

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HISENSE USA CORP.,

Petitioner,

v.

LIGHT GUIDE INNOVATIONS LLC,

Patent Owner.

Patent No. 8,408,778

Filing Date: February 2, 2010

Issue Date: April 2, 2013

Inventor: Hyung Hwa Park

Title: LIGHT SOURCE AND DISPLAY DEVICE HAVING THE SAME

**PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL OF INSTITUTION**

Case No. IPR2025-01526

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LIST OF EXHIBITS

Exhibit No.	Description of Document
2001	Docket Control Order (Dkt. 31) in <i>Light Guide Innovations LLC v. Walmart Inc.</i> , Case No. 2-25-cv-00312-RWS-RSP (Lead Case); <i>Light Guide Innovations v. Hisense Co.</i> , Case No. 2:25-cv-00051-RWS-RSP (Member Case) dated August 4, 2025 (E.D. Tex.)
2002	Complaint for Patent Infringement (Dkt. 1) in <i>Light Guide Innovations v. Hisense Co.</i> , Case No. 2:25-cv-00051-RWS-RSP dated January 17, 2025 (E.D. Tex.)
2003	Hisense Defendants' Invalidity and Subject Matter Eligibility Contentions in <i>Light Guide Innovations LLC v. Walmart Inc.</i> , Case No. 2-25-cv-00312-RWS-RSP (Lead Case); <i>Light Guide Innovations v. Hisense Co.</i> , Case No. 2:25-cv-00051-RWS-RSP (Member Case) dated September 22, 2025

I. INTRODUCTION

Pursuant to the Director’s March 26, 2025, Memorandum Regarding Interim Processes for PTAB Workload Management, Light Guide Innovations LLC (“LGI” or “Patent Owner”) files this Request for Discretionary Denial of Institution.

On September 10, 2025, Hisense USA Corp. (“Petitioner”) submitted a Petition (Paper 3, “Petition” or “Pet.”) requesting *inter partes* review (“IPR”) of U.S. Patent No. 8,408,778 (Ex. 1001, the “’778 Patent”). The Petition asserts *four* obviousness grounds relying on *five* different references, challenging Claims 1-15 and 20-26 (the “Challenged Claims”).

The Petition identifies co-pending district court litigation *Light Guide Innovations v. Hisense Co.*, Case No. 2:25-cv-00051-RWS-RSP (E.D. Tex., Jan. 17, 2025) (the District Court Litigation). Pet. at 1. The District Court Litigation is consolidated with *Light Guide Innovations LLC v. Walmart Inc.*, Case No. 2:25-cv-00312-RWS-RSP (E.D. Tex., March 21, 2025), and has a trial date set for February 16, 2027. Ex. 2001. Institution of any grounds will result in the issuance of a Final Written Decision (“FWD”) by March 22, 2027.

The Director should exercise discretion to deny the Petition under 35 U.S.C. § 314(a). First, the Petitioner asserts four obviousness grounds based on five different references, but does not assert any anticipation. Second, the real parties-in-interest are Defendants in a parallel proceeding. Third, the District Court Litigation

overlaps with the claims at issue in the Petition. Fourth, trial in the District Court Litigation is set for February 16, 2027, over a month prior to the projected statutory deadline for a Final Written Decision of this Petition on March 22, 2027. Fifth, the parties have invested significant resources in developing legal and factual issues of validity and infringement in the District Court Litigation and will have invested substantially more resources before any FWD. Finally, there are settled expectations regarding the '778 Patent, as it was granted over 12 years ago.

II. THE PETITION SHOULD BE DENIED IN THE DISCRETION OF THE DIRECTOR UNDER 35 U.S.C. § 314(a)

The circumstances of the parallel District Court Litigation necessitate denial of the Petition under the Board's precedent, as every factor considered in relation to efficiency, fairness, and the merits supports denial. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 6 (P.T.A.B. Mar. 20, 2020) (precedential) (hereinafter "*Fintiv*"); *see also NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, at 20 (P.T.A.B. Sept. 12, 2018) (finding institution would not be consistent with the objective of the AIA to "provide an effective and efficient alternative to district court litigation.") (quoting *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, at 16–17 (P.T.A.B. Sept. 6, 2017) (precedential)).

