

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION,

Petitioner

v.

OPTIMUM IMAGING TECHNOLOGIES LLC,

Patent Owner

Case IPR2024-01046

Patent No. 10,877,266

PATENT OWNER PRELIMINARY RESPONSE

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Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

<u>PATENT OWNER’S LIST OF EXHIBITS</u>	
EX. 2001	RESERVED
EX. 2002	RESERVED
EX. 2003	RESERVED
EX. 2004	RESERVED
EX. 2005	RESERVED
EX. 2006	RESERVED
EX. 2007	RESERVED
EX. 2008	RESERVED
EX. 2009	RESERVED
EX. 2010	RESERVED
EX. 2011	U.S. Patent No. 7,612,805 (“the ’805 Patent”)
EX. 2012	U.S. Patent No. 8,451,339 (“the ’339 Patent”)
EX. 2013	RESERVED
EX. 2014	RESERVED
EX. 2015	Email from Petitioner’s counsel to Patent Owner’s counsel, dated September 4, 2024
EX. 2016	Institution Decision, IPR2020-01321, Paper 10 (PTAB March 1, 2021)
EX. 2017	Institution Decision, IPR2020-01322, Paper 10 (PTAB March 1, 2021)

EX. 2018	Claim Construction Order, <i>Optimum Imaging Technologies LLC v. Canon Inc.</i> , No. 2:19-cv-00246, Dkt. 88 (E.D. Tex. June 11, 2020)
EX. 2019	Scheduling Order, <i>Optimum Imaging Technologies LLC v. Sony Corporation</i> , No. 4:23-cv-00928, Dkt. 46 (E.D. Tex. October 2, 2024)

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I. INTRODUCTION

Patent Owner respectfully submits this Patent Owner Preliminary Response (“POPR”) to request the Board deny institution. Petitioner challenges claims 1-27 and 29-30 of Patent No. 10,877,266 (“the ‘266 Patent”). Petition at 1. Petitioner’s arguments fail for at least two reasons.

First, Petitioner fails to establish that Niikawa and Watanabe-JP are properly combinable. As such, all Grounds fail.

Second, the proposed combinations are replete with hindsight bias. Petitioner fails to meet its burden to establish obviousness.

Additionally, Patent Owner requests the Board reject Petitioner’s belated stipulation as it relates to the *Fintiv* analysis in order to serve the interests of fairness and efficiency.¹

II. THE ’266 PATENT CLAIMS NOVEL AND NON-OBVIOUS METHODS FOR CORRECTING ABERRATIONS IN A DIGITAL CAMERA

The ’266 Patent claims methods that perform in-camera aberration correction using novel and non-obvious combinations of hardware and software.

¹ See *Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 11 (PTAB March 20, 2020)(precedential)(“*Fintiv*”).

EX. 1001 at Abstract (“A system is disclosed for the automated correction of optical and digital aberrations in a digital imaging system.”)

“Though every major advance in photography has solved an important problem, there are still remaining photographic problems to be solved in order to meet the goals of *optimizing optical imaging quality* while *increasing simplicity and efficiency* and *lowering cost*.” EX. 1001 at 3:21-25 (emphasis added).

“The present system dramatically improves image quality. This digital imaging system eliminates, or minimizes, post-production processes. In addition, the system presents substantial cost savings as well as time savings relative to existing digital imaging systems because of the automation of integrated in-camera optical and digital corrections of aberrations.” EX. 1001 at 7:26-31.

To achieve the advantages described in the specification, the independent claims of the '266 Patent recite, *inter alia*, “a digital camera,” “in-camera software,” and “a database system” wherein the digital camera can be upgraded to improve the in-camera aberration correction process. As claimed, the methods include upgrading the digital camera with updated software and/or correction data. The methods also include digitally processing at least one captured image to produce a corrected image and wirelessly transmitting the corrected image, for example, to an external monitor such as a personal computer or to external storage, etc.

As explained in the '266 Patent, “[t]his in-camera corrective feature provides a powerful tool to rapidly manipulate an image without using post-production editing software tools.” EX. 1001 at 16:34-36.

The '266 Patent includes 30 claims, with claims 1 and 22 being independent.

Independent claims 1 and 22 are set forth below:

Claim 1	
1[pre]	A method of processing one or more images with a digital camera, comprising:
1[a]	digitally processing at least one captured image, the processing using in-camera hardware and software that is configured to:
1[a-1]	perform a plurality of image correction algorithms,
1[a-2]	process image correction data stored in a database system,
1[a-3]	receive updated software and image correction data, and
1[a-4]	upgrade the digital camera with the updated software and image correction data;
1[b]	storing in memory one or more corrected images resulting from digitally processing the at least one captured image; and
1[c]	wirelessly transmitting at least one of the one or more corrected images,
1[d]	wherein the in-camera software and database system are upgradable to provide improved algorithms and correction data for correction of images.
Claim 22	
22[pre]	A method of displaying one or more images captured by a digital camera on an external monitor, comprising:
22[a]	digitally processing at least one captured image to produce one or more corrected image, the processing using in-camera hardware and software that is configured to:
22[a-1]	perform a plurality of image correction algorithms,
22[a-2]	process image correction data stored in a database system,
22[a-3]	store updated software or image correction data or both, and
22[a-4]	upgrade the digital camera with the updated software or image correction data or both; and

22[b]	wirelessly transmitting at least one of the one or more corrected images in a format that the external monitor can receive,
22[c]	wherein the in-camera software and database system are upgradable to provide improved algorithms and correction data for correction of images.

A. THE EXAMINER REVIEWED THREE PRIOR ART REFERENCES DURING ORIGINAL PROSECUTION

During original prosecution of the '266 Patent, the examiner reviewed the Niikawa, Ng, and Watanabe-US references and allowed the issued claims. EX. 1001 at code (56).² The examiner also reviewed the papers and exhibits from the Canon IPRs of related patents (*see supra*) and allowed the issued claims. This review included the expert testimony from the same expert, Dr. Laub, relied on in this IPR.

B. THE BOARD PREVIOUSLY DENIED INSTITUTION IN THE CANON IPRS INVOLVING OVERLAPPING PRIOR ART REFERENCES

The '266 Patent, U.S. Patent No. 7,612,805 ("the '805 Patent," EX. 2011), and U.S. Patent No. 8,451,339 ("the '339 Patent," EX. 2012) issued from related

² It is noted that for the Ng reference, the examiner reviewed U.S. Pub. No. 2007/0252074 which is a National Stage Entry and shares the same specification as WO 2006/039486 (EX. 1008).

continuation applications and claim priority to the same provisional application, No. 60/807,065 filed July 11, 2006.

