

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIGHTRICKS LTD.,
Petitioner,

v.

PLOTAGRAPH, INC. and SASCHA CONNELLY,
Patent Owner.

IPR2023-00152
Patent 10,558,342 B2

Before PATRICK R. SCANLON, CHARLES J. BOUDREAU, and
IFTIKHAR AHMED, *Administrative Patent Judges*.

SCANLON, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request for Rehearing of Decision
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Lightricks Ltd. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1–20 of U.S. Patent No. 10,558,342 B2 (Ex. 1001, “the ’342 patent”). Plotagraph, Inc. and Sascha Connelly (collectively, “Patent Owner”) filed a Preliminary Response (Paper 6).

On June 20, 2023, we issued a Decision Denying Institution of *Inter Partes* Review. Paper 7 (“Decision” or “Dec.”). Petitioner requests rehearing of our Decision. Paper 8 (“Rehearing Request” or “Reh. Req.”). For the reasons set forth below, Petitioner’s Rehearing Request is *denied*.

II. STANDARD OF REVIEW

The applicable requirements for a request for rehearing are set forth in 37 C.F.R. § 42.71(d), which provides:

A party dissatisfied with a decision may file a single request for rehearing, without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, a reply, or a sur-reply.

We review our Decision under an abuse of discretion standard. 37 C.F.R. § 42.71(c). An abuse of discretion may arise if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). “Substantial evidence is ‘such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.’” *OSI Pharm., LLC v. Apotex*

Inc., 939 F.3d 1375, 1381 (Fed. Cir. 2019) (quoting *Consol. Edison Co. v. N.L.R.B.*, 305 U.S. 197, 229 (1938)). “The substantial evidence standard asks ‘whether a reasonable fact finder could have arrived at the agency’s decision.’” *OSI Pharm.*, 939 F.3d at 1381–82 (quoting *Gartside*, 203 F.3d at 1312).

III. ANALYSIS

A. Background

The Petition asserts three grounds, including a ground challenging claims 1, 2, 4–11, 13–16, and 18–20 as unpatentable over IMU¹ and

¹ Wayback Machine Capture dated Mar. 27, 2012 of Anthony Thyssen, *Examples of ImageMagick Usage (Version 6)*, ImageMagick (Mar. 15, 2011), <http://www.imagemagick.org/Usage/> (retrieved from <https://web.archive.org/web/20120327064501/http://www.imagemagick.org/Usage/> (see Pet. vii)) (Ex. 1004); WayBack Machine Capture dated Mar. 29, 2012 of Anthony Thyssen, *ImageMagick v6 Examples -- Distorting Images*, ImageMagick (Mar. 21, 2012), <http://www.imagemagick.org/Usage/distorts/> (retrieved from <https://web.archive.org/web/20120329131929/http://www.imagemagick.org/Usage/distorts/> (see Pet. vii)) (Ex. 1005); Wayback Machine Capture dated Sept. 28, 2012 of Anthony Thyssen, *ImageMagick v6 Examples -- Masks*, ImageMagick (Mar. 10, 2011), <http://www.imagemagick.org/Usage/masking/> (retrieved from <https://web.archive.org/web/20120928070642/http://www.imagemagick.org/Usage/masking/> (see Pet. vii)) (Ex. 1006); Wayback Machine Capture dated Mar. 10, 2012 of Anthony Thyssen, *ImageMagick v6 Examples -- Animation Basics*, ImageMagick (Feb. 8, 2011), http://www.imagemagick.org/Usage/anim_basics/ (retrieved from https://web.archive.org/web/20120310193613/http://www.imagemagick.org/Usage/anim_basics/ (see Pet. vii)) (Ex. 1007); Wayback Machine Capture dated Apr. 5, 2012 of Anthony Thyssen, *ImageMagick v6 Examples -- Usage under Windows*, ImageMagick (Mar. 21, 2012), <http://www.imagemagick.org/Usage/windows/> (retrieved from <https://web.archive.org/web/20120405151502/http://www.imagemagick.org/Usage/windows/> (see Pet. vii–viii)) (Ex. 1008). Petitioner asserts that Exhibits 1004–1008 comprise a single

Okabe.² Pet. 8–86.

Independent claim 7 of the '342 patent, which is illustrative of the claimed subject matter, recites a method for automating a shifting of pixels within a digital image that comprises, in pertinent part, “selecting a first set of pixels extending along a length of the non-linear pathway and away from the first starting point” (“limitation [7c]”) and “shifting the first set of pixels along the non-linear pathway, wherein shifting the first set of pixels comprises rendering and re-rendering in a loop the first set of pixels being shifted” (“limitation [7d]”). Ex. 1001, 15:12–28.

