

**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: IPR2024-00867

U.S. Patent No. 10,176,848

**PATENT OWNER'S PRELIMINARY RESPONSE
TO PETITION FOR *INTER PARTES* REVIEW
OF U.S. PATENT NO. 10,176,848**

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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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
U.S. Patent Application No. 2009/0135269	2005
U.S. Patent No. 8,488,847	2006
Samsung invalidity contentions (Gallagher)	2007
Samsung invalidity contentions (Nakashima)	2008
U.S. Patent Application No. 2007/0098303	2009
U.S. Patent Application No. 2007/0019083	2010

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”) has failed to demonstrate a reasonable likelihood of success on the grounds submitted in its Petition for challenging the patentability of claims 11, 12, 16, 17, 19, 20, and 84 (“challenged claims”) of U.S. Patent No. 10,176,848 (“the ’848 Patent”) (Ex. 1001).

First, the Board should exercise its discretion pursuant to 35 U.S.C. § 314(a) or 35 U.S.C. §325(d) and deny this petition. Application of the *Becton, Dickinson* factors weigh in favor of denying institution because most of the art relied on in the Petition is cumulative to prior art considered or was in fact considered in the ’848 Patent and related applications. Moreover, application of the *Fintiv* factors weigh 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, Grounds 1-3 all rely on Nozaki as an anchor reference. Petitioner's treatment of Nozaki's fifty-seven different inventions in seven different embodiments (Ex. 1006, at ¶¶[0009]-[0038]) as a unitary invention glosses over the analysis that is clearly missing from the Petition, namely, an obviousness rationale for combining any particular embodiment of Nozaki with Petitioner's secondary references Haitani/Graham/Kim. All three grounds, which rely on disparate embodiments of Nozaki for which Petitioner has provided no explanation or motivation to combine, fail for this reason alone and the Petition should not be instituted.

Third, even if Petitioner had met its burden to show a rationale to combine Nozaki's disparate embodiments, Petitioner fails to show a reasonable likelihood of prevailing on any Ground because it has not shown that the cited references render obvious claims 11, 12, 16, 17, 19, 20, and 84. None of the cited references alone or in combination disclose the arrangement of each element of claims 11, 12, 16, 17, 19, 20, and 84.

Accordingly, the Board should decline to institute the Petition.

II. DISCRETIONARY FACTORS FAVOR DENIAL OF INSTITUTION

The Petition should be denied pursuant to the Director's discretion to deny institution of petitions. First, the Petition should be denied pursuant to 35 U.S.C. § 325(d) because the petition argues the "same or substantially the same art previously

[] presented to the Office” and fails to demonstrate “that the Office erred in a manner material to the patentability of the challenged claims.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, 8 (P.T.A.B. Feb. 3, 2020) (precedential); *see also Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, pp. 17-18 (PTAB Dec. 15, 2017) (Precedential). Second, 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. § 325(d) Weighs In Favor Of Denying Institution

The Petition should be denied pursuant to 35 U.S.C. § 325(d) because the petition argues the “same or substantially the same art previously [] presented to the Office” and fails to demonstrate “that the Office erred in a manner material to the patentability of the challenged claims.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, 8 (PTAB Feb. 3,

2020) (precedential); *see also Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, pp. 17-18 (PTAB Dec. 15, 2017) (Precedential). “Previously presented art includes art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent.” *Id.* at 7-8. Further, the Board has construed “previously presented” in 35 U.S.C. § 325(d) to refer to art and arguments presented to the Office *prior to* the filing of the petition at issue. *Ironsource Ltd. v. Digital Turbine Inc.*, PGR2021-00096, Paper 14 at 52 (PTAB Jan. 6, 2022).

Specifically, the IPR-asserted art is “substantially the same” because two of the references—Nozaki and Haitani—were previously presented to the Office. Nozaki was considered during prosecution of the ’848 Patent and the reexamination of the ’848 Patent. *See* Ex. 1003 at 533; Ex. 1004 at 165-190. Haitani was considered during the reexamination of the ’848 Patent. Ex. 1004 at 165-190. The remaining tertiary references—Graham and Kim—are cumulative of references previously presented to the Office during reexamination of the ’848 Patent as well as during prosecution of the ’848 Patent, and are each used identically and narrowly for Grounds 2 and 3 directed at one challenged claim. The first part of the two-part framework from *Advanced Bionics* is met here.

Under the second part, Petitioner states “to the extent that the challenges are found to be based on prior art that is the same as or cumulative to prior art considered by the examiner during prosecution, the examiner has made a clear error in allowing the claims over such prior art,” relying on a blanket statement that its arguments are “compelling.” Pet. at 58. Yet, other than pointing to its arguments generally, Petitioner never states where the material error, if any, specifically was made by the Examiner. *Albany Int’l Corp. v. Kimberly-Clark Worldwide, Inc.*, PGR2021-00019, Paper 22, 8-9 (P.T.A.B. June 22, 2021) (denying institution because “[i]f a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute [] review.”).

