

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

CORETRONIC CORPORATION and
OPTOMA CORPORATION,

Petitioners,

v.

MAXELL, LTD.,
Patent Owner

Case: IPR2025-00474

U.S. Patent No. 8,593,580

**BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL**

Mail Stop **Patent Board**
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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PATENT OWNER'S EXHIBIT LIST

Description	Exhibit #
Complaint, <i>Maxell, Ltd. v. Coretronic Corp., et al.</i> , No. 5:24-cv-00088-RWS-JBB (E.D. Tex. Jul. 9, 2024) (“Complaint”)	EX2001
First Amended Docket Control Order, <i>Maxell, Ltd. v. Coretronic Corp.</i> , No. 5:24-cv-00088-RWS-JBB (E.D. Tex.) (Dkt. 65) (January 7, 2025)	EX2002
Order Denying Motion to Transfer, <i>Maxell, Ltd. v. Coretronic Corp.</i> , No. 5:24-cv-00088-RWS-JBB (E.D. Tex.) (Dkt. 85) (March 25, 2025)	EX2003
Order Granting Motion to Dismiss, <i>Optoma Technology, Inc.v. Maxell, Ltd.</i> , No. 3:24-cv-08147-TLT (N.D. Cal.) (Dkt. 58) (March 14, 2025)	EX2004
Plaintiff’s Preliminary Election of Asserted Claims, <i>Maxell, Ltd. v. Coretronic Corp.</i> , No. 5:24-cv-00088-RWS-JBB (E.D. Tex.) (Dkt. 78) (March 11, 2025)	EX2005
Defendants’ Invalidity Contentions, <i>Optoma Technology, Inc.v. Maxell, Ltd.</i> , No. 3:24-cv-08147-TLT (N.D. Cal.) (served on December 27, 2024).	EX2006
Defendants’ Preliminary Election of Asserted Prior Art, <i>Maxell, Ltd. v. Coretronic Corp.</i> , No. 5:24-cv-00088-RWS-JBB (E.D. Tex.) (served on March 25, 2025)	EX2007

I. INTRODUCTION

Patent Owner Maxell, Ltd. ("Patent Owner") respectfully requests that the Board deny institution of the Petition filed by Coretronic Corp. and Optoma Corp. (hereinafter "Petitioners") challenging the patentability of claims 1, 3-11, 17, 18, and 32-38 ("challenged claims") of U.S. Patent No. 8,593,580 ("the '580 Patent") (CORETRONIC-1001).

The '580 Patent was thoroughly examined by the Office during original prosecution. In light of the basic facts, as set forth more fully below, the Petition is ripe for discretionary denial. Instituting IPR on the Petition would undermine the goals of the Acting Director's Memorandum dated March 26, 2025 ("the Memo") to "improve PTAB efficiency, maintain PTAB capacity to conduct AIA proceedings, . . . and promote consistent application of discretionary considerations in the institution of AIA proceedings."

More specifically, the Board should exercise its discretion pursuant to 35 U.S.C. § 314(a) and deny the Petition. Application of the *Fintiv* factors under § 314(a) weighs heavily in favor of denial given the state of the parallel District Court litigation where the same validity challenges are being adjudicated. The Board has discretion to deny institution under these circumstances to promote fairness and efficiency and manage its docket, potentially considering factors beyond the established frameworks. Instituting an IPR here would contradict the goal of IPRs

as an “effective and efficient alternative” to litigation, particularly given the substantial overlap and the finite resources of the Board. *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16-17 (P.T.A.B. Sept. 6, 2017) (precedential).

Accordingly, the Board should decline to institute the Petition.

II. THE MARCH 26, 2025 ACTING DIRECTOR'S MEMORANDUM

Pursuant to the Memo, which outlines “Interim Processes for PTAB Workload Management” including a bifurcated approach for considering discretionary denial, Patent Owner respectfully submits that the Director should deny institution of the Petition. This filing is being made within two months of the Notice of Filing Date dated March 10, 2025 (Paper #5), in accordance with the standard briefing schedule for discretionary denial arguments set forth in the Memo.

