

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

VIDEOLABS, INC.,
Patent Owner.

Case No. IPR2025-01329
Patent No. 7,769,238

**JOINT MOTION TO TERMINATE PURSUANT TO
37 C.F.R. §§ 42.72 & 42.74**

LISTING OF EXHIBITS

Exhibit	Description
1001	U.S. Patent No. 7,769,238 (the “’238 patent”)
1002	Prosecution History of U.S. Patent No. 7,769,238
1003	Declaration of Dr. Kannan Ramchandran
1004	International Publication No. WO03063501A1 (“Karczewicz”)
1005	Karczewicz Priority Application No. 10/054,610
1006	Karczewicz Priority Provisional Application No. 60/369,500
1007	ITU-T Recommendation H.324 (“H.324”)
1008	ITU-T Recommendation H.263 (“H.263”)
1009	Chart Comparing disclosures from Karczewicz (Ex. 1004) and the corresponding disclosures from Karczewicz 60/369,500 Provisional Application (Ex. 1006)
1010	JVT-B045 (“Improved Low Complexity Entropy Coding for Transform Coefficients,” Bjontegaard, Gisle)
1011	U.S. Patent No. 7,099,387 (“Bjontegaard”)
1012	IPR2018-00658, Paper 14
1013	IPR2022-00628, Paper 10
1014	IEEE Publication “Scene adaptive coder,” IEEE Transactions on Communications, 1984, W. Chen, C. H. Hsia, and W.K. Pratt
1015	IEEE Publication “Motion-compensation prediction with fractional-pel accuracy,” IEEE Transactions on Communications, April 1993, Bernd Girod
1016	Confidential Membership and License Agreement

Pursuant to 37 C.F.R. §§ 42.72 and 42.74, and the authorization provided by the Board on November 10, 2025, 2025, Petitioners Hisense USA Corporation and Hisense Electronica Mexico S.A. de C.V. (“Petitioners”) and Patent Owner VideoLabs, Inc. (“Patent Owner”) jointly move to terminate this proceeding in view of the parties’ settlement of their dispute relating to U.S. Patent No. 7,769,238 (“the ’238 Patent”). The parties are filing, concurrently with the present Motion, a true and complete copy of their written Membership and License Agreement (“Agreement”) (Confidential Exhibit 1016). This Agreement completely settles the parties’ dispute relating to the ’238 patent.

The parties further jointly certify that there are no other agreements or understandings, oral or written, between Patent Owner and Petitioners, including any collateral agreements, made in connection with, or in contemplation of, the termination of the present proceeding as set forth in 35 U.S.C. § 317(b).

The parties request that the Agreement be treated as business confidential information and kept separate from the file of this IPR. A joint request to treat the Agreement as business confidential information kept separate from the IPR file pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is being filed concurrently with this Motion.

I. ARGUMENT

A joint motion to terminate “must (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper No. 26, at *2 (P.T.A.B. July 28, 2014). These factors are addressed in turn below.

A. Why Termination is Appropriate

The parties “may terminate the proceeding ... unless the Board has already decided the merits of the proceeding.” Consolidated Office Patent Trial Practice Guide, 4 (November 2019); *see also id.*, 86 (“The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding”). Here, the parties have entered into a settlement and no longer have a dispute regarding the ’238 patent. Further, this proceeding is in its preliminary phase: the Board has yet to issue a decision on institution let alone a final decision on the merits. The Board can conserve its resources by terminating now, removing the need for the Board to further consider the arguments, to issue an institution decision, or render a final decision. Ending this proceeding early will promote the Congressional goal of establishing a more

efficient patent system by limiting unnecessary and counterproductive costs. *See* Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, 77 Fed. Reg. 48,680 (Aug. 14, 2012).

Termination is also appropriate for public policy reasons. Again, the parties have settled their dispute. And, Congress and federal courts favor settlement of litigation. *See, e.g., Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) (“The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation.”); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir.) (“The law favors settlement of cases.”), cert. denied, 479 U.S. 950 (1986). The Federal Circuit similarly favors settlement. *See Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between parties). Likewise, the Board’s original Trial Practice Guide states that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 46,768 (Aug. 14, 2012).

