

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORP., DELL INC., AND DELL TECHNOLOGIES INC.,
Petitioners,

v.

GENERAL VIDEO, LLC,
Patent Owner.

IPR2025-01039
U.S. Patent No. 7,359,437

**PETITIONERS' RESPONSE TO PATENT OWNER'S REPLY
IN SUPPORT OF DISCRETIONARY DENIAL**

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The Director should refer this Petition to a merits panel. First, the *Kim* reference—which was withheld by the Applicant and overlooked by the Examiner—discloses the same transmission sequence that was the basis for allowance. It is an appropriate use of Office resources to review the error. Second, Patent Owner concedes that it delayed over sixteen years after the '437 patent issued to file suit, which supports Petitioners' settled expectations that the '437 patent would not be asserted. Third, in a recent development on October 2, the district court denied Patent Owner's motion to modify the existing scheduling order in related Dell litigation, thereby ensuring a trial more than three months after the final written decision. Each of these facts weigh against discretionary denial.

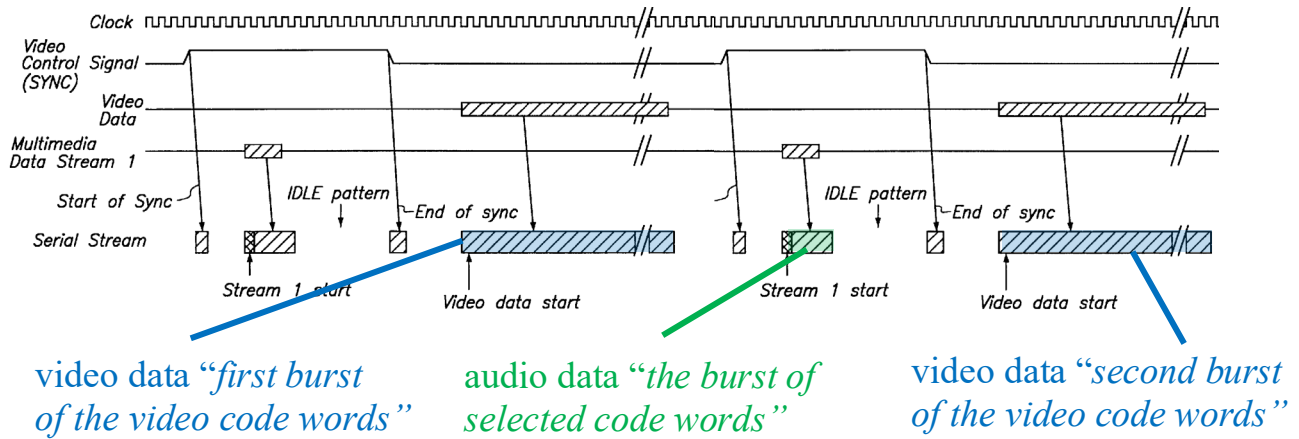
I. The Applicant's withholding of *Kim* and the Examiner's material error require merits review.

As explained in Petitioners' Opposition brief, merits review is appropriate because the Applicant withheld from the Examiner its own relevant prior art reference (*Kim* Ex.1005). Paper 9, 1. *Kim* that teaches the exact same transmission sequence that formed the basis of allowance. *See id.* This prosecution defect was compounded by the Examiner's error in overlooking *Kim*.

Patent Owner attempts to excuse the Applicant's withholding of *Kim* by noting that *Kim*'s parent patent, *Shin*, was submitted in an IDS. Paper 12, 3. But this argument ignores the fact that *Kim* is a *continuation-in-part* with new subject

matter. See Ex.1005, face. And the newly added subject matter in *Kim* is what

Petitioners had identified as teaching the claimed transmission sequence of auxiliary data between bursts of video code words. Particularly, Fig. 4A of *Kim*, shown below, is part of the newly added subject matter in *Kim*'s continuation-in-part patent.



Ex.1005, Fig. 4A (modified, annotated).