The Memo outlines relevant considerations for discretionary denial:

- Whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims;
- Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;
- The strength of the unpatentability challenge;
- The extent of the petition's reliance on expert testimony;

- Settled expectations of the parties, such as the length of time the claims have been in force;
- Compelling economic, public health, or national security interests; and
- Any other considerations bearing on the Director's discretion.

As explained more fully below, denial is warranted under 35 U.S.C. § 314(a). Furthermore, an additional consideration warrants discretionary denial, Petitioners' expert testimony that merely parrots the petition (EX1004). Thus the petition is ripe for discretionary denial in light of the Memo's aim to "improve PTAB efficiency, maintain PTAB capacity to conduct AIA proceedings, . . . and promote consistent application of discretionary considerations in the institution of AIA proceedings." Memo at 3.

III. DISCRETIONARY FACTORS FAVOR DENIAL OF INSTITUTION

The Petition should be denied pursuant to 35 U.S.C. § 314(a) and the factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020), given the parallel District Court litigation. Additional Factors set forth in the "Interim Processes for PTAB Workload Management" Memorandum also favor the Board denying the Petition using its discretion.

A. Application of 35 U.S.C. § 314(a) Weighs in Favor of Discretionary Denial

The Petition should be denied pursuant to 35 U.S.C. § 314(a) because the factors established in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (precedential), weigh strongly in favor of denial due to the parallel District Court Litigation: *Maxell, Ltd. v. Coretronic Corp.*, No. 5:24-cv-00088-RWS-JBB (E.D. Tex.) (filed July 9, 2024) (“District Court Litigation”). Petitioners’ analysis of these factors in the Petition is self-serving and ignores the actual progress and status of the District Court Litigation, thereby minimizing the substantial inefficiencies and prejudice inherent in instituting this duplicative proceeding on a patent due to expire shortly after the final written decision, particularly given Petitioners’ failure to file a *Sotera* stipulation. When properly analyzed based on the court docket, the *Fintiv* factors favor denial. Institution would be inconsistent with the AIA’s goal of providing an “effective and efficient alternative” where, as here, the District Court is actively adjudicating the same core validity issues. *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, at 20 (P.T.A.B. Sept. 12, 2018).

1. Status of Motion to Stay in District Court Litigation (Factor 1)

No stay has been requested in the District Court Litigation. Pet. 10. Petitioners attempt to posit factor 1 as neutral by stating that it *may* file a stay or that “courts

commonly stay cases upon IPR institution.” *Id.* The mere possibility of a stay, however, does not tilt the scale towards neutral.

Instead, even if the Board institutes the Petition, and Petitioners filed a motion to stay the District Court Litigation, the motion should fail because prejudice, tactical disadvantage to Patent Owner, the late stage of litigation, and the lack of potential simplification of the issues would weigh strongly against such a motion. *See Lennon Image Techs., LLC v. Macy's Retail Holdings, Inc.*, 2:13-CV-00235-JRG, 2014 WL 4652117, at *1 (E.D. Tex. Sept. 18, 2014). The statutory deadline for institution is not until after fact discovery closes. EX2002; *see Intell. Ventures II v. FedEx Corp.*, No. 2:16-cv-00980-JRG, Dkt. 141 at 5 (E.D. Tex. Oct. 24, 2017) (“The Court agrees that the Parties have already invested substantial effort and resources during discovery and in preparing claim construction briefing. . . .These circumstances weigh against staying this case.”).

Thus, the first factor weighs against institution.

2. Proximity Of The District Court's Trial Date (Factor 2)

Trial in the District Court Litigation is scheduled to begin on March 23, 2026, over **five** months before the statutory deadline for issuing a Final Written Decision

in this matter on September 10, 2026.¹ The Board has found scheduled jury selection, even three and a half months before the statutory deadline, to weigh in favor of denying institution. *See Int'l Business Machines Corp. v. Digital Doors, Inc.*, IPR2023-00969, Paper 8, at 10-11 (P.T.A.B. Dec. 5, 2023).

