

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

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

Petitioners,

v.

MAXELL, LTD.,
Patent Owner

Case: IPR2024-00717

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

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

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

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	BACKGROUND AND SCOPE OF THE PROCEEDING	1
A.	U.S Patent No. 11,223,757	1
B.	'757 Patent Family Prosecution History	4
C.	Person Of Ordinary Skill In The Art.....	5
D.	Cited References.....	5
E.	Instituted Grounds	5
III.	CLAIM CONSTRUCTION	6
A.	“first camera arranged on a same side of the touch display” / “first camera being arranged on the same face side of a touch display” and “second camera arranged on an opposite side of the touch display” / “second camera being arranged on an opposite side of the touch display”	6
B.	District Court Proceeding.....	7
IV.	GROUND 1: PETITIONERS HAVE FAILED TO ESTABLISH THAT CLAIMS 1-8 AND 10-11 ARE RENDERED OBVIOUS BY THE COMBIANTION OF CHINN, TAKAHASHI, AND EX-V7	8
A.	The Combination of Chinn, Takahashi, and EX-V7 Fails to Render Obvious Claim Element [1.i].....	8
1.	Chinn does not disclose a voice command for enabling the first camera and disabling the second camera	9
2.	There is no motivation to combine Chinn, Takahashi, and EX-V7	13
3.	Chinn does not disclose the first camera being enabled and the second camera being disabled.....	15
4.	Chinn does not disclose enabling the second camera and disabling the first camera	19
5.	Chinn does not disclose a first standby time that is longer than a second standby time	19
B.	Chinn, Takahashi, and EX-V7 Do Not Render Obvious Claim Elements [1.g] and [1.j].....	22

C.	Chinn, Takahashi, and EX-V7 Do Not Render Obvious Claim Elements [11.d] and [11.h].....	25
D.	Chinn, Takahashi, and EX-V7 Do Not Render Obvious Claims 2-8, and 10.....	25
V.	GROUND 2: PETITIONERS HAVE FAILED TO ESTABLISH THAT CLAIM 9 IS RENDERED OBVIOUS BY THE COMBINATION OF CHINN, TAKAHASHI, EX-V7, AND KIM	26
VI.	GROUND 3: PETITIONERS HAVE FAILED TO ESTABLISH THAT CLAIMS 1-3 AND 7-10 ARE RENDERED OBVIOUS BY THE COMBINATIONS OF KIM, YAMAMOTO, AND THORN	26
A.	Kim, Yamamoto, and Thorn Do Not Render Obvious Claim Element [1.i].....	26
1.	The Kim-Yamamoto-Thorn combination does not disclose a command voice for enabling the first camera and disabling the second camera.....	27
2.	The Kim-Yamamoto-Thorn combination does not disclose the first camera being enabled and the second camera being disabled.....	30
3.	The Kim-Yamamoto-Thorn combination does not disclose enabling the second camera and disabling the first camera	32
4.	The Kim-Yamamoto-Thorn combination does not disclose a first standby time that is longer than a second standby time	32
5.	There is no motivation to combine Kim, Yamamoto, and Thorn.....	35
B.	Kim, Yamamoto, and Thorn Do Not Render Obvious Claim Element [1.j].....	36
C.	Kim, Yamamoto, and Thorn Do Not Render Obvious Claims 2-3, and 7-10.....	39
VII.	GROUND 4: THE COMBINATION OF KIM, YAMAMOTO, THORN, AND CHINN DOES NOT DISCLOSE CLAIMS 4-6 AND 11	39
A.	Kim, Yamamoto, Thorn, and Chinn Do Not Render Obvious Claim Elements [11.d] and [11.h].....	39

VIII. PETITIONERS FAIL TO ALLEGE THAT ITS REFERENCES ARE ANALOGOUS ART	40
IX. CONCLUSION.....	41

PATENT OWNER'S EXHIBIT LIST

Description	Exhibit #
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
Declaration of Dr. Jacob O. Wobbrock	2005
Claim Construction Order (EDTX)	2006
Deposition of R. Michael Guidash (February 17, 2025)	2007

I. INTRODUCTION

Patent Owner Maxell, Ltd. (“Patent Owner”) respectfully requests that the Board confirm the patentability of claims 1-11 (“challenged claims”) of U.S. Patent No. 11,223,757 (“the ’757 Patent”) (EX1001). Petitioners have failed to show by a preponderance of the evidence that the challenged claims are unpatentable. The scope of the claims of the ’757 Patent include inventive and novel features glaringly absent from Petitioners’ combination of the prior art. In light of these absent features in the prior art, Petitioners resort to hindsight to try and disguise the separation between the prior art and the challenged claims. However, as demonstrated herein, careful analysis of the ’757 Patent and the Petition illustrates that Petitioners have failed to carry their burden and that Claims 1-11 are patentable.

II. BACKGROUND AND SCOPE OF THE PROCEEDING

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

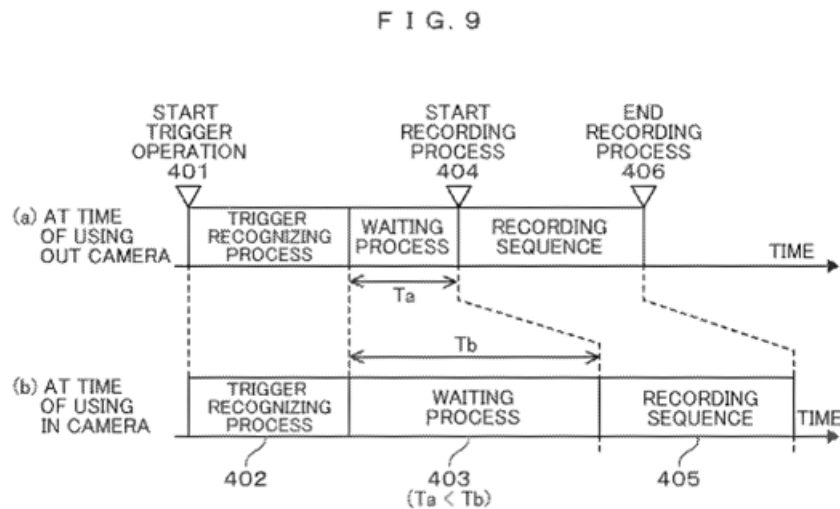
The ’757 Patent is directed to an image recording device configured to execute a plurality of different photographing processes using multiple cameras and a touch interface. Specifically, the ’757 Patent discloses an apparatus with an “audio input interface,” “a touch display,” “a first camera arranged 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. EX2005, ¶55.