A different petitioner, Canon Inc., challenged the '805 and '339 Patents in IPR2020-01321 and IPR2020-01322 (the "Canon IPRs"). The Canon IPRs involved the Niikawa and Watanabe-US references (as shown in bold in the bullets below), which are also at issue in this IPR.

The '805 Patent was challenged in IPR2020-01321 based on the following obviousness grounds (EX. 2016 at 3):

- **Niikawa**
- **Niikawa** + Kawanishi
- **Niikawa** + Russ
- **Watanabe-US**
- **Watanabe-US** + Russ

The Board denied institution finding that the merits did not outweigh the other *Fintiv* factors favoring denial. EX. 2016 at 11.

The '339 Patent was challenged in IPR2020-01322 based on the following obviousness grounds (EX. 2017 at 3):

- **Niikawa**
- **Niikawa** + Kita
- **Niikawa** + Kishida
- **Watanabe-US**
- **Watanabe-US** + Kita

The Board denied institution finding that the merits did not outweigh the other *Fintiv* factors favoring denial. EX. 2017 at 11.

The rationale for relying on Niikawa as a primary reference was substantially the same in IPR2020-01321 and IPR2020-01322 as well as in this IPR. The rationale for relying on Watanabe-US is also substantially the same in this IPR.

As done in the prior Canon IPRs, the Board should exercise its discretion to deny institution in this IPR.

C. PERSON OF ORDINARY SKILL IN THE ART (“POSA”) WAS PREVIOUSLY DEFINED BY THE DISTRICT COURT

Petitioner proposes a POSA would have had “a bachelor’s degree in electrical engineering, physics, or a related field, with at least two years of industry experience and/or research, both concerning digital camera system design and image processing.” Petition at 3.

In prior litigation involving the related ‘805 and ‘339 Patents, the district court found that a POSA would have had “an electrical engineering degree and three years of relevant experience.” EX. 2018 at 6.

Patent Owner submits that the district court’s definition of a POSA should be adopted for purposes of institution. Patent Owner reserves all rights regarding the correct definition of a POSA.

Petitioner’s expert, Dr. Laub, does not meet the definition of a POSA, at least because Dr. Laub does not have a degree in electrical engineering. *See* EX.

1004 at 6. As such, Dr. Laub is not qualified to offer expert testimony from the perspective of a skilled artisan. *Kyocera Senco Indus. Tools Inc. v. Int'l Trade Comm'n*, 22 F.4th 1369, 1376-1377 (Fed. Cir. 2022)(“To offer expert testimony from the perspective of a skilled artisan in a patent case—like for claim construction, validity, or infringement—a witness must at least have ordinary skill in the art. Without that skill, the witness' opinions are neither relevant nor reliable.”); *see also id.* at 1377 (“[T]o be qualified to offer expert testimony on issues from the vantage point of an ordinarily skilled artisan in a patent case, an expert must at a minimum possess ordinary skill in the art.”).

D. CLAIM CONSTRUCTION WAS PREVIOUSLY PERFORMED BY THE DISTRICT COURT

Patent Owner notes that the district court previously performed claim constructions for certain overlapping terms in the ‘805 and ‘339 Patents (*e.g.*, finding the term “algorithm” to have its plain and ordinary meaning, EX. 2018 at 18).

Petitioner does not propose any claim terms/phrases for construction. Petition at 3. Patent Owner does not propose any claim terms/phrases for construction for purposes of institution but reserves all rights regarding the correct constructions.

III. THE GROUNDS ARE WEAK

A. INTRODUCTION TO THE GROUNDS³

In this paper, Patent Owner will briefly address all grounds to show that instituting this IPR would not be an efficient use of the Board's time and resources. *Chevron Oronite Co. LLC v. Infineum USA L.P.*, IPR2018-00923, Paper 9 (PTAB Nov. 7, 2018)(informative)(insufficient number of proposed grounds/challenges to claims meet reasonable likelihood standard); *Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7 (PTAB Jan. 24, 2019)(informative)(same). The merits of Grounds 1-5 are weak and do not meet the institution standard. Even if the Board disagrees with some of Patent Owner's arguments, there is an insufficient number of grounds that meet the institution standard. Therefore, institution would not be efficient. *See SAS Inst. Inc.*, 138 S. Ct. 1348, 1354 (2018)(concluding that the Board must address every claim the petitioner has challenged and rejecting the practice of "partial institution").

Additionally, claims 1-30 of the '266 Patent are asserted in the parallel district court proceeding involving the same parties and so the issues presented

³ Patent Owner addresses certain deficiencies in this paper but reserves all rights to fully address all arguments and all grounds if this IPR is instituted.

here will likely be resolved by the district court.⁴ The final pretrial conference in the parallel proceeding is set for October 29, 2025 which is approximately three months before a final written decision is expected in this IPR. EX. 2019 at 6. Institution should be denied to avoid a waste of the Board's resources.

B. PETITIONER FAILS TO ESTABLISH NIIKAWA + WATANABE-JP ARE PROPERLY COMBINABLE

As discussed below, the independent claims of the '266 Patent recite (i) wireless transmission limitations and (ii) updatable/upgradable limitations. Petitioner relies on the combination of Niikawa + Watanabe-JP in its analysis of these limitations in Grounds 1-5. Because Petitioner fails to establish that the references are properly combinable, Grounds 1-5 fail.

The below summaries of Niikawa and Watanabe-JP show that these references are not properly combinable, much less applicable to the '266 Patent. A POSA would not have looked to either Niikawa or Watanabe-JP, or been motivated to combine them, to solve the problems addressed by the '266 Patent.

1. The independent claims 1 and 22 recite wireless transmission limitations.

Limitation 1[c] recites "wirelessly transmitting at least one of the one or more corrected images." Limitation 22[b] recites the same language.

⁴ Invalidity contentions are due on November 14, 2024. EX. 2019 at 1.

