

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG DISPLAY CO., LTD.,
Petitioner,

v.

PICTIVA DISPLAYS INTERNATIONAL LTD.,
Patent Owner.

IPR2024-00855
Patent 8,314,547 B2

Before GRACE KARAFFA OBERMANN, GARTH D. BAER,
and MICHAEL G. McMANUS, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

I. INTRODUCTION

Petitioner¹ filed a Petition to institute an *inter partes* review of claims 1–5 and 8–14 of U.S. Patent 8,314,547 B2 (Ex. 1001, “the ’547 patent”). Paper 1 (“Pet.”). Patent Owner² filed a Preliminary Response to the Petition. Paper 7 (“Prelim. Resp.”).

With Board preauthorization, Petitioner filed a Reply (Paper 8), Patent Owner filed a Sur-reply (Paper 9), Patent Owner filed a Supplemental Brief (Paper 10, “Supp. Br.”), and Petitioner filed an Opposition to Patent Owner’s Supplemental Brief (Paper 11, “Opp. Supp. Br.”). *See* Exs. 3001, 3002 (emails authorizing additional briefing).

We have authority to institute an *inter partes* review where a petitioner shows a reasonable likelihood of prevailing with respect to at least one challenged claim. 35 U.S.C. § 314(a); 37 C.F.R. § 42.4(a). Under appropriate circumstances, however, we may exercise our discretion under Section 314(a) and deny review without regard to whether the petitioner has met that threshold. Trial Practice Guide,³ 64; *see* 84 Fed. Reg. 64,280 (Nov. 21, 2019).

For reasons that follow, we exercise our discretion under Section 314(a) and do not institute an *inter partes* review.

¹ Petitioner identifies Samsung Display Co., Ltd., Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. as real parties-in-interest. Pet. 1.

² Patent Owner identifies Pictiva Displays International Limited, “a subsidiary of Key Patent Innovations Limited,” as “the owner” of the ’547 patent. Paper 5, 1.

³ PTAB Consolidated Trial Practice Guide (Nov. 2019), *available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

II. BACKGROUND

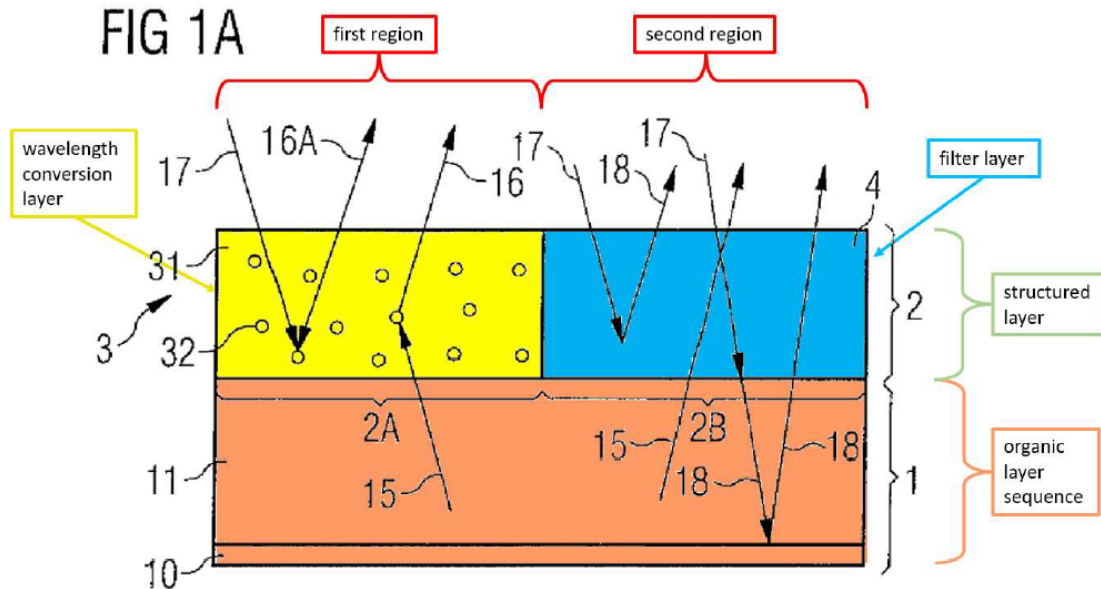
A. Related Proceedings

The parties identify *Pictiva Displays Int'l Ltd. v. Samsung Electronics Co., Ltd.*, No. 2:23-cv-00495 (E.D. Tex.) (“the District Court action”) as a related proceeding. Pet. 1; Paper 5, 1.

