UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners

v.

OPTIMUM IMAGING TECHNOLOGIES LLC,

Patent Owner

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Case IPR2024-01373

Patent No. 7,612,805

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# PATENT OWNER'S SUPPLEMENTAL BRIEF

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**TABLE OF CONTENTS**

I. INTRODUCTION....1
II. BACKGROUND....1
III. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION IN VIEW OF PARALLEL DISTRICT COURT LITIGATIONS....2
A. GOOD CAUSE EXISTS FOR ADMITTING EXS. 2006-2012....2
B. THE *FINTIV* FACTORS FAVOR DENIAL....3
1. Factor 1 favors denial....3
2. Factor 2 favors denial....4
3. Factor 3 favors denial....5
4. Factor 4 favors denial or is neutral....7
5. Factor 5 favors denial....9
6. Factor 6 favors denial....9
7. On balance, the factors favor denial....10
IV. CONCLUSION....10

| **PATENT OWNER'S LIST OF EXHIBITS** | |
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| EX. 2001 | RESERVED |
| EX. 2002 | Institution Decision, IPR2020-01321, Paper 10 (PTAB Mar. 1, 2021) |
| EX. 2003 | Patent Owner Preliminary Response, IPR2024-00924, Paper 8 (PTAB Sep. 20, 2024) |
| EX. 2004 | Scheduling Order, *Optimum Imaging Technologies LLC v. Nikon Corp.*, No. 4:23-cv-00923, Dkt. 37 (E.D. Tex. Oct. 2, 2024) |
| EX. 2005 | RESERVED |
| EX. 2006 | Order, *Panasonic Entertainment & Communication Co., Ltd. v. Optimum Imaging Technologies LLC,* No. 3:24-cv-02466, Dkt. 47 (N.D. Cal. Sep. 23, 2024) |
| EX. 2007 | Docket Report, *Optimum Imaging Technologies LLC v. Panasonic Corp. et al.,* No. 4:23-cv-00926 (E.D. Tex.) as of March 19, 2025 |
| EX. 2008 | Order granting Joint Motion to Modify Scheduling Order, *Optimum Imaging Technologies LLC v. Nikon Corp.*, No. 4:23-cv-00923, Dkt. 48 (E.D. Tex. Jan. 30, 2025) |
| EX. 2009 | Order granting Joint Motion to Modify Scheduling Order, *Optimum Imaging Technologies LLC v. Nikon Corp.*, No. 4:23-cv-00923, Dkt. 54 (E.D. Tex. Feb. 14, 2025) |
| EX. 2010 | Letter from Texas Secretary of State, *Optimum Imaging Technologies LLC v. Fujifilm Corp.,* No. 4-23-cv-00922-ALM, Dkt. 14 (E.D. Tex. Feb. 20, 2024) |
| EX. 2011 | Mediator's Report, *Optimum Imaging Technologies LLC v. Olympus Corporation, et al.,* No. 4:23-cv-00924-ALM, Dkt. 71 (E.D. Tex. March 10, 2025) |

| | |
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| EX. 2012 | Joint Notice of Settlement, *Optimum Imaging Technologies LLC v. Fujifilm Corporation,* No. 4:23-cv-00922-ALM, Dkt. 70 (E.D. Tex. March 19, 2025) |

## I. INTRODUCTION

With authorization from the Board (Paper 10), Patent Owner ("PO") respectfully submits this supplemental brief to address discretionary denial under *Fintiv*[1]. As discussed herein, the Board should deny institution in view of parallel district court litigations in the interest of efficiency.