More specifically, the '757 Patent illustrates a process of automatically switching between recording start delay times in accordance with which one of the two cameras is used. EX1001, 9:42-47; EX2005, ¶56. 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.

EX1001, 9:48-55.



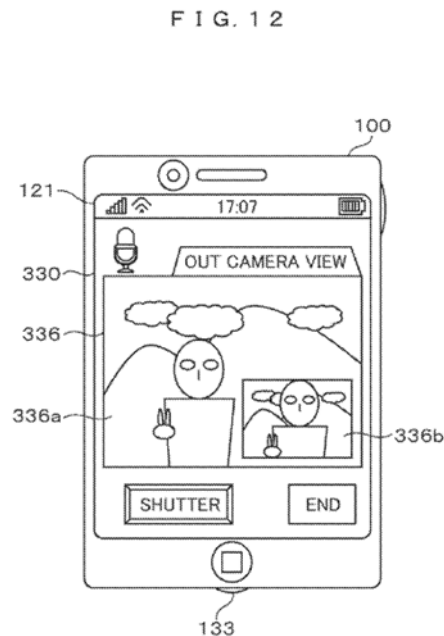
EX1001, FIG. 9.

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.

EX1001, 9:56-10:6.

This control sequence through the control unit can set a delay time until the 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. EX2005, ¶57. 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. EX1001 at 2:67-3:7; EX2005, ¶57

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



EX1001, 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. EX2005, ¶59.

C. Person Of Ordinary Skill In The Art

Patent Owner agrees with Petitioners 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. EX2005, ¶61.

D. Cited References

The Petition raises four grounds of alleged obviousness based on the following six references:

1. U.S. Patent Publication No. 2014/0247368 ("Chinn") (EX1004),
2. Translation of JP2001305642A ("Takahashi") (EX1005),
3. U.S. Patent Publication No. 2010/037026 ("Kim") (EX1008),
4. U.S. Patent Publication No. 2010/0026815 ("Yamamoto") (EX1009),
5. U.S. Patent Publication No. 2009/0167881 ("Thorn") (EX1011), and
6. Casio Exilim EX-V7 Users Guide ("EX-V7") (EX1014).

E. Instituted Grounds

The Board instituted Review on four grounds:

Ground	'757 Patent Claim(s)	Type of Challenge	Primary Reference	Secondary Reference(s)
1	1-8, 10-11	§ 103	Chinn	(1) Takahashi; (2) EX-V7
2	9	§ 103	Chinn	(1) Takahashi;

				(2) EX-V7 (3) Kim
3	1-3, 7-10	§ 103	Kim	(1) Yamamoto (2) Thorn
4	4-6, 11	§ 103	Kim	(1) Yamamoto (2) Thorn (3) Chinn

III. CLAIM CONSTRUCTION

A. “first camera arranged on a same side of the touch display” / “first camera being arranged on the same face side of a touch display” and “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 the same side as the touch display and the second camera is opposite to the touch display. No further construction is necessary. EX2005, ¶65.

B. District Court Proceeding

In the District Court Proceeding, Petitioners advanced a construction that the second camera limitation should be construed as “plain and ordinary meaning, which is that the first camera is located on a same side of the touch display.” EX2006 at 16. While the district court adopted Petitioners’ construction, it did so with the explanation that “the dispute is whether the recited arrangement contemplates the first and second cameras begin located together on the same side of the recording device.” *Id.* at 17. The claim construction order confirmed that the plain and ordinary meaning includes a front and rear camera as shown in Figs 4a and 4b of the ’757 Patent. *See id.* at 18. In addition, intrinsic evidence in the ’757 Patent’s specification makes this arrangement clear. *See, e.g.*, EX1001, Abstract, 2:3-15, 2:56-59, 7:56-60; *see also* EX2005, ¶66. Accordingly, Patent Owner maintains that the plain and ordinary meaning is an arrangement of two cameras such that one camera is on the same side of the device as the touch display and the second camera is on the opposite side of the device as the touch display. EX2005, ¶66. No further construction is necessary.

To the extent that Petitioners argue that the district court's construction requires an arrangement of two cameras such that one camera is on one side of the touch display and the second camera is on an opposite side of the touch display, Patent Owner submits that the Petition provides no evidence of such an arrangement in the prior art. Accordingly, any such arguments would undermine the entire Petition and common sense. EX2005, ¶67.

IV. GROUND 1: PETITIONERS HAVE FAILED TO ESTABLISH THAT CLAIMS 1-8 AND 10-11 ARE RENDERED OBVIOUS BY THE COMBIANTION OF CHINN, TAKAHASHI, AND EX-V7

Petitioners have failed to show by a preponderance of the evidence that Chinn in view of Takahashi and EX-V7 teaches each and every element of claims 1-8 and 10-11. Specifically, Chinn in combination with Takahashi and EX-V7 does not teach elements [1.i], [1.g], [1.j], [11.d], and [11.h]. EX2005, ¶75.

A. The Combination of Chinn, Takahashi, and EX-V7 Fails to Render Obvious Claim Element [1.i]

Petitioners fails to show that the Chinn-Takahashi-EX-V7 combination discloses or renders obvious claim element [1.i], which 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.” EX2005, ¶76. For this limitation, Petitioners rely nearly entirely on their expert to fill in the gaps of their three-

reference combination. In reality, none of Chinn, Takahashi, or EX-V7 disclose element [1.i]. Petitioners' expert's pronouncements of what a POSITA would have understood fail to carry Petitioners' burden of showing that claim element [1.i] is unpatentable by a preponderance of the evidence. The Petition fails to show Chinn, Takahashi, or EX-V7 disclose element [1.i] for several reasons.

