

**IN UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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SAMSUNG ELECTRONICS CO., LTD. AND  
SAMSUNG ELECTRONICS AMERICA, INC.

Petitioners,

v.

MAXELL, LTD.,  
Patent Owner

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**Case: IPR2024-00717**

**U.S. Patent No. 11,223,757**

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**PATENT OWNER'S PRELIMINARY RESPONSE  
TO PETITION FOR *INTER PARTES* REVIEW  
OF U.S. PATENT NO. 11,223,757**

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Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

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## PATENT OWNER'S EXHIBIT LIST

| <b>Description</b>                                              | <b>Exhibit #</b> |
|-----------------------------------------------------------------|------------------|
| 1st Amended Docket Control Order from District Court Litigation | 2001             |
| Original Docket Control Order from District Court Litigation    | 2002             |
| Maxell's Supplemental Preliminary Election of Asserted Claims   | 2003             |
| Defendants' Preliminary Election of Prior Art                   | 2004             |

## I. INTRODUCTION

Patent Owner Maxell, Ltd. (“Patent Owner”) respectfully requests that the Board deny institution because Petitioners Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (hereinafter “Petitioner” or “Samsung”) have failed to demonstrate a reasonable likelihood of success on the grounds submitted in the Petition for challenging the patentability of claims 1-11 (“challenged claims”) of U.S. Patent No. 11,233,757 (“the ’757 Patent”) (Ex. 1001).

**First**, the Board should exercise its discretion pursuant to 35 U.S.C. § 314(a) and deny this petition. Application of the *Fintiv* factors weighs in favor of denying institution. One of the purposes of IPRs is to be an “effective and efficient alternative” to litigation. *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16-17 (PTAB Sept. 6, 2017) (precedential). Here, instituting an IPR would not be an effective or efficient alternative to litigation, particularly given the stage of the co-pending District Court case *Maxell, Ltd. v. Samsung Electronics Co. Ltd. et al.*, No. Case No. 5:23-cv-00092 (E.D. Tex.) (“District Court Litigation”) and the finite resources of the Board.

**Second**, Petitioner fails to show a reasonable likelihood of prevailing on any Ground because it has not shown that the cited references render obvious claims 1-11. None of the cited references alone or in combination disclose the arrangement of each element of claims 1-11. Specifically, Grounds 1-2 fail because, even if

POSITA would have been motivated to combine Chinn, Takahashi, and EX-V7, Petitioner has failed to show with particularity how such a combination would render obvious elements 1[i], 1[j], 11[d], and 11[h]. Ground 3 fails because Kim, Yamamoto, and Thorn do not disclose claim elements 1[i], 1[j], 11[d], and 11[h], and Ground 4 fails because Kim, Yamamoto, Thorn, and Chinn do not disclose claim elements 11[d] and 11[h].

Accordingly, the Board should decline to institute the Petition.

## **II. DISCRETIONARY FACTORS FAVOR DENIAL OF INSTITUTION**

The Petition should be denied pursuant to 35 U.S.C. § 314(a) and the factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020). The PTAB has the authority, where warranted, to exercise discretion to deny institution in view of the *Fintiv* factors particularly where, as here, the merits of the challenge are neither compelling nor meritorious (*see infra*, Section III). *See* “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings With Parallel District Court Litigation,” issued June 21, 2022 (“Director’s Guidance”).

### **A. Application of 35 U.S.C. § 314(a) Weighs in Favor of Denying Institution**

The Petition should be denied pursuant to 35 U.S.C. § 314(a) because, as set forth below, not only are there significant flaws in Petitioners’ analysis that fail the “compelling merits” standard, but the circumstances of the parallel District Court

Litigation necessitate denial of the Petition under the Board's precedent. In the Petition, Petitioner does not argue that any *Fintiv* factor, other than factor 6, supports institution. Pet. at 94. Nor has Petitioner made a *Sotera* stipulation. Every factor considered in relation to efficiency, fairness, and the merits supports denial. See *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 6 (P.T.A.B. Mar. 20, 2020) (precedential).

Accordingly, the Board should exercise its discretion under § 314(a) and deny the Petition because institution of this proceeding would not be consistent with the objective of the AIA to "provide an effective and efficient alternative to district court litigation." *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, at 20 (P.T.A.B. Sept. 12, 2018) (quoting *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, at 16–17 (P.T.A.B. Sept. 6, 2017) (precedential))

**1. No Stay Of The Parallel District Court Litigation**

There is no stay of the parallel District Court Litigation. Even if the Petition were instituted and Petitioner filed a motion to stay the District Court Litigation, prejudice, tactical disadvantage to Maxell, the late stage of the litigation, and the lack of potential simplification would weigh strongly against such a motion. See *Lennon Image Techs., LLC v. Macy's Retail Holdings, Inc.*, 2:13-CV-00235-JRG, 2014 WL 4652117, at \*1 (E.D. Tex. Sept. 18, 2014). The statutory deadline for institution is not until after fact discovery closes and after the Court has conducted a

*Markman* hearing. Ex. 2001. Such facts make it unlikely that the District Court Litigation will be stayed. *See Intell. Ventures II v. FedEx Corp.*, No. 2:16-cv-00980-JRG, Dkt. 141 at 5 (E.D. Tex. Oct. 24, 2017) (“The Court agrees that the Parties have already invested substantial effort and resources during discovery and in preparing claim construction briefing. . . .These circumstances weigh against staying this case.”).

## **2. Proximity Of The District Court's Trial Date**

The proximity of the District Court Litigation's trial date to the Board's projected statutory deadline for a Final Written Decision strongly weighs in favor of discretionary denial. The parties' trial is scheduled for May 19, 2025. Ex. 2002 (Original Docket Control Order). Petitioner knew of this trial date four months prior to filing the Petition. *Id.* Pursuant to 35 U.S.C. §§ 314(b)(1) and 316(a)(11), the projected statutory deadline for a Final Written Decision of this Petition is November 12, 2025.<sup>1</sup> As the District Court's trial will be almost six months before the projected statutory deadline, this factor weighs strongly in favor of denying institution. *See Samsung Elecs. Am., Inc. v. Uniloc 2017 LLC*, IPR2019-01218, Paper 7, at 7-10

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<sup>1</sup> The Statutory deadline for institution is November 12, 2024, “three months after receiving a preliminary response to the petition under section 313.” *See* 35 U.S.C. §314(b)(1).

