

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA SOLUTIONS, INC.,
Petitioner

v.

STELLAR, LLC,
Patent Owner

Case: IPR2024-01284
U.S. Patent No. 8,310,540

PATENT OWNER'S PRELIMINARY RESPONSE

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Submitted Electronically via PTAB P-TACTS

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2013	Motorola's WatchGuard Acquisition Press Release (MOTOROLA_015931)
2014	File History of USP 5,982,418 (Ely)
2015	Motorola Stipulation Regarding Patents and Printed Publications
2016	Stellar Response to Motorola Stipulation

Pursuant to 35 U.S.C. § 313 and 37 C.F.R. § 42.107, Patent Owner Stellar, LLC (“Patent Owner”) submits this Preliminary Response to Petitioner Motorola Solutions, Inc.’s (“Petitioner”) Petition for *Inter Partes* Review, challenging claims 1-19 of U.S. Patent No. 8,310,540 (the “’540 Patent”). As detailed herein, the Board should either exercise its discretion to deny institution, or deny institution because Petitioner has failed to demonstrate a reasonable likelihood that it will prevail on any challenged claim.

I. INTRODUCTION

A. Stellar, LLC

Patent Owner, Stellar, LLC, is majority owned by Mr. Paul DeKeyser, the inventor of the ’540 patent. Mr. DeKeyser is an innovator on several issued patents and is highly experienced in the field of digital video recording, founding his first company in the digital-video recording arts in 1985. Mr. DeKeyser has received many industry awards and worked for many prominent clients, including NASA, Sandia Labs, PIXAR, Lockheed, and the NHL. Mr. DeKeyser founded Stellar in 2012.

The patents in the Stellar portfolio sprung from Mr. DeKeyser’s pioneering efforts in the areas of mobile and/or wearable video recording technology. Prior to his inventions, saving the relevant video recordings on a mobile device typically required that recorded data be manually saved or deleted when the device reached capacity. When the device reached the end of storage capacity in such a system, no

additional data could be recorded until the previously recorded data was transferred to an external medium or new/additional memory was added to the device. The other alternative was to utilize a circular buffer, which continually loops around to overwrite the next oldest data on the buffer, automatically erasing data that may have been desired for preservation.

B. Summary of Preliminary Response

Petitioner waited until less than one month before its statutory bar to file this Petition. Since the filing of the Complaint in the underlying litigation, the parties have gone through the claim construction process, have conducted more than a dozen depositions, have served expert reports, and are approximately seven months away from the district court's trial date—which, notably, the Court recently set July 2025. By the time of an institution decision in March 2025, the parties will have invested substantial effort and resources in fact and expert discovery, dispositive motions, and will be four months away from trial. A district court stay is essentially out of the question given the stage of the case. The facts here warrant the Board exercising discretion to deny institution under 35 U.S.C. § 314(a).

In addition, the Petition is flawed on the merits and does not warrant institution. Specifically, the primary references relied upon by Petitioner (Yerazunis and Ely) fail to disclose at least the elements of “protecting the multiple portions, within the single file, from being overwritten by subsequent recording in the memory loop” and “allowing the editing of the imaged data in protected multiple portions

stored in the memory loop within the single file via a recorder control while recording additional segments of the image data in the memory loop within the single file” as required by Independent Claim 1. Additionally, Petitioner’s asserted combination of Yerazunis and/or Ely with Fiore fails to disclose these elements. Accordingly, Petitioner has failed to meet its burden of establishing invalidity of any claims that depend from the independent claims of the ’540 patent.

Given these fatal flaws in each ground, as well as the ever-advancing stage of the district court case, the Board should deny institution, whether on the merits or through exercising its discretion under § 314(a).

II. OVERVIEW OF THE ’540 PATENT

Filed on Jun. 29, 2007, the USPTO issued on Nov. 13, 2012, U.S. Patent No. 8,310,540 (the “’540 Patent”), entitled “LOOP RECORDING WITH BOOK MARKING.” The ’540 Patent lists Paul DeKeyser, and claims the benefit of U.S. provisional patent 60/842,097, filed Aug. 31, 2006. The ’540 Patent is currently assigned to Stellar LLC, an entity in which Mr. DeKeyser owns a majority stake.

The ’540 Patent has 1 independent method claim (claim 1) with 14 dependent method claims, and 4 dependent system claims.

III. CLAIM CONSTRUCTION

Claims in a post-grant review are construed using the same claim construction standard as in a civil action. 37 C.F.R. § 42.100(b). Under this standard, claim terms are generally given their ordinary and customary meaning as understood by a person

of ordinary skill in the art (“POSITA”) at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-13 (Fed. Cir. 2005) (en banc). The POSITA is deemed to read claim terms in the context of the entire patent, including the specification and prosecution history. *Id.* at 1313-1316. Courts depart from the plain and ordinary meaning in only two instances: (1) when a patentee acts as its own lexicographer, and (2) when the patentee disavows the full scope of the claim term in the specification or during prosecution. *Hill-Rom Servs. v. Stryker Corp.*, 755 F.3d 1367, 1371 (Fed. Cir. 2014).

Petitioner asserts that the term “file” as used in the ’540 patent should be given its plain and ordinary meaning as of June 2007, which it asserts to be “an identifiable collection of data.” (Petition at 10-12.) As explained in detail below, Petitioner’s vague and unduly broad definition of “file” is not only contradicted by the prosecution history,¹ but also the extrinsic evidence it relies upon. Accordingly, Patent Owner reserves the right to present claim construction arguments if trial is instituted.

IV. THE BOARD SHOULD EXERCISE ITS DISCRETION UNDER 35 U.S.C. § 314(A) TO DENY INSTITUTION

¹ Applicant successfully distinguished over prior art cited in an Office Action rejection by pointing to the claimed storage of a “second distinct [event] file in the circular buffer,” because the mechanism of “storing captured data in a circular buffer as files facilitates exchange of data with other remote device [sic] without requiring post processing or finalization of the data.” (Ex. 1013 at 285-286.) This demonstrates that Applicant used “file” in a manner that is more specific than merely “an identifiable collection of data.”

The Board should exercise its discretion under 35 U.S.C. § 314(a) to deny institution here in view of the upcoming July 2025 district court trial date, which will occur ***eight months*** before the deadline for a final written decision (FWD) here. All six factors outlined in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 7-8 (May 13, 2020) support discretionary denial.

Notably, Petitioner is completely silent in its Petition as to the *Fintiv* factors. Also, in related IPR proceedings, Patent Owner raised *Fintiv* arguments in its POPRs, and Petitioner did not dispute those arguments, *e.g.*, by seeking leave to file a reply.

A. LEGAL STANDARDS

In exercising discretion under § 314(a) to deny institution, the Board may consider “events in other proceedings related to the same patent, either at the Office, in district courts, or the ITC.” Consolidated Trial Practice Guide, November 2019, at 58. The factors the Board considers in determining whether to exercise its discretion are: (1) whether the court granted a stay or evidence exists that a stay may be granted; (2) proximity of the court’s trial date to the Board’s projected deadline for a FWD; (3) investment in the parallel proceeding by the court and parties; (4) overlap between issues raised in the petition and the parallel proceeding; (5) whether the petitioner and the defendant in the parallel proceeding are the same party; and (6) other circumstances that impact the Board’s discretion, including the merits. *Fintiv*, IPR2020-00019, Paper 15 at 7-8.

B. BACKGROUND ON DISTRICT COURT LITIGATION

Patent Owner filed its complaint against Petitioner on August 21, 2023 in the Eastern District of Texas and served Petitioner with the Complaint on August 22, 2023. Exs. 2001, 2002. The Complaint accuses Petitioner of infringing the '540 Patent, as well as U.S. Patent Nos. 7,593,034, 8,692,882, 8,928,752, 9,485,471, 9,912,914, 10,523,901, and 10,965,910 (which Petitioner challenges in IPR2024-1205, -1206, -1207, -1208, -1285, -1313, and -1314 respectively).

Patent Owner served its Preliminary Infringement Contentions (PICs) on January 16, 2024 and First Amended PICs on February 7, 2024, at the request of Motorola. A motion for leave to amend is pending to allow service of the Second Amended PICs attached to that motion. Ex. 2003. Petitioner served its Preliminary Invalidity Contentions on February 27, 2024. Ex. 2004. The Court entered its Scheduling Order on January 12, 2024. Under the currently operative scheduling order, opening expert reports were served on October 16, 2024, rebuttal expert reports were served on November 6, 2024, and discovery will close on December 20, 2024. Ex. 2006. The Court recently ordered a July 2025 trial date. *Id.*

Patent Owner filed its opening *Markman* brief on May 17, 2024, Petitioner filed its responsive brief on May 31, 2024, and Patent Owner filed its reply brief on June 7, 2024. Ex. 2007. The Court conducted the *Markman* hearing on August 28, 2024, prior to which the Court provided preliminary constructions of the disputed claim terms. Ex. 2008, 2011.

