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'S PRELIMINARY RESPONSE SUR-REPLY

PATENT OWNER'S EXHIBIT LIST

Ex.	Description
2001	Complaint, *Solas OLED Ltd. v. Samsung Electronics Co., Ltd. et al.*, 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, *Samsung Electronics Co., Ltd. et al. v. Solas OLED Ltd. et al.*, Case No. 1:21-cv-05205-LGS ("SDNY case"), Dkt. 35 (S.D.N.Y. Aug. 23, 2021)
2005	Order Denying Stay Pending IPR, *Solas OLED Ltd. v. Samsung Display Co. et al.*, 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, *Gilstrap Holds Top Spot for Pandemic-Era Jury Patent Trials*, 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

The '767 patent is the only patent asserted in the EDTex case, which is scheduled for trial eight months before the IPR FWD deadline. In these circumstances, having the same parties litigate invalidity of the same patent in a separate IPR after trial is what the *Fintiv* factors were designed to prevent. It would create the risk of duplicative work and conflicting decisions, as well as be an inefficient use the Board's finite resources. Institution should be denied.

***Fintiv* Factor 1**: As Patent Owner explained, Judge Gilstrap has not granted a stay and no evidence exists that one will be granted. POPR at 2–5. Petitioners offer no evidence in reply; they don't even state they *intend* to move for a stay. Nor do Petitioners dispute that Judge Gilstrap is unlikely to stay pending IPR based on the specific facts and timing of the EDTex case. *Id.* at 4–5. Petitioners' merely assert that "Judge Gilstrap has stayed trials pending ex parte reexamination." Reply at 1. This is no evidence at all. Factor 1 weighs against institution.

***Fintiv* Factors 2 & 5**: Petitioners don't dispute that the parties are the same as the EDTex case, so Factor 5 weighs against institution. As to Factor 2, Petitioners concede that the EDTex trial date (eight months before the FWD deadline) "would weigh against institution." *Id.* at 2. But Petitioners try to cast doubt on Judge Gilstrap's trial schedule, primarily relying on inapposite and unreliable evidence.

Sen. Tillis's letter was not about Judge Gilstrap but rather focused on Judge Albright and the allegedly "inaccurate trial dates set by the Waco Division." Ex.

1039 at 1, 3. And the blog post (Ex. 1040) surveyed nationwide *Fintiv* denials between May–Oct. 2020, in the midst of COVID-19 concerns and court closures. Still, excluding terminated cases, it found that 72% (26 of 36) of trials did occur within six months of the predicted date, even during the pandemic. *Id.* at 2–3.

The issue here is whether the EDTex trial is likely to be postponed. It is not. Judge Gilstrap conducted *16 jury trials* from Aug. 2020–Sept. 2021, which is strong evidence that the EDTex case will go to trial in May 2022 or shortly thereafter. Ex. 2007. And even if trial were delayed by three months, it would still occur five months before the FWD deadline. Factor 2 weighs strongly against institution.

***Fintiv* Factor 3**: The entire EDTex case is devoted to the '767 patent and the parties will complete claim construction, fact discovery, and opening expert reports by Jan. 12, 2022—weeks before the institution deadline. Petitioners ask the Board to ignore these investments because they were reasonably diligent in filing this IPR. This is unsupported and contrary to how the Board has applied the *Fintiv* factors. Two recent Board decisions are particularly instructive.

In *Regeneron Pharm., Inc., v. Novartis Pharma AG, et al.*, the petitioner filed its petition less than a month after the ITC complaint was filed and before ITC proceedings were instituted. IPR2020-01317, Paper 15 at 14 (PTAB Jan. 15, 2021). Nevertheless, the Board gave petitioner's diligence no weight under Factor 2 and only limited weight under Factor 3. *Id.* at 15, 17. Despite petitioner's greater

diligence compared to Samsung's here (one month after complaint compared to four months after), the Board found that Factor 3 "weighs somewhat" against institution.[1]

In *Philip Morris Prods., S.A. v. RAI Strategic Holdings, Inc.*, the petitioner exercised "exceptional" diligence in filing an IPR less than a month after the district court complaint. IPR2020-00921, Paper 9 at 17–18 (PTAB Nov. 16, 2020). And because the parties' district court investments were modest (not yet exchanging invalidity contentions), the Board found that Factor 3 weighed in favor of institution. *Id.* Further, unlike here, the Board found that the petition was "particularly strong" and so Factor 6 also weighed in favor of institution. *Id.* at 26–27.

Nevertheless, the Board ultimately denied institution under the *Fintiv* factors, giving particular weight to the trial date set for eight to nine months before the FWD deadline. *Id.* at 28–29. The Board found that Factor 2 outweighed other several factors that favored institution, including petitioner's diligence in filing the petition and the strength of the petition on the merits. *Id.* The same outcome applies here, except that most of the *Fintiv* factors here present a stronger case for discretionary denial than the factors did in *Philip Morris*.

[1] *Id.* at 17 ("We acknowledge Petitioner's diligence in bringing this IPR proceeding, but the investment by the parties and the ITC in the parallel proceeding outweighs the effort expended so far in this proceeding. . . . [T]he parties, the ALJ, and the staff of the ITC have expended considerable resources to date on the ITC investigation, in the form of addressing claim construction, completing substantial fact discovery, and preparing for expert reports and discovery.").

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