

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TCL ELECTRONICS HOLDINGS LTD.
(f/k/a TCL MULTIMEDIA TECHNOLOGY HOLDINGS, LTD.),
Petitioner,

v.

MAXELL, LTD.,
Patent Owner.

IPR2025-00134
Patent 10,650,780 B2

Before TERRENCE W. McMILLIN, JOHN A. HUDALLA, and
JASON W. MELVIN, *Administrative Patent Judges*.

MELVIN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

TCL Industries Holdings Co., Ltd. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–11, 13, and 15–20 (the “challenged claims”) of U.S. Patent No. 10,650,780 B2 (Ex. 1001, “the ’780 patent”). Paper 1 (“Pet.”). Maxell, Ltd., (“Patent Owner”) filed a Preliminary Response. (Paper 8, “Prelim. Resp.”). With our authorization, the parties filed a Preliminary Reply (Paper 9) and Preliminary Sur-reply (Paper 10). Pursuant to 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a), we have authority to determine whether to institute review.

An *inter partes* review may not be instituted unless “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). For the reasons set forth below, we discretionarily deny review.

A. REAL PARTIES IN INTEREST

Petitioner identifies itself as well as TCL Industries Holdings Co., Ltd.; T.C.L. Industries Holdings (H.K.) Limited; TTE Corporation; TCL Moka International Limited; TCL Moka Manufacturing S.A. De C.V.; TCL King Electrical Appliances (Huizhou) Co., Ltd.; Manufacturas Avanzadas S.A. De C.V.; TCL Smart Device (Vietnam) Co., Ltd.; Shenzhen TCL New Technology Co., Ltd.; TCL Optoelectronics Technology (Huizhou) Co., Ltd.; TCL Overseas Marketing Ltd.; and TCL Technology Group Corporation (f/k/a TCL Corp.) as the real parties-in-interest. Pet. 2–3. Patent Owner identifies itself as the real party in interest. Paper 5, 1 (Patent Owner’s Mandatory Notices).

B. RELATED MATTERS

The parties identify the following related federal district-court litigation involving the '780 patent: *Maxell v. TCL et al.*, Case No. 5:23-cv-00108-RWS-JBB (E.D. Tex.) (the “Texas litigation”). Pet. 4; Paper 5, 1. Petitioner also identifies that it contemporaneously filed IPR2025-00120 (challenging US 10,375,341) and IPR2025-00135 (challenging US 10,219,020). Pet. 3.

C. THE '780 PATENT

The '780 patent is titled “Display Apparatus” and relates to getting images from external equipment and displaying them, such as in a slide show. Ex. 1001, codes (54), (57). The '780 patent describes that its display apparatus transmits a request for picture information to an external device to retrieve pictures for display. *Id.* at 2:13–19.

D. CHALLENGED CLAIMS

Claim 1 is independent and is reproduced below:¹

1. An image display apparatus, comprising:

- [1A] Universal Serial Bus (USB) interface circuitry configured to receive compressed first image information from a digital camera over a USB cable;
- [1B] wireless LAN interface circuitry configured to wirelessly receive compressed second image information from the digital camera over a network;
- [1C] a decoder configured to decode the compressed first image information received by the USB interface circuitry or the compressed second image information received by the wireless LAN interface circuitry; and

¹ We include bracketed limitation designations, consistent with the parties. Pet. 18–36; Prelim. Resp. ix–x.

- [1D] a display screen configured to display at least one of first images based on decoded the first image information and second images decoded the second information obtained by the decoder,
- [1E] wherein if displaying the first images on the display screen, based on an operation on the input device of the image display apparatus for conducting a slide show,
- [1F] the USB interface circuitry transmits, over the USB cable, a first signal to the digital camera for causing the digital camera to output compressed first image information corresponding to first still pictures, and receives, over the cable, the compressed first image information corresponding to first still pictures output from the digital camera,
- [1G] the decoder decodes the compressed first image information corresponding to first still pictures received by the USB interface circuitry, and
- [1H] the display screen displays a slide show at predetermined time intervals with the first still pictures, as the first images, based on the decoded first image information obtained by the decoder, and
- [1I] wherein if displaying the second images on the display screen, based on an operation on the input device of the image display apparatus for conducting a slide show,
- [1J] the wireless LAN interface circuitry wirelessly transmits, over the network, a second signal to the digital camera for causing the digital camera to output compressed second image information corresponding to second still pictures, and wirelessly receives, over the network, the compressed second image information corresponding to second still pictures output from the digital camera,
- [1K] the decoder decodes the compressed second image information corresponding to second still pictures received by the wireless LAN interface circuitry, and
- [1L] the display screen displays a slide show at predetermined time intervals with the second still pictures, as the