In context, the '266 Patent describes:

- “Because the present system uses digital files, it is possible to move these files to an external site for storage. The present system has capabilities to off-port images to an external data bank automatically.” EX. 1001 at 28:56-59.
- “Whether implemented in a local area network (LAN) or a wide area network (WAN), by using a built-in wireless router, the present digital imaging system may be set to send data files directly and automatically to hard-chive [sic – drive] storage either in a device in the same room or uploaded to the Internet for storage around the world.” EX. 1001 at 28:61-66.
- For example, “[w]hen automatically sending data files to a nearby computer, the computer may act as a data-port relay to automatically resend the images to an Internet site for storage. The system will maintain the option of keeping some images in the camera and sending duplicate copies of digital files of images to another site for storage as a backup.” EX. 1001 at 29:1-7.
- “The present digital imaging system not only automatically off-loads digital image files to remote locations for storage; the system also will allow one to photograph an image (or sequence of images) in one location (i.e., Paris) and instantly print it in another location (i.e., Los Angeles) for publication in real time. In addition, an image may be captured by the camera and instantly uploaded to a pre-programmed Web site for publication by using wireless technologies. In addition, it is possible to automatically print the digital image file anywhere in the world virtually the moment the image is taken.” EX. 1001 at 30:3-13.
- With respect to the exemplary embodiment of FIG. 34, “[t]he camera (3400) sends digital image data files wirelessly to a computer (3410). Files are also uploaded from the camera to the Internet in accessible locations (3450) ... One advantage of loading files automatically to the Internet is that the images are then automatically published (3460) at a remote location, or locations, for viewing.” EX. 1001 at 36:62-37:5.

The '266 Patent explains that the wireless transmission feature is “valuable” in order to preserve in-camera storage space. EX. 1001 at 28:59-60 and 28:66-29:1. The '266 Patent also explains that an automatic back-up storage process “provides insurance for the photographer.” EX. 1001 at 29:7-9. It is also possible to take a photograph in one location and instantly print it in another location for publication in real-time. EX. 1001 at 30:3-13. The ability to instantaneously store or print corrected images is possible “precisely because the image corrections are automated in-camera” so the corrected images are ready for “immediate release” and there is no need to further edit the images. EX. 1001 at 30:13-17.

2. The independent claims 1 and 22 recite updatable/upgradable limitations.

Limitation 1[a-3] recites “receive updated software and image correction data.” Limitation 22[a-3] similarly recites “store updated software or image correction data or both.”

Limitation 1[a-4] recites “upgrade the digital camera with the updated software and image correction data.” Limitation 22[a-4] similarly recites “upgrade the digital camera with the updated software or image correction data or both.”

Limitation 1[d] recites “wherein the in-camera software and database system are upgradable to provide improved algorithms and correction data for correction of images.” Limitation 22[c] recites the same language.

In context, the '266 Patent describes:

- “In the process, the camera identifies a specific lens and refers to a database that matches the lens type with the specific aberrations” EX. 1001 at 10:63-65.
- “The dynamics of correcting multiple simultaneous aberrations may be complex, but since the number and type of aberrations are constrained to a specific lens type, a centralized database may be accessed with specific corrections for each respective aberration.” EX. 1001 at 12:54-59.
- “[S]oftware files are periodically downloaded to the camera in order to update the camera settings and the database system” EX. 1001 at 29:11-13.
- “For example, as the camera manufacturer provides new lenses for the camera, it becomes necessary to load new updated settings to accommodate corrections for the new lenses” EX. 1001 at 29:13-16.
- As another example, “as the camera requires new software updates with improved algorithms to further optimize the corrective functions of both the optical and digital mechanisms, the camera will automatically accept these” EX. 1001 at 29:16-20.

The '266 Patent explains that the updatable/upgradable feature is “particularly important” to both the manufacturer and the user. EX. 1001 at 29:20-24 (“This feature is particularly important to both manufacturer and user because the ability to update software capability periodically will protect a user from needing to upgrade major hardware such as with a lens replacement.”)

3. Petitioner misplaces reliance on Niikawa + Watanabe-JP in Grounds 1-5.

In Ground 1, Petitioner relies on the proposed combination of Niikawa and Watanabe-JP for the (i) wireless transmission limitations and (ii)

updatable/upgradable limitations. Petition at 29-33 (analyzing 1[a-3]); 33-35 (analyzing 1[a-4]); 35-36 (analyzing 1[c]); 37 (analyzing 1[d]); Petition at 62 (analyzing 22[a-3], 22[a-4], 22[c]); 63-64 (analyzing 22[b]). In Grounds 2-5, Petitioner relies on its analysis in Ground 1 for these limitations. Petition at 72 (analysis of Ground 2), 82-83 (analysis of Ground 3), 87 (analysis of Ground 4)⁵, 91-92 (analysis of Ground 5).

Petitioner is using hindsight bias in its proposed combination of Niikawa and Watanabe-JP, as further discussed below. Petitioner is improperly using the claims of the '266 Patent as a roadmap. *See W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1552 (Fed. Cir. 1983) (“The result is that the claims were used as a frame, and individual, naked parts of separate prior art references were employed as a mosaic to recreate a facsimile of the claimed invention.”)

Finally, as noted above, Dr. Laub does not qualify as a POSA. Petitioner fails to establish that a POSA would have been motivated to combine the references, that it would have been within the ordinary skill of a POSA to do so, or that a POSA would have had a reasonable expectation of success.

⁵ Petitioner does not challenge independent claim 22 in Ground 4.

4. Summary of Niikawa.

Petitioner relies on the embodiments of FIG. 5 and FIG. 13 of Niikawa. Petition at 4-5. The embodiments of FIG. 5 and FIG. 13 differ in their use of dedicated hardware circuits for shading correction, white-balance (“WB”), and gamma correction versus software in general controller 150. Regardless, the underlying operation of Niikawa’s embodiments is fundamentally different from the ‘266 Patent and Watanabe-JP.

a. The first embodiment of Niikawa uses dedicated hardware circuits.

FIG. 5 of Niikawa shows a digital camera 1 with a shading correction circuit 123, WB circuit 124, and gamma correction circuit 125. The shading correction circuit 123 performs shading correction at the time of capturing image data. EX. 1006 at [0082], [0127]. “[A] correction table [stored in the shading ROM 153] which corresponds to the optical conditions of focal length and f-number at the time of exposure is selected and inputted to the shading correction circuit 123 by the general controller 150. The shading correction circuit 123 performs shading correction by executing multiplication process of image data outputted from the A/D conversion circuit 122 and the inputted correction table (see FIG. 6).” EX. 1006 at [0108]; *see also* EX. 1006 at [0084], [0087].

Niikawa’s correction table does not correspond to a database or database system as disclosed in the ‘266 Patent. For example, Niikawa does not disclose the

correction table is updatable, whereas the ‘266 Patent explains that the updatable database is a “particularly important” feature to both the manufacturer and the user. EX. 1001 at 29:20-24. Watanabe-JP does not disclose a correction table.

