

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

TCL ELECTRONICS HOLDINGS LTD.
(f/k/a TCL MULTIMEDIA TECHNOLOGY HOLDINGS, LTD.)
Petitioner,

v.

MAXELL, LTD.,
Patent Owner.

IPR2025-00120
Patent 10,375,341 B2

Before COKE MORGAN STEWART, *Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.*

ORDER

Granting Director Review, Vacating the Decision Granting Institution, and
Denying Institution of *Inter Partes* Review

Maxell, Ltd. (“Patent Owner”) filed a request for Director Review of the Decision granting institution (“Decision,” Paper 9), and TCL Electronics Holdings Ltd. (“Petitioner”) filed an authorized response. *See* Paper 12 (“DR Request”); Paper 13. Patent Owner argues that the Board erred in its analysis and weighing of the *Fintiv*¹ factors. DR Request 1–2. In particular, Patent Owner argues that the Board gave too much weight to Petitioner’s *Sotera*² stipulation (factor 4), which does not bind all real parties-in-interest (and co-defendants in the parallel litigation), and did not give enough weight to the trial date in the parallel litigation (factor 2), which is scheduled to begin eight months before the Board’s final written decision due date. *Id.* at 4–8. Patent Owner also contends that the Board placed too much weight on the merits of the petition (factor 6) and failed to explain “why the challenge was so strong as to outweigh four other *Fintiv* factors favoring discretionary denial.” *Id.* at 9–10.

Petitioner responds that the Board correctly determined that *Fintiv* factors 4 and 6 weigh against the exercise of discretion to deny institution and properly weighed the factors in view of all circumstances in the case. Paper 13, 2–5. As to factor 6, Petitioner specifically points to the Board’s discussion of Petitioner’s single-reference obviousness challenge as “straightforward . . . based on the reference’s disclosures.” *Id.* at 4.

¹ *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential).

² *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A.).

It is undisputed that the parallel district court trial involves additional patents, is not stayed, and is in an advanced state, with trial likely to begin approximately eight months before the Board's final written decision. *Id.* at 7–9. Considering the *Fintiv* factors as a whole, even assuming factors 4 and 6 both weigh against exercising discretion to deny institution, the Board erred in concluding that they outweigh the other four *Fintiv* factors, which favor denial.

In consideration of the foregoing, it is:

ORDERED that Director Review is granted;

FURTHER ORDERED that the Decision granting institution of *inter partes* review (Paper 9) is vacated; and

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

IPR2025-00120
Patent 10,375,341 B2

For PETITIONER:

Douglas A. Robinson
Glenn E. Forbis
HARNESS IP
drobinson@harnessip.com
gforbis@harnessip.com

For PATENT OWNER:

Amanda S. Bonner
Robert G. Pluta
Saqib J. Siddiqui
Sora Ko
MAYER BROWN LLP
asbonner@mayerbrown.com
rpluta@mayerbrown.com
ssiddiqui@mayerbrown.com
sko@mayerbrown.com