1. The Same Or Substantially The Same Art Was Previously Presented To The Office

The overlap between the IPR-asserted references and those submitted during prosecution and reexamination of the '848 Patent meets the first part of the two-part *Advanced Bionics* framework, which considers the similarities and material differences between the two sets of art, the cumulative nature of the art, and the extent of the overlap between the arguments. *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph) (factors (a), (b), and (d)).

In the instant case, the grounds presented by Petitioner are duplicative of the art and arguments considered by the Examiner during prosecution and reexamination of the '848 Patent.

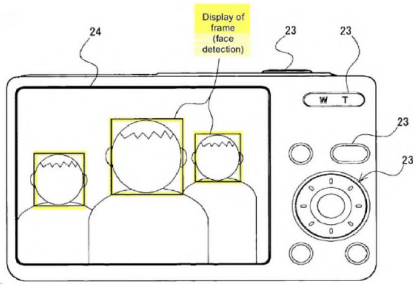
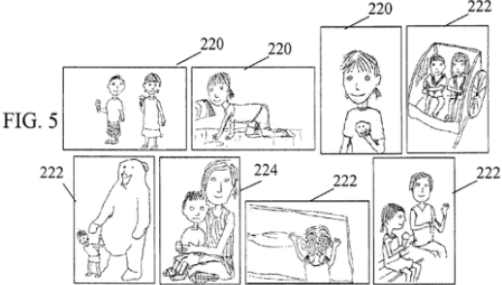
a. Nozaki and Haitani

Petitioner's main reference for all Grounds—Nozaki—was considered during prosecution of the '848 Patent. *See* Ex. 1003 at 452. Haitani, a secondary reference used for all grounds, was considered during the reexamination of the '848 Patent. Ex. 1004 at 171.

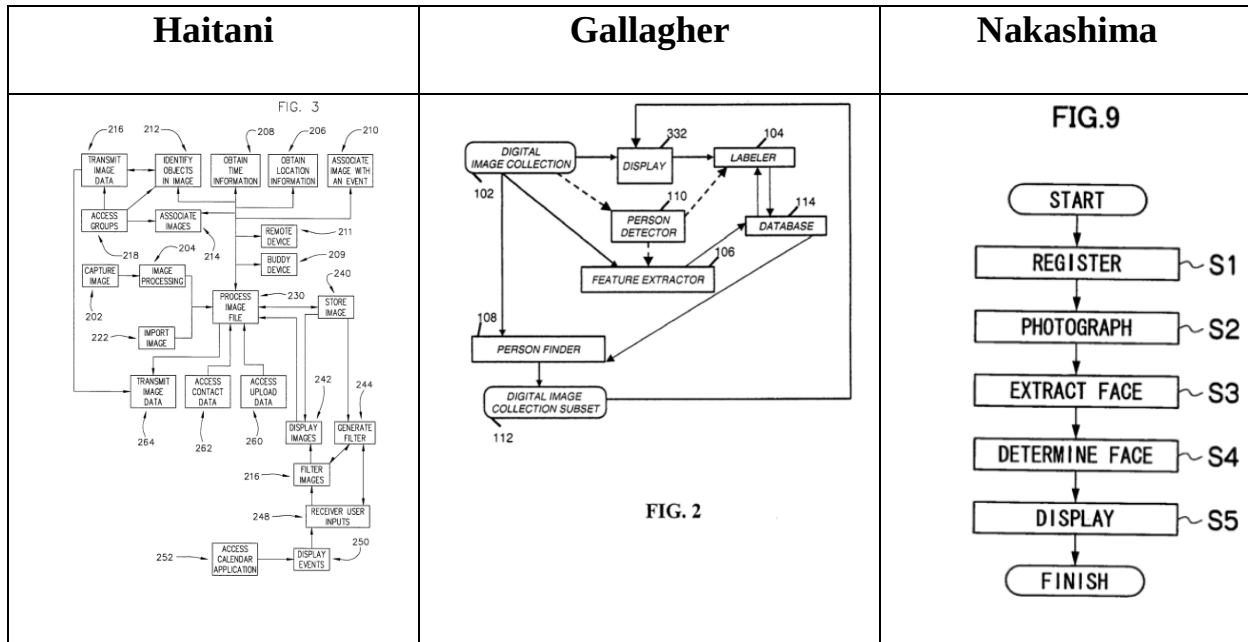
With respect to Nozaki, Petitioner admits that a U.S. publication of Nozaki was disclosed “but not expressly considered” during prosecution of the '848 Patent. Pet. at 5. First, the U.S. publication to which Petitioner refers, U.S. Patent Publication No. 2009/0135269, is same in substance as Petitioner's Nozaki publication. *Compare* Ex. 1006 *with* Ex. 2005. Indeed, the Nozaki publication issued as U.S. Patent No. 8,488,847 (Ex. 2006), based on the same PCT publication upon which Petitioner now relies—WO2007/060980. Second, contrary to Petitioner's claim, the Nozaki publication *was considered* during prosecution. *See* Ex. 1003 at 452. That Nozaki did not form a basis for rejection during prosecution does not preclude application of §325(d) here. *See Clim-A-Tech Ind., Inc. v. William A. Ebert*, IPR2017-01863, Paper 13, at 18-19 (PTAB Feb. 12, 2018) (denying institution even though the ‘Examiner did not base a rejection’ on the reference asserted in the

