

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner

v.

LED WAFER SOLUTIONS LLC.,
Patent Owner

Case IPR2021-01554
Patent No. 9,502,612

**PETITIONER'S REPLY
TO PATENT OWNER'S PRELIMINARY RESPONSE**

LIST OF EXHIBITS

Ex. No.	Description	Previously Submitted
Ex. 1001	U.S. Patent No. 9,502,612	X
Ex. 1002	Declaration of R. Jacob Baker, Ph.D., P.E.	X
Ex. 1003	Curriculum Vitae of R. Jacob Baker, Ph.D., P.E.	X
Ex. 1004	Prosecution History of U.S. Patent No. 9,502,612	X
Ex. 1005	U.S. Patent Publication No. 2003/0232455 to Tanaka	X
Ex. 1006	U.S. Patent No. 7,233,028 to Weeks et al.	X
Ex. 1007	U.S. Patent Publication No. 2007/0284602A1 to Chitnis et al.	X
Ex. 1008	U.S. Patent No. 7,419,839 to Camras et al.	X
Ex. 1009	U.S. Patent No. 6,020,602 to Sugawara et al.	X
Ex. 1010	U.S. Patent No. 7,928,317 to Atanackovic	X
Ex. 1011	U.S. Patent No. 7,224,013 to Herner et al.	
Ex. 1012	U.S. Patent No. 7,371,676 to Hembree	X
Ex. 1013	U.S. Patent No. 6,676,287 to Mathis et al.	X
Ex. 1014	Tritt, <u>Thermal Conductivity: Theory, Properties, and Applications</u> , 2004	X
Ex. 1015	Kane, Processing and Characterization of Benzocyclobutene Optical Waveguides, IEEE Transactions on Components, Packaging, and Manufacturing Technology, Part B, Vol. 18, No. 3, pp. 565-571, August 1995	X

Ex. 1016	Kane, Benzocyclobutene Optical Waveguides, IEEE Photonics Technology Letters, Vol. 7, No. 5, pp. 535-537, May 1995	X
Ex. 1017	Schubert, <u>Light Emitting Diodes, Second Edition</u> , 2006 (“Schubert”)	X
Ex. 10181	<i>LED Wafer Solutions LLC’s Infringement Contentions</i> regarding U.S. Patent No. 9,502,612 with respect to Samsung Galaxy S6 (August 13, 2021)	X
Ex. 1019	<i>LED Wafer Solutions LLC’s Infringement Contentions</i> regarding U.S. Patent No. 9,502,612 with respect to Samsung Galaxy S7 (August 13, 2021)	X
Ex. 1020	<i>LED Wafer Solutions LLC’s Infringement Contentions</i> regarding U.S. Patent No. 9,502,612 with respect to Samsung Galaxy S8 (August 13, 2021)	X
Ex. 1021	Complaint (Dkt. #1) in <i>LED Wafer Solutions LLC v. Samsung Electronics Co., Ltd. et al.</i> , 6-21-cv-00292 (W.D. Tex. Mar. 25, 2021)	X
Ex. 1022	Judge Albright’s (W.D. Tex.) “Order Governing Proceedings - Patent Cases 062421.pdf” available at https://www.txwd.uscourts.gov/judges-information/standing-orders/	X
Ex. 1023	RESERVED	
Ex. 1024	Motion for Inter-District Transfer to the Northern District of California, <i>LED Wafer Solutions LLC v. Samsung Electronics Co., LTD.</i> , 6:21-cv-292-ADA, D.I. 40, 41 (November 16, 2021)	
Ex. 1025	Judge Albright’s (W.D. Tex.) “Second Amended Standing Order Regarding Motions for Inter-District Transfer” (August 18, 2021)	

Ex. 1026	Led Wafer's First Request for Production Relating to Venue to Samsung (December 7, 2021)	
Ex. 1027	Judge Albright's (W.D. Tex.) "Amended Standing Order Regarding Venue and Jurisdictional Discovery Limits For Patent Cases" (June 8, 2021)	
Ex. 1028	Westlaw Analytics Statistics regarding Motion to Transfer Pendency for Judge Albright (retrieved January 22, 2022)	
Ex. 1029	Docket Navigator Analytics Statistics regarding Motion Pendency for Judge Albright (retrieved January 22, 2022)	
Ex. 1030	District Court Email Requesting Further Amended Scheduling Order (February 9, 2022)	
Ex. 1031	Joint Motion for Entry of Agreed Third Amended Scheduling Order, <i>LED Wafer Solutions LLC v. Samsung Electronics Co., LTD.</i> , 6:21-cv-292-ADA, D.I. 56 (February 11, 2022)	

I. THE *FINTIV* FACTORS FAVOR INSTITUTION

While the *Fintiv* factors favor institution for the reasons stated previously (Pet., 73-76), developments in the district court further support institution. There is an extremely high likelihood that the current trial schedule (Ex. 2012) will **not** hold, and the final written decision will issue **before** trial completion. For example, contrary to PO's suggestions (POPR, 2, 15-24), the dates for *Markman* (March 3, 2022) and trial (February 16, 2023) in the current schedule are unlikely to hold.

Samsung filed a Motion for Inter-District Transfer to the Northern District of California ("Transfer Motion") on November 26, 2021 (Ex. 1024). Under the district court's second amended standing order regarding motions for inter-district transfer, a *Markman* hearing will not be conducted until after a ruling on the Transfer Motion. (Ex. 1025.) But that ruling will not issue any time soon. PO has not yet opposed the Transfer Motion and has served venue discovery requests. (Ex. 1026.) Based on the Transfer Motion's filing date and pursuant to the Court's amended standing order regarding venue and jurisdictional discovery limits for patent cases (Ex. 1027), venue discovery must be completed by February 28, 2022. PO's response to Samsung's Transfer Motion is due by March 14, 2022, and Samsung's reply is due March 28, 2022 (*id.*), which is **after** the current *Markman* hearing date. Indeed, on February 9, 2022, the district court "request[ed] the parties meet and confer to produce a new amended scheduling order that sets the *Markman* hearing

for April 15, 2022” in view of the pending Motion for Inter-District Transfer. (Ex. 1030.)

