

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE**

NICHIA CORPORATION,

Plaintiff,

v.

TCL MULTIMEDIA TECHNOLOGY  
HOLDINGS LIMITED and TTE  
TECHNOLOGY, INC.,

Defendants.

Case Action No. 16-681-RGA

**DEFENDANTS' OPENING BRIEF IN SUPPORT OF MOTION TO STAY  
PENDING INTER PARTES REVIEW OF THE PATENTS-IN-SUIT**

CONNOLLY GALLAGHER LLP  
Arthur G. Connolly, III (#2667)  
Ryan P. Newell (#4744)  
Mary I. Akhimien (#5448)  
The Brandywine Building  
1000 West Street, Suite 1400  
Wilmington, DE 19801  
(302) 757-7300  
aconnolly@connollygallagher.com  
rnewell@connollygallagher.com  
makhimien@connollygallagher.com

OF COUNSEL:  
QUINN EMANUEL URQUHART & SULLIVAN LLP  
Raymond N. Nimrod  
James M. Glass  
51 Madison Ave., 22nd Floor  
New York, New York 10010  
(212) 849-7000  
raynimrod@quinnemanuel.com  
jimglass@quinnemanuel.com

*Attorneys for TCL Multimedia Technology  
Holdings Limited and TTE Technology, Inc.*

**B. Nichia's Patents Are Either Expired or Will Expire Imminently**

The patents-in-suit all claim priority to U.S. Patent Application No. 08/902,725, filed on July 29, 1997. All but the '631 patent expired on July 29, 2017. The '631 patent is subject to a 90 day extension and, thus, will expire imminently – on October 27, 2017.

**C. TCL's IPR Petitions Incorporate The PTAB's Teachings From *Vizio***

Nichia will likely note that the PTAB previously rejected IPR petitions filed by Vizio, Inc. against the same asserted patents. As an initial matter, the grounds presented in TCL's petitions are different from those asserted by Vizio. Vizio's petitions relied primarily on a prior art patent<sup>3</sup> which, according to the PTAB, failed to disclose key limitations of the claims, including the partial absorption of blue LED light and the synthesis of that light with yellow phosphor light. TCL's petitions address the PTAB's concerns by identifying a different reference that expressly discloses these limitations – a prior publication by a co-inventor of Nichia's own asserted patents, Japanese Unexamined Patent Application Publication No. H08-7614 to Shimizu *et al.* This reference discloses the partial absorption of blue LED light and synthesizing that light with yellow phosphor light. Indeed, the patents-in-suit even include a discussion of this reference, stating that:

“The light emitting diode disclosed [in Shimizu is] capable of *emitting white light* by *mixing the light of a plurality of sources* can be made by using a light emitting component capable of emitting blue light and molding the *light emitting component with a resin including a fluorescent material that absorbs the light emitted by the blue light emitting diode and emits yellowish light.*”

'631 patent, 2:23-29.<sup>4</sup>

<sup>3</sup> The subject patent is U.S. Patent No. 6,600,175 to Baretz *et al.* (“Baretz”).

<sup>4</sup> The specifications of the Nichia Patents are virtually identical, although there are some differences in column and line numbers associated with various passages. Unless stated otherwise, Nichia will provide citation to only the '631 patent when citing the shared disclosures.

TCL's petitions also address other issues raised by the Board in connection with the Vizio IPRs. For instance, the Board noted that Vizio did not explain how U.S. Patent No. 3,699,478 to Pinnow *et al.* ("Pinnow") is analogous to the patents-in-suit, *e.g.*, stating that "Petitioner does not explain how the gas ion laser projection system disclosed in Pinnow is in the same field of endeavor as a solid state LED light source." Ex. 5 (IPR2017-00556, Paper 9) at 35-36; *see also* Ex. 6 (IPR2017-00558, Paper 9) at 14 ("Petitioner has not provided any evidence or argument as to whether Pinnow is in the same field of endeavor as the '375 patent"). Vizio, however, did not explain that the *Federal Circuit* already found in a prior proceeding (in the context of another Pinnow reference) that Pinnow's teachings on lasers clearly apply to LED technology. *In re Cree*, 828 F.3d 694 (Fed. Cir. 2016) (affirming ruling that Pinnow laser prior art was applicable to LED art in early 1996). That decision was binding on the Board, is flatly contrary to the reasoning the Board adopted in the Vizio IPRs, and its implications have been fully briefed in TCL's petitions.

In other instances, the PTAB refused to address the substance of Vizio's petitions at all, because Vizio failed to provide basic substantive analysis of its grounds and instead relied on claim charts. Ex. 7 (IPR2017-00551, Paper 9) at 8-9. In other words, some of Vizio's petitions were denied because the Board could not discern Vizio's positions due to their overreliance on summary claim charts. TCL's petitions do not rely on summary claim charts, but instead provide a reasoned, detailed narrative explaining each of the references, their disclosures vis-à-vis the claims, and specific rationales as to *why* a skilled artisan would have combined them.

In short, TCL's petitions address each and every concern raised by the PTAB, and provide the PTAB with a factual record and legal analysis that was lacking from the Vizio petitions.

Thus, a stay will not unduly prejudice or otherwise tactically disadvantage Nichia.

## V. CONCLUSION

For the reasons set forth above, TCL respectfully requests that the Court grant its motion for a stay until the IPR proceedings are resolved.<sup>10</sup>

DATED: October 5, 2017

*/s/ Arthur G. Connolly, III*  
CONNOLLY GALLAGHER LLP  
Arthur G. Connolly, III (#2667)  
Ryan P. Newell (#4744)  
Mary I. Akhimien (#5448)  
The Brandywine Building  
1000 West Street, Suite 1400  
Wilmington, DE 19801  
(302) 757-7300  
aconnolly@connollygallagher.com  
rnewell@connollygallagher.com  
makhimien@connollygallagher.com

OF COUNSEL:  
QUINN EMANUEL URQUHART & SULLIVAN LLP  
Raymond N. Nimrod  
James M Glass  
51 Madison Ave., 22nd Floor  
New York, New York 10010  
(212) 849-7000  
raynimrod@quinnemanuel.com  
jimglass@quinnemanuel.com

*Attorneys for TCL Multimedia Technology  
Holdings Limited and TTE Technology, Inc.*

---

<sup>10</sup> Pursuant to Local Rule 7.1.1, counsel avers that a reasonable effort was made to reach agreement with the opposing party on the matters set forth in the motion.