

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DOLBY LABORATORIES, INC.,
Petitioner,

v.

INTERDIGITAL MADISON PATENT HOLDINGS, SAS,
Patent Owner

Case IPR2026-00252
Patent 9,185,268

**PETITIONER’S OPPOSITION TO PATENT OWNER’S REQUEST FOR
DISCRETIONARY DENIAL**

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	REFERRAL IS WARRANTED BECAUSE THE EXAMINER ERRED WHEN MISINTERPRETING THE “MASTERING” LIMITATION	2
A.	<u>Error 1</u> : The Examiner Misinterpreted The “Mastering” Limitation By Incorrectly Equating “Reference” And “Non-Reference” Displays/Gamuts	2
B.	<u>Error 2</u> : The Examiner Allowed The Claims Without Ever Conducting A Thorough Search Aligned With The Scope Of The “Mastering” Limitation	6
III.	OTHER DISCRETIONARY FACTORS DO NOT OUTWEIGH MATERIAL EXAMINATION ERROR.....	7
A.	<i>Revvo, Tesla, and Generac</i> Are Inapplicable To These Facts, And No Substantive Inconsistency Exists	7
1.	Dolby Is Not A Party To The Disney Action, And The Petition’s Constructions Are Consistent With The <i>Markman</i> Order	8
2.	The Dolby DJ Action Has Not Progressed To Claim Construction, And Presents No Basis for Inconsistency	12
B.	InterDigital’s Claimed Settled Expectations Do Not Support Discretionary Denial Because They Are Not Tied To The ’268 Patent’s Lifetime Or Dolby’s Technology Space	13
1.	InterDigital’s Licensing Evidence Is Non-Specific, And The Recency Of Its Only Enforcements Expose Any Patent Owner Expectations Unsettled Or Undermined By InterDigital’s Own Conduct	14
2.	Per <i>Proxense</i> , InterDigital’s Failure To Apply The ’268 Patent In Dolby’s Technology Space Weighs Against Settled Expectations	16
C.	The <i>Fintiv</i> Factors Do Not Favor Discretionary Denial For Either The Disney Action Or The Dolby DJ Action.....	16

1.	Disney Action—Dolby Is Not a Party, And Material Examination Error Overrides Schedule-Based Concerns.....	16
2.	Dolby DJ Action—In Its Earliest Stages, and Scheduled Trial Is Likely To Postdate The Board’s Anticipated FWD	18
D.	§325(d) Discretionary Denial Is Not Appropriate Because The Petition Relies On New Prior Art Never Before The Office.....	19
IV.	ADDITIONAL DISCRETIONARY CONSIDERATIONS FURTHER SUPPORT REFERRAL	20
V.	CONCLUSION.....	20

EXHIBITS

DOLBY-1001	U.S. Patent No. 9,185,268 to Doser et al. (“the ’268 Patent”)
DOLBY-1002	Prosecution History of the ’268 patent (“the Prosecution History”)
DOLBY-1003	Declaration and Curriculum Vitae of Dr. Eli S. Saber
DOLBY-1004	U.S. Pat. No. 7,053,927 (“Jones”)
DOLBY-1005	International Pat. Pub. No. WO 2007/050091 (“Ollivier”)
DOLBY-1006	U.S. Pat. App. Pub. No. 2007/0058183 (“Osaki”)
DOLBY-1007	U.S. Pat. App. Pub. No. 2007/0211074 (“Yeung”)
DOLBY-1008	Bancroft, Dave, “Emulating the Film Color Model in Digital Movie Production,” <i>Color and Imaging Conference</i> . Vol. 11. Society of Imaging Science and Technology, 2003
DOLBY-1009	Digital Cinema Initiatives, LLC, “Digital Cinema System Specification (V1.0),” 2005
DOLBY-1010	Morovič, Ján & Johan Lammens, “Color Management,” <i>Colorimetry: Understanding the CIE System</i> , John Wiley & Sons, Ch. 7 (pp. 159-203) (2007) (“Morovič”)
DOLBY-1011	Vetro, Anthony, “MPEG-21 Digital Item Adaptation: Enabling Universal Multimedia Access,” <i>IEEE MultiMedia</i> , vol. 11, no. 1, Jan-Mar. 2004, pp. 84-87 (“Vetro”)
DOLBY-1012	Declaration of June Munford
DOLBY-1013	U.S. Pat. No. 5,140,414 to Mowry et al. (“Mowry414”)
DOLBY-1014	U.S. Pat. No. 5,687,011 to Mowry et al. (“Mowry011”)
DOLBY-1015	U.S. Pat. No. 5,255,083 to Capitant et al. (“Capitant”)

