

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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INTEL CORP., DELL INC., and DELL TECHNOLOGIES INC.,

Petitioner,

v.

GENERAL VIDEO, LLC,

Patent Owner.

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Case IPR2025-01038

Patent No. 7,359,437

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**PATENT OWNER'S REQUEST FOR  
DISCRETIONARY DENIAL OF INSTITUTION**

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**EXHIBIT LIST**

<b>Exhibit #</b>	<b>Description</b>
2001	Declaration of Matthew G. McAndrews
2002	Docket Report for <i>General Video, LLC v. Dell Inc. et al.</i> , Case No. 1-24-cv-01530 (W.D. Tex.)
2003	Docket Report for <i>General Video, LLC v. Lenovo Group Limited</i> , Case No. 5-24-cv-00122 (E.D. Tex.)
2004	Docket Report for <i>General Video, LLC v. HP Inc.</i> , Case No. 5-24-cv-00123 (E.D. Tex.)
2005	Docket Report for <i>General Video, LLC v. ASUSTeK Computer, Inc. et al.</i> , Case No. 5-24-cv-00126 (E.D. Tex.)
2006	Defendants' Preliminary Invalidity Contentions (without exhibits) (May 19, 2025) in <i>General Video, LLC v. Dell Inc. et al.</i> , Case No. 1-24-cv-01530 (W.D. Tex.)
2007	Unused
2008	Defendant HP Inc.'s Invalidity Contentions (without exhibits) (June 26, 2025) in <i>General Video, LLC v. HP Inc.</i> , Case No. 5-24-cv-00123 (E.D. Tex.)
2009	Defendant's Preliminary Invalidity Contentions (without exhibits) (June 23, 2025) in <i>General Video, LLC v. ASUSTeK Computer, Inc. et al.</i> , Case No. 5-24-cv-00126 (E.D. Tex.)
2010	Statistics for Judge Albright on Contested Motions to Stay Pending IPR (taken from Docket Navigator on 8/1/25)
2011	Statistics for Judge Schroeder on Contested Motions to Stay Pending IPR (taken from Docket Navigator on 8/1/25)
2012	Docket Control Order (4/22/25) in consolidated cases of <i>General Video, LLC v. Lenovo Group Limited</i> , Case No. 5-24-cv-00122 (E.D. Tex.), <i>General Video, LLC v. HP Inc.</i> , Case No. 5-24-cv-00123 (E.D. Tex.), and <i>General Video, LLC v. ASUSTeK Computer, Inc. et al.</i> , Case No. 5-24-cv-00126 (E.D. Tex.)
2013	Scheduling Order (3/24/25) in <i>General Video, LLC v. Dell Inc. et al.</i> , Case No. 1-24-cv-01530 (W.D. Tex.)
2014	<a href="https://www.via-la.com/licensing-2/displayport/displayport-licensees/">https://www.via-la.com/licensing-2/displayport/displayport-licensees/</a>
2015	<a href="https://www.via-la.com/wp-content/uploads/Final-June-1-2025-DisplayPort-Attachment-1.pdf">https://www.via-la.com/wp-content/uploads/Final-June-1-2025-DisplayPort-Attachment-1.pdf</a>
2016	<a href="https://web.archive.org/web/20210616083136/https://">https://web.archive.org/web/20210616083136/https://</a>

Exhibit #	Description
	<a href="http://www.mpegla.com/programs/displayport/licensees/">www.mpegla.com/programs/displayport/licensees/</a>
2017	MPEGLA June 1, 2021 DisplayPort Attachment 1
2018	March 18, 2015 Ltr. from Dean Skandalis of MPEGLA to Chad Anson of Dell Inc.
2019	March 12, 2015 Ltr. from Dean Skandalis of MPEGLA to Ron Friedman of Intel Corp.
2020	Plaintiff General Video, LLC's Opposed Motion for Entry of Scheduling Order That "Generally Tracks" the Court's Exemplary Schedule (6/18/25) and Replacement Exhibit A (6/19/25) filed in <i>General Video, LLC v. Dell Inc. et al.</i> , Case No. 1-24-cv-01530 (W.D. Tex.)
2021	Joint Notice Regarding Settlement & Request to Vacate Case Management Conference (8/23/17) in <i>Lattice Semiconductor Corporation v. Technicolor SA et al.</i> , No. 4-16-cv-00668 (N.D. Cal.)
2022	Defendants' Motion to Dismiss in Part Plaintiff's Complaint for Failure to State a Claim (December 12, 2024) in <i>General Video, LLC v. Dell Inc. et al.</i> , Case No. 1-24-cv-01530 (W.D. Tex.)

## I. INTRODUCTION

Pursuant to the Acting Director's March 26, 2025 Memorandum setting forth the "Interim Processes for PTAB Workload Management" (the "Director's Memorandum"), Patent Owner General Video, LLC ("Patent Owner" or "General Video") hereby submits this Request for Discretionary Denial of Institution of the Petition for *Inter Partes* Review ("Petition") of claims 41-45, 47, 49-50, and 52-53 (the "Challenged Claims") of U.S. Patent No. 7,359,437 (the "437 Patent").

*Inter partes* review of the 437 Patent would be a waste of the Board's limited resources. The 437 Patent is expired, so the inventions disclosed in the patent are already free to the public going forward. In addition, prior to expiring, the 437 Patent was in force for over a decade, was licensed to dozens of licensees as part of a patent pool going back to 2021, and was previously asserted in litigation in 2016 by a predecessor in interest of Patent Owner, so the settled expectations of the parties weigh heavily in favor of denial.

Moreover, despite the facts that the 437 Patent is expired and Patent Owner asserts only one claim of the 437 Patent against Petitioners Dell Inc. and Dell Technologies Inc. in litigation, Petitioners have decided to burden the Board with not one, but two Petitions for IPR of the 437 Patent – this one and IPR2025-01039. In doing so, Petitioners ignore the Office's admonition that "one petition should be sufficient to challenge the claims of a patent in most situations," and multiple

petitions “are not necessary in the vast majority of cases.” *Consolidated Trial Practice Guide* (Nov. 2019) at 59. While Patent Owner will address this issue in more detail in its forthcoming Response to Petitioners’ Notice Explaining Material Differences Between Petitions, for purposes of this Request, Patent Owner just notes that Petitioners do not need 28,000 words to address the claims of the 437 Patent, especially since only one of those claims is asserted in litigation and, as Petitioners acknowledge, the claims of the 437 Patent overlap considerably. *See* Pet. at 72-75; IPR2025-01039 Pet. at 85-91. This is not one of the rare instances where two IPRs are warranted, and Petitioners’ disregard of the Board’s guidelines on multiple IPRs is reason alone for the Board to exercise its discretion to deny institution of both this IPR and IPR2025-01039.

In addition, this IPR would not “provide an effective and efficient alternative to” the three pending district court cases involving the 437 Patent. *General Plastic Industrial Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16-17 (P.T.A.B. Sept. 6, 2017). The 437 Patent is being asserted by Patent Owner in **three** pending and far-along litigations in “rocket dockets.” Importantly, two of those cases are scheduled for trial before the Final Written Decision (“FWD”) deadline in this IPR. Further, those three cases involve not only the 437 Patent but five other patents (including three that are not subject to IPR petitions) and also involve the same art that is relied on in the Petition. Moreover, defendants in those cases

(including two of the Petitioners) have asserted a number of invalidity contentions with respect to the 437 Patent that cannot be resolved in an IPR, such as Section 101 and 112 contentions and Section 102/103 contentions based on system prior art combined with the art relied on in the Petition.

In addition, (i) the art relied on in the Petition is the same, or substantially the same, as art that was already considered by the Office during prosecution of the 437 Patent, and (ii) the Petition grounds have no merit and are heavily based on unfocused expert testimony instead of the teachings of the cited art.

Thus, if this IPR is allowed to continue, it would be inefficient, potentially lead to results inconsistent with those in the parallel litigations, delay resolution of the parties' dispute, and burden the parties (not to mention the federal government) with another complex and expensive proceeding. The Board should exercise its discretion to deny.