(P.T.A.B. Jan. 7, 2020) (denying institution where jury selection was scheduled for approximately six months before trial in the Board proceeding would conclude); *Next Caller Inc. v. TrustID, Inc.*, IPR2019-00961, -00962, Paper 10, at 8-16 (P.T.A.B. Oct. 16, 2019) (denying institution where trial was scheduled to conclude “several months,” before a final decision would be due); *Cisco Sys., Inc.*, IPR2020-00122, Paper 15 at 8 (“Because the trial date is substantially earlier than the projected statutory deadline for the Board’s final decision, this factor weighs in favor of discretionary denial.”).

The proximity of the trial favors denial of institution.

### **3. Significant Investment In The Parallel Proceeding**

The parties’ investment in the parallel proceeding weighs in favor of discretionary denial. In the District Court Litigation, the Court has already entered a Docket Control Order (Dkt. 45), Discovery Order (Dkt. 46), and Protective Order (Dkt. 47), and an Amended Docket Control Order (Dkt. 72). The parties have briefed claim construction issues and completed claim construction discovery. Ex. 2001. The Court has also conducted a *Markman* Hearing (Dkt. 84). Discovery is also well under way, and fact discovery will be complete on October 29, 2024, about two weeks before the Institution Decision in this proceeding. Indeed, the parties have exchanged numerous documents, propounded numerous interrogatories, and Maxell and its experts have spent many hours reviewing source code produced by Samsung.

Thus, the parties' and Court's substantial investment in this proceeding weighs in favor of denial of institution under this factor. *10X Genomics, Inc. v. President and Fellows of Harvard College*, IPR2023-01299, Paper 15, at 17-18 (P.T.A.B. March 7, 2024) (finding, under similar facts, that the parties have made a substantial investment in the parallel proceeding as of the time of the Institution Decision).

**4. *Petitioner Fails To Offer A Sotera Stipulation And There Is Significant Overlap Between Issues Raised In The Petition And In The District Court Litigation***

The issues in this proceeding are substantially the same as in the District Court Litigation. Here, Petitioner asserts that Claims 1-11 of the '757 Patent are unpatentable. Pet. at 1. These claims include the asserted claims against Petitioner in the District Court Litigation. Ex. 2003. Not only will the District Court Litigation conclude long before this proceeding, but it will also resolve the invalidity arguments that Petitioner raises in the instant Petition. The prior art references relied on in this proceeding are the same, or substantially the same, as those at issue in the District Court Litigation. Ex. 2004.

In light of the Director's Guidance, Petitioner's failure to make a *Sotera* stipulation weighs against institution. "When a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition *or any grounds that could have reasonably been raised in the petition*, it mitigates concerns of

potentially conflicting decisions and duplicative efforts between the district court and the PTAB. *See Sotera*, Paper 12 at 18- 19.” Director’s Guidance at 7 (emphasis added). Contrary to making a *Sotera* stipulation, Petitioner has indicated that it will be wasting the Board and District Court’s resources by pursuing the same invalidity defenses using the same prior art in this proceeding and parallel District Court litigation. *See Ex. 2004 (Petitioner’s Election of Prior Art)* at 2-3 (electing each of “Chinn,” “Takahashi,” “Kim,” and “Yamamoto” as prior art).

Thus, any questions of whether the grounds of invalidity raised in the Petition invalidate the asserted claims of the ’757 Patent will be decided in the District Court Litigation at least six months prior to when the Board would issue a Final Written Decision in this proceeding. Given that the Petition is directed toward substantially the same claims, grounds, arguments, and significantly overlapping evidence at issue in the parallel District Court Litigation, and since Petitioner has not sought to mitigate any of these concerns, this factor favors denial of institution.

**5. *The Parallel District Court Litigation And The Petition Involve The Same Parties***

As noted in Maxell’s Mandatory Notice, there exists a parallel District Court Litigation between the same parties regarding the same subject patent (the ’757 Patent). *See Paper 5.* Samsung is a party to the District Court Litigation. Accordingly, this factor weighs in favor of discretionary denial.

**6. Other Factors Favor Discretionary Denial**

The Petition does not present a strong case on the merits, let alone a “compelling meritorious challenge,” further supporting denial of institution. *See infra* Section III. Petitioner also does not identify any other factors which weigh against discretionary denial. Pet. at 94.

Thus, when viewing the factors together, the Petition should be denied in the Director's discretion under 35 U.S.C. § 314(a).

**B. The Board Should Reject Any Late *Sotera* Stipulation**

Petitioner has not made a *Sotera*-style stipulation that “if IPR is instituted, [Petitioner] will not pursue in the District Court Litigation any ground raised or that could have been reasonably raised in an IPR” in its Petition, which weighs further in favor of discretionarily denying institution. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, 13-14 (P.T.A.B. Dec. 1, 2020) (designated Dec. 17, 2020). The Board should not accept any late *Sotera* stipulation after this Patent Owner Preliminary Response. Petitioner has known about the related District Court Litigation since Patent Owner filed a Complaint asserting infringement of the '757 Patent on September 7, 2023, over seven months before this Petition. Petitioner has continued to assert the same set of prior art across both proceedings requiring duplicative efforts. The Court set the trial date seven months ago. Ex. 2002. Any withholding of the *Sotera* stipulation in its Petition is gamesmanship and prejudicial

to Patent Owner in this proceeding, and is inconsistent with 37 C.F.R. § 42.1(b)'s mandate to "secure the just, speedy, and inexpensive resolution of every proceeding." Indeed, Petitioner's gamesmanship in this regard prejudices Maxell because Maxell is forced to prepare a validity defense in the District Court Litigation throughout the pendency of this Petition.

Both the Board and the Director are clear that petitioners cannot wait until after the Board renders its Institution Decision to address the issue of *Fintiv* and to submit a *Sotera* stipulation. *NXP USA, Inc. v Impinj, Inc.*, IPR2021-01556, Paper 12, 5-6 (P.T.A.B. Aug. 25, 2022); *see also id.*, IPR2021-01556, Paper 13, 3-4 (P.T.A.B. Sept. 7, 2022) (the Director finding "that the Board correctly determined that a stipulation, offered by a petitioner for the first time after a decision denying institution, is not a proper basis for granting rehearing of the decision on institution;" "[p]ermitting a petitioner to wait and see if the Board denies institution under *Fintiv*, and then offer such a stipulation for the first time on rehearing, frustrates these goals [of avoiding conflicting decisions] and would open the door to gamesmanship;" "the only appropriate time for a petitioner to offer a stipulation related to the *Fintiv* factor 4 analysis is prior to the Board's decision of whether to institute review.") (emphasis added). Petitioner's failure to provide a *Sotera* stipulation along with its Petition has prejudiced and continues to prejudice Maxell.