DOLBY-1016- DOLBY-1049	RESERVED
DOLBY-1050	Complaint, <i>InterDigital, Inc. et al. v. The Walt Disney Company et al.</i> , 2:25-cv-00895, CDCA (filed Feb. 2, 2025)
DOLBY-1051	RESERVED
DOLBY-1052	Exhibit D2 to Complaint, <i>InterDigital, Inc. et al. v. The Walt Disney Company et al.</i> , 2:25-cv-00895, CDCA (filed Feb. 2, 2025)
DOLBY-1053	Joint Claim Construction and Prehearing Statement, <i>InterDigital, Inc. et al. v. The Walt Disney Company et al.</i> , 2:25-cv-00895, CDCA (Aug. 15, 2025)
DOLBY-1054	Defendants' Opening Claim Construction Brief, <i>InterDigital, Inc. et al. v. The Walt Disney Company et al.</i> , 2:25-cv-00895, CDCA (Aug. 22, 2025)
DOLBY-1055	Plaintiff's Opening Claim Construction Brief, <i>InterDigital, Inc. et al. v. The Walt Disney Company et al.</i> , 2:25-cv-00895, CDCA (Aug. 22, 2025)
DOLBY-1056	Defendants' Responsive Claim Construction Brief, <i>InterDigital, Inc. et al. v. The Walt Disney Company et al.</i> , 2:25-cv-00895, CDCA (Sept. 5, 2025)
DOLBY-1057	Plaintiff's Responsive Claim Construction Brief, <i>InterDigital, Inc. et al. v. The Walt Disney Company et al.</i> , 2:25-cv-00895, CDCA (Sept. 5, 2025)
DOLBY-1058	<i>InterDigital, Inc., et al. v. The Walt Disney Co., et al.</i> , 2:25-cv-00895, Document 156 #7705 (CDCA), filed 3/5/26
DOLBY-1059	Relevant Excerpts of the Prosecution History of U.S. Pat. No. 9,854,136

DOLBY-1060	Patent Assignment Abstract, U.S. Pat. No. 9,185,268
DOLBY-1061	UNITED STATES DISTRICT COURT CENTRAL DISTRICT OF CALIFORNIA (Western Division - Los Angeles) CIVIL DOCKET FOR CASE #: 2:26-cv-02270-PA-SP
DOLBY-1062	“Dolby Vision Certified Professionals,” https://professional.dolby.com/content-creation/dolby-vision-certified-professionals/ (accessed May 18, 2026)
DOLBY-1063	“Post Production,” https://www.premieredigital.com/post-production/ (accessed May 18, 2026)
DOLBY-1064	“Dolby offices worldwide,” https://www.dolby.com/about/support/dolby-offices-worldwide/ (accessed May 18, 2026)
DOLBY-1065	Green, Jacob, “Next-Gen Dolby Vision Laser Projector to Expand Reach of Premium Cinemas,” July 8, 2025, https://www.audioholics.com/news/dolby-vision-laser-projector (accessed May 18, 2026)
DOLBY-1066	Petitioner’s <i>Sotera</i> Stipulation
DOLBY-1067	Plaintiff’s Opposition to Defendants’ Motion to Dismiss Plaintiff’s Complaint, <i>Dolby Laboratories, Inc. et al v. InterDigital, Inc. et al.</i> , 2-26-cv-02269 (CDCA) (filed Apr. 17, 2026)

I. INTRODUCTION

Referral of this proceeding is warranted. The claimed invention in the '268 patent was allowed only after two outcome-determinative (i.e., material) examination errors. As the Petition demonstrates, the Examiner misinterpreted the “mastering” limitation recited by each independent claim by treating the related “reference” and “non-reference” displays/gamuts elements as interchangeable, contrary to the claim language and specification. That error led the Examiner to misapply Spaulding and withdraw the only prior art rejection without conducting a thorough search directed to the claim limitation as properly understood. The resulting allowance therefore rests on a flawed construction that excluded probative prior art.

