

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ADOBE INC.,
Petitioner

v.

JONATHAN E. JAFFE,
Patent Owner

Inter Partes Review No. IPR2024-01352
U.S. Patent No. 6,757,828

PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW

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Patent Owner's Exhibit List

Exhibit No.	Description
2001	IEEE, “Official IEEE 802.11 Working Group Project Timelines” (Nov. 21, 2024)
2002	Claim Construction Scheduling Order issued in in <i>Jaffe v. Adobe Inc.</i> , Case No. 2:23-cv-06224-JWH(MAAX) (C.D. Cal.)
2003	Docket Navigator, “How Top US Patent Courts Compare on Median Time-to-Trial Statistics” (June 27, 2022)
2004	Plaintiff’s Original Complaint filed in <i>Jaffe v. Adobe Inc.</i> , Case No. 2:23-cv-06224-JWH(MAAX) (C.D. Cal.)

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.71(d) and § 42.75(c), Patent Owner respectfully requests Director Review of the Board’s decision granting institution of *inter partes* review (Paper 8) for at least two reasons.

First, the Board’s claim construction of the claim term “a sensor, which is tightly coupled to said memory” specifically requires coupling “via ***conductive traces or leads***.” However, the Petition fails to provide any evidence or argument showing specifically that the references, and in particular, the Glass reference discussed in the Board’s Institution Decision, includes any connection between the sensor and memory using conductive traces and leads specifically. Rather, the Glass reference only states that a “data path” exists between the two components. But merely identifying that a data path exists between components only discloses an *operational* connection between the two components such that one can receive data from the other; it does not establish nor require a *physical* connection between the two components, let alone that a physical connection be “via conductive traces or leads” as recited in the Board’s claim construction. The only evidence presented is conclusory expert testimony from Petitioner that the Glass reference teaches this requirement, but such conclusory testimony is legally afforded little if any weight. The Board’s Institution Decision, finding that the Glass reference teaches this limitation as construed by the Board, is thus not supported by any sufficient evidence.

Second, the Board’s Decision fails to properly weigh the six factors provided in the Board’s precedential decision in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (“*Fintiv*”). Until recently, the PTAB operated under a prior memorandum stating that the PTAB would not “discretionarily deny institution in view of parallel district court litigation where a petitioner presents a [Sotera] stipulation....” *See Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* (USPTO June 21, 2022). However, on February 28, 2025 the USPTO rescinded this memo and directed parties to prior precedent. “USPTO Rescinds Memorandum Addressing Discretionary Denial Procedures” (Feb. 28, 2025) (available at <https://www.uspto.gov/about-us/news-updates/uspto-rescinds-memorandum-addressing-discretionary-denial-procedures>). This prior precedent includes the six factors specified in *Fintiv*. *Fintiv* at 8.

Rescinding the 2022 memorandum signals an important policy emphasis from the Office, including the new administration, which clearly signals that the Office intends to take a more deferential perspective regarding issued patents. In particular, *Fintiv* itself recognizes that the Board’s cases “balance considerations such as system efficiency, fairness, and patent quality.” *Fintiv* at 5. Here, proper consideration and weighting of the *Fintiv* factors in this proceeding illustrates that this proceeding is neither effective nor efficient in light of the anticipated trial date in the parallel

District Court litigation in approximately December 2025, before a Final Written Decision would issue in this proceeding.