**III. THE PETITION DOES NOT SHOW A REASONABLE LIKELIHOOD OF PREVAILING WITH RESPECT TO ANY CHALLENGED CLAIM**

While application of the *Fintiv* factors weigh in favor of denial of institution, institution should also be denied because, for the reasons more fully set forth below, the petition fails to show a reasonable likelihood of prevailing with respect to any challenged claim.

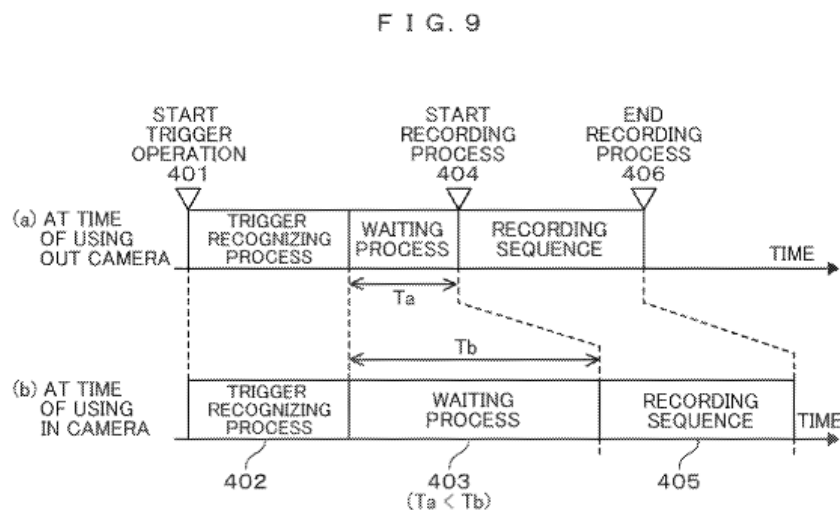
**A. U.S Patent No. 11,223,757**

The '757 Patent is directed to an image recording device configured to execute a plurality of different photographing processes using multiple cameras and a touch interface. Specifically, the '757 Patent discloses an apparatus with an “audio input interface,” “a touch display,” “a first camera arranged on a same side of the touch display,” “a second camera arranged on an opposite side of the touch display,” “a recorder,” and “a controller” such that these components work in conjunction to implement a plurality of different photographing processes including taking pictures based on voice input and touch input including after elapse of a first standby time and a second standby time, to allow a user with time to compose themselves before the camera to capture an individual or group selfie.

More specifically, the '757 Patent illustrates a process of controlling switching between recording start delay times in accordance with which one of the two cameras is used. Ex. 1001, 9:42-47. As the patent describes:

In a control sequence, when a trigger operation start **401** (an input of a command voice) is received, after a trigger recognition process **402** (a process of recognizing a command voice) and a standby process **403** of a predetermined time are performed, a recording process start **404** is performed. Then, a predetermined recording sequence **405** (storage of video data) is executed, and a recording process end **406** is performed.

Ex. 1001, 9:48-55.



Ex. 1001, FIG. 9.

As illustrated in (a), in a case where a subject is photographed using the second imaging unit **124** (out camera), a standby process **403** of a standby time  $T_a$  is performed. On the other hand, as illustrated in (b), in a case where a subject is photographed using the first imaging unit **123** (in camera), a standby process **403** of a standby time  $T_b$  is performed. Here, the standby times of both the cases are different from each other, and the standby time  $T_b$  is set to be longer than the standby time  $T_a$  ( $T_a < T_b$ ). Accordingly, a delay time until the recording process

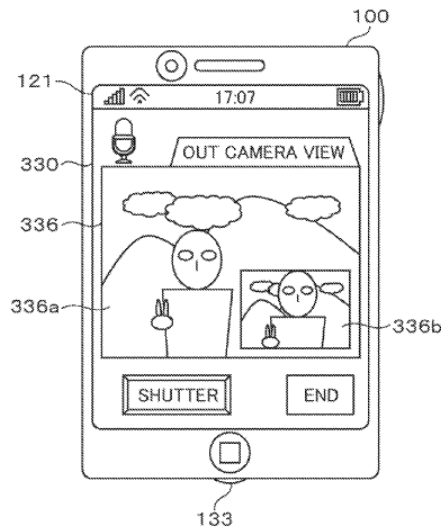
start **404** from the trigger operation start **401** is longer at the time of using the in camera illustrated in (b) than at the time of using the out camera illustrated in (a). In this way, the delay time is automatically switched over in accordance with selection of one of the second imaging unit **124** (out camera) and the first imaging unit **123** (in camera). Therefore, an optimal video corresponding to a photographing target (an external subject/a self-image) can be recorded.

Ex. 1001, 9:56-10:6.

This control sequence through the control unit can set a delay time until start of the recording process performed by the recording unit after input of the command voice in accordance with the imaging unit enabled by the operation unit. Here, the control unit sets the delay time of a case where the first imaging unit is enabled by the operation unit to be longer than the delay time of a case where the second imaging unit is enabled. *Id.* at 2:67-3:7.

Figure 12 illustrates an example of a screen on which two camera videos are composed and displayed:

FIG. 12



Ex. 1001, FIG. 12. “In this case, both the first imaging unit **123** (in camera) and the second imaging unit **124** (out camera) are simultaneously enabled, and two units of video data are input.” *Id.* at 13:33-35.

### **B. '757 Patent Family Prosecution History**

U.S. Application No. 16/686,467 (the “’467 Application”), which issued as the ’757 Patent, was filed on 11/18/2019. The ’467 Application claimed priority to a series of continuation applications, (1) U.S. Application No. 15/678,265, filed on August 16, 2017, now U.S. Patent No. 10,511,757, (2) U.S. Application No. 14/917,586, filed on September 12, 2013 as application No. PCT/JP2013/074728, now U.S. Patent No. 9,774,776.