petition); *Biocon Pharma Ltd. v. Novartis Pharm. Corp.*, IPR2020- 01263, Paper 12, 9 (PTAB Feb. 16, 2021) (holding that cited but unapplied references supported denying institution); *Sony Interactive Entm't LLC v. Terminal Reality, Inc.*, IPR2020-00711, Paper 15, at 11 (PTAB Oct. 13, 2020) (finding reference was previously considered by the PTO because it was listed in the Examiner's Notice of References Cited).

While Nozaki was considered during prosecution and reexamination, it is also cumulative to U.S. Patent Application No. 2007/0098303 to Gallagher (Ex. 2009). Gallagher was also considered during the reexamination of the '848 Patent. *See, e.g.*, Ex. 1004 at 153-159, 366-398. That Nozaki is cumulative to Gallagher can be seen by Petitioner's similar treatment of Gallagher and Nozaki in its invalidity contentions in the District Court Litigation. As an example, comparing the disclosure of Nozaki and Gallagher with respect to Claim element 8[g] illustrates the cumulative nature of Nozaki relative to Gallagher. In both instances Petitioner alleges that both Nozaki and Gallagher disclose claim element 8[g]. *Compare, e.g.*, Pet. at 12-16 with Ex. 2007 at 41-46:

Nozaki	Gallagher
 The diagram shows a video camera with a large display screen (24) and a control panel (23). The display screen shows three faces, each enclosed in a yellow rectangular frame. A label 'Display of frame face detection' points to one of these frames. The control panel includes a 'W T' switch and a circular dial with numbers 0 through 9.	 FIG. 5 is a grid of eight small images. The top row contains four images: two people standing (220), a person sitting at a desk (220), a person holding a baby (220), and a person in a car (222). The bottom row contains four images: a person standing (222), a person sitting (224), a person sitting at a desk (222), and a person sitting (222).

With respect to Haitani, which Petitioner also relies on for all four grounds, it too was considered during reexamination of the '848 Patent. Ex. 1004 at 171. Nevertheless, Haitani is also cumulative to Gallagher (Ex. 2009) and Nakashima (Ex. 2010). Nakashima was also considered during prosecution and the reexamination of the '848 Patent. *E.g.*, Ex. 1003 at 421-424; Ex. 1004 at 153-156, 367-371. A comparison of Haitani relative to Gallagher and Nakashima illustrates the cumulativeness of Haitani:



Compare Ex. 1007, Fig. 3 with Ex. 2009, Fig. 2 and Ex. 2010, Fig. 9. Petitioner relies on each of these figures from Haitani, Gallagher, and Nakashima in its invalidity contentions to allege disclosure of face detection relative to claim element 8[g]. *Compare, e.g.,* Pet. at 12-16 with Ex. 2007 at 41-46 (Gallagher invalidity contentions) and Ex. 2008 at 52 (Nakashima invalidity contentions)

b. Graham and Kim

With respect to Graham (Ground 2) and Kim (Ground 3), both are cumulative to prior art already considered during reexamination of the '848 Patent. Petitioner utilizes both Graham and Kim with respect to only claim element 84[h]:

“wherein the video camera captures video information corresponding to a scene and the processor automatically sets a plurality of sections corresponding to the video information of the scene; and generates a plurality of thumbnails corresponding to the plurality of sections,

wherein each of the plurality of thumbnails is associated with the same video information corresponding to the scene, and the display displays the plurality of thumbnails.

Petitioner contends that Graham:

discloses a method of “retrieving and displaying multimedia information” such as “video information” wherein “thumbnail images” of “video keyframes” are “extracted from the video information...at various points in time using a specified sampling rate” and then displayed to the user in a vertical interface. EX1008, Fig. 3, [0005], [0060]-[0062], [0088].

Pet. at 47-51. Petitioner contends that Kim:

discloses “video partitioning” of a “shot”—i.e., “a sequence of video frames obtained from a single camera without interruption”—where a “multimedia content indexing technique[...]...extract[s] key special elements such as key frames” from a video and automatically “indexes” them by chapters (or “partitions”), “in a way that describes them on a time axis, allowing users to easily browse or search for desired parts.” EX1009, 6-7.

Pet. at 53-54.