II. ARGUMENT

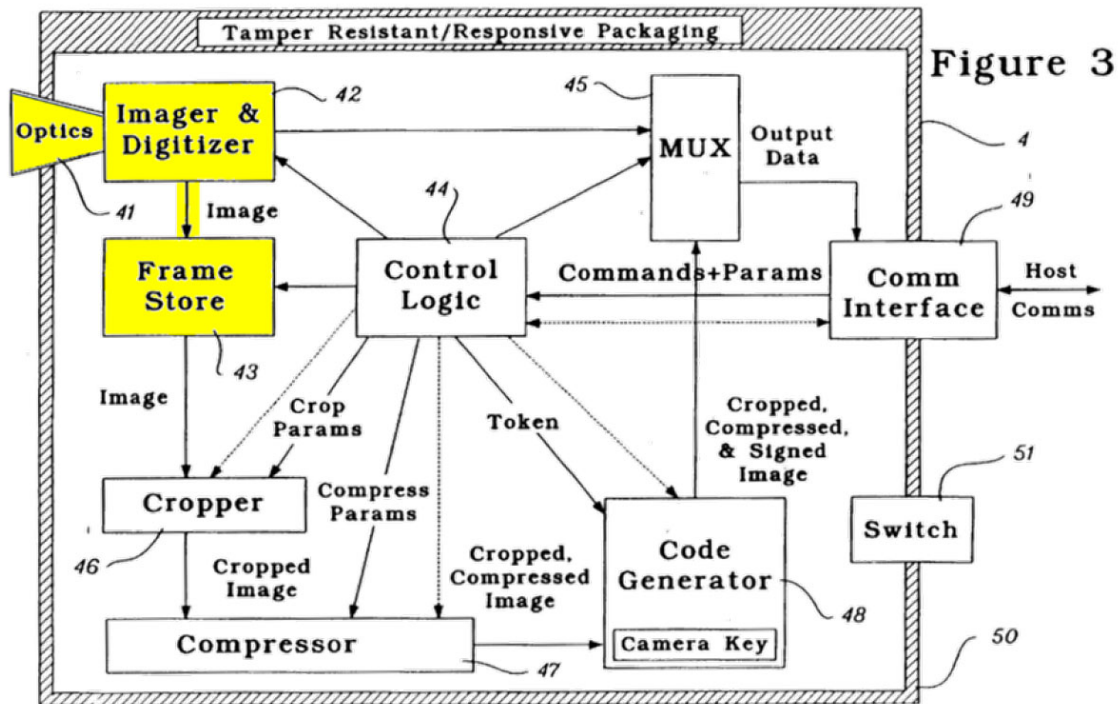
A. The Board’s Institution Decision Is Erroneous Because There Is No Non-Conclusory Evidence Showing That the Glass Reference Provides “a Sensor Coupled to said Memory via Conductive Traces or Leads”

Claim 1 of the ’828 Patent recites “a sensor, which is tightly coupled to said memory.” Ex. 1001 (’828 Patent), cl. 1. The Petitioner proposed that this limitation should be construed to mean “a sensor coupled to said memory via *conductive traces or leads*.” Pet. 10 (emphasis added). The Board, in its Institution Decision, adopted the Petitioner’s proposed construction. Paper 8 at 17-18. The only references relied upon in the Petition in support of this element were the Glass and Rieger references. Paper 1 at 26-28, 44-46. As such, it was necessary for the Petitioner to establish that the Glass reference teaches a connection by conductive leads or traces in order to meet the requirement of showing a reasonable likelihood of prevailing on the Petition.

However, the Petition fails to present non-conclusory evidence in support of the contention that the sensor is connected to memory specifically by conductive leads or traces in the prior art references. The only reference substantively discussed by the Board in the Institution Decision is the Glass reference. Paper 8 at 26-28. In support of this element, the Petition first states that the sensor and memory are

“electrically connected together within the imaging system.” Paper 1 at 26. However, the Petition does not assert, nor does it provide any evidence purporting to show that the connection between the identified components in Glass is by conductive leads or traces specifically as Petitioner’s (and the Board’s) claim construction requires. Rather, the Petition merely asserts conclusorily that the sensor and memory are coupled by “conductive leads or traces.” *Id.* at 26-27. Importantly, the Petitioner cites no specific language or teaching from Glass purporting to show that the sensor and the memory are coupled by conductive leads and traces. *Id.* Instead, the Petition conclusorily cites to the declaration of its expert. *Id.*

Petitioner’s expert similarly fails to specifically identify anything in Glass showing that the sensor and the memory are coupled by conductive leads and traces, specifically. Ex. 1003 at ¶171. Instead, Petitioner’s expert relies upon Figure 3 of Glass which includes an arrow connecting the “Imager & Digitizer” to the “Frame Store” in Glass. *Id.* However, Petitioner’s own expert concedes that this merely teaches the capability of transmitting information between these two elements, stating that there is a “data path from the sensor to memory.” *Id.* But, the mere existence of a data path is not sufficient to show the specific physical requirements of providing a connection by “conductive leads or traces” as the claim construction requires.



Glass, Fig. 3 (highlighted, from Paper 1 (Petition) at 26)

The Board’s Institution Decision relies upon a citation to Petitioner’s expert declaration to find that the Petition teaches a connection by “conductive leads or traces” under the claim construction, with the expert’s declaration citing a statement in Glass that the Figure illustrates “data paths ... in solid lines.” Paper 8 at 27 (citing Ex. 1003 at ¶ 171); Ex. 1005 at 5:46-48. However, a “data path” denotes operational, rather than physical, capabilities and is thus not sufficient to show even an “electrical connection” let alone a connection by conductive leads or traces. Specifically, Patent Owner’s Preliminary Response identified that computers connected to the internet have paths for sharing information with each other despite being separated by very

long distances (i.e., hundreds or even thousands of miles) and are would not have any direct, physical connection, electrical or otherwise. Paper 7 at 14.

