

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
SHERMAN DIVISION**

OPTIMUM IMAGING TECHNOLOGIES
LLC,

Plaintiff,

v.

SONY CORPORATION,

Defendant.

Civil Action No. 4:23-cv-00928-ALM

**DEFENDANT SONY CORPORATION'S
MOTION TO STAY PENDING *INTER PARTES* REVIEW**

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I. Introduction

Defendant Sony Corporation (“Sony”) respectfully moves to stay this case pending resolution of the four instituted *inter partes* reviews (“IPRs”) that Sony has filed against the patents asserted by Optimum Imaging Technologies LLC (“OIT”). Other defendants have also filed IPRs against the asserted patents, the first of which was instituted on February 24, 2025.

All three factors considered by this Court strongly favor a stay. **First**, a stay of this litigation would not unduly prejudice OIT. OIT does not sell products—let alone products that practice its patents—and does not compete with Sony. OIT therefore can be adequately compensated for any alleged infringement by monetary damages at a later time. Indeed, OIT delayed years after the issuance of its patents to file this litigation, and then delayed advancing its case by failing to serve Sony for half a year—confirming that any delay from a stay would not be unduly prejudicial. **Second**, this case is at an early stage. No depositions have taken place; expert discovery has not begun; no *Markman* hearing has occurred; and no trial date has been set. **Finally**, staying the case until the IPRs are resolved would greatly simplify the issues for the Court. Sony’s instituted IPRs challenge 24 of the 32 claims asserted in this case, and final written decisions on the IPRs from the Patent Trial and Appeal Board (“PTAB”) will greatly narrow the issues for this Court to decide. Not only could Sony’s IPRs result in the challenged claims’ invalidation (and thus removal from this case), but many of the eight unchallenged claims overlap heavily with claims that are challenged in Sony’s IPRs, so Sony’s IPRs will simplify the issues for those claims as well. Further, all eight of the claims not directly addressed in Sony’s IPRs are challenged in IPRs filed by other defendants, which may therefore further simplify—or even obviate completely—the issues in this case. Indeed, one of the other defendants’ IPRs has already been instituted (the day prior to this motion’s filing), reducing the number of asserted claims not addressed by an instituted IPR from eight to seven.

II. Background

A. OIT Delayed Bringing and Advancing this Lawsuit

Plaintiff OIT is a Texas LLC that was formed in 2009 by the inventor of the asserted patents,¹ Neal Solomon. Dkt. No. 1, ¶¶ 10-11. OIT does not claim to make or sell any products, let alone products that practice the asserted patents; in short, it is a non-practicing patent assertion entity. *See* Exhibit 1 (OIT’s Patent Local Rule 3-1 and 3-2 Disclosures) at 14 (“OIT identifies that it has no products that practice the Asserted Claims at this time.”). The ’805 patent issued on November 3, 2009, the ’339 patent issued on May 28, 2013, the ’685 patent issued on December 22, 2020, and the ’266 patent issued on December 29, 2020.

OIT first asserted the ’805 and ’339 patents in 2019 against Canon, ten years after the ’805 patent issued and six years after the ’339 patent issued. *See Optimum Imaging Technologies LLC v. Canon Inc.*, No. 2-19-cv-00246, Dkt. No. 1 (E.D. Tex. July 8, 2019) (“Canon Litigation”). The Canon Litigation concluded in 2021 pursuant to a settlement agreement. *See id.*, Dkt. No. 285 (Apr. 28, 2021). OIT then waited two more years, until October 18, 2023, to file this suit. This was almost fourteen years after the ’805 patent issued and nearly three years after the last of the asserted patents (the ’266 patent) issued. Dkt. No. 1.

OIT accuses of infringement various Sony camera products that have been on the market for almost two decades. *See, e.g., List of Sony α cameras*, Wikipedia, https://en.wikipedia.org/wiki/List_of_Sony_%CE%B1_cameras (last visited February 23, 2025) (listing release dates of various accused products: DSLR-A100 (2006), DSLR-A200 (2008), DSLR-A700 (2007), DSLR-A900 (2008)); Exhibit 1 at 10 (OIT identifying these as accused products).

¹ The asserted patents are United States Patent Nos. 7,612,805 (“the ’805 patent”), 8,451,339 (“the ’339 patent”), 10,873,685 (“the ’685 patent”), and 10,877,266 (“the ’266 patent”).

