UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BOE TECHNOLOGY GROUP CO., LTD.,

Petitioner,

v.

138 EAST LCD ADVANCEMENTS LIMITED,

Patent Owner.

Case IPR2025-01396
Patent No. 7,636,146

**PATENT OWNER'S MEMORANDUM
IN SUPPORT OF DISCRETIONARY DENIAL**

TABLE OF CONTENTS

Page

TABLE OF AUTHORITIES

Page

Cases

Statutes

PATENT OWNER'S EXHIBIT LIST

Ex. 2001	Complaint for Patent Infringement, *Longitude Licensing Limited et al. v. BOE Technology Group Co., Ltd. et al.*, Dkt. 1, Case No. 2:25-cv-00358 (E.D. Tex.) (April 8, 2025)
Ex. 2002	Complaint for Patent Infringement, *Longitude Licensing Limited et al. v. BOE Technology Group Co., Ltd. et al.*, Dkt. 1, Case No. 2:25-cv-00440 (E.D. Tex.) (April 25, 2025)
Ex. 2003	Consolidation Order, *Longitude Licensing Limited et al. v. BOE Technology Group Co., Ltd. et al.*, Dkt. 23, 2:25-cv-00440 (E.D. Tex.) (August 14, 2025)
Ex. 2004	Order Setting Scheduling Conference, *Longitude Licensing Limited et al. v. BOE Technology Group Co., Ltd. et al.*, Dkt. 15, 2:25-cv-00440 (E.D. Tex.) (August 15, 2025)
Ex. 2005	Order Resetting Scheduling Conference, *Longitude Licensing Limited et al. v. BOE Technology Group Co., Ltd. et al.*, Dkt. 30, 2:25-cv-00440 (E.D. Tex.) (September 11, 2025)
Ex. 2006	Defendant BOE Technology Group Co., Ltd.'s Amended Answer and Defenses to Plaintiffs' Complaint for Patent Infringement, *Longitude Licensing Limited et al. v. BOE Technology Group Co., Ltd. et al.*, Dkt. 32, 2:25-cv-00358 (E.D. Tex.) (September 16, 2025)
Ex. 2007	Defendant BOE Technology Group Co., Ltd.'s Amended Answer and Defenses to Plaintiffs' Complaint for Patent Infringement, *Longitude Licensing Limited et al. v. BOE Technology Group Co., Ltd. et al.*, Dkt. 39, 2:25-cv-00440 (E.D. Tex.) (October 14, 2025)

INTRODUCTION

The Director should deny institution. A trial in the United States District Court for the Eastern District of Texas will decide validity of U.S. Patent No. 7,636,146 ("the '146 patent") a few short months after the Board's final written decision deadline. Institution would require the Board, the district court, and the parties to invest significant resources in parallel validity proceedings. But the parties' settled expectations should be dispositive: the challenged claims have been in force for more than 15 years, and Petitioner has had actual notice of its infringement of the '146 patent for almost six years. Pursuant to Deputy Director Stewart's March 26, 2025 Memorandum "Interim Processes for PTAB Workload Management" ("Process Memorandum"), Patent Owner 138 East LCD Advancements Limited requests that the Director exercise discretion and deny Petitioner BOE Technology Group Co., Ltd.'s request for *inter partes* review of the '146 patent.

BACKGROUND

Patent Owner and its exclusive licensee, Longitude Licensing Limited, filed complaints asserting the '146 patent—and U.S. Patent Nos. 8,319,512 ("the '512 patent") and 8,391,020 ("the '020 patent") (collectively, the "Longitude Patents")—on April 8, 2025, in *Longitude Licensing Limited et al. v. BOE Technology Group Co., Ltd. et al.*, Case No. 2:25-cv-00358 (E.D. Tex.), and on April 25, 2025, in *Longitude Licensing Limited et al. v. BOE Technology Group Co., Ltd. et al.*, Case

No. 2:25-cv-00440 (E.D. Tex.). *See* Exs. 2001, 2002. The district court consolidated those cases. *See* Ex. 2003. Those cases are pending before United States District Judge Rodney Gilstrap. *See id.* The district court will hold a scheduling conference on November 24, 2025. Ex. 2004. Infringement contentions are due on November 10, 2025, and invalidity contentions are due January 5, 2026. *See* Ex. 2005. The district court is likely to set a trial date in April 2027.[1]

