

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.

IPR2025-00135
Patent 10,219,020 B2

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

HUDALLA, *Administrative Patent Judge*.

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

TCL Industries Holdings Co., Ltd. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1–6 and 17–30 (“the challenged claims”) of U.S. Patent No. 10,219,020 B2 (Ex. 1001, “the ’020 patent”). Petitioner filed a Declaration of Andrew Wolfe, Ph.D. (Ex. 1003) with its Petition. Maxell, Ltd. (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”). With our authorization, Petitioner filed a Preliminary Reply (Paper 7) and Patent Owner filed a Preliminary Sur-Reply (Paper 8) addressing certain claim construction issues and discretionary denial under 35 U.S.C. § 325(d).

We have authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314 (2018); 37 C.F.R. § 42.4(a) (2022). Under 35 U.S.C. § 314(a), we may not authorize an *inter partes* review unless the information in the petition and the preliminary 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.” The Board, however, has discretion to deny a petition even when a petitioner meets that threshold. *Id.*; *see, e.g., Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential) (“*NHK*”). For the reasons that follow, we exercise our discretion under 35 U.S.C. § 314(a) to deny institution of *inter partes* review.

I. BACKGROUND

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. Patent Owner identifies itself as the real party-in-interest. Paper 3, 1.

B. *Related Matters*

As required by 37 C.F.R. § 42.8(b)(2), the parties identify various related matters. Pet. 2–3; Paper 3, 1.

Both parties identify *Maxell, Ltd. v. TCL Electronics Holdings Ltd.*, No. 5:23-cv-00108 (E.D. Tex. filed Oct. 12, 2023) (“the underlying litigation”). Pet. 3; Paper 3, 1. Both parties also identify IPR2022-01458, which challenged U.S. Patent No. 9,578,369, which is related to the ’020 patent. *Id.*

Petitioner identifies other U.S. patent applications to which the ’020 patent claims priority. Pet. 2–3. Petitioner further indicates that it is “contemporaneously filing Petitions for *Inter Partes* Review of U.S. Patent No. 10,375,341 (IPR2025-00120) and U.S. Patent No. 10,650,780 (IPR2025-00134).” Pet. 3.

Patent Owner states that “[r]elated patents (U.S. Patent No. 9,578,369 and U.S. Patent No. 10,327,029) were also asserted against Hisense in the Eastern District of Texas in Case No. 5:19-cv-00156.” Paper 3, 1. Patent Owner also states that “[t]he ’369 Patent was also asserted against Vizio in the Central District of California in Case No. 2:21-cv-06758.” *Id.* Patent Owner further states that “[r]elated patent U.S. Patent No. 8,549,109 is currently the subject of [U.S. International Trade Commission] Inv. No. 337-TA-1420 and was previously the subject of Inv. No. 337-TA-1338.” *Id.*

C. The ’020 Patent

The ’020 patent is directed to providing “a portable terminal, an information processing apparatus, a content display system, and a content display method wherein viewing of a content on a portable terminal is smoothly passed to an information processing apparatus.” Ex. 1001, 3:12–16.

Figure 1 of the ’020 patent, reproduced below, shows the operation environment of an internet connection terminal (e.g., a television set) and a mobile terminal.

