving Paneltouch of having to comply with its Hague Convention obligations, which, in its own words, are “lengthy foreign service protocols that can take a year or longer.” *Id.*; Ex. 1012 (Waiver of Service). BOE should not be punished for simplifying matters for Paneltouch and *not* delaying the Texas case for a year or

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longer. To rule otherwise would discourage waiving service.

V. CONCLUSION

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

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Date: October 21, 2025

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CERTIFICATE OF PAGE COUNT

The undersigned certifies that the foregoing paper complies with the page limit set forth on the Interim Director Discretionary Process webpage (<https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>). The foregoing is not more than 20 pages.

Dated: October 21, 2025

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