Rather than looking at the scheduled trial date, the Petition relies on the median time from filing to case disposition in the Eastern District of Texas. Pet. 9-10. The Petition fails to provide any rationale or support for rejecting the trial date and only speculates the trial date “could get pushed back.” *Id.*; *see Dell Inc. v. Universal Connectivity Techs., Inc.*, IPR2024-01480, Paper 12, at 9 (P.T.A.B. Apr. 24, 2025) (“We are not persuaded by Petitioner’s unsupported argument that the trial date is speculative.”).

Regardless, the trial date statistics similarly favor discretionary denial. Petitioners contend that trial date statistics suggest a theoretical trial date would occur around May 2026. Pet. 10. Even this theoretical trial date precedes the statutory deadline for issuing a Final Written Decision by **four** months.

¹ Petitioners’ reliance on July 2026 as the Final Written Decision date in their Petition is incorrect. *See* 35 U.S.C. §316(a)(11) (requiring that the final determination in an inter partes review be issued not later than 1 year after the date on which the Director notices the institution).

Eastern District of Texas	Trial Date	Months before FWD (Sept. 10, 2026)
Docket Control Order	March 23, 2026	More than five months
US Courts Statistics	May 2026	Approximately four months

Given that the actual and “statistical” trial dates occur *well before* the due date for the Final Written Decision, the second factor strongly favors discretionary denial. *See Dell Inc.*, Paper 12, at 10 (finding this factor “strongly favors exercising discretionary denial” when both scheduled and statistical trial dates preceded expected final written decision date by several months); *Charter Comms., Inc. v. Adaptive Spectrum & Signal Alignment, Inc.*, IPR2024-01379, Paper 16, at 10-11 (P.T.A.B. Apr. 17, 2025) (finding this factor favors exercising discretionary denial when “regardless of which trial date estimate is considered, they all provide for a trial date months before a projected statutory deadline for a final written decision in this proceeding”).

3. Significant Investment In The Parallel Proceeding (Factor 3)

The parties’ and the court’s investment in the parallel District Court Litigation **weighs heavily in favor of discretionary denial**. The Board judges this factor from the institution decision’s date, which should issue no later than September 10, 2025. *See Fintiv*, Paper 11 at 9.

By the time of the institution decision, fact discovery will have concluded (August 7, 2025), and the parties will have served opening expert reports (August

28, 2025), thereby incurring substantial expense and effort by counsel and experts on both sides. EX2002 (First Amended Docket Control Order) at 4. Further, the District Court conducted a *Markman* hearing on May 9, 2025, issued preliminary claim constructions, and invested many hours in holding arguments and issuing numerous rulings on Petitioners' motions to dismiss and the parties' other various motions. EX2002 (First Amended Docket Control Order) at 4. For example, the Court already considered and denied a motion to transfer to the Northern District of California, and the Northern District of California already dismissed a related declaratory judgment action filed by Petitioners' subsidiary—Optoma Technology, Inc. EX2003 (Order Denying Motion to Transfer); EX2004 (Order Granting Motion to Dismiss). This extensive activity shows a significant investment by both the parties and the courts. *See Motorola Sols., Inc., v. Stellar, LLC*, IPR2024-01205, Paper 19 (P.T.A.B. Mar. 28, 2025) (finding “substantial time and effort” invested by parties and the district court, where the district court held a claim construction hearing, parties had served extensive infringement and invalidity contentions, parties had served opening expert reports, and conducted several depositions).

The Petition was filed on January 17, 2025. At that time, Petitioners asserted that “[t]he court proceeding is at an early stage, with relatively little investment from the court and parties.” Pet. 11. Patent Owner disagrees, but Petitioners' characterization about the state of affairs in January is irrelevant. As *Fintiv* instructs,

the Board judges the parties' and the District Court's investment in the District Court Litigation from the date of the anticipated institution decision, which will issue around September 10, 2025, not January 17, 2025. *Fintiv*, Paper 11 at 9. As presented above, the District Court and the parties have substantially invested in the District Court Litigation. Those investments will continue to compound in the four months between now and the institution decision's due date. This *Fintiv* factor strongly weighs in favor of denial.