## **II. BACKGROUND**

The Petition is one of four filed by Petitioners challenging a subset of patents at issue in the following three pending district court cases in which Patent Owner is the plaintiff: *General Video, LLC v. Dell Inc. et al.*, Case No. 1-24-cv-01530 (W.D. Tex.) (the "Dell Case"), *General Video, LLC v. HP Inc.*, Case No. 5-24-cv-00123

(E.D. Tex.) (the “HP Case”), and *General Video, LLC v. ASUSTeK Computer, Inc. et al.*, Case No. 5-24-cv-00126 (E.D. Tex.) (the “ASUSTeK Case”).<sup>1</sup>

Patent Owner filed the Complaints in all the Texas Cases in the Eastern District of Texas on August 30, 2024, but the Dell Case was transferred to the Western District of Texas in December 2024, and the ED Texas Cases were

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<sup>1</sup> The HP Case and the ASUSTeK Case are collectively referred to as the “ED Texas Cases.” The ED Texas Cases and the Dell Case are collectively referred to as the “Texas Cases.” Patent Owner also filed Complaints on August 30, 2024 in the Eastern District of Texas asserting against Acer Inc. (the “Acer Case”) and Lenovo Group Limited (the “Lenovo Case”) the same patents it asserts in the Texas Cases. (*General Video, LLC v. Acer Inc.*, Case No. 5-24-cv-00125 (E.D. Tex.) and *General Video, LLC v. Lenovo Group Ltd.*, Case No. 5-24-cv-00122 (E.D. Tex.)). The Acer Case was consolidated with the ED Texas Cases but was settled in June 2025 and subsequently dismissed. *See* Ex. 2003 at 10, 12-13 (Dkt. Nos. 45, 87, 100). The Lenovo Case was dismissed without prejudice for a lack of personal jurisdiction on August 11, 2025 (and the court did not address the defendant’s other arguments regarding venue or whether Patent Owner failed to state a claim). *See id.* at 14 (Dkt. No. 104).

consolidated in April 2025. *See* Ex. 2001 at ¶6. In each of the Texas Cases, Patent Owner has asserted the 437 Patent along with five other patents – U.S. Patent Nos. 6,584,443 (the “443 Patent”), 7,069,224 (the “224 Patent”), 7,225,282 (the “282 Patent”), 9,036,010 (the “010 Patent”), and 9,843,786 (the “786 Patent”) (collectively, the “General Video Patents”). *See id.*

The General Video Patents are generally directed to network protocols for the high-speed, efficient, and reliable transmission of audio and video data. The claimed inventions of the General Video Patents are essential to, and must be used to comply with, implementations of several versions of the DisplayPort standard promulgated by the Video Electronics Standards Association (VESA). The DisplayPort standards generally relate to audio/video network communications between source devices (*e.g.*, desktop or laptop computers) and sink devices (*e.g.*, computer monitors or laptop displays) and the transmission of packetized video, audio, and/or other forms of data between such source and sink devices.

Petitioners, which include the defendants in the Dell Case – Dell Inc. and Dell Technologies Inc. (the “Dell Defendants”) – and Intel Corp. (“Intel”), have filed four Petitions for IPR of three of the six patents at issue in the Texas Cases: the 437 Patent (in this IPR and in IPR2025-01039, both filed on May 27th), the 010 Patent (in IPR2025-01036, filed on May 23rd), and the 786 Patent (in IPR2025-01037, filed

on May 23rd).<sup>2</sup> The Petitions were filed more than eight months after the Complaint in the Dell Case was filed and served. *See* Ex. 2002 at 4-5 (Dkt. Nos. 5, 7, 8).

The 437 Patent issued on April 15, 2008 and expired in May 2025. The 010 Patent issued on May 19, 2015, and the 786 Patent issued on December 12, 2017 and is a child of the 010 Patent. Thus, the claims of the patents challenged by Petitioners in their four IPRs have been in force for a long time.

Trial is scheduled for September 28, 2026 in the ED Texas Cases, but, if the PTAB institutes here, the deadline for issuance of an FWD is December 23, 2026. As discussed in more detail below, the Texas Cases are already far along, and, by the time a decision on institution is issued in late December 2025, they will have been going on for 16 months, with claim construction briefing and much of discovery having been completed, and, in the case of the ED Texas Cases, *Markman Hearings* having been conducted.

In addition, the defendants in the ED Texas Cases rely on the same prior art that the Petition relies on (Kim, Myers, and Shin) in their invalidity contentions, so

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<sup>2</sup> Patent Owner has responded or will be responding to the Petitions in the other three IPRs by filing Requests for Discretionary Denial and Preliminary Responses and will respond to Petitioners' explanation of material differences between the Petition in this IPR and the Petition in IPR2025-01039.

no efficiencies will be realized by conducting an IPR trial on the 437 Patent – the Eastern District of Texas is going to have to evaluate the art relied on in the Petition regardless of whether the Board does. Moreover, the Office already considered (i) Myers and Shin, and (ii) references substantially the same as Kim during prosecution of the 437 Patent.

### **III. THE *FINTIV* FACTORS WEIGH STRONGLY IN FAVOR OF DISCRETIONARY DENIAL**

The Director should deny the Petition under the non-exclusive “*Fintiv*” factors the Board has laid out for determining whether to institute an IPR when there is parallel district court litigation. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020). Those factors are as follows:

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 an FWD;
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.

*Id.* at 6. Here, the *Fintiv* factors as a whole strongly weigh in favor of denial.

**A. Factor 1: No Stay Has Been Granted in any of the Texas Cases and It Is Unlikely That One Will Be**

*Fintiv* Factor 1 looks to “whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.” *Fintiv*, Paper 11 at 5-6. This factor weighs against institution.

The Dell Defendants have not moved for a stay, nor is there any indication they will do so. *See* Ex. 2001 at ¶7. That is also true of the defendants in the ED Texas Cases.<sup>3</sup> *See id.* Indeed, each of the Texas Cases is already far along and will be even further along by the time the Board issues a decision on institution (likely

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<sup>3</sup> Even though none of the Petitioners is a defendant in any of the ED Texas Cases, those cases must be addressed in any *Fintiv* analysis because they involve the 437 Patent. *See Fintiv*, Paper 11 at 14 (“Even when a petitioner is unrelated to a defendant . . . if the issues are the same as, or substantially similar to, those already or about to be litigated, or other circumstances weigh against redoing the work of another tribunal, the Board may . . . exercise the authority to deny institution.”); *Mylan Labs. Ltd. v Janssen Pharm. NV*, IPR2020-00440, Paper 17 (P.T.A.B. Sep. 16, 2020) (considering two district court cases involving the challenged patent in *Fintiv* analysis even though Petitioner was defendant in only one); *Fitbit, Inc. v. Philips N. Am. LLC*, IPR2020-00828, Paper 13 (P.T.A.B. Nov. 3, 2020) (same).

in late December 2025). In each of the Texas Cases, Patent Owner has served initial disclosures, infringement contentions, interrogatories, interrogatory responses, and issued third-party subpoenas to Via Licensing Alliance and VESA, and the defendants have served initial disclosures, interrogatories, interrogatory responses, and invalidity contentions. *See* Ex. 2001 at ¶8. The invalidity contentions in each case are well over 10,000 pages long and include numerous different invalidity claims against each of the six asserted General Video Patents, including invalidity claims that cannot be resolved in an IPR, such as Section 101 eligibility claims, Section 112 indefiniteness, written description, enablement claims, and Section 102/103 claims based on system art. *See id.*; Ex. 2006, 2008-2009.

Further, the parties in each of the Texas Cases have exchanged terms for claim construction, their proposed claim constructions, and extrinsic evidence. *See* Ex. 2001 at ¶9. Additionally, the defendants in the Dell Cases filed a partial motion to dismiss certain claims, and that motion has been fully briefed and is pending with the Court. *See id.* at ¶10; Ex. 2002 at 5-7 (Dkt. Nos. 16, 23, 27); Ex. 2003 at 7-9, 12 (Dkt. Nos. 17, 24, 31, 32, 35, 38, 78, 79, 81, 83); Ex. 2005 at 3-5 (Dkt. Nos. 13, 15, 21, 23, 26, 27, 29); Ex. 2022. Even if that motion were to be granted, the Dell Case will still go to trial. Further, on August 20, 2025, Patent Owner filed an amended complaint in the ASUSTeK Case and in the HP Case, *see* Ex. 2003 at 14, and those cases continue to move forward on the original schedule. In the Dell Case, the Dell

Defendants have issued subpoenas to Intel and Via Licensing Alliance and served interrogatories on Patent Owner, which Patent Owner has responded to. *See* Ex. 2001 at ¶11. The defendant in the HP Case filed a motion to dismiss for lack of venue, and the parties took discovery on venue before the defendant withdrew its motion. *See id.*; Ex. 2004 at 3-4 (Dkt. Nos. 12, 24, 25, 27).

Simply put, the parties and the courts have invested heavily, and are far along, in the Texas Cases, and there is no reason to believe a motion to stay is forthcoming in any of the district court cases involving the 437 Patent.

Even if a defendant in one of the Texas Cases were to file a motion to stay pending resolution of IPR, it is highly unlikely the district court would grant such a motion. First, any such motion filed *prior to an institution decision* would almost certainly be denied. The presiding judge in the consolidated ED Texas Cases, Judge Schroeder, has stated that the “traditional practice” in the Eastern District of Texas is to deny a motion to stay “when the PTAB has not yet acted on a petition for *inter partes* review.” *Maxell Ltd. v. Apple Inc.*, No. 5:19-CV-00036-RWS, 2020 U.S. Dist. LEXIS 257531, \*5-6 (E.D. Tex Apr. 27, 2020). Judge Albright, the presiding judge in the Dell Case, has made similar statements. *See Multimedia Content Mgmt. LLC v. Dish Network L.L.C.*, No. 6:18-CV-00207, 2019 U.S. Dist. LEXIS 236670, \*8 (W.D. Tex. May 30, 2019) (“[T]he most important factor bearing on whether to grant a stay . . . is the prospect that the [IPR] proceeding will

result in simplification of issues before the Court.’ . . . The Court finds that this factor strongly favors denying a stay. At the time this Motion was filed, the IPR Petition had not been instituted or denied by the PTAB; therefore, any simplification of the issues at trial after a PTAB decision will likely be minimal.”).