In short, OIT waited several years to assert its patents against Sony.

OIT similarly delayed in moving this litigation forward after filing its complaint. While OIT filed its complaint on October 18, 2023 (Dkt. No. 1), it waited almost three months, until January 10, 2024, to move for the appointment of an international process server (Dkt. No. 10). Sony was eventually served on May 13, 2024 (Dkt. No. 13). In short, OIT failed to expeditiously advance its case against a foreign defendant, serving its complaint more than half a year after filing the lawsuit.

B. Sony's Instituted IPRs Challenge the Vast Majority of the Asserted Claims

In contrast, Sony moved swiftly to prepare and file IPRs challenging all of the claims in the asserted patents that it felt OIT could plausibly accuse Sony of infringing. Sony filed three IPRs on May 20, 2024 and a fourth on June 25, 2024, all of which have now been instituted. These IPRs challenge the vast majority of the asserted claims, as shown in the following table:

Patent	Claims Asserted by OIT against Sony	IPR	Claims Challenged in Sony IPRs ²	Claims Asserted But Not Challenged
'805	1-4, 8, 9, 18, 21, 24	IPR2024-00924 <u>Filed:</u> May 20, 2024 <u>Instituted:</u> Dec. 12, 2024	1-3, 9, 18-20, 24	4, 8, 21
'339	1-4, 6, 7, 10, 14, 15	IPR2024-00925 <u>Filed:</u> May 20, 2024 <u>Instituted:</u> Nov. 18, 2024	1-5, 14-18	6, 7, 10
'685	1-2, 4, 6, 14, 20	IPR2024-00923 <u>Filed:</u> May 20, 2024 <u>Instituted:</u> Nov. 18, 2024	1-19, 22-30	20
'266	1, 2, 10, 21-23, 28-29	IPR2024-01046 <u>Filed:</u> June 25, 2024 <u>Instituted:</u> Jan. 17, 2025	1-27, 29-30	28

² The patent claims challenged in Sony's IPRs are collectively referred to herein as the "Sony Challenged Claims."

As of the date of this motion, the Sony Challenged Claims cover 24 of the 32 claims (*i.e.*, 75%) presently asserted by OIT.³ In addition to Sony's IPRs, other Defendants have filed their own IPRs as reflected in the following table.

Patent	Claims Asserted by OIT Against Sony	IPRs ⁴	Claims Challenged	Claims Asserted But Not Challenged
'805	1-4, 8, 9, 18, 21, 24	IPR2024-01373 Filed: August 30, 2024 Decision By: April 28, 2025	1-9, 18-24	None
'339	1-4, 6, 7, 10, 14, 15	IPR2024-01372 Filed: August 30, 2024 Decision By: April 28, 2025	1-5, 14-18	None
		IPR2025-00628 Filed: February 21, 2025 Decision By: Approx. Aug. 2025	6, 7, 10	
'685	1-2, 4, 6, 14, 20	IPR2024-01220 Filed: August 29, 2024 <u>Instituted</u> : February 24, 2025	1-30	None
'266	1, 2, 10, 21-23, 28-29	IPR2024-01374 Filed: October 8, 2024 Decision By: May 21, 2025	1-30	None

As shown above, the Other Defendants' IPRs challenge the patentability of every claim asserted against Sony, including the eight asserted claims not challenged in Sony's IPRs. One of the Other Defendant's IPRs has already been instituted, and institution decisions on three of the remaining four Other Defendants' IPRs are expected by the April-May 2025 time frame.

³ By April 18, 2025, OIT must make a final election of asserted claims, narrowing to no more than five asserted claims per patent and no more than sixteen total asserted claims. Dkt. No. 67. For the reasons discussed *infra* pp. 12-14, this additional narrowing is expected to substantially reduce, if not eliminate, the assertion of claims not challenged in Sony's IPRs.

⁴ These IPRs are collectively referred to herein as the "Other Defendants' IPRs." In addition to those listed here, the following "understudy" IPRs have also been filed: IPR2025-00461, IPR2025-00462, IPR2025-00463.

