

Nos. 2023-2117, 2023-2116

**United States Court of Appeals
for the Federal Circuit**

**MONDIS TECHNOLOGY LTD., HITACHI MAXELL, LTD., nka
Maxell Holdings, Ltd., MAXELL, LTD.,
*Plaintiffs-Appellants,***

v.

**LG ELECTRONICS INC., LG ELECTRONICS U.S.A., INC.,
*Defendants-Cross-Appellants.***

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF NEW
JERSEY, CASE No. 2:15-cv-04431-SRC-CLW, JUDGE STANLEY R. CHESLER

**LG ELECTRONICS INC. AND LG ELECTRONICS U.S.A., INC.'S
RESPONSE TO PETITION FOR PANEL REHEARING AND
REHEARING *EN BANC* OF PLAINTIFFS-APPELLANTS**

Michael J. McKeon
Christian A. Chu
R. Andrew Schwentker
Michael J. Ballanco
FISH & RICHARDSON P.C.
1000 Maine Ave. SW, Suite 1000
Washington, DC 20024
(202) 783-5070
mckeon@fr.com
chu@fr.com
schwentker@fr.com
ballanco@fr.com

*Counsel for LG Electronics Inc. and
LG Electronics U.S.A., Inc.*

CERTIFICATE OF INTEREST

Counsel for Defendants-Cross-Appellants LG Electronics Inc. and LG Electronics U.S.A., Inc. certifies the following:

1. **Represented Entities.** Provide the full names of all entities represented by undersigned counsel in this case.

LG Electronics Inc. and LG Electronics U.S.A., Inc.

2. **Real Party in Interest.** Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.

None/Not Applicable

3. **Parent Corporations and Stockholders.** Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.

LG Electronics Inc.: LG Corporation

LG Electronics U.S.A., Inc.: LG Electronics Inc.

4. **Legal Representatives.** List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

FISH & RICHARDSON P.C.: Ralph A. Philips; Scott A. Elengold*; Jared M. Hartzman; Ryan M. Teel*

WALSH PIZZI O'REILLY FALANGA LLP: Liza M. Walsh; Selina M. Ellis; William T. Walsh, Jr.*

MAYER BROWN LLP: Jamie B. Beaber; Michael W. Maas*; Hyunho Park*; Lisa Ferri; William J. Barrow; Anita Y. Lam*

POTTER MINTON: Michael E. Jones; Allen F. Gardner*

CONNELL FOLEY LLP: Jennifer Critchley*; Reade W. Seligmann*

* No longer with the firm

5. **Related Cases.** Other than the originating case(s) for this case, are there related or prior cases that meet the criteria under Fed. Cir. R. 47.5(a)?

Yes. See LG's Notice of Related Cases filed at Dkt. 19; Sec.I.

6. **Organizational Victims and Bankruptcy Cases.** Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