FIG. 9 of Niikawa shows a flow chart for the “gradation control processing mode” in the first embodiment in which a first image F1 is captured at a shutter speed two steps over the proper value (darker image), the first image F1 is subjected to shading correction by the shading correction circuit 123 and predetermined processes are executed by the WB circuit 124 and the gamma correction circuit 125 and stored in first temporary image memory 126a. EX. 1006 at [0108], [0109]. Then, a second image F2 is captured at a shutter speed two steps under the proper value (lighter image), the second image F2 is subjected to shading correction by the shading correction circuit 123 and predetermined processes are executed by the WB circuit 124 and the gamma correction circuit 125 and stored in second temporary image memory 126b. EX. 1006 at [0110].

Niikawa therefore teaches capturing two images and processing those two images which requires more space and more power. This is opposite to the teachings of the ‘266 Patent which emphasize space and power efficiency. Additionally, unlike Niikawa, the ‘266 Patent teaches that corrected images are available for “immediate release” and may be wirelessly transmitted from the digital camera.

FIG. 9 of Niikawa further shows the images F1 and F2 are positioned and synthesized by the image synthesizer 159. EX. 1006 at [0110], [0111]. “Since the first image F1 and the second image F2 have been subjected to shading correction by the shading correction circuit 123 at the time of capturing of images, positioning of images can be achieved without being influenced by a shading.” EX. 1006 at [0117].

The recording controller 156 then performs a predetermined compression process on the generated synthesized image. EX. 1006 at [0121]. An image file, with generated tag information, is then recorded onto the memory card 8. EX. 1006 at [0121].

Niikawa therefore teaches the use of image synthesizer to create a generated synthesized image that is compressed and ultimately stored on the camera’s memory card. To the contrary, the ‘266 Patent does not require the use of image synthesis to obtain corrected images. Watanabe-JP does not teach image synthesis either.

b. The second embodiment of Niikawa uses software in general controller 150.

FIG. 13 of Niikawa shows a digital camera 3 with shading corrector 160 implemented as software within general controller 150 that performs shading correction on image data that has been stored in the image memory 126. EX. 1006

at [0127], [0130]. “The shading corrector 160 implements the process as same as the process executed by the shading correction circuit 123 in the first preferred embodiment.” EX. 1006 at [0130]. Digital camera 3 also includes WB/gamma corrector 161 implemented as software within general controller 150. EX. 1006 at [0131].

As noted above, Niikawa’s methods for correction are different from those of the ‘266 Patent and Watanabe-JP.

FIG. 14 of Niikawa shows a flow chart for the “gradation control processing mode” in the second embodiment. The first and second images F1 and F2 are captured and stored in temporary image memory 126. EX. 1006 at [0135] – [0137]. Shading correction is performed by the shading controller 160 on the first image F1 (S50) and the second image F2 (S51). EX. 1006 at [0138]. Then, positioning and image synthesis is performed by the image synthesizer 159 (S52, S53). EX. 1006 at [0139]. Then, WB and gamma correction is performed on the generated synthesized image (S54). EX. 1006 at [0140]. In the second embodiment, “since any image processing such as shading correction is not executed between exposures of the first image F1 and the second image F2, it is possible to reduce the exposure interval.” EX. 1006 at [0142].

As noted above, Niikawa’s use of two images and image synthesis is contrary to the teachings of the ‘266 Patent and Watanabe-JP.

5. Summary of Watanabe-JP.

Petitioner relies on the embodiment of FIG. 1 of Watanabe-JP. Petition at 8. FIG. 1 shows a digital camera 1 with a transmission unit 31 and a wireless LAN communication unit 33. FIG. 1 also shows a personal computer 2 connected to a wireless LAN communication device 25 and to a cradle 4 with a transmission unit 42. *See also* EX. 1005 at [0037], [0047]. As discussed further below, Watanabe-JP requires two distinct transmission/ communication sub-systems (units 31/42 and 33/25) which require additional hardware and software that is not disclosed in Niikawa or required by the '266 Patent.

The digital camera 1 includes an imaging unit 11 that acquires image data S0 and an image processing unit 13 that performs image processing on the image data S0 to obtain processed image data S1. EX. 1005 at [0037]. The date and time of photographing are described in the header of the processed image data S1. EX. 1005 at [0042]. Unlike Niikawa, Watanabe-JP does not teach capturing two images or synthesizing images to obtain processed image data.

The digital camera 1 includes program memory 17 that stores the program data for operating the digital camera and a memory card 5 that stores the processed image data S1. EX. 1005 at [0037].

Watanabe-JP discloses an image data management process and a version management process. As discussed below, both processes require the use of cradle 4 and personal computer 2, which is opposite to the teachings of the ‘266 Patent.

a. The image data management process of Watanabe-JP.

“The user of the digital camera 1 sets the digital camera 1 in the cradle 4 to start the process.” EX. 1005 at [0054]. The image data management process is shown in FIG. 2 of Watanabe-JP. The image data management process of Watanabe-JP is fundamentally different from the operation of Niikawa and the ‘266 Patent, neither of which teach the use of Watanabe-JP’s two distinct transmission/ communication sub-systems (units 31/42 and 33/25).

The transmission unit 42 of the cradle 4 outputs electromagnetic waves that are superimposed with a signal indicating the transmission of a date signal and a version signal. EX. 1005 at [0055].

The transmission unit 31 of the digital camera 1 receives electromagnetic waves and generates power that causes the control unit 12 to start operation. EX. 1005 at [0056].

The date signal, indicating the data and time of photographing the processed image data S1, is generated by the control unit 12. EX. 1005 at [0042]. The date signal for the processed image data S1 is superimposed on the electromagnetic waves output from the transmission unit 31 of the digital camera to the

transmission unit 42 of the cradle. EX. 1005 at [0056]. The date signal is transmitted to the personal computer 2 via the transmission unit 31 of the digital camera and the transmission unit 42 of the cradle. *See* EX. 1005 at [0056].

It appears that the personal computer 2 compares the date information represented by the date signal with the date information of the image data stored in the personal computer 2. *See* EX. 1005 at [0057].⁶ The personal computer 2 determines whether or not there is new image data S2. EX. 1005 at [0057]. If there is new image data S2, the personal computer 2 sends an instruction signal to the digital camera via the transmission unit 42 of the cradle and the transmission unit 31 of the digital camera. EX. 1005 at [0057], FIG. 2 (S6).⁷ Watanabe-JP thus requires the use of personal computer 2 for image data management, which is opposite to the teachings of the '266 Patent.