B. Identity and Status of Any Related Litigations

The ’238 patent is at issue in *VideoLabs, Inc. et al. v. Hisense Co. Ltd. et al.*, No. 2:24-cv-00904-JRG-RSP (EDTX); *VideoLabs, Inc. et al. v. Meta Platforms, Inc. et al.*, No. 1:22-cv-00680 (D. Del) (settled); *VideoLabs, Inc. v. HP Inc.*, No. 6:22-

cv-01086 (WDTX) (settled); *VideoLabs, Inc. v. ASUSTeK Computer Inc. et al.*, No. 6:22-cv-00720 (WDTX) (settled); *VideoLabs, Inc. v. TCL Technology Group Corporation et al.*, No. 2:25-cv-00161 (E.D. Tex) (settled); *VideoLabs, Inc. v. Giga-Byte*, No. 2:25-cv-0704 (E.D. Tex.) (settled); *VideoLabs, Inc. et al. v. Roku, Inc.*, No. 1:23-cv-01136 (D. Del) (settled); *VideoLabs, Inc. v. Dell Techs. Inc.*, No. 6:21-cv-00456-ADA (WDTX) (settled); *VideoLabs, Inc. v. Dell Technologies Inc.*, No. 1:23-cv-01366 (WDTX) (consolidated with 6:21-cv-00456, settled); *VideoLabs, Inc. v. Lenovo Group Limited et al.*, No. 6:22-cv-00721 (WDTX) (settled); *VideoLabs, Inc. v. Micro-Star International Co., Ltd. et al.*, No. 6:22-cv-00722 (WDTX) (settled); *VideoLabs, Inc. v. Amazon.com, Inc.*, No. 6:22-cv-00079 (WDTX) (settled); *VideoLabs, Inc. v. Amazon.com Inc.*, No. 6:22-cv-01167 (WDTX) (settled); *VideoLabs, Inc. v. Amazon.com Inc.*, No. 2:22-cv-01451 (WD Wash.) (settled); *VideoLabs, Inc. v. Acer Inc. et al.*, No. 6:22-cv-00719 (WDTX) (settled); *Optis Wireless Technology, LLC v. Huawei Technologies Co, Ltd.*, No. 2:17-cv-00123 (EDTX) (settled); *Certain Video Processing Devices and Products Containing the Same*; Inv. No. 337-TA-1323 (Violation) ITC-337-TA-1323 (Terminated 4-25 2025); *Certain Video Processing Devices and Products Containing the Same*; Inv. No. 337-TA-1341 (Violation) ITC-337-TA-1341 (Terminated 8-1-2023); *Huawei Device Co., Ltd. v. Optis Wireless Tech., LLC*,

IPR2018-00658; and *Dell Technologies Inc. v. VideoLabs, Inc.*, IPR2022-00628.

Each of these cases is either settled, terminated or stayed pending settlement.

C. Identity and Status of Any Related Proceedings Currently Before the Office

The '238 patent is not currently at issue in any other pending *inter partes* review proceedings.

II. CONCLUSION

For the foregoing reasons, the parties jointly and respectfully request that the instant proceeding be terminated.

Respectfully submitted,

Dated: November 11, 2025

/Richard F. Martinelli/

Richard F. Martinelli
ORRICK, HERRINGTON & SUTCLIFFE LLP
Registration No. 52,003
51 West 52nd Street
New York, NY 10019-6142
Tel: 212-506-3702
Email: RFMPTABDocket@orrick.com

Attorneys for Petitioners

/Wayne M. Helge/

Wayne M. Helge
Registration No. 56,905
James T. Wilson
Registration No. 41,439
BUNSOW DE MORY LLP
277 South Washington Street, Suite 210
No. 1088
Alexandria, VA 22314
Tel: 571-208-0186
Email: BDIP-
VideoLabs_Hisense@bdiplaw.com
Email: erobinson@bdiplaw.com

Attorneys for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby confirms that the foregoing paper was caused to be served on November 11, 2025 via electronic mail, upon the following attorneys of record for the Patent Owner:

Wayne M. Helge whelge@bdiplaw.com
James T. Wilson jwilson@bdiplaw.com
BDIP-VideoLabs_Hisense@bdiplaw.com
erobinson@bdiplaw.com

BUNSOW DE MORY LLP

/Karen Johnson/

Karen Johnson