None/Not Applicable

Dated: October 20, 2025

/s/ Michael J. McKeon
Michael J. McKeon

TABLE OF CONTENTS

CERTIFICATE OF INTERESTi

TABLE OF CONTENTS..... iii

TABLE OF AUTHORITIESiv

I. INTRODUCTION 1

II. BACKGROUND 1

III. ARGUMENT.....4

 A. The Court Correctly Applied §282.....4

 1. The '180 Patent Does Not Describe the “Type” Limitation.....5

 2. Mondis’s Own Expert Confirmed the Lack of Written Description8

 B. The Court Did Not Adopt a New Burden-Shifting Regime for Written Description Challenges9

 1. Mondis Blurs the Burdens of Persuasion and Production and Misrepresents Precedent9

 2. The Court Properly Relied on *Centocor*, *PIN/NIP*, and *Rochester*11

 3. This Court Did Not Improperly Shift the Burden to Mondis ...15

 C. The Court Properly Rejected Mondis’s Attempt to Conjure Written Description Support..... 16

IV. CONCLUSION..... 18

CERTIFICATE OF SERVICE 19

CERTIFICATE OF COMPLIANCE.....20

TABLE OF AUTHORITIES

	Page(s)
<i>Ariad Pharmas., Inc. v. Eli Lilly & Co.</i> , 598 F.3d 1336 (Fed. Cir. 2010) (en banc)	9, 13, 16
<i>Canon Computer Sys., Inc. v. Nu-Kote Int’l, Inc.</i> , 134 F.3d 1085 (Fed. Cir. 1998)	10, 11
<i>Centocor Ortho Biotech, Inc. v. Abbott Labs.</i> , 636 F.3d 1341 (Fed. Cir. 2011)	<i>passim</i>
<i>Juno Therapeutics, Inc. v. Kite Pharma, Inc.</i> , 10 F.4th 1330 (Fed. Cir. 2021)	9
<i>Microsoft Corp. v. i4i Ltd. P’ship</i> , 564 U.S. 91 (2011).....	10, 11, 15
<i>Novartis Pharm. Corp. v. Accord Healthcare, Inc.</i> , 38 F.4th 1013 (Fed. Cir. 2022)	8-9
<i>Novo Nordisk A/S v. Caraco Pharm. Lab’ys, Ltd.</i> , 719 F.3d 1346 (Fed. Cir. 2013)	10
<i>Novozymes A/S v. DuPont Nutrition Biosciences APS</i> , 723 F.3d 1336 (Fed. Cir. 2013)	8
<i>Pfizer, Inc. v. Apotex, Inc.</i> , 480 F.3d 1348 (Fed. Cir. 2007)	10
<i>PIN/NIP, Inc. v. Platte Chem. Co.</i> , 304 F.3d 1235 (Fed. Cir. 2002)	13
<i>Ruan v. United States</i> , 597 U.S. 450 (2022).....	9
<i>Tech. Licensing Corp. v. Videotek, Inc.</i> , 545 F.3d 1316 (Fed. Cir. 2008)	10, 18
<i>Titan Tire Corp. v. Case New Holland, Inc.</i> , 566 F.3d 1372 (Fed. Cir. 2009)	10

Univ. of Rochester v. G.D. Searle & Co., Inc.,
358 F.3d 916 (Fed. Cir. 2004)8, 12, 13, 15

Statutes

35 U.S.C. § 11214

35 U.S.C. § 282.....*passim*

I. INTRODUCTION

To manufacture a ground for *en banc* review, Mondis misrepresents this Court’s opinion in this appeal and this Court’s precedent. Contrary to Mondis’s assertion, this Court did not adopt a new burden-shifting regime for written description challenges, did not contradict *i4i* or *Ariad*, and did not vitiate 35 U.S.C. §282’s presumption of validity. This Court simply followed its precedent and concluded that the “type” limitation at issue—which Mondis added to the claims through amendment more than a decade after the priority date—lacked written description support. This Court could not have reached any other result because the specification does not disclose the “type” limitation; Mondis’s own expert admitted the patent does not expressly disclose the limitation; and Mondis neither redirected its expert on his admission, nor presented a rebuttal case on written description. Nothing in this Court’s careful, case-specific and, ultimately, correct decision remotely warrants panel rehearing or *en banc* review.

II. BACKGROUND

At trial, Mondis asserted independent claim 14 and dependent claim 15 of U.S. Patent No. 7,475,180 against LG. Claim 14 recites the “type” limitation at issue: “said display unit information including *an identification number for identifying at least a type of said display unit* and characteristic information of said

display unit[.]”¹ Appx573. LG argued that the patent lacks written description for the “type” limitation. Although Mondis did not present a rebuttal on written description, the jury found in its favor. Appx193.

The District Court denied LG’s invalidity JMOL motion based on the presumption of validity, without identifying specification support for the “type” limitation. Appx221-224. Instead, the District Court relied on the purported impeachment of LG’s expert, although no such impeachment occurred and the cited testimony was unrelated to invalidity. Appx223.

A panel of this Court reversed based on a careful review of all evidence and arguments regarding written description. The Court’s opinion began by noting that Mondis’s claim amendment during prosecution “changed the nature of the claim’s identification number from one identifying a specific display unit to one identifying a type of display unit.” Op. 9. Turning to the patent itself, the Court underscored that “[i]t is undisputed that the patent does not expressly disclose the type limitation.” Op. 10 & n.2 (citing Mondis’s agreement during oral argument that “the specification does not disclose the actual words type identifier”). The Court then confirmed the specification’s non-disclosure of the “type” limitation with several citations and quotations demonstrating that “the patent consistently discloses an

¹ Unless otherwise noted, all emphases, highlights, and annotations are added, and all internal quotation marks and citations are omitted.

identifier that is associated with a specific computer.” Op. 10 (citing and quoting ’180 patent, 5:35-38, 5:43-44, 5:62-6:6, 7:18-20).

