

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

L'OREAL USA, INC.,
Petitioner,

v.

BRIGHTEX BIO-PHOTONICS, LLC,
Patent Owner.

IPR2025-00971
Patent 9,542,595 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

Brightex Bio-Photonics, LLC (“Patent Owner”) filed a request for discretionary denial (Paper 7, “DD Req.”) in the above-captioned case, and L’Oréal USA, Inc. (“Petitioner”) filed an opposition (Paper 11, “DD Opp.”).

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

Some considerations counsel against discretionary denial. For example, the parallel district court proceeding has been stayed. *See* DD Req. 41; DD Opp. 19. Therefore, it is likely that the final written decision in this proceeding will issue before the district court trial occurs.

Other considerations, however, favor discretionary denial. In particular, the challenged patent has been in force for eight years, creating settled expectations for Patent Owner. DD Req. 19. Additionally, it is uncontested that the parties were technology partners for many years and developed products together. *Id.* at 1–3, 20. Patent Owner provides evidence demonstrating that it informed Petitioner of the filing of the provisional application that led to the challenged patent in 2013, the publication of the non-provisional application in 2014, and the issuance of the challenged patent in 2017. *Id.* at 1–2, 5; Ex. 2015 ¶¶ 6–7. Patent Owner also sent a letter to Petitioner in 2022 identifying the challenged patent as relevant to Petitioner’s products. Ex. 1022. Accordingly, Petitioner appears to have had notice of the challenged patent for a significant period of time. Under these circumstances, the considerations that favor discretionary denial outweigh those that counsel against it.

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 Petition is 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 Petition is *denied*, and no trial is instituted.

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