The Longitude Patents relate to similar subject matter—inventions that improve consumer-facing benefits of LCD panels and/or modules, and/or monitors and TVs that incorporate these LCD panels and/or modules, including improvements in image quality and brightness, and manufacturing yields and costs. *See* Exs. 2001, 2002 at 8-9. In response to the complaints, Petitioner asserted counterclaims of invalidity against each Longitude Patent. *See* Exs. 2006 at 7-10, 2007 at 7-10. Four

[1] Median time-to-trial statistics for the Eastern District of Texas predict trial within 24.8 months of filing suit. *See Table C-5—U.S. District Courts–Civil Statistical Tables for the Federal Judiciary*, USCOURTS.GOV (June 30, 2025), https://www.uscourts.gov/data-news/data-tables/2025/06/30/statistical-tables-federal-judiciary/c-5.

months after Patent Owner filed its complaints, on August 14, 2025, Petitioner filed its Petition challenging the '146 patent.

ARGUMENT

Considering all relevant factors, exercising discretionary denial will serve the interests of efficiency and integrity of the system. Institution of *inter partes* review is a matter of discretion. *Cuozzo Speed Techs. v. Lee*, 579 U.S. 261, 273 (2016) (citing 35 U.S.C. § 314); *Mylan Labs. Ltd. v. Janssen Pharmaceutica, N.V.*, 989 F.3d 1375, 1382 (Fed. Cir. 2021) ("[N]o petitioner has a right to such institution."). Where institution does not align with the AIA's objective "to provide an effective and efficient alternative to district court litigation," it should be denied. *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16-17 (PTAB Sept. 6, 2017) (precedential). The Board and the Director routinely deny institution where IPR would be inefficient in view of parallel litigation. *See, e.g.*, *Advanced Micro Devices, Inc. v. Concurrent Ventures, LLC*, IPR2025-00223, Paper 9 at 2 (Director June 12, 2025); *Charter Commc'ns, Inc. v. Adaptive Spectrum & Signal Alignment, Inc.*, IPR2025-00087, 2025 WL 1297798, at *8 (PTAB May 5, 2025).

The Board and the Director adopt "a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review." *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (PTAB Mar. 20, 2020) (precedential) (citing *NHK Spring Co. v. Interi-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB

Sept. 12, 2018) (precedential)). When determining whether to exercise discretion to deny institution under 35 U.S.C. § 314, the Board and the Director consider six factors:

> (1) whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
>
> (2) proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
>
> (3) investment in the parallel proceeding by the court and the parties;
>
> (4) overlap between issues raised in the petition and in the parallel proceeding;
>
> (5) whether the petitioner and the defendant in the parallel proceeding are the same party; and
>
> (6) other circumstances that impact the Board's exercise of discretion, including the merits.

Fintiv, IPR2020-00019, Paper 11 at 6.

In evaluating and applying the *Fintiv* factors, the Director also may consider the settled expectations of the parties and the extent of the Petition's reliance on expert testimony. *See* Process Memorandum at 2-3.

A. Settled expectations and Petitioner's delay warrant discretionary denial.

Recent Director decisions granting requests for discretionary denial and denying institution have established the significance of settled expectations in this analysis. *See Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 (Director June 18, 2025). Settled expectations and Petitioner's specific delay in challenging the '146 patent, alone, justify denying the Petition here.

First, the '146 patent issued on December 22, 2009. Ex. 1001. Discretionary denial is appropriate here because the challenged claims have been in force for more than 15 years. *See iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00378, Paper 10 at 3 (Director June 6, 2025); *Dabico Airport Sols.*, IPR2025-00408, Paper 21 (finding settled expectations where the challenged claims had been in force for eight years); *United Microelectronics Corp. et al. v. Advanced Integrated Circuit Process LLC*, IPR2025-01053, Paper 12 at 2 (Director Oct. 10, 2025) (finding "strong settled expectations for Patent Owner" where "the challenged patents have been in force for eleven, sixteen, fourteen, ten, thirteen, thirteen, and twelve years"). And the fact that "Patent Owner did not previously assert the challenged patents against Petitioner does not defeat Patent Owner's settled expectations." *United Microelectronics Corp.*, IPR2025-01053, Paper 12 at 3.