4. There Is Significant Overlap Between Issues Raised In The Petition And In The District Court Litigation (Factor 4)

The issues in this proceeding are substantially the same as in the District Court Litigation. Here, Petitioners assert that Claims 1, 3-11, 17, 18, and 32-38 of the '580 Patent are unpatentable. Pet. 8. These claims fully overlap with the claims asserted by Maxell against Petitioners in the District Court Litigation. EX2005 (Plaintiff's Preliminary Election of Asserted Claims) at 2. Furthermore, the references that Petitioners rely upon in supporting its Petition **include substantially the same references Petitioners rely upon to challenge the validity of the '580 Patent in the District Court Litigation.** These references are explicitly listed in Petitioners' (as Defendants) own Invalidity Contentions served in the district court case on December 27, 2024. EX2006 (Invalidity Contentions) at 15-17; EX2007 (Preliminary Election of Asserted Prior Art) at 2.

Petitioners make a half-hearted attempt at a *Sotera* stipulation, claiming that “Petitioners stipulate that they will not pursue the grounds identified in this Petition before the district court.” Pet. 9. This is not a *Sotera* stipulation, and the statement does nothing to mitigate concerns regarding “potentially conflicting decisions and duplicative efforts between the district court and the PTAB.” *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, at 18-19 (P.T.A.B. Dec. 1, 2020).

Indeed, the Board repeatedly rejected near-identical attempts when considering *Fintiv* Factor 4. *See, e.g., Samsung Elecs. Co. v. Cal. Inst. of Tech.*, IPR2023-00130, Paper 10, at 19-20 (P.T.A.B. May 4, 2023) (denying institution of petition that included stipulation “broader to some degree than the stipulation discussed in *Sand Revolution*”); *Roku, Inc. v. IOENGINE, LLC*, IPR2022-01554, Paper 11, at 14 (P.T.A.B. May 5, 2023) (denying institution of petition that “falls far short of a *Sotera*-type stipulation that would bar [Petitioner] from pursuing any grounds in the parallel district court proceeding that could have reasonably been raised before the Board”).

Petitioners’ attempted “stipulation” purports to forego only a perfect overlap of the IPR prior art grounds in the District Court Litigation. Yet, institution would still leave the parties with duplicative efforts in the District Court Litigation because the Court would still make determinations regarding the references cited in the Petition. EX2006 (Invalidity Contentions) at 15. The following annotated table

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Brief in Support of Patent Owner's Request for Discretionary Denial

shows which grounds in the District Court Litigation involve the same references at issue in this Petition (red text) and which grounds Petitioners' stipulation would encompass (greyed out).

