Trials@uspto.gov
571-272-7822

Paper 23
Date: March 11, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION,
Petitioner,

v.

OPTIMUM IMAGING TECHNOLOGIES, LLC,
Patent Owner.

IPR2024-00923 (Patent 10,873,685 B2)[1]
IPR2024-00924 (Patent 7,612,805 B2)
IPR2024-00925 (Patent 8,451,339 B2)
IPR2024-01046 (Patent 10,877,266 B2)

Before MIRIAM L. QUINN, GARTH D. BAER, and RUSSEL E. CASS, *Administrative Patent Judges.*

QUINN, Administrative Patent Judge.

ORDER

Granting Patent Owner's Request to file
Motions to Terminate the Proceedings
37 C.F.R. §§ 42.5, 42.20

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[1] The combined caption is for administrative convenience only. The parties are not authorized to use this caption without express permission of the Board.

Sony Corporation ("Petitioner") filed petitions in each of the proceedings identified above, and Optimum Imaging Technologies, LLC ("Patent Owner") filed preliminary responses. *See*, *e.g.,* Papers 2 ("Pet."), 7 ("Prelim. Resp.").[2]

In its preliminary responses, Patent Owner requested discretionary denial of institution due to the pendency of a related district court proceeding, arguing denial was warranted under *Fintiv*.[3,4] *See*, *e.g.*, Prelim. Resp. 2–9. In instituting trials, we denied Patent Owner's requests because Petitioner had provided "a so-called *Sotera*[5] stipulation, stating that if IPR Nos. IPR2024-00923–00925, and 01046 are instituted, Sony will not pursue any ground that [Sony] raised or reasonably could have raised during the IPRS in the related district court proceeding.'" Paper 11, 8 (internal citations and quotations omitted). As a result, each of the petitions fell within the safe harbor provided by the *Interim Procedure for Discretionary Denails in AIA Post-Grant Proceedings with Parallel District Court Litigation* (June 21, 2022) ("Fintiv Memo").

On February 28, 2025, the Office rescinded the Fintiv Memo. The next day, Patent Owner emailed the Board in each proceeding, requesting "authorization to file a motion to terminate this proceeding . . . in view of

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[2] We reference the papers filed in IPR2024-00923, but similar papers were filed in IPR2024-00924, IPR2024-00925, and IPR2024-01046.
[3] *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB, Mar. 20, 2020) (precedential).
[4] Although Patent Owner's specific arguments differed among the proceedings, they all requested denial under *Fintiv.*
[5] *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18–19 (PTAB, Dec. 1, 2020) (precedential)

parallel district court litigation." Ex. 3001. We grant Patent Owner's requests in view of the Office's rescindment of the Fintiv Memo.

Patent Owner's motions to terminate shall not exceed 10 pages and are due no later than March 14, 2025. Petitioner is likewise authorized to file oppositions to the motions, not to exceed 10 pages, and due no later than March 26, 2025. No further briefing is authorized at this time.

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's requests for authorization to file a motion to terminate in each of IPR2024-00923, IPR2024-00924, IPR2024-00925, and IPR2024-01046 is *granted*;

FURTHER ORDERED that, in each proceeding, Patent Owner's motion to terminate shall not exceed 10 pages and is due no later than March 14, 2025;

FURTHER ORDERED that Petitioner is authorized to file an opposition to the motion to terminate filed in each proceeding; and

FURTHER ORDERED that, in each proceeding, Petitioner's opposition shall not exceed 10 pages and is due no later than March 26, 2025.

IPR2024-00923 (Patent 10,873,685 B2)
IPR2024-00924 (Patent 7,612,805 B2)
IPR2024-00925 (Patent 8,451,339 B2)
IPR2024-01046 (Patent 10,877,266 B2)

For PETITIONER:

Scott A. McKeown
Adam R. Wickman
Randy J. Pritzker
WOLF, GREENFIELD & SACKS, P.C.
SMcKeown-PTAB@WolfGreenfield.com
AWichman-PTAB@WolfGreenfield.com
RPritzker-PTAB@WolfGreenfield.com

For PATENT OWNER

Thomas M. Dunham
Robert W. Molitors
Elizabeth A. O'Brien
CHERIAN LLP
tom@dunham.cc
rmolitors@cherianllp.com
elizabetho@cherianllp.com