**C. Person Of Ordinary Skill In The Art**

For purposes of this preliminary response only, Patent Owner agrees with Petitioner that a POSITA at the time of the invention of the '757 Patent would have had a Bachelor's degree in electrical or computer engineering or a comparable field of study, plus approximately two to three years of professional experience with camera technology.

**D. Petitioner's References**

The Petition raises four grounds of alleged obviousness based on the following six references. U.S. Patent Publication No. 2014/0247368 ("Chinn") (Ex. 1004), Translation of JP2001305642A ("Takahashi") (Ex. 1005), U.S. Patent Publication No. 2010/037026 ("Kim") (Ex. 1008), U.S. Patent Publication No. 2010/0026815 ("Yamamoto") (Ex. 1009), U.S. Patent Publication No. 2009/0167881 ("Thorn") (Ex. 1011), and EX-V7 Guide ("EX-V7") (Ex. 1014).

| Ground | '757 Patent Claim(s) | Type of Challenge | Primary Reference | Secondary Reference(s)                 |
|--------|----------------------|-------------------|-------------------|----------------------------------------|
| 1      | 1-8, 10-11           | § 103             | Chinn             | (1) Takahashi;<br>(2) EX-V7            |
| 2      | 9                    | § 103             | Chinn             | (1) Takahashi;<br>(2) EX-V7<br>(3) Kim |
| 3      | 1-3, 7-10            | § 103             | Kim               | (1) Yamamoto<br>(2) Thorn              |
| 4      | 4-6, 11              | § 103             | Kim               | (1) Yamamoto<br>(2) Thorn<br>(3) Chinn |

**1. Chinn (Ex. 1004)**

Chinn, titled "Ready Click Camera Control," is an abandoned patent application that published on September 4, 2014 based on a March 4, 2013 filing date. Chinn describes technologies relating to "ready click" camera control. Chinn discloses technologies relating to "ready click" camera control. Camera devices may be equipped with a camera, a microphone, a processor, a memory, and a camera control system stored in the memory and executable by the processor. The camera control system may be configured to provide any of a variety of voice-interactive features, such as a voice-activated shutter, a voice-activated timer, a voice-activated flash, a voice-activated focus setting, a voice-activated ISO setting, a voice-activated scene setting, and/or a variety of other features, including both voice-interactive as well as other features described herein. Ex. 1004, Abstract.

**2. Takahashi (Ex. 1005)**

Takahashi, titled "Image Capturing Device," is a Japanese Unexamined Patent Application Publication published on November 2, 2001. Takahashi discloses a one-camera system for taking photographs using voice audio input in cases where the photographer is the subject. Takahashi describes a voice audio registration mode that is set using a mode dial 20, and a first voice audio pattern for shutter release that is registered in response to a voice audio input using a microphone 16. When the voice audio photography mode is set, a voice audio recognition process is performed on

voice audio input using the microphone 16, with focus adjustment being performed if voice audio corresponding to the first voice audio pattern is recognized, and shutter release control being performed after a prescribed amount of time has elapsed if voice audio corresponding to the second voice audio pattern is recognized. Ex. 1005, Abstract.

**3. *Kim (Ex. 1008)***

Kim, titled "Mobile Terminal and Method of Controlling Display Thereof," was published June 3, 2010 based on a filing date of April 9, 2009. Kim discloses a mobile terminal that includes a projector module projecting an image onto an external surface, a display having a touchscreen, and a controller configured to receive a control signal corresponding to a touch input received via the display, where the control signal is for adjusting at least a size or a position of an external display area formed on the external surface such that the external display area is adjusted based on a touch pattern of the touch input, to adjust the external display area in response to the control signal, and to control the projector module to project the image on the adjusted external display area, wherein a screen area set and positioned according to the touch input is displayed via the touchscreen and the external display area is adjusted according to a size and a position of the screen area. Ex. 1008. Abstract.

**4. Yamamoto (Ex. 1009)**

Yamamoto, titled "Information Processing Method, Information Processing Apparatus, and Computer-Readable Storage Medium," is a U.S. Patent Application filed on July 24, 2009 and published on February 4, 2010. Yamamoto discloses a method that includes detecting a start and an end of a first sound that satisfies a present standard, obtaining image data in response to detection of the start and end of the first sound, storing the obtained image data, and determining the image data to be data that is to be stored, in accordance with a content of the first sound. Ex. 1009, Abstract.

**5. Thorn (Ex. 1011)**

Thorn, titled "Camera System and Method for Operating a Camera System," was filed on January 2, 2008 and published on July 2, 2009. Thorn discloses a system and method for controlling a camera assembly that may include monitoring an image field for blinks by one or more subjects in the image field. The monitoring may be carried out by generating a video signal of the image field, the video signal having a sequence of frames; subtracting a previous frame of the video signal from a current frame of the video signal to generate a difference frame; and identifying image data in the difference frame that is representative of a blink. Each blink may be tracked and associated with a subject from the one or more subjects. Statistical data regarding blink duration and blink rate for each subject from the one or more subjects

may be generated. In response to user input to command the taking of a photograph, a determination if a blink is in progress may be made and a flash of the camera assembly may be fired and image data for the photograph may be captured if no blink is detected at the time of the command. Otherwise, firing of the flash and the capturing of the image data may be delayed by an amount of time that is based on the statistical data to minimize firing the flash and capturing the image data during a blink of the one or more subjects. Ex. 1011, Abstract.

**6. EX-V7 (Ex. 1014)**

EX-V7 is a digital camera user guide. EX-V7 discloses a one-camera system that includes a 2-second self-timer “to prevent blur due to hand movement.” Ex. 1014, at 77. Maxell reserves the right to argue the prior art status of EX-V7 in the event these proceedings are instituted.

**E. Claim Construction**

1. *“first camera arranged on a same side of the touch display” / “first camera being arranged on the same face side of a touch display”*
2. *“second camera arranged on an opposite side of the touch display” / “second camera being arranged on an opposite side of the touch display”*

The intrinsic evidence makes clear that no construction is necessary and that the plain and ordinary meaning of these claim terms is abundantly clear. Specifically, claim 1 of the '757 Patent recites “a first camera arranged on a same side of the touch

display” and “a second camera arranged on an opposite side of the touch display.” ’757 Patent, Claim 1. Further, Figs. 4(a) and 4(b) of ’757 Patent include drawings showing a first camera 123 arranged on a same side of touch display 141 and second camera 124 arranged on an opposite side of touch display 141. *Id.*, Figs. 4(a)-4(b). “[T]he specification ‘is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.’” *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (*quoting Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)). Here, both the claims and specification make clear that the plain and ordinary meaning is an arrangement of two cameras such that one camera is on a same side of the touch display and the second camera is arranged on an opposite side of the touch display. No further construction is necessary.