C. The Case Remains in Its Early Stages

While the parties expended some effort preparing infringement and invalidity contentions, the vast bulk of the work on this case remains in the future. As of the filing of this motion, Sony's responsive claim construction brief is not yet due (it is due on February 27, 2025) and the *Markman* hearing is still more than a month away (it is scheduled for March 27, 2025). No depositions have yet been taken. Sony's depositions are not scheduled to begin for another month, on March 24, 2025. Fact discovery does not close until April 18, 2025. Expert discovery does not even begin until May 16, 2025. A final pretrial conference has been scheduled for November 6, 2025, but no trial date has been set. Dkt. No. 67.

III. Legal Standards

This Court has “broad discretion to stay proceedings as an incident to its power to control its own docket.” *Clinton v. Jones*, 520 U.S. 681, 706 (1997). The “question whether to stay proceedings pending inter partes review of a patent is a matter committed to the district court’s discretion.” *NFC Tech. LLC v. HTC Am., Inc.*, 2015 WL 1069111, *1 (E.D. Tex. Mar. 11, 2015). District courts typically consider three factors to determine “whether the benefits of a stay outweigh the inherent costs of postponing resolution of the litigation: (1) whether the stay will unduly prejudice the nonmoving party, (2) whether the proceedings before the court have reach an advanced stage, including whether discovery is complete and a trial date has been set, and (3) whether the stay will likely result in simplifying the case before the court.” *Papst Licensing GmbH & Co., KG v. Apple, Inc.*, 2017 WL 11638426, *2 (E.D. Tex. June 16, 2017).⁵

⁵ Unless otherwise stated, all emphasis is added and internal quotations and citations are omitted.

IV. Argument

A. A Stay Will Not Unduly Prejudice OIT

OIT will not suffer undue prejudice if the Court stays this case while the PTAB decides the IPRs. “[W]hether the patentee will be unduly prejudiced by a stay in the district court proceedings ... focuses on the patentee’s need for an expeditious resolution of its claim.” *VirtualAgility Inc. v. Salesforce.com, Inc.*, 759 F.3d 1307, 1318 (Fed. Cir. 2014); *see also Vill. Green Techs., LLC v. Samsung Elecs. Co.*, 2023 WL 416419, *2 (E.D. Tex. Jan. 25, 2023). There is no such need here, as confirmed by OIT’s own actions.

A stay’s only prejudice to OIT would be a delay in OIT potentially collecting damages, which is insufficient to warrant denial of a stay. “When parties are competitors in the marketplace, delays in litigation are especially burdensome and weigh more heavily in favor of denying a stay,” *Cellular Commc’ns Equip., LLC v. Samsung Elecs. Co.*, 2015 WL 11143485, *2 (E.D. Tex. Dec. 16, 2015), but OIT admits it “has no products that practice the Asserted Claims.” Exhibit 1 at 14. OIT also failed to seek a preliminary injunction, which “contradicts” any assertion that it “cannot wait for a decision on infringement.” *Stingray Music USA, Inc. v. Music Choice*, 2017 WL 9885167, *2 (E.D. Tex. Dec. 12, 2017) (granting stay). While OIT purportedly desires a permanent injunction (Dkt. No. 1 at ¶¶ 40, 66, 87, 107), when it is “not a competitor of [Sony] in the market for products that contain the technology at issue, the prospect of an injunction is low.” *CyWee Grp. Ltd. v. Samsung Elecs. Co.*, 2019 WL 11023976, *4 (E.D. Tex. Feb. 14, 2019). Instead, monetary damages are sufficient to compensate OIT, as a non-practicing entity, for any alleged patent infringement. *Cypress Lake Software, Inc. v. Samsung Elecs. Am., Inc.*, 2019 WL 13335932, *2 (E.D. Tex. Aug. 28, 2019). “[M]ere delay in collecting those damages does not constitute undue prejudice.” *Stragent LLC v. BMW of N. Am., LLC*, 2017 WL 3709083, *2 (E.D. Tex. July 11, 2017).

Ultimately, while a stay will delay OIT’s “timely enforcement of its patent rights ... this factor is present in every case in which a patentee resists a stay, and is therefore not sufficient, standing alone, to defeat a motion to stay.” *Cobblestone Wireless, LLC v. Cisco Sys., Inc.*, 2024 WL 5047854, *2 (E.D. Tex. Dec. 9, 2024).