Petitioner's use of Graham and Kim is cumulative to Gallagher, considered during reexamination of the '848 Patent. As alleged by Petitioner in its invalidity contentions in the District Court Litigation with respect to Claim element 84[h]:

Gallagher discloses wherein the video camera captures video information corresponding to a scene and the processor ...

automatically sets a plurality of sections corresponding to the video information of the scene ... [and] generates a plurality of thumbnails corresponding to the plurality of sections, wherein each of the plurality of thumbnails is associated with the same video information corresponding to the scene, and the display displays the plurality of thumbnails

Ex. 2007 at 164-166 (Gallagher invalidity contentions). Petitioner's sole use of Graham and Kim for claim element 84[h] is cumulative to Gallagher. Petitioner's use of Gallagher for claim element 84[h] in its invalidity contentions in the District Court Litigation confirms this.

All told, Petitioner's main references for Grounds 1-3, Nozaki and Haitani, were previously considered by the Office. The secondary references, Graham and Kim, are cumulative to at least Gallagher. As such, the first part of the *Advanced Bionics* test is met.

2. Petitioner Fails To Demonstrate A Material Error By The Office

Regarding part two, Petitioner's attempt to detail material error by the Office is cursory. Petitioner's attempt at showing material error is limited to this: "Second, to the extent that the challenges are found to be based on prior art that is the same of cumulative to prior art considered by the examiner during prosecution, the examiner has made a clear error in allowing the claims over such prior art. This is at least because the challenges in this Petition satisfy the compelling merits standard...."

Pet. at 58. Nowhere in the petition is it explained why the Examiner's allowance of the claims over Nozaki, Haitani, Gallagher, and Nakashima was material error. Indeed, many of Petitioner's arguments are simply a rehash of the reexamination request that was thoroughly considered by the Office during reexamination.

The Board should use its discretion not institute the Petition pursuant to 35 U.S.C. § 325(d).

B. 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 Petitioner's 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. 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).

The Petition should be denied because the invalidity arguments Petitioner raises here will be resolved in a co-pending District Court Litigation long before this proceeding will conclude. Specifically, the '848 Patent is asserted in the co-pending District Court case *Maxell, Ltd. v. Samsung Elecs. Co. et al.*, Case No. 5:23-cv-

00092 (E.D. Tex.) (the "District Court Litigation"). While Petitioner acknowledges the District Court Litigation in the Petition, it failed to inform the Board that the District Court Litigation will be complete long before any final decision would issue in this proceeding. Nor did Petitioner inform the Board that Maxell identified Petitioner's infringement of the claims at issue in the '848 Patent, years prior to Petitioner filing its Petition, and that the trial date of May 2025 for the District Court Litigation was scheduled back in January 2024. Ex. 2001. The jury trial adjudicating the validity of the '848 Patent will conclude six months before any Final Written Decision issues in this proceeding.

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. Additionally, the challenged claims are substantially the same as those asserted in the District Court Litigation.

Thus, any questions of whether the grounds of invalidity raised in Petitioner's Petition invalidate the asserted claims of the '848 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.

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. Ex. 2001; *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. Petitioner knew of this trial date four months prior to filing their 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, 2025.¹ 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 (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.").

¹ 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).

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). The Court has also conducted a *Markman* Hearing (Dkt. 84). Discovery is also well under way, and fact discovery including depositions of numerous foreign inventors and foreign engineers will be complete on October 29, 2024, about two weeks before the Institution Decision in this proceeding.

The parties have already exchanged infringement contentions pursuant to P.R. 3-1, and invalidity contentions pursuant to P.R. 3-3, completed claim construction briefing and a trial date is set for May 19, 2025, which is only six months after a decision on Institution. Ex. 2001. 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 11, 12, 16, 17, 19, 20, and 84 of the '848 Patent are unpatentable. Pet. at 1. These claims cover the asserted claims against Petitioner in the District Court Litigation. Ex. 2003. The prior art that Petitioner relies on in supporting its Petition is the same or substantially the same as the prior art at issue in the District Court Litigation. See 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 pursuing the same invalidity defenses using the same prior art in this proceeding and parallel District Court litigation. See Ex. 2004 at 4 (showing Petitioner electing each of Nozaki, Haitani, Graham, and Kim as prior art for its invalidity defense).

Given that the Petition is directed toward the same claims, same grounds, same arguments, and significantly overlapping evidence at issue in the parallel

District Court proceeding, 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 Patent Owner's Mandatory Notice, there exists a parallel District Court Litigation between the same parties regarding the same subject patent (the '848 Patent). See Paper 5. Petitioners are parties to the District Court Litigation. Accordingly, this factor weighs in favor of discretionary denial.

6. Other Factors Favor Discretionary Denial

Petitioner 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 57.