**F. Grounds 1-2 Fail Because Chinn, Takahashi, And EX-V7 Do Not Disclose Elements 1[i], 1[j], 11[d], 11[h]**

Grounds 1-2 fail because, even if POSITA would have been motivated to combine Chinn, Takahashi, and EX-V7, Petitioner has failed to show with particularity how such a combination would render obvious claim elements 1[i], 1[j], 11[d], and 11[h]. Because Claims 2-8 and 10 all depend from Claim 1, Petitioner has also not shown these dependent claims to be unpatentable. As such, Ground 1 fails. Ground 2 fails because it is directed solely to dependent Claim 9, which depends on

Claim 1 that Petitioner has failed to show is unpatentable. While Grounds 1 and 2 fail even if Chinn, Takahashi, and EX-V7 are combined, Maxell reserves the right to argue if this proceeding is instituted that POSITA would not be motivated to combine Chinn, Takahashi, and EX-V7.

**1. *Chinn, Takahashi, and EX-V7 Do Not Render Obvious Claim Element 1[i]***

Claim 1[i] recites “control such that a first standby time of a case where the first camera is enabled and the second camera is disabled is longer than a second standby time of a case where the second camera is enabled and the first camera is disabled.” For this limitation, Petitioner relies nearly entirely on its expert to fill in the gaps of its three-reference combination. In reality, none of Chinn, Takahashi, or EX-V7 disclose element 1[i], and even Petitioner's expert's pronouncements of what POSITA would have understood cast serious doubt on the likelihood of success of this Ground. The Petition fails to show Chinn, Takahashi, or EX-V7 disclose element 1[i] in at least two respects.

First, Petitioner separates out the features of this claim element into two sections, (1) Enabled/Disabled First/Second Camera and (2) First Standby Time > Second Standby Time. Pet. at 29-30. In doing so, Petitioner glosses over the requirements of the claim element. For example, the first standby time and the first camera enabled are interrelated. In other words the first standby time must be

implemented while recording an image using the enabled first camera. Ex. 1001, Claim 1. Yet, Petitioner never shows if the alleged prior art combination ties the alleged first standby time with the first camera being enabled with reference to specific evidence. Instead, Petitioner points to a 10-second timer in Chinn as the first standby time. Pet. at 30. In Chinn, it is only after expiration of the 10-second timer that the front camera is enabled: “For example, in response to a ‘set timer: 10 seconds’ command, camera control system 175 may output an audible notification by speaker 140 such as ‘timer set’, and camera control system 175 may then proceed to output an audible **countdown to camera activation.**” Ex. 1004, ¶27 (emphasis added).

In other words, in Chinn it is not until *after* the 10-second timer that the camera is enabled and thus Petitioner has not shown that the claim language “a first standby time of a case where the first camera is enabled” is met. This is confirmed where Chinn further discloses that “[t]he camera control system 175 may be configured **to activate the camera** 125 to take a photograph or begin recording a video **in response to the words** ‘ready click’.” Ex. 1004, ¶23 (emphasis added). Thus, Chinn discloses two separate voice instructions for two separate tasks. Chinn discloses “activating” the camera in response to “ready click,” and separately setting a timer in response to the voice command “set timer.” Ex. 1004, ¶27.

This separation of tasks is also disclosed in Chinn at ¶25:

For example, after user activation of the listening initiation control 231, camera control system 175 may respond to the predetermined camera activation sound pattern **by activating the camera 125 as described above** [in paragraph 23 referring to “ready click”], and camera control system 175 may respond to any of a variety of **other voice commands**, Such as a “**set timer**” command, a “set flash” command, a “set focus” command, a “set ISO or “set speed” command, and/or a “set scene” command.

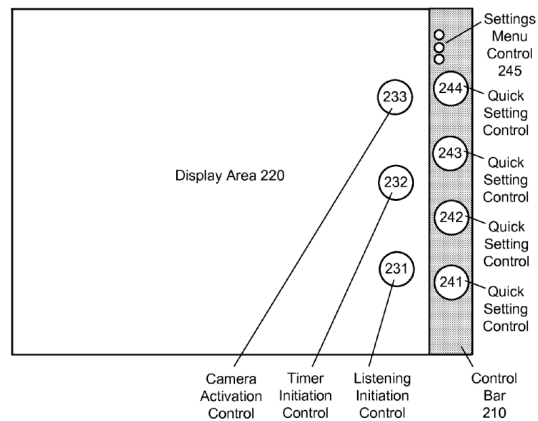
Ex. 1004, ¶25 (emphasis added).

The same separation of instructions to set timer versus to capture a picture is also disclosed in paragraph [0039] of Chinn:

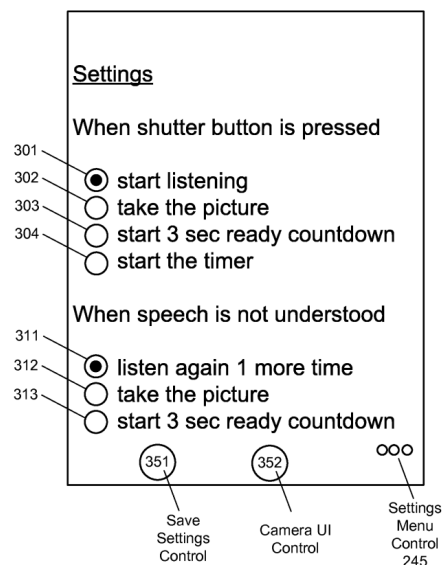
When the “start 3 sec ready countdown” control 303 is selected, the camera control system 175 may modify its response to user selection of shutter control 233, so that camera control system 175 starts a countdown (such as a three second countdown or any other countdown duration) and **then takes** a picture/initiates video recording **in response to user selection** of shutter control 233.

Ex. 1004, ¶39 (emphasis added).

