

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DJI EUROPE B.V.,
Petitioner,

v.

TEXTRON INNOVATIONS INC.,
Patent Owner.

Case No. IPR2023-01105
U.S. Patent No. 8,332,082 B2

**PATENT OWNER'S AUTHORIZED
SUPPLEMENTAL PRELIMINARY RESPONSE**

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EXHIBIT LIST

Exhibit No.	Description
2001	Defendants' Motion to Stay in <i>Textron Innovations Inc. v. SZ DJI Technology Co., Ltd.</i> , 2-22-cv-00351-RWS-RSP (E.D. Tex. Sept. 1, 2023)
2002	Plaintiff's Opposition to Motion to Stay in <i>Textron Innovations Inc. v. SZ DJI Technology Co., Ltd.</i> , 2-22-cv-00351-RWS-RSP (E.D. Tex. Sept. 18, 2023)
2003	Judge Schroeder Pre-Institution Stay Statistics
2004	Judge Payne Pre-Institution Stay Statistics
2005	Judge Schroeder Post-Institution Stay Statistics
2006	Judge Payne Post-Institution Stay Statistics
2007	Docket Control Order in <i>Textron Innovations Inc. v. SZ DJI Technology Co., Ltd.</i> , 2-22-cv-00351-RWS-RSP (E.D. Tex. May 11, 2023)
2008	U.S. District Courts – Federal Court Management Statistics (June 30, 2023), <i>available at</i> https://www.uscourts.gov/sites/default/files/data_tables/fcms_na_distprofile0630.2023.pdf
2009	Defendants' Invalidity Contentions in <i>Textron Innovations Inc. v. SZ DJI Technology Co., Ltd.</i> , 2-22-cv-00351-RWS-RSP (E.D. Tex. Jan. 19, 2023)
2010	Parties' Joint Claim Construction and Prehearing Statement Pursuant to Patent Rule 4-3, <i>Textron Innovations Inc. v. SZ DJI Technology Co., Ltd.</i> , No. 2:22-CV-00351-RWS-RSP (E.D. Tex. Oct. 27, 2023)
2011	<i>Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation Memorandum</i> (June 21, 2022)
2012	Declaration of Professor Soon-Jo Chung, <i>Textron Innovations Inc. v. SZ DJI Technology Co., Ltd.</i> , No. 2:22-CV-00351-RWS-RSP (E.D. Tex. Oct. 27, 2023)

I. INTRODUCTION

Pursuant to the Board's email authorization on January 16, 2024, Patent Owner respectfully submits this supplemental preliminary response to Petitioner's corrected petition for *inter partes* review filed January 22, 2024 (Paper 7, "Corrected Petition"). The Corrected Petition fails to remedy the deficiencies in the original petition (Paper 2, "Original Petition") identified in Patent Owner's preliminary response (Paper 6, "POPR"). Accordingly, the Board should deny institution.

II. PETITIONER HAS NOT SHOWN WHERE EACH ELEMENT OF CLAIM 11 IS FOUND IN THE ART RELIED UPON IN GROUND 1

The Board's rules require that "[t]he petition *must* specify where each element of the claim is found in the prior art patents or printed publications relied upon." 37 C.F.R. § 42.104(b)(4) (emphasis added); *see also* 35 U.S.C. § 312(a)(3) (requiring petitions to identify "with particularity . . . the evidence that supports the grounds for the challenge to each claim"). Petitioner's Ground 1 challenges independent Claim 11 of the '082 Patent, which recites, in part, "controlling the speed variation of the aircraft with actuators operably associated with the aircraft" (referred to as limitation 11.A.1 in the Corrected Petition). Original Petition, 2; DJI-1001, 9:33-34. The Original Petition, and the accompanying declaration of Petitioner's expert, Dr. Singhose, failed to address this element of Claim 11 and even omitted it from the claim listing in Appendix A to the Original Petition. *See* Original Petition, 50-

51, Appendix A (p.2); *see also* DJI-1003, ¶158 (Dr. Singhose omitting this limitation from his reproduction of Claim 11).

Petitioner represented to the Board that its failure to address this element of Claim 11 was the result of a clerical error and filed the Corrected Petition. The Corrected Petition attempts to remedy the deficiencies in the Original Petition by referring back to portions of the Petition's analysis of Claim 1. Corrected Petition, 50-51. The newly added cross-references in the Corrected Petition, however, fail to show that the Gold-Shue-Gold-Paper combination teaches limitation 11.A.1.

Specifically, the Corrected Petition cites only the analysis in section V.B.2 as allegedly demonstrating that the Gold-Shue-Gold-Paper combination discloses "controlling the speed variation of the aircraft with actuators operably associated with the aircraft" as recited in limitation 11.A.1. Corrected Petition, 50-51. Section V.B.2, however, addresses *different* limitations of Claim 1, which recite "a sensor carried by the aircraft, the sensor being adapted to sense a directional movement of the aircraft" (limitation [1A]) and "an actuator carried by the aircraft, the actuator being utilized to control the directional movement of the aircraft" (limitation [1B]). Corrected Petition, 22-25. While the cross-referenced portion of the Petition purports to identify disclosure in Gold of actuators utilized to control the directional movement of the aircraft, it lacks any explanation of how the identified disclosure

in Gold teaches “controlling the speed variation of the aircraft” using the identified actuators as recited in limitation 11.A.1. Corrected Petition, 25.

Furthermore, Petitioner made no attempt to correct Dr. Singhose's declaration (DJI-1003), which similarly failed to address limitation 11.A.1. Thus, the Corrected Petition's contention that limitation 11.A.1 is disclosed by the Gold-Shue-Gold-Paper combination “[f]or the reasons set forth in” its analysis of Claim 1 in section V.B.2 lacks corroborating expert testimony and therefore amounts to little more than unsupported attorney argument. Petition, 50 (citing DJI-1003, ¶¶165-171).

Even with the changes in the Corrected Petition, Petitioner has not met its burden to “specify where each element of the claim is found in the prior art patents or printed publications relied upon.” 37 C.F.R. § 42.104(b)(4); *see also Samsung Elecs. Co., Ltd. v. RightQuestion, LLC*, IPR2022-00251, Paper 17 at 38 (P.T.A.B. June 9, 2022) (“The burden of proof here lies with Petitioner, not Patent Owner, and [the Board does not] create and adopt unpatentability arguments on behalf of Petitioner as to whether or how [a reference] might teach a [claim element].”). Accordingly, Petitioner has not demonstrated a reasonable likelihood that Claim 11 would have been obvious and institution should be denied.

Respectfully submitted,

/Brian W. Oaks/

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MCDERMOTT WILL & EMERY

Dated: January 30, 2024

Patent Owner's Supplemental Preliminary Response
IPR2023-01105 (U.S. Patent 8,332,082)

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CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. § 42.6(e), the undersigned certifies that on the 30th day of January, 2024, a complete and entire copy of the foregoing **PATENT OWNER'S AUTHORIZED SUPPLEMENTAL PRELIMINARY RESPONSE** was served on Petitioner via email to counsel of record for the Petitioner at the following addresses:

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