1. *Chinn does not disclose a voice command for enabling the first camera and disabling the second camera*

First, Petitioners separate 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, Petitioners gloss over the requirements of the claim element. EX2005, ¶77. For example, the first standby time and the first camera enabled are interrelated. In other words, the first standby time must be implemented while starting to record an image using the enabled first camera. *Id.* Yet, Petitioners never show whether the alleged prior art combination ties the alleged first standby time with the first camera being enabled with reference to specific teaching in Chinn (Petitioners rely on Chinn alone for this element in Ground 1). *Id.*

To fully appreciate how Petitioners err in their analysis of claim 1, it is importance to trace how Claim 1 links various elements together. EX2005, ¶78. Claim 1 of the '757 Patent links the "command voice giving a first instruction"

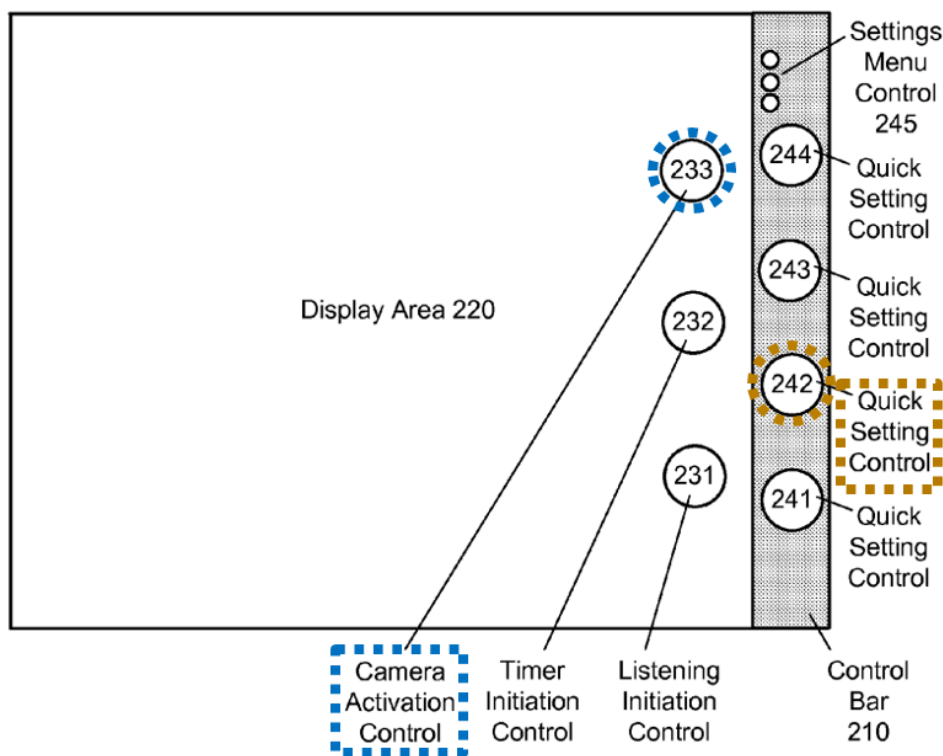
(element [1.g]) with the “first standby time” (element [1.i]) in element [1.j]: the first standby time, corresponding to a case where the first camera is enabled and the second camera is disabled, is a time from a recognition of the first instruction, which is given by the command voice, to a start of the recording of the first image signal acquired by the first camera. EX2005, ¶78. For example, claim element [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,” and that “the first standby time is a time **from a recognition of the first instruction**,” where the first instruction is “the command voice giving a first instruction.” See EX1001, claim 1; EX2005, ¶78. Thus, the first standby time is where **the** first camera is enabled and the first standby time is from a recognition of **the** first instruction, which is given by **the** command voice giving a first instruction. EX2005, ¶78. The claim provides clear antecedent basis and requires that the first camera is enabled and the second camera is disabled in response to the command voice. *Id.* Petitioners have simply ignored this antecedent basis and provided no evidence that Chinn discloses such a capability.

In contrast, Petitioners rely on a voice command for “set timer: 10 seconds” as the alleged command voice. Pet. at 30. However, the language of the claims is clear that the command voice gives “a first instruction to start a recording of an

image signal” and that “the recorder starts a recording of the first image signal acquired by the first camera on the storage in response to the first instruction.” EX1001, Claim [1.g]; EX2005, ¶79. Using a voice command to set a timer length does not meet the claim language of “a first instruction to start a recording of an image signal.” because Chinn’s “set timer” command does not start a recording of an image signal. *See* EX1004, ¶25; EX2005, ¶79. Accordingly, Petitioners have failed to show by a preponderance of evidence that Chinn alone or in combination with Takahashi or EX-V7 teaches at least element [1.i].

Similarly, Petitioners’ reliance on a user’s touch input “via the camera selection control 242” does not demonstrate an understanding of the claim scope. *Pet.* at 29, 30. As explained, claim 1 provides clear antecedent basis and requires that the first camera is enabled and the second camera is disabled in response to the command voice. EX2005, ¶¶79, 80. Petitioners, however, point to Chinn’s two-step combination of (1) a voice command for taking a picture (“voice-activated shutter”) and (2) manual selection of the camera “via the camera selection control 242.” *Pet.* at 29. Petitioners fail to address the plain reading of the claim and do not offer any opinions—grounded in Chinn or otherwise—for a single voice command that enables the first camera, disables the second camera, and initiates a first standby time preceding the capture of an image with the first camera. EX2005, ¶80.

In fact, Chinn has designed a system with specific user interfaces and a settings screen that emphasize this two-step, two-instruction process that requires a separation between selecting a front or rear camera (camera selection control 242) and capturing an image with the selected camera (camera activation control 233):



EX1004, Fig. 2 (showing UI 200 having “Camera Activation Control 233” different from “Quick Setting Control 242”); *see also* EX2005, ¶81.

Thus, Chinn discloses mixing two different input methods corresponding to separate instructions to select a camera and only then capturing an image with that camera, if desired by the user. EX2005, ¶82. Therefore, Chinn cannot disclose a voice command for enabling the first camera and disabling the second camera where

it exclusively discloses a touch input for such an instruction (in addition, as will be further explained below, Chinn does not disclose disabling). *Id.* In contrast, Chinn requires a touch input to enable the first camera or second camera. *See* EX1004, ¶22.