## II. BACKGROUND

On 10/18/2023, PO filed complaints for infringement in the following district court litigations with Petitioners: (1) *Optimum Imaging Technologies LLC v. Olympus Corporation, et al.,* No. 4:23-cv-00924 (E.D. Tex.)("Olympus Litigation")[2]; (2) *Optimum Imaging Technologies LLC v. FUJIFILM Corp.,* No. 4:23-cv-00922 (E.D. Tex.)("Fujifilm Litigation")[3]; (3) *Optimum Imaging Technologies LLC v. Nikon Corp..,* No. 4:23-cv-00923 (E.D. Tex.)("Nikon Litigation"); (4) *Optimum Imaging Technologies LLC v. Panasonic Corporation, et al.,* No. 4:23-cv-00926 (E.D. Tex.)("Panasonic Litigation")[4].

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

[2] As of 3/8/2025, the Olympus Litigation is settled in principle. EX. 2011.

[3] As of 3/19/2025, the Fujifilm Litigation is settled in principle. EX. 2012.

[4] Panasonic Entertainment & Communication Co., Ltd. filed a declaratory

On 8/30/2024, the instant petition against the '805 Patent was filed. On 1/28/2025, the Preliminary Response was filed.

On 2/28/2025, the USPTO rescinded the June 21, 2022, memorandum entitled "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation" (Memorandum). That same day, PO requested authorization for supplemental briefing. On 3/6/2025, the Board granted PO's request.

## III. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION IN VIEW OF PARALLEL DISTRICT COURT LITIGATIONS

PO respectfully submits that the *Fintiv* factors favor the Board exercising its discretion to deny institution in this IPR. As shown below, granting institution of this IPR would not be an efficient use of the Board's resources. The final pre-trial conference will occur long before a final written decision ("FWD") would be expected in this IPR. The parallel litigations involving the same parties and overlapping claims will resolve the issues in this IPR.

### A. GOOD CAUSE EXISTS FOR ADMITTING EXS. 2006-2012

This brief is supported by EXS. 2006-2012 and there is good cause for

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judgment action in N.D. Cal. which was transferred to E.D. Tex. under the first-to-file rule. *See* EX. 2006 at 10; EX. 2007.

admitting these exhibits at least because each of these exhibits is highly relevant to the Board's analysis of the *Fintiv* factors, as discussed in detail below. Admitting these exhibits furthers the policy objectives of *Fintiv* including efficiency, fairness, and integrity of the patent system. Denying entry of these exhibits would prejudice PO because PO will have to defend the '805 Patent and expend resources for a trial that should not be instituted.

## B. THE *FINTIV* FACTORS FAVOR DENIAL

### *1. Factor 1 favors denial*

Olympus previously filed an opposed motion to stay the Olympus Litigation. However, Olympus' motion is now moot. On 3/8/2025, PO and Olympus conducted a mediation and the Olympus Litigation is now settled in principle. EX. 2011.

No other petitioner in this IPR has filed a motion to stay its respective litigation. PO would oppose any such motion. The outcome of any such motion is speculative.

Also, there is no evidence that Judge Mazzant would stay the parallel litigation(s). There are four asserted patents, including the '805 Patent, at issue in the parallel litigations. According to DocketNavigator, Judge Mazzant has only ever granted one opposed motion to stay, post-institution, where the plaintiff/patent owner itself filed the motion regarding its own infringement action. *OnPoint*

*Systems, LLC v. Protect Animals With Satellites, LLC*, No. 4:20-cv-657- ALM, Dkt. 115 (E.D. Tex. July 12, 2022). Therefore, even post-institution, a stay is highly unlikely. Accordingly, factor 1 favors denial.

### *2. Factor 2 favors denial*

The final pretrial conference in the co-pending parallel litigations is currently set for 11/6/2025. EX. 2009.[5, 6] This conference will occur **almost 6 months** before a FWD would be expected in this IPR on 4/28/2026.[7]

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[5] Five pending litigations involving Olympus, Fujifilm, Nikon, Sony, and Samsung are on the same schedule for pre-trial purposes. EX. 2009. The Court modified the Scheduling Order on 1/30/2025 and set the final pretrial conference for 11/6/2025. EX. 2008. The Court further modified the Scheduling Order on 2/14/2025 and the final pretrial conference remains set for 11/6/2025. EX. 2009.

