

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARASHI VISION (U.S.) LLC (D/B/A INSTA360)
Petitioner,

v.

GOPRO, INC.
Patent Owner.

Case No. IPR2024-00984
U.S. Patent No. 10,015,413

PATENT OWNER'S MOTION TO STRIKE

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Pursuant to the Board's email of August 19, 2025, Petitioner respectfully requests that the below arguments and evidence be stricken.

I. LEGAL STANDARD

While a petitioner may “respond to arguments raised in the corresponding ... patent owner response” (37 C.F.R. § 42.23(b)), a petitioner “may not submit new evidence or argument in reply that it could have presented earlier, e.g. to make out a prima facie case of unpatentability.” Consolidated Trial Practice Guide at 73 (Nov. 2019).

A clear example is when a Petitioner “presents new issues by changing the unpatentability rationale from express reliance on [a reference's teachings], to asserting that those [teachings] would have been obvious to modify, as well as presenting new evidence to support the new rationale.” *Intelligent Bio-Systems v. Illumina Cambridge*, 821 F.3d 1359, 1366 (Fed. Cir. 2016); *see also Yita LLC v. MacNeil IP LLC*, 69 F.4th 1356, 1367 (Fed. Cir. 2023) (“Yita waited until its reply to present what in substance is an argument that it would have been obvious to a relevant artisan to modify Rabbe ... This argument was a meaningfully distinct contention ... from those made in Yita's petition, which focused ... only on what Rabbe discloses.”).

II. PETITIONER'S NEW PALM TREO THEORY

Ground 4 of the Petition relies on Meulen in view of Chao. As Patent Owner made clear, Meulen does not disclose that its device performs its algorithms on any image captured by the device's embedded camera. POR 13-17. In response, Petitioner argues it would have been obvious to apply Meulen to a Palm Treo device, with new evidence suggesting that some Palm Treo devices captured images using a different aspect ratio than that used for its display. Reply 6-7 (citing EX1018, EX1022, EX1023, EX1024); EX1014, ¶¶31-32, 37. These arguments should be stricken from the Reply and Petitioner's supplemental expert declaration.

Petitioner has revised its Ground 4 to be based on a Palm Treo, as purportedly described by at least two different documents (EX1018 and one of EX1022, EX1023, and EX1024), modified in view of Meulen and Chao. Putting aside that Petitioner does not argue the Palm Treo documents were publicly available before the '413 patent's earliest filing date or proffer any rationale to combine or reasonable expectation of success, Petitioner's Palm Treo theory relies on new argument and evidence to cure a facial deficiency in the Petition—precisely what the Federal Circuit warned against and what the Board's rules forbid.

Petitioner cannot argue that the Palm Treo theory simply expands on any argument found in the Petition or is in response to Patent Owner's Response. The

Petition merely, but incorrectly, asserted that “Meulen’s media source content is an ‘input image’” (Pet. 88) and that “Digital cameras comprise an image sensor configured to capture an input image” (Pet. 104). The Petition made no effort to argue that Meulen’s “media source content” was captured by the device itself—indeed the Petition provides no cite to Meulen stating or even suggesting that this is possible. Pet. 104. Since Meulen provides no such disclosure, it is improper for Petitioner to, at this late hour, present a completely new theory of invalidity based on modifying a Palm Treo.

While Meulen mentions that its device can be a Palm Treo (EX1007, 2:12), Petitioner cannot credibly argue that Meulen incorporated by reference any of the Palm Treo documents that Petitioner now relies on, for Meulen never “identif[ies] with *detailed particularity* what specific material” to incorporate. *Advanced Display Systems, Inc. v. Kent State University*, 212 F.3d 1272, 1282 (Fed. Cir. 2000).

III. PETITIONER’S NEW SUB-SAMPLING THEORY

PO’s Response pointed out that Meulen does not disclose pixel shifting but instead expressly performs pixel compression using “polyphase filtering,” which is a shift invariant approach. POR 11, 30; EX1007, 5:23-29. Petitioner’s Reply introduces a new theory combining Meulen with a method called “sub-sampling.” Reply 13-14. Meulen does not mention sub-sampling at all—instead, the Petition

solely relies on a new expert declaration. *Id.* (citing EX1014, ¶¶56-57). The Reply's sub-sampling theory attempts to cure a lack of disclosure in Meulen with its own expert's hindsight-driven testimony about sub-sampling, which Petitioner does not even assert was known before the '413 patent. These arguments and evidence should be stricken.

IV. PETITIONER'S NEW CAMERA THEORIES

As the Board noted in its Institution Decision, Petitioner failed to provide “any evidence in Grounds 1 and 3, other than the Dr. Katsaggelos's testimony, for its assertion that in 2013, cameras captured images in one aspect ratio and stored or displayed those images in a different aspect ratio.” ID, 35. Petitioner now seeks to improperly introduce new evidence and new grounds asserting that it would be obvious to modify various allegedly prior art cameras in view of Fleming or Obara. Reply 21-24, 26-27; EX1014, ¶¶80-88, 91, 105-112. Petitioner also newly asserts that such combinations would have a reasonable expectation of success. Reply 25, 26-27.

Once again, Petitioner is attempting to shift from grounds that relied on Fleming or Obara alone to grounds that assert unpatentability based on alleged prior art cameras modified in view of Fleming and Obara.

While the Petition did argue that it would be obvious to use Fleming or Obara “within a camera” (Pet. 28, 71), that is not a proper reason for Petitioner to introduce all new evidence that essentially changes its grounds of challenge to, for example, a Canon camera modified by Fleming or Obara. *Interactive Communications Int’l, Inc. v. Blackhawk Network Inc.*, IPR2023-01235, Paper 34 at 54 (Feb. 6, 2025) (“[W]e find that Petitioner[] ... diverges too far from the challenge presented in the Petition that relies *exclusively* on [Petition art] as teaching... the Challenged Claims.”). Nor can Petitioner assert that the new camera evidence was simply background knowledge or part of the state of the art that an expert would bring to bear—Dr. Katsaggelos testified that he could not define the state of the art, including whether it included the camera references. EX2042, 47:1-19.

And Petitioner has no excuse for its failure to assert a reasonable expectation of success in its Petition, which was another facial deficiency. *Intelligent Bio-Systems*, 821 F.3d at 1365 (“A conclusion of obviousness requires a reasonable expectation of success”). It is simply improper for Petitioner to newly assert this required prong of its obviousness case on Reply.

Date: August 26, 2025

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CERTIFICATE OF SERVICE (37 C.F.R. §§ 42.6(E), 42.105(A))

The undersigned hereby certifies that the foregoing document was served in its entirety on August 26, 2025 upon the following parties via Electronic Mail:

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