The Petition confirms the significance of this error by presenting Jones—a reference never before the Office that teaches the claimed “mastering” limitation—demonstrating that the claims would have issued under the correct construction. *See* Pet., 29-32; DOLBY-1003, ¶¶151-155; DOLBY-1004, 6:35-56. Recent Director decisions confirm discretionary denial is not warranted under these circumstances, even where a challenged patent has been in force for more than ten years. *See* IPR2025-00847, Pap. 10 (Acting Director Aug. 15, 2025) (*Marlin*); *Anthony Inc. v. ControlTec, LLC*, IPR2025-00559, Pap. 12, 2 (Acting Director July 16, 2025) (*Anthony*). As with the patents implicated in *Marlin* and *Anthony*, the '268 patent

clearly evaded a proper examination. Discretionary denial would leave it to persist as though providently examined, despite Office error leading to its issuance. Merits review is thus an appropriate use of Office resources, and the discretionary factors raised in InterDigital’s Request do not outweigh these material examination errors that led to issuance of the ’268 patent. *See* §III, *infra*.

II. REFERRAL IS WARRANTED BECAUSE THE EXAMINER ERRED WHEN MISINTERPRETING THE “MASTERING” LIMITATION

A. Error 1: The Examiner Misinterpreted The “Mastering” Limitation By Incorrectly Equating “Reference” And “Non-Reference” Displays/Gamuts

The Examiner’s first error involved the “mastering” limitation recited in every independent claim of the ’268 patent—“mastering the source picture content to provide mastered color corrected picture content for display on the non-reference type displays having a non-reference color gamut.” *See* DOLBY-1001, Cls. 1, 6, 12, 15, 20, 25. That limitation specifies “non-reference type displays,” as distinguished from “reference type displays” elsewhere recited in the independent claims. But the Examiner repeatedly treated that distinction as immaterial.

One clear example appears in the Examiner’s obviousness-type double-patenting rejection over the related ’136 Patent Application. The Examiner stated that the claims of the two applications were “not patentably distinct” and that “[t]he only distinction” between them is that one is a “broader version” of the other. DOLBY-1002, 558-559. The Examiner then treated the distinction between

“reference” and “non-reference” color gamuts as a “design[] choice,” reasoning that “[u]sing either of the non-reference type or the reference type display can be performed without departing from the scope of the invention.” DOLBY-1002, 560. The Examiner disregarded the claimed distinction between a term and its alternative (“reference” versus “non-reference”), which defies logic and the law. *Helmsderfer v. Bobrick Washroom Equip., Inc.*, 527 F.3d 1379, 1382 (Fed. Cir. 2008); *see Applied Med. Res. Corp. v. U.S. Surgical Corp.*, 448 F.3d 1324, 1333 n. 3 (Fed. Cir. 2006) (“[T]he use of two terms in a claim requires that they connote different meanings...”).

The Examiner’s “design choice” statement was also baseless. The specification does not treat “reference” and “non-reference” displays/gamuts as interchangeable. To the contrary, the specification explains that “colors on the CG2 [or non-reference] display **will not** look the same as the colors that were color corrected on the RCG display” because “at least some of the colors on the RCG2 display will be clipped and at least some will be displayed with the wrong hue.” DOLBY-1001, 4:21-27. The specification identifies these problems as “drawbacks and disadvantages of the prior art” addressed by the claimed methods and systems for “color correcting to provide predictable results on displays with different color gamuts.” DOLBY-1001, 1:11-15.

The Petition confirms the same, explaining “while content was often mastered on a ‘reference’ display associated with a standardized color gamut (e.g., based on CRT phosphors and standards such as EBU, SMPTE-C, or Rec.709), consumer displays implemented ‘non-standard’ or otherwise different gamuts, which could **cause the content (when displayed on such devices) to appear visually different than intended.**” Pet., 4-5 (citing DOLBY-1001, 1:15-30). Thus, the Examiner’s statement was not only imprecise, it is contrary to the specification and removed a critical differentiation of claim terms discussed in the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (“[T]he claims ‘must be read in view of the specification, of which they are a part.’”).

The Examiner’s misinterpretation was not harmless oversight. It nullified express claim language in three independent claims requiring that “the source picture content is **mastered only for the non-reference type displays** having the non-reference color gamut.” DOLBY-1001, Cls. 1, 12, 20. The term “only” has operative meaning only if “reference” and “non-reference” denote distinct categories. That is, content cannot be mastered “only for” one of two interchangeable terms, because if the terms are interchangeable there is no excluded counterpart. The Examiner’s interpretation therefore rendered the “mastered only for” limitation non-limiting and created an internal contradiction within the claims

as allowed. An allowability determination that rests on an interpretation reading out express claim language of meaning cannot stand.