Second, even if the Board were to institute, a motion to stay still would likely be denied. Judge Albright and Judge Schroeder consistently deny motions to stay pending IPR. Since 2019, Judge Albright has denied 23 out of 32 contested motions to stay a case pending IPR, and, since 2016, Judge Schroeder has denied 11 out of 13 contested motions to stay a case pending IPR. *See* Ex. 2010; Ex. 2011.<sup>4</sup>

Further, there would be good reason for the courts to, consistent with their practices, deny a motion for a stay even if institution is granted. The institution decision is not expected until late December 2025. At that point, the Texas Cases will be even further along, with even more discovery having been taken and with all claim construction briefing having been completed and, in the ED Texas Cases, the *Markman* Hearings having been conducted. *See* Ex. 2012 at 4-5; Ex. 2013 at 3-4. And even if all four of Petitioners’ petitions are instituted in late December 2025,

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<sup>4</sup> The charts in these exhibits were taken from an August 1, 2025 search on Docket Navigator for results of contested motions to stay pending IPR in cases before Judge Albright and in cases before Judge Schroeder.

the Texas Cases would still involve three patents (the 443, 224, and 282 Patents) that are not subject to IPR, not to mention numerous other invalidity claims directed at the 437 Patent that cannot be addressed in an IPR, such as Section 101, Section 112, and system art-based Section 103 claims. *See* Ex. 2001 at ¶8; Exs. 2006, 2008-2009.

Given how late it will be in the Texas Cases and how many other patents and invalidity issues in those cases that will not be affected by IPR, it is highly unlikely any of the Texas Cases will be stayed even if institution is granted. *See Smart Mobile Techs. LLC v. Apple Inc.*, No. 6:21-cv-00603, 2023 U.S. Dist. LEXIS 137593, at \*18-19 (W.D. Tex. Aug. 8, 2023) (Albright, J.) (denying stay where institution was granted for some but not all asserted patents); *Kirsch Research v. Dupont de Nemours, Inc.*, No. 5:20-CV-00057, Dkt. No. 269 at 4 (E.D. Tex. July 7, 2021) (Schroeder, J.) (“[O]nly one of the two patents is subject to review, and the patents do not have overlapping subject matter. Accordingly, this factor weighs against a stay.”); *see also Uniloc USA, Inc. v. Motorola Mobility LLC*, No. 2:16-cv-00992-JRG, Dkt. No. 125 at 3 (E.D. Tex. Apr. 5, 2017) (denying a stay “given that the pending IPR petitions do not challenge every patent asserted in this case”).

Because there is no evidence that the Texas Cases will be stayed – and, in fact, precedent and the facts strongly suggest that they will not be stayed, regardless of whether the Board institutes – Factor 1 weighs against institution. *See Arm Ltd. v. Daedalus Prime LLC*, IPR2025-00207, Paper 10 at 2 (P.T.A.B. May 16, 2025)

(exercising discretion to deny institution in part because “there is insufficient evidence that the district court is likely to stay its proceeding even if the Board were to institute trial”).

**B. Factor 2: District Court Trials Will Occur Months Before the Deadline for an FWD**

*Fintiv* Factor 2 weighs heavily in favor of discretionary denial. Factor 2 looks to “proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision.” *Fintiv*, Paper 11 at 6. “If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution.” *Id.* at 9. Here, the ED Texas Cases are scheduled to go to trial on September 28, 2026.<sup>5</sup> *See* Ex. 2001 at ¶7; Ex. 2012 at 1. The deadline for an FWD – should the Board institute – on the other hand, is December 23, 2026. Moreover, the Docket Control Order in the ED Texas Cases states that the trial date is a “Court designated date” that is “not flexible without good

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<sup>5</sup> Trial is currently scheduled for March 29, 2027 in the Dell Case, but that date was set by Judge Robert Pitman before the case was transferred to Judge Alan Albright. After the transfer, Patent Owner filed a motion for entry of a new scheduling order that tracks Judge Albright’s exemplary scheduling order and that schedules trial for October 19, 2026. *See* Ex. 2001 at ¶7; Ex. 2020.

cause.” *See* Ex. 2012 at 1. Thus, the ED Texas Case trials involving the 437 Patent are scheduled to occur three months before the FWD deadline in this IPR, and if the Court grants Patent Owner’s motion in the Dell Case, trial in that case will occur two months before the FWD deadline. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 13 (P.T.A.B. May 13, 2020) (informative) (“We generally take courts’ trial schedules at face value absent some strong evidence to the contrary.”).

That the validity of the 437 Patent will be adjudicated by a district court between two to three months before the deadline for an FWD weighs strongly in favor of denial. Indeed, the Director has issued a number of discretionary denials under the new briefing procedures where the time between a district court trial and expected FWD was around three months or less. *See Advanced Micro*, Paper 9 at 2 (denying institution where trial date was scheduled 16 days before projected FWD date); *Shenzhen Tuozhu Tech. Co. v. Stratasy, Inc.*, IPR2025-00354, Paper 11 at 2 (P.T.A.B. June 12, 2025) (denying institution where scheduled trial date was a month and a half before projected FWD date and time-to-trial statistics suggested trial would occur the same month as the FWD due date); *Full-Metal-Power B.V. v. Infocus Downhole Solutions USA LLC*, IPR2025-00391, Paper 14 at 2 (P.T.A.B. June 25, 2025) (denying institution where the district court’s scheduled trial date was a little over five weeks before the projected FWD due date); *Cisco Sys., Inc. v. WSOU Investments LLC*, IPR2025-00429, Paper 15 at 2 (P.T.A.B. June 25, 2025)

(denying institution where the projected FWD due date was July 30, 2026 but the district court's scheduled trial date was April 20, 2026 and time-to-trial statistics suggested trial starting in March 2026); *Arm Ltd.*, IPR2025-00207, Paper 10 at 2 (denying institution where projected FWD due date was in June 2026 but scheduled trial date was January 26, 2026 and time-to-trial statistics suggested trial would begin between March and May 2026); *NXP USA, Inc. v. Redstone Logics LLC.*, IPR2025-00485, Paper 11 at 2 (P.T.A.B. July 10, 2025) (projected FWD due date on September 12, 2026, but district court trial scheduled for June 22, 2026); *see also 10X Genomics, Inc. v. President and Fellows of Harvard College*, IPR2023-01299, Paper 15 at 17 (P.T.A.B. Mar. 7, 2024) (finding factor 2 weighs in favor of discretionary denial where district court trial would occur at least one month before an FWD would be due).

**C. Factor 3: The Parties Will Have Invested Substantially in the District Court Cases Before Any Institution Decision**

Factor 3 looks at the “amount and type of work already completed in the parallel litigation by the court and the parties *at the time of the institution decision.*” *Fintiv*, Paper 11 at 9 (emphasis added). As discussed above, a pre-institution stay in the District Court is essentially out of the question. As also discussed above, already in the three Texas Cases – which each involve six asserted patents – initial disclosures, infringement contentions, and thousands of pages of invalidity

contentions have been exchanged; discovery, including third-party discovery, is well under way; several motions to dismiss have been briefed (with HP's having been withdrawn and Dell's partial motion not going to result in dismissal of the case even if granted); and the parties have exchanged terms for claim construction and served proposed claim constructions and supporting extrinsic evidence. Further, the parties in the Texas Cases have so far produced over 200,000 pages of documents combined, and discovery and other issues require near daily actions involving things like deficiency letters, response letters, additional follow-up, meet-and-confer conferences, motions, briefing, and argument. *See* Ex. 2001 at ¶12; *10X Genomics*, Paper 15 at 18 (noting that district court's consideration of two motions to dismiss, among other things, evince investment of a "significant amount of time and resources to the parallel proceeding").

And by the time the institution decision in this IPR is issued, *i.e.*, late December 2025, claim construction briefing will have been completed in the Texas Cases, the *Markman* Hearings will have been completed in the ED Texas Cases, and discovery will be even further along in the Texas Cases. *See* Ex. 2012 at 4-6; Ex. 2013 at 3-5. Further, in the ED Texas Cases, fact discovery closes on February 3, 2026, and opening expert reports are due February 10, 2026, so fact discovery will be almost complete and work with experts will be well under way by the time an institution decision is issued. *See* Ex. 2012 at 4.