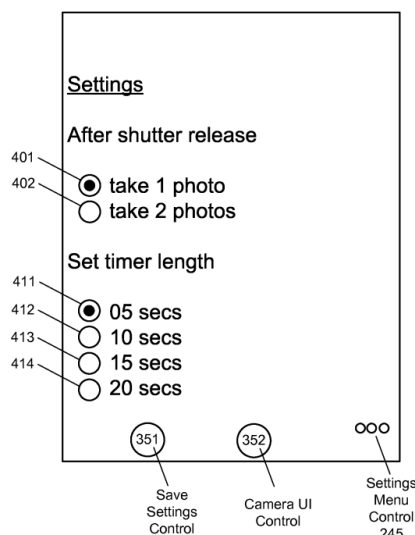
In fact, Chinn has designed a system with specific user interfaces and settings screen that emphasize this two-step two-instruction process that requires a separation between setting a timer and activating a camera:



Ex. 1004, Fig. 2 (showing UI 200 having “Camera Activation Control” setting 233 different from “Timer Initiation Control” setting);



Ex. 1004, Fig. 3 (showing UI 300 having “take the picture” setting 302 different from “start 3 sec ready countdown” setting 303 and “start the timer” setting 304);



Ex. 1004, Fig. 4 (showing UI 400 having “take [1/2] photo[s]” settings 401 and 402 different from “Start timer length” settings 411, 412, 413, and 414).

Thus, Chinn repeatedly discloses requiring the input of two different and separate instructions to set a timer and then to activate a camera, if desired by the user. Therefore, Chinn cannot disclose the relationship between two standby times because the claimed standby times are linked to the enabling and disabling of two separate cameras. In contrast, the activation of a camera in Chinn is based on when a user provides a second instruction of activating a camera and it has no relationship to enabling a first camera and disabling a second camera.

In fact, there is no disclosure in Chinn of disabling a “second camera” and disabling a “first camera,” and associating such disabling to first and second standby times. Instead, Petitioner simply relies on a hindsight driven analysis to argue obviousness when, in contrast, Chinn clearly discloses a multiple-voice instruction

system that requires two instructions: a first instruction to set a timer; and then after the timer is expired, a second instruction to activate the camera.

Neither Petitioner nor its expert provide any analysis on why a POSITA would be motivated to change Chinn's multiple-voice instruction and two-step process to a single instruction process when Chinn provides its own solution that repeatedly emphasizes a separation of tasks and voice instructions. Moreover, neither Petitioner nor its expert provide any rationale on why a POSITA would be motivated to redesign OS 171, Camera Control System 175, and User Interfaces 200, 300, and 400 of Chinn to arrive at the claimed invention when Chinn has its own solution of providing a timer and then subsequent activation of the camera based on a separate instruction. In short, modifying Chinn to arrive at the claimed invention would require a complete redesign of Chinn's system, and there is no rationale to do so beyond the hindsight driven analysis set forth by Petitioner. A proper obviousness analysis demands more than the vague, unsupported statements that Petitioner offers here. See *Unigene Labs. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011); *Guangdong Alison Hi-Tech v. Aspen Aerogels*, Case IPR2017-00152, Paper 8 at 16. Instead of providing any "rational underpinning" to support its asserted obviousness grounds, Petitioner offers only "conclusory assertions." See *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

Moreover, Petitioner's hindsight driven analysis does not stop here. Petitioner in fact concedes that Chinn does not disclose disabling of any camera and linking the disabling of the camera to a standby time by taking a logical leap and stating that "[a] POSITA would have also understood that because only the front camera 110 is activated, the back camera 125 (i.e., second camera) would remain disabled." Pet. at 29 (citing Ex. 1003, ¶100). Petitioner relies solely on the *ipse dixit* of its expert, with no reference to Chinn, Takahashi, EX-V7, or the intrinsic record. Yet, such a broad statement is undermined by the specification of the '757 Patent which specifically provides an example in Figure 12 of "a screen on which two camera videos are composed and displayed. In this case, both the first imaging unit 123 (in camera) and the second imaging unit 124 (out camera) **are simultaneously enabled**, and two units of video are input." Ex. 1001, 13:32-36 (emphasis added). As such, in light of the intrinsic record, and contrary to the conclusory statements of Petitioner's expert, it is clear that a POSITA would not necessarily have understood that "because only the front camera 110 is activated, the back camera 125 (i.e., second camera) would remain disabled." Similarly, the camera of Chinn may very well remain enabled or may never have been enabled in the first place to then have a change of state to "disabled" "such that a first standby time of a case where the first camera is enabled and the **second camera is disabled** is longer than a second standby time of a case where the second camera is enabled and the **first camera is disabled**," as recited by

claim 1. The Petition provides no evidence in the disclosure of Chinn that supports the conclusory statements of Petitioner requiring the change in state of cameras and associating such changes of states to standby times. Thus, Petitioner has not shown that claim element 1[i] is rendered obvious for this additional reason.

**2. *Chinn, Takahashi, and Ex-V7 Do Not Render Obvious Claim Elements 1[g] and 1[j]***

Claim 1[g] recites “control such that, when the audio input interface receives the command voice giving **a first instruction** to start a recording of an image signal, the recorder **starts a recording** of the first image signal acquired by the first camera on the storage **in response to the first instruction** and claim 1[j] recites “wherein the **first standby time** is a time from a recognition of **the first instruction** to a start of the recording of the first image signal acquired by the first camera, and the second standby time is a time from a recognition of the second instruction to a start of the recording of the second image signal acquired by the second camera.” Thus, the antecedent basis in claim 1 dictates that Chinn record the first image signal acquired by a first camera in response to the same first instruction that also starts the first standby time “wherein the first standby time is a time from a recognition of the first instruction to a start of the recording of the first image signal acquired by the first camera.”

Petitioner, however, gives short shrift to this antecedent basis when discussing claim element 1[j], with an entirely conclusory statement: “The Chinn-Takahashi-EX-V7 combination renders this limitation obvious. *See* §§VI.B.10, VI.A; EX1003, ¶103.” Pet. at 31. Petitioner relies *entirely* on its analysis of claim element 1[i], and it fails to show the cited prior art renders this element obvious for at least the reasons above with respect to claim element 1[i]. As such, Petitioner has not met its burden in showing the Chinn-Takahashi-EX-V7 combination renders claim element 1[j] obvious.