The related prosecution history confirms the same misunderstanding. In the first Office Action for the '268 Patent Application, the Examiner appeared to include the same analysis from a prior Office Action in the related '136 application. *Compare* DOLBY-1002, 255, *and* DOLBY-1059, 36. But the claims under examination in the '136 application recited a different “mastering” limitation because they used “reference,” not “non-reference.” *Id.* At minimum, the overlap confirms superficial treatment of the limitation. More importantly, it helps explain why the Examiner later treated “reference” and “non-reference” as a design choice rather than as claim language bearing on patentability.

The same misinterpretation also drove the Examiner’s application of prior art during examination. In a §103 rejection over Spaulding, the Examiner mapped Spaulding’s “reference color space 28” to the recited “non-reference color gamut” without explanation. DOLBY-1002, 255 (“Spaulding teaches that this algorithm 27 is applied to the input digital image in the reference color space 23 to form an output image in the **reference color space 28**”). That mapping reflected the same interchangeability premise as the design choice statement. The Examiner did not treat “reference” and “non-reference” as imposing distinct mapping requirements on the prior art. Applicant identified the inconsistency in response to the rejection

noting “[c]ontrary to Spaulding’s teachings, Applicants’ claims all require that the mastering generates a mastered color corrected picture content for display in a non-reference color space.” DOLBY-1002, 282

Following this response, the Examiner withdrew the §103 rejections over Spaulding and issued a Notice of Allowance. *See* DOLBY-1002, 526-531. But the withdrawal addressed only the immediate rejection—it did not correct the underlying misunderstanding that the Examiner repeated when they subsequently characterized the “reference”/“non-reference” distinction as “design choice.” DOLBY-1002, 560. Thus, the same error that prompted withdrawal of the rejection still persisted through allowance.

B. Error 2: The Examiner Allowed The Claims Without Ever Conducting A Thorough Search Aligned With The Scope Of The “Mastering” Limitation

After withdrawing rejections over Spaulding, the Examiner expressly identified the “mastering” limitation as a key basis for allowance. DOLBY-1002, 852-853 (“Spaulding fails to teach ‘mastering...’”). This identification should have triggered, for the first time during examination, a thorough search for other prior art aligned with the actual scope of the “mastering” limitation. The Examiner’s withdrawal of the Spaulding rejection effectively accepted that Applicant’s purported distinction was operative, making a search that accounted for the distinction unavoidable.

Instead, the Examiner’s search remained perfunctory. The file history reveals no meaningful change in search strategy following the Spaulding withdrawal—the Examiner spent less than two hours on searches that altogether omit any reference to the term “master.” *See, e.g.*, DOLBY-1002, 268-270, 532-533, 541-542, 566-569, 865-867, 900-904. This failure confirms that the Examiner did not meaningfully search for one of the very limitations that led to allowance.

Once the Examiner recognized that Spaulding did not disclose the “mastering” limitation, a reasonable search directed to that limitation would have readily uncovered prior art teaching this well-known feature. The Petition demonstrates this through Jones, which offers express disclosure of a digital master 46 (“*mastered color corrected content*”) generated subsequent to a color correction operation involving “display device 30 used in the color grading channel 12,” which is “preferably a wider-gamut device such as a digital projector,’ and thus is different from a standard gamut device and thereby represents an example of a non-reference type display.” Pet., 30 (citing DOLBY-1004 (Jones)), 6:35-56; *see* DOLBY-1003, ¶153.

III. OTHER DISCRETIONARY FACTORS DO NOT OUTWEIGH MATERIAL EXAMINATION ERROR

A. *Revvo, Tesla, and Generac* Are Inapplicable To These Facts, And No Substantive Inconsistency Exists

InterDigital improperly extends recent Director decisions in urging denial based on purportedly “inconsistent” positions between the Disney Action¹ and Dolby’s declaratory judgment (DJ) Action.² See Req., 6-10. InterDigital’s theory is overbroad: none of *Revvo*, *Tesla*, or *Generac* supports denial when invalidity positions are taken by different parties in different forums based on nothing in common other than the patent. Rather, those decisions address a narrower concern—preventing a single petitioner from advancing one claim construction before the Board while advancing a materially inconsistent position in district court. See IPR2025-00632, Pap. 20, 4 (Director Nov. 3, 2025) (*Revvo I*); IPR2025-00340, Pap. 18, 4 (Director Nov. 5, 2025) (*Tesla*); IPR2025-00805, Pap. 40, 4-5 (Director Feb. 3, 2026) (*Generac*). Dolby is not a party to the Disney Action (and Disney is not an RPI to this proceeding), and the Dolby DJ Action remains in its infancy without any claim construction or substantive §112 positions. Regardless, no actual inconsistency exists.

