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Paper 26
Date: April 7, 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

Denying Patent Owner's 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.

We authorized Patent Owner's request to brief the issue of whether the captioned proceedings should be terminated based on a recent change of Board guidance. *See* Order, Paper 24. Patent Owner thus filed a Motion to Terminate ("Motion" or "Mot.") and Petitioner filed an Opposition to the Motion ("Opposition" or "Op."). Papers 25, 26, respectively.[2]

We deny the Motion for the reasons that follow.

I. BACKGROUND

We issued institution decisions in each of the captioned proceedings between November 18, 2024 and January 17, 2025, following the then-binding guidance on discretionary denials promulgated in the *Interim Procedure for Discretionary Denails in AIA Post-Grant Proceedings with Parallel District Court Litigation* (June 21, 2022) ("*Fintiv* Memo"). The Office rescinded the *Fintiv* Memo on February 28, 2025.

II. ANALYSIS

Patent Owner urges that we revisit our institution decisions because the proceedings are at an early stage and they should not have been instituted under "current USPTO policy." Mot. 1. Patent Owner argues that under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential) ("*Fintiv*") a reassessment of the status of the parallel district court litigation involving Sony Corporation (Petitioner) would warrant a denial of institution. Mot. 3–10.

Petitioner asks us to deny the Motion primarily because the Board should not give retroactive effect to the rescission of the *Fintiv* memo. Opp.

[2] We refer here to the papers filed in IPR2025-00923. However, substantively identical papers were filed in the other captioned proceedings.

1–3. According to Petitioner, the Board should apply the three-factor test of *Princes Cruises, Inc. v. U.S.*, 397 F.3d 1358, 1362–1367 (Fed. Cir. 2005) and the outcome of that test warrants leaving the decisions on institution undisturbed. Opp. 3–5. In the alternative, Petitioner asks us to deny the Motion because a reassessment of the parallel district court litigation under *Fintiv* would not warrant the exercise of discretion to deny institution. *Id.* at 5–10.

We agree with Petitioner that we should not give retroactive effect to the rescission of the *Fintiv* memo. We follow the *Guidance on USPTO's Rescission of "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,"* issued March 24, 2025 ("*Rescission Guidance*").[3] The rescission of the *Fintiv* memo, according to the *Rescission Guidance*, "applies to any case in which the Board has not issued an institution decision, or where a request for rehearing or Director Review of an institution decision was filed and remains pending." *Rescission Guidance* at 2. In these proceedings, there are no pending requests for rehearing nor pending Director Review requests. Accordingly, bound by the express letter of the *Rescission Guidance*, we cannot apply the rescission retroactively here and reassess the outcome of the institution decisions under *Fintiv*.

The *Rescission Guidance* also states that "[a]bsent extraordinary circumstances, the Board will not revisit a decision on institution if the time

[3] Available from the USPTO website at: https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf.

for seeking Director Review or rehearing has passed." *Id.* The time for seeking rehearing and Director Review in the captioned proceedings has passed. Under 37 C.F.R. § 42.71(d)(1) a party dissatisfied with a decision granting institution of trial has 14 days to file a request for rehearing. Under 37 C.F.R. § 42.75 (c)(1), a request for Director Review must be filed within the time set forth in § 42.71(d) unless an extension is granted by the Director upon a showing of good cause. There have been no extensions to the times set forth in § 42.71(d) and § 42.75 (c)(1). And we find no "extraordinary circumstances" warranting reconsideration of the discretionary denial analysis in our decisions on institution.

Finally, we decline to determine whether an evaluation of the *Princess Cruises* three-factor test proposed by Petitioner would also support our denial of this Motion. It suffices that under the *Rescission Guidance*, and on the facts we have here, we have no recourse to disturb the outcome of the institution decisions.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's Motion to Terminate, filed in each of the captioned proceedings, is denied.

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