UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIDENDUM PRODUCTION SOLUTIONS, INC.,
Petitioner,

v.

ROTOLIGHT LIMITED,
Patent Owner.

Case IPR2023-01219
Patent 10,197,258

PATENT OWNER'S PRELIMINARY SUR-REPLY TO PETITIONER'S PRELIMINARY REPLY FOR INTER PARTES REVIEW OF U.S. PATENT NO. 10,197,258

I. INTRODUCTION

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 textbook abuse of the review process by repeated validity attacks. Petitioner cannot deny that (1) this is the second Petition that Petitioner has filed against this patent and Petitioner knew of the prior art asserted in this Petition ("2nd Petition") at the time of the first petition (IPR2022-00262, Paper 1 ("1st Petition")), and (2) Petitioner used the petition from now-terminated IPR2021-01497 ("ARRI IPR") as a roadmap for this 2nd Petition. Petitioner had over seven months between the denial of its 1st Petition and a final written decision in the ARRI IPR to join the ARRI IPR as an understudy or file this 2nd Petition at an earlier time, but instead chose to wait until the very last minute to attempt to stop the joint termination of the ARRI IPR. IPR2021-01497, Paper 36.

Petitioner was aware of the ARRI IPR in 2022 before it filed its 1st Petition but waited 1 year and 7 months to file this 2nd Petition. Petitioner does not offer any explanation for the 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. Further, Petitioner then waited an additional almost 6 months post-ARRI IPR termination to file this 2nd Petition, which is nearly identical to the ARRI IPR 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).

II. THE VIDENDUM PETITIONS

On September 3, 2021, ARRI filed an IPR petition ("ARRI petition") challenging claims 1-22 of U.S. Patent No. 10,197,258 (the "'258 Patent"). Petitioner cited to the ARRI petition in their 1st Petition 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 petition but chose to assert different art in the 1st Petition. Therefore, contrary to Petitioner's assertions, *General Plastic* factors 1 and 2 weigh against institution.

After learning of the ARRI IPRs, Petitioner waited 19 months to file this 2nd Petition and has not offered any explanation for the delay other than "Petitioner had

no obligation to file sooner." *See* Prelim. Reply 2 (citations omitted). Petitioner monitored how both parties' arguments developed throughout the ARRI IPR and used that knowledge to copy the ARRI petition and update it in response to those developments. IPR2021-01497, EX3001. 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, including the Oral Hearing. Petitioner then waited almost 6 months after the ARRI IPR proceedings were terminated to file this 2nd Petition, again with no explanation of the delay. Thus, *General Plastic* factors 3-6 also weigh against institution.

III. CONCLUSION

The Federal Circuit has previously ruled that "the PTO is permitted, but never compelled, to institute an IPR proceeding." *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016). "The absence of any restrictions on follow-on petitions would allow petitioners the opportunity to strategically stage their prior art and arguments in multiple petitions, using our decisions as a roadmap, until a ground is found that results in the grant of review." *General Plastic* at 17. This is exactly what Petitioner is attempting to achieve. Petitioner's gamesmanship should not be rewarded. If Petitioner wishes to use the exact same grounds and references as ARRI, it will have that chance in the District Court proceedings.

Dated: November 30, 2023

Respectfully submitted,
/*Brad Liddle*/

Bradley Liddle (Reg. No. 71,106)
bliddle@carterarnett.com
Carter Arnett PLLC
8150 N. Central Expressway
Suite 500
Dallas, TX 75206
214.431.4990
Lead Counsel for Patent Owner

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 PRELIMINARY SUR-REPLY was served by electronic mail upon the following counsel of record for Petitioners:

David M. Magee, dmagee@atllp.com
Marc Vander Tuig, mvandertuig@atllp.com
Kyle G. Gottuso (*pro hac vice* forthcoming), kgottuso@atllp.com

/Brad Liddle/
Brad Liddle (Reg. No. 71,106)
bliddle@carterarnett.com
Carter Arnett PLLC
8150 N. Central Expressway, Suite 500
Dallas, TX 75206
214.431.4990
Lead Counsel for Patent Owner