1. Dolby Is Not A Party To The Disney Action, And The Petition’s Constructions Are Consistent With The *Markman* Order

¹ *InterDigital, Inc. et al v. The Walt Disney Company et al.*, 2-25-cv-00895

(CDCA) (filed Feb. 2, 2025)

² *Dolby Laboratories, Inc. et al v. InterDigital, Inc. et al.*, 2-26-cv-02269 (CDCA)

(filed Mar. 3, 2026)

(a) InterDigital’s Cited Authority Address Single-Party Conduct Not Present Here

The Request misapplies each of the *Revvo*, *Tesla*, and *Generac* by demanding consistency between Dolby’s invalidity positions in this proceeding and those advanced in the Disney Action by the Disney—a distinct party in a separate proceeding involving several patents (of which one is the ’268 patent). But Dolby is not a party to the Disney Action, and it therefore has not (and could not have) taken any invalidity position before the district court in that case. Indeed, the *Tesla* decision confirms that the Director’s concern regarding inconsistency apply to a single party. *See Tesla*, at 4 (discussing preventing “a petitioner to advance a claim construction before the Board when that petitioner has made inconsistent indefiniteness arguments in district court fails to further,” which detracts from that goal).

Revvo is also factually distinguishable. Petitioner’s conduct in that proceeding differs from Dolby’s in filing the instant Petition. There, the petitioner “did not propose its own constructions” in the IPR and instead adopted Patent Owner’s district court constructions while having proposed different constructions in the district court litigation. *Revvo I*, at 2. Further, in later granting Director Review, the Director found that the same petitioner sought to preserve a “wait and see” approach depending on how the district court later construed the claims. IPR2025-00632, Paper 36, at 3-4 (Director Jan. 26, 2026) (*Revvo II*). None

of these facts are present here—Dolby could not have proposed any constructions before the district court and did not expressly adopt InterDigital’s litigation constructions in the Petition.

Tesla and *Generac* are similarly inapposite. *Tesla* and *Generac* each implicated a petitioner argued in district court that a claim limitation was indefinite, while suggesting to the Board that claims were defined and/or amenable to construction. *See Tesla*, at 2-3; *see also Generac*, at 4-5. InterDigital identifies no comparable indefiniteness position in the Disney Action attributable to Dolby. *See Req.*, 6-10. Nor could it because Dolby is not a party to the Disney Action.

(b) The *Markman* Order Resolves Construction Disputes Without Inconsistency With The Petition’s Prior Art Analysis

Closer examination of the claim terms identified in the Request confirms there is no claim construction inconsistency between before the Board and the district court. *See EX-2012*. To the contrary, the Petition’s prior art analysis (which predated the district court’s *Markman* Order issued on April 7, 2026) applied the asserted art in a manner consistent with the district court’s resolution of the disputed constructions. Thus, even though Dolby was not a party to the Disney Action and did not control the constructions Disney advanced, the *Markman* Order’s finding ultimately resolved any question about divergent claim constructions before the Board and the district court. Indeed, in the Dolby DJ Action, Dolby noted it “will

not challenge the Court’s existing claim constructions...” DOLBY-1067, 17-18.

This confirms *Revvo* is inapplicable, because the *Markman* Order now ensures the Board’s analysis of the Petition “correctly construes claim terms and [] minimize[s] inconsistency in claim construction between forums.” *Revvo I*, at 4.

(i) “Reference Color Gamut” / “Reference Type Display”

The Petition is consistent with the *Markman* Order because the Petition’s prior art analysis identified a “CRT display” as an example of a *reference type display*, consistent with the ’268 patent specification’s disclosure of a “standardized gamut” (*see, e.g.*, DOLBY-1001, 1:15-25) and which the district court explained is “encompassed by the claim language” (EX-2012, 17-18). The district court also found that “[c]oupled with ‘standardized color gamut,’ as agreed upon by the parties, the claim can reasonably be construed as ‘a reference type display having a standardized color gamut.’” *Id.*, 17-18.

(ii) “Non-Reference Color Gamut” / “Non-Reference Type Display”

The Petition is consistent with the *Markman* Order because the Petition’s prior art analysis identified a “wider-gamut device” as an example of a *non-reference type display*, and further explained that this is “different from a standard gamut device.” Pet., 30 (DOLBY-1004, 6:35-56). The district court similarly found that “[a] ‘non-reference color gamut’ should be construed as one that is *not* a ‘standardized color

gamut,’ in line with the parties’ agreement on the related language in the previous claim.” EX1012, 18-19.