Moreover, OIT’s own delay in bringing this lawsuit and litigating its case confirms that a stay would not unduly prejudice OIT. OIT waited fourteen years after the issuance of the ’805 patent, ten years after the issuance of the ’339 patent, and nearly three years after the issuance of the ’685 and ’266 patents, to bring this lawsuit against Sony. That delay in filing suit “undermin[es]” any suggestion by OIT that there is any “urgency of obtaining judicial relief.” *CyWee*, 2019 WL 11023976 at *4 (finding lack of undue prejudice with delay of more than three years after issuance of patents before bringing suit); *VirtualAgility*, 759 F.3d at 1319 (undue prejudice not found where plaintiff waited nearly a year after the patent issued before bringing suit). Moreover, many of the Sony products accused of infringement have been on the market for many years. *Supra* p. 2. OIT’s delay in filing this lawsuit despite the presence of the accused Sony products on the market for many years further confirms that OIT faces no undue prejudice from a stay. *Personal Audio LLC v. Google, Inc.*, 2015 WL 12915558, *2 (E.D. Tex. Nov. 3, 2015) (finding that 20-month delay from knowledge of accused product to lawsuit suggested that plaintiff would not be prejudiced by stay). Compounding OIT’s delay in bringing suit is OIT’s failure to serve Sony with its complaint for over half a year after filing the suit. Undoubtedly in an effort to establish venue in this Court, OIT sued only Sony Corporation, a foreign entity—and not any of the domestic Sony entities that actually sell the accused products—then waited almost seven months to serve the complaint. Given OIT’s extreme delay in suing and litigating this case, OIT cannot credibly argue that it faces undue prejudice from a stay.

B. The Early Stage of the Litigation Supports a Stay

This case is still in its early stages, with most of the significant pre-trial events, including the *Markman* hearing, expert discovery, dispositive motions, pre-trial disclosures, and trial, yet to occur. “Staying a case at an early juncture can advance judicial efficiency and maximize the likelihood that neither the court nor the parties expend their assets addressing invalid claims.” *Landmark Tech., LLC v. iRobot Corp.*, 2014 WL 486836, *3 (E.D. Tex. Jan. 24, 2014). While courts will consider “whether discovery is complete and a trial date has been set” under this factor when evaluating a stay motion, *NFC*, 2015 WL 1069111 at *2—both of which favor a stay in this case— “[a] case need not be in its infancy to warrant a stay.” *Norman IP Holdings, LLC v. TP-Link Techs., Co.*, 2014 WL 5035718, *3 (E.D. Tex. Oct. 8, 2014). Therefore, “[c]ourts often find the stage of litigation weighs in favor of a stay if there remains a significant amount of work ahead for the parties and the court, even when the parties and/or the court have already devoted substantial resources to the litigation.” *Id.* In particular, “even after the completion of claim construction and most of the discovery in the case, the most burdensome part of the case, for both the parties and the court, is the period immediately before, during, and after trial.” *CyWee*, 2019 WL 11023976 at *6; *see also Cypress Lake*, 2019 WL 13335932 at *4 (granting stay: “Here, the most burdensome parts of the case, for both the parties and the Court, still remained as of July 12, including finalizing expert discovery, briefing summary judgment and *Daubert* motions, preparing pretrial disclosures and motions in limine, and of course, trying this case.”). When assessing this factor, “the time of the motion is the relevant time to measure the stage of litigation.” *Cypress Lake*, 2019 WL 13335932 at *3.

At the time of this motion, there is still a significant amount of work ahead in the case. Courts in this District have granted a stay when “discovery was nearly complete and the trial date was four months away at the time the stay motion was filed.” *CyWee*, 2019 WL 11023976 at *6. In comparison, this case is significantly less far along. The *Markman* hearing and depositions are both still a month away, and expert discovery and summary judgment are further still down the road. Moreover, the trial, which is the most expensive and burdensome part of the case, is almost a year away—while a pretrial conference has been set for November 6, 2025, OIT’s counsel has a conflict with that date (Dkt. No. 65 at 2 n.5) and no trial date has been set.