second images, based on the decoded second image information obtained by the decoder.

Ex. 1001, 24:33–25:16. Claims 2–11 and 13 depend, directly or indirectly, from claim 1. *Id.* at 25:17–26:14. Claim 15 is independent and recites limitations similar to claim 1’s. *Id.* at 26:17–27:10. Claims 16–19 depend directly from claim 15. *Id.* at 27:11–22. Claim 20 is independent and recites a method with limitations similar to claim 1’s. *Id.* at 27:23–28:28.

E. PRIOR ART AND ASSERTED GROUNDS

Petitioner asserts the following ground of unpatentability:

Claim(s) Challenged	35 U.S.C. §²	Reference(s)/Basis
1–11, 13, 15–20	103(a)	Lawther ³

Pet. 4. Petitioner relies also on the Declaration of Dr. Andrew Wolfe.
Ex. 1003.

II. DISCRETIONARY DENIAL

Patent Owner requests that we discretionarily deny institution under 35 U.S.C. § 314(a) due to the advanced state of the parallel district-court action, which Patent Owner notes has scheduled trial date of September 22, 2025. Prelim. Resp. 21–28; *see Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB. Mar. 20, 2020) (precedential).

² The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), effective March 16, 2013, amended the applicable statutes. Because the application from which the ’815 patent issued claims priority to an application filed before this date, the pre-AIA version of § 103 applies.

³ U.S. Patent Publication No. 2008/0165081 (Ex. 1004).

A. STAY AT THE DISTRICT COURT

Patent Owner notes that there is no stay of the Texas litigation. Prelim. Resp. 24. Patent Owner submits that the Texas court is unlikely to issue a stay given the advanced state of litigation. *Id.*

In general, “[w]e decline to infer, based on actions taken in different cases with different facts, how the District Court would rule should a stay be requested by the parties in the parallel case here.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12 (PTAB May 13, 2020) (informative). Nevertheless, we agree with Patent Owner that the court is less likely to grant a stay after significant case development in the underlying litigation. *See infra* § II.C. Thus, this factor weighs slightly in favor of discretionary denial.

B. LITIGATION TRIAL DATE

Patent Owner notes that the trial in the underlying litigation is set for September 22, 2025, which is less than four months after the statutory deadline for this Decision and “almost eight months before the projected statutory deadline for a final written decision.” Prelim. Resp. 25 (citing Ex. 2004). Accordingly, the trial is currently set to occur several months before any Final Written Decision in this case will issue. Although trial delays are a possibility, there is no evidence before us that would indicate the likelihood of a trial postponement. Thus, this factor strongly favors discretionary denial.

C. INVESTMENT BY THE COURT AND THE PARTIES

According to Patent Owner, fact discovery in the underlying litigation closed on March 3, 2025, and expert discovery in the underlying litigation

closed on May 5, 2025. Prelim. Resp. 26 (citing Ex. 2004). The litigation parties have exchanged infringement and invalidity contentions. *See id.*; Ex. 2006 (Petitioner’s invalidity contentions).

Patent Owner also notes that the court has conducted a *Markman* hearing and issued a claim-construction order. *Id.*; *see* Ex. 2001 (claim construction order). The only claim-construction issues disputed at the district court, however, related to indefiniteness (Ex. 2001, 17–22), which the parties do not raise before us and which we would not address as an unpatentability basis. Thus, the Texas litigation’s investment in claim construction does not represent any overlap with this proceeding.

