

**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

JURY TRIAL DEMANDED

JAPAN DISPLAY INC.,

Plaintiff,

v.

TIANMA MICROELECTRONICS CO.
LTD.,

Defendant.

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

JURY TRIAL DEMANDED

JAPAN DISPLAY INC.,

Plaintiff,

v.

TIANMA MICROELECTRONICS CO.
LTD.,

Defendant.

CIVIL ACTION NO. 2:20-cv-00285-JRG

JURY TRIAL DEMANDED

DEFENDANT'S PRELIMINARY INVALIDITY CONTENTIONS

Pursuant to Patent Local Rules ("P.R.") 3-3 and 3-4 and the Court's Docket Control Order (Dkt. No. 30) ("Court's Order"), Defendant Tianma Microelectronics Co. Ltd. ("Defendant" or "Tianma Microelectronics"), hereby makes the following initial Invalidity Contentions and provides accompanying document production.

I. Introduction

Plaintiffs Japan Display Inc. and Panasonic Liquid Crystal Display Co., Ltd. (collectively, “Plaintiffs”) have asserted the following patents in Civil Action Nos. 2:20-cv-00283-JRG (E.D. Tex.) (“the 283 Action”), 2:20-cv-00284-JRG (E.D. Tex.) (“the 284 Action”), and 2:20-cv-00285-JRG (E.D. Tex.) (“the 285 Action”): U.S. Patent Nos. 8,218,119 (“the ’119 patent”), 10,139,687 (“the ’687 patent”), 9,715,132 (“the ’132 patent”), 9,793,299 (“the ’299 patent”), 10,018,859 (“the ’859 patent”), 8,218,118 (“the ’118 patent”), 10,423,034 (“the ’034 patent”), 10,330,989 (“the ’989 patent”), 7,936,429 (“the ’429 patent”), 9,310,654 (“the ’654 patent”), 8,830,409 (“the ’409 patent”), 9,817,288 (“the ’288 patent”), 7,636,142 (“the ’142 patent”), 7,385,665 (“the ’665 patent”), and 9,939,698 (“the ’698 patent”) (collectively, the “Patents-in-Suit”). *See* Plaintiffs’ Disclosure of Asserted Claims and Infringement Contentions (“Infringement Contentions”), served on January 6, 2021, with amended Appendices 2 and 5 served on January 12, 2021.

Defendant’s investigation is ongoing. Defendant serves these disclosures based on information currently available to Defendant at this early stage of these actions. Defendant reserves the right to modify and supplement these disclosures in response to any amendment by Plaintiffs to their Infringement Contentions or as Defendant discovers additional information in the course of discovery.

This Court has not yet construed any of the terms in the Patents-in-Suit in these actions. Defendant’s Invalidity Contentions are based on Defendant’s present understanding of the asserted claims and the apparent construction of the claims used by Plaintiffs in their Infringement Contentions. Defendant reserves the right to modify or supplement these contentions in response to the Court’s construction of the claim terms at issue. Defendant’s Invalidity Contentions, including the attached invalidity claim charts, may reflect alternative

positions dependent upon claim construction and scope. These Invalidity Contentions are not an admission by Defendant that the accused products, including any current or past versions of these products, are covered by or infringe the asserted claims. Furthermore, by including prior art that anticipates or renders obvious claims based on Plaintiff's apparent claim construction, Defendant does not thereby adopt Plaintiffs' apparent claim construction. These Invalidity Contentions do not represent an agreement with Plaintiffs' views as to the meaning, definiteness, written description support for, or enablement of any asserted claim.

Prior art not included in this disclosure may become relevant. Defendant is currently unaware of the extent, if any, to which Plaintiffs may contend that certain limitations of the asserted claims are not disclosed in the prior art identified by Defendant. Defendant reserves the right to identify other relevant prior art with respect to such allegedly missing limitation(s).

