

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BOE TECHNOLOGY GROUP CO., LTD.,
Petitioner,

v.

138 EAST LCD ADVANCEMENTS LIMITED,
Patent Owner.

Case No. IPR2024-00977
U.S. Patent No. 9,557,606

PATENT OWNER'S PRELIMINARY SUR-REPLY

The Board authorized Patent Owner to file a five-page preliminary sur-reply in response to Petitioner's Preliminary Reply. Though Petitioner has filed a *Sotera* stipulation, Patent Owner files this Preliminary Sur-Reply to correct two points in Petitioner's Preliminary Reply.

First, Petitioner suggests that it needed a preliminary reply to offer a *Sotera* stipulation, citing "the changed circumstance of Patent Owner presenting its *Fintiv* arguments." Preliminary Reply at 4. But Petitioner knew and chose to address *Fintiv* and discretionary denial in its Petition. Petitioner's statement that Patent Owner "changed" the record and put discretionary denial at issue is incorrect. In its Petition, Petitioner preemptively addressed *Fintiv* and discretionary denial and did not include a *Sotera* stipulation. Thus, Patent Owner addressed discretionary denial in its Preliminary Response, dedicating words to those issues in view of Petitioner's decision to forego a *Sotera* stipulation when it argued against discretionary denial. Nothing in Petitioner's explanation identifies a reason to change its position since filing its Petition.

Second, Petitioner's description of the parties' discovery efforts in the related district court proceeding is incomplete. Petitioner's suggestion that "Patent Owner will not make available for deposition the inventor of another patent" is misleading and incorrect. Preliminary Reply at 5. The inventor is a third party in Japan over whom Patent Owner does not exercise control. But more to the point,

the parties have been engaged in written and document discovery, depositions, and claim construction disclosures, all consistent with the scheduling order governing the case at the time that Petitioner filed its Petition. Petitioner suggests that discovery “has materially impacted Petitioner’s assessment of the litigation since the Petition was filed,” though it does not explain how. Preliminary Reply at 5. Nothing in Petitioner’s explanation identifies a reason to change its position since filing its Petition.

Patent Owner respectfully submits this Preliminary Sur-Reply to correct Petitioner’s representations in its Preliminary Reply.

Date: October 22, 2024

Respectfully submitted,

s/ Cyrus A. Morton

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CERTIFICATE OF SERVICE

I certify that on October 22, 2024, a copy of Patent Owner's Preliminary Sur-Reply was served in its entirety by electronic mail to Petitioner's counsel at the following addresses indicated in Petitioner's Mandatory Notices:

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Date: October 22, 2024

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