Patent Owner and Petitioner made their Initial Disclosures on February 22, 2024, which Petitioner has since twice supplemented. The court issued a Protective Order (which was extensively negotiated by the parties) on January 24, 2024. Ex. 2009. The parties have responded to multiple sets of interrogatories from the opposing party, and to date have produced a combined total of more than 42,000 pages of documents.

On February 27, 2024, Petitioner served nearly 3,000 pages of invalidity contentions, alleging that the asserted claims of the '540 Patent (and the other asserted patents) are invalid under 35 U.S.C. § 103 in view of various combinations of references. Ex. 2004. In addition, Petitioner alleged that the asserted claims of the '540 Patent are invalid under § 112 for lack of enablement and written description. *Id.* at 267-283. Petitioner also alleges invalidity in view of several pieces of alleged system prior art. *See, e.g., id.* at 11-53.

Petitioner has also served third-party subpoenas relating to this alleged prior art, seeking extensive document production and depositions. Ex. 2010. Petitioner has taken the depositions of five third party witnesses. Petitioner has also deposed Mr. DeKeyser and Patent Owner.

Petitioner also served a 1,000-plus page invalidity expert report on October 16, 2024, in which Petitioner alleges, *inter alia*, the same invalidity theories as in its Petition. Petitioner has also served three additional expert reports (on alleged non-infringing alternatives, non-infringement, and damages), and Patent Owner has

served three expert reports (on infringement, damages, and validity). Expert depositions have been completed with the last taking place December 20, 2024. Petitioner has already filed two *Daubert* motions that the parties have briefed one of which was denied as moot.

Petitioner waited over eleven months after Patent Owner filed its Complaint (and more than six months after receiving Patent Owner's Infringement Contentions) to finally file this Petition on August 9, 2024. Petitioner does not explain this delay. The institution decision is not expected until March 20, 2024, and a FWD is not expected until March 20, 2026. Thus, the FWD is not due until eight months after the district court trial date—a date the Court set after the Petition was filed.

C. FACTOR 1: A STAY AT THE DISTRICT COURT IS VERY UNLIKELY

Petitioner has not sought a stay in the district court, and Patent Owner has no intention of seeking or consenting to one. Moreover, even if Petitioner were to seek a stay, that motion would almost certainly be denied, as Judge Jordan has not, to Patent Owner's knowledge, ever granted an opposed motion to stay proceedings pending an IPR. Moreover, other judges in the Eastern District of Texas have routinely denied motions to stay pending IPR where the party seeking the stay does not request it until a late stage, as is the case here. *See, e.g., Resonant Sys., Inc. v. Sony Group Corp.*, No. 2:22-cv-00424-JRG, Dkt. 84 (E.D. Tex. July 9, 2024) (denying stay when defendant delayed filing IPR petitions until 10 months after

service of complaint and where IPRs would be decided after district court trial); *Pantech Corp. v. LG Elecs. Inc.*, No. 5:22-cv-113-RWS-JBB, Dkt. 341 (June 10, 2024) (denying stay when *Markman* hearing had already been held and dispositive motion deadline had passed); *General Access Sols. V. Cellco P'ship*, No. 2:22-cv-394-JRG, Dkt. 225 (May 22, 2024) (denying stay where parties had already exchanged opening expert reports, trial was five months away, and FWDs were not due until six months after trial), *DigitalDoors, Inc. v. Int'l Bus. Machines Corp.*, No. 2:22-cv-457-JRG, Dkt. 41 (July 23, 2023) (denying stay when parties had exchanged contentions and discovery had begun), *MyPort, Inc. v. Samsung Elecs. Co.*, No. 2:22-cv-114-JRG, Dkt. 73 (June 12, 2023) (denying stay when depositions had already been taken and deadline for FWDs was over two months after trial). Here, the district court has already held a *Markman* hearing, the parties have served expert reports, and trial is less than four months away. By the expected date of an institution decision, trial will be only three weeks away. Therefore, it is extremely unlikely that the district court case will be stayed because of this proceeding.

Although the Board has, in the past, declined to infer how a district court would rule on a motion to stay, the facts here are inescapable. Not only has Petitioner not even filed a motion to stay, but Judge Jordan has never granted an opposed motion to stay to the knowledge of Patent Owner, and nothing suggests he would here. Based on the schedule outlined above, a possible institution decision date of February 16, 2024 (which is presumably the earliest Petitioner would seek a

stay) occurs during a sufficiently advanced stage in the litigation that any hypothetical motion after that point would almost certainly be denied. Therefore, because a stay is extremely unlikely, Factor 1 weighs strongly in favor of discretionary denial.

D. FACTOR 2: THE DISTRICT COURT’S TRIAL DATE IS EIGHT MONTHS BEFORE THE EXPECTED FINAL WRITTEN DECISION DATE

The precedential *Fintiv* decision, IPR2020-00019 at Paper 11, in discussing the earlier *NHK* decision, expressly noted that

[U]nder § 314(a) the Board considered the fact that the parallel district court proceeding was scheduled to finish before the Board reached a final decision as a factor favoring denial. The Board found that the earlier district court trial date presented efficiency considerations that provided an additional basis, separate from the independent concerns under 35 U.S.C. § 325(d), for denying institution. Thus, *NHK* applies to the situation where the district court has set a trial date to occur earlier than the Board’s deadline to issue a final written decision in an instituted proceeding.

Fintiv, IPR2020-00019, Paper 11 at 3. The rationale for discretionary denial in *NHK* also applies here, where the trial date is scheduled to occur eight months before the expected decision date. This earlier trial date presents efficiency considerations that are an independent basis for the Board to discretionarily deny institution. In the later *Fintiv* decision, IPR2020-00019, Paper 15, the Board expressly found that even a trial occurring two months before the expected FWD favored discretionary denial. IPR2020-00019, Paper 15 at 13. A trial date over eight months before the expected FWD favors discretionary denial, even under the Director’s current guidance. *See*,

e.g., Pharaoh Energy Servs. v. Flex-Chem Holding Co., IPR2024-00822, Paper 6 at 10 (Sept. 20, 2024) (denying institution of IPR when district court trial was scheduled for eight months before FWD deadline); *T-Mobile USA, Inc. v. Wireless Alliance, LLC*, IPR2024-00607, Paper No. 16 at 10 (Sept. 10, 2024) (denying institution of IPR when district court trial was scheduled for ten months before FWD deadline); *T-Mobile USA, Inc. v. Cobblestone Wireless, LLC*, IPR2024-00136, Paper No. 18 at 15 (June 5, 2024) (denying institution of IPR when district court trial date was eight months before FWD deadline); *10X Genomics v. Pres. And Fellows of Harvard College*, IPR2023-01299, Paper No. 15 at 17 (Mar. 7, 2024) (denying institution of IPR when district court trial date was up to five months before FWD deadline); *Samsung Elecs. Co. v. Mojo Mobility Inc.*, IPR2023-01098, Paper No. 11 at 8 (Feb. 9, 2024) (denying institution of IPR when district court trial date was six months before FWD deadline); *Zhuhai Cosmx Battery Co., Ltd. v. Ningde Ampere Tech. Ltd.*, IPR2023-00587, Paper 12 (Sept. 22, 2023) (denying institution of IPR when district court trial date was eight months before FWD deadline).

Thus, because the district court's trial date is over eight months before the anticipated FWD date here, Factor 2 heavily favors discretionary denial.

E. FACTOR 3: BOTH PARTIES AND THE COURT HAVE INVESTED SUBSTANTIAL EFFORT INTO THIS CASE AND WILL INVEST EVEN MORE BEFORE AN INSTITUTION DECISION

Petitioner cannot discount the investment the district court and the parties have already made in this dispute (and will make before the expected institution

decision date). Patent Owner has invested significant time and resources in preparing its Infringement Contentions; conducting and reviewing discovery; going through the *Markman* briefing/hearing process; preparing expert reports; and conducting depositions of Petitioner's fact and expert witnesses as well as numerous third-party witnesses. Patent Owner's Infringement Contentions in this case span over 850 pages of claim charts demonstrating Petitioner's infringement of 14 claims across eight asserted patents. Patent Owner has also served opening and rebuttal expert reports. By the time of a decision on whether to institute, Patent Owner will have expended even more effort briefing dispositive motions (if any) and preparing for a trial that will be four months away.

