

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. IPR2024-01186
U.S. Patent No. 10,574,894

PATENT OWNER'S MOTION TO STRIKE

I. INTRODUCTION AND SUMMARY OF MOTION

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

- Petitioner's new discussion and analysis of the new reference, the "Kwatra" paper (EX1023), including Petitioner's theory about how new evidence in the form of GoPro's development documentation (EX1022) interpreted the "Kwatra" paper. Reply 13-15, Ex. 1017 at ¶¶68-74.

In its Reply, Petitioner and its expert, Dr. Katsaggelos, argue—for the first time—that statements by GoPro engineers purportedly characterizing the *Kwatra paper* support its interpretation of the Kwatra patent. This theory relies on a new prior art reference (the Kwatra paper, EX1023) not cited in the Petition, on internal development evidence (EX1022) not previously relied upon, and on new expert opinion interpreting the new reference and evidence. Patent Owner has no opportunity to introduce testimonial evidence from the engineers or rebuttal testimony to explain the context of the statements. Accordingly, Patent Owner brings this motion to strike.

In opposing Patent Owner's request for leave, Petitioner asserted:

Although Patent Owner conclusorily asserts that the Reply and Dr. Katsaggelos' testimony "present improper new theories of unpatentability," it only points to "discussion and analysis" of the Kwatra Paper (EX1023), which "respond to arguments raised in the [] patent owner response." 37 C.F.R. §42.23(b). For

example, the discussion responds to arguments in the POR (Paper 17) at 8-13, 16-26, and Foroosh Decl. (EX2018) at ¶¶46-56, 60-79.”

But it is not proper rebuttal to respond to an argument about Kwatra (the patent) by introducing—for the first time—a separate reference (the Kwatra paper) and asserting that GoPro engineers “understood” that new reference in a way that supports Petitioner’s theory. This is not fairly a rebuttal to Patent Owner’s arguments regarding Kwatra (the patent); it is a new argument supported by new prior art, new internal evidence, and new expert testimony—all raised too late for a meaningful response.

II. PETITIONER IMPROPERLY INTRODUCES NEW PRIOR ART NOT RAISED IN THE PETITION

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) (citing 37 C.F.R. §§ 42.104(b)(5), 42.23(b)).

The Board’s own guidance likewise prohibits reply arguments that go beyond that role. The Trial Practice Guide makes clear that “Petitioner may not submit new evidence or argument in reply that it could have presented

earlier, e.g., to make out a prima facie case of unpatentability.” Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) at 73-74.

Here, Petitioner's Reply introduces a new piece of prior art—the Kwatra paper (EX1023)—and relies on new expert testimony and an internal GoPro document (EX1022) to support its argument that Kwatra (the patent) teaches a cost function minimizing rotational velocity and acceleration. See Reply, 13–15; Ex. 1017 ¶¶68–74. This is not a fair rebuttal to Patent Owner's discussion of the Kwatra patent.

While Petitioner argues that this “responds” to Patent Owner's argument that Kwatra discloses only linear models and expressly avoids rotational optimization, this is not rebuttal—but introduction of a new prior art reference interpreted through the lens of an internal document and expert opinion never previously disclosed.

III. THE PREJUDICE IS CLEAR AND UNAVOIDABLE

Patent Owner has no procedural mechanism to rebut this new argument. Sur-replies cannot introduce new testimonial evidence. Yet Petitioner's theory rests on a claim about what GoPro's engineers “understood” when developing an early prototype that used the Kwatra paper.

As Patent Owner will explain in its forthcoming sur-reply, the internal document (EX1022) discusses GoPro's own early algorithm, which was based

in part on the Kwatra paper. The statement about rotational optimization refers to ***GoPro's own method***—not to Kwatra's cost function. But without the ability to present declarations from the engineers or rebuttal expert testimony, Patent Owner cannot fairly explain the context or respond on equal footing.

The Board should not assess this claim about what GoPro engineers believed based solely on Petitioner's framing and expert interpretation, without giving Patent Owner an opportunity to respond with counter-evidence.

IV. THE BOARD SHOULD STRIKE THE NEW PRIOR ART, EVIDENCE AND OPINION

Although motions to strike are granted sparingly, the Board has done so where Petitioners introduce new arguments supported by new prior art and expert opinion not presented in the Petition. For example:

- In *Laboratoire Francais Du Fractionnement Et Des Biotechnologies SA v. Novo Nordisk Healthcare AG*, IPR2017-00028, Paper 109 at 16-22 (PTAB Apr. 13, 2022), the Board struck reply arguments based on three new exhibits, presented to show how a POSITA would have interpreted the asserted prior art—arguments that “should have been offered to support Petitioner's *prima facie* case” in the Petition.
- In *Haag-Streit AG v. Eidolon Optical LLC*, IPR2018-01311, Paper 31 at 2–8 (PTAB Sept. 5, 2019), the Board struck reply arguments based on a new prior art reference and corresponding expert analysis that “set forth new positions” at to what a POSITA would have known—arguments that should have been presented in the Petition.

Here too, Petitioner had access to the Kwatra paper at the time of the Petition and could have cited it then—but chose not to. It cannot now invoke the Kwatra paper and out-of-context statements from GoPro engineers—filtered through its expert—as a new theory to support its position. The prejudice is self-evident: Patent Owner has no opportunity to offer engineer testimony or rebuttal expert opinion to explain what the engineers actually meant.

Patent Owner respectfully requests that the Board strike the portions of Petitioner's Reply that rely on the Kwatra paper (EX1023), GoPro's internal development document (EX1022), and Dr. Katsaggelos' opinions interpreting those materials. Reply 13-15, Ex. 1017 at ¶¶68-74.

Date: August 26, 2025

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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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