

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NIKON CORPORATION, PANASONIC ENTERTAINMENT &
COMMUNICATIONS CO., LTD., OLYMPUS CORPORATION,
OM DIGITAL SOLUTIONS CORPORATION, FUJIFILM
CORPORATION, FUJIFILM NORTH AMERICA CORPORATION,
Petitioner,

v.

OPTIMUM IMAGING TECHNOLOGIES, LLC,
Patent Owner.

IPR2024-01372 (Patent 8,451,339 B2)¹
IPR2024-01373 (Patent 7,612,805 B2)
IPR2024-01374 (Patent 10,877,266 B2)

Before JOHN F. HORVATH, GARTH D. BAER, and RUSSELL E. CASS,
Administrative Patent Judges.

HORVATH, *Administrative Patent Judge.*

ORDER
Granting Patent Owner's Request for Additional Briefing
37 C.F.R. §§ 42.5, 42.20

¹ The combined caption is for administrative convenience only. The parties are not authorized to use this caption without express permission of the Board.

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I. INTRODUCTION AND DISCUSSION

Nikon Corporation, Panasonic Entertainment & Communication Co., Ltd., Olympus Corporation, OM Digital Solutions Corporation, FUJIFILM Corporation, and FUJIFILM North America Corporation, (collectively, “Petitioner”) filed petitions in each of the proceedings identified above, and Optimum Imaging Technologies, LLC (“Patent Owner”) filed preliminary responses. *See, e.g.*, Papers 2 (“Pet.”), 8 (“Prelim. Resp.”).²

In its preliminary responses, Patent Owner argued institution of these proceedings “would not be a good use of the Board’s resources” in light of related district court proceedings involving each of the parties collectively identified above as Petitioner. *See, e.g.*, Prelim. Resp. 2. Nonetheless, Patent Owner acknowledged that Petitioner had filed a *Sotera*³ stipulation in each proceeding and that “[b]ased on current law/policy . . . a *Sotera*-style stipulation precludes discretionary denial under *Fintiv*^[4].” *Id.* at 2 n.3 (citing *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* (June 21, 2022) (“Fintiv Memo”)). Patent Owner, however, also stated that “[i]f there is an intervening change in law/policy, Patent Owner will seek authorization for supplemental briefing to address the *Fintiv* factors in detail.” *Id.*

On February 28, 2025, the Office rescinded the Fintiv Memo. The same day, Patent Owner emailed the Board in each proceeding, requesting

² We reference the papers filed in IPR2024-01372, but similar papers were filed in IPR2024-01373 and IPR2024-01374.

³ *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18–19 (PTAB, Dec. 1, 2020) (precedential)

⁴ *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB, Mar. 20, 2020) (precedential)

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“authorization for supplemental briefing to address discretionary denial in view of parallel district court litigation.” Ex. 3001, 2. On March 3, 2025, Petitioner “oppose[d] the requested briefing as wasteful in view of [Petitioner’s] *Sotera* stipulations,” but requested authorization to file a sur-reply in each proceeding should the Board grant Patent Owner’s request. *Id.* at 1.

We note that, absent the safe harbor provided in the *Fintiv* memo, Petitioner’s *Sotera* stipulations are one among several *Fintiv* factors to consider when determining whether discretionary denial of these proceedings is warranted. *Sotera*, Paper 12 at 11–21. Accordingly, in view of the Office’s rescindment of the *Fintiv* Memo, we grant Patent Owner’s requests to file supplemental discretionary denial briefing. Patent Owner’s briefing, in each proceeding, shall not exceed 10 pages and is due no later than March 19, 2025. We, likewise, authorize Petitioner to file briefing responsive to Patent Owner’s supplemental briefing, not to exceed 10 pages, and due no later than April 2, 2025. No further briefing is authorized at this time.

II. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner’s requests for authorization to file supplemental briefing on the issue of discretionary denial in each of IPR2024-01372, IPR2024-01373, and IPR2024-01374 is *granted*;

FURTHER ORDERED that, in each proceeding, Patent Owner’s supplemental briefing shall not exceed 10 pages and is due no later than March 19, 2025;

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FURTHER ORDERED that Petitioner is authorized to file responsive briefing on the issue of discretionary denial in each proceeding; and

FURTHER ORDERED that, in each proceeding, Petitioner's supplemental briefing shall not exceed 10 pages and is due no later than April 2, 2025.

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