The parties' investment of time and resources exploring overlapping validity issues trace back to Petitioner's service of its Invalidity Contentions and continue today on validity-related expert discovery. Petitioner's Invalidity Contentions identify 115+ alleged patent prior art, printed publication, and system art references and include 45 claim charts, including 16 for the patent and patent application references relied on in its Petition. Ex. 2004. Petitioner has served several third-party subpoenas related to alleged system prior art (Ex. 2010), conducted several depositions, filed eight IPR petitions, has served an invalidity expert report on the which exceeded 1,000 pages (along with other two other opening and two rebuttal expert reports). Petitioner's expert report on validity repeats all of the assertions in

this Petition. Petitioner has likewise invested substantial time in providing Patent Owner with source code, technical documents, and financial documents.

The district court also has invested substantial resources in this case, including appointing a technical advisor, considering extensive *Markman* briefing (including an expert declaration from Petitioner and deposition thereof), conducting a *Markman* hearing and issuing preliminary *Markman* rulings on sixteen terms. Ex. 2011. The district court will already have to decide at least one *Daubert* motion that Petitioner has filed, in addition to any dispositive motions that the parties file next month.

The parties and the court will continue to invest more effort and resources before an institution decision. By that time, fact and expert discovery will have closed, dispositive motions will be fully briefed, and the parties will be in the process of exchanging pretrial disclosures, with trial only a few weeks away. Of course, significant work remains to be done for trial in the underlying case, but that alone does not justify minimizing the investment the district court and the parties have made.

The amount of investment that has occurred in this case is similar to other cases in which the Board has found this factor weighed substantially in favor of denying institution. *See, e.g., Pharaoh Energy Servs.*, Paper 6 at 11 (Sept. 20, 2024) (denying institution of IPR when district court case had proceeded through fact and expert discovery); *T-Mobile v. Wireless Alliance*, IPR2024-00607, Paper No. 16 at 11-12 (Sept. 10, 2024) (denying institution of IPR when district court case had

proceeded through *Markman* hearing, the parties had exchanged expert reports, and were in the midst of pretrial disclosures at the time of the institution decision); *T-Mobile v. Cobblestone Wireless*, Paper No. 18 at 17 (June 5, 2024) (denying institution of IPR when district court case had proceeded through *Markman* hearing and exchange of expert reports); *10X Genomics*, Paper No. 15 at 18 (Mar. 7, 2024) (denying institution of IPR when district court case had proceeded through *Markman* hearing and parties had exchanged contentions and completed substantial fact discovery); *Samsung Elecs.*, Paper No. 11 at 8-9 (Feb. 9, 2024) (denying institution of IPR when district court case had proceeded through fact discovery and the *Markman* hearing); *Zhuhai Cosmx Battery*, Paper 12 (Sept. 22, 2023) (denying institution of IPR when district court trial date was eight months before FWD deadline).

Therefore, Factor 3 also favors the Board exercising discretion to deny institution.

F. FACTOR 4: OVERLAP OF ISSUES RAISED IN THE PETITION AND DISTRICT COURT CASE

The references relied on in the Petition substantially overlap with those in its Invalidity Contentions and the arguments are redundant of the opinions in its opening expert report. Specifically, Petitioner's combinations of Yerazunis and Ely in further view of Fiore are the same as those identified in Dr. Sarhan's opening expert report in the underlying litigation—and Petitioner relies on the same expert

in the underlying litigation. The Petition offers no explanation for this overlap or any means by which Petitioner intends to avoid this overlap.²

This factor thus favors denying institution as well.

G. FACTOR 5: PETITIONER AND ONE DEFENDANT IN THE DISTRICT COURT CASE ARE THE SAME PARTY

“Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.” *Fintiv*, IPR2020-00019, Paper 15 at 15.

Petitioner does not dispute that it is a defendant in the district court litigation. The only additional defendant in the underlying litigation is WatchGuard Video, Inc., a company Petitioner acquired in July 2019. Ex. 2013.

Factor 5 therefore favors discretionary denial of institution.

H. FACTOR 6: FATAL FLAWS IN THE PETITION FAVOR DISCRETIONARY DENIAL

As the Board reiterated in its *Fintiv* decision, “a balanced assessment of factors may include consideration of the merits.” *Fintiv*, Paper 15 at 15. In addition, under the Director’s June 21, 2022 Guidance Memorandum, because the five factors

² In early December, Petitioner generally suggested a stipulation, but the contours of it are unclear. Ex. 2015. For example, Petitioner has not committed as to which specific invalidity theories it will not pursue if the Board institutes trial here. Patent Owner has sought clarity on this from Petitioner (Ex. 2016), but Petitioner has thus far refused to provide clarity. Also, because the Board’s institution decision is due well after the district court’s January 2025 deadline for filing dispositive motions, Patent Owner may have to burden the Court with eleventh-hour motion practice on estoppel if the Board institutes trial—a result of Petitioner’s delay.

above favor discretionary denial, the Board must consider whether the Petition “presents a compelling unpatentability challenge.” *Commscope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 (Feb. 27, 2023). As discussed *infra*, the merits of the Petition are fatally flawed, as (i) Petitioner has failed to show any valid motivation to combine any of its primary and secondary references, and (ii) Petitioner has failed to show that its proposed combinations teach every element of the challenged claims.

The Board has found this factor favors discretionary denial where petitioners fail to provide valid motivations to combine. *See, e.g., Nine Energy Serv. Inc. v. NCS Multistage, Inc.*, IPR2020-01615, Paper 18 at 14-15 (Mar. 24, 2021). As discussed *infra*, Petitioner has failed to show any valid motivation to combine any of its primary and secondary references.

In addition, the Board has found this factor to favor exercising discretion to deny institution where a patent owner identifies flaws in the petitioner’s mapping of reference(s) to the claim elements. *Verizon Business Network Services LLC v. Huawei Technologies Co., Ltd.*, IPR2020-01278, Paper 12 at 15 (Jan. 26, 2021); *Fintiv*, IPR2020-00019, Paper 11 at 15 (“[I]f the merits of the grounds raised in the petition are a closer call, then that fact has favored denying institution when other factors favoring denial are present.”). As discussed *infra*, Petitioner has failed to show that its proposed combinations meet several claim elements.

Given these flaws, Factor 6 favors discretionary denial.

I. CONCLUSION REGARDING DISCRETIONARY DENIAL

All six *Fintiv* factors favor discretionary denial, and any mitigation of overlapping issues from a belated and as-yet defined stipulation does not outweigh the other factors. Petitioner’s silence on the *Fintiv* factors—coupled with its failure to dispute those arguments in related IPR proceedings—further suggests that the *Fintiv* factors favor denial of institution.

The Board should therefore exercise its discretion to deny institution under § 314(a).

V. PETITIONER HAS NOT ESTABLISHED A REASONABLE LIKELIHOOD OF PROVING ANY CHALLENGED CLAIM IS INVALID

Certain claim elements are missing from the references relied upon in the Petition. First, these references fail to disclose: “protecting the multiple portions, within the single file, from being overwritten by subsequent recording in the memory loop[.]” (Ex. 1018, claim 1.) This concept is sometimes referred to herein as signal-designated ‘*selective*’ write-protection. In addition, the Petition fails to articulate sufficient motivation to combine the asserted references.

A. BACKGROUND ON THE PATENABILITY CHALLENGE

1. Legal Standards

The Board may only institute an IPR where “the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C.

§ 314(a); 37 C.F.R. § 42.108(c). Petitioner bears the burden of showing that this statutory threshold has been met. *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (“[T]he Petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.”); *Liberty Mut. Ins. Co. v. Progressive Cas. Ins. Co.*, CBM2012-00003, Paper 8 at 14-15 (Oct. 25, 2012) (representative) (“[I]t is the responsibility of the Petitioner to clearly articulate [the proposed combination].”); 37 C.F.R. §§ 42.22(a)(2), 42.104(b)(4).

The Petition relies solely on obviousness, and more specifically upon combinations of two or more references for each ground. Section 103 of the Patent Act provides that “[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter **as a whole** would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103(a) (emphasis added). If a single element of a claim is absent from the prior art, the claim cannot be considered obvious. *CFMT, Inc. v. YieldUp Int’l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (“[O]bviousness requires a suggestion of all limitations in a claim.”) (citing *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974)); *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993) (reversing obviousness rejection where prior art did not teach or suggest all claim limitations); *Garmin Int’l, Inc. v. Patent of Cuozzo Speed Techs. LLC*, Case No. IPR2012-00001, Paper 15 at 15 (Jan.

9, 2013) (refusing to institute an IPR under 35 U.S.C. § 103 where prior art did not disclose all claim limitations).

The conclusion of obviousness based on a combination of references must be supported with explicit analysis of a reason to combine those references. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). The Federal Circuit has stated that such reasons must be more than “mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006); *accord Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1374 (Fed. Cir. 2008) (agreeing with the district court’s reasoning that “some kind of motivation must be shown from some source, so that the jury can understand why a person of ordinary skill would have thought of either combining two or more references or modifying one to achieve the patented method”); *LG Elecs., Inc. v. Cellular Commc’ns Equip. LLC*, IPR2016-00197, Paper 7 at 7-11 (April 29, 2016) (faulting a petition’s obviousness analysis for lack of sufficient articulated reasons with rational underpinnings for modifying references to achieve particular elements required in the claims).