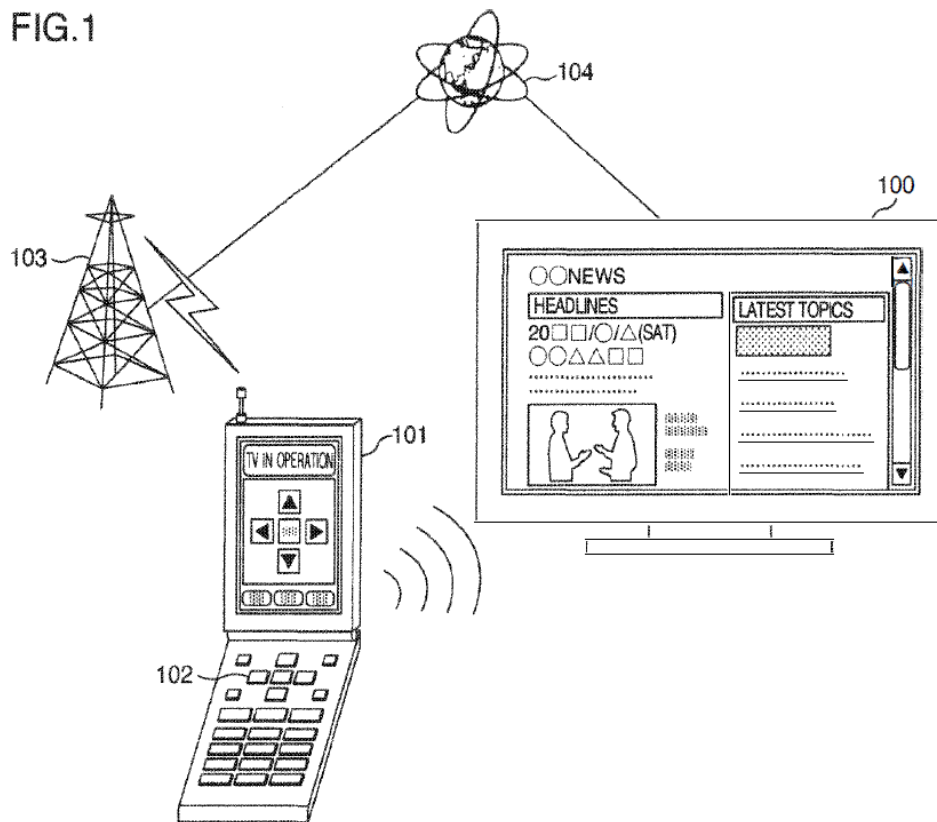


Figure 1, above, depicts mobile terminal 101 and internet terminal 100, which are terminals capable of connecting to the internet to display a homepage provided by an internet site. *Id.* at 4:39–42. Internet terminal 100, which may be a television set or a set top box, connects to the internet 104, and mobile terminal 101 connects to the internet 104 using an input unit 102 (e.g., a plurality of buttons) and a base station 103. *Id.* at 4:43–55, 4:64–66. Internet terminal 100 also enables a user to view digital broadcast programs. *Id.* at 5:2–3.

“In operation of the internet connection terminal 100 and the mobile terminal 101, an internet site being displayed on the mobile terminal 101 can be displayed on the internet connection terminal.” *Id.* at 7:1–4. “Also, the user can operate the internet connection terminal 100 by use of the mobile terminal 101.” *Id.* at 7:4–6.

Figure 2 of the '020 patent, reproduced below, is a block diagram showing the configuration of internet connection terminal 100.