B. The '547 Patent (Ex. 1001)

The '547 patent relates to an optoelectrical device, such as a flashlight component, having “a desired color impression in the switched-off state.” Ex. 1001, 1:13–15; *see id.* at 14:31–36. The specification indicates that a white color impression is desirable, whereas a yellow color impression is undesirable. *Id.* at 3:40–45, 4:16–27.

We reproduce below an exemplary embodiment as illustrated in Petitioner’s annotated Figure 1A.

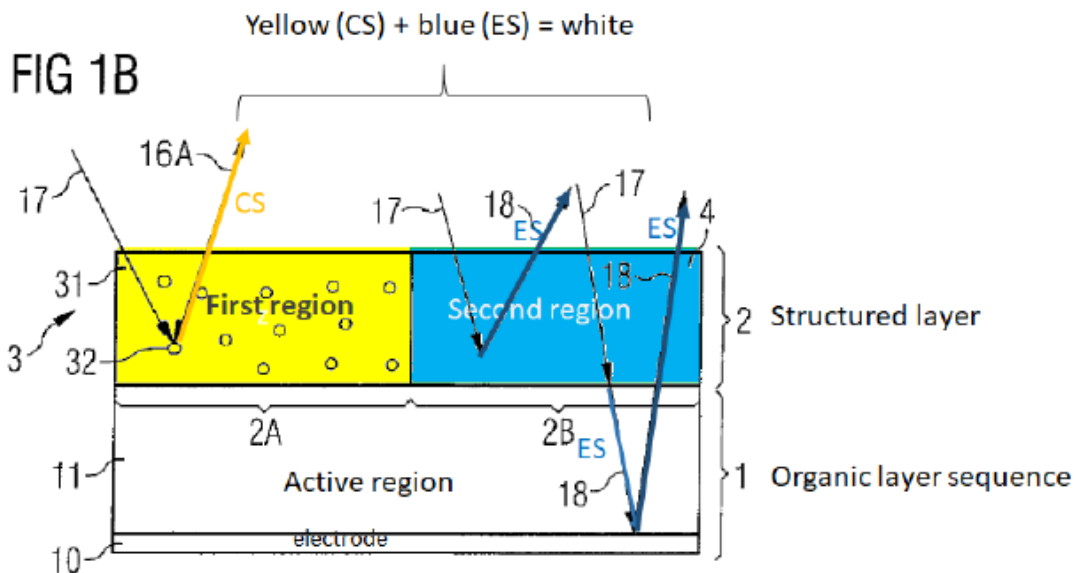


Pet. 5. Figure 1A illustrates an exemplary optoelectronic device during operation (that is, in the switched-on state). Ex. 1001, 9:39–41. Petitioner annotates Figure 1A to shade in orange an organic layer sequence, in yellow

a first region (including a wavelength conversion layer), and in blue a second region (including a filter layer).

In this switched-on state, the organic layer sequence emits first wavelength 15 (for example, blue light), which is converted to second wavelength 16 (for example, yellow light) by the wavelength conversion layer in the first region. Notably, in this embodiment, even when the device is switched-off, the wavelength conversion layer of the first region converts incident radiation 17 into a yellow wavelength spectrum (denoted 16A in Figure 1B), and the filter layer in the second region converts incident radiation 17 into a blue wavelength spectrum (denoted 18 in Figure 1B).

We reproduce below Patent Owner's annotated Figure 1B, which illustrates that result in the switched-off state.



Prelim. Resp. 7. Figure 1B illustrates an exemplary optoelectronic device in the switched-off state. Ex. 1001, 9:39–41. Patent Owner's annotations illustrate how the first and second regions work together to produce a desirable white color impression, consisting mostly of complementary yellow and blue radiation, even in the switched-off state.