'580 Patent		
Asserted Claim(s)	Prior Art Combination	Claim Chart
Claims 1, 3-9, 32-35, and 37-38	Claims 1, 3-9, 32-35, and 37-38 are unpatentable under 35 U.S.C. § 103 (a) over Ishino in view of Erchak .	Exhibit C Ground 1
Claims 6 and 36	Claims 6 and 36 are unpatentable under 35 U.S.C. § 103 (a) over Ishino in view of Erchak and Li '415 .	Exhibit C Ground 1
Claims 10 and 18	Claims 10 and 18 are unpatentable under 35 U.S.C. § 103 (a) over Ishino in view of Li '415 .	Exhibit C Ground 2
Claims 11 and 17	Claims 11 and 17 are unpatentable under 35 U.S.C. § 103 (a) over Ishino in view of Li '415 and Bakker .	Exhibit C Ground 2
Claims 1, 3-9, 18, and 32-38	Claims 1, 3-9, 18, and 32-38 are unpatentable under 35 U.S.C. § 103 (a) over Ishino in view of Li '415 and Erchak .	Exhibit C Ground 2
Claims 1, 3-9, 32-35, and 37-38	Claims 1, 3-9, 32-35, and 37-38 are unpatentable under 35 U.S.C. § 103 (a) over Uchiyama in view of Erchak .	Exhibit C Ground 3
Claims 6 and 36	Claims 6 and 36 are unpatentable under 35 U.S.C. § 103 (a) over Uchiyama in view of Erchak and Li '415 .	Exhibit C Ground 3
Claims 10 and 18	Claims 10 and 18 are unpatentable under 35 U.S.C. § 103 (a) over Uchiyama in view of Li '415 .	Exhibit C Ground 4
Claims 11 and 17	Claims 11 and 17 are unpatentable under 35 U.S.C. § 103 (a) over Uchiyama in view of Li '415 and Bakker .	Exhibit C Ground 4
Claims 1, 3-9, 18, and 32-38	Claims 1, 3-9, 18, and 32-38 are unpatentable under 35 U.S.C. § 103 (a) over Uchiyama in view of Li '415 and Erchak .	Exhibit C Ground 4
Claims 1, 3-10, 18, and 32-38	Claims 1, 3-10, 18, and 32-38 are unpatentable under 35 U.S.C. § 103 (a) over Ishino in view of Li '415 and Erchak .	Exhibit C Ground 5
Claims 11 and 17	Claims 11 and 17 are unpatentable under 35 U.S.C. § 103 (a) over Ishino in view of Li '415 , Erchak , and Bakker .	Exhibit C Ground 5
Claims 10 and 18	Claims 10 and 18 are unpatentable under 35 U.S.C. § 103 (a) over Ishino in view of Li '284 .	Exhibit C Ground 6
Claims 11 and 17	Claims 11 and 17 are unpatentable under 35 U.S.C. § 103 (a) over Ishino in view of Li '284 and Bakker .	Exhibit C Ground 6
Claims 1, 3-10, 18, and 32-38	Claims 1, 3-10, 18, and 32-38 are unpatentable under 35 U.S.C. § 103 (a) over Ishino in view of Li '284 and Erchak .	Exhibit C Ground 7
Claims 11 and 17	Claims 11 and 17 are unpatentable under 35 U.S.C. § 103 (a) over Ishino in view of Li '284 , Erchak , and Bakker .	Exhibit C Ground 7
Claims 1, 3-10, 18, and 32-38	Claims 1, 3-10, 18, and 32-38 are unpatentable under 35 U.S.C. § 103 (a) over Uchiyama in view of Li '415 and Erchak .	Exhibit C Ground 8
Claims 11 and 17	Claims 11 and 17 are unpatentable under 35 U.S.C. § 103 (a) over Uchiyama in view of Li '415 , Erchak , and Bakker .	Exhibit C Ground 8
Claims 10 and 18	Claims 10 and 18 are unpatentable under 35 U.S.C. § 103 (a) over Uchiyama in view of Li '284 .	Exhibit C Ground 9
Claims 11 and 17	Claims 11 and 17 are unpatentable under 35 U.S.C. § 103 (a) over Uchiyama in view of Li '284 and Bakker .	Exhibit C Ground 9
Claims 1, 3-10, 18, and 32-38	Claims 1, 3-10, 18, and 32-38 are unpatentable under 35 U.S.C. § 103 (a) over Uchiyama in view of Li '284 and Erchak .	Exhibit C Ground 10

'580 Patent		
Asserted Claim(s)	Prior Art Combination	Claim Chart
Claims 11 and 17	Claims 11 and 17 are unpatentable under 35 U.S.C. § 103 (a) over Uchiyama in view of Li '284 , Erchak , and Bakker .	Exhibit C Ground 10
Claims 10 and 18	Claims 10 and 18 are unpatentable under 35 U.S.C. § 103 (a) over Dho in view of Li '415 .	Exhibit C Ground 11
Claims 11 and 17	Claims 11 and 17 are unpatentable under 35 U.S.C. § 103 (a) over Dho in view of Li '415 and Bakker .	Exhibit C Ground 11
Claims 10 and 18	Claims 10 and 18 are unpatentable under 35 U.S.C. § 103 (a) over Ishino in view of Harbers .	Exhibit C Ground 12
Claims 11 and 17	Claims 11 and 17 are unpatentable under 35 U.S.C. § 103 (a) over Ishino in view of Harbers and Bakker .	Exhibit C Ground 12
Claims 10 and 18	Claims 10 and 18 are unpatentable under 35 U.S.C. § 103 (a) over Ishino in view of Iwanaga .	Exhibit C Ground 13
Claims 11 and 17	Claims 11 and 17 are unpatentable under 35 U.S.C. § 103 (a) over Ishino in view of Iwanaga and Bakker .	Exhibit C Ground 13
Claims 10 and 18	Claims 10 and 18 are unpatentable under 35 U.S.C. § 103 (a) over Uchiyama in view of Harbers .	Exhibit C Ground 14
Claims 11 and 17	Claims 11 and 17 are unpatentable under 35 U.S.C. § 103 (a) over Uchiyama in view of Harbers and Bakker .	Exhibit C Ground 14