Kim is not cumulative because neither *Shin* nor *Myers* teach this transmission sequence. Nor has Patent Owner identified any other reference of record that teaches this transmission sequence. *Kim*, which Applicant withheld, is thus not cumulative of *Shin*, *Myers*, or other prior art of record. By failing to disclose *Kim* in an IDS, Applicant breached its duty of candor under 37 C.F.R. § 1.56. See 37 C.F.R. § 1.56 (“Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information

known to that individual to be material to patentability.”).

Compounding this defect, the Examiner erred by failing to adhere to MPEP § 904.02 and conduct a thorough search that would have uncovered *Kim*. See, MPEP § 904.02 (Examiners “must conduct a thorough and complete search of the prior art ... starting with the area(s) where the invention would most likely be found in the prior art.”). The Applicant’s own references are a likely source of finding art and the Examiner erred by failing to review such references.

Accordingly, the Director should refer this Petition to a merits panel because “it is an appropriate use of Office resources to review the potential error.” *Anthony Inc., v. Controltec, LLC*, IPR2025-00559, Paper 9 at 2 (PTAB Jul. 16, 2025).

Patent Owner also does not dispute that *Kim* teaches the purportedly allowable transmission sequence. Paper 12, 4. Patent Owner argues that “while *Kim* teaches encoding audio input data, it does not teach encoding that input data into selected code words that are **members of a robust subset** of a full code word set.” Paper 12, 4. But the Examiner did not allow the claims based on the “robust subset” aspect: The Examiner found that *Myers* teaches encoding data with a robust subset. Ex.1002, 240-41. The Petition also relies on *Myers* for this feature, not *Kim*. And the Applicant conceded that this encoding was not new by amending the claims to include the transmission sequence. Ex.1002, 240-41. In sum, the “robust subset” aspects of the claim are not at issue here. Rather, the allowable

subject matter—the transmission sequence—is what is taught by *Kim*, which was withheld by the Applicant and overlooked by the Examiner.

Patent Owner's argument that "Petitioners overgeneralize and mischaracterize the reasons for allowance" ignores the overall prosecution record. Paper 12, 3. Patent Owner argues that "it is improper to limit the patentable distinctions of a claim to those noted in the reasons for allowance as Petitioners do." Paper 12, 4. But, Petitioners do not rely solely on the Examiner's stated reasons for allowance for identifying the allowable subject matter. Petitioners have explained the overall prosecution story in which the original claims were rejected over *Myers*, but the dependent claims reciting the transmission sequence were deemed allowable subject matter. Paper 9, 3. The Applicant's failure to submit *Kim* in an IDS, and the Examiner's failure to identify *Kim* further demonstrates that "it is an appropriate use of Office resources to review the potential error." *Anthony Inc., v. Controltec, LLC*, IPR2025-00559, Paper 9 at 2 (PTAB Jul. 16, 2025).

II. Patent Owner's delay in asserting the '437 patent weighs against discretionary denial.

Patent Owner mischaracterizes Petitioners' Opposition brief, which explains that Patent Owner waited over sixteen years after issuance—and nearly ten years after its initial licensing discussion with Dell—to assert the '437 patent against Dell. Paper 9, 7-8. Patent Owner's argument that "MPEGLA made it clear that it disagreed with Dell's position" and that "between July 27, 2020 and February 1,

2022, MPEGLA and Dell exchanged dozens of emails and had multiple calls regarding the DP SEP license” is beside the point. Paper 12, 1-2. The facts remain that Dell explicitly declined a license to the MPEGLA’s patent pool in 2015, and Patent Owner waited over nine years from that decision to file suit. This delay counsels against discretionary denial. *See Apple v. Ferid Allani*, IPR2025-00856, Paper 11, 2 (PTAB Sep. 11, 2025) (referring an IPR of a 13-year-old patent “because Patent Owner did not assert the challenged patent against Petitioner until eleven years after the parties’ discussion about that patent”).

