

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 OPPOSITION TO
PETITIONER'S MOTION TO STRIKE**

Petitioner’s Motion to Strike (“Motion”) is riddled with mischaracterizations of Patent Owner’s positions. The alleged “new” arguments are anything but—they are consistent with Patent Owner’s POR arguments and responsive to Petitioner’s Reply arguments, several of which were new and improperly raised in the Reply. The Board should deny Petitioner’s Motion.

I. NON-UNIFORM PIXEL SHIFTING ALONG BOTH AXES

Patent Owner did not raise a new argument with respect to limitation 1[g]/2[e]. In its POR, Patent Owner established that, consistent with the embodiments in the specification, the claims require non-uniform pixel shifting along both axes. POR 19. In its Reply, Petitioner argued (incorrectly) that the ’413 specification discloses an embodiment where non-uniform shifting only occurs on the horizontal axis. Reply 19. In its Surreply, Patent Owner pointed out that this embodiment still performs warping on both axes, first on the horizontal and then on the vertical. Surreply 23 (citing EX1001, 5:29-32). Patent Owner also stated that “*even if* the embodiment only performed horizontal shifting (*it does not*),” then clearly such an embodiment would not be covered by the claims as they require the non-uniform pixel shifting to be based on the input locations of *both axes*. Surreply 23-24. If pixel shifting (whether non-uniform or not) does not occur on the vertical axis, then the input position of the vertical axis would play no part in the pixel shift and therefore not practice the limitation.

Patent Owner's argument is a proper response to Petitioner's incorrect mischaracterization of the '413 patent. Petitioner is simply wrong that Patent Owner "switch[ed] gears," as it was and remains Patent Owner's position that embodiments in the '413 patent practice this limitation. Patent Owner is permitted to respond that *even if* Petitioner's characterization of the '413 patent is correct (which it is not), it is irrelevant, as claims do not necessarily need to cover all embodiments.

II. MEULEN'S LACK OF NON-UNIFORM SHIFTING ON BOTH AXES

The POR directly addressed the Petitioner's citation to Meulen at 10:19-26 ("image compression and/or scaling may be applied in a horizontal direction and/or in a vertical direction") by pointing out that this teaching does not in any way expressly state that vertical compression is performed non-uniformly, but instead that it describes applying "*uniform* vertical scaling." POR 40.

In its Reply, Petitioner raised the new argument that the phrase "image compression and/or scaling" must "refer[] to its non-uniform shifting method" because the phrase is allegedly used elsewhere to refer to Meulen's linear piecewise compression. Reply 19. Consistent with its POR argument, Patent Owner responded by pointing out that the phrase "image compression and/or scaling" is used by Meulen to refer to *uniform* compression for a single display region. Surreply 24 (citing EX1007, 5:67-6:3, 8:15-18).

Clearly, Patent Owner's Surreply argument is both responsive to Petitioner's

new Reply argument and entirely consistent with its POR position. There was no “abandon[ment of] its POR argument.” Motion 3. Petitioner’s claim that Patent Owner changed its theory is nonsensical and wrong. Patent Owner’s POR and Surreply positions are the same: Meulen teaches performing linear piecewise compression only on the horizontal axis and the off-hand remark at 10:19-26 only refers to adding *uniform* compression/scaling on the vertical axis.

Petitioner improperly inserts a new argument on the merits in its motion. Motion 4 (“Meulen’s disclosure of ‘or more’ still satisfies the ’413 claims.”). Regardless, Petitioner is wrong. That “image compression and/or scaling” can be applied to more than one display region does not change the fact that the phrase still refers to uniform compression/scaling, but being applied individually to each region—though there may be multiple regions, there is no dispute that each individual region in Meulen is uniformly compressed.

III. THE “SEPARATE DEVICE ARGUMENT” IS PETITIONER’S NEW ARGUMENT, NOT PATENT OWNER’S

Reinforcing that Petitioner’s motion is meritless, Petitioner makes the bizarre claim that Patent Owner made a “new separate device argument.” Motion 4-5. It was *Petitioner* that made a new “separate device argument” in its Reply, not Patent Owner. The Petition provided a vague, conclusory motivation for applying Fleming/Obara to a camera: that it “would have been less burdensome, cheaper, and saves time.” Pet. 28, 72. The Petition did not mention anything about a “separate

device.”

Following the Board’s preliminary rejection of Petitioner’s flawed motivation to combine in the Institution Decision, Petitioner raised several new arguments and voluminous new exhibits in its Reply (which are the subject of Patent Owner’s motion to strike)—one of Petitioner’s new arguments is that applying Fleming/Obara to a camera would be an improvement over using “a separate device” to perform aspect ratio conversion for display on the camera’s screen. Reply 20-21. The Surreply pointed out that the Reply’s new motivation was a nonsensical strawman that posited Fleming/Obara rendered obvious applying a transformation to an image generated by the internal camera because otherwise, the image would have needed to be sent to a separate device first, transformed, and then sent back to the camera device for display. Surreply 27. But this motivation makes no sense, and *presupposes* that the modification would have been obvious, rather than providing a motivation to do so. *Id.*

The Surreply argument is clearly responsive to Petitioner’s new Reply argument. Petitioner’s claim that it did not present such a hypothetical in its Reply is false. Pet. 28 (“[I]t would have been obvious for the digital camera to ... transform the captured image into an output image ... to be presented on the camera display.”); Reply 20-21 (obviousness combination “eliminates the need to transfer data between the camera and separate device”).

IV. GOPRO'S PROPER NEXUS AND UNMET NEED POSITIONS

The POR cited a “direct nexus” because much of the secondary consideration evidence is specifically for GoPro’s SuperView feature. POR, 49-59. Petitioner replied that Patent Owner had not established any presumption of nexus. Reply 29. The Surreply addresses this by showing, as it did in the POR, that the evidence is specifically for the SuperView feature such that it does in fact establish a presumption of nexus. The Surreply argument is responsive to Petitioner’s argument and is entirely consistent with the POR.

Date: September 30, 2025

By: /s/ James Glass

James M. Glass (Reg. No. 46,729)
QUINN EMANUEL URQUHART &
SULLIVAN LLP
295 5th Avenue
New York, NY 10016
Email: jimglass@quinnemanuel.com
Phone: 212-849-7142
Fax: 212-849-7100

*Counsel for Patent Owner
GoPro, Inc.*

CERTIFICATE OF LENGTH (37 C.F.R. §§ 42.24)

The undersigned hereby certifies that this document is within the 5 pagers authorized by the Board.

Date: September 30, 2025

By: /s/ James Glass

James M. Glass (Reg. No. 46,729)
QUINN EMANUEL URQUHART &
SULLIVAN LLP
295 5th Avenue
New York, NY 10016
Email: jimglass@quinnemanuel.com
Phone: 212-849-7142
Fax: 212-849-7100

*Counsel for Patent Owner
GoPro, Inc.*

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 September 30, 2025 upon the following parties via Electronic Mail:

ayap@mofo.com
marjomand@mofo.com
jnguyen@mofo.com
mofo_insta360-IPRs@mofo.com
AYuan@mofo.com
SMao@mofo.com

Date: September 30, 2025

By: /s/ James Glass
James M. Glass (Reg. No. 46,729)
QUINN EMANUEL URQUHART &
SULLIVAN LLP
295 5th Avenue
New York, NY 10016
Email: jimglass@quinnemanuel.com
Phone: 212-849-7142
Fax: 212-849-7100

*Counsel for Patent Owner
GoPro, Inc.*