As seen above, both the Board and District Court would make determinations based on the same references regardless of Petitioners' stipulation. In some cases, the Board and District Court will make determinations based on the **same** combination of references despite Petitioners' stipulation. For example, Ground 1 in the District Court litigation would require both the District Court and the Board to make determinations on whether Ishino in view of Erchak constitutes prior art of Claims 1, 3-5, 8-9, 32-35, and 38. Pet. 11; EX2006 (Invalidity Contentions) at 15. The stipulation fails to apply because the Petition offers new grounds as to Claims 6, 7,

and 37. *See id.* Thus, Petitioners' statement (Pet. 11) that "[t]here will be no overlap of issues between the two proceedings" is false.²

Given that the Petition is directed toward the same patent, encompasses the claims at issue in the parallel District Court Litigation, involves substantially overlapping prior art and arguments, and does not seek to mitigate concerns regarding duplicative efforts or potentially conflicting decisions via a *Sotera* stipulation, this factor strongly favors denial of institution.

5. The District Court Litigation And The Petition Involve The Same Parties (Factor 5)

As noted in Patent Owner's Mandatory Notice, there exists a parallel District Court Litigation between the same parties regarding the same subject patent (the '580 Patent). Petitioners are both parties to the District Court Litigation. Accordingly, this factor weighs in favor of discretionary denial. *See Sotera*, IPR2020-01019, Paper 12 at 19 (stating that this factor supports denying institution when the "parties are the same in the *inter partes* proceeding and in the parallel

² "A petitioner should file a *Sotera* or *Sand* stipulation as soon as practicable, so that a patent owner may address the impact of the stipulation in its discretionary denial brief." EX2015 (USPTO, *FAQs for Interim Processes for PTAB Workload Management*, <https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management> (last visited May 7, 2025)).

proceeding"). These facts fails to support Petitioners' assertion that *Fintiv* factor five is neutral. *See id.*

6. Other Factors Favor Discretionary Denial (Factor 6)

The challenges set forth in the Petition are flawed. For example, the Petition is deficient on its face because Petitioner has not properly construed what it contends are several means-plus-function claims of the '580 Patent. Petitioner contends claim elements 1.2, 1.3, 1.4, 10.2, 10.3, 10.4, 32.2, 32.3, and 32.4 are means-plus-function elements. Pet. at 25-26, 49-50.

Construing a means-plus-function claim term is a two-step process. Petitioner must first identify the claimed function. Then, Petitioner must determine what structure disclosed in the specification corresponds to the claimed function. *Williamson v. Citrix Online*, 792 F.3d 1339, 1351 (Fed. Cir. 2015) (en banc concerning Part II.C.1 (regarding "Applicability of 35 U.S.C. § 112, para. 6)). Board rules similarly require that a petition filed to initiate an *inter partes* review "must identify:"

How the challenged claim is to be construed. Where the claim to be construed contains a means-plus-function or step-plus-function limitation as permitted under 35 U.S.C. 112(f), the construction of the claim must identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function.

37 C.F.R. § 42.104(b)(3). This claim construction rule applies solely to the “petition.” *Id.* Failure to comply with this mandatory requirement will result in a petition being denied. *Head Sport GMBH v. Vermont Safety Developments LLC*, IPR2024-01099, Paper 15 at 34 (P.T.A.B. Jan. 15, 2025).

Here, for all of the elements Petitioner contends are means-plus-function elements, Petitioner alleges certain structure, but never identifies the alleged claimed *function*. Because Petitioner failed to comply with 37 C.F.R. § 42.104(b)(3) for every challenged claim, the Board should deny institution. *Head Sport*, IPR2024-01099, Paper 15 at 34.