Nevertheless, there are additional reasons why this claim element is not obvious over the Chinn-Takahashi-EX-V7 combination. Petitioner fails to meet its burden in showing the “first standby time is a time from a recognition of the first instruction to a start of the recording of the first image signal” and the “second standby time is a time from a recognition of the second instruction to a start of the recording of the second image signal.” For example, as discussed above with respect to claim element 1[i], Chinn explicitly discloses providing separate instructions for setting a timer, activating a camera, and taking a picture. *See* Ex. 1004, at Fig. 3 (showing UI 300 having “take the picture” setting 302 different from “start 3 sec ready countdown” setting 303 and “start the timer” setting 304); *id.* at Fig. 4 (showing UI 400 having “take [1/2] photo[s]” settings 401 and 402 different from “Start timer length” settings 411, 412, 413, and 414). Thus, Chinn cannot disclose

the claimed “first instruction” that is required by claim elements 1[g] and 1[j] because even if an instruction of setting a timer begins a standby time in Chinn, Chinn does not disclose starting “a recording of the first image signal . . . on the storage in response to the first instruction.” Chinn requires a second separate instruction to activate a camera, let alone begin recording of an image signal by the camera. *Id.*

Nowhere in the discussion of the purported standby times in the Chinn-Takahashi-EX-V7 combination does Petitioner account for such disclosures in Chinn and why a POSITA would be motivated to completely redesign Chinn's multi-instruction and separate instruction system to arrive at the claimed “first instruction.” Thus, Petitioner has not met its burden to show that claim elements 1[g] and 1[j] are met by the Chinn-Takahashi-EX-V7 combination.

**3. *Chinn, Takahashi, and Ex-V7 Do Not Render Obvious Claim Elements 11[d] and 11[h]***

Claim element 11[d] recites “performing a first standby process during a first predetermined time when the command voice includes the first instruction and when the first camera is enabled and the second camera is disabled.” Claim element 11[h] recites “performing a second standby process during a second predetermined time when the command voice includes the second instruction and when the second camera is enabled and the first camera is disabled.”

Petitioner refers back to §VI.B.10 (element 1[i]) for its analysis for these two elements. For the reasons expressed above with respect to elements 1[i] and 1[j], Petitioner has not met its burden to show a likelihood of success that elements 11[d] and 11[h] are rendered unpatentable the Chinn-Takahashi-EX-V7 combination.

**4. *Chinn, Takahashi, and Ex-V7 Do Not Render Obvious Claims 2-8, and 9-10.***

Claims 2-8 and 9-10 all depend from independent claims for which Petitioner has failed to show that the Chinn-Takahashi-EX-V7 combination renders the independent claims unpatentable. Thus, for the same reasons, Claims 2-8 and 9-10 are not rendered unpatentable by the Chinn-Takahashi-EX-V7 combination.

**G. *Ground 3 Fails Because Kim, Yamamoto, and Thorn Do Not Disclose Elements 1[i], 1[j], 11[d], and 11[h]***

Ground 3 fails because, even if POSITA would have been motivated to combine Kim, Yamamoto, and Thorn, Petitioner has failed to show with particularity how such a combination would render obvious elements 1[i], 1[j], 11[d], and 11[h]. As such, Petitioner has failed to demonstrate a likelihood of success for Ground 3. While Ground 3 fails even if Kim, Yamamoto, and Thorn are combined, Maxell reserves the right to argue if this proceeding is instituted that POSITA would not be motivated to combine Kim, Yamamoto, and Thorn.

**1. *Kim, Yamamoto, and Thorn Do Not Render Obvious Claim Element 1[i]***

Claim 1[i] recites “control such that a first standby time of a case where the first camera is enabled and the second camera is disabled is longer than a second standby time of a case where the second camera is enabled and the first camera is disabled.” For this limitation, Petitioner relies on its expert declaration, rather than the references themselves because none of Kim, Yamamoto, or Thorn disclose element 1[i]. Petitioner's reliance on expert pronouncements of what POSITA would have understood cast serious doubt on the likelihood of success of this Ground.

Again, Petitioner separates out the features of this claim element into two sections, (1) Enabled/Disabled First/Second Camera and (2) First Standby Time > Second Standby Time. Pet. at 75-76. By doing so, Petitioner attempts to hide the absence of disclosure across the three prior art references directed to the interrelated nature of the first standby time with the first camera and the second standby time with the second camera. But Petitioner cannot show that the alleged prior art combination ties the alleged first standby time with the first camera being enabled with reference to specific evidence.

Instead, Petitioner points to Yamamoto's disclosure of a “certain amount of time” following a voice command of “Say Cheese” as a first standby time. Pet at 76. However, this alleged first standby time is dependent upon the input method *alone*,

independent of any enabled/disabled status of the first camera or the second camera because Yamamoto does not disclose multiple cameras. The claim language clearly links the first standby time with the “case where the first camera is enabled **and** the second camera is disabled.” Nor does Kim disclose disabling a “second camera” or disabling a “first camera,” and associating such disabling to first and second standby times. Accordingly, the Petition's mere identification of a “certain amount of time” is deficient.

Furthermore, beyond identifying the insufficient disclosure of Yamamoto (discussed above), Petitioner also fails to explain **how** the “certain period of time” of Yamamoto would be combined with Kim. *Lowe's Home Centers, LLC v. Epistar Corp.*, IPR2018-00932, Paper 7 at 19 (PTAB Nov. 1, 2018) (citing *TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1066 (Fed. Cir. 2016)) (“It is Petitioner's burden to explain **specifically** how the references would be combined to produce the claimed invention.” (emphasis added)). Neither Petitioner nor its expert provide any analysis on why a POSITA would be motivated to combine Yamamoto's delay for a single camera device with the multiple camera device of Kim. Specifically, where Yamamoto only discloses a single camera facing away from a user (*i.e.*, a second camera) the Petitioner fails to explain how a POSITA would be motivated to combine the standby time of Yamamoto with the dual camera system in Kim, lacking any sort of voice activated image capture or corresponding standby time.

Moreover, Petitioner relies solely on hindsight and the knowledge of a POSITA to show that a “POSITA would have understood the need to activate the front camera means that it was previously inactive/disabled” and that “because only the front camera is activated, the back camera [] would remain disabled.” Pet. at 75 (citing Ex. 1003, ¶201). However, as with Grounds 1 and 2, Petitioner’s conclusion is contradicted by the specification of the ’757 Patent which specifically discloses an example in Figure 12 describing “a screen on which two camera videos are composed and displayed. In this case, both the first imaging unit 123 (in camera) and the second imaging unit 124 (out camera) **are simultaneously enabled**, and two units of video are input.” Ex. 1001, 13:32-36 (emphasis added). As such, in light of the intrinsic record, it is clear that a POSITA would not automatically have understood that “because only the front camera is activated, the back camera (i.e., second camera) would remain disabled.” Thus, Petitioner has not shown through its evidence a scenario where the first camera is enabled while the second camera is disabled.