In sum, the parties and the courts will have made a substantial investment in the Texas Cases prior to any institution decision, which weighs in favor of denial. Indeed, the Director recently exercised discretionary denial in an IPR where just a single parallel litigation was similarly as far along as the *three* parallel litigations are here. *See Advanced Micro*, Paper 9 at 2 (“[T]he parties have made meaningful investment in the district court proceeding. . . . [T]he parties have exchanged infringement and invalidity contentions, have already conducted over seven months of fact discovery, and a Markman hearing is scheduled to occur before the due date for an institution decision.”); *see also Elong International USA Inc. v. Feit Electric Co.*, IPR2025-00258, Paper 16 at 3 (P.T.A.B. June 25, 2025) (“[T]here has been meaningful investment by the parties in the district court proceeding, for example, a Markman hearing was scheduled for [before the institution decision], and fact discovery is scheduled to close soon.”); *Coretronic Corp. v. Maxell, Ltd.*, IPR2025-00474, Paper 11 at 2 (P.T.A.B. July 10, 2025) (same).

Petitioners’ lack of diligence in filing the Petition further swings Factor 3 in favor of Patent Owner. Petitioners waited over eight months after service of the Complaint in the Dell Case to file the Petition. *See Ex. 2002* at 4-5 (Dkt. Nos. 5, 7, 8). There is no reason it should have taken that long. The Petition challenges just 10 claims (claims 41-45, 47, 49-50, and 52-53). As Petitioners acknowledge, the three challenged independent claims (41, 52, and 53) share many of the same

limitations. *See* Pet. at 72-77. Further, Patent Owner served its infringement contentions for the 437 Patent (asserting infringement of just claim 41, just as the Complaint did) on the Dell Defendants on March 19, 2025 – ***more than two months before the Petition was filed.*** *See* Ex. 2001 at ¶8. In addition, two of the three references relied on in the Petition (Myers and Shin) are identified on the face of the 437 Patent (and Myers was the primary reference the Examiner relied on during examination), and the third reference (Kim) is a continuation-in-part of Shin, so Petitioners cannot pin their delay on a time-consuming prior art search. *See* Ex. 1001 at 2; Ex. 1005 at 22; Ex. 1007 at 1. If Petitioners had been diligent in filing the Petition – instead of taking over eight months to challenge three substantially similar independent claims based on art that was readily identifiable – “that diligence could [have] potentially mitigate[d] some of the investments in parallel proceedings that are at issue.” *Global Tel\*Link Corp. v. HLFIP Holding, Inc.*, IPR2021-00444, Paper 14 at 22-23 (P.T.A.B. July 22, 2021).

**D. Factor 4: There Is Substantial Overlap Between the IPR Proceeding and the Parallel Litigations**

Factor 4 favors denial “if the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding.” *Fintiv*, Paper 11 at 12. Here, there is substantial overlap between the issues raised in the Petition, on one hand, and in the Texas Cases, on the other hand,

and thus very real “concerns of inefficiency and the possibility of conflicting decisions.” *Id.*

Patent Owner has asserted claim 41 of the 437 Patent against the defendants in the Texas Cases. *See* Ex. 2001 at ¶8. The Challenged Claims include asserted claim 41, independent claims 52 and 53, which recite subject matter similar to that of claim 41 (*see* Pet. at 72-77), and dependent claims 42-45, 47, and 49-50. Thus, there is substantial claim overlap. *See Samsung Electronics Co. v. Clear Imaging Research, LLC*, IPR2020-01551, Paper 12 at 18-19 (P.T.A.B. Feb. 17, 2021) (“Petitioner does not show that the non-overlapping claims differ significantly in some way. . . . Rather, both sets of claims recite similar subject matter. . . . So, although the non-overlapping claims are challenged here, those claims are sufficiently similar to those at issue in the parallel proceeding.”); *Apcon, Inc. v. Gigamon Inc.*, IPR2020-01583, Paper 9 at 14 (P.T.A.B. Mar. 16, 2021) (in finding Factor 4 favors denial, noting that the additional claims challenged in the petition depend from a claim challenged in district court case).<sup>6</sup>

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<sup>6</sup> Even if there was not substantial overlap of the claims, it still would not be efficient to institute because the Board would have to expend resources determining the validity of claims (42-45, 47, 49-50, and 52-53) that are not asserted against the Dell

In addition, the prior art and ground relied on in the Petition are also raised in the Dell Case – in their invalidity contentions, the Dell Defendants assert that claim 41 of the 437 Patent would have been obvious over Kim combined with Shin and Myers. *See* Ex. 2006 at 69. This overlap of art and grounds weighs in favor of denial. *See PEAG LLC v. VARTA Microbattery GmbH*, IPR2020-01213, Paper 9 at 18 (P.T.A.B. Jan. 6, 2021) (“[S]ubstantially identical prior art and invalidity grounds are asserted in both the district court and the *inter partes* review proceedings. . . . Accordingly, the fourth *Fintiv* factor weighs in favor of exercising discretion to deny institution.”).

In the Petition, “Petitioner Dell stipulates, consistent with the stipulation made by the Petitioner in *Sotera* that, if the PTAB institutes this IPR, Petitioner Dell will not pursue in this litigation against the claims challenged in this IPR, (i) the specific grounds raised, or (ii) any other grounds that could have reasonably been raised before the PTAB in that instituted proceeding (*i.e.*, any ground that could have reasonably been raised under §§ 102 or 103 on the basis of prior art patents or printed publications).” Pet at 12. This stipulation is an empty gesture and does not make

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Defendants in district court and that Patent Owner would likely be estopped from later asserting under the doctrines of claim splitting and *res judicata*.

this proceeding a “true alternative” for several reasons.<sup>7</sup> *First*, the defendants in each of the ED Texas Cases (to whom “Petitioner Dell’s” stipulation does not apply) are asserting that claim 41 of the 437 Patent would have been obvious over Kim, Shin, and Myers. *See* Ex. 2008 at 57-58, 66; Ex. 2009 at 62, 69. Thus, the stipulation will not remove any prior art overlap between this IPR and the ED Texas cases.

*Second*, the Dell Defendants make invalidity arguments in district court that cannot be raised in an IPR and thus are unaffected by the stipulation. In that regard, they contend that claim 41 of the 437 Patent is invalid under Sections 101 and 112. *See* Ex. 2006 at 153-154, 160-161, 166-167. They also contend that claim 41 of the 437 Patent is anticipated by several “system” art references and would have been obvious over a number of combinations of references including one of the system art references. *See id.* at 67-68, 70-74. In particular, they rely on combinations of system art and each of Shin and Myers in arguing claim 41 of the 437 Patent would have been obvious. *See id.* at 70-74.

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<sup>7</sup> As an initial matter, it is not even clear who is offering the stipulation. There are two Dell entities identified as Petitioners and as defendants in the Dell Case, but only “Petitioner Dell” is offering the stipulation, and the Petition does not state if “Petitioner Dell” encompasses both Dell entities or just one.

In addition, the Federal Circuit has found that, while IPR estoppel precludes challenges in district court that “were raised or reasonably could have been raised during the IPR,” it “does not preclude a petitioner from relying on the same patents and printed publications as evidence in asserting a ground that could not be raised during the IPR, such as that the claimed invention was known or used by others, on sale, or in public use.” *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354 (Fed. Cir. 2025). So, Petitioner Dell’s *Sotera* stipulation does not encompass the substance of the very invalidity grounds raised in the Petition as long as an allegedly known, on sale, or in public use “system” is used to supplement or substitute for the teachings of the patents for at least one claim element. This “end-run” on IPR estoppel permitted by *Ingenico* renders the stipulation meaningless under the circumstances.

Therefore, even with the stipulation, the court in the Dell Case will still need to invest in fully understanding the claimed inventions of the 437 Patent, the scope and meaning of its claim terms, the level of skill in the art, the scope and content of the prior art (including Shin and Myers), and the 437 Patent’s advances over the prior art (in the case of analyzing eligibility under Section 101).

*Third*, because the stipulation limits Dell from raising any grounds that are raised or could have reasonably been raised in this IPR in only *the parallel district court case*, it will not, if institution is granted, prevent Petitioners from subsequently filing requests for *ex parte* reexamination of the 437 Patent based on such grounds.

Thus, the stipulation still allows for repeated challenges to the same patent by the same parties in multiple venues (including two within the USPTO itself – the PTAB and the Central Reexamination Unit), obviating the very purpose of the IPR process, which is to streamline the patent system and reduce litigation costs.<sup>8</sup> *See Apotex Inc. v. Alkermes Pharma Ireland Ltd.*, IPR2025-00514, Paper 10 at 2 (P.T.A.B. July 2, 2025) (“It is not an appropriate use of Office resources to review a patent in two separate, concurrent Office proceedings, especially when the issues and evidence in those proceedings has substantial overlap.”).