A desirable color impression is accomplished, whether the device is switched-on or switched-off, by an architecture having first and second regions located downstream of an active region (denoted the organic layer sequence in Figures 1A and 1B). As shown in these figures, that architecture includes a filter layer in the second region that is *transparent* to first wavelength spectrum 15 or 18 (which are the same, and may be blue) but *opaque* to second wavelength spectrum 16 or 16 A (which may be yellow). *See* Pet. 4–6 (explaining this aspect of the claimed invention).

The complementary combination of wavelength spectrum 16 or 16A (yellow) and wavelength spectrum 15 or 18 (blue) conveys a desirable white color impression, regardless of whether the device is switched-on or switched-off. *See id.*; Prelim. Resp. 6–7.

C. Challenged Claims

Claims 1–5 and 8–14 of the '547 patent are at issue in this proceeding. Pet. 2. We reproduce below claim 1, the sole independent challenged claim.

1. An optoelectronic device, comprising:

an organic layer sequence which emits an electromagnetic radiation having a first wavelength spectrum during operation;
and

a structured layer disposed downstream of the organic layer sequence in a beam path of the electromagnetic radiation emitted by the organic layer sequence and including first and second regions;

wherein the first regions each include a wavelength conversion layer configured to convert at least partially electromagnetic radiation having a first wavelength spectrum into an electromagnetic radiation having a second wavelength spectrum;

wherein the second regions each include a filter layer which is at least partially opaque to an electromagnetic radiation having

a third wavelength spectrum which corresponds to at least one part of the second wavelength spectrum;

wherein the first and second regions of the structured layer are arranged laterally in a beam path of the optoelectronic device; and

wherein *the filter layer is transparent to the electromagnetic radiation having the first wavelength spectrum.*

Ex. 1001, 14:55–15:11 (Board’s emphasis).

We refer to the first highlighted term as “the first wavelength spectrum limitation” and the second highlighted term as “the filter transparency limitation.” Each of the other challenged claims inherit those limitations through direct or indirect dependence on claim 1.

D. Asserted Challenges to Patentability

The Petition sets forth the following challenges to patentability.

Claim(s) Challenged	35 U.S.C. §⁴	Reference(s)/Basis
1–5, 8–11, 13	103(a)	Igarashi, ⁵
12	103(a)	Igarashi, Pilcher ⁶
14	103(a)	Igarashi, Dresevic ⁷
1–5, 8–10, 13	103(a)	Shiotani ⁸
11, 12	103(a)	Shiotani, Pilcher
14	103(a)	Shiotani, Dresevic

⁴ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. § 103 effective March 16, 2013. Because the ’547 patent’s priority date is before the AIA’s amendments to Section 103, this decision refers to the pre-AIA statutory provision. Neither party indicates the result would change under the AIA version.

⁵ US 2007/0023734 A1, filed July 27, 2006, published Feb. 1, 2007 (Ex. 1004).

⁶ US 6,949,389 B2, filed May 2, 2022, issued Sept. 27, 2005 (Ex. 1006).

⁷ US 6,624,828 B1, filed July 30, 1999, issued Sept. 23, 2003 (Ex. 1007).

⁸ JP H10-170918, filed Dec. 6, 1996, published Jan. 26, 1998 (Ex. 1005) (certified English translation).

Petitioner advances the Declaration of J. Gary Eden, Ph.D. (Ex. 1003) (corrected). Patent Owner advances the Declaration of Kirk S. Schanze, Ph.D. (Ex. 2010).

III. DISCRETIONARY DENIAL UNDER 35 U.S.C. § 314(A)

The parties disagree about whether the factors identified in *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”), weigh in favor of denial in view of the District Court action.⁹ Pet. 79–80; Reply 4–5; Prelim. Resp. 90–92; Sur-reply 5.

We consider the following factors to assess “whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.”

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.

Fintiv, Paper 11 at 5–6.

⁹ See *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* at 9 (June 21, 2022) (“Director’s Interim Procedure”) https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf.