(iii) “At Least One Of”

The Petition is consistent with the *Markman* Order because the Petition’s prior art analysis noted that “*SuperGuide* is inapplicable because the recitation of *non-reference type display* and *reference type display* within [1.1] do not represent ‘a series of categories of criteria,’ and because the term “and” is not used to ‘separate the categories of criteria...’” Pet., 26 (fn 3). InterDigital concedes that its purported inconsistency “has since been resolved by the district court’s *Markman* Order.” Req., 9-10. More specifically, the district court found that “...the facts of the patent at issue weigh in favor of a disjunctive construction” because “several embodiments in the ’268 Patent depict only one of the two displays as inputs for the color correction system (see Figures 7 and 8)...” EX-2012, 19.

2. The Dolby DJ Action Has Not Progressed To Claim Construction, And Presents No Basis for Inconsistency

(a) No Proposed Or Briefed Claim Constructions Presently Exist

Revvo is also inapplicable here because the Dolby DJ Action is in its early stages and has not progressed to substantive claim construction. *See* DOLBY-1061. As of the filing of this paper, the district court has not yet issued a case schedule and no *Markman* hearing has been scheduled. *Id.* Moreover, because Dolby has not proposed any claim constructions in the Dolby DJ Action, Dolby has not asked the

Board to construe the claims in one way while asking the district court to construe them another way.

(b) No Substantive §112 Positions Have Been Asserted

Tesla and *Generac* are also inapplicable here because Dolby has not advanced any substantive §112 contention in the Dolby DJ Action. The concerns raised in those decisions also do not apply here because Dolby had not previously raised §112 contentions in another forum before filing the Petition. In contrast, the petitioners in *Tesla* and *Generac* had already taken positions that arguably created a risk of inconsistency across forums. Dolby has not engaged in comparable conduct in the DJ Action and discretionary denial based on *Tesla* and *Generac* would therefore be improper.

B. InterDigital’s Claimed Settled Expectations Do Not Support Discretionary Denial Because They Are Not Tied To The ’268 Patent’s Lifetime Or Dolby’s Technology Space

The Request fails to address two critical considerations relevant to the settled expectations inquiry: (1) when activity occurred within the patent’s lifetime, and (2) whether that activity was specific to Dolby’s technology space. *See* IPR2025-00327, Pap. 12, 2-3 (*Proxense*) (noting that a patent “may have been in force for years but may not have been commercialized, asserted, marked, licensed, or otherwise applied in a petitioner’s particular technology space, if at all”). InterDigital fails both. Its licensing evidence is non-specific—establishing at most ten unidentified entities,

with no information about when licenses were executed, their terms, or whether they cover the '268 patent specifically as opposed to broad portfolio agreements. Its enforcement evidence is similarly limited. InterDigital first enforced the '268 patent in 2025, seven years after acquiring it in 2018 and nearly ten years after issuance, with no intervening activity that would have led Dolby to expect enforcement. Such evidence certainly does not establish settled expectations sufficient to deny inter partes review, particularly where the Petition identifies material examination error. *See Anthony*, at 2; *Taiwan*, at 3-4.

1. InterDigital's Licensing Evidence Is Non-Specific, And The Recency Of Its Only Enforcements Expose Any Patent Owner Expectations Unsettled Or Undermined By InterDigital's Own Conduct

Aside from patent age, InterDigital's only other bases for its settled expectations claim is licensing and enforcement. *See Req.*, 5-6. But InterDigital's licensing evidence (EX-2002, EX-2006, EX-2016, EX-2017) lacks the specificity needed to support that claim. InterDigital does not identify any specific entities as subject to licenses. Instead, a declaration from InterDigital's Vice President and Associate General Counsel, Mr. Ryan Pohlman, refers vaguely to "10 different companies," without naming them or providing detail. *See EX-2006*.

Nor does InterDigital establish any cited agreement that is directed to the '268 patent itself, as opposed to a broader portfolio license. Although InterDigital references agreements with Sony and Panasonic (*see EX-2016, EX-2017*), its

evidence fails to establish anything more than a general “license agreement,” not a license to the ’268 patent. InterDigital could have provided evidence to substantiate claims that Sony or Panasonic took licenses to the ’268 patent. It did not. And license agreements referenced in EX-2016 and EX-2017 do not demonstrate specific licensing activity within the technology domains of Dolby and/or Disney. Broad portfolio licenses do not demonstrate that licensees—or the market—placed any particular reliance on the validity of the ’268 patent. At most, they reflect generalized business arrangements spanning numerous unrelated assets.