A. The Petition's Excessive Number of Grounds and Weak Merits Warrant Discretionary Denial

The Petition does not assert any anticipation. *See* Pet. at 4; *see also Fintiv*,

IPR2020-00019, Paper 11, at 6 (considering “other circumstances that impact the Board’s exercise of discretion, including the merits.”). Rather, the Petition asserts a patchwork of *four* obviousness grounds combining *five* different references¹ to challenge claims directed to a display light source (“such as a backlight assembly”), strongly weighing in favor of discretionary denial. *See* Pet. at 4; ’778 Patent at 1:14-24. Any institution decision addressing so many grounds and motivations to combine, let alone a trial and FWD, would be excessively burdensome. This excessive burden is of Hisense’s making and is grossly disproportionate to the resources warranted for the Board to expend on a single IPR.

Moreover, while the Petition wrongly asserts that the Examiner erred in allowing the claims over the Kurihara reference, it notably does *not* identify any “optical sheet . . . and a conversion sheet provided on an optical sheet” disclosed in Kurihara.² *See* Pet at 9. Instead, Petitioner only highlights a “phosphor film” in

¹ Notably, the Petition’s Ground 1 challenging independent Claims 1 and 23 relies on a combination of two references, and its Ground 4 challenging independent Claim 20 relies on a combination of three references.

² Petitioner also argues that the Examiner erred in characterizing the Choi reference, over which no rejection was issued, as “the closest prior art,” following amendment,

yellow (which it identifies as the claimed “conversion sheet), without identifying any allegedly disclosed “optical sheet” which is “on a top surface of the light guide plate,” and on which “a conversion sheet [is] provided on a top surface [of].” Similar deficiencies in the asserted references apparently prevented Petitioner from advancing any anticipation grounds. The fact that no allegedly anticipatory art was available is telling.

**B. The Parallel District Court Litigation and the Petition
Involve the Same Real Parties-in-Interest**

As Petitioner notes, there exists a parallel District Court Litigation between the same parties regarding the same subject patent (the ’778 Patent). Pet. at 1; Paper No. 6 (“Patent Owner’s Mandatory Notice”), at 2. Petitioner is a subsidiary of Hisense Company Ltd. and lists the Defendants of the District Court Litigation as real parties-in-interest. Pet. at 1. The District Court Litigation involves causes of action asserting the ’778 Patent against Petitioner’s products, which include LED-backlit LCD televisions. *See* Ex. 2002 at 9. Petitioner waited almost eight months

but fails to articulate how this alleged error is in any way material to validity. At most Petitioner argues that Choi is irrelevant. But the Examiner’s diligence in addressing what was characterized as the closest prior art after amendment does not constitute an error merely because Petitioner disagrees.

after Patent Owner filed its Complaint against Petitioner in the District Court Litigation on January 17, 2025 before filing its Petition on September 10, 2025. Ex. 2002.

Accordingly, this factor weighs strongly in favor of discretionary denial.

C. The Parallel District Court Litigations Involve Substantially the Same Claims

There is overlap between the claims and grounds at issue in this Petition and the District Court Litigation because the Petition challenges claims 1-15 and 20-26 of the '778 Patent³, including Claims 1, 4, and 13-15 asserted in the District Court Litigation, under the same grounds asserted in the District Court Litigation. In particular, Hisense's Invalidity Contentions in the District Court Litigation challenge the Challenged Claims using Japanese Patent Publication No. 2005-332963 ("Asada") (Ex. 1004), Japanese Patent Publication No. 2008-117879 ("Kinoshita") (Ex. 1005), an allegedly published article in the *Sixth International Conference on Solid State Lighting* ("Ashdown") (Ex. 1006), Korean Patent No. 10-0664982 ("Cho") (Ex. 1007), and U.S. Patent Application Publication No. US

³ While the Petition's cover page purports to challenge claims 1-26, the grounds of the Petition do not address Claims 16-19. *See* Pet. at 4.

2006/0255711 (“Dejima”) (Ex. 1010) the exact same references asserted in this proceeding. *Compare* Pet. at 4, 14-21 *with* Ex. 2003 at 27-29.