In the Decision, we found that Petitioner had failed to show a reasonable likelihood of prevailing on any of its three asserted grounds of unpatentability. Dec. 9–23. With respect to the ground based on IMU and Okabe (“Ground 2”), we concluded that Petitioner had not shown sufficiently that the prior art taught or suggested limitation [7d]. *Id.* 20–22. The Decision also indicated doubt as to whether Petitioner had shown sufficiently that the prior art taught or suggested limitation [7c]. *Id.* at 20.

B. Petitioner’s Arguments on Rehearing

In the Rehearing Request, Petitioner argues that the Board overlooked or misapprehended certain aspects of Ground 2 and that Ground 2 should be instituted. Reh. Req. 1–7. Petitioner does not present any arguments regarding the other two grounds asserted in the Petition. *Id.*

Regarding limitation [7d], Petitioner argues that the Decision “did not discuss Petitioner’s arguments on how IMU teaches creating an animation

reference, which Petitioner refers to as IMU. Pet. 4 n.3 (citing Ex. 1002 ¶ 44 n.6).

² Makoto Okabe et al., Creating Fluid Animation from a Single Image using Video Database, 30 Computer Graphics Forum 7 (2011) (Ex. 1009).

by moving a Shepard's Distortion 'control point' over time." Reh. Req. 4 (citing Pet. 60–61; Dec. 21–22). This argument is not persuasive. The cited portion of the Petition addresses claim limitation [7a] ("receiving a first indication of a first starting point through a user interface, wherein the first starting point is received through a user selection of a portion of the digital image") and does not address limitation [7d]. Pet. 60–61. Moreover, the portion of the Petition that does address limitation [7d] does not cite to or reference the arguments regarding how IMU teaches creating an animation by moving a Shepard's distortion control point over time. *See id.* at 64–66. Therefore, Petitioner's assertion that our discussion of limitation [7d] in the Decision failed to address these arguments does not establish that we overlooked or misapprehended arguments applicable to limitation [7d]. *See DeSilva v. DiLeonardi*, 181 F.3d 865, 866–67 (7th Cir. 1999) ("A brief must make all arguments accessible to the judges, rather than ask them to play archaeologist with the record."); *see also In re Baxter Travenol Lab 'ys*, 952 F.2d 388, 391 (Fed. Cir. 1991) ("It is not the function of this court to examine the claims in greater detail than argued by an appellant"); *Novartis AG v. Torrent Pharms. Ltd.*, 853 F.3d 1316, 1328 (Fed. Cir. 2017) ("[T]here is no requirement that the Board expressly discuss each and every negative and positive piece of evidence lurking in the record.").

Petitioner also argues that the Decision did not "address the Petition's reliance on Okabe's '[n]on-linear user-drawn strokes' ***as utilized in the IMU-Okabe Combination***, which 'specif[y] . . . a nonlinear direction and speed' of that Shepard's Distortion control point," and addressed Okabe in isolation. Reh. Req. 4 (citing Pet. 62, 65; Dec. 21–22) (alterations in original).

We did not overlook this argument from the Petition, nor did we improperly address Okabe in isolation. The Decision states:

Petitioner argues that *the IMU-Okabe combination* allows a user to specify a control point's non-linear direction and speed by drawing a non-linear stroke as taught by Okabe such that the combination automatically generates animation frames by shifting the selected pixels along the stroke. Pet. 65 (citing Ex. 1009, 1–3, 7; Ex. 1002 ¶ 168). This argument is also not persuasive.

Dec. 21 (emphasis added). As such, the Decision did address Petitioner's proposed combination and its reliance on Okabe's disclosure of non-linear user-drawn strokes but did not find the arguments persuasive. Moreover, we did not address Okabe in isolation, but concluded that Petitioner's reliance on Okabe's teachings in the combination was insufficient because Okabe's non-linear user-drawn strokes only provide a general indication for a desired direction of movement and do not define pathways that pixels are shifted along. *Id.* at 21–22 (citing Ex. 1009, 2, 6, 7, Figs. 1, 8).

Next, Petitioner argues that:

To the extent the Board's assessment was more so that a [person of ordinary skill in the art] would not have recognized or known how to use Okabe's strokes to define a control point's direction and speed, such likewise overlooked or misapprehended Petitioner's reliance on a [person's of ordinary skill in the art] background knowledge of AECS6, which includes an essentially identical feature for defining the direction and speed of a Deform pin.³

Reh. Req. 5 (citing Pet. 57–58). This argument is not persuasive. The cited portion of the Petition discusses reasons purporting to show why one of ordinary skill in the art would have been motivated to modify IMU's image

³ “AECS6” refers to the Adobe After Effects CS6 software program described in the Adobe After Effects Help and tutorials manual. Ex. 1003.

