

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.

Case IPR2025-01038

Case IPR2025-01039

Patent No. 7,359,437

**PATENT OWNER'S RESPONSE TO PETITIONERS'
NOTICE RANKING PETITIONS AND EXPLAINING MATERIAL
DIFFERENCES BETWEEN PETITIONS**

Petitioners fail to show why they needed to file two petitions for IPR – both asserting the same single ground based on the same combination of references – of *expired* U.S. Patent No. 7,359,437 (the “437 Patent”), only one claim of which – claim 41 – is being asserted in litigation.

The Board disfavors multiple petitions, advising practitioners that “one petition should be sufficient to challenge the claims of a patent in most situations,” that “[t]wo or more petitions filed against the same patent at or about the same time . . . may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns,” and that “multiple petitions by a petitioner are not necessary in the vast majority of cases.” Consolidated Trial Practice Guide (Nov. 2019) at 59.

And while the Board recognizes some “rare” circumstances that can possibly justify more than one petition – when the patent owner has asserted a large number of claims in litigation or when there is a dispute about a priority date requiring arguments under multiple prior art references (*see id.*) – those circumstances are not present here. Patent Owner has asserted just one claim of the 437 Patent in the parallel litigations (*see* IPR2025-01038, Ex. 2001 at ¶¶ 6, 8), and there is no dispute about priority dates justifying arguments under multiple prior art references – indeed, both petitions rely on the same combination of art – Kim, Shin and Myers.

Nevertheless, Petitioners gin up some differences to justify their decision to disregard the Board’s preference for a single petition. First, they argue that the “number and length of the challenged claims makes presenting the asserted Grounds in a single petition impractical.” IPR2025-01038, Paper 4 at 2. But the Board typically rejects such an argument. *See Intel Corp. v. Ax Wireless*, IPR2023-01140, Paper 12 at 7-8 (P.T.A.B. Feb. 14, 2024) (finding petitioner’s argument that multiple petitions are justified because of the length of the independent claims “unavailing”). Further, as only claim 41 of the 437 Patent is being asserted in litigation, that argument rings hollow – Petitioners simply did not need to seek IPR of claims 1-6, 8, 10-17, 19-23, 26-31, 33, 37 39-40, 42-45, 47, 49, 50, and 52-53.

Moreover, the case law Petitioners rely on is readily distinguishable. In *Peloton Interactive, Inc. v. Ifit, Inc.*, the Board allowed two petitions because the challenged patent included 84 claims and the Patent Owner insisted that the petitioner’s first petition should have challenged all 84 claims. IPR2022-00030, Paper 12 at 33-34 (P.T.A.B. Apr. 2, 2022). The 437 Patent includes far fewer claims, and Patent Owner has never suggested Petitioner should challenge them all – again, Patent Owner has asserted only claim 41 in litigation. In *Novartis Gene Therapies v. Genzyme Corp.*, the Board allowed two petitions because Patent Owner had asserted 34 claims (including seven independent claims) against the petitioner. IPR2023-01045, Paper 10 at 3-4 (P.T.A.B. Jan. 17, 2024). But here, only one claim of the 437

Patent has been asserted in litigation. In *Flex Logix Techs. v. Venkat Konda*, the Board allowed two petitions because of “the length of the claims in the [challenged] patent, the complexity of the subject matter of the claims, and their relative detail.” IPR2020-00261, Paper 22 at 23-24 (P.T.A.B. Aug. 3, 2020). Here, Petitioners have not shown that the challenged claims are so long, complex, and detailed that multiple petitions are warranted.

Moreover, the claims challenged in the two petitions include many of the same limitations, which the petitions acknowledge. *See* IPR2025-01038, Paper 3 at 72-75; IPR2025-01039, Paper 3 at 72-91. Indeed, the challenged independent claims all recite a “serial link,” providing or receiving and encoding “input data,” “generate/generating a sequence of selected code words,” “each of the selected code words is a member of a robust subset of [a/the] full code word set,” and a “sequence” or “burst” of “selected code words [that] is less susceptible to inter-symbol interference during transmission over the link than would be the conventional sequence of code words.” *See* IPR2025-01038 at Ex. 1001 (compare independent claims 1, 14, 18-21, 26, 38-40, 41, and 51-53). Further, if the challenged claims were not closely related, the two petitions would not have been able to rely on the same single combination of the same three references (not to mention the same expert declaration making essentially the same conclusory arguments against all the claims). *See* IPR2025-01038 at Ex. 1003.