Indeed, Patent Owner provided an illustrative example of a data path that would provide the operational capability of providing information without even being electrically connected in the form of a WiFi connection between two devices (let alone connected by conductive leads or traces). Paper 7 at 14-15, fn. 3. To take a still further example, satellite-based internet service providers allow computers to establish data paths that are not even confined to the Earth's atmosphere, much less an electrical connection or a connection by conductive leads or traces. As such, merely identifying that an *operational* data path exists between two components is not sufficient to show that the *physical* connection between the components is by "conductive leads or traces" as the claim construction requires.

The Board's Institution Decision relies upon a conclusory declaration from Petitioner's expert that Glass teaches "conductive leads and traces." *See* Paper 8 at 27 (citing Ex. 1003 ¶ 171). The Board states that Patent Owner did not address this expert testimony. Paper 8 at 28. However, Patent Owner's Preliminary Response specifically addressed this very portion of Petitioner's expert declaration, and the conclusory assertions contained therein. Paper 7 at 13-16. But the conclusory nature of Petitioner's expert declaration (let alone instituting trial relying upon that conclusory declaration), leaves Patent Owner guessing in the trial of this IPR. Where

specifically does the reference teach conductive leads or traces? Why does the portion of the reference teach that particular physical connection? Is the connection by conductive leads, by traces, or both? Does the reference teach connection via conductive leads or traces specifically, or is the teaching supposedly inherent? Neither the Petition nor Petitioner's expert declaration provide any meaningful answers. Indeed, "[e]xpert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight." 37 C.F.R. § 42.65(a); *cxLoyalty, Inc. v. Maritz Holdings Inc.*, 986 F.3d 1367, 1378 (Fed. Cir. 2021) ("[w]e do not accord weight to conclusory expert testimony").

The Board's Institution Decision, finding that the Glass reference teaches this limitation as construed by the Board, is erroneous because it is not supported by legally cognizable evidence and because it ignores Patent Owner's showing that an *operational* connection in the cited references fails to disclose the *physical* requirements of a connection "via conductive leads or traces" recited in the Petitioner's and in the Board's claim construction.

B. Proper Application of the *Fintiv* Factors Heavily Favor Reviewing and Denying Institution on Discretionary Grounds

Director Review is necessary to vacate the Institution Decision because the Board failed to perform a proper *Fintiv* analysis. Under a proper analysis, the six *Fintiv* factors favor denying institution on discretionary grounds.

1. No Stay in the Parallel District Court Litigation Heavily Favors Denying Institution

In the parallel litigation between Petitioner and Patent Owner (*Jaffe v. Adobe Inc.*, Case No. 2:23-cv-06224-JWH(MAAx) (C.D. Cal., filed Aug. 1, 2023)) (“the District Court Litigation”)) the district court has not stayed the parallel litigation. The Institution Decision indeed identifies that the parties agreed that no motion for a stay of the District Court Litigation has been filed. Paper 8 at 10. There is no reason to believe that a contested motion to stay would be granted, nor has Petitioner identified any reason that a stay would be granted. Indeed, the District Court Litigation has already been pending for over 19 months. Ex. 2004 at 1, 14. Despite the strong evidence showing that a contested stay motion would be unlikely and has not even been requested, the Board nevertheless stated that it would “not attempt to predict how the District Court will proceed.” Paper 8 at 10. The Board found that this factor was neutral. *Id.* The Board’s finding that this factor is neutral is contrary to the evidence presented by Petitioner, and is clearly erroneous. Proper weighting of the evidence presented would heavily favor denying institution.

2. Proximity of the District Court’s Trial Date Favors Denying Institution

The anticipated proximity of the District Court Litigation’s trial date to the Board’s statutory deadline for a Final Written Decision favors discretionary denial. The Board’s Institution Decision recites that the median time-to-trial in the District

Court is 27.7 months, and that anticipated timeline would set trial near the end of 2025, in approximately December 2025. Paper 8 at 10. In the present proceeding, however, the statutory deadline for a Final Written Decision of this Petition would not pass until several months later, on March 7, 2026. Because trial in the District Court Litigation should occur before the statutory deadline, Factor 2 should weigh strongly in favor of denying institution. The Board's Institution Decision states that the anticipated trial date is optimistic because deadlines for fact and expert discovery have not yet been scheduled in the District Court Litigation. *Id.* However, this ignores that the anticipated decision in this proceeding is nearly one year away, and the District Court has set no deadlines that would preclude trial at or near the anticipated trial date. Likewise, the Board's observation that the District Court previously moved the claim construction hearing date three weeks from July 16, 2024 to August 6, 2024 ignores that the claim construction hearing occurred over six months ago, and that the anticipated trial date would occur months before the statutory deadline in this proceeding. The Board failed to properly weigh this factor in its Institution Decision, and Factor 2 weighs in favor of denying institution.