Turning to expert testimony, this Court explained that “*Mondis’s expert*, Mr. Lamm, also testified that the specification *does not expressly recite* an identification number for identifying *a type* of display unit.” Op. 11 (quoting Appx20417-18 (417:24-418:2)). While “LG’s expert, Dr. Stevenson, testified that the patent does not disclose an identification number to identify a type of display unit,” the Court decided to “resolve the issue on appeal without relying on his testimony.” Op. 10-11 & n.3.

Based on the undisputed evidence, the Court determined that, “[b]ased only on the patent and Mr. Lamm’s testimony, any reasonable jury performing this objective inquiry into the four corners of the patent would have to find that the inventors only possessed and disclosed identifying a specific display unit.” Op. 11.

Despite this determination, the Court continued its analysis because “[i]t would not automatically be fatal that the type limitation was not expressly disclosed as long as substantial evidence showed that the patent disclosed identifying a type of display unit in some less express way.” *Id.* The Court considered Mondis’s arguments “that (1) Mr. Lamm’s testimony, (2) Dr. Stevenson’s admissions, and (3) the prosecution history each provide substantial evidence to support the jury’s

finding on validity.” Op. 11. After a thorough analysis, however, the Court determined that each of Mondis’s arguments lacked merit. Op. 11-16.

Accordingly, the Court concluded:

Even if we assume the jury was free to disregard Dr. Stevenson’s testimony, the only evidence before the jury regarding written description was the patent—which does not disclose the type limitation—and Mr. Lamm’s testimony that the patent does not disclose the asserted claims’ type limitation. Because Mondis neither redirected Mr. Lamm on his testimony that the patent does not expressly disclose the type limitation, nor called him in rebuttal, *there was no evidence in the record that would allow a reasonable jury to determine that a person of ordinary skill in the art would understand that the patent disclosed the type limitation*. The patent and Mr. Lamm’s testimony established that the inventors only possessed and disclosed identifying a specific display unit.

Op. 16. Because “[s]ubstantial evidence does not support the jury’s finding” on written description, the Court “h[e]ld that claims 14 and 15 of the ’180 patent are invalid for lack of an adequate written description.” *Id.*

III. ARGUMENT

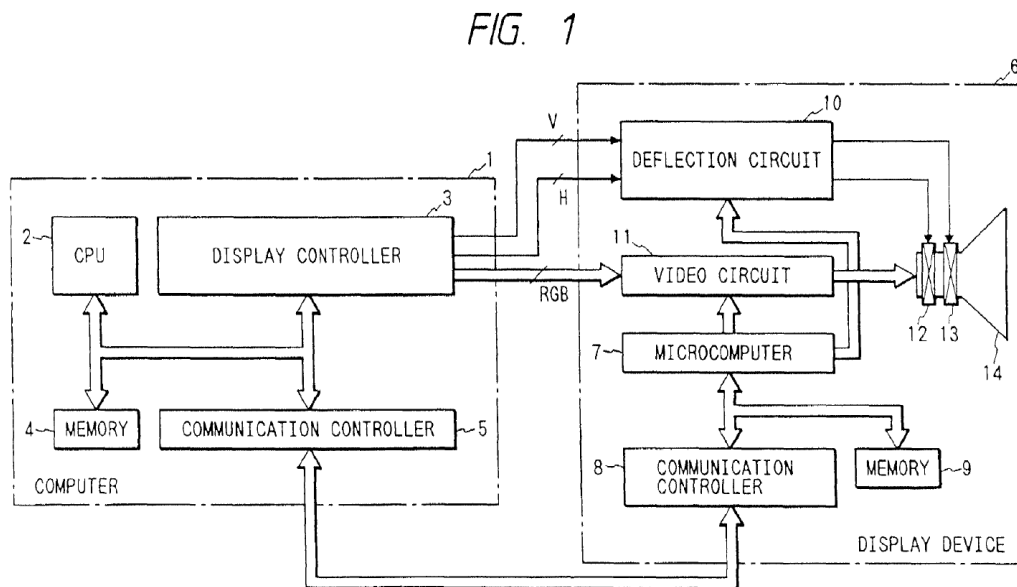
A. The Court Correctly Applied §282

Contrary to Mondis’s arguments, the Court did not disregard §282’s presumption of validity or the clear-and-convincing evidence standard. Pet. 3-4. To the contrary, the Court acknowledged that “[p]atents are presumed to be valid and overcoming this presumption requires clear and convincing evidence[.]” Op. 7, and expressly allocated to LG the burden of persuasion on invalidity, Op. 8 (noting LG

bore the “burden of persuasion” of proving lack of written description by “clear and convincing evidence”). And contrary to Mondis’s assertion, the Court never held that “the patentee may not rely on the presumption of validity,” as Mondis’s equivocal language (“[t]he Panel *effectively* said...”) and lack of supporting citations confirm. Pet. 2. Under the Court’s correct burden allocation and proper application of legal principles, LG met its burdens of production and persuasion based on the ’180 patent and the admission of Mondis’s expert.