2. Exemplary Concepts Claimed in the ’540 Patent

a. Claim 1 as Exemplary

Claim 1, the only independent claim in the ’540 patent, is reproduced here with the element numbering used in the Petition:

- Pre** 1. A method of storing discrete segments of imaged data in a camera, comprising:
- #1 using a sensor in the camera to capture image data;
 - #2 providing a recorder coupled to the camera and having a memory;
 - #3 using multiple portions of the memory as a memory loop in which to record segments of the image data in approximately real time;
 - #4 treating the memory loop as a single file;
 - #5 protecting the multiple portions, within the single file, from being overwritten by subsequent recording in the memory loop; and
 - #6 allowing the editing of the imaged data in protected multiple portions stored in the memory loop within the single file via a recorder control while recording additional segments of the image data in the memory loop within the single file.

b. Teachings of the '540 Patent Regarding *Protecting Portions*

With respect to element #5 of claim 1 of the '540 patent, the patent teaches that multiple portions of data captured on a memory loop may be write-protected and 'skipped over' (Ex. 1018, 2:64–3:3, 4:11–15, 7:19–27), while the circular buffer otherwise loops to overwrite, by subsequent recording in the memory loop, at the location of the oldest non-protected data on the buffer. (See, e.g., Ex. 1018, 4:5–7, 7:19–27.) This looping overwrite and selective write-protection concept is specifically illustrated through Figures 1 and 3. In describing the concept of selective write-protection within the circular buffer, the '540 patent specification explains the illustrations in these figures as follows:

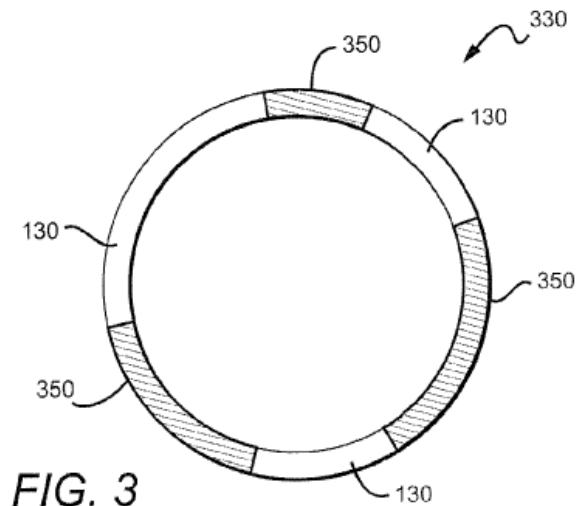
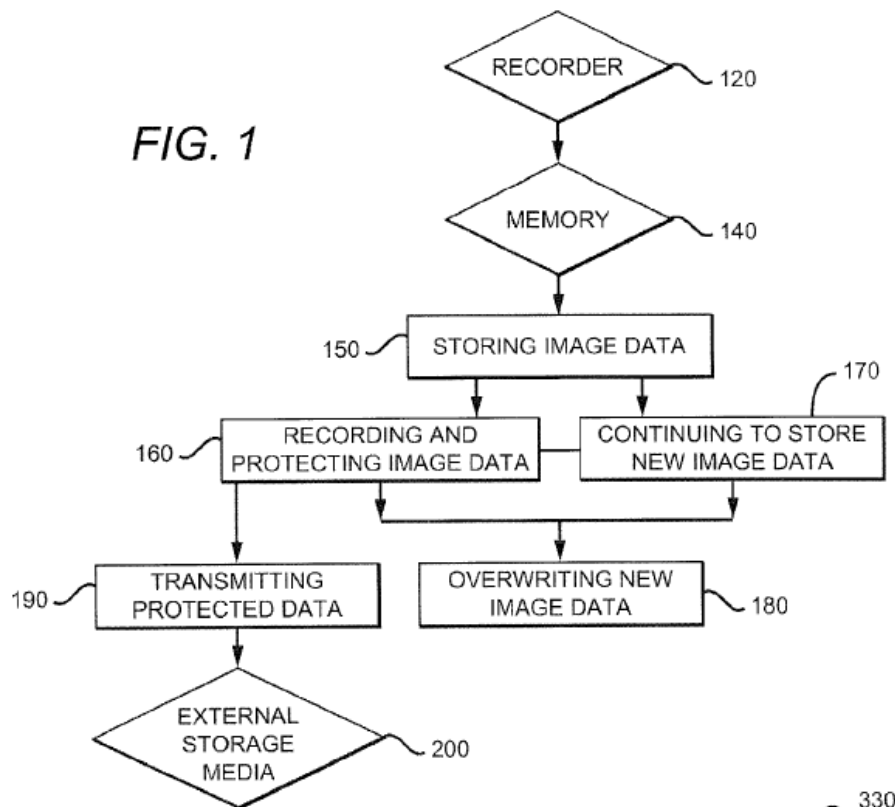
FIG. 1 is a block diagram generally includes the steps of a recorder 120 comprising a memory 140, storing image data 5 onto the memory 150, recording and protecting image data onto memory 160, continuing to store new image data into available memory 170, overwriting new image data onto available memory 180, and transmitting protected data 190 to an external storage media 200.

Ex. 1018, 3:4–10

The patent continues, explaining that:

As shown in a diagram in FIG. 3, image data 130 marked for protection becomes protected data 350 in loop 330. Protected data 350 is characterized as a predefined portion of the recording data. It is contemplated that the portion of the loop that is marked as protected data cannot be overwritten once the recorder loops back to the beginning of the media.

(Ex. 1018, 4:10–15.)



c. Teachings of the '540 Patent Regarding *Storing Data as a 'File' Within the Buffer*

In its 'Summary of the Invention' the '540 patent specification explains the benefits of storing data as a "file" within the circular buffer:

. . . In preferred embodiments, the loop is sufficiently large enough to store at least five minutes of the image data and be stored as a single

file. When the recorder stores the first and second multiple data portions, they can be stored as separate files or a common file separate from the loop single file.

(Ex. 1018, 2:4–8.) And further provides:

. . . It is preferred when the recorder is turned on *the entire circular buffer is treated and stored as a single **file***. Thus, if no recording is protected or bookmarked, then *the entire **file** will be erased* and the recording will start at the beginning of the loop.

(Ex. 1018 at 4:3-7.) And as further detailed below, the prosecution history of the predecessor application to the '540 patent evidences that “file” as recited in the claims constitutes a more specific means for saving data than simply “*an identifiable collection of data*,” as the Petition wrongly proposed. (*Compare*, Ex. 1013 at 285–286, *with* Pet. at 10.)

B. THE PETITION FAILS TO ESTABLISH THAT THE CLAIMS OF THE '540 PATENT WOULD HAVE BEEN OBVIOUS OVER YERAZUNIS ALONE OR AS COMBINED WITH FIORE, AS ASSERTED IN ITS GROUNDS 1A THROUGH 1C

Petitioner’s Ground 1 theories—Yerazunis alone or in combination with Fiore—fail to address at least three key requirements of the independent claims of the '540 patent. First, Yerazunis (alone or combination with Fiore) fails to teach “treating [a] memory loop as a single file,” especially a file of write-protected data. (Ex. 1018, 8:27.) Second, Yerazunis (alone or in combination with Fiore) fails to teach “protecting the multiple portions, within the single file, from being overwritten by subsequent recording in the memory loop.” (Ex. 1018, 8:28-30.) Third, Yerazunis (alone or in combination with Fiore) fails to teach “allowing the editing

of the imaged data in protected multiple portions stored in the memory loop within the single file via a recorder control while recording additional segments of the image data in the memory loop within the single file.” (Ex. 1018, 8:31-35.) Thus, Petitioner’s Ground 1 combinations fails to establish a substantial question of patentability as to any claim of the ’540 patent.

1. The Combination of Yerazunis and Fiore Does Not Disclose “*File*” Storage in the Buffer

Claim 1 of the ’540 patent requires: (i) “treating the memory loop as a single *file*;” and (ii) “protecting the multiple portions, within the single *file*, from being overwritten by subsequent recording in the memory loop.” (Ex. 1018 at 8:27–35.) Yerazunis fails to teach this use of a “*file*” within a memory loop. In fact, Yerazunis makes no mention of any “*file*” at all, let alone as part of a memory loop (or circular buffer) or even as an output format. Instead, Yerazunis contemplates outputting data from its buffer by serial data transfer: “[a] serial output channel is provided to permit recorded frame data to be downloaded to a computer for viewing. Alternatively, any appropriate data transfer link and protocol may be employed.” (Ex. 1017 at 3:1-4.)

