

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TVISION INSIGHTS, INC.,

Petitioner,

v.

THE NIELSEN COMPANY (US), LLC,

Patent Owner.

IPR2023-01014

U.S. Patent No. 11,470,243

**PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

Even if discretionary denial is considered, the merits of this petition are compelling. *See* USPTO Guidance Memo (June 21, 2022), 2. Furthermore, discretionary denial is inappropriate because the *Fintiv* factors weigh against denial.

Under **Fintiv Factor 6**, the Petition presents a compelling case. Nielsen conceded to the compelling merits of the Petition by disclaiming independent claims 1, 9, and 16 upfront. POPR, 2. The POPR includes multiple arguments attacking the motivation to combine Lu-577 with Tian and Nielsen-372 with Steinberg. POPR, 10-29, 38-45, 50-57. Nielsen also argues that Tian and Steinberg are not analogous art. POPR, 57-61. All of these arguments apply to the independent claims of the '243 patent. Had Nielsen believed in the merit of these arguments, there would have been no reason to disclaim the independent claims.

The only arguments in the POPR not applicable to the disclaimed independent claims are that Tian does not teach “reduc[ing] a resolution” in claims 4, 11, and 18 and that it would not have been obvious to analyze reduced-resolution images. POPR, 7-10, 30-38. These arguments do not undermine the compelling merit of the Petition. Regarding the limitation “reduc[ing] a resolution,” Nielsen does not dispute that Tian teaches that “lower resolution images are down-sampled from the originals” and that down-sampling is a method of reducing image resolution. POPR, 7-10; Ex-1003, ¶119. Rather, Nielsen

contends that this teaching is somehow negated by Tian’s additional teaching of storing down-sampled images in a database. POPR, 8-10. This argument is based on an unfounded narrow interpretation of claim 4 – that it prohibits storing reduced-resolution images in a database. Nielsen’s obviousness attack is similarly flawed because Tian explicitly teaches analyzing reduced-resolution images and that doing so does not reduce the accuracy of head orientation determination. Ex-1005, Abstract, 000002, 000005; Ex-1003, ¶68.

Fintiv Factor 1 weighs against denial. Judge Burke has a record of staying cases based on IPR institutions. *See, e.g., WSOU Invs., LLC v. Netgear, Inc.*, No. 1:21-cv-1117-MN-CJB, Dkt. 97 (D. Del. Nov. 30, 2022); *Speyside Med., LLC v. Medtronic Corevalve, LLC*, No. 1:20-cv-361-GBW-CJB, Dkt. 155 (D. Del. Sep. 30, 2021); *ImmerVision, Inc. v. Apple Inc.*, No. 1:21-cv-1484-MN-CJB, Dkt. 159 (D. Del. Oct. 17, 2023).

While Judge Burke frequently grants stays *after* institution, Nielsen cites *Topia Technology, Inc. v. Egnyte, Inc.*, where Judge Burke denied stay prior to institution of IPR. No. 1:21-cv-1821-CJB (D. Del. Mar. 6, 2023); Ex-2007, 49:7-50:11. Judge Burke further noted that the IPRs in *Topia* were filed by third parties, reducing the potential for an estoppel effect. Ex-2007, 50:12-51:4. The *Topia* defendant’s renewed motion to stay was denied because IPRs on four out of the six patents-in-suit were not instituted. No. 1:21-cv-1821-CJB, Dkt. 143 (D. Del. Sep.

6, 2023).

Here, the '243 patent is the only patent-in-suit, where all asserted claims are challenged in this IPR. Nielsen was not able to point to any case where Judge Burke denied a motion to stay when an instituted IPR filed by the defendant covered all asserted claims in his court.