1. The ’180 Patent Does Not Describe the “Type” Limitation

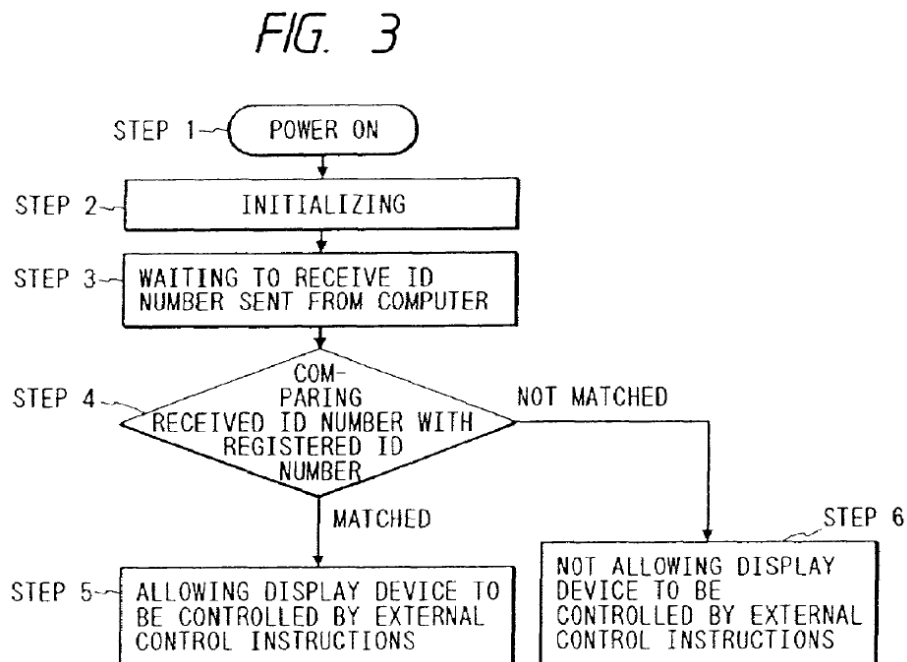
The specification of the ’180 patent only discloses embodiments associating a *specific* computer with a *specific* display device. Figure 1 depicts this system:



Appx556.

As the specification explains, the computer may request control of a newly-connected display unit by transmitting the computer’s individualized identification

number, which the display unit then compares to a list of known identification numbers stored in the display unit's memory. Appx570 (5:38-42); Appx557 (Fig.2). If the computer's identification number matches a registered identification number in the display unit's memory, that computer can control aspects of the display unit, such as its brightness and contrast. Appx570 (5:43-47). If there is no matching identification number, the computer cannot control the display unit. Figure 3 depicts this operation:



Appx558 (Fig.3). Alternatively, the computer can store registered identification numbers for specific display units and gain control of the display unit by matching the display unit's identification number against its stored list. Appx570 (5:61-6:4).

In either configuration, each identifier is associated with a specific computer or a specific display unit. That is, the patent consistently describes a one-to-one

relationship in which one identification number corresponds to one device. For example, the patent explains that “the microcomputer 7 in the display device 6 waits for sending of the identification number assigned to the computer 1, that is, the so-called ID number from the computer 1.” *Id.* (5:35-38). After this registration process, “the computer 1 is allowed to control the display device 6[.]” *Id.* (5:43-44). Similarly, for the alternative configuration, “an ID number is sent to the computer 1 from the display device 6 so that the computer 1 identifies that the display device 6 ... is connected,” and “[b]y doing this, the computer 1 communicates with a specific display device 6.” *Id.* (5:62-6:6); *see also* Appx571 (7:9-33) (describing embodiment, depicted in Figure 5, where “[e]ach of the display devices 6B, 6C, and 6D has ... a registered ID number”).