Petitioner wrongly assertions that, for the term “*file*”, its “plain and ordinary meaning as of June 2007 . . . was ‘*an identifiable collection of data.*’” (Pet. at 10.) Petitioner uses this misinterpretation of “*file*” to wrongly assert that “A POSITA would have found it obvious to treat the circular buffer as a single file . . . based on Yerazunis’s disclosure of storing pointers that “defin[e] the areas(s) of the circular

buffer” in memory.” (Pet. at 26 (*citing* Sarhan Decl., EX1051, at ¶182.) Petitioner offers no further explanation for why storing pointers that define the areas of a circular buffer would make it obvious to a POSITA to treat the circular buffer as a single file—other than to parrot this same conclusory assertion by its own expert. This does not suffice to meet the standard for proving obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006); *accord Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1374 (Fed. Cir. 2008); *LG Elecs., Inc. v. Cellular Commc’ns Equip. LLC*, IPR2016-00197, Paper 7 at 7-11 (April 29, 2016). Also, in computer programming, “pointers” are used to reference an address/location in memory.³ Petitioner’s suggest that using pointers to ‘define the areas’ of memory somehow means storing data as a “file” is nonsensical. This would mean all data stored in memory is stored as a “file”.

Likewise, Petitioner’s assertion that the plain and ordinary meaning of “*file*” in digital video recording arts broadly means “*an identifiable collection of data*” is too generic to be the plain an ordinary meaning. (Pet. at 9-12.) As explained below, this ignores the common understanding, as shown in many of the dictionary definitions offered by Petitioner, that a file is treated as a single unit. It also ignores the prosecution history of the ’034 patent (which is a continuation-in-part of the application issuing as the ’540 patent), wherein Patent Owner explained:

³ See, e.g., https://en.wikipedia.org/wiki/Pointer_%28computer_programming%29

Amended claim 1 clarifies that the data streams are recorded in a circular buffer as a first file using a digital video file format, and a write-protected portion is indexed as a second distinct file in the circular buffer. The Applicant has appreciated that *storing captured data **in a circular buffer as files** facilitates exchange of data with other remote device without requiring post processing or finalization of the data* as is required by known systems, including the cited art. The cited art, Vanman and Hattori both discuss circular buffers. However, neither disclose storing data streams as files within the circular buffer, especially where a write-protected portion of the buffer is indexed as a second, distinct file from the file representing the data stream. In short, claim 1 is allowable over Vanman and Hattori, alone or combined, on the grounds that they fail to teach, suggest, or motivate all the elements of claim 1.

The Examiner notes that Hattori lacks support for storing protected areas ***as separate files***, and cites passage located at C3/L62 - C4/L 11 as motivation storing write protected regions ***as separate files***. The Applicant respectfully disagrees. One should note in the claimed approach files are stored within a circular buffer as opposed to a flat memory space (e.g., HOD, DVD, etc.) that would utilize a traditional file system with which one skilled in the art would be familiar. Traditional file systems are completely unsuitable for use within a circular buffer because they expect bounded extents, among other limitations. *Therefore, having **files within a circular buffer** of the claimed apparatus would be **non-obvious**, especially where a file (i.e., the second distinct file) could be created in the middle of another file (i.e., the first file).* The approach disclosed by the Applicant resolves such issues.

(Ex. 1013 at 285-286 (only bolded emphasis added).) Following this response, all rejections (other than provisional rejections based on double patenting) were dropped in view of these distinctions made over the cited prior art, which included the concept of file storage but not the claimed inclusion of a file of signal-designated write-protected data stored ***within*** the circular buffer. (*Id.* at 293-296.)

This intrinsic record underscores the fallacy of Petitioner’s construction of the term “file”. Patent Owner makes clear that it was not merely introducing the concept of a “*file*” to indicate any “*identifiable collection of data*”. Rather, Patent Owner used the term “*file*” to indicate something that would “*facilitate [the] exchange of data*” and eliminate the need for further “*processing*” of the data. (*Id.* at 285-286.) Next, the forgoing reveals that, “in the claimed approach files are stored *within* a circular buffer as opposed” to being stored elsewhere. (*Id.*) Nowhere does Yerazunis (nor Fiore, for that matter) disclose storing a “file” within a circular buffer (or, as phrased in the ’540 patent claims, “a memory loop”), which Patent Owner specifically asserted to be “non-obvious”. (*Id.*) Instead, Petitioner attempts to equate a “file” with a Yerazunis disclosure of a “table” which can store information associated with firing-event data (Pet. at 28 (*citing* Ex. 1017 at 17:50-56)) but is not itself a unit of containerized data. Not only is a *table* not a *file*, but even here, the disclosure fails to teach storing such a table within the buffer itself.

Finally, Petitioner’s use of “*identifiable*” to define “*file*” is inconsistent with logic and common understanding. Under Petitioner’s overly broad construction, all stored data constitutes a “*file*”, because one way to ‘identify’ data could be based on its location of storage, making all stored (*i.e.*, locatable) data “*identifiable data*”. Petitioner’s oversimplified definition of “file” is even at odds with its own extrinsic evidence. Petitioner’s cited dictionaries show that a file is stored and named as a unit, especially for purposes of input and output, and the file’s type indicates a

software type needed for proper handling of its contents. (Ex. 1025 at 3 (“[a] collection of related data or program records stored as a unit with a single name.”); Ex. 1026 at 3 (“a complete collection of data (as text or a program) treated by a computer as a unit esp. for purposes of input and output.”; Ex. 1027 at 3 (“[a] collection of information which is stored as a unit. Files may be retrieved, modified, stored, deleted, or transferred. Each type of file requires the appropriate software for the proper handling of its contents.”).)

In addition, claim 3 of the ’540 patent recites: “storing first and second ones of the multiple portions as separate files.” To allege that this concept exists in the prior art, Petitioner offers the same arguments rebutted above, asserting: “Yerazunis discloses protecting video data pertaining to multiple events from being overwritten (by subsequent recording) by indexing the video data as one or more files in a table/index corresponding to the buffer.” (Pet. at 36.) Again, Yerazunis makes no mention of “file”. And Yerazunis certainly makes no mention of storing a separate file for one of multiple portions in a memory loop. Nor does Fiore disclose this concept of storing a data file (corresponding to single portion of recorded image data) within a memory loop. Instead, Fiore teaches saving secondary, discrete files in a separate database: “additional secondary memory mapped files . . . [into which] an event processor . . . **copies** a plurality of data frames stored in the circular storage buffer that have time stamps proximate to the time of the event . . . [for storage in an] event database.” (Ex. 1009 at ¶ 0022.)

Thus, the Petition fails to establish that the claimed “file” concepts exist in Yerazunis alone, or in combination with Fiore.

2. Yerazunis Does Not Disclose “Protecting the Multiple Portions, within the Single File, from Being Overwritten by Subsequent Recording in the Memory Loop”

Claim 1 of the ’540 patent requires “protecting the multiple portions, within the single file, from being overwritten by subsequent recording in the memory loop;” (Ex. 1018, 8:28–30.) Yerazunis fails to teach this write-protecting “portions” of its buffer memory. Instead, Yerazunis discloses a system whereby the entirety of a circular buffer (*i.e.*, all data in the buffer) is preserved in response to a triggering signal by ceasing to record over previously ***used*** (*i.e.*, recorded) portions of the Yerazunis buffer(s).

Generally, Yerazunis discloses a camera system for use either within a car to capture accidents, or with a gun to capture video surrounding the firing of the gun. (Ex. 1017 at 1:17-27.) According to Yerazunis, the inventors aimed to address the problem of recording video in such situations, confined by the limitations of recording such an event, *i.e.*, the size limitations of mounting the camera to the gun, as well as dealing with the shock and vibrations inherent in both setups. (*See* Ex. 1017 at 1:32-67, 3:9-19.)

Given these environmental limitations, the solution that Yerazunis proposes for the car implementation is a simple ‘buffer-record-and-stop’ scheme, in which the video data is stored in a circular buffer until a triggering event, at which point the

system records a small amount of additional video, and then stops the recording altogether. (*See id. at, e.g.*, 2:19-25 (“Upon detection of a trigger event, the video recording device records a predetermined number of additional frames and then ceases to record further frame data.”); *see also id.*, 8:26-32.)

For the gun camera implementation, Yerazunis proposes a slightly more involved solution, in which the system pre-designates portions of the memory for multiple firing events. (*See id.*, Abstract (“In the event of a further firing of the gun, an additional portion of the buffer memory is dedicated to preserving the image data associated with [the] subsequent firing incident.”); 17:9-15 (“The circular buffer memory may be subdivided evenly to accommodate a predetermined number of firings of the gun and an equal number of frames may be stored within the circular buffer memory for each firing. Alternatively, a fraction of the circular buffer memory may be devoted to the storage of data associated with the first firing.”).)

