

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

HISENSE USA CORPORATION and
HISENSE ELECTRONICA MEXICO S.A. de C.V.,
Petitioner,

v.

VIDEOLABS, INC.,
Patent Owner.

IPR2025-00880 (Patent 8,291,236 B2)
IPR2025-00881 (Patent 8,291,236 B2)
IPR2025-00882 (Patent 8,291,236 B2)
IPR2025-00883 (Patent 8,667,304 B2)

Before COKE MORGAN STEWART, *Deputy Under Secretary of
Commerce for Intellectual Property and Deputy Director of the United
States Patent and Trademark Office.*

DECISION
Denying Institution of *Inter Partes* Review

IPR2025-00880 (Patent 8,291,236 B2)
IPR2025-00881 (Patent 8,291,236 B2)
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VideoLabs, Inc. (“Patent Owner”) filed a request for discretionary denial (Paper 8, “DD Req.”) in the above-captioned cases, and Hisense USA Corporation and Hisense Electronica Mexico S.A. de C.V. (“Petitioner”) filed an opposition (Paper 9, “DD Opp.”).¹

After considering the parties’ arguments and the record, and in view of all relevant considerations, discretionary denial of institution is appropriate in these proceedings. This determination is based on the totality of the evidence and arguments the parties have presented.

Some considerations counsel against discretionary denial. In particular, the projected final written decision due date in these proceedings is December 24, 2026. No trial date has been set in the parallel proceeding involving the parties and the challenged patents. DD Opp. 4. As such, it is likely that a final written decision will issue before the district court trial occurs, reducing the concern of inconsistent outcomes or significant duplication of efforts resulting from two proceedings operating in parallel.

Other considerations, however, favor discretionary denial. In particular, the challenged patents have been in force for twelve and eleven years, creating settled expectations for Patent Owner. DD Req. 1, 7–8. Patent Owner also provides evidence that the challenged patents have been licensed to over twenty companies. *Id.* at 4; Ex. 2002. In addition, Patent Owner provides evidence that it has been in contact with Petitioner since December 2022, when Patent Owner sent Petitioner a notice letter regarding Patent Owner’s patent portfolio. DD Req. 4–5, 9; Ex. 2004. Patent Owner

¹ Citations are to papers in IPR2025-00880. The parties filed similar papers in IPR2025-00881, IPR2025-00882, and IPR2025-00883.

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specifically notified Petitioner about the challenged patents in June 2023, when Patent Owner provided Petitioner with a claim chart during licensing negotiations. DD Req. 9. Petitioner's arguments regarding Patent Owner's settled expectations are not persuasive, and Petitioner does not otherwise provide persuasive reasoning why an *inter partes* review is an appropriate use of Board resources. *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 2–3 (Director June 18, 2025).

Although certain arguments are highlighted above, the determination to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented. Accordingly, the Petitions are denied under 35 U.S.C. § 314(a).

In consideration of the foregoing, it is:

ORDERED that Patent Owner's request for discretionary denial is *granted*; and

FURTHER ORDERED that the Petitions are *denied*, and no trial is instituted.

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