The lack of particularized evidence distinguishes this proceeding from licensing evidence in *Alliance*, where the patent owner (i) identified specific licensees that a petitioner had agreed to take for the implicated patent and (ii) demonstrated that those licenses resulted in settlement of three proceedings that involved the licensees. *See* IPR2025-00950, Pap. 6 (Filed Jul. 28, 2025) (PO DD Brief). Even there, the Acting Director found that the implicated licensing evidence only create “some settled expectations favoring Patent Owner.” IPR2025-00950, Pap. 11, at 3 (Acting Director Sep. 19, 2025).

Finally, InterDigital’s reference to a grant of patent injunction by the Munich Regional Court in Germany against Disney’s Disney+ streaming service is inapposite to any settled expectations. That decision arose only months ago and it does not reflect enforcement activity earlier within the patent’s lifetime. *See* EX-

2018; EX-2015. Disney has also appealed the grant of an injunction. And, because the injunction was granted only months ago, it does not establish any expectation by InterDigital that the '268 patent would not be challenged. InterDigital also fails to identify any authority from the Acting Director supporting its claim that a foreign injunction grant heightened settled expectations to support discretionary denial.

2. Per *Proxense*, InterDigital's Failure To Apply The '268 Patent In Dolby's Technology Space Weighs Against Settled Expectations

Dolby could not have anticipated that InterDigital would assert the '268 patent against its customers. InterDigital acquired the '268 patent around July 2018 (~3 years from issuance), but then waited nearly 7 years from this date to assert the '268 patent against Disney in February 2025. See DOLBY-1060, 2. During this time, InterDigital did nothing to commercialize, assert, mark, license, or otherwise apply the '268 patent in either Dolby's technology space or those of Dolby's customers. InterDigital also did not contact Dolby regarding the '268 patent before pursuing downstream enforcement against Dolby's customers. Dolby did not have any reason to expect InterDigital would assert the '268 patent in the streaming technology space.

C. The *Fintiv* Factors Do Not Favor Discretionary Denial For Either The Disney Action Or The Dolby DJ Action

1. Disney Action—Dolby Is Not a Party, And Material Examination Error Overrides Schedule-Based Concerns

InterDigital’s *Fintiv* factor analysis largely relies on the premise that the schedule of the Disney Action supports discretionary denial of this proceeding even though Dolby is not a party to that proceeding. Even where parallel litigation presents potential inefficiencies, those considerations are outweighed where, as here, there was material error in the examination of the ’268 patent. Dolby has also actively avoided further inefficiencies by noting in the Dolby DJ Action, that it “will limit discovery, and will proceed to trial on an expedited schedule.” DOLBY-1067, 17-18.

Factor 1 is neutral: No motion to stay has been granted in the Disney Action, and the Board should not infer the outcome of such a motion. IPR2024-00619, Pap. 19, at 9 (PTAB. Sept. 13, 2024); IPR2023-00361, Pap. 9, at 7-8 (PTAB July 31, 2023).

Factor 2 favors referral: Dolby is not a party to the Disney Action, and “*Fintiv* factor 2 weigh[s] strongly against exercise of discretion” when “Petitioner is not a party to the [other] litigation.” IPR2021-00612, Pap. 15, 24 (PTAB Sept. 15, 2021); *see also* PGR2025-00025, Pap. 10, 2 (PTAB July 16, 2025). The February 8, 2027 trial date of the Disney Action does not change that conclusion—Dolby has no control over the case, no ability to participate, and will not be bound by its judgment. Even if that date holds, material examination error supports institution. *Tesla*, at 2.

Factor 3 favors referral: Dolby is not a named party in the Disney Action, and its investment is limited to its indemnification obligations relating solely to Disney’s alleged infringement through use of Dolby’s technology.

Factor 4 favors referral: Each of the Petition’s grounds include Jones, which was not before the Office during original examination, and not the subject of Dolby’s third-party discovery in the Disney Action.

Factor 5 favors referral: InterDigital concedes that “Dolby is not a party to that proceeding,” and thus, this factor is “neutral.” Req., 13. And, while InterDigital speculates Disney “should have been named as an RPI to this proceeding,” it offers no evidence to support this assertion. *Id.*

Factor 6 favors referral: The Petition advanced grounds that demonstrate satisfaction of the “mastering” limitation that was deemed allowable in original examination over the teachings of Spaulding reference. *See* Pet., 29-32; DOLBY-1003, ¶¶151-55; *see* §II, *supra*.