To implement this memory designation scheme, Yerazunis explains that, after the first firing event, “[t]he head and the tail pointers are then reset to allow *continued recording into **another portion** of the circular buffer memory.*” (*Id.*, 17:56-58.) In other words, for firing event #1, the head and tail pointers confine the system to recording to designated portion #1; then, for firing event #2, the head and tail pointers are reset to record data to designated portion #2, and so on. As the above disclosures make clear, there is no “**write-protection**” of a “**segment**” within a circular buffer in Yerazunis. In the in-car ‘buffer-record-and-stop’ scheme, the

entire buffer (not just a segment of it) is saved. And, in the gun implementation, the system uses only unused blocks of memory for each firing event (*i.e.*, no overwriting within the buffer once a trigger signal is detected). In that scenario, the system is not “respond[ing] to a signal to record by designating a segment of the circular buffer as a write-protected portion” (as claims 1 requires), but is instead responding to the signal by recording to one unused portion and then switching (using the pointers) to record in a second unused portion. This is made even more apparent by Yerazunis’s disclosure of a “purge button” that, once pressed, “[erases] the contents of the circular buffer and any still images that have been captured.” (*Id.*, 9:47-51.) That is, the entire contents of the buffer are protected and unprotected as a whole.

Yerazunis explains that video data ‘*preservation*’ is a step that occurs ***after***, not as part of, the step of “continu[ing] to record for a brief interval” in response to a trigger signal:

More specifically, the video recording device 300 includes a sensor, which is responsive to the discharge of the gun 304 to cause the video recording device 300 to continue to record for a brief interval following the discharge of the gun into a designated portion of a memory ***and to then preserve*** video frame information generated before and after the discharge of the weapon by the officer.

(Ex. 1017 at 14:55-61.) Yerazunis’s claims also reveal that video image data associated with an event trigger is ‘*preserved*’ by ***transferring*** the data to a “separate portion of . . . semiconductor memory” that is “nonvolatile” memory, *i.e.*, not write-protecting while the data remains within the multiple portions of the memory loop

itself, wherein the segments of the image data were recorded in real time. (*See, e.g.*, Ex. 1017 at 21:11, 21:59-22:5, 22:53-67.)

As explained below with respect to the lack of motivation to combine, Fiore also fails to disclose the concept of write-protecting portions of data within its circular buffer. Rather, to preserve data, Fiore teaches that individual event data may be transferred to a different memory location:

The extracted data frames are then stored in file system 17 thereby providing a permanent record of the data frames before, during, and after the event prior to the data frames being overwritten in the circular storage buffer 15 by more recent data frames.

(Ex. 1009 at ¶ 0048.) Nowhere does Fiore suggest write-protecting portions of data within a memory loop or circular buffer, so, a POSITA could not look to Fiore for guidance on a system to institute the claimed write-protections within a memory loop or circular buffer.

Thus, the Petition fails to establish that the claimed “*protecting the multiple portions . . . in the memory loop*” concept exists in Yerazunis alone, or in combination with Fiore.

3. Yerazunis Does Not Disclose “Allowing the Editing of the Imaged Data in Protected Multiple Portions Stored in the Memory Loop within the Single File via a Recorder Control While Recording Additional Segments of the Image Data in the Memory Loop within the Single File”

Claim 1 of the ’540 patent requires “allowing the editing of the imaged data in protected multiple portions stored in the memory loop within the single file via a recorder control while recording additional segments of the image data in the

memory loop within the single file.” (Ex. 1018, 8:31-35.) Yerazunis fails to disclose this editing element of claim 1. Petitioner attempt to rely on a disclosure in Yerazunis regarding “a purge button 76” which allows captured images to be erased. In order to equate erasure with editing Petitioner quotes the following from claim 19 of the ’540 patent: “. . . wherein the step of allowing the editing of the image data . . . includes an action selected from the group consisting of . . . releasing a protected portion of the memory from protection.” Note, however that this does not equate erasure with editing. This shows that the patentee deems one of the characterizes of data editing to include revising the write-protection status of data. This does not suggests that one way image data’s characteristic may be edited is to erase the image data altogether. That goes beyond the plain and ordinary meaning of “edit”, the dictionary definitions for which generally include the notion of modifying, altering or rearranging information from its original written form.⁴

Petitioner next argues that Yerazunis’ disclosure of “overlay[ing] time and date information on the digital frame data stored within the applicable memory” is something a POSITA would have understood to be among the “myriad potential actions” that constitute “editing”. (Pet. at 33.) Petitioner, here, relies on the writing of data in the first instance as an example of “editing”. This, again, goes beyond the

⁴ See, e.g., <https://dictionary.cambridge.org/us/dictionary/english/editing>, <https://www.merriam-webster.com/dictionary/edit>, and <https://www.collinsdictionary.com/us/dictionary/english/editing>.

plain and ordinary meaning of “edit” as embodying some notion of modification or alteration of original information.

Thus, the Petition fails to establish that the claimed “*editing*” concept exists in Yerazunis alone, or in combination with Fiore.

4. Petitioner Has Failed to Meet Its Burden of Showing That a POSITA Would Have Been Motivated to Combine Yerazunis with Fiore

Petitioner wrongly states that a POSITA would have been motivated to combine Yerazunis and Fiore to arrive at the inventions of the ’540 patent. (Pet. at 17–18.) Petitioner’s expert asserts that Yerazunis and Fiore “describe similar technologies and solve similar problems.” (Ex. 1051 at ¶ 166; *see also* Pet. at 17–18.) First, as Petitioner’s expert acknowledges, Yerazunis discloses a “compact video image recording device” for different applications. (Pet. at 18; Ex. 1051 at ¶ 166.) Fiore, by contrast, distinguishes itself from specialized devices by discouraging reliance on “proprietary hardware architectures and internal programming” which Fiore describes as “not readily transferable to event recording and playback devices” and instead directs its application to “a programmable computer such as personal computers, servers, or the like. . . . a computer based implementation of the event recording and playback devices is desirable since such computers provide the flexibility to be adapted for various applications.” (Ex. 1009 at ¶ 0009.)

Petitioner further asserts that “[b]ecause Yerazunis and Fiore disclose data recording systems that store data in a circular buffer and preserve data associated with an event—both before and after an event trigger—a POSITA would have been aware of and motivated to combine the two references.” (Pet. at 18; Ex. 1051 at ¶ 166.) As explained above, Yerazunis **ceases** to record video data after a predetermined number of frames following a trigger. (Ex. 1017 at 2:53-55.) This concept of stopping the recording is repeated throughout Yerazunis. (*Id.* at 2:53-55, 4:49-52, 7:62-64, 8:2-7, 8:30-32, 11:27-30, 12:14-17, 12:17-23, 13:5-11, 14:1-7, 14:12-18.) Yerazunis’s planned ‘**cessation**’ of circular recording is incompatible with one of the fundamental purposes of Fiore, to avoid “dropped frames” or any scenario where real-time data is not captured and stored, resulting in “the loss of potentially very critical data.” (Ex. 1009 at ¶¶ 0012-13.) Even where Yerazunis contemplates capturing “subsequent firing events” after the initial trigger, this subsequent event data “is stored within an **unused** portion of the circular buffer memory” and goes on to describe how this unused portion may be rationed in the recording of subsequent firing events “until the buffer memory is **full**.” (Ex. 1017 at 3:28-33; *id.* at 16:66-17:61; *see also* 8:53-55.)

Yerazunis further discloses that recorded data frames will only be stored in buffer memory “**for a short period of time**.” (Ex. 1017, Abstract; *see also, id.* at 1:56, 3:25-28.) This short amount of data capture—coupled with Yerazunis’s teaching to cease recording once the buffer is full—is incompatible with one of the

core needs targeted in Fiore, “minimizing the likelihood of dropped frames” and allowing playback “without interrupting simultaneous recording of new input signal data.” (See, *e.g.*, Ex. 1009 at ¶¶ 0016, 0023.)

In addition, Fiore would not be a source to which a POSITA would look when searching for a solution to selectively write-protect segments of continuously recorded data while the data resides in the circular buffer. Fiore does not disclose ***selectively write-protecting*** those individual events time-stamped ***within*** a circular buffer. Fiore discloses a circular buffer operating such that “the oldest signal data . . . is being overwritten by the most recent signal data.” (Ex. 1009 at ¶¶ 0047; 0063.) To preserve data, Fiore teaches that individual event data may be transferred to a different memory location. Specifically, Fiore discloses that:

The extracted data frames are then stored in file system 17 thereby providing a permanent record of the data frames before, during, and after the event prior to the data frames being overwritten in the circular storage buffer 15 by more recent data frames.

