

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners

v.

OPTIMUM IMAGING TECHNOLOGIES LLC,

Patent Owner

Case IPR2024-01374

Patent No. 10,877,266

PATENT OWNER'S SUPPLEMENTAL BRIEF

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Patent Trial and Appeal Board
United States Patent and Trademark Office
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<u>PATENT OWNER'S LIST OF EXHIBITS</u>	
EX. 2001	Claim Construction Memorandum Opinion and Order, <i>Optimum Imaging Technologies LLC v. Canon Inc.</i> , No. 2:19-cv-00246-JRG, Dkt. 88 (E.D. Tex. June 11, 2020)
EX. 2002	Order granting Joint Motion to Modify Scheduling Order, <i>Optimum Imaging Technologies LLC v. Fujifilm Corp.</i> , No. 4:23cv-00922, Dkt. 61 (E.D. Tex. Feb. 14, 2025)
EX. 2003	Order, <i>Panasonic Entertainment & Communication Co., Ltd. v. Optimum Imaging Technologies LLC</i> , No. 3:24-cv-02466, Dkt. 47 (N.D. Cal. Sep. 23, 2024)
EX. 2004	Docket Report, <i>Optimum Imaging Technologies LLC v. Panasonic Corp. et al.</i> , No. 4:23-cv-00926, (E.D. Tex.) as of March 19, 2025
EX. 2005	Letter from Texas Secretary of State, <i>Optimum Imaging Technologies LLC v. Fujifilm Corp.</i> , No. 4-23-cv-00922-ALM, Dkt. 14 (E.D. Tex. Feb. 20, 2024)
EX. 2006	Mediator's Report, <i>Optimum Imaging Technologies LLC v. Olympus Corporation, et al.</i> , No. 4:23-cv-00924-ALM, Dkt. 71 (E.D. Tex. March 10, 2025)
EX. 2007	Joint Notice of Settlement, <i>Optimum Imaging Technologies LLC v. Fujifilm Corporation</i> , No. 4:23-cv-00922-ALM, Dkt. 70 (E.D. Tex. March 19, 2025)
EX. 2008	Printout of Website titled "Founding of Olympus" accessed at https://www.olympus-global.com/company/milestones/founding.html on March 7, 2025
EX. 2009	Printout of Website titled "History [of Fujifilm Corporation]" accessed at https://www.fujifilm.com/us/en/about/hq/corporate/history on March 18, 2025

I. INTRODUCTION

With authorization from the Board (Paper 12), 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.

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. 2006.

³ As of 3/19/2025, the Fujifilm Litigation is settled in principle. EX. 2007.

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

On 10/8/2024, the instant petition against the ‘266 Patent was filed. On 2/21/2025, 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. 2003-2009

This brief is supported by EXS. 2003-2009 and there is good cause for

judgment action in N.D. Cal. which was transferred to E.D. Tex. under the first-to-file rule. *See* EX. 2003 at 10; EX. 2004.

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 '266 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. 2006.

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 '266 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. 2002.^{5, 6} This conference will occur **over 6 months** before a FWD would be expected in this IPR on 5/21/2026.⁷

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

⁵ Five pending litigations involving Olympus, Fujifilm, Nikon, Sony, and Samsung are on the same schedule for pre-trial purposes. EX. 2002.

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 approx. six months before a FWD in this IPR.

FWD in May 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 May 2026.

The parties will have significantly invested in the district court litigations by the time of the **institution decision** expected on 5/21/2025. 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. 2002. Thus, trial

preparation will be completed by October 2025.

Petitioners did not act promptly in filing the petition – almost one full year (356 days) 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. 2003 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. 2005 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 complaints long before Hague service was complete.

Petitioners were aware of prior art references long before the petition was filed in this IPR. Below, PO addresses Sarbadhikari and Katagiri which are at

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

issue in all Grounds in this IPR.

First, Sarbadhikari was cited by at least: 11 patents/publications assigned to Fujifilm⁹, 8 patents/publications assigned to Nikon¹⁰, and 2 patents/publications assigned to Olympus¹¹.

Second, Katagiri was cited by at least: 4 patents/publications assigned to Olympus¹² and 1 publication assigned to Nikon¹³.

⁹ See US5631701, US6198526, US20030184652, US20030231249, US20040021789, US6801251, US6801327, US20050088698, US7034881, US7123296, and US7733387. All patents/publications issued/published before 2010. Fuji Photo Film Co., Ltd. later became Fujifilm Corp. EX. 2009.

¹⁰ See US6311322, US20020024603, US20020129084, US20030011703, US20030016293, US20030122928, US20040184788, and US20050185002. All patents/publications issued/published before 2005.

¹¹ See US6434342 and US20040018014. All patents/publications issued/published before 2004. Olympus Optical Co., Ltd. Changed its name to Olympus Corp. in October 2003. EX. 2008.

¹² See JP2006345053A, JP2007067677A, JP2007096588A, and US7839446. All patents/publications issued/published before 2010.

¹³ See JP2008141568A which published in 2008.

In view of the above, Petitioners were aware of these prior art references at least by 2010 and could have filed the petition in this IPR before October 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 356 days.

Accordingly, factor 3 favors denial.

4. Factor 4 favors denial or is neutral

Petitioners challenge claims 1-30 in this IPR. Patent Owner originally asserted claims 1-30 in the parallel district court litigations. Paper 11 at 2. Following a court ordered reduction of asserted claims on 1/21/2025, Patent Owner now asserts claims 1, 2, 10, 21, 22, 23, 28, and 29. 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 13.¹⁴

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

¹⁴ For example, claims 3-9 depend from claim 2.

against the ‘266 Patent. *See* EX. 2002. Nikon asserts 2 systems and 10 patents/publications, including Sarbadhikari and Katagiri discussed above.¹⁵ Therefore, the invalidity challenges based on Sarbadhikari and Katagiri at issue in this IPR may be evaluated by the district court in the Nikon Litigation.¹⁶

Petitioners also assert system art and so, even with the stipulation in effect, Petitioners are pursuing invalidity of the ‘266 Patent in district court. As discussed 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.

¹⁵ Following settlement in the Olympus and Fujifilm Litigations, PO refers to Nikon’s preliminary election in the Nikon Litigation. Nikon also asserts Iwasawa, Ito, Miyazawa, and Hamilton at issue in this IPR in the Nikon Litigation.

¹⁶ At least one other defendant also asserts Sarbadhikari, Katagiri, Iwasawa, and Ito in its respective district court litigation, *e.g.*, No. 4:23-cv-927.

6. *Factor 6 favors denial*

For at least the reasons discussed in the Preliminary Response, the merits of the petition are weak. Paper 11 at 16-25. All Grounds are based on obviousness, not anticipation. 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. 2006; EX. 2007. Conducting this IPR would not be a good use of resources.¹⁷

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 over 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 May 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.

¹⁷ Samsung has indicated intent to file a motion in IPR2025-00463 to join this IPR which, if granted, could further delay a FWD up to 6 months. PO reserves all rights regarding IPR2025-00463.

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This paper is within the 10 page-limit authorized by the Board. Paper 12. 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
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