In sum, Petitioner Dell’s *Sotera* stipulation does not meaningfully simplify the parallel litigations or increase efficiency – rather, if institution is granted, the Dell Defendants get two bites at the invalidity apple, while the Board and the district courts in the Texas Cases perform similar invalidity analyses and potentially arrive at inconsistent results (*e.g.*, different claim constructions). It is for these kinds of

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<sup>8</sup> To make matters worse, Petitioners’ stipulation does not prevent a scenario where (i) Petitioner Intel, who is not a party to any of parallel district court litigations, requests *ex parte* reexamination of the 437 Patent based on a first set of grounds that were raised or could have been raised in the Petition, (ii) and the Dell Defendants separately request *ex parte* reexamination of the 437 Patent based on a second set of grounds that were raised or could have been raised in the Petition.

reasons that the Director has found on multiple occasions that a *Sotera* stipulation “does not eliminate” inefficiencies taken into consideration under Factor 4. *Shenzhen*, Paper 11 at 2-3; *see also Motorola Sols. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3–4 (P.T.A.B. Mar. 28, 2025) (“Petitioner’s invalidity arguments in the district court are more expansive and include combinations of the prior art asserted in these proceedings with unpublished system prior art, which Petitioner’s stipulation is not likely to moot.”); FAQs for Interim Processes for PTAB Workload Management (“FAQS”) at Question 15 (“Where the petitioner is relying on corresponding system art in a co-pending proceeding and/or several other invalidity theories, a stipulation may not be particularly meaningful because the efficiency gained by any AIA proceeding will be limited.”).<sup>9</sup>

As there clearly will be significant – if not complete – overlap between this IPR and the parallel litigations, Factor 4 weighs in favor of discretionary denial.

**E. Factor 5: The Dell Defendants Are Also Petitioners**

When “the petitioner and the defendant in the parallel proceeding are the same party,” this factor weighs in favor of discretionary denial. *Fintiv*, Paper 11 at 15. Here, two of the three petitioners – the Dell Defendants – are the defendants in the Dell Case.

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<sup>9</sup> <https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management>.

Moreover, that Intel is not a party to any of the parallel litigations, and that the parties to the ED Texas Cases are not petitioners in this IPR, does not affect the Factor 5 analysis. In *Fintiv*, the Board stated that

Even when a petitioner is unrelated to a defendant, however, if the issues are the same as, or substantially similar to, those already or about to be litigated, or other circumstances weigh against redoing the work of another tribunal, the Board may, nonetheless, exercise the authority to deny institution. An unrelated petitioner should, therefore, address any other district court or Federal Circuit proceedings involving the challenged patent to discuss why addressing the same or substantially the same issues would not be duplicative of the prior case even if the petition is brought by a different party.

*Fintiv*, Paper 11 at 14. As discussed above, the issues in this IPR substantially overlap with those in the Texas Cases, and Petitioners have not explained how addressing the issues in this IPR would not be duplicative of work done in the Texas Cases. Further, Intel has a relationship with defendants in the Texas Cases and is coordinating with them. The same firm (Baker Botts) is counsel for Petitioners *and* for the defendants in the Dell and ASUSTeK Cases, and the Desmarais firm, which is known to represent Intel in patent matters, is also counsel for defendants in the Dell Case and was counsel for the defendant in the Lenovo Case. *See, e.g., XMTT, Inc. v. Intel Corp.*, No. 2023-1712, 2024 U.S. App. LEXIS 29850 (Fed. Cir. Nov. 21, 2024) (identifying Desmarais as counsel for Intel).

Accordingly, *Fintiv* Factor 5 weighs in favor of discretionary denial. See *Mylan Labs*, Paper 17 at 23 (“[B]ecause the Petitioner is the same as the defendant in the *Mylan* litigation, and because the issues in both the *Teva* and *Mylan* litigations are substantially the same as those raised in the Petition, *Fintiv* factor # 5 favors denial.”); *Fitbit*, Paper 13 at 15-16 (finding Factor 5 weighs in favor of denial where petitioner was defendant in only one of two district court cases involving challenged patent); *Entegris, Inc. v. Inpria Corp.*, IPR2025-00267, Paper 12 at 2 (P.T.A.B. July 2, 2025) (“though Petitioner is not a named defendant in the parallel district court proceeding, the parties are related, the validity of the challenged patent is already being adjudicated in another forum that will issue an earlier decision, and the issues presented in the Petition are ‘the same as, or substantially similar to, those already or about to be litigated,’ all of which favor discretionary denial”); see also *Arm*, Paper 7 at 8 and Paper 10 (denying institution; one of the two petitioners – Arm – was not involved in the district court litigation).

**F. Factor 6: Other Factors that Impact the Board’s Exercise of Discretion Favor Denial**

Because the other five *Fintiv* Factors favor discretionary denial, the Board “need not decide whether the merits of [Petitioners’] asserted grounds are particularly strong because it would not impact [its] ultimate determination under § 324(a).” *NXP USA, Inc. v. Impinj, Inc.*, PGR2022-00005, Paper 18 at 12-13

(P.T.A.B. May 2, 2022) (finding Factor 6 analysis unnecessary and denying institution based on Factors 1-5).

Nevertheless, consideration of other circumstances that impact the Board's exercise of discretion also heavily weighs in favor of discretionary denial. To start with, the fact that the 437 Patent is at issue in *three* parallel litigations is an “other circumstance” that strongly favors denial under *Fintiv*. See *Comcast Cable Commc'ns, LLC v. Entropic Commc'ns, LLC*, IPR2025-00183, Paper 11 at 3 (P.T.A.B. June 25, 2025) (“Because there are multiple ongoing district court proceedings, discretionary denial of the Petitions reduces the chances of duplicative workloads and inconsistent outcomes.”).

Further, as will be demonstrated in Patent Owner's forthcoming Preliminary Response (to which Patent Owner directs the Director's attention pursuant to FAQs at Question 25), and as discussed in more detail below, the Petition fails to present any compelling merits of unpatentability.

In addition, as discussed in more detail below, (i) the prior art relied upon in the Petition is the same, or is substantially the same, as art that was considered during prosecution of the 437 Patent, (ii) the 437 Patent was in force for over a decade and actively licensed, and the Dell Defendants have been aware of it since at least 2021, (iii) Petitioners extensively rely on unfocused expert testimony in the Petition to fill in gaps in the invalidity grounds, and (iv) the district courts provide a better forum

than the PTAB for Patent Owner to take discovery that will support its non-obviousness arguments.

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Accordingly, all six *Fintiv* Factors weigh in favor of the Board exercising its discretion to deny the Petition.

#### **IV. DISCRETIONARY DENIAL IS APPROPRIATE UNDER 35 U.S.C. § 325(d)**

In determining whether to deny institution under 35 U.S.C. § 325 (d), the Board applies a two-part framework to determine: “(1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of [the] first part of the framework is satisfied, whether the Petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (P.T.A.B. Feb. 13, 2020).

To apply this framework, the *Becton, Dickinson* (“BD”) factors “provide useful insight.” *Id.* at 9-10. The nonexclusive BD factors are:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;

- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art;
- (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

*Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17-18 (P.T.A.B. Dec. 15, 2017).

“[BD] factors (a), (b), and (d) relate to the first part of the *Advanced Bionics* framework (whether the same or substantially the same art or arguments previously were presented to the Office), and [BD] factors (c), (e), and (f) relate to the second part of that framework (previous Office error).” *Autel Intelligent Technology Corp., Ltd., v. Orange Electronic Co., Ltd.*, IPR2021-01545, Paper 8 at 13 (P.T.A.B. Apr. 8, 2022). “If a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute *inter partes* review.” *Advanced Bionics*, IPR2019-01469, Paper 6 at 8-9.

Part one of the *Advanced Bionics* framework is met here because the art relied on in the Petition is the same or substantially the same as the art that was previously presented to the Office. For part two, Petitioners have not demonstrated material error by the Office.

**A. The Prosecution History of the 437 Patent**

The application that issued as the 437 Patent was thoroughly examined by the Office. Indeed, the application was pending before the Office for *over six years*, and the Examiner rejected claims of the application (i) for obviousness-type double patenting over a related application, and (ii) as anticipated or obvious over Myers. *See* Ex. 1002 at 237-243, 170-175. During the course of prosecution, the applicant submitted several references, including Shin, to the Office in Information Disclosure Statements (“IDS”), which the Examiner considered. *See id.* at 246, 279-284. The Examiner ultimately allowed the claims over Myers. *See id.* at 164-168.

**B. The First *Advanced Bionics* Factor Is Met Because Petitioners’ References are the Same, or Substantially the Same, as the Prior Art Previously Presented to the Office**

The references relied on in the Petition – Kim, Shin, and Myers – are the same, or substantially the same, as the art that was presented to the Office during prosecution of the 437 Patent.

**1. Myers and Shin Were Considered by the Examiner**

First, with respect to BD Factor (a), both Myers and Shin were considered by the Examiner. As discussed above, Myers was considered and applied by the Examiner during examination. *See* Ex. 1002 at 237-243. Shin was submitted to the Office in an IDS on April 18, 2014, and the Examiner subsequently initialed the Shin reference on the IDS to indicate he considered it. *See id.* at 246, 279-284. The 437 Patent later issued with Shin and Myers listed as “References Cited.” *See* Ex. 1001 at 2. Thus, Myers and Shin indisputably are “the same . . . art previously . . . presented to the Office” and satisfy the first part of the *Advanced Bionics* framework. *See Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 at 4 (P.T.A.B. May 19, 2025).

