

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. 11,336,832

Inter Partes Review No. IPR2024-01052

PETITIONER'S MOTION TO STRIKE

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Petitioner moves to strike GoPro’s (1) new claim construction on the term “configured”, (2) new reliance on EX2004, (3) new position on “location of the viewing window,” and (4) new “presumption of nexus” and “unmet need” arguments concerning secondary considerations.

I. GOPRO’S NEW CLAIM CONSTRUCTION ARGUMENT IS IMPROPER

In its Patent Owner Response (POR), GoPro wrongly contended that “the ‘viewing window’ must bound the *same* content that is ultimately horizon-leveled.” (Paper 25, 58 (emphasis added).) GoPro then mischaracterized that Voss always “crops” its inset rectangle and thus does not meet this requirement. (Paper 25, 59-60.) As Insta360 explained in the Reply, claim 1 merely requires that the horizon-leveled visual content *include* (not equate) the visual content defined by the viewing window. (Paper 32, 1-2.) Further, GoPro ignored Voss’ disclosure of “letter boxing” and “pillar-boxing,” which preserves the entire inset rectangle and “black[s] out any unused area with ‘letter boxing’ or ‘pillar boxing,’” thus disclosing the “viewing window” limitation. (EX1007, 10:20-21; Paper 32, 27.)

Unable to justify its mischaracterization, GoPro changes course in its Sur-reply. (Paper 39, 17-21.) There, it concedes that the claim merely requires “including.” *Id.* But GoPro advances a new construction of claim 1’s “configured” language, arguing for the first time that the term “configured” excludes prior art that may oscillate between cropping and pillar-boxing. *Id.*

At no point did the POR discuss the language “configured.” (*See* Paper 39.) Nor did the POR ever mention Voss’ example involving “oscillat[ing].” *Id.* GoPro’s reliance on pages 32-35 of the POR (EX3002, 3) for support is unavailing. That section discusses neither claim 1 nor Voss. Instead, it is related to claims 8/18. Thus, the Sur-Reply impermissibly “proceed[s] in a new direction with a new approach.” (*See* PTAB Consolidated Trial Practice Guide at 74 (Nov. 2019).)

The Federal Circuit rejected a similar tactic in *ParkerVision, Inc. v. Vidal*, 88 F.4th 969 (Fed. Cir. 2023). There, the patent owner argued in its POR that the prior art’s capacitors were not “storage elements” because they were not part of “an energy transfer system.” *Id.* at 979-80. But, on sur-reply, the patent owner improperly pivoted, arguing that the capacitors were not “storage elements” because they stored “negligible amounts of energy.” *Id.* at 981. Likewise, here, the POR rests on one theory (based on Voss’ disclosure of “cropping”) while the Sur-Reply advances another (relying on a sentence on “oscillat[ing]”).

GoPro’s new argument also is meritless. The term “configured” does not carry the restrictive construction GoPro proposes. The Federal Circuit has consistently construed “configured to” as “programmed to.” *See, e.g., Nevro Corp. v. Boston Scientific Corp.*, 955 F.3d 35, 41-42 (Fed. Cir. 2020) (“we construe ‘configured to’ to mean ‘programmed to’”). Nothing in the case law suggests that claiming “one or more physical processors configured by machine-readable

instructions” to perform certain operations forecloses the processors from performing other operations. Indeed, the ’832 patent itself confirms that the claimed processor(s) can perform operations beyond generating horizon-leveled content. (EX1001, 3:25-28; 24:4-24.)

GoPro’s cited case law is inapposite. The claim at issue in *In re Facebook, Inc.* did not even recite “configured.” *See* 2018 WL 3860547, at *1000 (Fed. Cir. 2018). Likewise, *Rex Med., L.P. v. Intuitive Surgical, Inc.*, 2020 WL 2128795 (D. Del. 2020) is distinguishable because the claim there relates to a surgical device and the court rejected a narrow construction of “configured to.” *Id.* at *5 (rejecting the defendant’s attempt to construe “configured to cause” to “shaped to contact”).