As initially filed, claim 14 mirrored the specification’s disclosure. Appx18192-18193; Appx20615-20616 (615:22-616:11). Fourteen years after the priority date, Mondis amended the claim to insert the phrase “at least a type of” into the limitation: “an identification number for identifying at least a type of said display unit.” Appx18203-18204; Appx18209-18210; Appx20417 (417:13-23); Appx20576-20577 (576:1-577:3); Appx20616 (616:12-21). This amendment changed the nature of the claim’s identification number from one identifying a *specific* display unit to one identifying a “*type*” of display unit. Appx6109. But because the specification only describes that “*an* identification number is set to *each*

device,” Appx572, 10:28; *see also* Appx570, 6:5-6, there is no disclosure in the patent of an identification number for identifying a *type* of display unit. *See generally* Appx550-582.

The patent’s lack of support for the “type” limitation, on its own, compelled JMOL in LG’s favor. *See Univ. of Rochester v. G.D. Searle & Co., Inc.*, 358 F.3d 916, 927 (Fed. Cir. 2004) (“[A] patent can be held invalid for failure to meet the written description requirement, based solely on the language of the patent specification ... [as] it is in the patent specification where the written description requirement must be met.”); *Centocor Ortho Biotech, Inc. v. Abbott Labs.*, 636 F.3d 1341, 1347 (Fed. Cir. 2011) (“A patent also can be held invalid for failure to meet the written description requirement based solely on the face of the patent specification.”); *Novozymes A/S v. DuPont Nutrition Biosciences APS*, 723 F.3d 1336, 1350 (Fed. Cir. 2013).

2. Mondis’s Own Expert Confirmed the Lack of Written Description

Mondis’s technical expert, Joseph Lamm, confirmed the lack of written description by admitting that “the specification of the ’180 patent *does not expressly recite* an identification number for identifying *a type* of display unit.” Appx20417-18 (417:24-418:2). At no point during trial did he ever testify that a skilled artisan would have found support for this limitation in the patent. This is dispositive, as “[s]ilence is generally not disclosure.” *Novartis Pharm. Corp. v.*

Accord Healthcare, Inc., 38 F.4th 1013, 1017 (Fed. Cir. 2022); *see also id.* at 1017 n.2 (rejecting “implicit disclosure” as satisfying written description requirement).

Under similar situations where there was insufficient evidence to sustain a validity verdict, this Court has reversed the denial of JMOL of no written description. *E.g., Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1340 (Fed. Cir. 2010) (en banc); *Juno Therapeutics, Inc. v. Kite Pharma, Inc.*, 10 F.4th 1330, 1342 (Fed. Cir. 2021); *Centocor*, 636 F.3d at 1343-44. Consistent with this precedent, the Court properly reversed the denial of JMOL here because “there was no evidence in the record that would allow a reasonable jury to determine that a person of ordinary skill in the art would understand that the patent disclosed the type limitation.” Op. 16.

B. The Court Did Not Adopt a New Burden-Shifting Regime for Written Description Challenges

Mondis wrongly accuses the Court of adopting a new burden-shifting regime in written description challenges. Pet. 3-11.

1. Mondis Blurs the Burdens of Persuasion and Production and Misrepresents Precedent

Mondis blurs the distinction between the burdens of *persuasion* and *production* by ambiguously accusing the Court of “shifting the burden to the patentee.” Pet. 2. But these two burdens are distinct. *See Ruan v. United States*, 597 U.S. 450, 463 (2022). As this Court’s opinion recognized, “LG had the burden

of *persuasion*” on invalidity, and “[t]hroughout litigation the presumption of validity remains intact and the ultimate burden of proving invalidity remains with the challenger.” Op. 8.

While the burden of *persuasion* never shifts to the patentee, the burden of *production* can: “[O]nce a challenger ... has introduced sufficient evidence to put at issue” validity, “the patentee has the burden of going forward with evidence and argument to the contrary.” *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1329 (Fed. Cir. 2008). Indeed, this Court has long recognized the shifting burden of production in invalidity challenges. *E.g.*, *Novo Nordisk A/S v. Caraco Pharm. Lab’ys, Ltd.*, 719 F.3d 1346, 1353 (Fed. Cir. 2013); *Titan Tire Corp. v. Case New Holland, Inc.*, 566 F.3d 1372, 1376-77 (Fed. Cir. 2009); *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1360 (Fed. Cir. 2007).