(*Id.* at ¶ 0048.) Nowhere does Fiore suggest selectively write-protecting within a circular buffer. Thus, a POSITA would not look to Fiore for guidance on a system to write-protect designated portions within a memory loop.

Yerazunis discloses different data decimation algorithms to save semiconductor buffer space. (See, Ex. 1017 at 11:44-13:2, Figures 6-8.) These algorithms limit the amount of frame data preserved. And, as noted above, Yerazunis automatically stops video capture after a predetermined number of frames

in response to an event signal. (*See, e.g.*, Ex. 1017 at 2:53-55.) These space-saving technique of Yerazunis are anathema to the teachings of Fiore, which seeks to avoid dropping frames so as not to face “the loss of potentially very critical data.” (Ex. 1009 at ¶¶ 0012-13.)

Fiore does not disclose *selectively write-protecting* those individual segments of time-stamped event data within a circular buffer. Nor does Fiore disclose creating or storing *individual event files* within a circular buffer. In fact, the idea of storing individual event files within temporary storage is expressly discouraged in Fiore’s background section. (Ex. 1009 at ¶ 0010 (“Having to retrieve one or more of the plurality of files that are stored in the intermediate storage location, and/or to compile a plurality of files is cumbersome and time consuming.”).) Instead, Fiore discloses “a circular storage buffer having a memory mapped file.” (*Id.* at ¶ 0020.) Fiore consistently refers to the memory mapped file as a single file. Fiore further discloses that the “single” memory mapped file is preferably “contiguous” on the disk. (*Id.* at ¶ 0071.). This singular memory mapped file should not be confused with Fiore’s disclosure of a plurality of “additional secondary memory mapped files,” into which “an event processor . . . *copies* a plurality of data frames stored in the circular storage buffer that have time stamps proximate to the time of the event” for storage in an “event database”. (*Id.* at ¶ 0022.) Notably, the information stored in Fiore’s “event database” is identified as “files”, while the information stored in Fiore’s buffer is identified as “frames” or “data”.

Petitioner appears to conflate Fiore’s use of event time-stamps *to create event files* (called “secondary memory mapped files”) that are stored in an “event database,” with an idea that is nowhere disclosed in Fiore, of indexing “***files within the memory-mapped file.***” (Pet. at 18, 31-32; Ex. 1003 at ¶¶ 171, 350.) Again, the latter is nowhere disclosed in Fiore.

Finally, a POSITA would not have been motivated to combine Yerazunis with Fiore to arrive at a system that creates and stores individual event files on a circular buffer because Fiore seeks to avoid such “multi-tasking” demands on a processor controlling memory access, which contributes to the problem of dropped frames. (*Id.* at ¶ 0013.)

C. The Petition Fails to Establish that the Claims of the ’540 Patent Would Have Been Obvious Over Ely Alone or as Combined with Fiore, as Asserted in ITS Grounds 2a Through 2d

Like with its Ground 1 assertions, Petitioner’s Ground 2 theories—Ely alone or in combination with Fiore—fail to address at least three key requirements of the independent claims of the ’540 patent. First, Ely (alone or combination with Fiore) fails to teach “treating [a] memory loop as a single file,” especially a file of write-protected data. (Ex. 1018, 8:27.) Second, Ely (alone or in combination with Fiore) fails to teach “protecting the multiple portions, within the single file, from being overwritten by subsequent recording in the memory loop.” (Ex. 1018, 8:28-30.) Third, Ely (alone or in combination with Fiore) fails to teach “allowing the editing of the imaged data in protected multiple portions stored in the memory loop within

the single file via a recorder control while recording additional segments of the image data in the memory loop within the single file.” (Ex. 1018, 8:31-35.) Thus, Petitioner’s Ground 2 combinations fails to establish a substantial question of patentability as to any claim of the ’540 patent.

**1. No Prior Art Disclosure of the Claim Requirements
Regarding “File” Storage in the Buffer**

As noted above, claim 1 of the ’540 patent requires: (i) “treating the memory loop as a single *file*,” and (ii) “protecting the multiple portions, within the single *file*, from being overwritten by subsequent recording in the memory loop.” (Ex. 1018 at 8:27-35.) While not expressly referring to its proposed construction of file, the Petitioner appears to analyze the prior art in view of its overly generalized construction of “*file*” as “*an identifiable collection of data.*” (Pet. at 10.) As explained above, this oversimplification of the term is not consistent with the intrinsic record or the plain and ordinary meaning of “*file*”.

Regardless, Ely fails to teach “treating the memory loop as a single file.” In fact, Ely makes no mention of “file” at all, let alone as part of a memory loop (or circular buffer) or even as an output format. Rather, file-based storage of data on a memory loop/buffer would be incompatible with Ely’s final goal of storing the data in an analog format as a sequence of frames, because Ely is directed to a “distributed video data storage in video surveillance system” in which the ultimate storage destination is videotape. (Ex. 1020, Abstract, 3:29-36, 4:31-35.) Storage of video

data onto videotape means storage in analog format. This is inconsistent with storage of digital data in computer memory as a “*file*,” as that term is used in the context of ’540 patent per the discussion above. Rather than treating the memory loop as a “file,” Ely contemplates use of serial data transmissions, explaining that data will be “read out” from a storage device buffer for transmission to a central station over “a common data transmission channel[.]” (Ex. 1020 at 3:37-41.)

Petitioner offers the unsupported, conclusory assertions of its expert for why on what a POSITA would understand “that using a single file format had been found to be well-suited for implementing a ring buffer and for storing video data.” (Pet. at 60 (citing Ex. 1051, ¶ 235.)) As noted above, the law does not allow conclusory statements like this to suffice for obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). In any event, Petitioner mainly relies on Fiore for the “*file*” concept. For the reasons give above, Ely is incompatible with Fiore for the concept of file storage. Ely’s goal is to store event data in analog format on video tape. This, and for the additional reasons detailed below, a POSITA would not have been motivated to combine Ely with Fiore.

In addition, claim 3 of the ’540 patent recites: “storing first and second ones of the multiple portions as separate files.” To allege that this concept exists in the prior art, Petitioner offers the same arguments rebutted above. (See Pet. at 36, 66-67.) Again, Ely makes no mention of “file”. And Ely certainly makes no mention of storing a separate file for one of multiple portions in a memory loop. Nor does

Fiore disclose this concept of storing a data file (corresponding to single portion of recorded image data) within a memory loop. Instead, Fiore teaches saving secondary, discrete files in a separate database: “additional secondary memory mapped files . . . [into which] an event processor . . . ***copies*** a plurality of data frames stored in the circular storage buffer that have time stamps proximate to the time of the event . . . [for storage in an] event database.” (Ex. 1009 at ¶ 0022.)

Thus, the Petition fails to establish that the claimed “file” concepts exist in Yerazunis alone, or in combination with Fiore.

2. Ely Does Not Disclose “Protecting the Multiple Portions, within the Single File, from Being Overwritten by Subsequent Recording in the Memory Loop”

As noted above, claim 1 of the ’540 patent requires “protecting the multiple portions, within the single file, from being overwritten by subsequent recording in the memory loop; . . .” (Ex. 1018, 8:28–30.) Ely fails to teach this write-protecting of “portions” of its buffer memory. Instead, Ely discloses continuously recording in a circular buffer by overwriting the next oldest frames, but “***inhibiting***” the overwriting of previously recorded data in response to an event signal. (Ex. 1020 at 2:65-3:16, 4:1-8; *see also, id.* at 7:30-36, 11:67-12:19, 14:24-38.) This protection mechanism applies to the entire circular buffer, not portions. The concept of ***inhibiting*** overwriting is repeated throughout Ely. (*Id.* at 3:9-21, 4:6-7; 4:24-30; 7:34-38; 12:13-18; 14:32-38.) Inhibiting overwriting in response to an alarm signal was also repeatedly asserted as a basis for distinguishing over prior art during the

examination that resulted in the allowance of Ely’s claims. (Ex. 2014 at 82-84, 92-93, 99-100, 108-109.) In response to an alarm signal, Ely’s ring buffer stops overwriting its oldest data (as a circular buffer would otherwise be configured to do), but instead looks to store new (i.e. “live compressed video”) data into a *different* “portion of the memory” in order to preserve previously captured data. (Ex. 1020 at 7:28-38.)

As with Yerazunis, the Ely approach to data preservation by “*inhibiting*” the overwriting of the oldest data in response to an alarm signal is at odds with the claimed requirements of “protecting the multiple portions, within the single file, from being overwritten by subsequent recording in the memory loop [.]”

