

**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**

TABLE OF CONTENTS

I.	PRELIMINARY STATEMENT	1
II.	FACTUAL BACKGROUND.....	1
A.	Plaintiffs belatedly produced their own prior art information only after the Court's order	2
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	2
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.....	3
III.	APPLICABLE LAW	4
IV.	GOOD CAUSE SUPPORTS TIANMA MICROELECTRONICS' SUPPLEMENTAL CONTENTIONS WITH COMBINATIONS BASED ON PLAINTIFFS' BELATED PRODUCTION OF THEIR OWN PRIOR ART PRODUCTS.....	4
A.	After this Court ordered Plaintiffs to produce their own prior art products, Tianma Microelectronics sought to supplement its contentions as quickly as practicable	5
B.	The supplemental contentions are important to Tianma Microelectronics' counterclaims and defenses because Plaintiffs' own prior products threaten to invalidate seven of their asserted patents.....	7
C.	Plaintiffs suffer no prejudice because they are familiar with their own products and had knowledge of each of the cited references for months	9
D.	Any prejudice could be addressed by reurging the parties' joint request for a continuance	11
V.	CONCLUSION.....	11



I. PRELIMINARY STATEMENT

Defendant Tianma Microelectronics Co. Ltd. (“Tianma Microelectronics”) seeks leave of this Court to amend its invalidity contentions to address the prior use products Plaintiffs were ordered to produce at the June 21 hearing (Dkt. No. 95 at 2), and to address prior art that Plaintiffs have been aware of since at least June 21.¹ Plaintiffs do not oppose this motion to the extent the supplemental contentions only address their prior art products. Plaintiffs, however, oppose this motion to the extent the supplemental contentions based on Plaintiffs’ prior art products as modified by certain printed publications raised in *Inter Partes* Review (IPR) petitions that Tianma Microelectronics filed in June. The “good cause” standard does not allow Plaintiffs to dictate, after delaying production of prior art information solely in their possession, how Tianma Microelectronics may use that information to attack their asserted patents. As explained herein, all four “good cause” factors support granting leave to supplement and this motion should be granted.

II. FACTUAL BACKGROUND

Plaintiffs sued Tianma Microelectronics in 2020, asserting infringement of 135 claims from 15 patents, in three now-consolidated cases. On March 3, 2021, Tianma Microelectronics served its Preliminary Invalidity Contentions and identified a number of products of Plaintiffs or their predecessors, which are believed to be prior art because they were sold prior to the priority dates of the asserted patent(s). The limited public information, however, did not provide sufficient technical details for Tianma Microelectronics to chart Plaintiffs’ prior art products or raise invalidity arguments based on those products. Defendant also put Plaintiffs on notice that it

¹ On September 3, 2021, the court denied the remainder of Tianma Microelectronics’s motion regarding production of Plaintiffs’ “similar” prior art products. (Dkt. No. 122 at 3.) Thus, Tianma Microelectronics understands Plaintiff’s technical production of prior art products to now be complete.

incorporates by reference all IPR proceedings at the USPTO related to any of the asserted patents. *See* Ex. A², 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.³ 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

² Exhibits refer to those identified in the attached declaration of Aidan C. Skoyles.

³ 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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