FIG.2

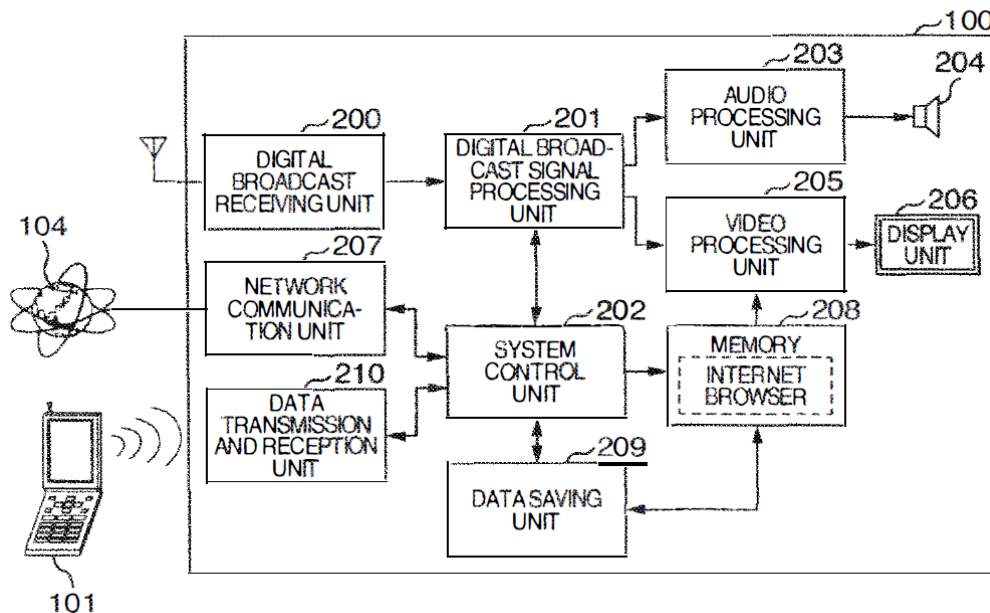


Figure 2, above, shows that internet connection terminal 100 includes digital broadcast receiving unit 200, digital broadcast signal processing unit 201, system control unit 202, audio processing unit 203, speaker 204, video processing unit 205, display unit 206, network communication unit 207, internet browser 208, data saving unit 209, and data transmitting and receiving unit 210. *Id.* at 5:6–12.

Figure 3 of the '020 patent, reproduced below, is a block diagram showing a configuration of mobile terminal 101.

FIG.3

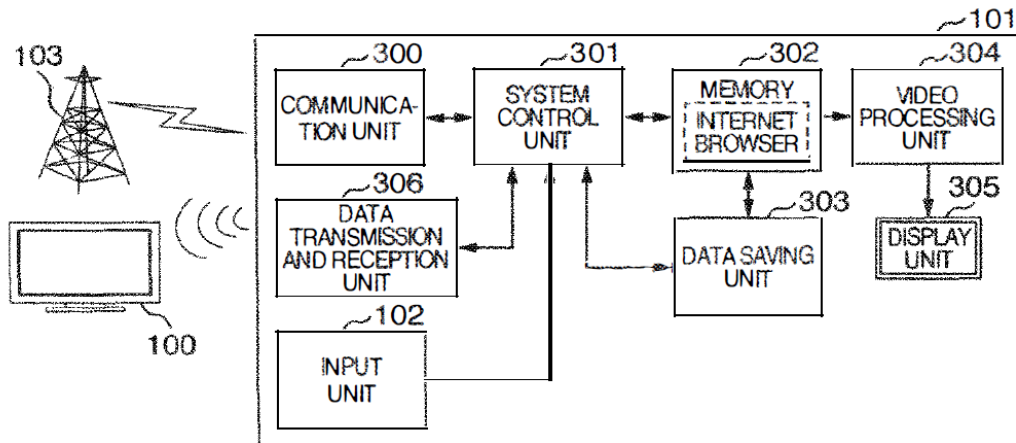


Figure 3, above, shows that mobile terminal 101 includes communication unit 300, system control unit 301, internet browser 302, data saving unit 303, video processing unit 304, display unit 305, and data transmitting and receiving unit 306. *Id.* at 6:22–26.

Figure 5 of the '020 patent, reproduced below, shows a flowchart explaining operations of internet connection terminal 100 and mobile terminal 101.