Thus, in view of the overlap of the claims and of the art relied on in the petitions, Petitioners’ “number and length of the challenged claims” argument fails. *See Apple Inc. v. Speir Techs. Ltd.*, IPR2023-00543, Paper 8 at 9-10 (P.T.A.B. Aug. 8, 2023) (petitioner’s reasons for filing second petition were “lacking” because, though each petition was directed to different claims, the claims were similar and relied on the same combination for the independent claims).

Petitioners further assert that because each petition challenges a distinct set of claims, the petitions are materially different. *See* IPR2025-01038, Paper 4 at 3. However, as discussed above, the subject matter of the two sets of challenged claims overlaps significantly – so much so that Petitioners rely on the same single ground involving the same three references in both petitions.

Petitioners also argue that two petitions challenging more than just claim 41 are justified because Patent Owner’s complaint asserts infringement of “at least claim 41 of the 437 Patent” and its final infringement contentions are not due until April 2026.¹ *See id.* But the Board has found that the possibility that a patent owner might assert additional claims in litigation is not a circumstance that justifies

¹ Patent Owner has asserted claim 41 against Petitioners Dell Inc. and Dell Technologies Inc. in litigation but has not sued Petitioner Intel Corp. for infringement of the 437 Patent.

multiple petitions. *See Apple*, Paper 8 at 10. Further, Petitioners' concerns are unfounded because only claim 41 is being asserted against the Dell Petitioners after more than a year of litigation, and Patent Owner would likely be estopped from asserting other claims in a different lawsuit under the doctrines of claim splitting and *res judicata*.

Lastly, Petitioners argue that because the two petitions challenge each claim only once and rely on the same combination of art and the same expert declaration, institution of both petitions would not materially increase the burden on the Board and consolidation would be appropriate. *See IPR2025-01038*, Paper 4 at 4. However, the petition in IPR2025-01038 is 85 pages, and the petition in IPR2025-01039 is 107 pages, and each petition addresses different claims of the 437 Patent. Therefore, institution of both petitions would most certainly increase the burden on the Board.

The Board should not institute on either petition based on discretionary reasons and on the merits – and it most certainly should not institute on both petitions. It simply makes no sense for the Board to expend resources on two petitions directed at dozens of claims of an expired patent that are not at issue in the underlying litigation (which itself involves only a subset of the Petitioners), especially when one of the petitions does not even address the only claim that has been asserted in litigation.

Dated: September 23, 2025

/Peter J. McAndrews/

Peter J. McAndrews
Registration No. 38,547
McANDREWS, HELD & MALLOY
500 West Madison St., Suite 3400
Chicago, IL 60661
Telephone: (312) 775-8000

CERTIFICATE OF SERVICE

I certify that Patent Owner’s Response to Petitioners’ Notice Ranking Petitions and Explaining Material Differences Between Petitions was served on September 23, 2025 by electronic mail to:

LEAD COUNSEL	BACK-UP COUNSEL
Gregory P. Huh HAYNES AND BOONE, LLP 2801 N. Harwood St., Suite 2300 Dallas, TX 75201 Phone: (972) 739-6939 Fax: (214) 200-0853 gregory.huh.ipr@haynesboone.com	David L. McCombs HAYNES AND BOONE, LLP 2801 N. Harwood St., Suite 2300 Dallas, TX 75201 Phone: (214) 651-5533 Fax: (214) 200-0853 david.mccombs.ipr@haynesboone.com
	Calmann J. Clements HAYNES AND BOONE, LLP 2801 N. Harwood St., Suite 2300 Dallas, TX 75201 Phone: (972) 739-8638 Fax: (214) 200-0853 calmann.clements.ipr@haynesboone.com
	Stephanie N. Sivinski HAYNES AND BOONE, LLP 2801 N. Harwood St., Suite 2300 Dallas, TX 75201 Phone: (214) 651-5 078 Fax: (214) 200-0853 stephanie.sivinski.ipr@haynesboone.com

	<p>Roger Fulghum BAKER BOTTS L.L.P. One Shell Plaza 910 Louisiana Street Houston, TX 77002 Phone: (713) 229-1234 Fax: (713) 229-1522 Roger.Fulghum@BakerBotts.com</p>
	<p>Mark Speegle BAKER BOTTS L.L.P. 401 South First Street, Suite 1300 Austin, TX 78704 Phone: (512) 322-2536 Fax: (512) 322-3636 Mark.Speegle@BakerBotts.com</p>

/Peter J. McAndrews/

Peter J. McAndrews