Where the Petition relies almost entirely on the knowledge of a POSITA for element [1.i], the Board's decision to institute relies on evidence beyond that presented by the Petitioners. For example, in presenting their case against "Enabled/Disabled /First/Second Camera," Petitioners fail to cite directly to Chinn (or any other reference). *See* Pet. at 29-30. Whereas the ID independently includes an explanation from paragraphs 38 and 39 in Chinn as support for the same limitation. ID. at 38. However, this expansion upon the Petition demonstrates the Petition's inadequacy and Petitioners' failure to present in its case-in-chief by a preponderance of the evidence that Chinn discloses a voice command for enabling the first camera and disabling the second camera. *See Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) ("It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify 'with particularity' the 'evidence that supports the grounds for the challenge to each claim.'" (quoting 35 U.S.C. § 312(a)(3))).

2. *There is no motivation to combine Chinn, Takahashi, and EX-V7*

Neither Petitioners nor their expert provide any analysis on why a POSITA would be motivated to change Chinn's voice and touch instructions to a single voice

instruction process when Chinn provides its own solution that repeatedly emphasizes a separation of tasks and voice instructions. *See, e.g.*, EX1004, ¶¶23, 25; EX2005, ¶83. Moreover, neither Petitioners nor their expert provide any rationale as to 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 camera selection and then subsequent activation of the camera based on a separate instruction. *See, e.g.*, EX1004, ¶¶23, 25; EX2005, ¶83. In particular, Chinn describes a mobile device such as a smart phone with a front camera and a back camera in a single housing. *See* EX1004, ¶ 16. In comparison, Takahashi and EX-V7 describe digital cameras with a single image capture unit. *See* EX1005, ¶16; EX1014 at 11; EX2007 at 40:4-6, 46:23-25. Further, a POSITA would not look to the earlier single, standalone cameras of Takahashi (April 2000) or EX-V7 (May 2007) for improvements to the Chinn mobile device. EX2005, ¶83. Particularly where Chinn already describes “camera control systems that provide more power features, better user interactions and more user interaction options” than earlier devices, such as those described by Takahashi and EX-V7.

Additionally, 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 Petitioners. EX2005, ¶83. This hindsight driven analysis is particularly obvious where Petitioners cherry-pick

various elements from devices such as Takahashi and EX-V7 that pre-date the Chinn device by many years. EX2005, ¶83. A proper obviousness analysis demands more than the vague, unsupported statements that Petitioners offer here. *See Unigene Lab’ys, Inc. 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 (March 23, 2017). Instead of providing any “rational underpinning” to support their asserted obviousness grounds, Petitioners offer only “conclusory assertions.” *See In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

3. *Chinn does not disclose the first camera being enabled and the second camera being disabled*

Second, Petitioners have failed to demonstrate that the first instruction results in the first camera being enabled and the second camera being disabled. EX2005, ¶84. Acknowledging Chinn does not disclose this limitation, Petitioners rely on self-serving hindsight allegations that a “POSITA would have understood the need to activate the front camera 110 means that it was previously disabled.” Pet. at 29. However, the need to activate the front camera is set forth in the claims, not in Chinn. EX2005, ¶84. This lack of evidence is underscored by the lack of citation to Chinn (or any reference) in the Petition or Mr. Guidash’s Declaration (EX1003) supporting an enabled first camera **and** disabled second camera. *Id.* Instead, Petitioners rely on “user selection of the camera activation control 223” and “the need to activate the

back camera 125 means that it was previously disabled.” Pet. at 30. But, the claims cover “a case where the first camera is enabled and the second camera is disabled” that is triggered by the first instruction, which is the command voice. EX2005, ¶84. Then, the claims switch to cover “a case where the second camera is enabled and the first camera is disabled.” *Id.* In this case, the front camera was previously enabled and would therefore need to be disabled. *Id.* None of Petitioners, Mr. Guidash, or Chinn provide a disclosure of disabling a camera that was previously enabled.

Additionally, Petitioners’ allegation that a “POSITA would have also understood or at least found obvious that because *only* the back camera 125 is activated, the front camera 110 (i.e., first camera) remains disabled” is directly contradicted by both Chinn and the ’757 Patent. Pet. at 30 (emphasis added). Petitioners rely solely on the *ipse dixit* of their expert, with no reference to Chinn, Takahashi, EX-V7, or the intrinsic record to cure this deficiency. EX2005, ¶85. Yet, such a broad statement is undermined by Chinn’s own teaching (and Petitioners repeatedly cite (*see, e.g.*, Pet. at 16, 18, 24, 26 (n. 4))) that “camera control system 175 may be configured to activate the camera, **which may be either or both of camera 110 and/or camera 125.**” EX1004 at ¶ [0023] (emphasis added). Mr. Guidash acknowledged this teaching on cross-examination. EX2007 at 53:1-54:3.

As another example, the specification of the ’757 Patent undermines Petitioners’ assertions by specifically providing 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.” EX1001, 13:32-36; EX2005, ¶86. Again, on cross-examination Mr. Guidash acknowledged this teaching of the ’757 Patent. EX2007 at 32:4-12. As such, in light of the intrinsic record and Petitioners’ own references, a POSITA would not have understood that “because only the front camera 110 is activated, the back camera 125 (i.e., second camera) would remain disabled.” EX2005, ¶86. These explicit cases of simultaneous enablement not only undermine the assertions made by Petitioners, but also further highlight the hind-sight driven analysis upon which their assertions are based. *Id.*

Similarly, the camera of Chinn may either stay enabled or may never have been enabled initially, thus not requiring a change to a “disabled” state. This results in a scenario where limitation [1.i] is not met because neither camera in Chinn would change from an enabled state to a disabled state. EX2005, ¶86. Petitioners provide no evidence in the disclosure of Chinn that supports their conclusory statements requiring the change in state of cameras and associating such changes of states to standby times. *Id.* In fact, Mr. Guidash acknowledged on cross-examination that both Chinn’s cameras may be used to “enable and take images with both cameras simultaneously, so it could do either individually or together.” EX2007 at 53:1-54:3.