Further, the Federal Circuit is clear that “[p]rior art product that sometimes, but not always, embodies claimed method nonetheless teaches that aspect of invention.” *Hewlett-Packard Co. v. Mustek Sys., Inc.*, 340 F.3d 1314 (Fed. Cir. 2003). Thus, Voss’ “oscillat[ing]” example discloses the limitation because it involves “pillar-boxing.” (EX1007, 10:22-11:2.) Moreover, Voss mentions the “oscillat[ing]” example only once, and for the specific scenario of “a 16:9 video comprised of 1:1 to 16:9 content.” *Id.* Voss discloses several “pillar boxing” examples without “oscillat[ing]” or “cropping.” (*See, e.g., id.*, 11:5-7 (“if a user records a video that is ‘mostly landscape’ with a minority of portrait content, the

output format will be a landscape aspect ratio (pillar boxing the portrait segments).”); Abstract, 13:7-8.)

II. GOPRO’S NEW RELIANCE ON EX2004 IS IMPROPER

In its Sur-Reply, GoPro relies on EX2004, a Chinese patent application by Insta360, when addressing the Thomason-Pacurariu combination and claims 7/17. (Paper 39, 5-6.) But EX2004 was only mentioned in discussing secondary considerations in GoPro’s POR. (Paper 25, 77-78.) GoPro briefly mentioned EX2004 in its POPR, but only in connection with its failed attempt to limit “function of progress” to a smoothed zoom curve. (Paper 7, 16-18, 23.) Regardless, GoPro has waived its argument based on EX2004 in the Sur-Reply. *See In re NuVasive*, 842 F.3d 1376, 1380-81 (Fed. Cir. 2016) (finding patent owner waived arguments made in its preliminary response, but omitted in its POR).)

The Sur-Reply attempts to disguise its reliance on EX2004 as a purported response to GoPro’s discussion of frame-by-frame size determination. (Paper 39, 5-6.) Not so. The Petition made clear that the Thomason-Pacurariu combination discloses frame-by-frame size determination. (*See* Paper 2, 19-31, 37-40.) GoPro had the opportunity to address these arguments in its POR but chose not to.

III. GOPRO’S NEW POSITION ON “LOCATION” IS IMPROPER

GoPro has taken directly contradictory positions on whether claims 10 and 20 require the location of the viewing window to change. In its POR, GoPro

incorrectly asserted that “location” must be an “x–y coordinate” that must “change.” (Paper 25, 36 (“[t]he viewing window *cannot have the same location* throughout the video.”) (emphasis added).) Now that Insta360 has shown that GoPro’s claim construction is untenable and disclosed by prior art (Paper 32, 5-7, 15, 30-31; EX1001, Claim 1, 20:19-22, 24:50-58; EX1018, 68:4–11, 78:15–79:1), GoPro reversed course in its Sur-Reply, conceding that “[t]here may be circumstances where *location is determined to be the same* across frames” (Paper 39, 10 (emphasis added)) because claims 10 and 20 allegedly “require[] a process that *allows* for change.” (Paper 39, 10.)

The Board should reject GoPro’s attempt to shift positions.

IV. GOPRO’S NEW “UNMET NEED” ARGUMENT IS IMPROPER

In its POR, GoPro argued that “there is a *direct* nexus between GoPro’s Horizon Leveling and the objective evidence” without mentioning any presumptive nexus. (POR, 73 (emphasis added).) Yet in its Sur-reply, GoPro newly argues “a presumption of nexus.” (Paper 39, 26.)

Further, for the first time, GoPro raises “unmet need” as a secondary consideration. (Paper 39, 27-28.) It never raised this factor in its POR. (See Paper 25, 69-78.) Instead, its secondary consideration arguments rested solely on the alleged copying and commercial success. The Board should reject GoPro’s belated attempt to shift theories and introduce new arguments.

Dated: September 23, 2025

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