1. First Factor - Whether a Stay Exists or Is Likely to Be Granted if a Proceeding Is Instituted

Petitioner does not address this factor. Pet. 8.

Patent Owner argues that no stay of the District Court action has been requested and, in any event, such a request would likely be denied, given the District Court's demonstrated practice of denying requests to stay based on administrative proceedings in our forum. Prelim. Resp. 91.

We decline to speculate about how the District Court might rule on a motion that has not been filed. On this record, the first factor is neutral.

2. Second Factor - Proximity of the Court's Trial Date to the Board's Projected Statutory Deadline

The District Court action is scheduled for trial on August 4, 2025. Pet. 79 (citing Ex. 1029); Prelim. Resp. 91. We agree with Patent Owner that, on the current record, the trial in the District Court action is scheduled to take place "more than three months before the projected statutory deadline" for entry of any final written decision in this proceeding. *Id.*

We also agree with Patent Owner that the August 4, 2025, trial date is consistent with the District Court's median time-to-trial, which Patent Owner states is 21.6 months. *Id.* (citing Ex. 2025, 35); *see Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* (USPTO June 21, 2022) ("Guidance Memo")¹⁰ at 8–9 ("Parties may present evidence regarding the most recent statistics on median time-to-trial for civil actions in the district court in which the parallel litigation resides for the PTAB's consideration.").

¹⁰ Available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf.

Petitioner counterargues that “there is significant uncertainty” that trial will commence on August 4, 2025, because two motions are pending before the District Court; specifically, Petitioner’s motion to dismiss based on lack of standing and Patent Owner’s motion to join an entity and file a replacement lawsuit. Reply 5. Patent Owner addresses only the first motion, arguing it “is based on outdated caselaw.” Sur-reply 5. Nonetheless, Petitioner’s arguments require the Board to speculate about how the District Court might resolve these pending motions or how these motions might delay trial. Petitioner’s arguments, therefore, fail to move the needle in favor of institution.

Accordingly, we agree with Patent Owner that this second factor favors denial based on the trial date set for the District Court action, as well as the District Court’s median time-to-trial data.

3. Third Factor - Investment in the Parallel Proceeding by the Court and Parties

Petitioner argues that the District Court action “remains in a very early stage” because “the parties have made no material investments in the parallel litigation. No discovery has taken place,” according to Petitioner, “beyond initial disclosures, and the claim construction process has not even begun.” Pet. 79. In Petitioner’s further view, it “acted with diligence” by filing the Petition “less than two months after service of infringement contentions” in the District Court action. *Id.*

Patent Owner counterargues that, “by the projected institution date, the parties would have filed their joint claim construction statement and have invested in claim construction discovery.” Prelim. Resp. 91. Petitioner responds that this as “not a material investment in the litigation.” Reply 4.

Patent Owner rejoins that it has “already filed multiple motions to compel” in the District Court action and has served “a deposition notice.” Sur-reply 5.

Petitioner has the better position regarding this *Fintiv* factor. We are directed to no substantive orders issued by the District Court, and the absence of concrete discovery activity beyond Patent Owner’s identification of a single “deposition notice” belies that there has been a substantial investment by the parties and the District Court in the parallel litigation. *Id.* Accordingly, we find the District Court action is in its early stages, Petitioner did not delay unduly in filing the Petition, and factor three weighs against exercising our discretion to deny the Petition.

4. Fourth Factor - Overlap Between Issues Raised in the Petition and in the Parallel Proceeding

Our assessment of this fourth factor is two-fold; we first assess whether the District Court action will resolve the same patent claims, then address whether the District Court action involves the same prior art.

Petitioner avers that “Patent Owner will need to narrow the asserted claims in advance of any trial” in the District Court action, but does not show on this record that this circumstance mitigates concern about duplicative efforts across the two proceedings. Pet. 79 (citing Ex. 1029, 1). To the contrary, Petitioner directs us to evidence that Patent Owner’s final election of claims is set to occur relatively far in the future; namely, 10 days prior to jury selection in a trial scheduled for August 4, 2025. Ex. 1029, 1. Consequently, up until about 10 days before August 4, 2024, the District Court action likely will proceed on the same patent claims at issue here.