Additionally, Petitioners waited years after receiving notice of the '580 patent on **April 27, 2023** (EX2001 (Complaint) ¶ 36) to file this IPR, only after substantial litigation progress. This delay suggests tactical gamesmanship aimed at disrupting the District Court case. As recognized in the Memo regarding discretionary denials, such considerations regarding case management, efficient use of resources, and potential abuse of process may be relevant to the denial analysis and weigh against institution here.

Although Petitioners filed the Petition prior to the statutory deadline (July 2025), they did not do so as quickly as they might have. Indeed, rather than prioritize this proceeding, Petitioners filed three motions to dismiss (including two based on invalidity) in the District Court Litigation, a motion to transfer venue, and a

declaratory judgment action. Plainly, the Petition was not a priority for Petitioners, and this factor is (at best) neutral.

IV. ADDITIONAL FACTORS SET FORTH IN THE MEMORANDUM SUPPORT DISCRETIONARY DENIAL

Beyond the established *Fintiv* framework, the Memo clarifies that the Director may weigh additional considerations relevant to fairness and efficiency. Several such considerations further support denying institution here.

A. Petitioners' Reliance on Expert Testimony

A substantial portion of Dr. Sasian's declaration appears to mirror the Petition's language, restating arguments and assertions made by Petitioners' counsel often nearly verbatim, without offering sufficient independent analysis, supporting data, or reasoning grounded in specific evidence beyond the Petition's own assertions.

The following provides a few examples:

Petition (Pet. at 16-17)	Sasian Decl. (Ex.1004, at ¶¶ 80-82)
Ishino discloses a projection-type image display that "includes an illuminator 2[,] which emits illumination light including components having three primary colors, respectively, and an optical system [including] a main condenser lens 6, dichroic mirrors 7 and 8, mirrors 11, 15 and 17, channel condenser lenses 9, 12 and 18, relay lenses 14 and 16, cross prism 20 and a projection lens 21" EX1005, [0054].	80. Ishino discloses a projection-type image display that, as shown in Fig. 1, reproduced below, "includes an illuminator 2[,] which emits illumination light including components having three primary colors, respectively, and an optical system[,] which includes a main condenser lens 6, dichroic mirrors 7 and 8, mirrors 11, 15 and 17, channel condenser lenses 9, 12 and 18, relay lenses 14 and 16, cross prism 20 and a projection lens 21 EX1005, [0054].

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Ishino further describes that the illuminator emits white light: “The lamp 1 emits an illumination light including components having three primary colors: R, G and B, ... The lamp 1 includes a light emitter, [which] is an ultra-high voltage mercury lamp, halogen lamp, metal halide lamp or a xenon lamp, for example.” <i>Id.</i>, [0056]-[0057]. Lamp 1 “emits generally parallel light.” <i>Id.</i>, [0123], [0126].	81. Ishino further describes that the illuminator emits white light: “The lamp 1 emits an illumination light including components having three primary colors: R, G and B, respectively. The lamp 1 includes a light emitter, [which] is an ultra-high voltage mercury lamp, halogen lamp, metal halide lamp or a xenon lamp, for example.” <i>Id.</i>, [0056]-[0057]. Ishino further describes that lamp 1 “emits generally parallel light.” <i>Id.</i>, [0123], [0126].
Ishino explains that “[t]he dichroic mirror 7 [] split[s] the illumination light ... into blue light 23 ..., and light [of] other primary colors. [The] mirror 11, channel condenser lens 12 and liquid crystal panel 13 [are] in this order along the optical path of the blue light 23 The liquid crystal panel 13 spatially modulates the blue light 23 ..., according to a video signal corresponding to the blue.” <i>Id.</i> [0061]-[0066]. “The dichroic mirror 8 splits the incident light components ... into a green light 24 ... and a red light 25 The liquid crystal panel 10 spatially modulates the green light 24 incident thereupon ... according to a video signal corresponding to green.” <i>Id.</i>, [0067]-[0071]. “The liquid crystal panel 19 [] spatially modulates the red light 25 according to a video signal corresponding to the red.” <i>Id.</i>, [0072]-[0074].	82. Ishino explains that “[t]he dichroic mirror 7 is provided to split the illumination light ... into blue light 23 ... and light components having wavelengths corresponding to other primary colors. [The] projector has provided therein the mirror 11, channel condenser lens 12 and the liquid crystal panel 13 in this order along the optical path of the blue light 23 The liquid crystal panel 13 spatially modulates the blue light 23 ... according to a video signal corresponding to the blue.” <i>Id.</i> [0061]-[0066]. Ishino further discloses that “[t]he dichroic mirror 8 splits the incident light components ... into a green light 24 ... and a red light 25 The liquid crystal panel 10 spatially modulates the green light 24 incident thereupon ... according to a video signal corresponding to green.” <i>Id.</i>, [0067]-[0071]. “The liquid crystal panel 19 will spatially modulate the red light 25 according to a video signal corresponding to the red.” <i>Id.</i>, [0072]-[0074].