As an additional example of the self-serving nature of Petitioners' arguments, the unsupported statement (Pet. at 30) that the benefits of a camera remaining disabled "include reducing power consumption and increasing battery life" are incorrect. EX2005, ¶87. Such a statement is based on the assumption that a camera that is in an "inactive state" uses less power because it is powered off. *Id.* However, in modern mobile devices, including those around September 2013, it would be more efficient for battery life to keep both cameras powered on, and switch between an active and inactive state based on the user's selection. *Id.*

Petitioners' hindsight and unsupported reasoning cannot serve as a basis to find that this claim element is disclosed in Chinn or would be within the knowledge of a POSTIA. *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570 (Fed. Cir. 1996) ("To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction—an illogical and inappropriate process by which to determine patentability.") (*citing W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312–13 (Fed.Cir.1983)).

Accordingly, Petitioners have not shown by a preponderance of the evidence that the Chinn-Takahashi-EX-V7 combination renders obvious element [1.i].

4. *Chinn does not disclose enabling the second camera and disabling the first camera*

For similar reasons to those set forth above, Chinn does not disclose the “case where the second camera is enabled and the first camera is disabled. EX2005, ¶90. For example, Chinn does not disclose disabling any camera and Petitioners fail to demonstrate otherwise. *Id.* Accordingly, Petitioners have not shown by a preponderance of the evidence that the Chinn-Takahashi-EX-V7 combination renders obvious element [1.i].

5. *Chinn does not disclose a first standby time that is longer than a second standby time*

Petitioners rely on hindsight, scattered prior art combinations, and the user’s discretion to attempt to demonstrate a first standby time that is longer than a second standby time. Their attempts fall short. EX2005, ¶91.

Furthermore, Chinn’s disclosure in paragraph 40 is incomplete when compared with the claim language. See ID at 42 (citing EX1004 at ¶ 40). Where Chinn discloses that “in response to user selection of shutter control 233, camera control system 175 starts a timer and then takes a picture/initiates video recording after the time period specific for the timer elapses,” Chinn fails to describe the length of time for the timer. EX2005, ¶92. Instead, the length of time is left to the purview of the user. Petitioners allege that a “POSITA would have found it obvious, and would have been motivated, to set a longer delay for a front-camera selfie than for a

rear-camera, touch-initiated photograph” without proper support. Pet. at 12. Instead, Petitioners rely Takahashi’s single-camera system and “common sense.” *Id.* However, this is improper hindsight. EX2005, ¶92.

Claim 1 includes a “controller, wherein the controller is configured to: ... 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.” EX1001, Claim [1.i]. Contrary to the Petitioners’ arguments, the claims articulate that it is the controller that provides for the longer first standby time in comparison to the second standby time, not the user. EX2005, ¶93.

The “first standby time of a case where the first camera is enabled and the second camera is disabled” corresponds to “recording of the first image signal acquired by the first camera on the storage in response to the first instruction,” which is the voice command. EX1001, Claim [1.g]; EX2005, ¶94. Similarly, the “standby time of a case where the second camera is enabled and the first camera is disabled” corresponds to “recording of the second image signal acquired by the second camera on the storage in response to the second instruction,” which is a touch instruction. *Id.*, Claim [1.h]; EX2005, ¶94.

Accordingly, the controller controls the standby time based on the method of input (*i.e.*, voice or touch) and which camera is enabled (front or rear). *See* EX1001

at 6:42-45, 9:42-47, 12:12-19; EX2005, ¶95. Leaving such a determination to user, as Petitioners describe, ignores the advantages of the '757 Patent described therein. EX2005, ¶95. For example, the specification describes a “distinctive feature of this embodiment is a camera operation (recording start timing switching) performed by the camera function executing unit 104b, the voice recognition executing unit 104c, and the timing display executing unit 104d.” EX1001 at 6:42-45. As another example, “in accordance with the out camera or the in camera that is operated, a delay time until start of recording from timing at which the trigger is received is **automatically** switched over.” EX1001 at 12:12-19. This automatic switching that does not require user intervention is part of the inventiveness of the '757 Patent. EX2005, ¶95. Finally, Figure 9 illustrates “the process of controlling switching between delay times in accordance with which one of the two cameras is used.” EX1001 at 9:42-47.

Therefore, Chinn’s user-selected timers do not meet the claim limitation. EX2005, ¶96. Furthermore, Takahashi at best describes using a delay for voice-activated images in a single-camera system. See EX1005 at ¶41. Accordingly, Chinn in view of Takahashi fails to describe a controller that controls a standby time based on *both* input type *and* in accordance with which one of two cameras is used. EX2005, ¶96.

B. 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 records a 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.” EX2005, ¶97.

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. Petitioners rely *entirely* on their 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]. EX2005, ¶98. As such, Petitioners have not shown by a preponderance of the evidence that 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. Petitioners fail to meet their 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.” EX2005, ¶99. For example, as introduced above with respect to claim element [1.i], Chinn discloses providing separate instructions for setting a timer, activating a camera, and taking a picture. *See* EX1004, 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); EX2005, ¶99. 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,” because Chinn requires a second separate instruction to activate a camera, let alone begin recording

of an image signal by the camera. EX2005, ¶99.

Nowhere in their discussion of the purported standby times in the Chinn-Takahashi-EX-V7 combination do Petitioners 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." EX2005, ¶100.

As additional evidence that the Petition fails to identify the disclosure of the claimed "first instruction," the Board's institution decision relies on additional citations from Chinn that are not identified as supporting Petitioners' position of obviousness for this element. For example, the ID widens the reliance on Chinn, citing to paragraph 40, reinforcing the incorrect understanding that multiple camera activation controls can be mixed and matched to satisfy the claim elements. ID at 42. Moreover, this is done without addressing the arguments anchored in the antecedent basis provided in the claims. As such, Petitioners' failed to present in its case-in-chief by a preponderance of the evidence that Chinn discloses the claimed first instruction to start a recording of an image signal. *See Intelligent Bio-Sys.*, 821 F.3d at 1369.

Thus, Petitioners have not shown by a preponderance of the evidence that claim elements [1.g] and [1.j] are met by the Chinn-Takahashi-EX-V7 combination.

C. 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 touch operation instruction includes the second instruction and when the second camera is enabled and the first camera is disabled.”