We agree with Patent Owner that the court and the parties have spent substantial time and effort developing the issues in the underlying litigation. And, of significance to us, this includes contention discovery on invalidity and expert discovery on invalidity. *See Sand Revolution II, LLC v. Continental Intermodal Group–Trucking LLC*, IPR2019-01393, Paper 24 at 10–11 (June 16, 2020) (informative) (noting the significance of case development related to invalidity in a *Fintiv* analysis). These circumstances weigh in favor of discretionary denial.

We also consider whether Petitioner unreasonably delayed in filing this proceeding. *See Fintiv*, Paper 11 at 11–12. Patent Owner notes that Petitioner filed the Petition “at almost a year after the litigation was commenced.” Prelim. Resp. 28. Patent Owner also notes that “Petitioner knew of th[e] trial date seven months prior to filing the Petition.” *Id.* at 25 (citing Ex. 2004 (setting a trial date in an April 11, 2024, order)). We agree with Patent Owner that the relative lateness of Petitioner’s filing in the statutory period under 35 U.S.C. § 315(b) also weighs in favor of exercising

discretion to deny institution. Thus, *Fintiv* factor 3 weighs in favor of exercising discretion to deny institution.

D. OVERLAP OF THE ISSUES

Patent Owner argues that the challenged claims in this case include the asserted claims in the underlying litigation. Prelim. Resp. 27. Patent Owner also argues that “[t]he prior art references relied on in this proceeding are the same, or substantially the same, as those at issue” in the underlying litigation. *Id.*

Petitioner stipulates not to pursue in the Texas litigation “the same grounds or any grounds that could have reasonably been raised before the PTAB.” Pet. 60. Such a *Sotera* stipulation eliminates the substantive overlap between this proceeding and invalidity in the Texas litigation. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18–19 (PTAB Dec. 1, 2020) (precedential as to § II.A).

On balance, we view Petitioner’s stipulation as effectively addressing concerns about duplicative efforts. Thus, we find that this factor weighs strongly against discretionary denial.

E. WHETHER PETITIONER IS UNRELATED TO THE DEFENDANT IN THE UNDERLYING LITIGATION

Petitioner is a defendant in the Texas litigation, which supports discretionary denial.

F. OTHER CONSIDERATIONS

The final *Fintiv* factor is a catch-all that takes into account any other relevant circumstances. *See Fintiv*, Paper 11 at 14–16. We conclude that

the Petition does not present a particularly strong challenge, because it inadequately addresses at least one claim limitation.

In particular, limitation [1F] requires “USB interface circuitry [that] transmits, over the USB cable, a first signal to the digital camera for causing the digital camera to output compressed first image information.” Petitioner addresses that requirement by asserting Lawther’s interface circuit “can also be adapted to enable exchange data with a connected external device.” Pet. 39 (quoting Ex. 1004 ¶ 50). Although Lawther may “exchange data,” supporting that signals may be sent to a connected camera, Petitioner does not establish that such a signal would have been used as claimed. It may be that such a signal is inherently present in the interactions Lawther describes, but Petitioner does not assert or establish so, only that Lawther has the capability to “exchange data” with a connected camera. Because of this potential weakness in Petitioner’s showing, we cannot conclude that the Petition presents a particularly strong challenge.

Accordingly, this factor is neutral.⁴

G. CONCLUSION ON *FINTIV*

Based on holistic evaluation of the above factors, we discretionarily deny institution. Work at the district court has progressed and trial there will in all likelihood predate our final written decision. Although Petitioner’s stipulation would avoid overlap, we are not persuaded that Petitioner has presented a sufficiently strong challenge to overcome the other factors.

⁴ Patent Owner makes other arguments relative to the catch-all factor of *Fintiv* (Prelim. Resp. 27–28), but we have already considered those arguments as part of our analysis of other factors above.

Accordingly, we discretionarily deny institution in light of the Texas litigation.

III. ORDER

Accordingly, it is

ORDERED that, pursuant to 35 U.S.C. § 314(a), no *inter partes* review of claims 1–11, 13, and 15–20 of the '780 patent is instituted.

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