When the digital camera receives the instruction signal, the control unit 12 of the digital camera starts the wireless LAN communication unit 33. EX. 1005 at

⁶ New image data S2 is data that is not stored in the personal computer 2. EX. 1005 at [0058]. New image data S2 is acquired after the date on which the latest image stored in the person computer 2 was acquired. EX. 1005 at [0057].

⁷ If there is not new image data S2, then the version management process begins. EX. 1005 at [0060].

[0058]. Thus, the camera's communication unit 33 is not started unless there is an instruction signal from personal computer 2. This is opposite to the teachings of the '266 Patent.

The wireless communication unit 33 is placed in standby state and starts transmitting new image data S2 that is not stored in the personal computer. EX. 1005 at [0058]. The wireless LAN communication device 25 connected to the personal computer receives the new image data S2 and the new image data S2 is saved in the prescribed folder in the personal computer. EX. 1005 at [0059].

Once transmission of new image data S2 is complete, the version management process begins. EX. 1005 at [0060]; FIG. 2 (S11, S12). This is opposite to the teachings of the '266 Patent which do not require, first, performing the image data management process and only after its completion, performing the version management process.

b. The version management process of Watanabe-JP.

The version management process is shown in FIG. 3 of Watanabe-JP. The version management process of Watanabe-JP is fundamentally different from the operation of Niikawa and the '266 Patent, neither of which teach the use of Watanabe-JP's two distinct transmission/ communication sub-systems (units 31/42 and 33/25).

The control unit 12 of the digital camera reads the version of the program data stored in the program memory 17. EX. 1005 at [0061]. The version signal, indicating the version of the program data, is generated by the control unit 12. EX. 1005 at [0042]. The version signal is superimposed on the electromagnetic waves output from the transmission unit 31 of the digital camera to the transmission unit 42 of the cradle. EX. 1005 at [0061]. The version signal is transmitted to the personal computer 2 via the transmission unit 31 of the digital camera and the transmission unit 42 of the cradle. *See* EX. 1005 at [0061], [0073].⁸

“The personal computer 2 compares the version of the program data represented by the version signal with the version of the program data stored in the personal computer 2.” EX. 1005 at [0062]. The personal computer 2 determines whether or not an update of the program data is necessary, based on whether the version of the program data stored in the program memory 17 of the digital camera is old. *See* EX. 1005 at [0062]. Like the image data management process, the version management process requires the use of personal computer 2, which is opposite to the teachings of the ‘266 Patent.

⁸ The translation of Watanabe-JP refers to transmission “to the digital camera 1” rather than “to the personal computer 2”. EX. 1005 at [0061]. The translation appears incorrect.

If an update is necessary, the personal computer determines whether the storage battery 19 of the digital camera has sufficient remaining capacity. EX. 1005 at [0062]. If there is sufficient battery capacity, “the personal computer 2 displays a screen on the monitor 22 to allow the user to select whether or not to update the program data, and allows the user to input instructions on whether or not to perform the update.” EX. 1005 at [0065].⁹ Watanabe-JP’s required involvement of a personal computer and a user is opposite to the teachings of the ‘266 Patent.

If an instruction to perform the update has been given by the user, and assuming the wireless LAN communication unit 33 of the digital camera was started during the image management process and placed in the standby state, the control unit 12 sends a standby signal to the personal computer 2 via the

⁹ If there is not sufficient battery capacity, the personal computer 2 suspends the version management process and starts the timer. EX. 1005 at [0062]. After a predetermined period of time has elapsed, a check signal is sent from the personal computer 2 to the control unit 12 of the digital camera via the transmission unit 42 of the cradle and the transmission unit 31 of the digital camera. *See* EX. 1005 at [0062].

transmission unit 31 of the digital camera and the transmission unit 42 of the cradle. EX. 1005 at [0066].¹⁰

“When the personal computer 2 receives the standby signal, it sends the program data to the digital camera via the wireless LAN communication device 25.” EX. 1005 at [0067]. The program data is divided into multiple segments such that the segments are sequentially transmitted to the digital camera. EX. 1005 at [0067]. The control unit 12 monitors the proximity status of the transmission unit 31 of the digital camera and the transmission unit 42 of the cradle. EX. 1005 at [0069]; *see also* [0070], [0071]. Because Watanabe-JP requires maintaining close proximity of the digital camera and the cradle, Watanabe-JP does not achieve the advantages of the ‘266 Patent.

¹⁰ If the wireless LAN communication unit 33 was not started in the image data management process, *e.g.*, when there was no new image data S2, a start signal is sent from the personal computer 2 to the wireless LAN communication unit 33 of the digital camera via the transmission unit 42 of the cradle and the transmission unit 31 of the digital camera. *See* EX. 1005 at [0065]. The control unit 12 starts the wireless LAN communication unit 33 and places it in the standby state. EX. 1005 at [0066].

The wireless LAN communication unit 33 of the digital camera receives the program data and stores it in the program memory 17. EX. 1005 at [0068]. No update of the program data is performed until control unit 12 determines it has completed receiving the program data. EX. 1005 at [0072]. Then, the wireless LAN communication unit 33 is stopped and the process is terminated. EX. 1005 at [0072].

6. Petitioner fails to establish Niikawa and Watanabe-JP are properly combinable.

Based on the above summaries, a POSA would not have looked to either Niikawa or Watanabe-JP, or been motivated to combine them, to solve the problems addressed by the ‘266 Patent. Neither reference achieves the advantages of the inventions of the ‘266 Patent.

Petitioner argues that “POSAs would have been motivated to modify Niikawa by (1) implementing Watanabe-JP’s wireless LAN communication unit 33, transmission unit 31, rechargeable storage battery 19 and power supply circuit 32 in Niikawa’s digital camera 1...; (2) configuring Niikawa’s GC-150 with control programs and processing programs that perform Watanabe-JPs image data and version management processes ...; and (3) utilizing Watanabe-JP’s wireless charging cradle.” Petition at 13 (citations omitted).

Petitioner's arguments fail at least because a POSA would not have been motivated to incorporate the teachings of Watanabe-JP into Niikawa.

Watanabe-JP begins by addressing equipment having a rechargeable battery that uses electromagnetic induction instead of connectors. EX. 1005 at [0002]. Watanabe-JP notes that transmission/reception of data can be performed using electromagnetic waves. EX. 1005 at [0003]. However, the frequency of electromagnetic waves "must be kept low" and therefore "it is not possible to transmit and receive large amounts of data." EX. 1005 at [0010].