Petitioners refer back to §VI.B.10 (element [1.i]) for their analysis of these two elements. For the reasons expressed above with respect to elements [1.i] and [1.j], Petitioners have not shown by a preponderance of the evidence that elements [11.d] and [11.h] are rendered unpatentable the Chinn-Takahashi-EX-V7 combination. EX2005, ¶103.

D. Chinn, Takahashi, and EX-V7 Do Not Render Obvious Claims 2-8, and 10.

Claims 2-8 and 10 all depend from independent claim 1, for which Petitioners have failed to show that the Chinn-Takahashi-EX-V7 combination renders the independent claim unpatentable. Thus, for the same reasons, Petitioners have failed to show by a preponderance of the evidence that claims 2-8 and 10 are rendered unpatentable by the Chinn-Takahashi-EX-V7 combination. EX2005, ¶104.

V. GROUND 2: PETITIONERS HAVE FAILED TO ESTABLISH THAT CLAIM 9 IS RENDERED OBVIOUS BY THE COMBINATION OF CHINN, TAKAHASHI, EX-V7, AND KIM

Ground 2 challenges claim 9, which depends from claim 1. Petitioners do not rely on the additional Kim reference to cure any of the deficiencies of the Chinn-Takahashi-EX-V7 combination with respect to claim 1. As such, due to at least the reasons set forth above with respect to Ground 1, Petitioners have similarly failed to establish that claim 9 is rendered obvious by the combination of Chinn, Takahashi, EX-V7, and Kim. EX2005, ¶105.

VI. GROUND 3: PETITIONERS HAVE FAILED TO ESTABLISH THAT CLAIMS 1-3 AND 7-10 ARE RENDERED OBVIOUS BY THE COMBINATIONS OF KIM, YAMAMOTO, AND THORN

Ground 3 fails because, even if POSITA would have been motivated to combine Kim, Yamamoto, and Thorn, Petitioners have failed to show with particularity how such a combination would render obvious elements [1.i], [1.j], [11.d], and [11.h]. EX2005, ¶106. As such, Petitioners have failed to demonstrate obviousness by a preponderance of the evidence.

A. 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, Petitioners rely on their expert declaration, rather than the references themselves because none of Kim, Yamamoto, or Thorn disclose element [1.i]. EX2005, ¶107. Petitioners’ reliance on expert pronouncements of what POSITA would have understood do not carry the burden of showing element [1.i] is unpatentable by a preponderance of the evidence. *Id.*

1. The Kim-Yamamoto-Thorn combination does not disclose a command voice for enabling the first camera and disabling the second camera

Again, Petitioners separate 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, Petitioners attempt 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. EX2005, ¶108. Petitioners 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. *Id.*

Claim 1 of the ’757 Patent links the “command voice giving a first instruction” (element [1.g]) with the “first standby time” (element [1.i]) in element [1.j]: the first standby time, corresponding to a case where the first camera is enabled and the second camera is disabled, is a time from a recognition of the first instruction, which is given by the command voice, to start a recording of the first image signal acquired

by the first camera. EX2005, ¶109. For example, the claim 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,” and that “the first standby time is a time **from a recognition of the first instruction**,” where the first instruction is “the command voice giving a first instruction.” See EX1001, claim 1. Thus, the first standby time is where **the** first camera is enabled and the first standby time is from a recognition of **the** first instruction, which is given by **the** command voice giving a first instruction. EX2005, ¶109. The claim provides clear antecedent basis and requires that the first camera is enabled and the second camera is disabled in response to the command voice. *Id.* Petitioners again ignore this antecedent basis and provided no evidence that the Kim-Yamamoto-Thorn combination discloses such a capability. *Id.*

Instead, Petitioners point 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. EX2005, ¶110. The claim language clearly links the first standby time with the “case where the first camera is enabled **and** the second camera is disabled.” *Id.* Nor does Kim disclose disabling a

“second camera” or disabling a “first camera,” and associating such disabling to first and second standby times. *Id.* Accordingly, the Petition’s mere identification of a “certain amount of time” is deficient. *Id.*

Furthermore, beyond identifying the inept disclosure of Yamamoto (discussed above), Petitioners also fail 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 Petitioners nor their expert provide any analysis as to why a POSITA would be motivated to combine Yamamoto’s delay for a single camera device with the multiple camera device of Kim. EX2005, ¶111. Specifically, where Yamamoto only discloses a single camera facing away from a user (*i.e.*, a second camera) the Petitioners fail to explain how a POSITA would be motivated to combine the standby time of Yamamoto with the dual camera system in Kim, which lack any sort of voice activated image capture or corresponding standby time. *Id.*

Moreover, Petitioners rely 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 EX1003, ¶201). However, as with Grounds 1 and 2, Petitioners’ 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. EX2005, ¶112. 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.” EX1001, 13:32-36. Again, on cross-examination Mr. Guidash acknowledged this teaching of the ’757 Patent. EX2007 at 32:4-12. 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.” EX2005, ¶112. Thus, Petitioners have not shown through their evidence a scenario where the first camera is enabled and the second camera is disabled.

2. *The Kim-Yamamoto-Thorn combination does not disclose the first camera being enabled and the second camera being disabled*

As with Ground 1, Petitioners have failed to demonstrate that the first instruction results in the first camera being enabled and the second camera being disabled. EX2005, ¶113. Petitioners refer to the analysis for [1.g] in Ground 3 as disclosing the supposed understanding of a POSITA that “that the need to activate the front camera means that it was previously inactive/disabled.” Pet. at 75 (citing

EX1003, ¶201). However, the “need to activate the front camera” is based on the claim language and not any teaching or disclosure in the prior art, demonstrating Petitioners’ improper hindsight. EX2005, ¶113. Further, Petitioners admit in their analysis for element [1.g] that “Kim does not explicitly disclose receiving a command voice for activating the front camera 121.” Pet. at 70. Quizzically, Petitioners repeat the same flawed analysis based on Chinn to support their contortion of the prior art. Pet. at 70.¹ Accordingly, for at least the reasons set forth above in Ground 1, or devoid of support in Kim, Yamamoto, and Thorn, Ground 3 is similarly deficient. EX2005, ¶113.