Second, Patent Owner notified Petitioner of its infringement of the '146 patent almost six years ago, on January 2, 2020. *See* Ex. 2001 ¶¶ 48-51. Patent Owner provided actual notice to Petitioner of its infringement of the '146 patent and identified, in claim charts and in letters, exemplary infringing third-party devices incorporating Petitioner's infringing LCD products. *Id.*

The '146 patent's longstanding claims and Petitioner's specific failure to challenge the '146 patent for more than six years after receiving actual notice of its infringement warrant denial. Indeed, in the recent *VideoLabs* decision, the Deputy Director denied institution because the challenged claims had been in force for 12 years, creating settled expectations, and "Patent Owner specifically notified Petitioner about the challenged patents in June 2023, . . . during licensing negotiations." *Hisense USA Corp. et al. v. VideoLabs, Inc.*, IPR2025-00880, Paper 11 at 2-3 (Director Oct. 10, 2025); *see also Nkt Photonics Inc. et al. v. Omni Continuum LLC*, IPR2025-00839, Paper 10 (Director Sep. 4, 2025) (finding strong settled expectations and denying institution because "Petitioner appears to have had notice of the challenged patent . . . and was engaged in discussions with Patent Owner about its portfolio until shortly before Patent Owner asserted the challenged patent"). Those settled expectations justified denial even though "[n]o trial date [had] been set in the parallel proceeding involving the parties and the challenged patents," and "it [was] likely that a final written decision [would] issue before the

district court trial occurs." *VideoLabs*, IPR2025-00880, Paper 11 at 2; *see also Astera Mf. Ltd. et al. v. ElectraLED Inc.*, IPR2025-01022, Paper 12 at 2 (Director Oct. 10, 2025) (denying institution even where no parallel proceeding trial date had been set because "the challenged patent has been in force for fifteen years, creating strong settled expectations for Patent Owner, and Petitioner does not provide persuasive reasoning why an inter partes review is an appropriate use of Board resources," and thus "the considerations that favor discretionary denial outweigh those that counsel against it"); *Apple Inc. v. Advanced Coding Techs. LLC*, IPR2025-00983, Paper 10 (Director Oct. 3, 2025) (same).

B. The parallel district court proceeding favors discretionary denial.

The posture of the parallel district court proceeding favors discretionary denial, too. First, Petitioner has not moved to stay that proceeding, and the district court is not likely to grant a stay even if Petitioner moves for one. *See AGIS Software Development LLC v. Google LLC*, 2:19-CV-00361-JRG, 2021 WL 465424, at *2 (E.D. Tex. Feb. 9, 2021) ("It has been this Court's consistent and long established practice to deny motions to stay pending IPR and EPR when the PTAB or PTO have instituted review on less than all asserted claims of all asserted patents because at least one or more originally asserted claims will be unaffected by the outcome of those parallel proceedings and left intact before this Court to be tried.").

Second, the Board's final written decision deadline and the district court's anticipated trial are likely to fall within two months of one another. Even though the Board may issue a final written decision before the district court proceeding concludes, institution would require the Board, the district court, and the parties to invest significant and duplicative resources in parallel validity proceedings.

Patent Owner filed suit against Petitioner and its customers in the United States District Court for the Eastern District of Texas more than four months before Petitioner filed its Petition challenging the '146 patent. Petitioner challenges the validity of the '146 patent in the district court proceeding. *See* Exs. 2006 at 7-10, 2007 at 7-10. Petitioner has not filed a *Sotera* stipulation here. The district court will set a trial date and a schedule next month. Based on the district court's consistent practice and median time-to-trial statistics, Patent Owner expects that the district court will set a trial date in April 2027. *See supra*. If the Board institutes, it will issue a final written decision in February 2027. *See* 35 U.S.C. §316(a)(11).

Patent Owner anticipates that parties will have completed claim construction, fact and expert discovery, and dispositive motions before the Board issues its final written decision. This proceeding and the district court proceeding will progress together, and the Board and the parties will expend resources here only for the district court to decide validity around the same time. *See Omnivision Techs., Inc. v. RE Secured Networks, LLC*, IPR2025-01019, Paper 14 at 2 (Director Oct. 10, 2025)

(finding "meaningful investment in the parallel proceeding" even if unclear whether the district court trial would take place before the Board's final written decision deadline); *Advanced Micro Devices*, IPR2025-00223, Paper 9 at 2 ("Even though a district court trial date that occurs after a projected final written decision date reduces the possibility of conflicting decisions, that benefit does not outweigh the efficiencies gained by avoiding parallel proceedings in this instance because of the parties' meaningful investment in the district court proceeding discussed above.").

