

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.; AND
SAMSUNG. ELECTRONICS AMERICA, INC.,
Petitioners,

v.

SOLAS OLED, LTD.,
Patent Owner

Case IPR2021-01254
U.S. Patent No. 8,526,767

PATENT OWNER PRELIMINARY RESPONSE

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PATENT OWNER'S EXHIBIT LIST

Ex.	Description
2001	Complaint, <i>Solas OLED Ltd. v. Samsung Electronics Co., Ltd. et al.</i> , Case No. 2:21-cv-00105-JRG (“EDTex case”) Dkt. 1, (Mar. 22, 2021)
2002	Amended Complaint, EDTex case, Dkt. 11 (Apr. 16, 2021)
2003	Docket Control Order, EDTex case, Dkt. 45 (Aug. 16, 2021)
2004	Amended Complaint, <i>Samsung Electronics Co., Ltd. et al. v. Solas OLED Ltd. et al.</i> , Case No. 1:21-cv-05205-LGS (“SDNY case”), Dkt. 35 (S.D.N.Y. Aug. 23, 2021)
2005	Order Denying Stay Pending IPR, <i>Solas OLED Ltd. v. Samsung Display Co. et al.</i> , No. 2:19-CV-00152-JRG, Dkt. 133, 2020 WL 4040716, at *1 (July 17, 2020)
2006	Scheduling Order, SDNY case, Dkt. 44 (Sept. 2, 2021)
2007	Tiffany Hu, <i>Gilstrap Holds Top Spot for Pandemic-Era Jury Patent Trials</i> , LAW360 INTELLECTUAL PROPERTY (Oct. 26, 2021), available online at https://www.law360.com/articles/1434133/gilstrap-holds-top-spot-for-pandemic-era-jury-patent-trials
2008	Joint Claim Construction and Prehearing Statement, EDTex case, Dkt. 62 (Oct. 23, 2021).
2009	Preliminary Infringement Contentions and Claim Chart, EDTex case, (July 12, 2021)
2010	Invalidity Contentions Cover Pleading, EDTex case (Sept. 24, 2021)
2011	Invalidity Claim Chart for Baltierra, EDTex case
2012	Invalidity Claim Chart for Katou, EDTex case
2013	Invalidity Claim Chart for Warren, EDTex case
2014	Invalidity Claim Chart for Westerman, EDTex case

One of the primary objectives of the AIA was “to provide an effective and efficient *alternative* to district court litigation.” But this IPR cannot be an alternative (much less an effective and efficient one) to a trial in the Eastern District of Texas between Petitioners and Patent Owner involving U.S. Patent No. 8,526,767 (“’767 patent”), which is scheduled to be completed *eight months* before the FWD deadline. The parties have already invested significant resources in that case and at the time of the institution decision, the parties in the EDTex will have completed fact discovery and exchanged expert reports. Further, the EDTex case and scheduled trial will involve the same claim construction standard, same invalidity theories, and same prior art references and combinations that are at issue in this IPR.

Under the PTAB’s precedential orders in *NHK Spring* and *Fintiv*, the Board should exercise its discretion to deny institution under § 314(a).

I. ALL *FINTIV* FACTORS WEIGH AGAINST INSTITUTION

35 U.S.C. § 314(a) gives the Board discretion to deny institution because of because of the advanced state of parallel proceedings on the same patent. *See NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019) (“*NHK Spring*”). The PTAB recently promulgated six factors for determining whether discretionary denial due to the advanced state of parallel proceedings is appropriate (the “*Fintiv* factors”):

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Apple Inc., v. Fintiv, Inc., IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential, designated May 5, 2020) ("*Fintiv Order*") at 6; *Apple Inc., v. Fintiv, Inc.*, IPR2020-00019, Paper 15 (PTAB May 13, 2020) (order denying institution) ("*Fintiv ID*") at 7–8. Here, all six *Fintiv* factors weigh against institution.

A. Factor 1 weighs against institution, as no court has granted a stay and no evidence exists that a stay may be granted.

Factor 1 concerns whether the court in a related proceeding has granted a stay or evidence exists that one may be granted if a proceeding is instituted. *Fintiv Order* at 6; *Fintiv ID* at 12. This factor weighs against institution.

The '767 patent is at issue in the following Eastern District of Texas case before Judge Gilstrap, where the '767 patent is the only asserted patent: *Solas OLED*

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