Fintiv Factor 2 weighs against denial. Even if the D. Del. litigation proceeded, a Final Written Decision would be due by January 11, 2025, ***about 10 months before the scheduled November 3, 2025 trial.***¹ Ex-1029, 000018. Nielsen concluded that “*Fintiv* Factor 2 regarding the trial date is, at best, neutral toward discretionary denial” without even addressing the above facts. POPR, 63. The Board has consistently found Factor 2 to weigh against denial when the trial date is later than the FWD deadline. *See, e.g., CrowdStrike, Inc. v. Open Text Inc.*, IPR2023-00124, Paper 11 at 11 (PTAB Jun. 15, 2023) (finding that the trial date being two months later than the FWD deadline “is sufficient for [Factor 2] to weigh against exercising discretion to deny institution”). Nielsen did not identify any case where the Board used its discretion to deny institution when the FWD

¹ The median time from filing to trial for the District of Delaware is 36.7 months (https://www.uscourts.gov/sites/default/files/data_tables/fcms_na_distprofile0630.2023.pdf), yielding a projected trial date of November 2025 as well.

deadline is prior to trial date, let alone 10 months prior.

Fintiv Factor 3 weighs against denial. The district court litigation remains in its early stages, and little work has been completed. The parties have only exchanged initial invalidity and infringement contentions. Ex-1029, 000004. The final contentions are not due until July 2024. *Id.* The hearing on claim construction is scheduled for March 14, 2024. *Id.* at 000013. In fact, the parties have recently stipulated to extend the time for Nielsen to respond to TVision’s Amended Answer and Counterclaim to November 21, 2023. Ex-1030, 000001. By January 11, 2024, when the Board is expected to issue its decision on institution, the parties and district court would not have invested a large amount of work in the co-pending case. The Board has repeatedly weighed this factor against denial under similar conditions. *See, e.g., Samsung Electronics Co., Ltd. v. CardWare Inc.*, IPR2023-00314, Paper 11 at 12 (PTAB July 18, 2023) (“[T]he claim construction hearing is not scheduled until [half a month after the institution decision] ... [w]e determine this factor weighs against exercising discretion to deny institution.”); *Samsung Electronics Co., Ltd. v. G+ Communications, LLC* IPR2022-01598, Paper 10 at 19 (PTAB April 4, 2023).

Fintiv Factor 4 weighs against denial because the Board’s FWD will predate trial in the district court. *See, e.g., Beckman Coulter, Inc. v. Sirigen II Limited*, IPR2022-01204, Paper 12 at 21 (PTAB Jan. 6, 2023) (finding Factor 4 to

weigh against denial of institution, noting, while Petitioner “has not provided a stipulation,” “the projected statutory deadline for a final written decision will predate any trial date in the parallel District Court litigation” and “[a]s such, any overlap in issues will serve to streamline the issue in the litigation, as opposed to creating duplication or redundancy”); *ecobee Technologies ULC v. EcoFactor, Inc.*, IPR2022-00969, Paper 8 at 41 (PTAB Nov. 15, 2022).

Nielsen cites to *Vector Flow, Inc. v. HID Global Corporation* in support of its argument regarding Factor 4 (POPR, 62-63) but failed to inform the Board that the cited institution decision was vacated by the Director. IPR2023-00353, Paper 11 (PTAB Aug. 10, 2023). Furthermore, in *Vector Flow*, the trial was scheduled before the FWD deadline. IPR2023-00353, Paper 8 at 19-20 (PTAB Jul. 17, 2023).

Fintiv Factor 5 weighs against denial because the Board’s FWD will precede trial in the district court. *Huawei Tech. Co. v. WSOU Inv., LLC*, IPR2021-00225, Paper 11 at 14 (PTAB June 14, 2021) (holding that Factor 5 “favors denial if trial precedes the Board’s Final Written Decision and favors institution if the opposite is true[.]”); *Beckman Coulter, Inc. v. Sirigen II Limited*, IPR2022-01204, Paper 12 at 21-22 (PTAB Jan. 6, 2023).

Date: October 31, 2023

Respectfully submitted,

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Attorney for Petitioner

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that the foregoing Petitioner's Reply to Patent Owner's Preliminary Response complies with 37 CFR § 42.6 and the five-page limit specified by the Board. The page count does not include those portions excepted by 37 C.F.R. § 42.24(a)(1).

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on October 31, 2023, a true and correct copy of the Petitioner's Reply to Patent Owner's Preliminary Response was served in entirety via email to all parties to this proceeding at the addresses indicated:

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