Nor does the evidence cited by Petitioner indicate that the trial in the District Court action will be limited to any particular number of claims. *Id.* Thus, the evidence cited by Petitioner does not demonstrate adequately, if at

all, that Patent Owner could not possibly elect to pursue the same subset of claims in the District Court action that are at issue in our forum or, for that matter, that the trial in the District Court action could not possibly “resolve all of Petitioner’s claim challenges.” Pet. 79; Ex. 1029, 1; *see* Pet. 2 (stating challenges against only a subset of the ’547 patent claims).

In any event, we agree with Patent Owner that “there is significant overlap between” the issues raised in the District Court action and those raised here, because both proceedings involve the same prior art references and Petitioner “has not filed any stipulation regarding the use of the references that it has raised or could have reasonably raised in the district court.” Prelim. Resp. 91–92; Ex. 2026, 34. Even if the trial in the District Court action ultimately resolves fewer than all of the claims challenged in the Petition (and the record is not clear on that point), significant concerns about duplicative efforts persist because the same substantive issues related to the same prior art references are in contention in both forums.

In sum, the Petition is based on the same prior art references, presently asserted against the same patent claims, as the District Court action, raising the specter of significant overlap and duplication of efforts. Accordingly, factor four favors denial.

5. Fifth Factor - Whether the Petitioner and the Defendant in the Parallel Proceeding Are the Same Party

This factor takes into account whether Petitioner is the defendant in the District Court action. There is agreement that Petitioner’s real parties-in-interest are the defendants in the District Court action. Prelim. Resp. 92; Pet. 1. This factor favors denial. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A).

6. *Sixth Factor - Other Circumstances that Impact the Board's Exercise of Discretion, Including the Merits*

The sixth *Fintiv* factor takes into account other circumstances that may bear on our decision whether to exercise discretion to deny, such as whether the merits of the challenges are compelling. *Fintiv*, Paper 11 at 14–16. Board precedent provides that we should consider the compelling merits standard only if the first five *Fintiv* factors favor discretionary denial. *CommScope Techs. LLC. v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 at 4–5 (PTAB February 27, 2023) (precedential) (“*CommScope*”).

The second, fourth, and fifth *Fintiv* factors favor denial. The first factor is neutral, and the third weighs against denial. Under a holistic view of the first five *Fintiv* factors, we find that these factors, taken together, weigh in favor of denial; therefore, we assess compelling merits. *CommScope*, Paper 23 at 5 (where the Board’s analysis of the first five *Fintiv* factors favors denial, “the Board shall then assess compelling merits.”).

The “other considerations” relevant to this sixth *Fintiv* factor are not limited to compelling merits, however, and a party is free to raise additional “facts and circumstances” that “exist in their proceeding.” *Fintiv*, Paper 11 at 6, 16. As a matter distinct from the compelling merits analysis, Patent Owner asserts that discovery and timing issues related to a “swear-behind analysis” further favor denial under the sixth *Fintiv* factor. *Prelim. Resp.* 92. We address each of the “other considerations” raised by Patent Owner in turn below. *Fintiv*, Paper 11 at 6.

(a) *Compelling Merits*

Even where, as here, the first five *Fintiv* factors favor denial, “the PTAB will not deny institution based on *Fintiv* if there is compelling evidence of unpatentability.” Guidance Memo 5. The compelling merits

standard is met if “the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence.” Guidance Memo 4. A challenge can only meet this standard “if it is highly likely that the petitioner would prevail with respect to at least one challenged claim.” *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper 102 at 49 (PTAB Oct. 4, 2022) (precedential) (“*OpenSky*”).

