UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ARASHI VISION (U.S.) LLC (D/B/A INSTA360)
Petitioner,

v.

GOPRO, INC.
Patent Owner.

Patent No. 10,958,840 B2

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Inter Partes Review No. IPR2024-01165

PETITIONER'S PETITION RANKING AND EXPLANATION OF MATERIAL DIFFERENCES BETWEEN PETITIONS

Petitioner Arashi Vision (U.S.) LLC (d/b/a Insta360) ("Petitioner" or "Insta360") seeks *inter partes* review of U.S. Patent No. 10,958,840 ("the '840 patent" (Ex1001)) in two concurrently filed Petitions. (*See* IPR2024-01164, Paper 2; IPR2024-01165, Paper 2.)

Pursuant to the November 2019 Patent Trial and Appeal Board Consolidated Trial Practice Guide published by the USPTO, Petitioner submits this paper to "identify: (1) a ranking of the petitions in the order in which it wishes the Board to consider the merits, if the Board uses its discretion to institute any of the petitions, and (2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions if it identifies one petition that satisfies petitioner's burden under 35 U.S.C. § 314(a)." (*See* Patent Trial and Appeal Board Consolidated Trial Practice Guide November 2019, 59-61.)

The two Petitions rely on separate prior art. Petition 1 (IPR2024-01164) relies on U.S. Patent No. 10,027,893 to Bell *et al.* and U.S. Patent No. 10,462,370 to Shi *et al.*, which are prior art to the '840 Patent under at least § 102(a). Petition 2 (IPR2024-01165) relies on U.S. Patent No. 9,674,438 to Zhou *et al.* and U.S. Patent No. 10,158,802 to Cai *et al.*, which are prior art to the '840 Patent under at least § 102(a).

I. ORDERING OF PETITIONS

Although Petitioner believes that its two Petitions are meritorious and justified, at this stage, Petitioner requests that the Board consider the Petitions in the following order:

Rank	Petition	Primary References	Claims Challenged
1	IPR2024-01164 (Petition 1 of 2)	Bell (in view of Shi)	1-21
2	IPR2024-01165 (Petition 2 of 2)	Zhou (in view of Cai)	1-21

In view of the material factors shown below, the Board should exercise its discretion to institute both Petitions. Each Petition is necessary to show the breadth of prior art that reads on the overly broad claims. Each Petition provides a strong showing of unpatentability, without being redundant or duplicative. Instituting on only one or two of the Petitions would give Patent Owner an unfair advantage, allowing Patent Owner to strategically attempt to distinguish its claims over the instituted prior art even if those same arguments would effectively show invalidity over the noninstituted prior art.

II. MATERIAL DIFFERENCES JUSTIFY INSTITUTING MULTIPLE IPR PETITIONS

A. Large Number of Long Claims

Due to the large number of challenged claims and the lengthy and complex

nature of the claims, Petitioner requires two petitions to raise all of its IPR grounds.

In the parallel litigation involving the ’840 patent, Patent Owner asserted all 21 claims of the ’840 patent against Petitioner. (EX1013, 1.) Moreover, the claim language is particularly lengthy. For example, independent claim 1 spans almost an entire column of the ’840 patent. Petitioner is not able to fit all grounds against the claims into a single petition, but rather needs two petitions to challenge all asserted claims under two primary sets of grounds.

Indeed, in cases where petitions address more than 20 claims asserted against the petitioner, requests to institute multiple petitions have often been granted, particularly where claims are lengthy and where they introduce complexity, as here. *See, e.g.*, *Dolby Laboratories, Inc. v. Intertrust Technologies Corp.*, IPR2020-01106, Paper 12, 19-21 (PTAB Jan 5, 2021) (granting two petitions filed against 18 claims); *Adobe Inc. v. Synkloud Technologies, LLC*, Paper 8 at 8-10 (PTAB Mar. 11, 2021) (granting two petitions against 20 “lengthy” and “complex” asserted claims). Institution of both Petitions is reasonable when considering the large number of lengthy claims that Petitioner is required to address.

B. Primary Reference Teachings

Petitions 1 and 2 are not cumulative and independently teach each element of the challenged claims. The two petitions rely on completely separate prior art - Bell and Shi for Petition 1, and Zhou and Cai for Petition 2. Additionally, both Bell and Zhou disclose video stabilization but with different approaches. For example, Bell discloses performing video stabilization by defining a new virtual camera and adjusting the virtual camera's velocity, while Zhou discloses modulating the video stabilization strength value. As another example, Bell checks if the resulting crop polygon, whose position corresponds to the virtual camera position, is within either an inner or outer region of the image frame, while Zhou discloses checking if the stabilized frame is within an overscan region.

The Petitions are materially different with respect to the unpatentability grounds that they raise and the substantive prior art disclosures on which they rely. This justifies instituting both Petitions.

C. Respect for the Board's Resources

The '840 patent has never been previously presented in IPRs. And Petitioner is only filing two Petitions against the '840 patent, and presents a reasonable number of grounds in each, which further supports institution. *Abbott Labs. v. Integrated Sensing Sys., Inc.*, IPR2019-01338, Paper 7 (P.T.A.B. Jan. 23, 2020). In *Abbott Labs*, "there [were] only two concurrent petitions, each including a reasonable number of grounds," and the Board instituted both petitions on the

merits. *Id.*, 11 ("we do not find these two Petitions to be a significant burden on the Board's resources" and "[a]ddressing the challenges in both Petitions in these proceedings will provide a timely, fair and efficient resolution for both parties before the Board"); *see also Intel Corp. v. Hera Wireless S.A.*, IPR2018-01700, Paper 9 at 25-26 (P.T.A.B. Apr. 19, 2019) (instituting IPR on two petitions where the Board did "not regard the two proceedings as 'vexatious multiplication of proceedings.'"). Here too, there are only two concurrently filed Petitions, each with a reasonable number of grounds that rely on two primary references.

Dated: July 15, 2024

Respectfully submitted,

By: */s/ Alex S. Yap*

Alex S. Yap
Registration No.: 60,609
MORRISON & FOERSTER LLP
707 Wilshire Boulevard, Suite 6000
Los Angeles, CA 90017
Tel: (213) 892-5688
Fax: (213) 892-5454
Email: AYap@mofo.com

Certificate of Service (37 C.F.R. § 42.6(e)(4) and 42.205(a))

I hereby certify that the attached PETITIONER'S PETITION RANKING AND EXPLANATION OF MATERIAL DIFFERENCES BETWEEN PETITIONS was served as of the below date by UPS, which is a means at least as fast and reliable as U.S. Express Mail, on the Patent Owner at the correspondence address indicated for U.S. Patent No. 10,958,840:

GoPro Issuance
3025 Clearview Way
San Mateo, CA 94402

Dated: July 15, 2024

By: */s/ Alex S. Yap*
Alex S. Yap