**2. Kim Is Cumulative of, and Substantially Similar to, Art Considered by the Examiner**

With respect to BD Factors (a) and (b), though Kim was not presented to the Office during prosecution of the 437 Patent, that reference is substantially similar to, and cumulative of, art considered and applied by the Examiner and thus satisfies the first part of the *Advanced Bionics* framework.

To start with, Kim is a continuation-in-part of Shin, claims priority to Shin, claims priority to the same provisional application as Shin, and incorporates Shin by reference. *See* Ex. 1005 at 22 (“The present application is a continuation-in-part of

U.S. patent application Ser. Nos. 60/004,907, abandoned, and 08/723,694 [the application that issued as Shin] . . . filed on Oct. 6, 1995 and Sep. 30, 1996 which is incorporated herein by reference.”); Ex. 1007 at 1. Accordingly, there is a significant overlap of subject matter disclosed in Kim and Shin.

In addition, for every portion of a limitation in the Challenged Claims that Petitioners rely on Kim to teach, (i) the Examiner found Myers teaches the limitation, or (ii) Kim is materially cumulative to Shin. Using Petitioners’ claim limitation identifiers, Petitioners assert that Kim teaches the following limitations (or portions of the following limitations) that the Examiner found Myers teaches: [41.0]-[41.4], [52.0]-[52.4], and [53.0]-[53.4]. *See* Pet. at 25-44, 72-75; Ex. 1002 at 240-241 (finding Myers anticipates original claim 54) and at 428 (showing limitations of original claim 54, which are recited in challenged independent claims 41, 52 and 53).

For the “generating burst of the encoded control words” and “encoded control words” limitations recited in [41.5]-[41.7], the Petition purports to rely on Kim and Shin, but the Petitioners’ argument is that Shin provides this disclosure. *See* Pet. at 50. (“Thus, Kim’s repeated transmission of 10-bit IDLE words, which may be generated by encoding control bits *as described by Shin*, renders obvious ‘generating bursts of encoded control words by encoding control bits.’”) (emphasis added). Further, to the extent it matters to Petitioner’s argument that Kim’s purported

burst of encoded control words comprises “IDLE words” – a term not used in the Challenged Claims – Shin also describes transmitting idle words and other similar control words. *See* Ex. 1007 at 6:32 (“preambling pattern and link idle pattern”) and 14:44-45 (“preamble sequence is produced by the encoder 18 at various times (e.g., at system power-up”).

For the “generating a sequence of selected code words by encoding the input data,” “wherein each of the selected code words is a member of a robust subset of the full code word set,” “the sequence of selected code words is less susceptible to inter-symbol interference during transmission over the link than would be the conventional sequence of code words,” and “the burst of the selected code words” limitations recited in [41.2]-[41.4], [41.6], [41.7], [42.1], [43.1], [44.1], [45], [47], [49.2], [50.2], [52.5], [53.5], and [53.6], Petitioners purport to rely on Myers and Kim, but Petitioners’ argument shows that they are relying on Kim only for its disclosure of transmitting multimedia data (*e.g.*, audio data) in a stream with video data. *See* Pet. at, *e.g.*, 34, 51-55. The Petition admits that Kim does not disclose or suggest any particular encoding scheme (*e.g.*, a robust scheme that is less susceptible to inter-symbol interference) for both audio and video data. *See* Pet. at 21 (“Kim leaves the selection of encoding schemes for both audio and video up to a POSITA[.]”). Instead, the Petition “relies on Myers[‘] . . . selecting a subset of the available encoder output values that provide improved transmission reliability.” *Id.*

at 22. Thus, it appears that the Petition only introduced Kim for its disclosure of transmitting multimedia, *i.e.*, audio and video data. *See* Ex. 1005 at 1:36. But Shin also discloses communicating data in a “multimedia environment.” *See* Ex. 1007 at 8:8. Therefore, because Shin discloses the aspects of Kim that the Petition relies on, Kim is cumulative of Shin.

Accordingly, Kim is cumulative of, and “substantially the same as,” the Myers and Shin references that “previously [were] presented to the Office” and thus satisfies the first part of the *Advanced Bionics* framework. *See Regeneron Pharms., Inc. v. Merus N.V.*, 864 F.3d 1343, 1350 (Fed. Cir. 2017) (“A reference is cumulative when it teaches no more than what a reasonable examiner would consider to be taught by the prior art already before the PTO.”); *Litton Indus. v. Solid State Sys.*, 775 F.2d 158, 167 (Fed. Cir. 1985) (references cumulative because, though structurally different, “they have the same relative degree of materiality with respect to the claimed invention”); *Biocon Pharma Ltd. v. Novartis Pharmaceuticals Corp.*, IPR2020-01263, Paper 12 at 10-11 (P.T.A.B. Feb. 16, 2021) (petition references are substantially the same as art previously presented to the Office because they did not provide any additional information relevant to the claim limitations at issue); *Helena Lab. Corp. v. Sebia SA*, IPR2024-00801, Paper 10 at 14-15 (P.T.A.B. Oct. 23, 2024) (“Patent Owner argues that Coufal is substantially similar to previously considered references because Coufal does not address any claim feature additional to or

different from features already addressed by Sunzeri, Camilleri, and Nouadje . . . [W]e agree . . . that Coufal is cumulative to Camilleri, and Coufal's teachings are substantially similar to those in Sunzeri, Camilleri, and Nouadje . . . ."); *Sandoz, Inc. v. Acerta Pharma BV*, IPR2023-00478, Paper 17 at 15 (P.T.A.B. Aug. 7, 2023) (“[W]e agree . . . that Cheson is cumulative to the teaching in Smyth and Evarts relied on by the Examiner for multiple daily dosing of a BTK inhibitor and, therefore, is ‘substantially the same art.’”).

**C. Petitioners Have Not Shown the Office Erred Materially**

Because the first part of the *Advanced Bionics* framework is satisfied, Petitioners are required to show that the Office erred in a manner material to the patentability of the Challenged Claims. In doing so, Petitioners “must explain, ‘with reference to *Becton Dickinson* factors (c), (e), and (f), how the Examiner erred in overlooking the prior art” and “if the Examiner applied the asserted prior art or substantially the same prior art during examination, then a petitioner must demonstrate that . . . the previously presented art teaches the limitations of the challenged claims, and that no reasonable examiner could have found otherwise.” *Ecto World*, Paper 13 at 5-6; *see also Advanced Bionics*, Paper 6 at 9 (“If reasonable minds can disagree regarding the purported treatment of the arts or arguments, it cannot be said that the Office erred in a manner material to patentability.”).

Petitioners, however, have made no effort to meet this burden, and, in fact, cannot meet it.

Regarding BD Factor (c) – the extent to which the asserted art was evaluated during examination – the Examiner thoroughly examined the claims of the 437 Patent, rejecting claims for obviousness type double patenting and as anticipated or obvious over Myers. As part of that thorough examination, the Examiner considered Myers and Shin, which, as discussed above, are substantially the same as Kim. Further, it is highly unlikely the Examiner failed to give Shin serious consideration given the reasonable number of references (29) that were cited during prosecution of the 437 Patent. *See* Ex. 1001 at 1-2. Moreover, the Board has found that a petitioner must provide an analysis under part two of *Advanced Bionics* (and cannot rely on the alleged strength of its unpatentability grounds) for art that was identified on an IDS but not applied by the Examiner, but Petitioners have failed to do so with respect to Shin. *See Ecto World*, Paper 13 at 5.

Regarding BD Factor (e), Petitioners have not explained how the Examiner erred in evaluating Myers or Shin – despite having the burden of doing so. *Nespresso USA, Inc. v. K-Fee Sys. GmbH*, IPR2021-01223, Paper 9 at 29 (P.T.A.B. Jan. 18, 2022) (“Petitioner bears the burden of showing that the Office erred . . .”). That alone is sufficient to deny institution. *See Sony Interactive Entm’t LLC v. Terminal Reality, Inc.*, IPR2020-00711, Paper 15 at 11-12 (P.T.A.B. Oct. 13, 2020)

(denying institution under § 325(d) where Petitioner was silent on BD Factors (e) and (f)).

Finally, regarding BD Factor (f), the Board “look[s] for some explanation of how or why ‘the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.’” *Nespresso*, Paper 9 at 30. Here, Petitioners point to no additional evidence or facts in the Petition that warrant a do-over based on Petitioners’ duplicative art. Indeed, as discussed above, Kim is cumulative of, and substantially the same as, the art that was thoroughly considered by the Examiner.

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Denial is therefore appropriate under the *Advanced Bionics* framework.

## **V. ADDITIONAL FACTORS SUPPORTING DISCRETIONARY DENIAL**

The Director’s Memorandum identifies several additional factors that further support the exercise of discretionary denial here, including:

- The settled expectations of the parties, such as the length of time the claims have been in force;
- The strength of the unpatentability challenge;
- The extent of the petition’s reliance on expert testimony; and
- Any other considerations bearing on the Director’s discretion.

For the reasons discussed below, these factors further support discretionary denial.