[6] The Panasonic Litigation is on a delayed schedule due to Panasonic's misguided declaratory judgment action in N.D. Cal. which continues to cause extreme prejudice to PO. *See also infra,* note 4. Panasonic should not be rewarded.

[7] According to DocketNavigator, Judge Mazzant's final pretrial conference typically occurs 1-3 weeks before Trial Day 1. *See, e.g.,* Mazzant Case Nos. 4:20-cv-886, 4:08-cv-451, 4:18-cv-cv-469, 4:18-cv-474, 4:15-cv-766. Thus, Trial Day 1 is expected to occur at least five months before a FWD in this IPR.

Additionally, as discussed herein, a stay of the parallel litigations is unlikely and there will have been significant investment by the parties and the court by October 2025. Multiple trials will likely already be completed by the time of a FWD in April 2026. Accordingly, factor 2 favors denial.

### *3. Factor 3 favors denial*

As discussed below, the parties will have completed essentially all the work associated with trial by October 2025, long before a FWD in April 2026.

The parties will have significantly invested in the district court litigations by the time of the **institution decision** expected on 4/28/2025. The parties will have completed claim construction briefing with a claim construction hearing set for 3/27/2025 and fact discovery which closes 4/18/2025.

**Fact discovery including depositions of foreign witnesses is itself a significant investment by all parties** at least because of the required international travel to the embassy in Japan and special deposition visas which only authorize entry for a limited time-period. PO has already acquired the special visas and rooms are reserved at the embassy in Japan through 4/9/2025. PO has also already invested substantial resources in deposition preparation, document translation, and source code review as part of fact discovery.

Additionally, the parties will have completed trial preparation by October 2025, which is likely before oral argument in this IPR (not yet scheduled) and

surely long before a FWD in this IPR. Expert discovery closes on 6/27/2025; dispositive motions are due 7/11/2025; and other pretrial submissions are due by 10/17/2025 in preparation for the final pretrial conference. EX. 2009. Thus, trial preparation will be completed by October 2025.

**Petitioners did not act promptly in filing the petition – over ten months elapsed between the filing of the complaint and the filing of the petition in this IPR**. As noted above, the complaints were filed on 10/18/2023. Panasonic admits awareness of the complaint "shortly" after the complaint was filed in the Panasonic Litigation. EX. 2006 at 5. The other petitioners have not yet admitted when they actually became aware of the complaints.

The complaints were provided to the Texas Secretary of State for service on 10/30/2023. *See, e.g.,* EX. 2010 at 2. Fujifilm sent a signed return receipt that was received by the Texas Secretary of State on 1/8/2024. *Id*. Fujifilm was thus aware of the complaint in the Fujifilm Litigation at least by January 2024.

With authorization from the district court, PO also proceeded with service through the Hague Convention on 1/19/2024, which was completed for most petitioners in May 2024.[8] PO believes that all petitioners were aware of the filed

[8] Hague service for Panasonic was completed in October 2024. However, as noted above, Panasonic admitted knowledge of the complaint much earlier.

complaints long before Hague service was complete.

**Petitioners recycled prior art and arguments from the prior Canon IPR**[9]. All grounds in this IPR are based on primary reference Niikawa (EX. 1005) which was also at issue in the Canon IPR. Petitioners and their expert also rely on many other references from the Canon IPR, including for example, Enomoto II (EX. 1019) and Ricoh (EXS. 1029, 1030).

In view of the above, Petitioners could have filed the petition in this IPR before 8/30/2024. There is no evidence regarding when/how Petitioners conducted a prior art search with reasonable diligence and/or became aware of the prior art relied on in this IPR. Petitioners cannot otherwise explain how their actions show "promptness" over the course of the elapsed ten months.

Accordingly, factor 3 favors denial.