Even when Mondis mentions the “burden of production,” it misapplies precedent. Pet. 4-5 (citing *Microsoft Corp. v. i4i Ltd. P’ship*, 564 U.S. 91 (2011), and *Canon Computer Sys., Inc. v. Nu-Kote Int’l, Inc.*, 134 F.3d 1085 (Fed. Cir. 1998)).

Contrary to Mondis’s assertion, *i4i* never “held” that “courts do not employ a shifting burden of production in analyzing validity.” Pet. 5. Instead, *i4i* “h[e]ld” that “§282 requires an invalidity defense to be proved by clear and convincing evidence.” *i4i*, 564 U.S. at 95; *see also id.* at 103 (ruling that §282’s presumption of

validity “establish[ed] the governing standard of proof” for invalidity challenges). In reaching this conclusion, *i4i* merely rejected Microsoft’s alternative arguments that §282’s presumption of validity “**only** allocates the burden of production, or ... shifts **both** the burden of production and the burden of persuasion.” *Id.* at 106-07; *see also id.* at 103. At no point did *i4i* reject shifting the burden of production. Instead, *i4i* distinguishes between the burdens of persuasion and production by recognizing that the latter can shift during litigation. *Id.* at 100 n.4 (explaining “the burden of production [specif[ies] which party must come forward with evidence at various stages in the litigation”); *id.* at 107 (“The same party who has the burden of persuasion also **starts out** with the burden of producing evidence[.]”).

Canon further undermines Mondis’s argument. As Mondis’s quote indicates, “**where** the challenger **fails to identify any persuasive evidence** of invalidity, the very existence of the patent satisfies the patentee’s burden on the validity issue.” *Canon*, 134 F.3d at 1088. But where the challenger identifies such evidence, the burden of production shifts to the patentee under *Canon*: “[A]t trial on the merits, [the patentee] need only submit sufficient evidence to rebut any proof of invalidity offered by [the challenger].” *Id.*

2. The Court Properly Relied on *Centocor*, *PIN/NIP*, and *Rochester*

Mondis’s criticisms of this Court’s reliance on *Centocor*, *PIN/NIP*, and *Rochester* lack merit, Pet. 5-9, because these cases support the Court’s correct

observation that “sometimes the patent itself is clear enough that it establishes inadequacy of support in the written description for the full scope of the claimed invention unless there is contrary evidence[.]” Op. 9.

First, as *Rochester* explained, “a patent can be held invalid for failure to meet the written description requirement, based solely on the language of the patent specification ... [as] it is in the patent specification where the written description requirement must be met.” *Rochester*, 358 F.3d at 927. Although Mondis denigrates this statement as mere “dicta,” Pet. 8, this ruling was critical to the lack of written description holding because “it [was] undisputed that the [asserted] patent does not disclose any compounds that can be used in its claimed methods[.]” *Rochester*, 358 F.3d at 927. Thus, the asserted patent “prove[d] its own invalidity ... clearly and convincingly[.]” *Id.* at 930.

Rochester also undermines Mondis’s argument that a face-of-the-patent analysis conflicts with §282. Pet. 2. Like Mondis, the patentee in *Rochester* argued that, “because all issued patents are presumed to be valid, the district court was wrong to conclude that the ’850 patent constitutes clear and convincing proof of its own invalidity.” *Rochester*, 358 F.3d at 930. But this Court rejected that argument: “Although section 282 of the Patent Act places the burden of proof on the party seeking to invalidate a patent, it does not foreclose the possibility of that party demonstrating that the patent in suit proves its own invalidity[.]” *Id.* *Rochester*—

which the *Ariad en banc* Court repeatedly cited with approval—remains good law. *See Ariad*, 598 F.3d at 1353-55.

Second, Mondis cannot distinguish *PIN/NIP*. Pet. 6-7. There, this Court invalidated a claim for lack of written description because “the originally filed application, which is devoid of any mention or even implication that the two chemicals can be applied in a spaced, sequential manner, does not support the later-added claim 33.” *PIN/NIP, Inc. v. Platte Chem. Co.*, 304 F.3d 1235, 1247-48 (Fed. Cir. 2002). Even if the patentee “admitted” the claim was broader than the patent’s disclosure, Pet. 7, the only evidence this Court identified to support invalidity was the patent itself. *PIN/NIP*, 304 F.3d at 1247-48; *see also Rochester*, 358 F.3d at 927 (citing and relying upon *PIN/NIP*).