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

C. 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.

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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 at least when Patent Owner filed a Complaint asserting infringement of the '848 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, and these duplicative efforts have prejudiced Maxell and continue to prejudice Maxell as it responds to Petitioner's invalidity allegations in the District Court. The Court set the trial date seven months ago. Ex. 2002, Docket Control Order, Dkt. 45, *Maxell, Ltd. v. Samsung Elecs. Co.*, No. 5:23-cv-00092 (E.D. Tex. January 12, 2024). 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 and *Becton, Dickinson* 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. 10,176,848

The '848 Patent generally describes a recording and reproducing apparatus (such as a mobile phone or camera), Ex. 1001 at 13:38-42, that allows users to “rapidly and easily” locate certain types of images from among a large number of images. *Id.* at 2:18-22. Specifically, the patent recognizes that, in the 2008 timeframe, the memory capacities of camera devices were increasing, thereby

allowing for the storing of more and more images. *Id.* at 1:55-59. Aware of this trend, inventor Ms. Yoshida recognized the need for a better way to find images among the ever-increasing number of images stored on recording devices. *See id.* at 1:59-61 (“It is therefore difficult for a user to quickly find a target scene from a number of scenes recorded in the recording medium.”).

Ms. Yoshida solved this problem by applying a face-recognizing process to characterize recorded images by registering individual people in the recorded images. For example, the claims recite two ways in which a face-recognizing process registers a person in an image as a specific person: a “first setting mode,” in which a person in newly photographed images is registered as a specific person; and a “second setting mode,” in which a person is selected from among a plurality of images and registered as a specific person. *E.g., id.* at 15:64-16:7 (claim 8).

The specification illustrates one example of this concept in the embodiment shown in Figure 3:

FIG. 3

25	26	27
001	filepath/file.jpg	hh:mm:ss:ff ...
002	filepath/file.jpg	
003	filepath/file.jpg	hh:mm:ss:ff ...
⋮	⋮	

24

As shown in this figure, this embodiment associates a face ID 25 with the file path 26 of an image containing that particular person's face. *Id.* at 5:47-65. In another exemplary embodiment, the recording apparatus can recognize faces and associate them with specific persons by newly photographing a person. *Id.* at 6:32-59. The patent also describes using a similar face-recognizing process to register individuals "for an image already photographed." *Id.* at 7:10-16.

B. Person Of Ordinary Skill In The Art

For purposes of this Preliminary Response, Maxell agrees that the Petition sets forth a plausible definition of a POSITA.

C. Summary Of Petitioner's Proposed Grounds Of Unpatentability And The References Cited

The Petition raises three grounds of alleged obviousness based on the following four references: WO 2007/060980 ("Nozaki") (Ex. 1006), U.S. Patent No. 9,665,597 ("Haitani") (Ex. 1007), U.S. Patent Application No. 2004/0095376 ("Graham") (Ex. 1008), and Korean Unexamined Patent Publication No. 2007/0017068A ("Kim") (Ex. 1009).

Ground	'848 Patent Claim(s)	Type of Challenge	Primary Reference	Secondary Reference(s)
1	11, 12, 16, 17, 19, 20	Obviousness	Nozaki	Haitani
2	84	Obviousness	Nozaki	Haitani & Graham
3	84	Obviousness	Nozaki	Haitani & Kim

1. Nozaki (Ex. 1006)

Nozaki, titled "Electronic Camera and Image Processing Device," was filed as an international patent application on November 22, 2006 and published on May 31, 2007.

Nozaki purportedly discloses fifty-seven different inventions in seven different embodiments. Ex. 1006, ¶¶[0009]-[0038]. Nozaki discloses an electronic camera with an imaging element, an image processing section, a face detecting section, a control section, a face image creating section, or a face recognition data creating section, and a recording section. The imaging element generates an imaging signal by photo-electrically converting the image of an object captured by an imaging optical system. The image processing section creates face registration image data from the image signal sent from the imaging element and creates through image data from the image signal. The face detecting section detects a face region on the imaging screen on the basis of the through image data. The control section adjusts the imaging parameter of the imaging optical system according to the detected position of the face region. The face image creating section cuts out the image of the face region to create face image data. The face recognition data creating section extracts a feature point of the face of the imaged person from the face region of the face registration image data and creates face recognition data according to the feature points. The recording section records the face recognition data or the face

image data. Ex. 1006, Abstract.

2. Haitani (Ex. 1007)

Haitani, titled "Method and System for Processing Images Using Time and Location Filters," was filed on March 22, 2007 and issued on May 30, 2017.

Haitani discloses a device that processes images (e.g. sort, group, file, e-mail, etc.) using various filters. The filters relate to non-image data in the image files to be processed, and may include time and location filters. Ex. 1007, Abstract.

3. Graham (Ex. 1008)

Graham, titled "Techniques for Displaying Information Stored in Multiple Media Documents" was filed on June 18, 2003 and published on May 20, 2004.

Graham discloses techniques for providing a graphical user interface (GUI) that displays a representation of stored information that may include information of one or more types. The displayed representation may include representations of information of the one or more types. The GUI enables a user to navigate and skim through the stored information and to analyze the contents of the stored information. The stored information may include information captured along the same timeline or along different timelines. Ex. 1008, Abstract.