"[I]n view of the above circumstances" (EX. 1005 at [0011]), Watanabe-JP discloses a system that uses electromagnetic transmission (units 31 and 42) and wireless LAN communication (unit 33 and 25). While various signals may be superimposed on electromagnetic waves transmitted between units 31/42, Watanabe-JP teaches image data and program data are transmitted between wireless LAN communication units 33/25.

Petitioner does not sufficiently explain why Watanabe-JP's teachings for image data transfer and program data management are applicable to an **unmodified** version of Niikawa. A POSA reading Watanabe-JP would not have looked to Niikawa or vice versa. Unlike Niikawa, Watanabe-JP does not teach

methods for shading correction or the use of image synthesis.¹¹ Unlike Watanabe-JP, Niikawa does not disclose a rechargeable battery or an electromagnetic induction cradle. Niikawa does not disclose wireless transmission/communication sub-systems (electromagnetic or otherwise). Niikawa does not disclose the program data in ROM 151 is rewritable or updatable/upgradable. Niikawa does not disclose the correction table in shading ROM 153 is rewritable or updatable/upgradable.

Given the number and extent of modifications necessary in Petitioner's proposed combination, the series of proposed modifications are the result of hindsight. *See Metalcraft of Mayville, Inc. v. The Toro Co.*, 848 F.3d 1358, 1367 (Fed. Cir. 2017) (“[W]e cannot allow hindsight bias to be the thread that stitches together prior art patches into something that is the claimed invention.”); *InTouch Techs., Inc. v. VGO Commc'ns, Inc.*, 751 F.3d 1327, 1351 (Fed. Cir. 2014) (criticizing use of the challenged patent as a “roadmap” for putting what the expert referred to as “pieces of a ‘jigsaw puzzle’” together).

¹¹ Watanabe-JP merely discloses image processing unit 13 applies various image processes to image data S0 to obtain the processed image data S1. EX. 1005 at [0039].

First, a POSA would not have been motivated to modify Niikawa to use a rechargeable battery and cradle as taught by Watanabe-JP. A POSA would have understood that charging based on electromagnetic induction, such as using Watanabe-JP's cradle 4, has a low power efficiency and results in a much longer charging time. Using an electromagnetic induction charger is also more expensive.

Also, Watanabe-JP does not disclose the use of cradle 4 to solve the problem of possible disconnection during program data transmission. *Contra* Petition at 6. Watanabe-JP discusses equipment in which the version of a program may be upgraded using connectors (EX. 1005 at [0004]), but notes that if the connector is disconnected during transmission of program data, the program may result in an incomplete update and cause problems in the operation of the equipment (EX. 1005 at [0009]). Watanabe-JP addresses the problem of possible disconnection during program data transmission by waiting to actually update the program data until all segments of the program data are received. EX. 1005 at [0072]. Watanabe-JP requires the digital camera 1 to be in close proximity to the cradle 4 during program data transmission and if there is a possible disconnection or “inadvertent[] release[]”, transmission will be stopped and incomplete program data will not be stored. EX. 1005 at [0034]. Therefore, the problem of “possible disconnection” relates to timing of receipt/update and not the use of an electromagnetic induction charger.

Additionally, though Watanabe-JP discloses the digital camera need not be physically connected to the personal computer for charging, the cradle must still be physically connected to the personal computer and the digital camera must be in close proximity to the cradle. Therefore, the alleged benefits of Watanabe-JP regarding a lack of required physical connections is significantly diminished. *Contra* Petition at 12.

It is the proposed modification of Niikawa to use a rechargeable battery and electromagnetic induction cradle, which then leads to Petitioner's modifications to use the methods of Watanabe-JP for image data transfer and program data management. Petitioner is using hindsight bias.

Watanabe-JP discloses the date signal and the version signal are superimposed on the electromagnetic waves transmitted between units 31 and 42. EX. 1005 at [0055]-[0056] and [0061]. These signals are critical to the performance of Watanabe-JP's methods for image data management and version management. A POSA would not have been motivated to require these signals or units 31/42 in modifying Niikawa system in order to accomplish "more convenient image transfer" (Petition at 10) or a "more convenient way to upgrade Niikawa's digital camera" (Petition at 11). The '266 Patent does not teach the use of such signals and instead relies on, for example, a built-in wireless router in the digital camera. EX. 1001 at 28:61-66.

The methods of Watanabe-JP rely on two distinct transmission/communication sub-systems (units 31/42 and 33/25) which a POSA would not have been motivated to use in Niikawa. Contrary to Petitioner's arguments, it is not more efficient to incorporate these **two** distinct sub-systems in Niikawa. In particular, a POSA would not have been motivated to incorporate the electromagnetic transmission units 31/42 in Niikawa. Without the electromagnetic transmission units 31/42, the wireless communication units 33/24 would not function.

Additionally, the methods of Watanabe-JP require additional steps that teach away from the claims of the '266 Patent.

The methods of Watanabe-JP require the digital camera 1 to be in the cradle 4 to "start the process". EX. 1005 at [0054]. This is opposite to the teachings of the '266 Patent.

Watanabe-JP requires the cradle 4 is connected to the personal computer 2. EX. 1005 at [0047].. This is opposite to the teachings of the '266 Patent.

The control unit 12 only starts operation when the rechargeable battery 19 is charging by electromagnetic induction. EX. 1005 at [0056]. This is opposite to the teachings of the '266 Patent.

The wireless LAN communication unit 33 only starts operation in response to an instruction signal from the personal computer 2. EX. 1005 at [0057]-[0058]. This is opposite to the teachings of the ‘266 Patent.

The image data management process is necessarily performed before the version management process. This is opposite to the teachings of the ‘266 Patent.

Watanabe-JP requires input instructions from the user to perform the update of program data. EX. 1005 at [0065]. This is opposite to the teachings of the ‘266 Patent.

Moreover, the methods of Niikawa require additional steps that teach away from the claims of the ‘266 Patent. Most notably, Niikawa teaches capturing two images and performing image synthesis.

Ultimately, a POSA would not have been motivated to combine Niikawa and Watanabe-JP to arrive at the claimed inventions of the ‘266 Patent.

For at least the foregoing reasons, Petitioner’s proposed combination fails.

C. PETITIONER FAILS TO ESTABLISH THE TERTIARY REFERENCES ARE PROPERLY COMBINABLE

In Grounds 2-5, the methods used for image correction are so different that the references are not properly combinable, much less applicable to the ‘266 Patent. Overall, Petitioner fails to explain *how* the techniques taught by the tertiary references actually work or *why* a POSITA would have been motivated to

implement the specific teachings in the Niikawa + Watanabe-JP combination.