Petitioner’s challenges do not meet the compelling merits standard because a genuinely-disputed issue surrounds the correct construction of the first wavelength spectrum limitation. That genuine dispute, in turn, casts doubt upon whether Petitioner “is highly likely” to prevail in showing that the filter transparency limitation would have been obvious over the asserted prior art references. *Id.*

1. The First Wavelength Spectrum Limitation

The first wavelength spectrum limitation of claim 1 is inherited by each of the other challenged claims. That limitation requires “an organic layer sequence which emits an electromagnetic radiation having a first wavelength spectrum during operation.” Ex. 1001, 14:56–57. Petitioner relies on Igarashi and Shiotani for this limitation. Pet. 16–17, 48–50.¹¹

Igarashi’s organic layer emits “visible light” having “a wavelength range of 380 to 780 nm,” which includes a “blue region having a wavelength range of 450 to 470 nm.” Ex. 1004 ¶ 88. The Petition nowhere refers to the

¹¹ Patent Owner advances evidence that Igarashi’s and Shiotani’s organic layers employ the same emitter material, designated as BCzVBi in DPvBi. Prelim. Resp. 81–82. That evidence is not contested on this preliminary record and is consistent with the disclosures of these references. Ex. 1004 ¶ 88; Ex. 1005, 5/12 (page numbers added by Petitioner)). Our analysis of the spectra emitted by Igarashi’s organic layer applies with equal force to those emitted by Shiotani’s organic layer.

entirety of the wavelength range emitted by Igarashi's organic layer; that is, "visible light" having "a wavelength range of 380 to 780 nm." *Id.*; *see generally* Pet. 11, 17, 20, 25. Instead, the Petition repeatedly directs the Board to the "blue region," subsumed within that visible light range, "having a wavelength range of 450 to 470 nm." Ex. 1004 ¶ 88; *see* Pet. 11.

We agree with Patent Owner that Petitioner advances an "implicit construction" under which the first wavelength spectrum limitation reads on a portion of the overall spectra emitted by an organic layer during operation. Pet. 17, 50; Prelim. Resp. 58. Petitioner identifies in Igarashi a "blue region" of emitted light, "having a wavelength of 450 to 470 nm," as the first wavelength spectrum, even though Igarashi discloses that the entire spectrum of radiation emitted by its organic layer has "a wavelength range of 380 to 780 nm (visible light range)." Ex. 1004 ¶ 88; *see* Pet. 17.¹²

Patent Owner also advances credible evidence that this limitation refers to the entirety of the wavelength spectrum emitted by an organic layer during operation. Prelim. Resp. 46–63. For support, Patent Owner directs us to disclosures in the '547 patent, which tend to show that "the 'first wavelength range' cannot be an arbitrary portion of the emission spectrum of the organic layer sequence that excludes substantial portions of emission."

¹² Petitioner states, "Patent Owner misrepresents Petitioner's arguments" by asserting that "Petitioner's 'apparent position' is that the claimed 'first wavelength spectrum' 'can mean just a portion of the entire emission spectrum.'" Opp. Supp. Br. 2. Petitioner further states, "Petitioner has never made any such claim." *Id.* Those statements are untenable. The Petition consistently and repeatedly maps the first wavelength spectrum of claim 1 to a "blue light" portion of the broader "visible light range" emitted by the prior art organic layers. Pet. 16–17, 23–25, 48–50, 57–59; Ex. 1004 ¶ 88.

Id. at 58 (quoting Ex. 1001, Fig. 1A, 10:36–42); *see* Ex. 1001, Fig. 2, 11:30–47 (further supporting Patent Owner’s arguments at Prelim. Resp. 59–60).

Patent Owner also advances evidence, consisting of a claim construction proposed by Petitioner’s real parties-in-interest in litigation involving the ’547 patent, that the first wavelength spectrum of claim 1 “corresponds to the *entire* wavelength spectrum of the electromagnetic radiation emitted by the organic layer sequence during operation.”¹³

Ex. 2053, 8 (Board’s emphasis); Supp. Br. 1. That construction corresponds to Patent Owner’s construction in this forum, and provides some extrinsic support that Patent Owner’s construction is not meritless.

