

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. IPR2024-01052
U.S. Patent No. 11,336,832

PATENT OWNER'S MOTION TO STRIKE

I. INTRODUCTION AND SUMMARY OF MOTION

PO respectfully moves to strike the following arguments from Petitioner's Reply, which present improper new theories of unpatentability:

- Petitioner's new (unsubstantiated) obviousness ground—Thomason and Pacurariu alone (*i.e.* without Watanabe)—for claims 3-5 and 13-15. Reply 24, Ex. 1019, ¶83.
- Petitioner's new obvious to try theory for combining Voss and Derbanne (Reply 32, Ex. 1019, ¶¶105-107)

II. LEGAL STANDARD

The Board's rules are clear that "[a] reply may only respond to arguments raised in the corresponding . . . patent owner response." 37 C.F.R. § 42.23(b). As the Federal Circuit has emphasized, a petitioner's reply in an *inter partes* review is "limited to a true rebuttal role." *Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1367 (Fed. Cir. 2015).

III. THE BOARD SHOULD STRIKE PETITIONER'S NEW OBVIOUSNESS GROUND FOR CLAIMS 3-5 AND 13-15

The Petition presented a single obviousness ground for claims 3-5 and 13-15: "the Thomason-Pacurariu-Watanabe combination." Pet., 48-52. But now GoPro has shown that Watanabe does not disclose or render obvious the additional limitations of claims 3-5 and 13-15, Petitioner attempts to disclaim its reliance on Watanabe and introduce a new obviousness ground

(Thomason-Pacurariu) for these claims: “the combination of Thomason and Pacurariu alone, when processing a distorted image, would disclose claims 3-5 and 13-15.” Ex. 1019 at ¶83 (emphasis added); Reply 24 (same). This new ground does not appear in the Petition. Pet., 8 (identifying grounds). Indeed, the Petition states that the Thomason-Pacurariu combination applies only to claims “1, 2, 7-12, 17-20.” *Id.* The Petitioner’s only discussion of Thomason-Pacurariu in the context of claim 3-5 and 13-15 relates to combining the references with Watanabe. Pet., 48-42. This new ground should be stricken.

The decision in *Kerry Group Services International Ltd. v. Florida Food Products, LLC*, 2025 WL 582881, *4 (Fed. Cir. 2025) is instructive. In *Kerry* the Federal Circuit vacated the Board’s obviousness finding because it was unclear whether the Board found obviousness based on a single prior art reference standing alone, which was not one of the grounds argued in the petition: “FFP’s petition did not present an obviousness ground that was based on Voorde alone. In its institution decision, the Board appropriately understood FFP’s petition to assert a combination of the two references. To the extent the Board found the challenged claims to be unpatentable based on an obviousness ground that was not presented in the petition, this was error.... On remand, the Board must hold FFP to the obviousness theory articulated in ground one.” Here, the Petition includes a ground based on Thomason-

Pacurariu-Watanabe, and not Thomason-Pacurariu for claims 3-5 and 13-15. Thus, it would be improper to consider the new Thomason-Pacurariu ground.

Allowing Petitioner to inject a new ground in Reply is highly prejudicial to Patent Owner because PO is deprived of the opportunity to introduce new evidence or testimony to rebut these claims and is limited in the length of its sur-reply.

IV. THE BOARD SHOULD STRIKE PETITIONER’S NEW OBVIOUSNESS TO TRY THEORY FOR VOSS-DERBANNE

The Petition includes a conclusory assertion that “it would have been obvious to try combining the teachings of Voss and Derbanne, as these technical features of Derbanne may be combined with the teachings of Voss without requiring much effort and with a reasonable expectation of success.” Pet., 62. This assertion merely parrots the “obvious to try” rationale in KSR. But “[t]o prove obviousness under an obvious to try theory, [Petitioner] must show (1) a design or market need to solve a particular problem, and (2) that ‘there are a finite number of identified, predictable solutions’ that would lead to an expectation of success.” *Grunenthal GMBH v. Alkem Labs. Ltd.*, 919 F.3d 1333, 1345 (Fed. Cir. 2019) (emphasis omitted) (quoting *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007)). Petitioner’s conclusory assertion does not make out a *prima facie* case of obviousness as a matter of law. See, e.g., *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015) (“the

conclusory assertions in Dr. Mohazzab's declaration do not provide substantial evidence for finding a motivation to combine.”).

GoPro showed that “Petitioner’s ‘obvious to try’ argument does not even recite the proper standard, which requires showing a limited number of ‘identified, predictable solutions,’” and that its reasoning is “not in any way directed to the specific teachings from Derbanne that Petitioner wishes to combine with Voss.” POR, 68. Unable to rebut GoPro’s showing, Petitioner’s Reply declaration presents a new obviousness to try theory that attempts to cure these deficiencies. *See, e.g.*, EX1019, ¶107 (“The Voss-Derbanne combination is obvious to try because there are a finite number of solutions...”). But this new theory in the Reply is untimely. It is well-established that “an IPR petitioner may not raise in reply an entirely new rationale for why a claim would have been obvious.” *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1330-31 (Fed. Cir. 2019) (internal quotation marks omitted); *Corephotonics, Ltd v. Apple, Inc.*, 84 F. 4th 990, 1002 (the Board “must [] reject any ‘entirely new theory of *prima facie* obviousness absent from the petition,’” if the petitioner attempts to inject such a theory into the proceeding post-petition.”). Allowing Petitioner to inject a new ground in Reply violates due process and deprives GoPro of the opportunity to offer

rebuttal expert opinions. GoPro is also limited in the length of its sur-reply such that it is unable to fully respond.

Even if the Board were to permit Petition to raise this new obviousness to try theory (it should not), the Board should exclude Petitioner from relying on this rational to argue a new obviousness theory for Claims 10 and 20. Specifically, the Petition relied exclusively on disclosure by Voss for these claims. Pet., 77-78. The Petition did not even mention Derbanne or provide any reason to combine Voss and Derbanne for this limitation. *Id.* Yet now that Petitioner is unable to show that Voss discloses Claims 10 and 20, which requires determining a viewing window's location frame-by-frame, Petitioner attempts to rely upon Derbanne's disclosure. Reply, 31. Setting aside the fact that Derbanne's alleged viewing window serves an entirely different purpose than Voss's alleged viewing window and does not even pertain to horizon-leveling, the Board should not consider this untimely new obviousness ground. *Kerry*, 2025 WL 582881, *4.

Date: August 26, 2025

By: /s/ James Glass

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

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

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

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