However, even the proposed April 15th *Markman* hearing date is uncertain. For example, according to Westlaw Analytics, 62% of Judge Albright’s rulings on transfer motions came within 54 to 230 days of the motions’ filing, with the median time to rule being 159 days. (Ex. 1028; *see also* Ex. 1029 (Docket Navigator statistics showing similar timing for transfer motion rulings).)

Thus, it is reasonably likely that a *Markman* hearing will not be held until after approximately 159 days (*i.e.*, more than five months) from the date of the Transfer Motion’s filing (*i.e.*, May 4, 2022) or even as late as 230 days (*i.e.*, more than seven months) from the Transfer Motion’s filing (*i.e.*, July 14, 2022). In the event the Transfer Motion is not granted, the delay in resolution of claim construction will inevitably push back the trial date (currently February 16, 2023). Moreover, given civil trials “may possibly slip [due to] months of backlogged trials, including many active criminal cases that would take precedence over civil trials,” *HP Inc. v. Slingshot Printing LLC*, IPR2020-01085, Paper 12 at 7 (Jan. 14, 2021), it is highly unlikely that the currently scheduled trial date will hold. In view of the foregoing, the **second** (proximity of trial dates) and **third** (investment in parallel proceedings)¹

¹ Fact discovery will not open until March 4, 2022. (Ex. 1030.)

Fintiv factors weigh in favor of institution. (*See also* Pet., 74-75.)

Samsung’s diligence in filing its petition within six weeks after receiving PO’s preliminary infringement contentions on August 13, 2021 and less than six months from the complaint (Ex. 1021) is also a “countervailing consideration” to any investment in the district court proceedings and weighs against exercising discretion. *Tianma Microelectronics Co. Ltd. v. Japan Display Inc.*, IPR2021-01028, Paper 14 at 9-11 (December 14, 2021) (instituting IPR when “[FWD] would issue approximately ten months after the start of trial” and IPR was filed within five months of receiving infringement contentions); *see also Coolit Systems, Inc. v. Asetek Danmark A/S*, IPR2021-01195, Paper 10 at 11-12 (Dec. 28, 2021).²

With respect to the **fourth** factor (overlap), PO incorrectly states that “the district court will address the same issues, arguments and evidence months before the Board’s final decision would be due [and so] instituting review here would not be an efficient use of the Board’s resources.” (POPR, 24.) PO seems to misunderstand Petitioner’s stipulation—Petitioner has stipulated that, if the IPR is instituted, Petitioner will not pursue the IPR grounds in the district court litigation.

² Indeed, PO’s final infringement contentions are not due until April 12, 2022 and the parties recently agreed to move the deadline for final infringement/invalidity contentions to June 10, 2022. (Ex. 1031, 5.)

(Pet., 75.) That is, Petitioner’s stipulation is contingent upon institution of review, not issuance of the final written decision. The Board has routinely found this type of stipulation to favor institution. *See Sand Revolution II, LLC v. Continental Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 at 12 (June 16, 2020) (informative) (finding the fourth factor weighs in favor of institution due, in part, to petitioner’s stipulation that it will not pursue the same grounds in district court and instituting IPR); *Coolit Systems, Inc.*, IPR2021-01195, Paper 10 at 12-13 (same); *Siemens Industry Software Inc., v. Synopsys, Inc.*, IPR2021-01212, Paper 11 at 15-17 (January 13, 2022) (same); *Becton Dickinson and Co. v. Sage Products, LLC*, IPR2021-01201, Paper 7 at 14-16 (January 11, 2022) (same). PO also fails to address Petitioner’s argument that this IPR challenges claims not-at-issue in the litigation. (Pet., 75.)³ Thus, this factor favors institution.

The **first** factor (stay) also favors institution for the reasons previously explained. (Pet., 74.) Indeed, Judge Albright recently granted a motion to stay in another case after the Board instituted an IPR, even though that case was in the

³ Whether the additional claim (i.e., claim 8) depends from an asserted claim or is a separate independent claim is irrelevant to this analysis. Nothing in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 12 (Mar. 20, 2020) (precedential) compels a different result.

“advanced stage” of having held the *Markman* hearing six months earlier and on the eve of the close of discovery. *Kirsch Rsch. & Dev., LLC v. IKO Indus., Inc.*, No. 6:20-CV-00317-ADA, 2021 WL 4555610, at *1 (W.D. Tex. Oct. 5, 2021).

With respect to the **sixth** factor (other circumstances), PO fails to sufficiently address Petitioner’s arguments regarding the undeniable similarity between Petitioner’s references and the ’612 patent. (*See also* Pet., 76.) For example, PO asserts that the “Petition fails on the merits for numerous reasons.” (POPR, 76.) But PO provides no expert testimony to support its attorney arguments regarding the purported deficiencies in Samsung’s analysis. (*See generally id.*) PO’s assertions are merely unsupported attorney argument.

Accordingly, Petitioner respectfully requests that the Board decline to exercise its discretion to deny institution, and instead institute review.

Respectfully submitted,

Dated: February 11, 2022

By: Naveen Modi/

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CERTIFICATE OF SERVICE

I hereby certify that on February 11, 2022, I caused a true and correct copy of the foregoing Petitioner's Reply to Patent Owner's Preliminary Response to be served electronically on counsel for Patent Owner at the following addresses:

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