**A. The Settled Expectations of the Parties and Efficiency Weigh Against Institution**

Institution would unjustly deprive Patent Owner of its reasonable and well-settled expectations that it may rely on its property rights in the 437 Patent. The application that issued as the 437 Patent was published in March 2003 – over 22 years ago. *See* Ex. 1001 at 1. The 437 Patent issued in April 2008 and is now expired. *See id.* Thus, the public has known about the subject matter claimed in the 437 Patent since at least March 2003, and the 437 Patent was in force for well over 10 years. That alone is reason to deny institution. Indeed, the Director recently found that the fact that a patent was in force for eight years created settled expectations and warranted discretionary denial. *See Dabico Airport Solutions Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 2-3 (P.T.A.B. June 18, 2025) (“the considerations favoring discretionary denial outweigh those that counsel against it. In particular, the challenged patent has been in force almost eight years, creating settled expectations . . . . Although there is no bright-line rule on when expectations become settled, in general, the longer the patent has been in force, the more settled expectations should be.”); *see also Samsung Electronics Co. v. Sinotechnix LLC*, IPR2025-00331, Paper 13 at 2 (P.T.A.B. July 2, 2025) (“the challenged patents have been in force for more than 10 years, creating strong settled expectations”); *Samsung Electronics Co., v. Cerence Operating Co.*, IPR2025-00458, Paper 14 at 2 (P.T.A.B.

June 25, 2025) (settled expectations weigh toward discretionary denial where the challenged patents “issued over 11 years ago”).

Moreover, because the subject matter of the 437 Patent has been published online for all to see since March 2003, it is not necessary for Petitioners to have had actual notice of the 437 Patent, or their infringement of it, to create settled expectations. *See Dabico*, Paper 21 at 3 (“[P]atent applications (after 18 months) and issued patents are almost always publicly available to provide notice to the public, other inventors, competitors, and commercial interests. . . . As such, actual notice of a patent or of possible infringement is not necessary to create settled expectations.”). Indeed, large, sophisticated technology companies like the Dell Defendants and Intel would have had no problem finding the 437 Patent after it issued.

Further, the 437 Patent has been actively enforced and licensed in the industry – putting industry players on notice of the patent. Patent Owner’s predecessor-in-interest sued Technicolor for infringement of the 437 Patent in 2016. *See Lattice Semiconductor Corporation v. Technicolor SA et al.*, No. 4-16-cv-00668 (N.D. Cal.). That case resulted in a settlement agreement including a payment to the patent owner. *See Ex. 2021. And Via Licensing Alliance (“Via LA”)*, a patent pool administration company, has licensed the 437 Patent in its DisplayPort patent portfolio on behalf of Patent Owner and its predecessors-in-interest. Via LA’s

webpage lists dozens of companies that have licensed Patent Owner's 437 Patent (now identified as expired) as part of that portfolio. *See* Ex. 2014; Ex. 2015. In fact, dozens of companies have been licensing the 437 Patent since at least 2021, when MPEG LA (Via LA's predecessor) was responsible for licensing the DisplayPort patent portfolio. *See* Ex. 2016; Ex. 2017.

And even though actual notice is not required for discretionary denial, in this case, Petitioners ***had actual notice*** of the 437 Patent ***and*** their infringement ***for years*** before they filed the Petition. MPEG LA, on behalf of Patent Owner and its predecessors-in-interest, actively sought to license the 437 Patent in Petitioners' technology space. In March 2015, MPEG LA provided notice to the Dell Defendants (1) of Standard Essential Patents ("SEPs") then administered and licensed by MPEG LA; (2) that such patents had been found by an independent patent consultant to be essential to various DisplayPort standards; and (3) that Dell, as a "company that offer[ed] products with DisplayPort technology[,] need[ed] to be licensed under [those] essential patents and [would] benefit from the coverage that [the] DisplayPort License provides." *See* Ex. 2018 at 1. In the same letter, MPEG LA advised Dell that the portfolio of DisplayPort SEPs it was offering for license would be amended by the periodic posting of an updated list of patents on its website (<http://www.mpegla.com/main/programs/DisplayPort/Pages/PatentList.aspx>). *See id.* at 4. MPEG LA sent a similar letter to Intel in March 2015. *See* Ex. 2019.

Subsequently, on June 1, 2021, the 437 Patent was posted on that website – putting Petitioners on notice of the 437 Patent and their infringement of it. *See Ex. 2017.*

Thus, **for almost four years**, Petitioners could have done something about any concern about the validity of the 437 Patent but chose not to. Accordingly, the parties' expectations regarding the validity of the 437 Patent were well settled, and, for this additional reason, institution should be denied. Indeed, the Director has found that similar circumstances warranted denying institution, even when other factors favored institution. *See iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 at 2-3 (P.T.A.B. June 6, 2025) (finding facts that “one of the [challenged] patents” had been in force since 2012 and that Petitioner knew of it since 2013 but “fail[ed] to seek early review of the patents” outweigh “several” considerations the Board found went against discretionary denial); *Nvidia Corp. v. Neural AI, LLC*, IPR2025-00606, Paper 18 at 2-3 (P.T.A.B. July 31, 2025) (denial appropriate because Petitioner had actual notice of the challenged patent due to fact that in 2017 Patent Owner sent Petitioner a presentation with its patent portfolio, which included the challenged patent).

There are yet other reasons the “settled expectations” factor weighs in favor of denial. In the many years after its issuance, and despite MPEG LA and Via LA's efforts to license the 437 Patent to major players in the industry, no party has invalidated the claims of the 437 Patent, or, prior to this IPR, even sought to

challenge the claims of the 437 Patent in the Office. Further, in reliance on the 437 Patent's presumption of validity, General Video's predecessor-in-interest paid the 3.5, 7.5, and 11.5 year maintenance fees for the 437 Patent.

Moreover, proceeding with an IPR of the *expired* 437 Patent is an inefficient use of the Board's and the parties' resources. While there is a claim for past damages attributable to infringing the patent in district court cases, the limited nature of that dispute does not justify expending the Board's resources on a review of the 437 Patent. There is little potential benefit to the industry or the public at large in the Board canceling a patent that has already expired. The subject matter of this patent is already available to the public. Instituting review here is therefore unlikely to expand the industry's freedom to operate in this space and, consequently, does not promote the legislative purpose of IPR proceedings. *See Hunting Titan, Inc. v. DynaEnergetics Europe GmbH*, 28 F.4th 1371, 1381 (Fed. Cir. 2022) (observing that the "basic purpose of IPR proceedings" is to reexamine an earlier agency decision to "[keep] patent monopolies . . . within their legitimate scope").

**B. The Lack of Strength of the Unpatentability Challenge**

As discussed above in section IV.B., the Petition relies on prior art that is the same as, or cumulative to, prior art that was before the Office during examination. And even so, the Petition fails to present any compelling merits of unpatentability. It does not present anticipatory prior art under Section 102. Instead, the Petition

relies *solely* on obviousness arguments based on combinations of art, which highlight the novelty of the Challenged Claims. Further, the obviousness assertions are exceptionally weak, relying on conclusory and hindsight-based expert testimony.

For example only (other reasons why the Petition does not demonstrate unpatentability will be provided in the Patent Owner's Preliminary Response), although Kim does not disclose encoding audio data using a subset of codewords that increase robustness, the Petition asserts that "it was known that when transmitting both video and audio, that audio data should be encoded more robustly." Pet. at 22. However, no reference teaches that normal encoding is insufficient for audio data. Instead, the Petition relies solely on conclusory expert testimony. Ex. 1003 at ¶75. This conclusory testimony refers to tertiary references, Asai, Altmann, and Pasqualino, but none of those references describes transmitting audio data using a set of robust codewords or, more particularly, one that is less susceptible to inter-symbol interference; at best they observe a desire to transmit or reproduce audio without substantial errors. And to the extent these references describe any particular way to reduce errors, they employ something other than the inventions of the Challenged Claims. *See, e.g.*, Altmann (Ex. 1010) (describing error correction and retransmission); Pasqualino (Ex. 1009) (describing optional error correction codes and redundancy, *i.e.*, transmitting multiple copies of data). The Petition and Petitioners' expert do not provide any reason why one of skill in the art would find

conventional codewords insufficient or necessarily implement transmission using a robust codeword set that is less susceptible to inter-symbol interference. It is readily apparent that only improper hindsight led Petitioners and their expert to choose the claimed robust codeword set for audio data among a multitude of other possible ways to transmit audio data.<sup>10</sup>

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<sup>10</sup> See, e.g., *TQ Delta, LLC v. CISCO Sys., Inc.*, 942 F.3d 1352, 1362 (Fed. Cir. 2019) (“Untethered to any supporting evidence, much less any contemporaneous evidence, [the expert’s] *ipse dixit* declaration ‘fail[s] to provide any meaningful explanation for why one of ordinary skill in the art would be motivated to combine these references *at the time of this invention.*’ *InTouch*, 751 F.3d at 1353-54 (emphasis added). It also ‘fails to explain why a person of ordinary skill in the art would have combined elements from specific references *in the way the claimed invention does.*’ *ActiveVideo*, 694 F.3d at 1328 (first citing *KSR*, 550 U.S. at 418; then citing *Innogenetics*, 512 F.3d at 1373). Without this support, Dr. Tellado's declaration ultimately fails ‘to resist the temptation to read into the prior art the teachings of the invention in issue.’ *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 36, 86 S. Ct. 684, 15 L. Ed. 2d 545 (1966).”).

