PTO-2326 (04-2024)
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

REQUEST FOR REFUND

Reference # *(Patent #, Application #, Trademark Serial #, Registration #, etc.)*	**Title of Invention or Mark Information**	
IPR2025-00942	PROJECTION-TYPE IMAGE DISPLAY DEVICE	
Attorney Docket # *(if applicable)*	**Payment Date** *(mm/dd/yyyy)*	**Refund Request Amount**
19702.0012USWX	05/14/2025	$ 28,125.00

Refund Option *(Select one)*

- (●) If approved, issue the refund to the account associated with the original payment.
- ( ) If approved, and the original payment was a check, issue the refund to deposit account # _____.
- ( ) If approved, and the original payment was a check, issue the refund as a U.S. Treasury check.

Reason for Refund Request *Refund requests must generally be filed within 2 years of payment date (37 CFR 1.26 and 2.209)*

- [ ] Duplicate Payment
- [ ] No Fee Due
- [ ] Office Error
- [x] Other: Discretionary Denial
- [ ] Small Entity Later Established* **(Must be filed within 3 months of payment date, 37 CFR 1.28. There is no refund when micro entity is later established.)*

Rationale *(Supporting documentation may be submitted with this form)*

IPR Petition was denied due to a Discretionary Denial decision.

Requester's Information

Company or Firm Name *(if applicable)*		
Merchant & Gould, P.C.		
Address Line 1	**City**	**State/Region**
1900 Duke Street, Suite 600	Alexandria	VA
Address Line 2 *(if applicable)*	**Country**	**Zip/Postal Code**
	USA	22314
Email Address *(You will receive an acknowledgment of receipt only if you provide a valid email address)*	**Phone Number**	
jkern@merchantgould.com	(703) 518-4514	
Requester's Name	**Registration Number** *(if applicable)*	
John Kern	42,719	
Signature	**Date** *(mm/dd/yyyy)*	
/s/ John Kern	10/06/2025	

Submit online via Patent Center (Patents customers who are registered users only): https://patentcenter.uspto.gov, or
Fax to: 571-273-6500, or
Mail to: Mail Stop 16, Director of the U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450

EXHIBIT A

Director_Discretionary_Decision@uspto.gov
571-272-7822

Paper 9
Date: September 26, 2025

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

CORETRONIC CORPORATION and
OPTOMA CORPORATION,
Petitioner,

v.

MAXELL, LTD.,
Patent Owner.

IPR2025-00941 (Patent 7,159,988 B2)
IPR2025-00942 (Patent 9,900,569 B2)

Before COKE MORGAN STEWART,[1] *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

---

[1] The Director has delegated his discretionary authority to the Deputy Director for this decision. *See* https://www.uspto.gov/sites/default/files/documents/dsco-delegation.pdf.

Maxell, Ltd. ("Patent Owner") filed a request for discretionary denial (Paper 7, "DD Req.") in the above-captioned cases, and Coretronic Corporation and Optoma Corporation (collectively, "Petitioner") filed an opposition (Paper 8, "DD Opp.").[2]

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.

In particular, the challenged patents have been in force for approximately seven and eighteen years, creating settled expectations for Patent Owner, and Petitioner does not provide any 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).

Additionally, the projected final written decision due date in these Board proceedings is in December 2026. The patent challenged in IPR2025-00942 is part of a parallel district court proceeding involving the parties. Although there is currently no trial date set for the district court trial, Patent Owner presents time-to-trial statistics that suggest trial would begin in August 2026, which Petitioner does not contest. DD Req. 6–8; DD Opp. 4–5. As such, it is unlikely that a final written decision in this proceeding will issue before the district court trial occurs, resulting in significant duplication of effort, additional expense for the parties, and a risk of inconsistent decisions. Additionally, there is insufficient evidence that the district court

[2] Citations are to papers in IPR2025-00941. The parties filed similar papers in IPR2025-00942.

is likely to stay its proceeding even if the Board were to institute trial, and there has been meaningful investment in the parallel proceeding by the parties. DD Req. 4–5, 9–14. For example, the parties have participated in a *Markman* hearing, fact discovery was scheduled to close on August 21, 2025, and expert discovery will close soon. *Id.* at 7–8.

The patent challenged in IPR2025-00941 presents different circumstances. Patent Owner is no longer asserting the challenged patent in the parallel district court proceeding. DD Opp. 2; Ex. 1017. It is an inefficient use of Board resources to review claims of a patent that will not be further addressed in the district court trial involving the parties. *See Roche Diabetes Care, Inc. v. Trividia Health, Inc.*, IPR2025-00553, Paper 10 (Director July 29, 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 requests for discretionary denial are *granted*; and

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

FOR PETITIONER:

Donald McPhail
John Kern
MERCHANT & GOULD P.C.
dmcphail@merchantgould.com
jkern@merchantgould.com

FOR PATENT OWNER:

Robert Pluta
Bryan Nese
So Ko
MAYER BROWN LLP
rpluta@mayerbrown.com
bnese@mayerbrown.com
sko@mayerbrown.com