3. Significant Investment in the Parallel Proceeding Favors Denying Institution

The parties' significant investment in the District Court Litigation weighs in favor of discretionary denial. More specifically, in the District Court Litigation, preliminary infringement contentions have been exchanged, the parties have also

exchanged terms for claim construction, preliminary constructions, and exchanged extrinsic evidence and briefing, the District Court has held its claim construction hearing, and has issued a Tentative Claim Construction Order. Ex. 2002, Ex. 1020. In *Fintiv*, the Board recognized that the “investment factor is related to the trial date factor, in that more work completed by the parties and court in the parallel proceeding tends to support the arguments that the parallel proceeding is more advanced, a stay may be less likely, and instituting would lead to duplicative costs.” *Fintiv* at 10.

The Board erred in evaluating this factor by stating, “the relatively limited investment in the parallel proceeding to date ... weighs only marginally, if at all, in favor of exercising discretion to deny institution.” Paper 8 at 11. However, this analysis from the Board is both cursory and fails to recognize the substantial work that has *already* been done in the District Court Litigation described above. The Board failed to properly weigh this factor in its Institution Decision and Factor 3 weighs at least substantially or heavily in favor of denying institution.

4. Significant Overlap Between Issues Raised in the Petition and in the Parallel Litigation Is at Minimum Neutral, If Not Favors, Denying Institution

Petitioner made a *Sotera* stipulation indicating that, if review was instituted, the Petitioner would not pursue grounds raised or that could have been raised in this proceeding in the . Paper 1 at 73. Filing a *Sotera* stipulation is not dispositive of whether the Board should deny institution under *Fintiv*. Such a stipulation is one

non-dispositive factor in connection with all other circumstances of the case. *See e.g., Cisco Systems, Inc. v. Estech Systems, Inc.*, IPR2021-00333, Paper No. 12 at 12-13 (PTAB. July 7, 2021) (denying institution under *Fintiv* where *Sotera* stipulations had been filed because the stipulations were not “sufficient when weighed against the other factors”). Here, the Board relies upon Petitioner’s stipulation entirely in reaching its conclusion that this factor weighs strongly against exercising discretion to deny institution. Paper 8 at 11-12. The Board failed to properly weigh this factor in its Institution Decision. In combination with the other factors, Factor 4 weighs in favor of denying institution or is, at minimum, neutral.

5. The Parallel District Court Litigation and the Petition Involve the Same Parties

In *Fintiv*, the Board stated that “[e]ven when a petitioner is unrelated to a defendant... [a]n unrelated petitioner should, therefore, address any other district court or Federal Circuit proceedings involving the challenged patent to discuss why addressing the same or substantially the same issues would not be duplicative.” *Fintiv* at 14. Here, however, there is no dispute that Petitioner and the defendant in the District Court Litigation are the *same party*, which weighs even more strongly in favor of denial. The Board concluded that “either neutral or weighs slightly in favor of denying institution” despite the identity of parties in the two proceedings. Paper 8 at 13. The Board failed to properly weigh this factor in its Institution Decision, and Factor 5 weighs strongly in favor of denying institution.

6. Other Considerations Favor Denying Institution

As set forth above, the Board’s claim construction of the claim term “a sensor, which is tightly coupled to said memory” specifically requires coupling “via *conductive traces or leads*.” However, as explained above, the Petition fails to provide any evidence or argument showing specifically that the Glass reference relied upon by the Board includes a connection between the sensor and memory using “conductive traces and leads” as the construction requires. *Supra* at 3-7. Because the only evidence presented by Petitioner is conclusory expert testimony, entitled to little if any weight, the Board’s Institution Decision finding that the Glass reference teaches this limitation is not supported by any legally cognizable or sufficient evidence. The Board therefore failed to properly weigh this factor in its Institution Decision. Factor 6 weighs strongly in favor of denying institution.

7. Holistic Assessment of the *Fintiv* Factors Favors Denying Institution

The Board determines that, weighing “holistically” the above factors, that the “the factors favoring discretionary denial do not outweigh the strength of the reasons not to discretionarily deny institution.” Paper 8 at 14. However, the Board does not identify any specific facts, nor does the Board identify any reasoning for weighing any one factor over another. As shown above, the Board failed to properly weigh each of the six factor in its Institution Decision. As such, any “holistic” assessment would therefore weigh in favor of denying institution.

III. CONCLUSION

For the above reasons, Patent Owner respectfully requests that the Director grant review of the Board's institution decision and deny institution of Petitioner's request for *inter partes* review.

Dated: March 21, 2025

Respectfully submitted,

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Certificate of Service 37 C.F.R. § 42.6(e)

The undersigned certifies that on March 21, 2025, I will cause true and correct copies of the foregoing Patent Owner's Request for Director Review, and all associated exhibits or appendices referred to therein, to be served electronically upon the following attorneys who have consented to service via email. Paper No. 1 (Petition) at 2-3.

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