**2. *Kim, Yamamoto, and Thorn Do Not Render Obvious Claim Element 1[j]***

Claim 1[j] recites “wherein the first standby time is a time from a recognition of the first instruction to a start of the recording of the first image signal acquired by the first camera, and the second standby time is a time from a recognition of the

second instruction to a start of the recording of the second image signal acquired by the second camera.” Petitioner summarily dismisses this claim element: “The Kim-Yamamoto-Thorn combination renders this limitation obvious for reasons set forth for limitation [1j]; See §§VIII.B.8, VIII.B.10; EX1003, ¶210.” Pet. at 79. Petitioner relies entirely on its flawed analysis of claim element 1[i], and it fails to show the cited prior art renders this element obvious for at least the reasons above with respect to claim element 1[i]. As such, Petitioner has not met its burden in showing the Kim-Yamamoto-Thorn combination renders claim element 1[j] obvious.

Furthermore, there are separate reasons why this claim element is not rendered obvious over the Kim-Yamamoto-Thorn combination. For example, Petitioner does not identify a standby time in any of Kim, Yamamoto, or Thorn that renders obvious the first standby time set forth in element 1[j]. Petitioner relies on “a certain period of time (for example, 0.5 seconds).” Pet. At 76 (citing Ex. 1009, ¶249). However, in the context of Yamamoto the “certain amount of time” describes the time “after, in general, ‘Say Cheese’ or the like has *uttered*” to when the image has been captured. Ex. 1009, ¶249 (emphasis added); *see also id.* ¶44 (““detecting the end of utterance’ means detecting the audio signal satisfied the end condition”). Yamamoto (and Petitioner) fails to explain or distinguish between times allotted for a trigger recognizing process, a waiting process, and a recording process. *See, e.g.*, Ex. 1009, Fig. 9. Instead, the “certain amount of time” measures from the end of an utterance

(*e.g.*, “Say Cheese”) to the end of the image capture process. *Id.*, ¶¶249-250.

The end of an utterance described in Yamamoto is not the claimed “recognition of the first instruction.” The processing time for recognition of an instruction happens after and *separately* from detecting the end of an utterance. *See, e.g.*, Ex. 1009, ¶55 (“The recognition result processing unit 108 obtains a recognition result output by the speech recognition unit 107 and determines control corresponding to the command...”); *see also id.*, ¶¶37, 44, 47, 55, 245; Ex. 1001, 9:48-55 (identifying separate “input of a voice command,” “trigger recognition process,” “standby process,” and “recording process”). Yamamoto’s failure to distinguish these processing times demonstrates that it does not disclose the claimed first standby time.

Further, the alleged first standby time includes the time for capturing an image. However, the claim language explicitly excludes the capture time from the standby time: “the first standby time is a time from a recognition of the first instruction to a *start* of the recording of the first image signal.” Therefore, the “certain amount of time” mentioned in Yamamoto cannot be the claimed “first standby time” and Petitioner does not rely on Kim or Thorn to overcome this deficiency.

Accordingly, Petitioner has not met its burden to show that this element is disclosed by the purported Kim-Yamamoto-Thorn combination.

**3. *Kim, Yamamoto, and Thorn Do Not Render Obvious Claims 2-3, and 7-10.***

Claims 2-3 and 7-10 all depend from independent claims for which Petitioner has failed to show that the Kim-Yamamoto-Thorn combination renders the independent claims unpatentable. Thus, for the same reasons, Claims 2-3 and 7-10 are not rendered unpatentable by the Kim-Yamamoto-Thorn.

**H. *Ground 4 Fails Because Kim, Yamamoto, Thorn, and Chinn Do Not Disclose Elements 11[d] and 11[h]***

In Ground 4, Petitioner adds a fourth reference, Chinn, and refers back to the earlier flawed analysis offered in Grounds 1 and 2. Accordingly, Ground 4 falls short of demonstrating that the Kim-Yamamoto-Thorn-Chinn would render obvious claims 4-6 and 11 for the same reasons discussed above.

For the reasons further set below, Ground 4 additionally fails to show a likelihood of success in showing that Kim-Yamamoto-Thorn-Chinn renders Claim 11 unpatentable. Additionally, while Ground 4 fails even if Kim, Yamamoto, Thorn, and Chinn are combined, Maxell reserves the right to argue if this proceeding is instituted that POSITA would not be motivated to combine Kim, Yamamoto, Thorn, and Chinn.

**1. *Kim, Yamamoto, Thorn, and Chinn Do Not Render Obvious Claim Elements 11[d] and 11[h]***

Claim element 11[d] recites “performing a first standby process during a first

predetermined time when the command voice includes the first instruction and when the first camera is enabled and the second camera is disabled.” Claim element 11[h] recites “performing a second standby process during a second predetermined time when the command voice includes the second instruction and when the second camera is enabled and the first camera is disabled.”

Petitioner refers back to §VIII.B.10 (element 1[i] in Ground 3) for its analysis for these two elements. For the reasons expressed above with respect to elements 1[i] and 1[j], Petitioner has not met its burden to show a likelihood of success that elements 11[d] and 11[h] are rendered unpatentable the Kim-Yamamoto-Thorn-Chinn combination.

#### **IV. CONCLUSION**

For at least the foregoing reasons, the Board should deny institution of the Petition.

Dated: August 12, 2024

Respectfully submitted,

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Patent No. 11,223,757  
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**CERTIFICATE OF SERVICE**

I hereby certify that on this 12th day of August, 2024, a copy of the attached PATENT OWNER PRELIMINARY RESPONSE TO PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 11,223,757, together with all exhibits was served by electronic mail to the attorneys of record, at the following addresses:

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Respectfully submitted,

Date: August 12, 2024

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**CERTIFICATION PURSUANT TO 37 C.F.R. § 42.24(d)**

Pursuant 37 CFR 42.24(d), the undersigned certifies that this Preliminary Response and complies with the type-volume limitation of 37 CFR §42.24(a). The word count application of the word processing program used to prepare this Preliminary Response indicates that the Preliminary Response contains 8,086 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

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