

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

TRANSCEND INFORMATION INC.,
Petitioner,

v.

TRUESIGHT COMMUNICATIONS LLC,
Patent Owner.

IPR2025-00723
Patent 8,977,783 B2

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

DECISION
Denying Institution of *Inter Partes* Review

Truesight Communications LLC (“Patent Owner”) filed a request for discretionary denial (Paper 6, “DD Req.”) in the above-captioned case, and Transcend Information Inc. (“Petitioner”) filed an opposition (Paper 7, “DD Opp.”).

After considering the parties’ arguments and the record, and in view of all relevant considerations, discretionary denial of institution is appropriate in this proceeding. This determination is based on the totality of the evidence and arguments the parties have presented.

In particular, the projected final written decision due date in the Board proceeding is October 16, 2026. DD Req. 5. The district court’s scheduled trial date is January 5, 2026. *Id.*; DD Opp. 3. As such, it is unlikely that a final written decision in this proceeding will issue before the district court trial occurs, resulting in significant duplication of effort, additional expense for the parties, and a risk of inconsistent decisions. Additionally, there is insufficient evidence that the district court is likely to stay its proceeding even if the Board were to institute trial, and there has been meaningful investment in the parallel proceeding by the parties. DD Req. 7–8. Finally, the patent has been in force for ten years, creating strong settled expectations for Patent Owner.

Petitioner argues it has its own settled expectations because it “had no reason to believe that it was infringing a patent that requires a kiosk, which [Petitioner] is not even alleged to make or use.” DD Opp. 11. Although this weighs against discretionary denial, it does not overcome both Patent Owner’s settled expectations *and* the significantly earlier district court trial date. *See BOE Tech. Grp. Co. v. Optronic Scis. LLC*, IPR2025-00238, Paper 11 at 2–3 (Director July 29, 2025).

Although certain arguments are highlighted above, the determination to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented. Accordingly, the Petition is denied under 35 U.S.C. § 314(a).

In consideration of the foregoing, it is:

ORDERED that Patent Owner's request for discretionary denial is *granted*; and

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

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