Defendant's exhibits attached hereto cite to particular portions, teachings, and disclosures of the prior art as applied to features of the asserted claims. Persons skilled in the art, however, may view an item of prior art in the context of other publications, literature, products, and understanding. The cited portions of prior art identified herein are exemplary only. Defendant will rely on the entirety of the prior art references listed herein, including uncited portions of those prior art references, as well as additional information including products, documents, materials, and expert testimony.

The references cited herein disclose the elements of the asserted claims explicitly or inherently, and they also demonstrate the state of the art in the relevant time frame. The suggested obviousness combinations are provided in the alternative to Defendant's anticipation contentions and are not to be construed to suggest that any reference included in the combinations is not by itself anticipatory. Further, the combinations listed herein are exemplary

and not exhaustive. There are many possible invalidating combinations of the references listed herein and it is not practical, at this early stage, to identify and list all potentially relevant combinations without the benefit of further factual investigation and prior to the claim construction proceedings.

In addition to the prior art identified below and in the accompanying invalidity claim charts, Defendant hereby incorporates by reference any additional prior art and invalidity contentions that have been or will be disclosed in any other action related to any of the Patents-in-Suit. Defendant's incorporation by reference also includes all *inter partes* review proceedings at the U.S. Patent and Trademark Office related to any of the Patents-in-Suit.

II. P.R. 3-3(a): Identification of Prior Art

Defendant identifies the following prior art that anticipates one or more asserted claims of the Patents-in-Suit and/or renders one or more claims obvious. Defendant also incorporates by reference each and every prior art reference of record in the prosecution of the Patents-in-Suit and patents or patent applications related to the Patents-in-Suit, as well as the prior art referred to in the specifications of the Patents-in-Suit.

In these contentions, Defendant identifies each item of prior art, including: (1) each patent, constituting prior art under pre-AIA 35 U.S.C. §§ 102(a), (b), and/or (e)/ AIA 35 U.S.C. §§ 102(a)(1) and/or (a)(2), by its patent number, country of origin, and date of issue; (2) each non-patent publication, , constituting prior art under pre-AIA 35 U.S.C. §§ 102(a) and/or (b)/ AIA 35 U.S.C. §§ 102(a)(1) and/or (a)(2), by its title, date of publication, and, where feasible, author and publisher; (3) pre-AIA 35 U.S.C. § 102(a) and/or (b)/AIA 35 U.S.C. § 102(a)(1) prior art by the item offered for sale or publicly used or known, the date the offer or use took place or the information became known, and the identity of the person or entity which made the use or which made and received the offer, or the person or entity which made the information known or

to whom it was made known; (4) pre-AIA 35 U.S.C. § 102(f) prior art by the name of the person(s) from whom and the circumstances under which the invention or any part of it was derived; and (5) pre-AIA 35 U.S.C. § 102(g) prior art by the identities of the person(s) or entities involved in and the circumstances surrounding the making of the invention before the patent applicant(s), based on currently available information.

Defendant's identification of patents and publications as prior art herein and in the attached claim charts includes the publications themselves as well as the use of the products and systems described therein. Defendant's investigation continues, but information available to date indicates that such products and systems were (1) known or used in the country before the alleged invention(s) of the claimed subject matter of the asserted claims, (2) were in public use and/or on sale in this country more than one year before the filing date of the patent, and/or (3) were invented by another who did not abandon, suppress, or conceal, before the alleged invention(s) of the claimed subject matter of the asserted claim. Upon information and belief, these prior art products and systems and their associated references anticipate and/or render obvious each of the asserted claims.

Defendant further intends to rely on inventor admissions concerning the scope of the prior art relevant to the Patents-in-Suit found in, *inter alia*: the patent prosecution histories for the Patents-in-Suit and related patents, patent applications, and/or re-examinations; any deposition testimony of the named inventors on the Patents-in-Suit; and the papers and any evidence submitted by Plaintiffs in these actions.

A. Prior Art Patents

Defendant identifies the following prior art patents as anticipating or rendering obvious, either alone or in combination with one or more other prior art references, one or more asserted claims of the Patents-in-Suit under pre-AIA 35 U.S.C. §§ 102(a), (b), and/or (e)/

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