That construction, moreover, cannot be reconciled with the manner in which Petitioner, in the Petition, maps the first wavelength spectrum of claim 1 to a *portion* of the entire wavelength spectrum emitted by the organic layer sequences in Igarashi and Shiotani. Pet. 16–17, 23–25, 48–50, 57–59; *see supra* at 14 n.11. Stated somewhat differently, Petitioner’s claim mapping in the Petition runs counter to its real party-in-interest’s averment that the first wavelength spectrum of claim 1 “corresponds to the *entire* wavelength spectrum of the electromagnetic radiation emitted by the organic layer sequence during operation.” Ex. 2053, 8 (Board’s emphasis).

On this record, we discern a genuinely-disputed issue surrounding the correct construction of the first wavelength spectrum limitation. Specifically, a question arises whether the first wavelength spectrum limitation can be

¹³ Neither party identifies the litigation involving Petitioner’s real parties-in-interest as related to this proceeding. Pet. 1; Paper 5, 1. That litigation, however, involves assertions of the ’547 patent claims against Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. Ex. 2053, 1, 8; *see* Pet. 1 (identifying those entities as Petitioner’s real parties-in-interest).

met by a *portion* of the radiation emitted by the organic layer (as argued by Petitioner); or instead, the first wavelength spectrum limitation refers to the *entirety* of the radiation emitted by the organic layer (as argued by Patent Owner). *Compare* Pet. 23–25, 57–58, *with* Prelim. Resp. 64–74.

To be clear, we need not and, therefore, do not resolve the correct construction of the first wavelength spectrum limitation. It is enough for us to observe, on this record, that a genuinely-disputed issue surrounds this issue of claim construction. As explained in the next section, that dispute casts doubt upon whether Petitioner shows sufficiently, for purposes of trial institution, that the prior art suggests the filter transparency limitation.

2. The Filter Transparency Limitation

The filter transparency limitation of claim 1 is inherited by each of the other challenged claims. That limitation requires a “filter layer” that “is transparent to the electromagnetic radiation having the first wavelength spectrum.” Ex. 1001, 15:9–10. Petitioner relies on Igarashi and Shiotani for this limitation. Pet. 23–25, 57–59.

Patent Owner directs us to credible evidence that the filter transparency limitation requires that the first wavelength spectrum must pass through the filter layer “in an unimpeded manner and substantially without any alteration of its spectral components.” Ex. 1001, 10:36–42; Prelim. Resp. 58. The challenges stated in the Petition, however, address only whether the filter layers of Igarashi and Shiotani are transparent to the “blue” portion of the broader spectra emitted by the organic layers. Pet. 17, 23–25, 57–59.

Patent Owner provides a detailed explanation of why neither Igarashi nor Shiotani meets the filter transparency limitation, because the organic

layers of both references emit significant radiation outside the blue wavelength spectrum—radiation that is blocked by the filter layers. Prelim. Resp. 2, 56–72, 81–83. That explanation is supported by a cogent analysis of the emitter material (BCzVBi in DPvBi) employed in the organic layers of the prior art.¹⁴ *Id.*; *see supra* at 13 n.10. Importantly, Patent Owner’s explanation is not conclusory, but is supported by citations to disclosures of the prior art, Dr. Schanze’s declaration, and background references. Prelim. Resp. 2, 56–72, 81–83.

3. Conclusions on Compelling Merits

Patent Owner directs us to credible evidence that (1) only a *portion* of the *entirety* of radiation emitted by the prior art organic layers passes through a filter layer unimpeded; that is, without alteration of its spectral components, and (2) claim 1 specifies that the *entirety* of the radiation emitted by the organic layer must do so in order to meet the challenge claims. *Compare* Pet. 23–25, 57–58, *with* Prelim. Resp. 64–74. Given that there are multiple material disputed issues and because Patent Owner’s arguments addressing those issues are supported by credible evidence, this case does not fall within the *Fintiv* “compelling merits” category.

¹⁴ Petitioner belatedly suggests that an ordinarily skilled artisan would have been prompted to replace the emitter material employed by the prior art (namely, BCzVBi in DPvBi) with a different, but undisclosed, emitter material having “no significant emission at wavelengths above 500 nm.” Opp. Supp. Br. 2 (citing Ex. 2010 ¶ 43); *see* Reply 3–4 (same). That argument is not presented in the Petition, much less supported in the Petition by a rationale to combine. *See* Pet. 16–17, 48–50 (mapping the organic layer sequence of claim 1 to the organic layer sequence of Igarashi or Shiotani, which both employ BCzVBi in DPvBi as the emitter material (Ex. 1004 ¶ 88; Ex. 1005, 5/12)).

