

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ADOBE INC.
Petitioner

v.

JONATHAN E. JAFFE
Patent Owner

Case IPR2024-01352
Patent No. 6,757,828

AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST

The Director authorized Petitioner, Adobe Inc., to submit this response to address the Request for Director Review (“Request”) by Patent Owner.

In the Institution Decision, the Board evaluated each of the *Fintiv* factors and concluded they “do not favor the exercise of discretion to deny institution.” Paper 8 at 14. The current facts if anything now weigh even more heavily in favor of institution. There is still ***no scheduled trial date*** in the related district court case. Full fact discovery ***has not begun***. There is no current case schedule, i.e., no deadlines for fact discovery, expert discovery, or dispositive motions. And while Patent Owner asserted in the Request that no ***contested*** motion to stay had been filed, it misleadingly failed to inform the Director that an ***unopposed*** motion to stay had already been filed ***before*** the Request. No *Fintiv* factor weighs in favor of discretionary denial; instead, the factors favor institution as the Board concluded.

Regarding the term “a sensor, which is tightly coupled to said memory,” the Board evaluated the evidence and arguments presented by the parties and found that “Petitioner has shown sufficiently that a POSITA would understand Glass shows imager & digitizer 42 and frame 43, connected by a ‘data path,’ ‘are electrically connected by conductive leads or traces within imaging system 4.’” Paper 8 at 27. The Board also found that Patent Owner “has not provided persuasive competing evidence....” Paper 8 at 28. Patent Owner simply repeats the same unsupported arguments in the Request—simply seeking a second bite at

the apple rather than showing any actual error.

Further, the Board also found a reasonable likelihood that claim 1 is obvious over Rieger. Paper 8 at 35. This is a ***separate and independent basis*** for institution that Patent Owner fails to even acknowledge in the Request.

I. ARGUMENT

A. The Board Appropriately Evaluated the *Fintiv* Factors

The Board properly considered all six *Fintiv* factors and declined to deny review. Paper 8 at 9-14. Patent Owner merely disagrees with the Board's conclusion, which is no ground for Director review. Moreover, a full airing of the facts shows that the Board's decision is now even more well-supported. For instance, regarding the first *Fintiv* factor, Petitioner filed a motion to stay the related litigation pending the outcome of this review ***before*** Patent Owner filed the Request. *See Jaffe v. Adobe*, No. 2:23-cv-06224-JWH, Dkt. 57 (C.D. Cal.). Patent Owner confirmed that ***he will not oppose that motion.***¹ There is no reason to think the related case will not be stayed shortly.

Regarding the second *Fintiv* factor, Patent Owner relies entirely on median time-to-trial statistics and ignores the actual state of the case. ***There is no***

¹ Apparently, Patent Owner sought to side-step this inconvenient fact by asserting in the Request that “a ***contested*** stay motion would be unlikely and has not even been requested.” Paper 10 at 8 (emphasis added). Patent Owner's assertion is literally accurate—though highly misleading—only because an ***uncontested*** motion to stay had been filed.

scheduled trial date in the related litigation. Further, there are no deadlines to complete fact discovery, expert discovery, or summary judgment briefing, and no claim construction order has issued. To date, only two interrogatories addressing claim construction have been served, and the parties ***have not begun*** non-claim-construction fact discovery. Patent Owner’s speculation that trial could be conducted this year is belied by the fact that most of the litigation has yet to occur.

Similarly, regarding the third *Fintiv* factor, there has been virtually no investment in the related litigation, as discussed above, other than claim construction proceedings that are not yet complete.

With regard to the fourth *Fintiv* factor, Patent Owner acknowledges that Petitioner has made a *Sotera* stipulation but argues that the Board should have ignored it. But such stipulations remain “highly relevant.”² And this factor weighs “strongly in favor of not exercising discretion to deny institution....” *Sotera v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19.

B. The Board Weighed the Evidence and Found That the Prior Art Discloses “a Sensor, Which Is Tightly Coupled to Said Memory”

In the Request, Patent Owner repeats the arguments it made to the Board regarding the “tightly coupled” limitation and simply asks to Director to reach the opposite conclusion. This is not an appropriate basis for Director Review.

² See <https://www.uspto.gov/about-us/news-updates/uspto-rescinds-memorandum-addressing-discretionary-denial-procedures>.

The Board accepted Petitioner’s proposed construction—which Patent Owner did not dispute—for “a sensor, which is tightly coupled to said memory” as “a sensor coupled to said memory via conductive traces or leads.” Paper 8 at 18.

The Board then summarized Petitioner’s argument and evidence on this limitation: “Petitioner contends Glass discloses ‘utilizing a sensor, which is tightly coupled to said memory, to generate at least one internal and unique parameter.’” Pet. 26-30 (citing Ex. 1001, 6:60-61; Ex. 1002, 277, 292; Ex. 1003 ¶¶ 168-180; Ex. 1005, 4:6-8, 5:49-6:4, 6:12-13, 6:16-17, Figs. 2, 2A, 3; Ex. 1022, 15-16; Ex. 1023, 11).” Paper 8 at 26. The Board found “[o]f particular relevance” Glass’s Figure 3, which Petitioner annotated to show that “optics 41 and imager & digitizer 42 teach a ‘sensor’ and, further, frame store 43 teaches a ‘memory.’” *Id.* at 26-27. The Board noted that “Petitioner, supported by the Declaration of Dr. Xiong, asserts that the arrow connecting imager & digitizer 42 and frame store 43 is a ‘data path’ and ‘indicates that the components are electrically connected by conductive leads or traces within imagine system 4,’ thereby being ‘tightly coupled.’” *Id.* at 27.

The Board also evaluated the counterarguments by Patent Owner “that Glass does not expressly describe conductive leads or traces” and that Dr. Xiong’s opinion was conclusory—the very same arguments repeated in the Request. Paper 7 at 13-14; Paper 8 at 28. The Board recognized that Patent Owner’s argument “does not address Petitioner’s evidence, in the form of Dr. Xiong’s testimony, that

a POSITA would understand Glass’s imager & digitizer 42 and frame store 43 are connected by conductive leads or traces.” Paper 8 at 28. The Board also found Patent Owner’s argument that “data can be communicated between computer over the Internet via WiFi” to be “of limited moment here where this issue centers on a POSITA’s understanding of Glass’s digital camera and housed components.” *Id.* With no contrary evidence to suggest that a POSITA would understand Figure 3 any other way, the Board credited Dr. Xiong’s opinion.

Having evaluated the arguments and weighed the evidence, the Board concluded that “at this stage in the proceeding, Patent Owner has not provided persuasive competing evidence that discounts Dr. Xiong’s testimony,” and stated that “on this record, we find Petitioner adequately shows Glass teaches this limitation.”³ Paper 8 at 27-28. Patent Owner identifies no “material error” in the Institution Decision and merely seeks to re-run the same arguments the Board rejected, effectively asking the Director to second-guess the Board’s evidentiary findings. The Request should be denied.

II. CONCLUSION

Petitioner respectfully requests that the Director deny the Request because Patent Owner has not shown that the Board committed any error.

³ In addition, the Board instituted review based on Petitioner’s separate and independent grounds based on Rieger. Paper 1 at 41-69; Paper 8 at 35-36, 38. The Request ignores Rieger, providing a further reason the Request should be denied.

Respectfully submitted,

/James L. Day/

James L. Day

Registration No. 72,681

FARELLA BRAUN + MARTEL LLP

One Bush Street, Suite 900

San Francisco, California 94104

jday@fbm.com