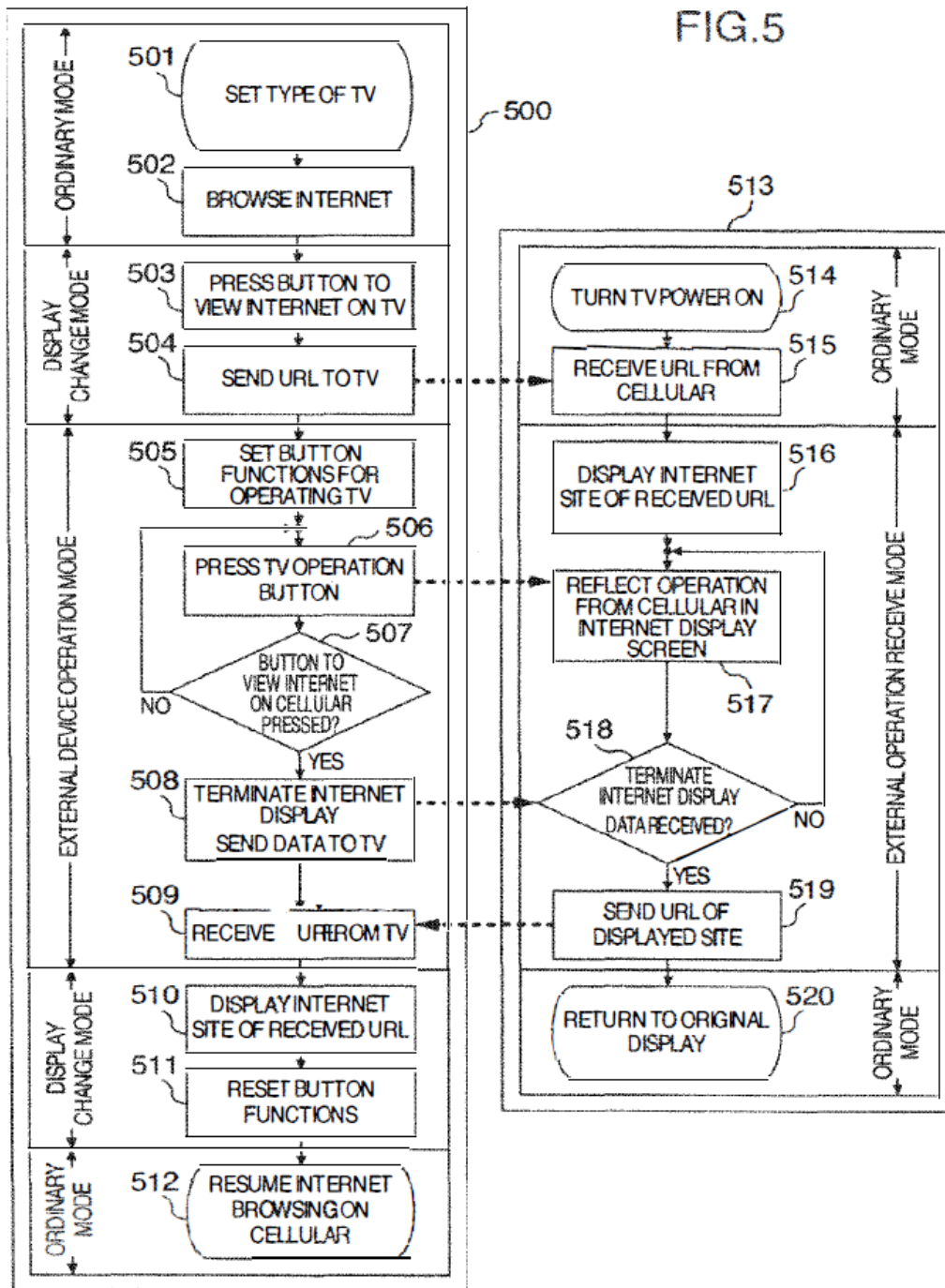


Figure 5, above, shows operations of mobile terminal 101 (cellular phone) in frame 500, and internet connection terminal 100 (television set) in frame 513. *Id.* at 9:64–10:6. In ordinary mode, the user sets a command using input unit 102 of the cellular phone to transmit information to the

television set (step 501), and conducts a predetermined operation to display an internet site on the cellular phone so that the user can browse the internet site (step 502). *Id.* at 10:7–21, 30–36. In display change mode, the user uses input unit 102 to select button 402 in display unit 305 of the cellular phone (step 503), and then system control unit 301 of the cellular phone sends the Uniform Resource Locator (URL) of the internet site on the display via data transmitting and receiving unit 306 to the television set (step 504). *Id.* at 10:37–47.

In ordinary mode on the television set, the user powers on the television set, the television set receives and reproduces a broadcast received from the digital broadcast receiving unit (step 514), and then receives the URL via data transmitting and receiving unit 210 from the cellular phone (step 515). *Id.* at 10:22–29, 54–59. After or concurrently with the URL transmission, system control unit 301 of the cellular phone terminates the display of the internet site on the cellular phone. *Id.* at 10:47–51. In external operation receive mode, the television displays the internet site on display unit 206 (step 516) and enters a state to receive operation from the cellular phone. *Id.* at 10:59–64.

