

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.

Patent No. 10,015,413

Inter Partes Review No. IPR2024-00984

PETITIONER'S MOTION TO STRIKE

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. PATENT OWNER’S ARGUMENT THAT ELEMENTS 1[G] AND 2[E] EXCLUDE EMBODIMENTS OF SHIFTING ALONG ONE AXIS IS IMPROPER	1
III. PATENT OWNER’S “ONE” DISPLAY REGION ARGUMENT FOR MEULEN IS NEW AND TOO LATE.....	3
IV. PATENT OWNER’S NEW SEPARATE DEVICE ARGUMENT IS IMPROPER AND DOES NOT RESPOND TO ANY REPLY ARGUMENT.....	4
V. THE BOARD SHOULD REJECT PATENT OWNER’S SHIFT TO ARGUING PRESUMPTION OF NEXUS ARGUMENT.....	5

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Google LLC v. Uniloc 2017 LLC</i> , IPR2020-00447, Paper 24, 13-14 (PTAB May 11, 2021)	3
<i>Hewlett-Packard Co. v. Mustek Sys., Inc.</i> , 340 F.3d 1314 (Fed. Cir. 2003)	4
<i>ParkerVision, Inc. v. Vidal</i> , 88 F.4th 969 (Fed. Cir. 2023)	4
<i>Unwired Planet, LLC v. Google Inc.</i> , 841 F.3d 995 (Fed. Cir. 2016)	4
Other Authorities	
37 C.F.R. § 42.23(b)	3

I. INTRODUCTION

Pursuant to the Board’s email authorization on September 16, 2025 (EX3002), Petitioner submits this motion to strike four new arguments of Patent Owner’s Sur-reply (Paper 37):

- Elements 1[g] / 2[e] of the ’413 patent excludes the specification’s embodiments of non-uniformly shifting along one axis;
- Meulen’s option of applying non-uniform shifting to “*one* or more of the display regions” means it does not non-uniformly shift all other display regions;
- The Fleming and Obara-Liu combinations improve on a hypothetical involving re-uploading a transformed image back to the camera for display; and
- There is a presumption of nexus for secondary considerations.

II. PATENT OWNER’S ARGUMENT THAT ELEMENTS 1[G] AND 2[E] EXCLUDE EMBODIMENTS OF SHIFTING ALONG ONE AXIS IS IMPROPER

For elements 1[g] and 2[e], the Petition showed that Meulen teaches non-uniform shifting along the horizontal direction, vertical direction, or both.

(Petition, 91.) In its Patent Owner Response (POR), Patent Owner made narrowing arguments that “non-uniform” means “non-linear,” and the claims require the steps be performed in a certain order. But Patent Owner did not argue

in the POR that any disclosed passage of the '413 specification is excluded from the '413 claims. It's expert confirmed, offering testimony consistent with Patent Owner's position at the time of the POR. (EX1015, 21:13-18 ("Q. . . . So my question is, are there any examples described in the '413 specification that are not covered by Claim 1 of the '413 patent?" "[A.] I don't believe so, no.").)

Specifically, in its POR, Patent Owner points to two sets of equations in the '413 specification that are allegedly applied "to every pixel": the equations at 6:65-7:5 "for horizontal pixel shifting," and the equations at 7:6-42 "for the vertical shift." (POR, 26-27.) Patent Owner then switches gears in its Sur-reply, now contending that the sentence describing the 6:65-7:5 equations is "**not** embodied by the limitation." (Sur-reply, 23-24 (emphasis added).)

Patent Owner's new Sur-reply argument is not responsive to any alleged mischaracterization of the '413 claims and is improper because it runs counter to its POR argument. The 6:65-7:5 equations cannot be both encompassed by the '413 claims (POR, 26-27) while also excluded from it (Sur-reply, 23-24). The Board should not allow Patent Owner to present one theory in its POR and then pivot to a different theory on Sur-reply. PTAB Consolidated Trial Practice Guide, 74 (Nov. 2019) (Sur-reply arguments cannot "proceed in a new direction with a new approach as compared to the positions taken in a prior filing.").