Sony was also diligent in filing its IPR petitions and moving for a stay after its IPRs were instituted. *NFC*, 2015 WL 1069111 at *4 (“Another consideration that bears on this factor is whether the defendant acted with reasonable dispatch in filing its petitions for inter partes review and then, after the petitions were granted, in filing its motion for a stay.”). Sony began filing its IPRs only seven months after the complaint was filed, and finished filing IPRs on all four asserted patents a little more than eight months after the complaint was filed. *See id.* (“Given the complexity entailed in seeking inter partes review, a delay of seven and one-half months from the filing of the complaint is not unreasonable.”). Moreover, Sony’s IPRs were filed mere weeks after being served with the complaint and several months *before* OIT served its infringement contentions on September 27, 2024. *See id.* (finding petition filed four months after service of infringement contentions was warranted and collecting similar cases). Finally, Sony was diligent in moving for a stay, filing this motion on February 25, 2025, just over a month after the final IPR was instituted on January 17, 2025. *See Stragent*, 2017 WL 2839260 at *2 (delay of two months to file motion to stay after institution was not “unreasonable or intentional delay”).

The early stage of this case and Sony’s diligence both support a stay.

C. A Stay Will Simplify the Case and Promote Judicial Economy

IPRs simplify district court proceedings because “if the proceedings result in cancellation of some or all of the asserted claims, either some portion of the litigation will fall away, or the litigation will come to an end altogether.” *NFC*, 2015 WL 1069111 at *4. Further, “even if the PTAB does not invalidate any of these claims, the PTAB’s insight and expertise is likely to be of considerable assistance to the Court.” *Onpoint Sys., LLC v. Protect Animals With Satellites, LLC*, 2022 WL 2704166, *4 (E.D. Tex. July 12, 2022). Also, statutory estoppel—to which Sony has already agreed via a *Sotera* stipulation for the patent claims subject to its own IPRs—limits the invalidity challenges available in this case.⁶ *CyWee*, 2019 WL 11023976 at *8. Thus, regardless of the ultimate outcome of Sony’s IPRs, simplification is highly likely here. *NFC*, 2015 WL 1069111 at *4 (“[T]he PTAB’s decision to institute inter partes review ordinarily means that there is a substantial likelihood of simplification of the district court litigation.”).

The likelihood is high that Sony’s IPRs will invalidate at least some, if not all, of the challenged claims. *See* Exhibit 2 at 13 (in the most recent quarter, 52% of instituted claims were found unpatentable in PTAB final written decisions). “If the PTAB holds that the claims at issue in the IPR are invalid, the result will be that those claims will be canceled, and they will not be available ... to press in this or any other ongoing litigation.” *CyWee*, 2019 WL 11023976 at *8. Reducing the number of claims available for assertion will undoubtedly simplify this case and may result in this case’s dismissal or settlement. *NFC*, 2015 WL 1069111 at *4 (noting that “[i]n those cases resulting in effective invalidity of the patent, the suit will likely be dismissed” and “[t]he outcome of the [IPR] may encourage a settlement without the further use of the Court”).

⁶ Sony agrees to extend its *Sotera* stipulation to claims asserted in this case that are challenged in IPR2024-01220 and in any of the other Other Defendant’s IPRs, when instituted.

Even if Sony's IPRs are unsuccessful in invalidating asserted claims, the IPR proceedings will still simplify the issues for this Court. First, statutory estoppel will limit the invalidity arguments Sony can make in this Court with respect to the claims challenged in Sony's IPRs. Second, statements OIT makes during the course of the IPR trials will become part of the prosecution histories of the asserted patents. This will help elucidate the proper construction of any claims that are not invalidated, potentially streamlining the claim construction process. *Aylus Networks, Inc. v. Apple Inc.*, 856 F.3d 1353, 1361 (Fed. Cir. 2017) (“[S]tatements made by a patent owner during an IPR proceeding can be considered during claim construction and relied upon to support a finding of prosecution disclaimer.”). Third, allowing the PTAB to adjudicate the validity of the Sony Challenged Claims while this litigation is stayed “reduces what otherwise would be unavoidable duplication of effort and a possibility of inconsistent results between the administrative agency and the court.” *CyWee*, 2019 WL 11023976 at *9. Finally, even if unsuccessful, Sony's IPRs will still give the Court “the benefit of the expert agency's full and focused consideration of the effect of prior art on patents being asserted in litigation,” *NFC*, 2015 WL 1069111 at *4, and “the expertise of the PTAB judges in this field of art is likely to be of considerable assistance to the Court.” *CyWee*, 2019 WL 11023976 at *9. Particularly given the potential complexity of the technology in this case,⁷ “which is sure to challenge the ability of the jury to absorb and rationally decide issues of infringement and invalidity, there is a particularly high premium on simplification.” *CyWee*, 2019 WL 11023976 at *9. The potential simplification offered by Sony's IPRs weighs heavily in favor of a stay.

