UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG DISPLAY CO., LTD.
Petitioner,

v.

SURPASS TECH INNOVATION LLC,
Patent Owner.

Case IPR2015-00885
Patent 7,202,843

RESPONSE TO BOARD ORDER OF MAY 13, 2016
BY PATENT OWNER SURPASS TECH INNOVATION LLC

In response to the Board's Order dated May 13, 2016, Patent Owner SURPASS TECH INNOVATION LLC submits that the Board should not enter judgment against claims 4, 8, and 9 of the subject patent. As explained below, claims 4, 8, and 9 have been fully and finally adjudicated in a prior *inter partes* review. Accordingly, the Board should terminate this proceeding as to claims 4, 8, and 9 under 37 C.F.R. § 42.72 as moot.

1. The patentability of claims 4, 8, and 9 has been fully and finally adjudicated in IPR2015-00021

The patent at issue in this proceeding, U.S. Patent No. 7,202,843 ("the '843 Patent") was also at issue in IPR2015-00021 previously pending before this Board. In IPR2015-00021, the Board issued a final written decision on February 26, 2016 that held claims 4, 8, and 9 of the '843 patent to be unpatentable. The period to appeal the final written decision expires after 63 days from the date of the final written decision. This deadline to file a notice of appeal, by Patent Owner's calculation, was April 29, 2016. As of that deadline and the date signed below, Patent Owner has not appealed the final written decision in IPR2015-00021, which is now final.

2. There is no Article III standing to adjudicate the patentability of claims 4, 8, and 9

A party who seeks to invoke federal jurisdiction must establish Article III standing, which is now absent in this case. *Consumer Watchdog v. Wis. Alumni Research Found.*, 753 F.3d 1258, 1260-61 (Fed. Cir. 2014)

> To meet the constitutional minimum for [Article III] standing, the party seeking to invoke federal jurisdiction must satisfy three requirements. *Lujan v. Defenders of Wildlife*, 504 U.S. 555, 560, 112 S.Ct. 2130, 119 L.Ed.2d 351 (1992). First, the party must show that it has suffered an "injury in fact" that is both concrete and particularized, and actual or imminent (as opposed to conjectural or hypothetical). *Id.* at 560-61, 112 S.Ct. 2130. Second, it must show that the injury is fairly traceable to the challenged action. *Id.* at 560, 112 S.Ct. 2130. Third, the party must show that it is likely, rather than merely speculative, that a favorable judicial decision will redress the injury. *Id.* at 561, 112 S.Ct. 2130.

Id. As of this date, claims 4, 8, and 9 are fully and finally unpatentable. Should the Board decide to adjudicate the patentability of claims 4, 8, and 9 again in this current proceeding, Patent Owner would have no Article III standing to appeal that judgment; in that instance, there would be no “injury in fact” in the Board’s determination that unpatentable claims 4, 8, and 9 are unpatentable. Further, an appeal of the current *inter partes* review would have no effect on the Board’s

determination in IPR2015-00021 that claims 4, 8, and 9 are unpatentable. These factors confirm that the patentability of claims 4, 8, and 9 is now moot.

The U.S. Court of Appeals for the Federal Circuit recently issued an informative Opinion that addressed three IPRs decided against a common patent. In IPR2014-00110, the Board determined that claims 16-19 of the patent-at-issue were unpatentable. *See* IPR2014-00110, Paper 46 at 22. In IPR2014-00111, the Board determined that claims 20-24 of the same patent- at-issue were unpatentable. *See* IPR2014-00111, Paper 47 at 32. Then, in IPR2014-00395, the Board determined that claims 16 and 19-24 were unpatentable. *See* IPR2014-00395, Paper 41 at 30. The patent owner appealed these cases to the Federal Circuit.

In deciding these cases on appeal, the Court affirmed the Board in the first two cases, IPR2014-00110 and IPR2014-00111. And since those two cases fully addressed the patentability of claims 16 and 19-24 at issue in IPR2014-00395, the Court dismissed the appeal of IPR2014-00395 as moot. *See Norred v. Medtronic, Inc. et al*., Case No. 2015-1731 (Fed. Cir., May 10, 2016) (nonprecedential). Similarly here, this case is moot as to the question of whether claims 4, 8, and 9 are unpatentable. The issue has been fully and finally decided, and the property rights embodied in claims 4, 8, and 9 no longer exist for adjudication.

In this circumstance, Patent Owner submits that the proper action is for the Board to terminate this *inter partes* review as to claims 4, 8, and 9 as moot.

Termination without rendering a final decision as to these claims is appropriate here, where the patent rights in these claims are already extinguished. Authority is granted to the Board for such termination under 37 C.F.R. § 42.72.

Dated: May 23, 2016

Respectfully submitted,

By: /s/ *Wayne M. Helge*
Registration No. 56,905
Lead Counsel for Patent Owner

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