

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Videndum Production Solutions, Inc.
Petitioner,

v.

Rotolight Limited,
Patent Owner.

Case: IPR2023-01218
U.S. Patent No. 10,845,044

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

Institution is consistent with public policy. Congress established IPRs “to improve patent quality and restore confidence in the presumption of [patent] validity.” *Code200, UAB v. Bright Data Ltd.*, IPR2022-00861, Paper 18 at 5-6 (PTAB Aug. 23, 2022); Director Vidal’s Memo. at 3-4 (June 21, 2022). Petitioner’s challenge has merit as the Board found a reasonable likelihood of invalidity on the same grounds. *Arnold & Richter Cine Technik GmbH & Co. Betriebs KG v. Rotolight, Ltd.*, IPR2022-00099, Paper 13 at 25 (PTAB May 12, 2022).

Patent Owner’s Preliminary Response (“POPR”) argues that the Board should deny the Instant Petition based on a prior petition in IPR2022-00099 that was *not filed by Petitioner* (“the ARRI Petition”). POPR at 15-25. In other words, Rotolight asks the Board to deny the Instant Petition based on a prior petition that was (i) instituted and (ii) filed by a direct competitor of Petitioner for which there is no significant relationship. Patent Owner’s argument does not support denial.

I. Denial Based on the ARRI Petition Would Be Inappropriate

This is Petitioner’s first petition against the ‘044 Patent. Despite this, Patent Owner incorrectly argues the Instant Petition should be denied because of a purported “significant relationship” between Petitioner and ARRI. No such relationship exists—they are direct competitors—therefore, the *General Plastic* factors are of “little probative value.” *General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017); *Nanobebe US*

Inc. v. Mayborn (UK) Ltd., IPR2023-00467, Paper 11 at 10 (PTAB June 16, 2023). Patent Owner relies on *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11 (PTAB Apr. 2, 2019) to argue the existence of a “significant relationship” with ARRI, but *Valve* is disanalogous. *Valve* involved co-defendants accused of infringement based on the same product that were joined in a related IPR. IPR2019-00062, Paper 11 at 3, 9-10. *None of these facts are present here.* Petitioner and ARRI are competitors that were separately sued based on different products, and did not collaborate on an IPR. *Keysight Techs., Inc. v. Centripetal Networks, LLC*, IPR2023-00446, Paper 9 at 10-11 (PTAB Aug. 7, 2023); IPR2023-00467, Paper 11 at 10; *Google LLC v. Uniloc 2017 LLC*, IPR2020-00396, Paper 11 at 5-17 (PTAB Aug. 3, 2020) (distinguishing *Ericsson*: “[t]he fact that [petitioners] are direct competitors who have been sued separately...weighs against finding a significant relationship”).

Patent Owner also cites *Ericsson Inc. v. Uniloc 2017, LLC*, IPR2019-01550, Paper 8 at 11-12 (PTAB Mar. 17, 2020) to assert a significant relationship with ARRI. But in *Ericsson*, the denied petition was one of *many* filed petitions, and used the prior petitions as a roadmap by “picking and choosing from” the work product like “a menu.” *Id.* Here, Petitioner did not use the ARRI Petition to “pick[] and choose[]” invalidity arguments. In fact, Patent Owner calls the Instant Petition a copycat, and the Board has held that copying a petition “to present substantively identical challenges” does not create a significant relationship. POPR at 1; *Cisco*

Sys., Inc. v. Centripetal Networks, Inc., IPR2022-01151, Paper 12 at 47 (PTAB Jan. 4, 2023). Patent Owner has failed to demonstrate the existence of a significant relationship, mooting its *General Plastic* analysis based on the ARRI Petition.

Even if a significant relationship existed, the facts still favor institution. The ARRI Petition was instituted, mooting “roadmap” concerns in factors one and three. *Signify N. Am. Corp. v. CAO Lighting, Inc.*, IPR2023-00214, Paper 14 at 22 (PTAB June 15, 2023); IPR2022-01151, Paper 12 at 48-49 (a petition cannot be both a copycat, as alleged by Patent Owner, and the product of “roadmapping.”). Factor two weighs in favor of institution because Patent Owner fails to establish that Petitioner knew of the prior art at the time the ARRI Petition was filed. *Keysight Techs., Inc. v. Centripetal Networks, Inc.*, IPR2023-00446, Paper 9 at 11 (PTAB Aug. 7, 2023). Factors four and five weigh in favor of institution because the Instant Petition was filed within a reasonable time, with Petitioner working efficiently to find a new expert, coordinate with third parties (one residing overseas), and finalize declarations. Factors six and seven favor institution, as the Board already found a likelihood that the '044 Patent may be invalid based on the grounds in the Instant Petition. IPR2022-00099, Paper 13 at 25.

Dated: November 22, 2023

Respectfully submitted,

/David M. Magee/

David M. Magee (Reg. No. 51,982)

CERTIFICATE OF SERVICE

Under 37 C.F.R. § 42.6(e), the undersigned certifies that on November 22, 2023, a copy of the foregoing PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE were served in their entirety on the following counsel of record for Patent Owner via email:

LEAD COUNSEL

Bradley Liddle (Reg. No. 71,106)
bliddle@carterarnett.com
Carter Arnett PLLC
8150 N. Central Expressway, Suite 500
Dallas, Texas 75206
(214) 431-4990
(214) 550-8185 (fax)

BACK-UP COUNSEL

Michael Pomeroy (Reg. No. 76,010)
mpomeroy@carterarnett.com
Carter Arnett PLLC
8150 N. Central Expressway, Suite 500
Dallas, Texas 75206
(214) 550-4680
(214) 550-8185 (fax)

ADDITIONAL BACK-UP COUNSEL

Scott Breedlove (Reg. No. 46,577)
sbreedlove@carterarnett.com
Carter Arnett PLLC
8150 N. Central Expressway, Suite 500
Dallas, Texas 75206
(214) 550-8172
(214) 550-8185 (fax)

Petitioner's Preliminary Reply for U.S. Patent No. 10,845,044

Howard L. Lim (Reg. No. 73,369)
hlim@carterarnett.com
Carter Arnett PLLC
8150 N. Central Expressway, Suite 500
Dallas, Texas 75206
(214) 295-3966
(214) 550-8185 (fax)

Dated: November 22, 2023

Respectfully submitted,

/David M. Magee/

David M. Magee (Reg. No. 51,982)
Armstrong Teasdale LLP
800 Boylston St., 30th Floor
Boston, MA 02199
Telephone: 617.824.5150
Facsimile: 617.830.8490

Counsel for Petitioner