Discretionary denial is appropriate for all of the other reasons provided herein. Petitioners' grounds do not diminish any of those reasons but, rather, the lack of strength of those grounds support discretionary denial.

**C. The Petition Relies Heavily on Unfocused Expert Testimony**

As the Office has explained, “[w]hile the Board may consider expert testimony, *as a matter of efficiency, extensive reliance on expert testimony* and/or reasonable disputes between experts on dispositive issues may suggest that the questions are better resolved in an Article III court.” FAQs at Question 22 (emphasis added). The Office has further explained that it “is most helpful if an expert is providing *focused testimony*, for example to provide helpful context or to explain terms of art. The *failure to provide focused expert testimony* may weigh against institution.” *Id.* (emphasis added).

Petitioners run afoul of this guidance by relying *extensively* on the testimony of their expert, Dr. Andrew Wolfe, throughout the Petition. Dr. Wolfe's declaration is submitted as an exhibit to the Petition in this IPR and to the Petition in the other IPR directed to the 437 Patent, IPR2025-01039. Dr. Wolfe is a professional expert (see Ex. 1004 at 1), and, while the Petition in this IPR is “only” 77 pages long and the Petition in IPR2025-01039 is “only” 91 pages long, his declaration is **218** pages long and includes **461** paragraphs. The Petition cites to and relies on Dr. Wolfe's declaration **170 times**, directing the Board to consult the declaration for effectively

every substantive argument made for every limitation. This is far from an “efficient” use of “focused” expert testimony. Further, such heavy reliance on expert testimony is more appropriate in the parallel district court cases where the judges and juries can hear expert testimony live and assess its credibility firsthand.

Moreover, the Office has also explained that petitions are “require[d] to be based on prior art patents and printed publications” and that “it is not necessary for an expert to explain every aspect of the prior art,” FAQs at Question 22, but here the Petition relies heavily on Dr. Wolfe’s assumptions about what a POSITA would have purportedly known a reference to teach instead of just the reference’s teachings.

Just a few examples are as follows:

- “Kim explains that ‘for stream 1 to n each stream has a dedicated coder 40*b* to 40*n*, respectively, to encode each particular data stream.’ . . . Thus, any of Kim’s encoders generates a sequence of code words. Because the output words are selected from a code word set, they are “*selected*” words as claimed.”
- A POSITA would have understood that a ‘symbol’ simply refers to the 10-bit encoded word.”
- “While the full scope of this claim limitation is not clear . . . whatever “*the video code words*” references would have encompassed at least the bursts of “*video code words*” disclosed by Kim.”
- “While the full scope of this claim limitation is not clear . . . whatever “*the burst of the selected code words*” references would have encompassed at least

some portion (or the whole sequence) from the previously recited “*sequence of selected code words*” disclosed by Kim.”

- “While the scope of “*the preferred words*,” “*the non-preferred words*,” and “*the full set*” is not clear . . . the claim terms would have encompassed at least the concept that the “*selected code words*” have fewer contiguous ones and zeroes than the conventional set, which is taught by Kim and Myers.”

Pet. at 34-35, 43, 50, 51, 73; Ex. 1003 at 155, 171, 181, 211. Many other such statements permeate the Petition.

As yet further evidence of the Petition’s heavy and inefficient reliance on unfocused expert testimony, the language in the Petition often largely tracks that found in the expert declaration. As shown below, in just one example, the language in the Petition and the language in Dr. Wolfe’s declaration is almost identical:

A POSITA would have found it obvious to use known options for transmitting data stream separation words—using one or more control words to indicate the start or end of a stream. Ex.1003, ¶407. Providing repeated guard band words helps to ensure that a guard band word is not missed by the receiver. Applying Myers’ repeated start word technique to Kim’s data separation start word is merely applying a known technique to a known method to yield predictable results. Ex.1003, ¶407[.]

Pet. at 59-60.

**407.** A POSITA would have found it obvious to use known options for transmitting data stream separation words—using one or more control words to indicate the start or end of a stream. Providing repeated guard band words helps to ensure that a guard band word is not missed by the receiver. Applying Myers' repeated start word technique to Kim's data separation start word is merely applying a known technique to a known method to yield predictable results.

Ex. 1003 at ¶ 407.

This is the opposite of the “focused expert testimony” the Office has requested. Petitioners' extensive reliance on unfocused expert testimony that largely parrots the Petition weighs in favor of denial. *See Kinetic Techs., Inc. v. Skyworks Solutions, Inc.*, IPR2014-00529, Paper 8 at 15 (P.T.A.B. Sep. 23, 2014) (“Merely repeating an argument from the Petition in the declaration of a proposed expert does not give that argument enhanced probative value.”).

The Petition pays lip service to the Office's “focused testimony” requirement by baldly asserting that the “declaration provides focused expert testimony on the following topics: (i) the level of skill in the relevant art; (ii) technical background, (iii) overview of the '437 patent, (iv) claim construction, (v) key teachings of the prior art, and (vi) motivations to combine. Ex.1003, ¶¶26-54.” Pet. at 6. However, even assuming *arguendo* that this attorney argument is correct and that paragraphs 26-54 of the declaration do include focused testimony, in making this statement,

Petitioners are tacitly admitting that the **430+ *additional paragraphs*** of the declaration that the Petition extensively cites to and relies on do not include focused testimony.

**D. Other Considerations**

There are still other reasons the Board should exercise discretionary denial. First, there have been no changes in the law or new judicial precedent issued since the claims of the 437 Patent issued that may affect patentability.

Second, there are discovery-related issues that make the district courts in the Texas Cases better forums to resolve the issue of invalidity than the PTAB. As all the grounds in the Petition are based on obviousness and rely heavily on expert opinion, evidence of secondary considerations is likely to be an important aspect of Patent Owner's validity case. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538 (Fed. Cir. 1983) (“[E]vidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art was not.”). At least some such evidence is likely to be in the possession of parties besides Patent Owner.

Patent Owner's ability to obtain that evidence, however, will be hamstrung by the Board's policy limiting “non-routine” discovery (*i.e.*, discovery that is routinely permitted in district court but not in PTAB proceedings). *See* 37 C.F.R. §§ 42.51(b); *Garmin Int'l Inc., v. Cuozzo Speed Techs.*, IPR2012-00001, Paper 26 at 5 (P.T.A.B.

Mar. 5, 2013) (“discovery [in IPRs] is limited as compared to that available in district court litigation”). In particular, the Board’s discovery procedures require a party to already have some of the information that it seeks to discover. *Id.* at 6 (“The party requesting discovery should already be in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered.”). Further, obtaining a subpoena for third-party discovery in an IPR is governed by 35 U.S.C. § 24, which requires “application” for subpoenas to the district court—a process that is not often used. *See Waterdrop Microdrink GmbH v. Qingdao Ecopure Filter Co.*, No. 2:23-MC-00123, 2024 WL 277461, at \*4 (C.D. Cal. Jan. 18, 2024); *see also* 37 C.F.R. § 42.52 (requirements for compelling testimony and production). In contrast, in the Texas Cases, Patent Owner is not so hamstrung in taking discovery and can seek secondary consideration evidence through normal district court discovery mechanisms (document requests, interrogatories, depositions, subpoenas, *etc.*).

Further, demonstrating non-obviousness by secondary considerations often requires the substantial consideration of factual evidence and the evaluation of witness credibility – things for which a district court is well suited.

These aforementioned issues relating to the discovery and evaluation of evidence of the validity of the 437 Patent further weigh in favor of denial. *See TCO AS v. NCS Multistage Inc.*, PGR2020-00078, Paper 16 at 20 (P.T.A.B. Feb. 28, 2021) (“[I]t appears that third-party discovery is required to resolve the issue of whether or

not the TDP-PO plug qualifies as prior art as a 'public use.' Institution in these circumstances raises concerns of inconsistent outcomes, which does not favor institution.”).

## **VI. CONCLUSION**

For all of the reasons discussed above – both individually and collectively – Patent Owner respectfully requests that the Director exercise her discretion to deny institution.

Dated: August 25, 2025

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I certify that the Patent Owner's Request for Discretionary Denial in connection with *Inter Partes Review* Case IPR2025-01038 and Exhibits 2001-2022 were served on August 25, 2025 by electronic mail to:

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**CERTIFICATE OF WORD COUNT**

Pursuant to 37 C.F.R. § 42.24(d), the undersigned attorney for the Patent Owner, General Video, LLC, declares that Patent Owner's Request for Discretionary Denial has a total of 12,266 words, according to Microsoft Word® word count tool, excluding the parts of the Request exempted by 37 C.F.R. § 42.24(a)(1).

Dated: August 25, 2025

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