4. Kim (Ex. 1009)

Kim, titled "Apparatus and Method for Partitioning Videos According to Topic," was filed on August 4, 2006 and published on February 8, 2007.

Kim discloses a way to partition a video according to topic. Kim discloses a start shot determining unit that detects a plurality of key frames using character information in a video sequence composed of a plurality of frames and determines the detected key frames as the start shot of each subject, and a topic list generating unit that generates a topic list using the starting shot of each topic. Ex. 1009, Abstract.

D. Claim Construction

It is Petitioner's burden to propose a construction and then explain how the construed claim is unpatentable under that proposed construction. See 37 C.F.R. § 42.104(b)(4). As Patent Owner explains herein, the Petition fails to meet this burden. Given the multiple reasons why the Petition should not be instituted, including 35 U.S.C. § 325(d) and 35 U.S.C. § 314, and to minimize the disputes that the Board needs to address at this preliminary stage, for the purposes of this Preliminary Response only, Patent Owner simply applies Petitioner's own constructions to show how the Petitioner has not met its burden under 37 CFR § 42.104(b)(4).

Patent Owner, however, reserves all rights to dispute Petitioner's proposed construction with the support of expert testimony to the extent the Board decides to institute review of this Petition. Any statements made herein with respect to the lack of a claim element in a prior art reference are under Petitioner's proposed constructions and should not be construed as an admission on behalf of Patent Owner that such construction is proper under the *Phillips* standard.

E. Grounds 1-3 Fail Because Petitioner Fails To Set Forth Any Motivation To Combine The Different Embodiments Of Nozaki Upon Which It Relies

Petitioner attempts to explain how a combination of Nozaki and Haitani meets the elements of the claims and how a POSITA would be motivated to combine Nozaki and Haitani. Pet. at 7-9. Petitioner, however, provides *absolutely no reasoning* as to why a POSITA would be motivated to combine the various embodiments of Nozaki Petitioner uses to cobble together its challenges. Petitioner's failure to do so is fatal to its Petition. "In an [inter partes review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable." *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring [inter partes] review petitions to identify "with particularity . . . the evidence that supports the grounds for the challenge to each claim")). This burden never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)) (discussing the burden of proof in inter partes review).

Petitioner relies solely on Nozaki in all grounds for a significant portion of its obviousness analysis of the challenged independent claims (*i.e.*, Claim elements 8[pre]-8[h], 13[pre]-13[g], 18[pre]-18[f], 84[pre]-84[c.i-c.viii]). Pet. at 9-20, 32-33, 35, 38-42. Nozaki purportedly discloses fifty-seven different inventions in seven

different embodiments. Ex. 1006, at ¶¶[0009]-[0038]. In addition to attempting to combine Haitani with Nozaki for all the grounds, Petitioner utilizes three different embodiments disclosed in Nozaki in analyzing Claim elements 8[e] (Nozaki embodiments 1 and 5), 8[g] (Nozaki embodiment 1), 8[h] (Nozaki embodiment 5), and 8[i] (Nozaki embodiments 5 and 6). Pet. at 11-26. Petitioner employs similar mixing of Nozaki's embodiments in its analysis of the dependent claims. Pet. at 26-31, 34-36. Yet, Petitioner made *no* effort to meet its burden of showing any motivation or rationale to combine the various embodiments it utilizes in Nozaki. Petitioner never once indicates whether Nozaki's embodiments can be used together, much less explain why one skilled in the art would have found it obvious to combine those teachings. "Pointing to disparate embodiments without providing a sufficient motivation to combine them is not enough to establish the obviousness of [the claim] as a whole." *Markforged Inc. v. Continuous Composites, Inc.*, IPR2022-00679, Paper 24 at 14-15 (Sept. 26, 2023). In *Markforged*, the Petitioner argued one-reference obviousness and argued the reference's statement that "various features of the invention which are, for clarity, described in the contexts of separate embodiments may also be provided in combination in a single embodiment" was sufficient, yet the Board found this insufficient to establish obviousness because Petitioner never provided sufficient motivation combine the embodiments. *Id.*; see also *Markforged Inc. v. Continuous Composites, Inc.*, IPR2022-01431, Paper 7 at

12-13 (Jan. 18, 2023) (denying institution for similar reasons).

Both Federal Circuit and Board case law require a motivation to combine two (or more) embodiments of a reference. *Abiomed, Inc., v. Maquet Cardiovascular, LLC*, IPR2017-01026, Paper 8, 7-8, 10- 11 (PTAB Sept. 20, 2017) (an obviousness argument based on “combining multiple embodiments from a single reference” must include a motivation and a reasonable expectation of success); *In re Stepan*, 868 F.3d 1342, 1346 n.1 (Fed. Cir. 2017) (Whether a rejection is based on ... combining multiple embodiments from a single reference ... there must be a motivation to make the combination and a reasonable expectation that such a combination would be successful, otherwise a skilled artisan would not arrive at the claimed combination.)