Additionally, Yamamoto does not disclose a voice command that results in the first camera being enabled and the second camera being disabled. EX2005, ¶114. While Yamamoto discloses “speech commands for starting an image capturing operation” (EX1009 at ¶ 205), none of the commands describe an enabled or disabled camera. EX2005, ¶114. Indeed, Yamamoto only discloses a single camera. See EX1009 at ¶ 32. Therefore, the concept of selecting—let alone enabling—

¹ Mr. Guidash confirmed that a similar reference in his declaration was a typo and that he was not relying on a Chinn in combination with Kim, Yamamoto, and Thorn for Ground 3. See EX2007 at 25:2-26:7.

different cameras is necessarily absent from Yamamoto. EX2005, ¶114.

Additionally, Petitioners allegation that a “POSITA would have also understood or at least found obvious that because *only* the back camera 125 is activated, the front camera 110 (i.e., first camera) remains disabled” is not supported by Kim, Yamamoto, or the ’757 Patent. Pet. at 75 (emphasis added). Petitioners again rely solely on the *ipse dixit* of their expert, with no reference to Kim, Yamamoto, Thorn, or the intrinsic record to cure this deficiency. EX2005, ¶115. To the extent Petitioners rely on the teaching of Chinn, the flaws of this broad statement are highlighted in Section IV.A.2 above, and there is no attempt by Petitioners to salvage this gaping hole in the prior art otherwise. *Id.*

3. *The Kim-Yamamoto-Thorn combination does not disclose enabling the second camera and disabling the first camera*

For similar reasons to those set forth above, the Kim-Yamamoto-Thorn combination does not disclose the second “case where the second camera is enabled and the first camera is disabled. For example, none of Kim, Yamamoto, or Thorn discloses disabling of any camera and Petitioners fail to demonstrate otherwise. EX2005, ¶116. Accordingly, Petitioners have not shown by a preponderance of the evidence that the Kim-Yamamoto-Thorn combination renders obvious element [1.i].

4. *The Kim-Yamamoto-Thorn combination does not disclose a first standby time that is longer than a second standby time*

Petitioners’ reliance on Yamamoto’s description of a “0.5 second delay before

taking a voice activated image” (Pet. at 76 (citing EX1009, ¶249), is, at best, incomplete, particularly when paired with Kim’s silence regarding any standby time. EX2005, ¶117.

Claim 1 includes a “controller, wherein the controller is configured to: ... 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.” EX1001, Claim [1.i]. Contrary to the Petitioners’ arguments, it is the controller that provides for the longer first standby time in comparison to the second standby time, not the user. EX2005, ¶118.

The “first standby time of a case where the first camera is enabled and the second camera is disabled” corresponds to “recording of the first image signal acquired by the first camera on the storage in response to the first instruction,” which is given by the command voice. EX1001, Claim [1.g]; EX2005, ¶119. Similarly, the “standby time of a case where the second camera is enabled and the first camera is disabled” corresponds to “recording of the second image signal acquired by the second camera on the storage in response to the second instruction,” which is a touch instruction. EX1001, Claim [1.h]; EX2005, ¶119.

Accordingly, the controller controls the standby time based on the method of input (*i.e.*, voice or touch) and which camera is enabled (front or rear). *See* EX1001

at 6:42-45, 9:42-47, 12:12-19. Petitioners' hindsight-driven selection of 0.5 seconds and 0 seconds, would rob the '757 Patent of the advantages described therein. EX2005, ¶120. For example, the specification describes a "distinctive feature of this embodiment is a camera operation (recording start timing switching) performed by the camera function executing unit 104b, the voice recognition executing unit 104c, and the timing display executing unit 104d." EX1001 at 6:42-45. As another example, "in accordance with the out camera or the in camera that is operated, a delay time until start of recording from timing at which the trigger is received is **automatically** switched over." EX1001 at 12:12-19. This automatic switching that does not require user intervention is part of the inventiveness of the '757 Patent. EX2005, ¶120. Finally, Figure 9 illustrates "the process of controlling switching between delays times in accordance with which one of the two cameras is used." EX1001 at 9:42-47. Therefore, Yamamoto at best describes using a delay for voice-activated images in a single-camera system. See EX1009 at ¶32.

Additionally, Kim offers no discussion of a delay whereas the '757 Patent specifies that "when the second imaging unit 124 (out camera) is used, in order to further decrease the delay time, **it is preferable that the standby time** Ta of the standby process 403 **is close to zero.**" Ex1001, 10:19-22 (emphases added); EX2005, ¶121.

Accordingly, the prior art fails to describe a controller that controls a standby time based on *both* input type and in accordance with which one of two cameras is used.

5. *There is no motivation to combine Kim, Yamamoto, and Thorn*

Petitioners fail to provide adequate analysis on why a POSITA would be motivated to combine the voice commands for capturing an images in Yamamoto with the dual camera system of Kim. EX2005, ¶123. For example, Petitioners allege that “Kim and Yamamoto both relate to imaging devices with manual and voice activated command for commanding a camera to capture and image.” Pet. at 52 (citing EX1008 (Kim), ¶¶54, 56, 64, 66, 160-165). However, upon cross examination, Mr. Guidash could not identify a voice activated command for commanding a camera to capture an image among the citations to Kim. See EX2007 at 6:5-9:7. Instead, the only voice activated commands grounded in Kim relate to “a voice command that can be used to change the size or position of the area that’s being displayed.” See EX2007 at 8:20-22. Thus, Petitioners’ stated premise of the motivation to combine Kim and Yamamoto fails. EX2005, ¶123.

Moreover, neither Petitioners nor their expert provide any rationale on why a POSITA would be motivated to redesign the overall operation of Kim to arrive at the claimed invention when Kim is separately directed to a mobile terminal configured to display an image on an external display. EX1008, ¶2; EX2005, ¶124.

In comparison, Yamamoto and Thorn further diverge, describing “starting capturing of an image in response to a sound” in a single-camera device (EX1009, ¶¶1, 32) and monitoring subjects in an image field and controlling flash operations according to detected blinking by the subject in a single-camera device. See EX1011, ¶¶1 36; EX2005, ¶124.