Because *PIN/NIP*’s focus on the patent itself undermines Mondis’s position, Mondis resorts to citing the parties’ appellate briefs to find evidence beyond the patent itself. Pet. 7. But this Court decided the case based on the language of the patent specification alone, and the parties’ briefs cannot change this reality.

Third, *Centocor*’s analysis is remarkably similar to the Court’s analysis here. In *Centocor*, the patentee “***presented no expert testimony on written description at trial*** and instead chose to rest on the ’775 patent specification and the testimony of its inventors.” 636 F.3d at 1349. After reciting the principle that “[a] patent also can be held invalid for failure to meet the written description requirement based

solely on the face of the patent specification,” *id.* at 1347 (citing *Rochester* and *PIN/NIP*), this Court “turn[ed] to the four corners of the [patent] applications to assess whether their disclosure provides adequate written description for the asserted claims[.]” *id.* at 1349. But there was no disclosure of the claimed human antibody in the patent’s specification, and the inventor’s testimony could not overcome this lack of written description. *Id.* at 1349-51. Accordingly, this Court concluded that “the jury lacked substantial evidence for its verdict that the asserted claims were supported by adequate written description” and that “[t]he district court erred when it declined to grant Abbott a JMOL that the asserted claims fail to satisfy the written description requirement of 35 U.S.C. § 112.” *Id.* at 1353.

Hoping to distinguish *Centocor*, Mondis argues that the whole testimony of the challenger’s expert regarding written description was undisputed. Pet. 6. Not so. As *Centocor* explained, the “undisputed trial testimony indicated that the sequence of Centocor’s mouse variable region was very different from the sequence of a human variable region like the one in Abbott’s fully-human antibody.” *Centocor*, 636 F.3d at 1349-50. Beyond this narrowly undisputed point, the testimony of the challenger’s expert was very much disputed, as shown by the patentee’s reliance on its inventor’s testimony to show written description. *Id.* at 1350 (contrasting the testimony of the challenger’s expert against the inventor’s testimony).

Finally, Mondis incorrectly dismisses *Rochester*, *PIN/NIP*, and *Centocor* because they “were all decided before *i4i*.” Pet. 6. But *i4i* did not change the law regarding §282. Instead, *i4i* **affirmed** this Court’s “settled interpretation of §282” that the presumption of validity requires proof of invalidity by clear and convincing evidence. *i4i*, 564 U.S. at 97-99, 113. There is, therefore, no conflict between *i4i* and this Court’s jurisprudence in *Centocor*, *PIN/NIP*, and *Rochester*.

At base, the Court’s analysis here firmly rests on §282, Supreme Court precedent, and this Court’s own precedent. Mondis cannot show otherwise.

3. This Court Did Not Improperly Shift the Burden to Mondis

Mondis accuses this Court of improperly reversing the JMOL denial based solely on the “face of the patent” and “shift[ing] the burden on written description to Mondis.” Pet. 9-11. Mondis is wrong.

This Court did not merely rely on the “face of the patent.” Pet. 9. It based its decision on both “the patent **and** Mr. Lamm’s testimony.” Op. 11. Mr. Lamm indeed admitted there is no express support for the “type” limitation in the patent’s specification. Op. 11 (quoting Appx20417-18 (417:24-418:2)). And he failed to offer any rebuttal on written description. Op. 5 (citing Appx20744 (744:3-6)). Thus, although the patent’s non-disclosure alone would have sufficed, *Rochester*, 358 F.3d at 927, additional evidence—from Mondis’s own expert—confirmed the lack of written description.

Mondis cannot avoid the consequences of its patent’s non-disclosure and its expert’s admissions by pressing *Ariad*’s observation that the specification need not “recite the claimed invention *in haec verba*.” Pet. 9. While the specification need not use the exact words of the claims, the patent must nonetheless “reasonably convey[] to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad*, 598 F.3d at 1351-52. “[A] description that merely renders the invention obvious does not satisfy the requirement.” *Id.* at 1352. Given Mr. Lamm’s admission and his lack of rebuttal testimony, *Ariad*’s required showing was impossible, as the jury had no evidence—much less any expert guidance—on which to establish the legally-mandated possession.

And even after concluding that LG clearly and convincingly proved a lack of written description, this Court continued its analysis to determine if “substantial evidence showed that the patent disclosed identifying a type of display unit in some less express way.” Op. 11. Because the record contained no such evidence, this Court correctly concluded that the jury’s finding was unsupported. Op. 16.