III. Trial in related Dell litigation will be three months after the Final Written Decision.

Since Petitioners filed their Opposition brief, on October 2, Judge Albright issued an Order denying Patent Owner’s motion to modify the scheduling order. Ex.1029. This confirms Petitioners’ position that *Fintiv* Factor 2 weighs against denial because the trial date for Petitioner Dell’s case in WDTX is currently set for March 29, 2027, which would occur *three months after* the final written decision (December 23, 2026). Ex.1025,7. Patent Owner’s argument regarding EDTX litigation is meritless for the reasons discussed in the Opposition. Paper 9, 13-14. Patent Owner also fails to address related litigation in DDE, which will have a trial date *more than a year* after the final written decision. With the court’s recent denial of Patent Owner’s motion, this *Fintiv* factor continues to weigh against denial.

Date: October 7, 2025

Respectfully submitted,

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PETITIONER’S EXHIBIT LIST

Ex.1001	U.S. Patent No. 7,359,437.
Ex.1002	Prosecution History of U.S. Patent No. 7,359,437.
Ex.1003	Declaration of Dr. Andrew Wolfe under 37 C.F.R. § 1.68.
Ex.1004	<i>Curriculum Vitae</i> of Dr. Andrew Wolfe.
Ex.1005	U.S. Patent No. 5,835,498 to <i>Kim et al.</i> (“ <i>Kim</i> ”)
Ex.1006	U.S. Patent No. 5,625,644 to <i>Myers</i> (“ <i>Myers</i> ”)
Ex.1007	U.S. Patent No. 5,974,464 to <i>Shin</i> (“ <i>Shin</i> ”)
Ex.1008	European Patent 0241014 B1 to Asai, (“Asai”)
Ex.1009	U.S. Patent No. 7,356,051 to Pasqualino (“Pasqualino”)
Ex.1010	U.S. Patent No. 7,143,328 to Altmann (“Altmann”)
Ex.1011	The Authoritative Dictionary of IEEE Standards Terms” Seventh Edition, (“IEEE Dictionary”)
Ex.1012	<i>General Video, LLC v. Dell Inc. et al.</i> 5:24-cv-00124, EDTX - Complaint - Appendix E
Ex.1013	<i>General Video, LLC v. Dell Inc. et al.</i> 5:24-cv-00124, EDTX - Complaint
Ex.1014	<i>General Video, LLC v. Dell Inc. et al.</i> 5:24-cv-00124, EDTX – Infringement Contentions
Ex.1015	<i>General Video, LLC v. Dell Inc. et al.</i> 5:24-cv-00124, EDTX – Scheduling Order
Ex.1016	Assignment Record
Ex.1017	DisplayPort Release Date
Ex.1018	MPEG LA Letter to Dell re DisplayPort License (2015-03-18)
Ex.1019	Dell Letter to MPEG LA re DisplayPort (2015-07-13)
Ex.1020	WDTX Agreed Scheduling Order
Ex.1021	Judge Moses Order 1/31/24

Response to Patent Owner's Reply in Support of Discretionary Denial
IPR2025-01039 (U.S. Patent 7,359,437)

Ex.1022	Total Transfers to Judge Albright (LexMachina)
Ex.1023	Patent Transfers to Judge Albright (LexMachina)
Ex.1024	Federal District Court Cases for Judge Albright
Ex.1025	EDTX First Amended Docket Control Order
Ex.1026	March 26, 2025, UPSTO Memorandum, " <i>Interim Procedure for PTAB Workload Management</i> "
Ex.1027	DDE Lenovo Complaint for Declaratory Judgment of Non-Infringement and Invalidity
Ex.1028	General Video, LLC's Preliminary Disclosure of Asserted Claims and Infringement Contentions to Dell (Served 2025-03-19)
Ex.1029 (NEW)	Judge Albright Order on 10/2/25 denying General Video's motion to modify the schedule.

CERTIFICATE OF SERVICE

The undersigned certifies, under 37 C.F.R. § 42.6, that service was made on the Patent Owner as detailed below.

Date of service October 7, 2025

Manner of service Electronic Email: pmcandrews@mcandrews-ip.com; rchiplunkar@mcandrews-ip.com; dpetty@mcandrews-ip.com; IPR2025-01036@mcandrews-ip.com

Documents served **Petitioners' Response to Patent Owner's Reply in Support of Discretionary Denial; Exhibit 1029**

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