Thus, the *Fintiv* factors considering the parallel proceeding favor discretionary denial.

C. The Petition relies on extensive expert testimony, which also favors discretionary denial.

Last, Petitioner's reliance on extensive expert testimony favors discretionary denial. *See* Process Memorandum at 2. Petitioner cites a 205-page, 260-paragraph expert declaration throughout the Petition. *See generally* Paper 1 ("Pet."). In particular, Petitioner's expert provides 42 paragraphs of "technology overview" and 63 paragraphs describing the "state of the art" (with discussion of the asserted references but also other references). *See* Ex. 1002 ¶¶ 38-79, 98-160. Petitioner relies on expert testimony to support the two asserted obviousness combinations (one requiring four references, the other requiring three), including to fill gaps in the documentary evidence relating to motivation to combine and whether certain

concepts were conventional and within the general knowledge of a POSITA. *See, e.g.*, Pet. at 32-38; Ex. 1002 ¶¶ 161-71.

The extensive expert testimony, which Patent Owner will counter in its forthcoming Patent Owner Preliminary Response, raises credibility issues better resolved by the district court. Patent Owner will otherwise address the merits of the Petition in its POPR.[2]

CONCLUSION

Discretionary denial is appropriate, and the Director should decline to institute *inter partes* review of the '146 patent.

---

[2] Interim Director Discretionary Process, https://www.uspto.gov/patents/ptab/interim-director-discretionary-process ("Notwithstanding the prohibition on incorporation by reference in 37 C.F.R. § 42.6(a)(3), when filing a brief for discretionary denial, a patent owner may direct attention to an anticipated POPR and evidence for a discussion of the merits.").

Dated: October 17, 2025

Respectfully submitted,

/*Cyrus A. Morton*/

Cyrus A. Morton (Reg. No. 44,954)
CMorton@RobinsKaplan.com
Lead Counsel
Samuel J. LaRoque (Reg. No. 68,542)
SLaRoque@RobinsKaplan.com
Back-Up Counsel
Robins Kaplan LLP
800 LaSalle Avenue, Suite 2800
Minneapolis, MN 55402
Phone: 612-349-8500
Fax: 612-339-4181

Attorneys for Patent Owner

WORD-COUNT CERTIFICATE

The undersigned certifies that Patent Owner's Memorandum in Support of Discretionary Denial complies with the type-volume limitation of 37 C.F.R. § 42.24(a) and (b) and contains 2140 words in 14-point Times New Roman font as calculated by the word count feature of Microsoft Office. This word count is inclusive of all text and footnotes but does not include the table of contents, table of authorities, certificates of word count or service, or appendix of exhibits or claim listing.

Dated: October 17, 2025

Respectfully submitted,

/*Cyrus A. Morton*/

Cyrus A. Morton (Reg. No. 44,954)
CMorton@RobinsKaplan.com
Lead Counsel
Samuel J. LaRoque (Reg. No. 68,542)
SLaRoque@RobinsKaplan.com
Back-Up Counsel
Robins Kaplan LLP
800 LaSalle Avenue, Suite 2800
Minneapolis, MN 55402
Phone: 612-349-8500
Fax: 612-339-4181

Attorneys for Patent Owner

CERTIFICATE OF SERVICE

The undersigned certifies that Patent Owner's Memorandum in Support of Discretionary Denial was served on October 17, 2025, by electronic mail to Petitioner's counsel at the following addresses indicated in Petitioner's Mandatory Notices:

Amy E. Simpson, Reg. No. 54,688
Amy.Simpson@hklaw.com

Kristopher L. Reed, Reg. No. 58,694
kris.reed@hklaw.com

Edward J. Mayle, Reg. No. 65,444
edward.mayle@hklaw.com

Dated: October 17, 2025

Respectfully submitted,

/*Cyrus A. Morton*/

Cyrus A. Morton (Reg. No. 44,954)
CMorton@RobinsKaplan.com
Lead Counsel
Samuel J. LaRoque (Reg. No. 68,542)
SLaRoque@RobinsKaplan.com
Back-Up Counsel
Robins Kaplan LLP
800 LaSalle Avenue, Suite 2800
Minneapolis, MN 55402
Phone: 612-349-8500
Fax: 612-339-4181

Attorneys for Patent Owner