⁷ For example, the Court found it appropriate to appoint a Technical Advisor to assist the Court with claim construction. Dkt. No. 61.

While Sony's IPRs do not challenge every claim asserted in this litigation, "even when IPRs are instituted on fewer than all the asserted claims, the policies favoring simplification and the reduction of litigation burdens on the parties and the court are often applicable" and "courts in this district have regularly issued stays in cases in which IPR proceedings have been instituted on fewer than all the claims asserted in the related litigation." *CyWee*, 2019 WL 11023976 at *8 (granting stay when instituted IPRs addressed six of eleven asserted claims). Here, Sony's instituted IPRs challenge 24 of the 32 asserted claims, and instituted IPR2024-01220 challenges claim 20 of the '685 patent, for a total of 25 of 32, or 78%, of all asserted claims—considerably more than the 55% of asserted claims challenged via instituted IPRs in *CyWee*. Additionally, the remaining Other Defendants' IPRs—all but one of which will have institution decisions in the April-May time frame—collectively challenge the remaining asserted claims.

Moreover, even as to asserted claims not yet covered by instituted IPRs, "the validity of those claims could be affected by the PTAB's analysis of the claims before it, which involve related technology." *Id.* at *10. All of the unchallenged asserted claims depend from and/or heavily overlap with the Sony Challenged Claims. *See* Appendix A (highlighting in yellow and bolded text overlapping claim limitations between Sony Challenged Claims and unchallenged asserted independent claims). The PTAB's decisions regarding the Sony Challenged Claims will therefore provide guidance on the validity and construction of the unchallenged claims as well.

Finally, it will be difficult, if not impossible, for OIT to maintain in good faith allegations that the accused Sony products infringe the seven asserted claims not challenged in already-instituted IPRs, as confirmed by the severe deficiencies in OIT's infringement contentions for those claims. OIT should not be permitted to frustrate this stay motion merely by asserting—almost certainly temporarily—claims that plainly are not infringed.

For example, claim 28 of the '266 patent requires “digitally correcting for dust on a digital image sensor.” Dust, however, can be addressed in two ways: by avoiding the presence of dust on the image sensor in the first place (for example, by vibrating the sensor to shake off dust), or by applying digital techniques to correct for the effect of dust on a resulting digital image. Defendants’ Tutorial, Slide 14. OIT’s own infringement contentions confirm that the accused Sony cameras do not do the latter; the contentions cite no evidence of dust correction, and instead mention only “pixel mapping,” *see* Exhibit 3 (Appendix E4 to Plaintiff’s Local Rule 3-1 and 3-2 Disclosures) at 103-106—a feature that addresses defective pixels in the image sensor (which can show up as bright, or “hot,” pixels in a digital image); pixel mapping does not correct for dust.⁸

Claim 6 of the '339 patent (and by extension claims 7 and 10, which depend therefrom) requires “wherein at least one optical and/or digital aberration in the image file are identified by comparing image files in the database management system.” OIT’s infringement contentions provide zero evidence of such comparison, citing Sony documentation describing different file formats (e.g., RAW, JPEG) but with no indication that image comparison is performed, let alone to identify aberrations. Exhibit 4 (Appendix E2 to Plaintiff’s Local Rule 3-1 and 3-2 Disclosures) at 111.

Finally, claims 4, 8 and 21 of the '805 patent require separating specific objects in an image using “the differentiation of the depth-of-field.” OIT’s infringement contentions cite only object-tracking technology with no indication that the differentiation of the depth-of-field is utilized in the Sony accused products. Exhibit 5 (Appendix E1 to Plaintiff’s Local Rule 3-1 and 3-2 Disclosures) at 135-138, 399-402.

⁸ *See, e.g.*, <https://tinyurl.com/yvz5shhw>; <https://tinyurl.com/3wnbkwns>.