Here, Petitioner's pointing to disparate embodiments in Nozaki without providing *any* motivation to combine them is not enough to establish the obviousness of the challenged claims. This failure is fatal to the Petition. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (requiring “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”); *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004) (improper under the “as a whole” requirement of § 103 to “break an invention into its component parts (A+B+C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious”).

Moreover, instituting an IPR on such a Petition would prejudice Patent Owner. *T-Mobile US, Inc. v. TracBeam LLC*, IPR2015-01687, Paper 10 at 20 (PTAB Feb. 12, 2016) (“We will not...improperly shift the burden of deciphering the arguments onto the Patent Owner”). Indeed, institution would enable Petitioner to develop arguments not initially presented in the Petition. This is also improper. *ADT LLC v. Vivint, Inc.*, IPR2022-00642, Paper 7 at 13-14 (Oct. 4, 2022); *see also Wasica Fin. GmbH v. Cont'l Auto. Sys., Inc.*, 853 F.3d 1272, 1286 (Fed. Cir. 2017) (explaining that “[s]hifting arguments” during the course of a trial are “foreclosed by statute, [Federal Circuit] precedent, and Board guidelines”).

Petitioner's failure to provide such a rationale as to Nozaki also infects the combinations Petitioner attempts with Nozaki and Haitani (Grounds 1-3), Nozaki, Haitani, and Graham (Ground 2), and Nozaki, Haitani, and Kim (Ground 3). Petitioner's treatment of Nozaki's fifty-seven different inventions in seven different embodiments (Ex. 1006, at ¶¶[0009]-[0038]) as a unitary invention glosses over the analysis that is clearly missing, namely, and obviousness rationale for combining any particular embodiment of Nozaki with Haitani/Graham/Kim.

Grounds 1-3, all of which rely on disparate embodiments of Nozaki for which Petitioner has provided no explanation or motivation to combine, fail for this reason alone and the Petition should not be instituted.

F. Grounds 1-3 Fail To Establish That All Challenged Claims Are Rendered Obvious By Nozaki In View Of Haitani

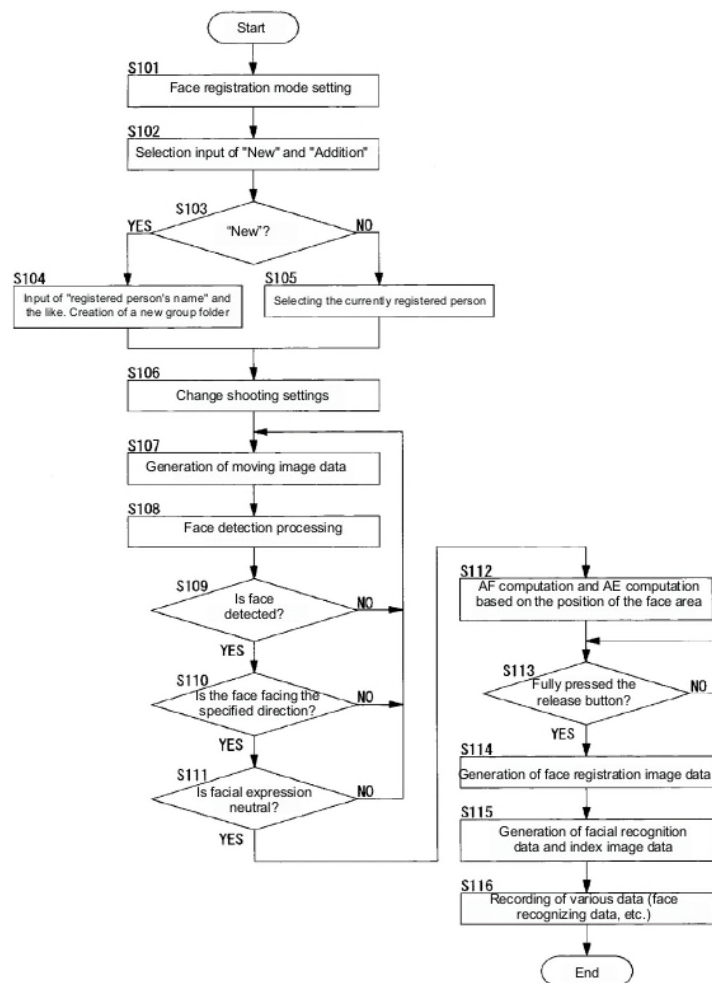
Petitioner also has not shown a likelihood of prevailing with respect to Grounds 1-3 because Nozaki in view of Haitani does not teach each and every element of Claims 11, 12, 16, 17, 19, 20, and 84. Specifically, even if Nozaki and Haitani are combined, Nozaki in combination with Haitani does not teach elements 8[g], 13[f], 18[f], and 84[c.v] as required for each of these claims. Because the challenged dependent claims 11, 12, 16, 17, 19, and 20 all depend from an independent claim that Petitioner has not shown to be unpatentable, Petitioner has also failed to show that claims 11, 12, 16, 17, 19, and 20 are unpatentable by Nozaki in view of Haitani.