“In at least these ways, the parallel proceedings would duplicate effort. This is an inefficient use of Board, party, and judicial resources and raises the possibility of conflicting decisions.” *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, IPR2020-00122, Paper 15 at 10 (P.T.A.B. May 15, 2020). This waste of the Board’s resources would be particularly excessive in this proceeding given the Petition’s *four* obviousness grounds over *five* different references.

Accordingly, this factor weighs strongly in favor of discretionary denial.

D. Proximity of the District Court’s Trial Date

The proximity of the District Court Litigation’s trial date to the Board’s projected statutory deadline for a Final Written Decision weighs strongly in favor of discretionary denial. The trial in the District Court Litigation is scheduled for February 16, 2027. Ex. 2001. Pursuant to 35 U.S.C. §§ 314(b)(1) and 316(a)(11), the projected statutory deadline for a Final Written Decision of this Petition is March 22, 2027.⁴ As the District Court Litigation’s trial will be over a month before the

⁴ Patent Owner will file a timely preliminary response on December 22, 2025. The statutory deadline for institution is March 22, 2026, “three months after receiving a

projected statutory deadline, this factor weighs strongly in favor of denying institution. *See Next Caller Inc. v. TRUSTID, Inc.*, IPR2019-00961, -00962, Paper 10, at 8-16 (P.T.A.B. Oct. 16, 2019) (denying institution where trial was scheduled to conclude “several months,” before a final decision would be due); *F5 Networks, Inc. v. WSOU Invs., LLC*, IPR2022-00239, Paper 12 at 7-8 (P.T.A.B. May 19, 2022) (denied when trial predates FWD by six months); *Google LLC v. EcoFactor, Inc.*, IPR2021-00488, Paper 12 at 11-12 (P.T.A.B. Aug. 11, 2021) (denied when trial predates FWD by six months); *Cisco Sys., Inc. v. Oyster Optics, LLC*, IPR2021-00238, Paper 10 at 11-13 (P.T.A.B. Jun. 1, 2021) (denied when trial predates FWD by seven months); *Samsung Elecs. Co. v. Truesight Commc’ns LLC*, IPR2025-00123, Paper 12, at 6-7 (P.T.A.B. Apr. 22, 2025) (denied when trial predates FWD by six months). The month differential between the February 2027 trial date and the March 2027 FWD justifies discretionary denial.

Accordingly, this factor weighs in favor of discretionary denial.

preliminary response to the petition under section 313.” *See* 35 U.S.C. § 314(b)(1). If instituted, the statutory deadline for a Final Written Decision is March 22, 2027, “not later than 1 year after the date on which the Director notices the institution of a review.”

E. Significant Investment in the Parallel Proceeding

The parties' investment in the parallel District Court Litigation weighs strongly in favor of discretionary denial. The parties have already exchanged infringement and invalidity contentions, and claim construction briefing begins July 6, 2026. The deadline for substantial completion of document production will also pass on July 6, 2026. Ex. 2001. By the deadline for a FWD, the case will have completed claim construction, fact discovery, expert discovery, and will have obtained a jury verdict. The substantial investments in the District Court Litigation weigh strongly in favor of denial of institution.

F. Settled Expectations of the Parties

The '778 Patent was granted April 2, 2013, more than 12 years before Petitioner brought this action, and claims priority to an application from February 17, 2009, which is more than 16 years before Petitioner filed its Petition. Ex. 1001. As such, Patent Owner has settled expectations at this point. The Board has previously discretionarily denied institution because "the challenged patent has been in force almost eight years, creating settled expectations." *Dabico Airport Sols. Inc. v. AXA Powers Aps*, IPR2025-00408, Paper 21 at 2 (P.T.A.B. June 18, 2025). The Board also noted that "the longer the patent has been in force, the more settled expectations should be" and equated this approach to the six-year damages period related to filing infringement lawsuits. *Id.* at 3. The situation is no different here, as

“actual notice of a patent or of possible infringement is not necessary to create settled expectations.” *Id.* This factor weighs strongly in favor of discretionary denial.

III. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Director exercise discretion to deny institution of the Petition.

Respectfully submitted,

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CERTIFICATE OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION has 1,581 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24. This word count was prepared using Microsoft Word for Office 365.

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CERTIFICATE OF SERVICE

A copy of the foregoing PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION and Exhibits 2001 through 2003 have been served on Petitioner's counsel of record as follows:

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