Additionally, modifying Kim to arrive at the claimed invention would require a complete redesign of Kim’s system, and there is no rationale to do so beyond the hindsight driven analysis set forth by Petitioners. EX2005, ¶125. A proper obviousness analysis demands more than the vague, unsupported statements that Petitioners offer here. See *Unigene Labs.*, 655 F.3d at 1360; *Guangdong Alison Hi-Tech*, Case IPR2017-00152, Paper 8 at 16. Instead of providing any “rational underpinning” to support their asserted obviousness grounds, Petitioners offer only “conclusory assertions.” See *In re Kahn*, 441 F.3d at 988.

B. 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.” Petitioners summarily dismiss this claim element: “The Kim-

Yamamoto-Thorn combination renders this limitation obvious for reasons set forth for limitation [1i]; See §§VIII.B.8, VIII.B.10; EX1003, ¶210.” Pet. at 79. Petitioners rely entirely on their 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]. EX2005, ¶126. As such, Petitioners have not shown by a preponderance of the evidence that 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, Petitioners do 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]. EX2005, ¶127. Petitioners rely on “a certain period of time (for example, 0.5 seconds).” Pet. At 76 (citing EX1009, ¶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. EX1009, ¶249 (emphasis added); *see also id.* ¶44 (““detecting the end of utterance’ means detecting the audio signal satisfied the end condition”); EX2005, ¶127. Yamamoto (and Petitioners) fail to explain or distinguish between times allotted for a trigger-recognizing process, a waiting process, and a recording process. *See, e.g.*, EX1009, Fig. 9; EX2005, ¶127. 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. EX1009, ¶¶249-250; EX2005, ¶127.

The end of an utterance described in Yamamoto is not the claimed “recognition of the first instruction.” EX2005, ¶128. The processing time for recognition of an instruction happens after and *separately* from detecting the end of an utterance. *See, e.g.*, EX1009, ¶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; EX1001, 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. EX2005, ¶128.

Further, the alleged first standby time includes the time for capturing an image. EX2005, ¶129. 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 Petitioners do not rely on Kim or Thorn to overcome this deficiency. EX2005, ¶129.

Accordingly, Petitioners have not shown by a preponderance of the evidence that the Kim-Yamamoto-Thorn combination renders obvious element [1.j] of the

'757 Patent.

C. 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 Petitioners have 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 combination. EX2005, ¶131.

VII. GROUND 4: THE COMBINATION OF KIM, YAMAMOTO, THORN, AND CHINN DOES NOT DISCLOSE CLAIMS 4-6 AND 11

In Ground 4, Petitioners add a fourth reference, Chinn, and refer back to the earlier purported analysis offered in Grounds 1 and 2. Accordingly, Ground 4 falls short of demonstrating that the Kim-Yamamoto-Thorn-Chinn combination would render obvious claims 4-6 and 11 for the same reasons discussed above. EX2005, ¶132. For the reasons further set below, Ground 4 additionally fails to show that the Kim-Yamamoto-Thorn-Chinn combination renders Claim 11 unpatentable.

A. 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 touch operation instruction includes the second instruction and when the second camera is enabled and the first camera is disabled.” EX2005, ¶133.

Petitioners refer back to §VIII.B.10 (element [1.i] in Ground 3) for their analysis of these two elements. For the reasons expressed above with respect to elements [1.i] and [1.j], Petitioners have not met their burden to show by a preponderance of the evidence that elements [11.d] and [11.h] are rendered unpatentable the Kim-Yamamoto-Thorn-Chinn combination. EX2005, ¶134.

VIII. PETITIONERS FAIL TO ALLEGE THAT ITS REFERENCES ARE ANALOGOUS ART

Regarding the references cited by the Petitioners as prior art, Petitioners fail to allege that each reference is analogous art to the '757 Patent. A patent challenger, such as Petitioners, “must compare the reference to the challenged patent.” *Sanofi-Aventis Deutschland GmbH v. Mylan Pharms. Inc.*, 66 F.4th 1373, 1377 (Fed. Cir. 2023) (citing *Donner Tech., LLC v. Pro Stage Gear, LLC*, 979 F.3d 1353, 1359 (Fed. Cir. 2020)). Similarly, Petitioners will fall short by arguing that each references “is analogous to another prior art reference and not the challenged patent.” *Id.* at 1380.

Here, Petitioners entirely fail to assert or analyze whether its references are analogous art to the '757 Patent. At most, Petitioners makes an attempt to demonstrate that subsets of art are analogous to each other. However, even this

cannot provide a basis to determine that the references are analogous *to the '757 Patent*. Therefore, because Petitioners did not meet their burden, they cannot meet their other burden of establishing obviousness based on these references. *See id.* Accordingly, the patentability should be confirmed for this reason alone.

IX. CONCLUSION

For at least the foregoing reasons, the Board should confirm the patentability of Claims 1-11.

Dated: February 20, 2025

Respectfully submitted,

/Robert G Pluta Reg No 50970 /
Robert G. Pluta (Reg. No. 50,970)
MAYER BROWN LLP
71 S. Wacker Drive
Chicago, IL 60606
Telephone: (312) 701-8641
Fax: (312) 706-8144
rpluta@mayerbrown.com

Saqib J. Siddiqui (Reg. No. 68,626)
Seth W. Bruneel (Reg. No. 78,973)
MAYER BROWN LLP
1999 K Street NW
Washington DC, 20006
ssiddiqui@mayerbrown.com

Counsel for Maxell, Ltd.

CERTIFICATE OF SERVICE

I hereby certify that on this 20th day of February, 2025, a copy of the attached PATENT OWNER 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:

James Heintz
Jim.Heintz@us.dlapiper.com

Gianni Minutoli
Gianni.Minutoli@us.dlapiper.com

With a courtesy copy by electronic mail to:
dla-samsung-maxell@us.dlapiper.com

Respectfully submitted,

Date: February 20, 2025

By: /Robert G Pluta Reg No 50970/
Robert G. Pluta (Reg. No. 50,970)

Counsel for Maxell, Ltd.

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

Pursuant 37 CFR 42.24(d), the undersigned certifies that this Patent Owner 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 Patent Owner Response indicates that the Patent Owner Response contains 9,265 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

Respectfully submitted,

/Robert G Pluta Reg No 50970/
Robert G. Pluta (Reg. No. 50,970)