1. Nozaki Fails to Disclose Claim Elements 8[g], 13[f], 18[f], and 84[c.v]

Claim element 8[g] requires a processor to “register a person in the image information as a specific person in a mode selected from a first setting mode and a second setting mode, wherein, when the first setting mode is selected, a person with a face is obtained by newly photographing the person in a photographing mode and thereafter registered as the specific person.” Ex. 1001, Claim 8. Claim elements 13[f], 18[f], and 84[c.v] require similar elements, and Petitioner relies entirely on its analysis of claim element 8[g] for claim elements 13[f], 18[f], and 84[c.v]. Pet. at 12-16, 33, 36, 40.

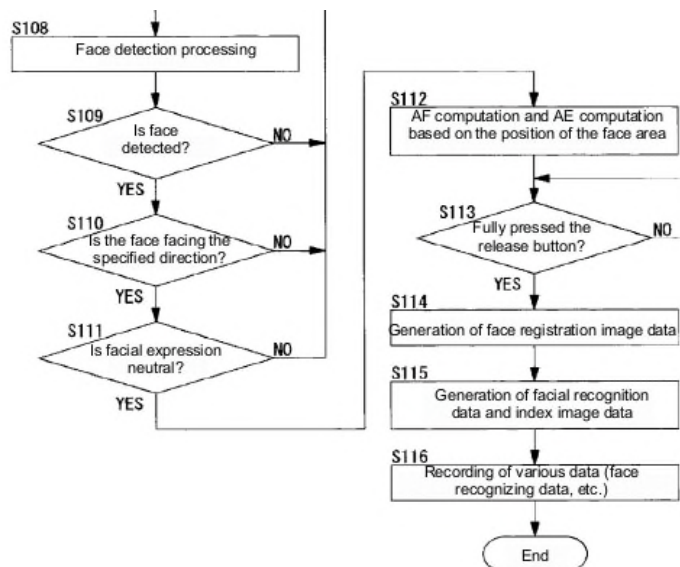
Petitioner contends that Nozaki's "new" face registration mode is the claimed first setting mode and Nozaki's "regeneration mode" face registration mode is the claimed second setting mode. Pet. at 12; Ex. 1006, ¶¶[0062]-[0065], [0073]-[0083]. Regarding the first setting mode, Petitioner contends (through its expert) that "the first registration mode (the "new" face registration mode) in Nozaki involves newly photographing a person and using the new image to register him/her as a specific person. EX1005, ¶79." Pet. at 14. But Nozaki teaches just the opposite, and does not meet the limitations of Claim element 8[g]. For example, Petitioner relies heavily on Fig. 2 in Nozaki to allegedly show a first setting mode:

[Figure 2]



Petitioner asserts that Nozaki teaches that selecting “new” face recognition causes the device to “generate[] a group folder of a newly registered person (a registered person to be shot this time)’ in a ‘face registration memory 27.’ EX1006, Fig. 2 (S103, S104), Fig. 5, [0065]. The user can thereafter ‘input information on the name of registered person,...’” Pet. at 14. Then, as admitted in the Petition and by Petitioner’s expert, “[a]fter the person’s registration information is inputted, **Nozaki’s device newly captures a photograph** of him/her. EX1005, ¶80.” Pet. at

14 (emphasis added). This is confirmed in Figure 2 of Nozaki and the discussion surrounding the steps such as S103, S104. Ex. 1006, Fig. 2, ¶¶[0065], [0080]. For example, the face registration including the name of the face occurs at step S104 (“input of registered person’s name”) and then many steps later including the various configuration settings of the camera, the button to capture the photograph occurs, *i.e.*, Step 113 (“Fully pressed the release button”).



Ex. 1006, Fig. 2. Thus, Nozaki operates in precisely the opposite manner as the claimed invention, namely, “when the first setting mode is selected, a person with a face is obtained by **newly photographing the person** in a photographing mode **and thereafter** registered as the specific person.” Ex. 1001, Claim 8 (emphasis added). In other words, it is not until after the new person is photographed that the new person is registered as the specific person. Nozaki, as admitted by Petitioner, only newly captures a photograph after the person’s registration information is inputted.

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Pet. at 14. As a result, Petitioner has failed to show that Nozaki discloses elements 8[g], 13[f], 18[f], and 84[c.v].

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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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. 10,176,848, together with all exhibits was served by electronic mail to the attorneys of record, at the following addresses:.

Respectfully submitted,

Date: August 12, 2024

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 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 6,966 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

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