In short, even if the Court reaches, as part of its analysis of the “simplification” factor, the seven asserted claims that are not challenged in already-instituted IPRs, no weight should be afforded to these claims since Sony is confident they are not infringed and OIT has provided no contentions making an inference of infringement plausible. OIT should not be permitted to frustrate a stay motion by arbitrarily asserting such claims in order to argue that instituted IPRs do not address “all asserted claims.” Further, as discussed above, all seven of these claims *are* challenged by Other Defendants’ IPRs, so even if OIT chooses to continue asserting them after the April 18, 2025 claim-narrowing deadline, they are likely to be addressed by the PTAB in due course, resulting in simplification as discussed above. To the extent OIT wishes to investigate potential infringement of such claims (though doing so is, at best, a fishing expedition), it can do that after a stay if any of the claims survive IPR.

V. Conclusion

For the foregoing reasons, Sony respectfully requests that the Court stay this action.

Respectfully submitted,

Date: February 25, 2025

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CERTIFICATE OF SERVICE

I certify that this document is being filed through the Court's electronic filing system, which serves counsel for other parties who are registered participants as identified on the Notice of Electronic Filing (NEF). Any counsel for other parties who are not registered participants are being served by first class mail on the date of electronic filing.

/s/ Michael N. Rader

Michael N. Rader

CERTIFICATE OF CONFERENCE

The undersigned hereby certifies compliance with with Local Rule CV-7(h). Counsel for all defendants conferred with counsel for Plaintiff about the defendants' contemplated stay motions by telephone on February 10, 2025, and counsel for Sony also followed up on the issue by email sent to Plaintiff's counsel on February 24, 2025 after IPR2024-01220 was instituted. Counsel for Plaintiff indicated that it opposes this motion on the ground that the balance of stay factors does not favor a stay. Sony, on the other hand, believes that the balance of stay factors strongly favors a stay. The undersigned certifies that the negotiation over the contemplated stay motion, cordial and professional as it has been, has conclusively ended in an impasse. Accordingly, Sony respectfully requests that the Court rule on this motion.

/s/ Michael N. Rader

Michael N. Rader

APPENDIX A: COMPARISON OF CHALLENGED AND UNCHALLENGED CLAIMS

'805 Patent, Claim 1 – Challenged in Sony IPR	'805 Patent Claim 4 – Not Challenged in Sony IPR, But Challenged in Joint Defendants' IPRs
A digital imaging system for image filtration comprising:	A digital imaging system for image filtration comprising:
a digital camera mechanism, an optical lens mechanism, a digital sensor, a microprocessor, a digital signal processor, an application specific integrated circuit, system software, a database management system and a memory storage sub-system;	a digital camera mechanism, an optical lens mechanism, a digital sensor, a microprocessor, a digital signal processor, an application specific integrated circuit, system software, a database management system and a memory storage sub-system;
wherein the optical lens mechanism is a fixed focal length;	wherein the optical lens mechanism is a fixed focal length;
wherein the aberrations from the optical lens mechanism are corrected by applying digital filtration by using the application specific integrated circuit and the digital signal processor;	wherein the aberrations from the optical lens mechanism are corrected by applying digital filtration by using the application specific integrated circuit and digital signal processor;
wherein the microprocessor is used to provide digital and optical data to the digital signal processor;	wherein the microprocessor is used to provide digital and optical data to the digital signal processor;
wherein the system software is organized to identify specific optical aberrations and to access the database to identify specific corrections to the aberrations;	wherein the system software is organized to identify specific optical aberrations and to access the database to identify specific corrections to the aberrations;
wherein the system software forwards the data from the digital sensor to the digital processor;	wherein the system software forwards the data from the digital sensor to the digital processor;
wherein the digital signal processor selects a specific procedure to optimize the image and corrects the aberrations;	wherein the digital signal processor selects a specific procedure to optimize the image and corrects the aberrations;
wherein the data are forwarded from the digital sensor to the digital signal processor by an application specific integrated circuit;	wherein the data are forwarded from the digital sensor to the digital signal processor:
wherein the digital signal processor applies a fast Fourier transform to a data file in order to satisfy a user specified special effects function;	
wherein the digital signal processor modifies the data file by applying the special effects function; and	
	wherein a data file is analyzed by the microprocessor to separate specific objects in the image using the differentiation of the depth-of-field;
	wherein the digital signal processor applies filtration only to specific objects in the image;
	wherein the aberrations of the specific objects are corrected; and
wherein the modified data file consisting of the digital data optimized from the aberrations that are corrected from the original optical image is stored in memory.	wherein the digital signal processor forwards the modified data file to storage in memory.