***4. Factor 4 favors denial or is neutral***

Petitioners challenge claims 1-9 and 18-24 of the '805 Patent in this IPR. Patent Owner originally asserted claims 1-14, 18, 21, 24, and 26 of the '805 Patent in the parallel district court litigations. Paper 8 at 2. Following a court ordered reduction of asserted claims on 1/21/2025, Patent Owner now asserts claims 1-4, 8-

[9] IPR2020-01321 of Patent No. 7,612,805 ("Canon IPR"). The Canon IPR was denied institution under *Fintiv*. EX. 2002 at 11.

9, 18, 21, and 24. PO submits that it would not be efficient to grant institution in this IPR because the district court will resolve validity of enough overlapping claims to resolve key issues in the petition. *Fintiv* at 13.[10]

Though Petitioners filed *Sotera*-style stipulations, this only moderately influences the analysis under the circumstances. On 2/27/2025, the defendants in the co-pending litigations served their preliminary elections of asserted prior art against the '805 Patent. *See* EX. 2009. Nikon asserts 6 systems and 6 patents/publications, including primary reference Niikawa discussed above.[11] Therefore, the invalidity challenges based on Niikawa at issue in this IPR may be evaluated by the district court in the Nikon Litigation.[12]

Petitioners also assert system art and so, even with the stipulation in effect, Petitioners are pursuing invalidity of the '805 Patent in district court. As discussed

[10] For example, the additional limitations of claim 19 are similar to claim 2, and the additional limitations of claim 20 are similar to claim 3.

[11] Following settlement in the Olympus and Fujifilm Litigations, PO refers to Nikon's preliminary election in the Nikon Litigation. In addition to Niikawa, Nikon also asserts Enomoto, Levien, and Yamasaki at issue in this IPR.

[12] Other defendants also assert Niikawa, Enomoto, Levien, and/or Yamasaki in their respective district court litigations, *e.g.,* Nos. 4:23-cv-927 and -928.

above, a post-institution stay by the district court is highly unlikely. Conducting parallel proceedings based on patents/publications in IPR and systems in district court is not efficient. Petitioners should not be given multiple bites at the invalidity apple.

Accordingly, factor 4 favors denial or is at minimum, neutral.

***5. Factor 5 favors denial***

The same parties are involved in this IPR and the district court litigations. Accordingly, factor 5 favors denial.

***6. Factor 6 favors denial***

For at least the reasons discussed in the Preliminary Response, the merits of the petition are weak. Paper 8 at 8-25. Conducting this IPR would not be a good use of resources.[13]

Additionally, the '805 Patent is currently involved in IPR2024-00924.[14] As further explained in the recently filed Patent Owner Response in IPR2024-00924,

[13] Samsung has indicated intent to file a motion in IPR2025-00461 to join this IPR which, if granted, could further delay a FWD up to 6 months. PO reserves all rights regarding IPR2025-00461.

[14] PO reserves all rights regarding IPR2024-00924 which PO submits should be terminated.

there is strong evidence of secondary considerations in view of the prior Canon Litigation. There is additional evidence now in view of the settlements in the Olympus Litigation and Fujifilm Litigation. *See* EX. 2011; EX. 2012.

Accordingly, factor 6 favors denial.

#### *7. On balance, the factors favor denial*

None of the *Fintiv* factors favor grant and instead, each of the six *Fintiv* factors favors denial or is at minimum, neutral. As discussed above, the final pretrial conference is set almost six months before a FWD in this IPR. By November 2025, the parties and the court will have invested substantially in the district court litigations and in preparation for trial. By April 2026, the parties and the court will likely have already completed multiple trials.

## IV. CONCLUSION

PO respectfully requests the Board deny institution in this IPR.

Respectfully submitted,

Date: March 19, 2025

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**CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS**

This paper is within the 10 page-limit authorized by the Board. Paper 10. This paper complies with the general format requirements under 37 C.F.R. § 42.6(a).

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**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies the PATENT OWNER'S SUPPLEMENTAL BRIEF and all exhibits thereto were served on the undersigned date via email, as authorized by Petitioners, at the following email addresses:

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