

PTAB Rejects Dell's Challenges To 3 Video Tech Patents

By **Britain Eakin**

Law360 (October 5, 2022, 6:52 PM EDT) -- The Patent Trial and Appeal Board has denied petitions from Dell Inc. challenging three video coding and decoding patents that a patent licensing company accused it of infringing, with the board disqualifying Dell's prior art.

In a series of three decisions handed down Tuesday, the PTAB sided with VideoLabs Inc., which successfully argued that its patents are entitled to a filing date that predates the primary prior art references Dell was relying on to try to show the patents are invalid. The board agreed that the proper filing date for the patents is April 15, 2002, the date of an earlier filed Japanese patent application.

Only prior art that came before the patent being challenged can be used to invalidate it. The prior art references Dell relied on came in May and August of 2002, and so the board determined the petitions failed on that basis.

"This priority showing is fatal to the Petitioner's obviousness showing," the board said in all three decisions.

In order for a patent to get an earlier filing date, the earlier filed patent application must contain written description support for the invention claimed in the later filed patent. To meet the written description requirement, the earlier filed application must describe the invention claimed in the later filed patent in enough detail to convey the inventors were in possession of the invention.

Dell had argued that there was no written description support in the Japanese patent application for a key element of the patents, which involves demultiplexing and decoding audio. But the board rejected that argument, saying it was persuaded by testimony from VideoLabs' expert, which the board noted "the record supports and Petitioner does not dispute."

The decisions were a blow to Dell's attempts to fight off infringement suits over the patents, which were originally issued to Panasonic. California-based VideoLabs fired off the suits in May 2021 in the Western District of Texas, alleging that various Dell laptops, desktops and tablets infringe. U.S. District Judge Alan Albright, who is overseeing the consolidated cases, put them on hold while he weighs whether to grant Dell's motion to transfer the case to the Austin division of the district.

Judge Albright modified the stay last week, saying in a Sept. 28 order that the stay only applies to the claim construction hearing and no other case deadlines.

VideoLabs has also sued Amazon over the patents, according to the board's decisions. That case, which involves additional VideoLabs patents not at issue in the board's decisions, is proceeding apace. In that suit, VideoLabs said it established a platform in 2019 to address what it perceived as a problem in the video technology space — no single company could provide high quality video experiences without using the technology of others.

VideoLabs said it spent millions to identify the most impactful patents in the video space and compiled a portfolio of them from companies like Hewlett Packard, Panasonic, LG and Nokia, among others. It provides access to the portfolio through membership or licensing fees, it said in the Amazon suit.

Prior to acquiring the patents at issue in the board's decisions, the prior assignee — Optis Wireless Technology LLC — asserted them against Huawei, along with several others that were not at issue in the board's decisions Tuesday. Huawei had been facing a \$13.2 million infringement judgment in the suit, but Huawei and Optis settled their dispute in April 2020.

The patents-in-suit are U.S. Patent Nos. 7,769,238; 8,139,878; and 7,970,059.

Administrative Patent Judges Karl D. Easthom, Jeffery S. Smith and Patrick M. Boucher sat on the panels.

Dell is represented by Brian M. Buroker, Paul E. Torchia and Nathan R. Curtis of Gibson Dunn & Crutcher LLP.

VideoLabs is represented by David L. Alberti and Jerry Tice of Kramer Day Alberti Lim Tonkovich & Belloli LLP, and Jason A. Fitzsimmons Richard M. Bembem and Michael D. Specht of Sterne Kessler Goldstein & Fox PLLC.

The cases are Dell Technologies Inc. et al. v. VideoLabs Inc., case numbers IPR2022-00701; IPR2022-00629; and IPR2022-00628, at the Patent Trial and Appeal Board.

--Additional reporting by Cara Salvatore. Editing by Emily Kokoll.