

**IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF TEXAS  
MARSHALL DIVISION**

JAPAN DISPLAY INC. and PANASONIC  
LIQUID CRYSTAL DISPLAY CO., LTD.,

Plaintiffs,

v.

TIANMA MICROELECTRONICS CO.  
LTD.,

Defendant.

CIVIL ACTION NO. 2:20-cv-00283-JRG  
(Lead Case)

CIVIL ACTION NO. 2:20-cv-00284-JRG

CIVIL ACTION NO. 2:20-cv-00285-JRG  
(Consolidated)

JURY TRIAL DEMANDED

**DEFENDANT'S MOTION FOR LEAVE  
TO SUPPLEMENT INVALIDITY CONTENTIONS**

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incorporates by reference all IPR proceedings at the USPTO related to any of the asserted patents. *See* Ex. A<sup>2</sup>, Preliminary Invalidation Contentions at 4.

**A. Plaintiffs belatedly produced their own prior art information only after the Court's order**

A series of failed requests to Plaintiffs to produce their own prior art product information led Tianma Microelectronics to file its Motion to Compel Plaintiffs to Produce Relevant Information in Plaintiffs' Sole Possession (Dkt. No. 64) ("Motion to Compel"), which this Court heard and granted in part on June 21, 2021. Plaintiffs started producing documents related to a subset of their prior art products on June 25, continuing through July 22. By the time Plaintiffs started making that prior art production, over three months had passed since the March 3 preliminary contention date.

**B. Tianma Microelectronics's supplemental invalidity contentions are either based on the prior art products alone or based on the prior art products in combination with reference publications**

Since Plaintiffs' production of its prior art files, Tianma Microelectronics's counsel and experts have been diligently reviewing JDI's production and developing supplemental invalidity contention claim charts.<sup>3</sup> Skoyles Dec. ¶ 5. On August 20, Tianma Microelectronics informed Plaintiffs it intended to move for leave to supplement its invalidity contentions based on Plaintiffs' prior art products alone, as well as based on combinations of the prior art products

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<sup>2</sup> Exhibits refer to those identified in the attached declaration of Aidan C. Skoyles.

<sup>3</sup> Tianma Microelectronics started reviewing Plaintiffs' source code the very first day it became available after the two-day notice period required by the Protective Order, *i.e.*, July 2. *See* Dkt. No. 89 at 7 (amended to add in-person review provisions). To expedite the process, Tianma Microelectronics requested access to the code on a source-code style laptop in Plaintiffs' counsel's Washington, DC office. In view of the logistical challenges involved in in-person code review, Tianma Microelectronics subsequently requested Plaintiffs set up a remote code review on the same system already in use by Plaintiffs to review Tianma Microelectronics's GDS files. Despite making the request on July 19, Plaintiffs delayed making the code available until August 13.

[REDACTED]

with reference publications whenever appropriate. Ex. B. Tianma Microelectronics provided courtesy copies of the claim charts it prepared based on Plaintiffs' prior art products. *Id.*; *see also* Ex. C, Ex. D, *Nagano* Amended Invalidity Contention; Ex. E, *No* and *Lee* Amended Invalidity Contention.

**C. Plaintiffs do not oppose supplemental contentions based on the prior art products, but oppose the contentions based on a modification of the prior art products in light of later-discovered references**

On August 26, Plaintiffs informed Tianma Microelectronics that they do not oppose the invalidity contentions based on the prior art products. But they do oppose those contentions based on modifications of the prior art products in light of secondary reference publications, if the publications were not already disclosed in the March 3 contentions. Admittedly, these three such secondary references were not included in Defendant's March 3 contentions; they were included in the IPRs Defendant filed in June and July.

But Defendant could not have raised combinations based on the prior art products any sooner because it did not have access to Plaintiffs' files on those prior art products until recently. Plaintiffs only produced the seven prior art products cited in Defendant's supplement in July. Skoyles Dec. ¶ 12. Even as of this motion, Defendant is still awaiting design layer information, which is necessary to review Plaintiffs' GDS source code. And despite multiple requests, Plaintiffs still have not agreed to narrow this case or reduce the asserted claims. Ex. G. Defendant therefore needed to analyze 135 asserted claims from 15 patents against all of Plaintiffs' prior art products.

During the meet-and-confer related to this Motion, Plaintiffs acknowledged they have been aware of each of the three secondary references since Defendant filed the IPR petitions and their IPR experts have been considering them. Plaintiffs also did not identify any additional specific discovery they would need to take if Tianma Microelectronics' motion for leave was

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