The above examples are exemplary and pervade the Sasian declaration.

Such parroting of attorney argument diminishes the weight, if any, that should be accorded to the testimony. *See Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 12 (P.T.A.B. Feb. 10, 2023) (precedential) (according “little weight” to declaration testimony that contains a verbatim restatement of a petition’s conclusory assertions without additional supporting evidence or reasoning); *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1340–41 (Fed. Cir. 2020) (affirming

Board decision giving no weight to expert testimony that “merely repeated Petitioner’s argument, nearly verbatim, without citation to the basis for his testimony”); *see also* *Wowza Media Sys., LLC v. Adobe Sys. Inc.*, IPR2013-00054, Paper 12 at 12 (P.T.A.B. Apr. 8, 2013) (“The Declaration . . . appears, for the most part, simply to track and repeat the arguments for unpatentability presented in the Petition [and] . . . is therefore no more helpful tha[n] the Petition in determining where the challenged recitation is found in the references.”). This practice raises concerns under 37 C.F.R. § 42.65(a). *See* 37 C.F.R. § 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”).

Accordingly, Petitioners’ improper use of expert testimony further supports discretionary denial under 35 U.S.C. § 314(a).

V. CONCLUSION

For at least the foregoing reasons, the Board should deny institution of the Petition.

Dated: May 12, 2025

Respectfully submitted,

/Robert G Pluta Reg No 50970 /
Robert G. Pluta (Reg. No. 50,970)
MAYER BROWN LLP
71 S. Wacker Drive
Chicago, IL 60606
Telephone: (312) 701-8641
Fax: (312) 706-8144

Patent No. 8,593,580

Brief in Support of Patent Owner's Request for Discretionary Denial

Bryan C. Nese (Reg. No. 66,023)

Sora Ko (Reg. No. 78,801)

MAYER BROWN LLP

1999 K Street NW

Washington, D.C. 20006

Telephone: (202) 263-3000

bnese@mayerbrown.com

sko@mayerbrown.com

Counsel for Maxell, Ltd.

Patent No. 8,593,580

Brief in Support of Patent Owner's Request for Discretionary Denial

CERTIFICATE OF SERVICE

I hereby certify that on this 12th day of May, 2025, a copy of the attached Brief in Support of Patent Owner's Request for Discretionary Denial, together with all exhibits was served by electronic mail to the attorneys of record, at the following addresses:

Donald R. McPhail

dmcphail@merchantgould.com

John S. Kern

jkern@merchantgould.com

Tong Wu

twu@merchantgould.com

With a courtesy copy by electronic mail to: coretronic580ipr@merchantgould.com

Respectfully submitted,

Date: May 12, 2025

By: /Robert G Pluta Reg No 50970/
Robert G. Pluta (Reg. No. 50,970)

Counsel for Maxell, Ltd.

CERTIFICATION PURSUANT TO 37 C.F.R. § 42.24(d)

Pursuant 37 CFR 42.24(d), the undersigned certifies that this Preliminary Response and complies with the type-volume limitation of 37 CFR §42.24(a). The word count application of the word processing program used to prepare this Preliminary Response indicates that the Preliminary Response contains 4,151 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

Respectfully submitted,

/Robert G Pluta Reg No 50970/

Robert G. Pluta (Reg. No. 50,970)
Mayer Brown, LLP
71 S. Wacker Drive
Chicago, IL 60606
Telephone: (312) 701-8641
Fax: (312) 706-8144
rpluta@mayerbrown.com