C. The Court Properly Rejected Mondis’s Attempt to Conjure Written Description Support

Hoping to gin up written description support, Mondis cites a passage about communication function from the patent’s column 5. Pet. 11-14 (discussing ’180 patent, 5:62-67). But because Mondis must admit that “this passage does not expressly recite a type ID[,]” Pet. 11, it tries to create a connection between the

passage's discussion of a "communication function" and the "type limitation." Pet. 11-12 (citing Appx20290-20291 (290:5-291:4)). This attempt fails for three reasons.

First, this Court's opinion already considered and rejected this exact argument: "Not only was [Mr. Lamm's cited] testimony about infringement rather than validity, it was also silent about the type limitation. Mondis never presented any evidence to the jury connecting this communication function to the type limitation that would allow a reasonable jury to find written description support." Op. 12-13. Simply put, the cited testimony, provided in the context of infringement, never referenced or discussed the "type" limitation. Appx20290-20291 (290:5-291:4).

Second, Mondis's argument lacks specification support because this passage says nothing about a display unit "type," much less about the "type" limitation. Appx570 (5:62-6:2). Rather, the passage indicates that the display device transmits to the computer an identification number identifying a *specific* display unit, not the claimed "*type of said display unit*[" Appx570 (5:62-6:4). The next three specification sentences (omitted from Mondis's block quote of 5:62-67) confirm that the identification number identifies "a specific display device." Appx570 (5:67-6:9).

Third, even if the communication function could somehow be connected to the "type" limitation (it is not), there is still no cogent testimony connecting this passage to the "type" limitation. For written description support to exist, "the

applicant *must convey with reasonable clarity* to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and demonstrate that *by disclosure in the specification of the patent.*” *Centocor*, 636 F.3d at 1348. Mondis’s oblique reference to a “communication function” does not provide any indication of the “type” limitation, let alone with “reasonable clarity.”

Nor can Mondis merely rely on the presumption of validity and stay silent. Pet. 13. Given LG’s strong showing of no written description, Mondis did not have the luxury of remaining silent. *See, e.g., Tech. Licensing*, 545 F.3d at 1329.

Thus, the Court properly concluded that “neither Mr. Lamm’s testimony nor the plain words of the specification in the portions that he cited in his testimony provide substantial evidence to support the jury’s finding on validity.” Op. 13.

IV. CONCLUSION

Mondis’s rehearing petition should be denied.

Dated: October 20, 2025

Respectfully submitted,

/s/ Michael J. McKeon

Michael J. McKeon (mckeon@fr.com)

Christian A. Chu (chu@fr.com)

R. Andrew Schwentker (schwentker@fr.com)

Michael J. Ballanco (ballanco@fr.com)

FISH & RICHARDSON P.C.

1000 Maine Ave. SW, Suite 1000

Washington, DC 20024

(202) 783-5070

*Counsel for LG Electronics Inc. and LG
Electronics U.S.A., Inc.*

CERTIFICATE OF SERVICE

I certify that on October 20, 2025, I electronically filed the foregoing LG Electronics Inc. and LG Electronics U.S.A., Inc.'s Response to Petition for Panel Rehearing and Rehearing *En Banc* of Plaintiffs-Appellants using the Court's CM/ECF filing system. Counsel for Mondis was served by email at the following addresses:

Martin J. Black (martin.black@dechert.com)

Jeffrey S. Edwards (jedwards@dechert.com)

Jeffrey B. Plies (jeff.plies@dechert.com)

Brian M. Goldberg (brian.goldberg@dechert.com)

/s/ Michael J. McKeon

Michael J. McKeon

CERTIFICATE OF COMPLIANCE

LG Electronics Inc. and LG Electronics U.S.A., Inc.'s Response to Petition for Panel Rehearing and Rehearing *En Banc* of Plaintiffs-Appellants is submitted in accordance with the type-volume limitation of Fed. Cir. R. 40(e). This Brief contains 3,897 words excluding the parts of the brief exempted by Fed. R. App. P. 32(f) and Fed. Cir. R. 32(b)(2). This Brief has been prepared in a proportionally spaced typeface using Microsoft Word 2016 in Times New Roman, 14 Point.

Dated: October 20, 2025

/s/ Michael J. McKeon
Michael J. McKeon