After transmitting the URL, the cellular phone enters external device operation mode, where system control unit 301 of the cellular phone is capable of operating the television set (step 505). *Id.* at 10:65–11:5. In this mode, the user can press a key on input unit 102 of the cellular phone to indicate an operation for the television set, and, in this way, the cellular phone serves as a remote control device for the television set (step 506). *Id.* at 11:6–22. When data transmitting and receiving unit 210 of the television set receives the information and the signal of the operation indication from

the cellular phone, the television set reflects the information in screen display 406 (step 517). *Id.* at 11:23–29.

The user may terminate the internet display on the television set and return to a state where the user browses the internet site on the cellular phone (steps 507 and 508). *Id.* at 11:30–40. The television set interrupts the internet site display (step 518), sends the URL of the internet site last displayed via data transmitting and receiving unit (step 519) and then returns to ordinary mode, displaying the television program being displayed before the start of the internet display (step 520). *Id.* at 11:41–55. The cellular phone receives the URL of the internet site last displayed on the television set and then accesses and displays the internet site of the URL (step 510). *Id.* at 11:56–58. The cellular phone then enters display change mode, and input unit 102 is used to operate the cellular phone (step 511), and the cellular phone returns to ordinary mode (step 512). *Id.* at 11:65–12:5.

D. Illustrative Claim

Of the challenged claims, only claim 1 is independent. Claims 2–6 and 17–30 depend directly or indirectly from claim 1. Claim 1 is illustrative of the challenged claims and recites:

1. [Preamble] A display apparatus for the display of video content acquired from a television broadcast and for the display of video content acquired via the internet, comprising:

[A] a digital broadcast receiver configured to receive a digital broadcast signal;

[B] a signal separator for de-multiplexing the digital broadcast signal into video data and audio data;

[C] a video processor configured to convert the format of the video data;

[D] an audio processor configured to convert the format of the audio data;

[E] a network communication module configured to communicate over the internet;

[F] a radio receiver for receiving data from an external mobile terminal;

[G] an infra-red (IR) receiver for receiving commands from a remote controller;

[H] a display panel; and

[I] a system controller configured to control the display apparatus to:

[I.1] receive a first video content via the received broadcast signal;

[I.2] display the first video content on the display panel;

[I.3] receive an identifier for identifying a second video content from the external mobile terminal;

[I.4] acquire the second video content via the internet using said identifier;

[I.5] display the second video content on the display panel;

[I.6] terminate display of the first video content prior to display of the second video content;

[I.7] execute operation instructions received from the external mobile terminal via the radio receiver while the second video content is being displayed; and

[I.8] execute commands received from the remote controller, wherein said remote controller is a different device than the external mobile terminal.

Ex. 1001, 20:29–64 (Petitioner's identifiers added in brackets).

E. Prior Art

Petitioner relies on the following prior art:

U.S. Patent Application Publication No. 2007/0124792 A1, filed Nov. 30, 2005, published May 31, 2007 (Ex. 1004, “Bennett”); and

U.S. Patent Application Publication No. 2003/0020693 A1, filed July 10, 2002, published Jan. 30, 2003 (Ex. 1005, “Nashida”).

F. The Asserted Grounds

Petitioner challenges claims 1–6 and 17–30 of the ’020 patent based on the following grounds (Pet. 5):

Claims Challenged	35 U.S.C. §	References
1–6, 17–30	103(a) ¹	Bennett
1–5, 23, 30	103(a)	Bennett, Nashida

II. ANALYSIS

Institution of *inter partes* review is discretionary. *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he [Office] is permitted, but never compelled, to institute an [*inter partes* review] proceeding.”); 35 U.S.C. § 314(a) (“The Director *may not* authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. §§ 102 and 103. Because the ’020 patent claims priority to an application filed before March 16, 2013 (the effective date of the relevant amendments), the pre-AIA versions of §§ 102 and 103 apply.

that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” (emphasis added)). Patent Owner contends we should exercise our discretion to deny institution under 35 U.S.C. § 314(a). Prelim. Resp. 50–58. Petitioner argues against discretionary denial based on a stipulation in the Petition “that it will not pursue in the parallel district court litigation the same grounds or any grounds that could have reasonably been raised before the PTAB.” Pet. 83 (citing *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18–19 (PTAB Dec. 1, 2020) (precedential as to § II.A) (“*Sotera*”). Otherwise, Petitioner does not put forth arguments related to discretionary denial under § 314(a). We now consider the parties’ arguments regarding discretionary denial.