2. Dolby DJ Action—In Its Earliest Stages, and Scheduled Trial Is Likely To Postdate The Board’s Anticipated FWD

Factor 1 is neutral: No motion to stay has been filed in the Dolby DJ Action, so the Board should not infer the outcome of such a motion.

Factor 2 favors referral: The Dolby DJ Action is in its infancy. Based on a 25.5 median-time-to-trial statistic for CDCA, the Dolby DJ Action is expected to reach trial in April 2028, several months after the Board is expected to reach a FWD

by August 18, 2027. Indeed, InterDigital concedes that Factor 2 favors referral because “[m]edian time to trial statistics indicate that trial in the Dolby DJ action is likely to occur after the FWD deadline.” Req., 13-14.

Factor 3 favors referral: Investment in the Dolby DJ Action remains limited to early motions practice because discovery has not begun. *See* IPR2023-00126, Pap. 9, at 10 (PTAB May 5, 2023) (early-stage investment weighs against denial).

Factor 4 favors referral: Dolby is filing a broad stipulation that mitigates concerns about duplicative efforts, committing not to pursue in the Dolby DJ Action any invalidity grounds based on printed publications or patents that could have been raised in the IPR. DOLBY-1066.

Factor 5 favors referral: While the parties are the same, the timing of the trial (Factor 2) renders this factor favorable to referral because the Board’s earlier FWD will simplify the issues for trial. *See* IPR2020-01133, Paper 23 at 13-14 (P.T.A.B. Aug. 6, 2021).

Factor 6 also favors referral. *See* Pet., 29-32; APPLE-1003, ¶¶151-55.

D. §325(d) Discretionary Denial Is Not Appropriate Because The Petition Relies On New Prior Art Never Before The Office

InterDigital’s §325(d) arguments ignore Jones—the reference at the basis of every Petition ground, never before the Office. *Compare* Pet., 1-2, *and* Req., 18-20. Under the Board’s §325(d) framework, discretionary denial is inappropriate where a petition presents new, noncumulative art. IPR2019-00975, Pap. 15, 19-20. Jones

is also not cumulative of Spaulding. *See* DOLBY-1002, 252-63. Because Jones was not previously considered, *Advanced Bionics* Part 1 is not met, and the Director need not reach Part 2. *Thorne Research*, at 9; IPR2023-01369, Pap. 10, at 19 (PTAB Mar. 5, 2024). In any event, material examination error (§II, *supra*) confirms discretionary denial under §325(d) is not appropriate.

IV. ADDITIONAL DISCRETIONARY CONSIDERATIONS FURTHER SUPPORT REFERRAL

Additional discretionary considerations also support referral. The Challenged Claims are directed to methods and systems for color correction and implicate U.S.-based content creation and delivery activity, such as professional post-production and mastering environments and Dolby's own U.S.-headquartered technology investment in the Dolby Vision platform. DOLBY-1062-DOLBY-1065. By contrast, InterDigital acquired the '268 patent from a French entity (DOLBY-1060) and asserts only licensing-based interests not tied to any identified U.S.-manufactured competitive product practicing the Challenged Claims. *See* EX-2006; EX-2016; EX-2017.

V. CONCLUSION

For the foregoing reasons, the Director should deny InterDigital's Request for Discretionary Denial.

Respectfully submitted,

Dated: 5/18/2026

/W. Karl Renner/

W. Karl Renner, Reg. No. 41,265

Ryan Chowdhury, Reg. No. 74,466

Alex Yu, Reg. No. 74,295

Indranil Sarkar, Reg. No. 79,432

Fish & Richardson P.C.

60 South Sixth Street

Minneapolis, MN 55402

T: 202-783-5070

F: 877-769-7945

Attorneys for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e)(4)(i) *et seq.* and 42.105(b), the undersigned certifies that the captioned Petitioner's Opposition to Patent Owner's Request for Discretionary Denial and accompanying exhibits were provided electronically by e-mail, on May 18, 2026 to the Patent Owner by serving the correspondence address of record as follows:

Ryan C. Richardson
Jennifer Chagnon
David Haars
Wenhao Xiong
Sterne, Kessler, Goldstein & Fox PLLC
1101 K Street, NW, 10th Floor
Washington, DC 20005

Email: Rrichardson-ptab@sternekessler.com
Jchagnon-ptab@sternekessler.com
Dhaars-ptab@sternekessler.com
Wxiong-ptab@sternekessler.com
PTAB@sternekessler.com

/Diana Bradley/
Diana Bradley
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
bradley@fr.com