Petitioner is using hindsight bias.

Petitioner also repeatedly refers to modifying Niikawa's "ROM" without specifying or distinguishing between Niikawa's ROM 151 and shading ROM 153. Petitioner's analysis is not sufficiently specific.

1. Ground 2 based on Niikawa + Watanabe-JP + Bolle fails.

Petitioner argues that a POSA "would have been motivated to configure Niikawa's general controller 150 with Bolle's scene analysis 103 and expert 104 programs" to operate in Bolle's "automatic mode" or "guided mode". See Petition at 69-71. Petitioner additionally argues that a POSA would have modified Niikawa's LCD 10 and interface controls to create a suitable user interface. Petition at 71-72.

Petitioner fails to consider that Bolle's teachings are time-consuming and require a significant amount of processing power. As such, a POSA would not have been motivated to implement Bolle's teachings as proposed by Petitioner.

Bolle explains that a temporary image is acquired and scene analysis unit 103 extracts information about the image. As shown in FIG. 2 of Bolle, scene analysis 103 includes input attributes 201-232, raw features 204-210, scene components 211-215, and scene classifications 216-225. Bolle explains that the final stage of scene analysis is a scene classification arbitration process 226 that

reduces the number of hypotheses to a single best choice, or a small number of alternatives, or a composite hypothesis. EX. 1007 at 5:7-20. The photographic expert 104 takes the output of the scene arbitration unit 226 and determines a set of values 107 for the imaging parameters. EX. 1005 at 5:28-32; *see also* FIG. 3 (imaging parameters 107 including focus distance, aperture, zoom, orientation, shutter speed, imager sensitivity, flash control, pan and tilt, exposure instant). The expert may receive user feedback, a decision override, or manual control inputs. EX. 1005 at 3:43-47. Then, a permanent image is acquired.

A POSA would not have been motivated to incorporate these teachings into Niikawa + Watanabe-JP.

2. Ground 3 based on Niikawa + Watanabe-JP + Ng fails.

Petitioner argues that a POSA would have (1) configured Niikawa's general controller 150 to perform Ng's virtual aperture functions; (2) stored Ng's pre-computed "database of weights" in Niikawa's ROM; and (3) included Ng's microlens and circuitry for detecting light direction in Niikawa's system. Petition at 82.

Petitioner fails to consider that Ng is directed at a plenoptic camera which captures information about the direction of light rays, while a typical digital

camera only records light intensity.¹² For example, a POSA would have understood that a plenoptic camera measures a 4D light field as opposed to a 2D photograph. A POSA would also have understood that plenoptic cameras are extremely expensive and complex.

Additionally, Ng discloses a variety of example and alternative embodiments and Petitioner's analysis in Ground 3 is not sufficiently specific to understand which functions Petitioner proposes would be incorporated into Niikawa's general controller 150. *See Personal Web Techs., LLC v. Apple*, 848 F.3d 987, 994 (Fed. Cir. 2017)("[A] clear, evidence supported account of the contemplated workings of the combination is a prerequisite" to concluding "that a relevant skilled artisan would have been motivated to make the combination and reasonably expect success in doing so.")). Because Petitioner's analysis is not sufficiently specific, Petitioner fails to meet its burden.

For example, Petitioner fails to explain why a POSA would have been motivated to use Ng's techniques relating to a plenoptic camera that generates multiple images, by varying a "virtual aperture", that can be combined such that each final pixel retains the pixel that is best focused in any of the set of generated

¹² Niikawa discloses a typical digital camera using CCD 303. *See, e.g.*, EX. 1006 at [0077].

images. EX. 1008 at 20:26-28 (cited by Petitioner's expert, EX. 1003 at ¶423).

Ng's techniques are extremely time-consuming and require a significant of memory and processing power, as well as additional hardware. A POSA would not have been motivated to use Ng's techniques as proposed by Petitioner. For example, Ng explains that a virtual aperture function is varied from pixel to pixel in an output image 3200, where pixel 3201 uses virtual aperture function 3210 and pixel 3251 uses virtual aperture function 3250. EX. 1008 at 18:27-30 (cited by Petitioner's expert; EX. 1003 at ¶423).

Additionally, Petitioner fails to explain why a POSA would have been motivated to use Ng's database of weights. Ng discloses that "[t]he light field values for each ray are integrated to calculate the corrected image value for each particular film pixel." EX. 1008 at 24:7-9. With respect to FIG. 29, Ng explains the flow diagram for pre-computing a database of weights selectively using ray-tracing and, with respect to FIG. 30, Ng explains the flow diagram for generating an output image using the database of weights. EX. 1008 at 24:21-25:21 (cited by Petitioner's expert; EX. 1003 at ¶432). As disclosed in Ng, these processes require a significant amount of processing power and a POSA would not have been motivated to implement these processes as proposed by Petitioner. Ng's processes are so different from Niikawa and Watanabe-JP and Petitioner fails to establish that

even if a POSA were motivated to incorporate Ng's teachings, that doing so would have been within the ordinary skill of a POSA.

Furthermore, storing Ng's "database of weights" in Niikawa's ROM would require a significant amount of memory and processing power, thereby increasing costs. Niikawa already states that the data size of pixel correction coefficients is enormous (EX. 1006 at [0085]) and adding more data from Ng would only further increase system requirements. A POSA would not have been motivated to incorporate Ng's database of weights in Niikawa's ROM.

3. Ground 4 based on Niikawa + Watanabe-JP + Irie fails.

Petitioner argues that a POSA would have (1) stored Irie's contiguous deflection correction look-up table 66A and isolated defect correction look-up table 78A in Niikawa's ROM; (2) include a high-speed SRAM in Niikawa's RAM 152; and (3) configure Niikawa's general controller 150 to perform defective pixel correction. Petition at 86-87.

Petitioner fails to consider Irie's teachings regarding the use of look-up tables ("LUTs"). Petitioner also fails to consider the hardware requirements and associated costs in the proposed combination. Petitioner further fails to consider Irie's teachings regarding exposure duration in view of Niikawa's gradation control processing.

In still photography mode, Irie teaches using both LUTs 66A and 78A to correct defective pixels. EX. 1011 at [0058].¹³ Irie admits that this requires a large amount of information to be read in and takes a long time. *See* EX. 1011 at [0064]. Irie also acknowledges that reading in the LUTs can create memory shortages at the EEPROM. EX. 1011 at [0067]. Irie further acknowledges that corrected images require a longer time for signal processing. EX. 1011 at [0087]. Therefore, a POSA would not have been motivated to incorporate Irie's teachings into Niikawa + Watanabe-JP as proposed by Petitioner.