In *Fintiv*, the Board discussed potential applications of *NHK*, as well as a number of other cases dealing with discretionary denial under § 314(a). *Fintiv* identifies a non-exclusive list of factors parties may consider addressing, particularly where there is a related, parallel district court action and whether such action provides any basis for discretionary denial. *Fintiv*, Paper 11 at 5–16. Those factors include:

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 a final written decision;
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 5–6.

We now consider these factors to determine whether we should use our discretion to deny institution under 35 U.S.C. § 314(a). In evaluating the factors, we take a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review. *Fintiv*, Paper 11 at 6. Our analysis also is guided by the Chief Administrative Patent Judge’s March 24, 2025, memorandum titled “Guidance on USPTO’s rescission of ‘Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation’” (“CAPJ Memo”).²

A. Stay in the Underlying Litigation

Patent Owner notes that there is no stay of the underlying litigation. Prelim. Resp. 54. Further, Patent Owner argues that the court in the underlying litigation is unlikely to issue a stay given that this Decision will issue at a relatively late juncture in the underlying litigation, i.e., after the close of fact and expert discovery and after the court’s issuance of a claim construction order. *Id.*; *see also infra* § II.C.

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

² Available at https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_rescission_20250324.pdf.

grant a stay after such significant case development in the underlying litigation. *See infra* § II.C. Thus, we find this factor weighs slightly in favor of exercising our discretion to deny institution.

B. The Trial Date in the Underlying Litigation

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. 54–55 (citing Ex. 2009, 2). 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 the exercise of discretionary denial.

C. Investment by the Court and the Parties in the Underlying Litigation

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. 55. Patent Owner also notes that the court has conducted a *Markman* Hearing and issued a claim construction order. *Id.*; *see also* Ex. 2002 (claim construction order). Patent Owner additionally notes that the parties have already exchanged infringement contentions and invalidity contentions under the patent local rules of the Eastern District of Texas. Prelim. Resp. 56; *see also* Ex. 2010 (Petitioner’s invalidity contentions). Accordingly, Patent Owner argues that “the parties’

and Court’s substantial investment in this proceeding weighs in favor of denial of institution under this factor.” Prelim. Resp. 56.

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 exercising discretion to deny institution.

As part of this factor, we also consider whether Petitioner unreasonably delayed in filing the Petition in this case. *See Fintiv*, Paper 11 at 11–12. Patent Owner notes that Petitioner filed the Petition “at almost a year after the [underlying] litigation was commenced.” Prelim. Resp. 58. Patent Owner also notes that “Petitioner knew of th[e] trial date seven months prior to filing the Petition.” *Id.* at 54 (citing Ex. 2008,³ 2). 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. *See Fintiv*, Paper 11 at 11 (“[I]t may impose unfair costs to a patent owner if the petitioner, faced with the prospect of a

³ Patent Owner mistakenly filed the court’s “First Amended Docket Control Order” at both Exhibit 2008 and Exhibit 2009. We discern that Patent Owner intended to file the court’s initial “Docket Control Order” at Exhibit 2008. We have included the initial Order, dated April 11, 2024, at Exhibit 3001. That Order, and all other subsequent Docket Control Orders, indicate a trial date of September 22, 2025.

looming trial date, waits until the district court trial has progressed significantly before filing a petition at the Office.”).

Thus, we find that *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. 56. 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.* at 56–57. Patent Owner notes that “Petitioner disclosed the Bennett and Nashida references in its [invalidity] contentions five months before filing its Petition.” *Id.* at 57 (citing Ex. 2010, 11).