The Petition does not identify a specific disclosure in Ely for the concept of only write-protecting “*portions*” of image data within Ely’s ring buffer. (See Pet. at 61-63.) Instead, the Petition relies primarily on Fiore for this concept. (Id. at 63.) As explained above, Fiore does not disclose the concept of write-protecting portions of data while in a buffer.

And as explained above and below, Fiore also fails to disclose the concept of write-protecting portions of data within its circular buffer. Rather, to preserve data, Fiore teaches that individual event data may be transferred to a different memory location:

The extracted data frames are then stored in file system 17 thereby providing a permanent record of the data frames before, during, and

after the event prior to the data frames being overwritten in the circular storage buffer 15 by more recent data frames.

(Ex. 1009 at ¶ 0048.) Nowhere does Fiore suggest write-protecting portions of data within a memory loop or circular buffer, so, a POSITA could not look to Fiore for guidance on a system to institute the claimed write-protections within a memory loop or circular buffer.

Thus, the Petition fails to establish that the claimed “*protecting the multiple portions . . . in the memory loop*” concept exists in Yerazunis alone, or in combination with Fiore.

3. Ely Does Not Disclose “Allowing the Editing of the Imaged Data in Protected Multiple Portions Stored in the Memory Loop within the Single File via a Recorder Control While Recording Additional Segments of the Image Data in the Memory Loop within the Single File”

As noted above, claim 1 of the ’540 patent requires “allowing the editing of the imaged data in protected multiple portions stored in the memory loop within the single file via a recorder control while recording additional segments of the image data in the memory loop within the single file.” (Ex. 1018, 8:31-35.) Ely fails to disclose this editing element of claim 1 (from which all subsequent claims depend, either directly or indirectly). Petitioner attempts to rely on a disclosure in Ely regarding a “clear” command. (Pet. at 64 (citing EX1020, 8:7-12.)) Petitioner makes no attempt to suggest that this clear command is performed on data stored within a “single file”. In fact, as explained above, Ely fails to disclose the concept of saving a data file in a buffer and is incompatible with Fiore for this concept

because, as explained above, Ely preserves video data by storing it in analog format on video tape via a VCR. (EX1020, 10:43-45.) And, as noted above, Fiore does not save files within its circular buffer. Not only does this editing element require that the edited data be stored within a single file, but it further requires that this editing occur while recording continues within this single file in a memory loop (or circular buffer). Petitioner makes no attempt to show such a disclosure in either Ely or Fiore.

Thus, the Petition fails to establish that the claimed “editing” concept exists in Ely alone, or in combination with Fiore.

4. Petitioner Has Failed to Meet Its Burden of Showing That a POSITA Would Have Been Motivated to Combine Ely with Fiore

Petitioner wrongly states that a POSITA would have been motivated to combine Ely and Fiore to arrive at the inventions of the claims. (Pet. at 53-55.)

The Petition asserts that Ely and Fiore “describe similar technologies and solve similar problems”. (Pet at 53.) Petitioner is wrong. Ely begins its “Objects and Summary of the Invention” section by noting: “[i]t is accordingly an object of the invention to provide a video surveillance system having an improved capability for storage of video signals.” (Ex. 1020 at 2:34-36.) Ely continues:

By providing a video surveillance system that includes camera units having digital storage for signals generated in the respective camera unit, video signals corresponding to conditions before, during and after an alarm event can be conveniently and reliably stored, and the locally stored video can be read out and transmitted to an operator attended

station at a convenient time for viewing and ***permanent recording on video tape***.

(*Id.* at 4:63-5:3.) This goal in Ely of “permanent recording” by “***video tape***” is incompatible with Fiore, which states:

Event recording and playback devices used to monitor and record events typically fall into one of two types. VCR and tape recording type devices permit the recording of a video and/or other signal and allows later playback of these signals. Other recording and playback devices utilize a circular storage buffer during recording in which recent data over-writes the older data.

(Ex. 1009 at ¶ 0005.) Fiore is directed to the latter type, not the “tape recording type” system described in Ely. While Ely describes a “ring buffer” for “storing digital video data,” video frame event data stored from Ely’s buffers will ultimately be converted back to analog video for storage onto a video tape. (*See, e.g.*, Ex. 1009 at 10:43-45.) This goal of analog storage would be thwarted if the serial data in the buffer were packaged into, and transmitted as, a digital data file. A digital data “***file***” is not stored on video tape.

As noted above, Fiore would not be a source to which a POSITA would look when searching for a solution to selectively write-protect segments of continuously recorded data while the data resides in the circular buffer. Fiore does not disclose ***selectively write-protecting*** segments of time-stamped event data within a circular buffer. Fiore discloses a circular buffer operating such that “the oldest signal data . . . is being overwritten by the most recent signal data.” (Ex. 1009 at ¶¶ 0047; 0063.) To preserve data, Fiore (like Ely) teaches that individual event data may be

transferred to a different memory location. Specifically, Fiore resolves data preservation in view of the circular buffer's overwrite operations as follows:

[t]he extracted data frames are then stored in file system 17 thereby providing a permanent record of the data frames before, during, and after the event prior to the data frames being overwritten in the circular storage buffer 15 by more recent data frames.

(Ex. 1009 at ¶ 0048.) Nowhere does Fiore suggest selectively write-protecting segments of data within a circular buffer. Thus, a POSITA would not look to Fiore as guidance on a system to selectively write-protect data segments on a circular buffer.

Further, as noted above, Fiore does not disclose creating or storing ***individual event files*** within a circular buffer. The idea of storing individual event files within temporary storage is expressly discouraged in Fiore's background section:

Having to retrieve one or more of the plurality of files that are stored in the intermediate storage location, and/or to compile a plurality of files is cumbersome and time consuming.

(Ex. 1009 at ¶ 0010.) Instead, Fiore discloses “a circular storage buffer having a memory mapped file.” (*Id.* at ¶ 0020.) Fiore consistently refers to the memory mapped file as a single file, in contrast to Fiore's disclosure of a plurality of “additional secondary memory mapped files,” into which “an event processor . . . ***copies*** a plurality of data frames stored in the circular storage buffer that have time stamps proximate to the time of the event” for storage in an “event database”. (*Id.* at ¶ 0022.) Thus, Fiore identifies information stored in the buffer as “frames” or

“data”, while identifying information separately stored in the “event database” as “files”.

As noted above, Petitioner appears to conflate Fiore’s use of event time-stamps to create event files (called “secondary memory mapped files”) that are stored in an “event database,” with an idea that is nowhere disclosed in Fiore, of indexing “*files within the memory-mapped file.*” (Pet. at 54; EX1051, ¶¶223-225.) Again, the latter is nowhere disclosed in Fiore.

Finally, a POSITA would not have been motivated to combine Ely with Fiore to arrive at a system that creates and stores individual event files on a circular buffer because Fiore seeks to avoid such “multi-tasking” demands on a processor controlling memory access, which contributes to the problem of dropped frames. (Ex. 1009 at ¶ 0013.)

VI. CONCLUSION

In conclusion, the facts here warrant the Board exercising discretion to deny institution under 35 U.S.C. § 314(a). In addition, given the fatal flaws in each ground (as articulated above), as well as the ever-advancing stage of the district court case, the Board should deny institution, whether on the merits or through exercising its discretion under § 314(a).

Dated: December 20, 2024

Respectfully submitted,

/James M. Lennon/

James M. Lennon (Reg. No. 56,815)

DEVLIN LAW FIRM LLC

1526 Gilpin Avenue

Wilmington, DE 19806

Tel: (302) 449-9010

jlennon@devlinlawfirm.com

Attorney for Patent Owner

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that there are 11,832 words in this paper, excluding any table of contents, table of authorities, mandatory notices under 37 C.F.R. § 42.8, certificate of word count, certificate of service, or appendix of exhibits. This certification relies on the word count of the word-processing system used to prepare this paper.

Dated: December 20, 2024

/James M. Lennon/
James M. Lennon
Reg. No. 56,815
1526 Gilpin Avenue
Wilmington, DE 19806
Tel: (302) 449-9010
jlennon@devlinlawfirm.com

Attorney for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on December 20, 2024, the foregoing document is being served via electronic mail upon the following counsel of record for Petitioner:

LEAD COUNSEL	BACKUP COUNSEL
Joshua R. Nightingale (Reg. No. 67,865) JONES DAY 500 Grant Street, Suite 4500 Pittsburgh, PA 15219 (412) 394-7950 jrnightingale@jonesday.com	Hilda C. Galvan (Reg. No. 39,680) JONES DAY 2727 North Harwood Street, Suite 500 Dallas, TX 75201 (214) 969-4556 hcgalvan@jonesday.com John A. Marlott (Reg. No. 37,031) JONES DAY 110 North Wacker Drive, Suite 4800 Chicago, IL 60606 (312) 269-4236 jamarlott@jonesday.com

/James M. Lennon/
James M. Lennon