Additionally, storing Irie's LUTs 66A and 78A in Niikawa's ROM would require a significant amount of memory and increase costs. With respect to FIG. 7 (exemplary correction table), Niikawa explains that since the correction coefficients are set for every pixel, the data size is enormous. EX. 1006 at [0085]. Additionally storing Irie's LUTs 66A and 78A in Niikawa's ROM would only

¹³ In continuous/video photography mode, Irie teaches using only continuous defect correction LUT 66A memorized at the SRAM 66 because speed is prioritized over image quality. EX. 1011 at [0062]. However, Niikawa is directed at improving image quality for accurate positioning and image synthesis. *See, e.g.*, EX. 1006 at [0015].

further increase system requirements. A POSA would not have been motivated to incorporate Irie's tables in Niikawa's ROM.

Moreover, adding a high-speed SRAM to Niikawa would be extremely expensive. A POSA would not have been motivated to do so. Petitioner is using hindsight bias.

Finally, Niikawa explains that increased exposure results in increased shading. EX. 1006 at [0060]. In the gradation control processing mode, Niikawa teaches capturing two images having different exposures for the same subject in different timings and then synthesizes these images. *E.g.*, EX. 1006 at [0060]. However, in the relied-upon first embodiment of Irie, the correction of defective pixels only addresses static characteristics, irrespective of the duration of exposure. EX. 1011 at [0068]. Irie explains that an increase of exposure duration can increase dynamic noise components and Irie teaches the use of different LUTs. EX. 1011 at [0068]. Irie therefore discloses a second embodiment which is not addressed in the petition. A POSA reading Niikawa would not have incorporated the teachings of Irie into Niikawa + Watanabe-JP as proposed by Petitioner.

4. Ground 5 based on Niikawa + Watanabe-JP + Watanabe-US fails.

Petitioner argues that a POSA would have (1) stored Watanabe-US's shading correction coefficients and distortion aberration correction values for different

lenses in Niikawa's ROM 151; and (2) configured Niikawa's general controller 150 to access the stored correction tables and apply the obtained correction data.

Petition at 90-91.

Petitioner fails to consider the different corrections taught by Niikawa and Watanabe-US. Petitioner also fails to consider the hardware requirements and associated costs in the proposed combination.

Niikawa teaches that correction coefficients are set for every pixel. EX. 1006 at [0085]. Watanabe-US does not teach correction coefficients for every pixel. Petitioner fails to explain how the teachings of these references are properly combinable.

Furthermore, with respect to FIG. 7 (exemplary correction table), Niikawa explains that since the correction coefficients are set for every pixel, the data size is enormous. EX. 1006 at [0085]. Additionally storing Watanabe-US's tables in Niikawa's ROM would require a significant amount of memory and processing power, thereby increasing costs. Niikawa already states that the data size is enormous (EX. 1006 at [0085]) and adding more data based on Watanabe-US's teachings would only further increase system requirements. A POSA would not have been motivated to incorporate Watanabe-US's tables in Niikawa's ROM as proposed by Petitioner.

IV. PETITIONER’S BELATED STIPULATION THWARTS THE POLICY OBJECTIVES OF THE VIDAL MEMORANDUM

The Board should not allow petitioners to file belated stipulations in order to negate the *Fintiv* analysis. Allowing a petitioner to make a belated stipulation thwarts the policy objectives outlined in the Vidal Memorandum¹⁴ including to “limit unnecessary and counterproductive litigation costs” and to minimize “inefficiency and gamesmanship in AIA Proceedings”. Vidal Memorandum at 1. This is particularly true when the challenged patent is involved in multiple district court proceedings with multiple defendants. *See* Paper 9 at 1-2.

Petitioner filed four petitions against Patent Owner in IPR2024-00923, IPR2024-00924, IPR2024-00925, and IPR2024-01046. Paper 9 at 2. None of these petitions included a stipulation regarding the parallel district court proceeding. Petitioner emailed a Sotera-style stipulation on September 4, 2024. EX. 2015.¹⁵

Under the current law/policy, there is no incentive for petitioners to make a stipulation at or around the time of filing the petition. Mindful of the precedential

¹⁴ Director Vidal, Memorandum, ‘Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation’ dated June 21, 2022 (“Vidal Memorandum”).

¹⁵ Based on current law/policy, Patent Owner understands that a Sotera-style stipulation precludes discretionary denial under *Fintiv*. Vidal Memorandum at 7.

NXP decision¹⁶ which requires a stipulation to be filed before an institution decision, the Board should not invite gamesmanship or otherwise encourage petitioners to delay making stipulations.

Director Vidal also stated that the use of stipulations “avoids inconsistent outcomes between the PTAB and the district court and allows the PTAB to review grounds that the parallel district court litigation will not resolve”. Vidal Memorandum at 7-8. However, that is not true here. Petitioner’s belated stipulation does not prevent the other defendants in related district court proceedings involving the ‘266 Patent from pursuing the same invalidity challenges in district court. Therefore, Petitioner’s belated stipulation does not mitigate concerns of duplicative efforts and conflicting decisions.

If the Board were to reject Petitioner’s belated stipulation, the Board would understand that the *Fintiv* factors overwhelmingly favor denial of institution.¹⁷ The parallel litigation involving the same parties and overlapping claims will resolve

¹⁶ *NXP USA, Inc. v. Impinj, Inc.*, IPR2021-0156, Paper 13 (PTAB September 7, 2022)(precedential)(“*NXP*”).

¹⁷ If there is an intervening change in law/policy, Patent Owner expressly requests authorization for supplemental briefing to address the *Fintiv* factors in detail.

the issues presented here and institution should be denied to avoid conflicting decisions and a waste of the Board's resources.

V. CONCLUSION

For at least the reasons set forth herein, Patent Owner respectfully requests that institution be denied.

Respectfully submitted,

Date: October 24, 2024

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CERTIFICATE OF COMPLIANCE

This Patent Owner Preliminary Response (“POPR”) consists of 8,748 words, which is no more than 14,000 words, excluding table of contents, table of authorities, certificate of service, this certificate, or table of exhibits. The POPR complies with the type-volume as mandated in 37 C.F.R. § 42.24. In preparing this certificate, counsel has relied on the word count of the word-processing system used to prepare the paper (Microsoft Word).

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies the
PATENT OWNER PRELIMINARY RESPONSE and all exhibits thereto were
served on the undersigned date via email, as authorized by Petitioner, at the
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