As stated above, Petitioner stipulates in accordance with *Sotera* that it will not pursue in the underlying litigation the same grounds or any grounds that could have reasonably been raised in this case. Pet. 83 (citing *Sotera*, Paper 12 at 18–19). Thus, Petitioner argues we should not exercise discretion to deny institution.⁴

Patent Owner argues that Petitioner’s “purported ‘Sotera’ stipulation . . . is not dispositive of whether the Board should deny institution under

⁴ Petitioner bases this argument on the Office’s June 21, 2022, memorandum titled “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation.” Pet. 83. That memorandum was rescinded on February 28, 2025. *See* USPTO Rescinds Memorandum Addressing Discretionary Denial Procedures (Feb. 28, 2025), <https://www.uspto.gov/about-us/news-updates/uspto-rescinds-memorandum-addressing-discretionary-denial-procedures>.

Fintiv.” Prelim. Resp. 53. Patent Owner also argues that the effect of Petitioner’s stipulation “is substantially muted” because it is “not binding all real parties-in-interest” and because “the parties will have already prepared expert reports and completed expert discovery” by the time we issue an institution decision. *Id.* at 57.

Under the latest applicable guidance, Petitioner’s *Sotera* stipulation “is highly relevant, but [is] not . . . dispositive by itself.” CAPJ Memo at 2–3. Accordingly, we consider Petitioner’s stipulation “as part of [our] holistic analysis under *Fintiv*.” *Id.* at 2.

In theory, Petitioner’s stipulation could “mitigate[] any concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions” regarding unpatentability/invalidity. *Sotera*, Paper 12 at 19. We note that Petitioner’s initial invalidity contentions included the two asserted references here, Bennett and Nashida. Although Petitioner served those contentions before the filing of the instant Petition—in which it proffered its stipulation—we cannot discern from the instant record whether Petitioner’s present invalidity positions in the underlying litigation incorporate any aspects of its grounds here based on Bennett and Nashida. Still, we view Petitioner’s stipulation as significantly mitigating potential conflict given the likelihood that the court would hold Petitioner (and its privies) to Petitioner’s representations made here.⁵

⁵ We already have considered the trial date and the investment by the court and the parties above, so we decline to again consider the potentially “muted” impact of Petitioner’s stipulation (*see* Prelim. Resp. 57) at this late juncture of the underlying litigation.

Otherwise, we consider the overlap in the asserted claims. According to a January 21, 2025, filing in the underlying litigation, Patent Owner has asserted claims 1–4 and 24 of the '020 patent. Ex. 3002. Thus, five of the 20 claims challenged here are common to the underlying litigation, which means that the underlying litigation will not address the patentability of 15 of the 20 claims asserted here. Still, all 15 of these claims depend directly or indirectly from claim 1, which is asserted in the underlying litigation. Thus, the extra claims in this case weigh very slightly in favor of proceeding here.

On balance, we view Petitioner's stipulation as effectively addressing concerns about duplicative efforts. Thus, we find that this factor weighs strongly against exercising discretion to deny institution.

E. Whether Petitioner is Unrelated to the Defendant in the Underlying Litigation

“If a petitioner is unrelated to a defendant in an earlier court proceeding, the Board has weighed this fact against exercising discretion.” *Fintiv*, Paper 11 at 13–14. As noted by Patent Owner (Prelim. Resp. 57), Petitioner here is a defendant in the underlying litigation. The other named defendants appear to be entities that Petitioner has named as real parties-in-interest in this case. *Compare* Pet. 2, with Ex. 2002 (caption). Given this overlap, we find that this factor does not weigh against exercising 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. Patent Owner argues that “[t]he Petition does not present a strong case on the merits, let alone a

compelling meritorious challenge, further supporting denial of institution.” Prelim. Resp. 57. We have reviewed Petitioner’s unpatentability arguments in the Petition and Patent Owner’s arguments in the Preliminary Response, and based on the limited record before us, we find that the merits do not outweigh the other *Fintiv* factors.