(b) Swear-Behind Analysis

Patent Owner raises additional “facts and circumstance,” distinct from the compelling merits analysis, in support of its view that the sixth *Fintiv* factor favors denial. *Fintiv*, Paper 11 at 16. Specifically, Patent Owner argues that three of the grounds asserted in the Petition implicate a “swear-behind analysis” relevant to whether Igarashi qualifies as prior art. Prelim. Resp. 92. Patent Owner, on that point, submits that a trial in this forum will implicate the testimony of “inventors who are all based in Germany” and over whom “Patent Owner does not have access.” *Id.* Patent Owner argues that the District Court is better-equipped to secure international discovery from, and resolve arguments in connection with, these foreign witnesses, given the Board’s “compressed timeline” and briefing “word limit[s].” *Id.*

Petitioner disagrees, arguing that Igarashi qualifies as prior art as a matter of law; thereby implying that Patent Owner would not be entitled to any fact discovery to support its proposed swear-behind analysis during a trial phase in this proceeding. Reply 5 n. 1. We are not persuaded, however, that Petitioner’s view of the law is so unassailably correct that Patent Owner would be precluded, during a trial phase in this forum, from pursuing international discovery of the inventors or presenting a swear-behind analysis. *Id.*

In that regard, we observe that Patent Owner raises arguments, refuting Petitioner’s view of the applicable legal authority, which may be novel but are not definitively meritless on this record. *Compare* Prelim. Resp. 8–56; Sur-reply 1–2, *with* Reply 1–2 (the parties’ conflicting views of the applicable authority). Further, we agree with Patent Owner that the factual circumstances surrounding the swear-behind issue in this case is

“complicated.” Prelim. Resp. 92; *see id.* at 8–56 (factual background presented by Patent Owner).

The Board takes account of all relevant facts and circumstances raised by a party in support its positions under the sixth *Fintiv* factor. *Fintiv*, Paper 11 at 6, 16. Under the particular and unique circumstances presented on this record, we determine that the issues surrounding the prior art status of Igarashi may be better suited for resolution by the District Court, where live testimony is the norm. Any swear-behind analysis likely would turn on witness credibility, and live witness testimony may be a particularly effective tool for fleshing out those credibility issues, without the “compressed timeline” or “word limit” constraints applicable in our forum. Prelim. Resp. 92.

(c) Conclusions on the Sixth Fintiv Factor

The sixth *Fintiv* factor is a catch-all factor under which the Board takes account of “other circumstances” that may bear on a decision whether to exercise discretion and deny review under Section 314(a). *Fintiv*, Paper 11 at 6, 16. Patent Owner raises two circumstances for our consideration; namely, the facts pertaining to the “compelling merits” issue and a “complicated swear-behind analysis.” Prelim. Resp. 92. We agree with Patent Owner that the Petition does not present a case of “compelling merits” and, further, that a trial in this forum may involve a “complicated swear-behind analysis” better suited, on the facts presented, for resolution in the District Court action. *Id.* The sixth *Fintiv* factor favors denial.

7. Balancing the Fintiv Factors

No single *Fintiv* factor is determinative of whether we exercise our discretion to deny institution under Section 314(a). A majority of the *Fintiv*

factors, namely, factors 2, 4, 5, and 6, weigh in favor of exercising our discretion to deny institution under Section 314(a). The first factor is neutral. Only the third factor weighs against discretionary denial.

A holistic review of all the *Fintiv* factors does not sufficiently tip the balance in favor of declining to exercise our discretion to deny under Section 314(a). Accordingly, we exercise our discretion and deny institution.

IV. CONCLUSION

For the above reasons, we exercise our discretion and deny institution under 35 U.S.C. § 314(a).

V. ORDER

It is

ORDERED that the Petition is *denied* and no trial is instituted.

IPR2024-00855
Patent 8,314,547 B2

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