III. PATENT OWNER’S “ONE” DISPLAY REGION ARGUMENT FOR MEULEN IS NEW AND TOO LATE

The Petition pointed to the passage at 10:19-26 of Meulen (“[image] [c]ompression and/or scaling may be applied in a horizontal direction and/or in a vertical direction”) to show that its non-uniform shifting is along both axes. (Petition, 90-92.) Patent Owner’s POR rebuttal pointed to Table 1 and 5:65-67, and argued that *each* region’s compression is affected by the horizontal position only and applied to the horizontally-aligned lateral display regions only. (POR, 38-41.) The Reply again pointed to 10:19-26—the same passage and argument in the Petition—and explained how this passage shows non-uniform shifting in the vertical direction. (Reply, 18-20.) The Sur-reply then abandoned its POR argument and retreats to different passages, 5:67-6:3 and 8:15-18 in Meulen. It argues that Meulen’s option of non-uniformly shifting “*one* or more display regions” means it does not non-uniformly shift all other display regions. (Sur-reply, 24.) This change from “each” region in the POR to only “one” region in the Sur-reply is improper. And now is too late. Patent Owner had the opportunity to rebut the Petition’s showing in the POR, but chose not to. *Google LLC v. Uniloc 2017 LLC*, IPR2020-00447, Paper 24, 13-14 (PTAB May 11, 2021) (rejecting Patent Owner “improperly ma[king] this new argument for the first time its Sur-reply . . . Patent Owner has not adequately explained why it did not raise this argument in its Response.”); 37 C.F.R. § 42.23(b) (“A sur-reply may only respond

to arguments raised in the corresponding reply.”).

The Federal Circuit rejected a similar strategy. In *ParkerVision, Inc. v. Vidal*, the POR argued the prior art’s capacitors were not storage elements because they were not part of “an energy transfer system.” 88 F.4th 969, 980 (Fed. Cir. 2023). On Sur-reply, ParkerVision improperly pivoted, arguing that the reason the capacitors were not storage elements was because they stored “negligible amounts of energy.” *Id.*, 981. Likewise, here, the POR presents one theory (based on horizontal positions and horizontally-aligned lateral display regions only) and the Sur-reply presents another theory (based on one display region only). Patent Owner’s change in theory is improper.

Nevertheless, Meulen’s disclosure of “or more” still satisfies the ’413 claims. *Hewlett-Packard Co. v. Mustek Sys., Inc.*, 340 F.3d 1314 (Fed. Cir. 2003) (“[p]rior art product that *sometimes, but not always*, embodies claimed method [nonetheless] teaches that aspect of invention.”) (emphasis added); *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1002 (Fed. Cir. 2016) (“It is enough that the combination would *sometimes* perform all the method steps”) (emphasis added).

IV. PATENT OWNER’S NEW SEPARATE DEVICE ARGUMENT IS IMPROPER AND DOES NOT RESPOND TO ANY REPLY ARGUMENT

The Petition presented single reference obviousness for Ground 1 based on

Fleming, and obviousness for Ground 3 based on Obara and Liu. It argued that it would have been obvious for Fleming's and Obara's processor(s) to be included within a camera. (Petition, 28, 71.) The Reply emphasized the same argument in the Petition by stating that "a POSITA would have been motivated to apply Fleming's non-uniform shifting by processor(s) included within a camera because of the benefits of being less burdensome, cheaper, and saving time *compared to applying non-uniform shifting by a separate device.*" (Reply, 20-21 (emphasis added).) The Reply also rebutted Patent Owner's POR arguments that digital cameras at the time of the '413 patent did not need aspect ratio conversion. (Reply, 21-22.) But then Patent Owner introduces a new argument in its Sur-reply by mischaracterizing the motivation presented in both the Petition and the Reply. Nowhere did the Petition or Reply present a motivation against a "hypothetical . . . [involving] re-uploading the image back to the camera for display." (Sur-reply, 27.) This argument should be stricken from the Sur-reply.

V. THE BOARD SHOULD REJECT PATENT OWNER'S SHIFT TO NOW ARGUING PRESUMPTION OF NEXUS ARGUMENT

In its POR, Patent Owner argued that "there is a *direct* nexus between SuperView and the objective evidence." (POR, 49 (emphasis added).) Yet in its Sur-reply, Patent Owner changes course and argues "a *presumptive* nexus for SuperView." (Sur-reply, 24-25 (emphasis added).) The Board should reject Patent Owner's attempt to once again shift theories.

Dated: September 23, 2025

By: /s/ Jean Nguyen

Jean Nguyen

Reg. No.: 71,051

MORRISON & FOERSTER LLP

707 Wilshire Blvd., Suite 6000

Los Angeles, CA 90017

Email: JNguyen@mofo.com

Tel: 213-892-5200

Counsel for Petitioner

Certificate of Service (37 C.F.R. § 42.6(e)(4))

I hereby certify that the attached PETITIONER'S MOTION TO STRIKE was served as of the below date via e-mail (by agreement) to the following counsel of record for Patent Owner:

James M. Glass, Registration No. 46,729
John T. McKee, Registration No. 65,926
Quincy Lu, Registration No. 76,954
Patrick Schmidt (*pro hac vice*)
Nathaniel A. Hamstra, Registration No. 65,680
Quinn Emanuel Urquhart & Sullivan LLP
Email: jimglass@quinnemanuel.com
Email: johnmckee@quinnemanuel.com
Email: quincylu@quinnemanuel.com
Email: patrickschmidt@quinnemanuel.com
Email: nathanhamstra@quinnemanuel.com

Dated: September 23, 2025

/s/ Jean Nguyen
Jean Nguyen