For example, claim 1 recites a “display apparatus” with a “system controller” that “receive[s] an identifier for identifying a second video content from [an] external mobile terminal” and “acquire[s] the second video content via the internet *using said identifier*.” Ex. 1001, 20:29–31, 20:46–47, 20:52–55 (alterations and emphasis added). In the Bennett obviousness ground, Petitioner cites Bennett’s control signal that directs display of a video stream on a television screen for teaching the recited “identifier.” Pet. 32 (citing Ex. 1004 ¶ 32). Petitioner further cites Bennett’s teaching of an Internet server as a media source for teaching the “acquire[s]” limitation. *Id.* at 34 (citing Ex. 1004 ¶ 55). Petitioner alternatively cites its declarant’s testimony and contends that it would have been obvious “to use an identifier such as URL in Bennett’s system to retrieve video content from the Internet.” *Id.* at 35 (citing Ex. 1003 ¶ 87). Yet Patent Owner’s arguments (*see* Prelim. Resp. 59–64) call into question whether Bennett teaches or suggests the *use* of either Bennett’s control signal or a URL to “acquire the second video content via the internet.” In addition, we preliminarily agree with Patent Owner that Petitioner’s arguments regarding the URL “focus on justifying an example of *what* an identifier could be, and fail[] to address a scenario that would justify the receipt of a URL from a phone/remote” in Bennett’s system. *Id.* at 63.

Petitioner’s further contentions for these limitations in the Bennett–Nashida obviousness ground (*see* Pet. 73–75) do not necessarily cure the deficiencies mentioned by Patent Owner. Petitioner contends that “Nashida discloses the use of identifiers, such as URLs, for retrieving internet content” and cites Nashida’s teaching of “‘*controller 1010 transmit[ting] a command of requesting a transmission of a URL*’ for retrieving and displaying web content on a display apparatus.” *Id.* at 73 (quoting Ex. 1005 ¶ 120). Yet, according to Patent Owner, Nashida appears to show the URL moving in the opposite direction of Petitioner’s intended mapping: “It is therefore the image display apparatus (the alleged ‘display apparatus’) that sends the URL to the remote controller . . . , and not the other way around, as claimed by Petitioner.” Prelim. Resp. 67 (citing Ex. 1005 ¶ 121⁶).

At the very least, these issues preclude a finding of “particularly strong” merits under *Fintiv*. *See Fintiv*, Paper 11 at 14–15. Thus, we find this factor to be neutral.⁷

III. CONCLUSION

Petitioner has stipulated that, if we were to institute *inter partes* review, it will not pursue in the underlying litigation the same grounds or any grounds that could have reasonably been raised in this case, which mitigates any concerns of duplicative efforts between the district court and

⁶ Patent Owner mistakenly cites paragraph 120 of Nashida, but Patent Owner’s reference to “[t]he next paragraph of Nashida” indicates that Patent Owner intended to cite paragraph 121.

⁷ Patent Owner makes other arguments relative to the catch-all factor of *Fintiv* (Prelim. Resp. 57–58), but we have already considered those arguments as part of our analysis of other factors above.

the Board, as well as concerns of potentially conflicting decisions. *See Sotera*, Paper 12 at 19. Against this factor, Patent Owner has established that (1) the trial in the underlying litigation is set to occur many months before a Final Written Decision would be issued here; (2) the court and the parties have completed considerable work that is related to invalidity, including contention discovery and expert discovery; and (3) Petitioner filed the Petition fairly long into the development of the underlying litigation and nearly at the end of the statutory period under 35 U.S.C. § 315(b). Given the advanced posture of the underlying litigation, we find that it would be inefficient to proceed with *inter partes* review even if Petitioner's stipulation were put into effect. Thus, based on our holistic view of the *Fintiv* factors, we exercise our discretion under 35 U.S.C. § 314(a) to deny *inter partes* review.

IV. ORDER

Accordingly, it is

ORDERED that the Petition is *denied* as to all grounds and all challenged claims of the '020 patent.

IPR2025-00135
Patent 10,219,020 B2

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