'805 Patent, Claim 18 – Challenged in Sony IPR	'805 Patent, Claim 21 – Not Challenged in Sony IPR, But Challenged in Joint Defendants' IPRs
A method of image filtration which comprises:	A method of image filtration which comprises:
a digital camera mechanism, an optical lens mechanism, a digital sensor, a microprocessor, a digital signal processor, an application specific integrated circuit, system software, a database management system and a memory storage sub-system;	a digital camera mechanism, an optical lens mechanism, a digital sensor, a microprocessor, a digital signal processor, an application specific integrated circuit, system software, a database management system and a memory storage sub-system;
wherein the aberrations from the optical lens mechanism are corrected by applying digital filtration by using the application specific integrated circuit and the digital signal processor, the method consisting of;	wherein the aberrations from the optical lens mechanism are corrected by applying digital filtration by using the application specific integrated circuit and digital signal processor, the method consisting of;
	analyzing a data file by the microprocessor to separate specific objects it the image using the differentiation of the depth-of-field:
forwarding the data from a digital sensor to a digital signal processor by an application specific integrated circuit;	forwarding the data from a digital sensor to a digital signal processor;
providing digital and optical data to the digital signal processor;	providing digital and optical data to the digital signal processor;
identifying specific optical aberrations and accessing a database to identify specific corrections to the aberrations:	identifying specific optical aberrations and accessing a database to identify specific corrections to the aberrations;
selecting a specific procedure from the database using the microprocessor to optimize the image and correct the aberrations:	selecting a specific procedure from the database using the microprocessor to optimize the image and correct the aberrations;
applying digital filtration by using the application specific integrated circuit and digital signal processor to correct digital or optical aberrations:	applying digital filtration by using the application specific integrated circuit and digital signal processor to correct digital or optical aberrations:
	correcting the aberrations of the specific objects in the image by applying the digital signal processor filtration; and
applying a fast Fourier transform to a data file in order to satisfy a user specified special effects function;	
modifying the data file by applying the special effects function using the digital signal processor; and	
storing the data file in memory.	forwarding the modified data file from the digital signal process to storage in memory.

'339 Patent, Claim 1 – Challenged in Sony IPR	'339 Patent, Claim 6 – Not Challenged in Sony IPR
A digital imaging system for correcting optical image aberrations comprising:	A digital imaging system for correcting image aberrations comprising:
a digital camera mechanism, an optical lens mechanism, a digital sensor, a microprocessor, a digital signal processor, system software, a database management system and a memory storage sub-system;	a digital camera mechanism, an optical lens mechanism, a digital sensor, an integrated circuit, a digital signal processor, system software, a database management system and a memory storage sub-system;
wherein the optical lens mechanism is a fixed focal length lens;	wherein the optical lens mechanism is a zoom lens or a fixed focal length lens;
wherein a microprocessor uses system software to identify at least one optical aberration by accessing the database;	
wherein the microprocessor uses the database to identify at least one algorithm to use to correct the at least one optical aberration;	
wherein when the image file is captured by the digital sensor the digital file is forwarded to the digital signal processor;	
	wherein the image data file is forwarded from the digital sensor to storage in memory;
	wherein at least one optical and/or digital aberration in the image file are identified by comparing image files in the database management system by using the system software and the integrated circuit;
	wherein the at least one filtration algorithms required to correct the at least one optical and/or digital aberration are sent from the integrated circuit to the digital signal processor;
wherein the image file with the at least one optical aberration is corrected by applying digital filtration by using at least one algorithm in the digital signal processor; and	wherein the at least one optical and/or digital aberration from the optical lens mechanism are corrected by using the digital signal processor to apply digital filtration algorithm; and
wherein the modified digital file consisting of the digital data optimized from the at least one optical aberration that are corrected from the original optical image is stored in memory.	wherein the modified digital file consisting of the digital data optimized from the at least one aberration that are corrected from the original optical image is stored in memory.