

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
Patent 10,845,044

**PATENT OWNER'S SUR-REPLY IN SUPPORT OF
PRELIMINARY RESPONSE**

Neither Public policy, nor the General Plastics factors support instituting an *inter partes* review in this case. Although public policy of IPRs is to “improve patent quality,” this desire must be balanced “against the potential for abuse of the review process by repeated attacks on patents.” *Intel Corp. v. VLSI Tech. LLC*, IPR2022-00366, Paper 14 at 9-10 (June 8, 2022). As the Board has stated, “[a]lthough we recognize that an objective of the AIA is to provide an effective and efficient alternative to district court litigation, we also recognize the potential for abuse of the review process by repeated attacks on patents.” *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016–01357, Paper 19 at 16-17 (PTAB September 6, 2016) (precedential) (*General Plastic*).

The present Petition is part of a pattern of textbook abuse of the review process by repeated attacks on the validity of Patent Owner’s patents. Petitioner does not deny that (1) Petitioner was aware of ARRI’s petitions at the time they were filed or shortly thereafter, (2) Petitioner knew of the prior art asserted in this Petition (“2nd Petition”) at the time of the first petition filed by ARRI (IPR2022-00099, Paper 2 (“1st Petition”)), and (3) Petitioner used the proceedings in now-terminated IPR2022-00099 (“ARRI IPR”) as a roadmap for this 2nd Petition. Petitioner did not seek to join the ARRI IPR, but instead chose to wait until the very last minute to attempt to stop the joint termination of the ARRI IPR. *See* EX1010 (Petitioner’s email to board in IPR2022-00099). Petitioner waited to see how the ARRI IPR

developed, and filed this Petition more than 1 year and 7 months after filing petitions challenging two other Rotolight patents. Petitioner cannot explain such a delay. A 19-month delay is not a reasonable amount of time, nor is failing to join the ARRI petitions in case of a settlement. Petitioner then filed nearly identical petitions with road-mapped modifications. Thus, Patent Owner respectfully requests that the Board should exercise its discretion and deny the Petition under 35 U.S.C § 314(a).

I. THE *GENERAL PLASTIC* FACTORS FAVOR DENIAL

In September and October, 2021, ARRI filed 4 IPR petitions (“ARRI petitions”) against Rotolight patents. Among the patents challenged were the ’257 Patent, ’258 Patent, and the ’044 Patent. Petitioner cited to the ARRI petitions in their 1st Petitions (challenging the ’257 and ’258 patents) and elected to primarily assert different prior art than ARRI but challenged the same claims. *See, e.g.*, IPR2021-00262, Paper 1 at 1 (PTAB Dec. 3, 2021) (“The following currently pending matters relate to the challenged ’258 Patent: IPR2021–01497.”). This indicates that Petitioner was aware of the prior art asserted in the ARRI IPRs. Indeed, in September 2021 ARRI had filed a petition against another Rotolight patent using Astera and Edwards references that are used in the present Petition. Petitioner’s Reply suggests it is Patent Owner’s burden to show that Petitioner knew of Astera and Edwards when the ARRI petition was filed. But precedent from the Board holds that Petitioner’s failure to set forth facts or offer an explanation concerning its

knowledge is weighed against Petitioner. *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 at 9 (PTAB Oct. 28, 2020) (precedential). Therefore, *General Plastic* factor 2 weighs against institution.

After learning of the ARRI IPRs, Petitioner waited 19 months to file this 2nd Petition and has not explained why finding a new expert justifies such a delay. Petitioner monitored how both parties' arguments developed throughout the ARRI IPR and used that knowledge to copy the ARRI IPR and modify it in response to those developments. *See* EX1010. Petitioner's assertion that a Petition cannot be both a copycat and employ road mapping is of no import. Reply at 3. Petitioner copied the ARRI IPR, nearly verbatim, and then supplied additional arguments from observing the various filings in the ARRI IPR proceeding. Petitioner then waited almost 6 months after the ARRI IPR proceedings were terminated to file this 2nd Petition. Thus, *General Plastic* factors 3-6 also weigh against institution.

Petitioner's behavior here—being aware of the previous petition but declining to join it in favor of using its progression as a roadmap to file a similar petition long after the first proceeding was terminated—sufficiently ties its interests to the first petitioner to weigh against institution under factor 1 also. The fact that Petitioner was able to pick and choose from many filings in a single proceeding rather than picking and choosing from multiple petitions fails to meaningfully distinguish *Ericsson*. Petitioner's gamesmanship should not be rewarded.

Dated: November 30, 2023

Respectfully submitted,
/Brad Liddle/

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CERTIFICATE OF SERVICE

I hereby certify that on this 30th day of November 2023, a true and correct copy of the foregoing Patent Owner's Sur-Reply In Support of Preliminary Response was served by electronic mail upon the following counsel of record for Petitioners:

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