processing software (“IMV6”) to be a GUI image editor rather than a non-graphical, text-based process. Pet. 57–58. The Petition states that “AECS6 was another such ‘readily available image manipulation program[]’ that combined the ability to create a looping animation of effects applied to still images (e.g., the Puppet effect) with simple and graphical user commands for defining such animation,” allegedly “confirming” that one of ordinary skill in the art would have been motivated to make such a combination of features. *Id.* (citing Ex. 1003, 187–89, 193–95, 218–19, 317, 562; Pet. 8–16, Ex. 1002 ¶ 153) (alteration in original). This argument states only that AECS6 “*confirm[s]*” (as opposed to teaches) that one of ordinary skill in the art would have combined IMU and Okabe in the manner proposed. As such, that we did not discuss this argument expressly in the Decision does not mean we overlooked or misapprehended the argument.

Furthermore, the Decision turned on our determination that the Petition was not sufficiently persuasive that the combination of IMU and Okabe would disclose limitation [7d], not that one of ordinary skill in the art would not have been motivated to combine the references. *See* Dec. 21–22. Therefore, discussing Petitioner’s reasons to combine the references in detail was not necessary.

In addition, the Decision noted that “Petitioner first argues that the ’342 patent states that the claimed shifting can be performed using ‘a warping function, such as Shepard’s distortion,’ and that IMU explicitly teaches performing ‘Shepard’s Distortion’ and, therefore, the claimed pixel shifting.” Dec. 21 (citing Pet. 64–65). We determined that this argument was not persuasive because the “fleeting reference to Shepard’s distortion in the ’342 patent does not suggest that Shepard’s distortion is the only technique for performing the claimed shifting of the first set of pixels, *nor is*

it sufficient to establish that any prior art disclosure of Shepard’s distortion would teach the claimed shifting.” Id. (emphasis added).

Petitioner argues that it never contended that *any* prior art disclosure of Shepard’s distortion would teach the claimed shifting. Reh. Req. 6. The Petition, however, states “[w]ith respect to ‘shifting the first set of pixels along the non-linear pathway,’ the ’342 Patent’s specification states the claimed ‘shifting’ can be performed by using, for example, ‘a warping function, such as Shepard’s distortion,’” and “IMU explicitly teaches that IMV6 performs ‘Shepard’s Distortion’ and therefore the claimed pixel shifting.” Pet. 64 (citing Ex. 1001, 8:30–32; Ex. 1002 ¶ 167; Ex. 1005, 59). To the extent Petitioner is contending that IMU’s disclosure of Shepard’s distortion teaches the claimed shifting, we remain unpersuaded that this argument sufficiently establishes that IMU’s disclosure of Shepard’s distortion teaches shifting a first set of pixels along a non-linear pathway. We also disagree with Petitioner that we overlooked or misapprehended the ’342 patent’s disclosure of Shepard’s distortion. See Reh. Req. 7. We did address Petitioner’s arguments regarding the ’342 patent’s disclosure of Shepard’s distortion and found them unpersuasive. Dec. 21.

Lastly, Petitioner argues that “in view of the ’342 Patent’s admission above, the IMU-Okabe Combination’s use of Okabe’s user-drawn non-linear strokes to control the ‘direction and speed’ of that control point . . . meets—let alone establishes a reasonable likelihood of meeting—the claimed ‘shifting.’” Reh. Req. 7. However, for the reasons discussed above and in the Decision, we determine that Petitioner has failed to establish adequately that the combination of IMU and Okabe discloses limitation [7d] and, thus, has not meet its burden to show a reasonable likelihood it would prevail with

respect to the contention that claim 7 is unpatentable over IMU and Okabe. *See* Dec. 21–22.

As noted above, the Decision questioned whether Petitioner had shown sufficiently that the prior art taught or suggested limitation [7c]. Dec. 20. In the Rehearing Request, Petitioner presents arguments asserting that the Board overlooked or misapprehended Petitioner’s reliance on Okabe with respect to limitation [7c]. Reh. Req. 1–3. The Decision, however, did not turn on whether the proposed combination disclosed limitation [7c]; instead, it turned on the determination that Petitioner’s arguments regarding limitation [7d] were not persuasive. *See* Dec. 20–21 (“[B]ut even assuming for the sake of argument that [limitation [7c]] is [disclosed], we are not persuaded by Petitioner’s arguments that the combination of IMU and Okabe discloses “shifting the first set of pixels along the non-linear pathway.”). Because we are not persuaded by Petitioner’s Rehearing arguments with respect to limitation [7d], as discussed above, we do not address the Rehearing arguments regarding limitation [7c].

For the above reasons, we determine Petitioner has not carried its burden of showing that we misapprehended or overlooked any matter or that the Decision denying institution of *inter partes* review was an abuse of discretion.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner’s Rehearing Request is *denied*.

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