

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Nikon Corporation, Panasonic Entertainment & Communication Co., Ltd.,
Petitioners,

v.

Optimum Imaging Technologies LLC,
Patent Owner.

Case IPR2024-01374

Patent No. 10,887,266

**PETITIONERS' RESPONSE TO PATENT OWNER'S SUPPLEMENTAL
BRIEF REGARDING § 314(a)**

TABLE OF CONTENTS

I.	Introduction	1
II.	Discretionary Denial Is Not Warranted	2
A.	Factor 4: Petitioners’ <i>Sotera</i> stipulations strongly counsel against discretionary denial.	2
B.	Factor 1: Judge Mazzant granted the only post-institution stay motion he ruled on.	4
C.	Factor 2: Panasonic’s trial will postdate the final written decision; Nikon’s trial date is uncertain. This counsels against denial.	5
D.	Factor 3: The trial court matters remain in an early stage, indicating against denial.	7
E.	Factor 6: The Petition is strong, such that trial should be instituted.	9
III.	Conclusion	9

I. Introduction

Petitioners Nikon Corporation and Panasonic Entertainment & Communication Co., Ltd. (“Petitioners”) respond to Patent Owner’s Supplemental Brief of March 19, 2025.^{1,2}

Discretionary denial is not appropriate for the reasons set forth in the Petition (at 73-75) and elaborated below. *Sotera* remains precedential, and Petitioners’ full *Sotera* stipulations “weigh[] strongly in favor of not exercising discretion to deny institution under 35 U.S.C. § 314(a).” *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020) (precedential as to § II.A).

¹ The Patent Owner has settled with Petitioners Olympus (Olympus Corporation and OM Digital Solutions Corporation) and FujiFilm (FUJIFILM Corporation and FUJIFILM North America Corporation). Paper 15 at 1. Those entities are being withdrawn from the present matter. As Patent Owner noted in an April 1, 2025 email, settlement negotiations with the remaining petitioners are ongoing but not final, such that trial should be instituted. The remaining parties will promptly inform the Panel if settlement occurs.

² Petitioners do not object to Patent Owner submitting Exhibits 2003-2009 regarding the state of the copending litigations. Petitioners hereby submit Exhibits 1079-1082 to provide further context.

Also, contrary to Patent Owner’s assertion, neither a firm final pre-trial conference date nor any trial date has been set in the Nikon case, while the anticipated trial date in the separate Panasonic case will occur after the date of a final written decision in this proceeding. The balance of the *Fintiv* factors counsels against denial.³

II. Discretionary Denial Is Not Warranted⁴

A. **Factor 4: Petitioners’ *Sotera* stipulations strongly counsel against discretionary denial.**

Factor 4 considers overlap between issues raised in the petition and in the parallel proceeding. To avoid duplicative effort, the Petitioners have stipulated that if IPR is instituted, the Petitioners will “(i) not pursue the grounds [presented in the IPR petition] in the respective District Court Case, and (ii) not pursue any other ground that reasonably could have been raised during the IPR in the respective District Court Case.” Ex. 1078 at 1. This stipulation matches the petitioner’s

³ Petitioners agree that the parties involved in the noted litigations and present IPR are the same for Factor 5.

⁴ *Sotera* remains a precedential decision that indicates that Factor 4 stipulation “***weighs strongly*** in favor of not exercising discretion to deny institution under 35 U.S.C. § 314(a).” *Sotera*, Paper 12 at 19 (emphasis added). Factor 4 is addressed first here based on that strong weight. The remaining factors are then addressed in order.

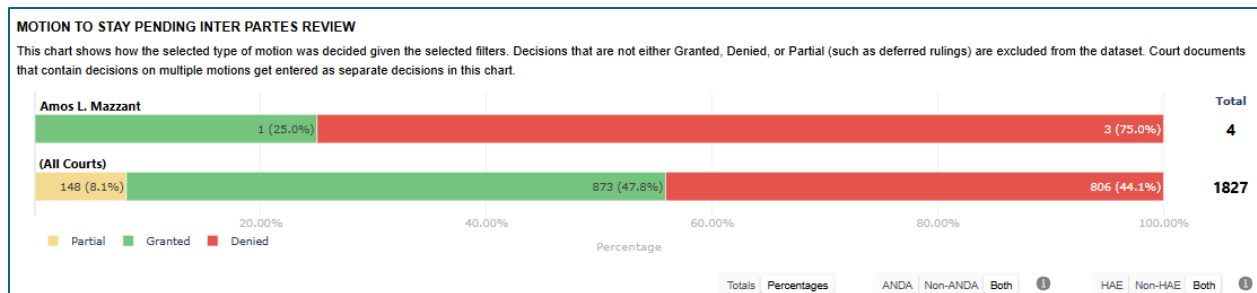
language in *Sotera*. Such a stipulation “mitigates any concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions.” *Sotera*, Paper 12 at 19.

Although the June 2022 Interim Procedure For Discretionary Denials In AIA Post-Grant Proceedings With Parallel District Court Litigation (“Guidance”) has been rescinded, the PTAB continues to give considerable weight to *Sotera* stipulations in granting institution. *See, e.g., Adobe Inc. v. Jonathan E. Jaffe*, IPR2024-01352, Paper 8 at 12, n. 4 (PTAB March 5, 2025) (recognizing that even after rescission of the Guidance, a *Sotera* stipulation “weighs strongly in favor of not exercising discretion to deny institution”); *Samsung Electronics Co. Ltd., v. Headwater Research LLC*, IPR2024-01407, Paper 9 at 8 (PTAB March 20, 2025) (weighing Factor 4 “strongly against exercising ... discretion to deny institution” because “[b]ased on Petitioner’s [*Sotera*] stipulation, ... there would be no overlap between issues raised in the Petition and in the parallel proceeding”); *Deltran USA LLC v. The NOCO Company*, IPR2024-01219, Paper 8 at 17-18 (PTAB March 19, 2025) (weighing Factor 4 “strongly against exercising ... authority to deny institution” because of petitioner’s *Sotera* stipulation). Even after withdrawal of the Guidance, the stipulation in the present matter means that Factor 4 “weighs strongly in favor of not exercising discretion to deny institution under 35 U.S.C. § 314(a).” *Sotera*, Paper 12 at 19.

Based on Petitioners’ unequivocal stipulation, Factor 4 weighs heavily against denial.

B. Factor 1: Judge Mazzant granted the only post-institution stay motion he ruled on.

The Patent Owner’s claim that “a stay is highly unlikely” is puzzling. DocketNavigator indicates that Judge Mazzant granted the only post-institution stay motion he ruled on. *OnPoint Systems, LLC v. Protect Animals With Satellites, LLC*, 4-20-cv-00657 (E.D. Tx.), Paper 115.



The three stay motions that Judge Mazzant denied were pre-institution motions. *See, Shoes by Firebug LLC v. Stride Rite Children's Group, LLC*, 4-16-cv-00899 (E.D. Tx.), Paper 37 at 2 (“a stay of these proceedings in advance of the PTAB’s decision on whether or not to grant the petitions for inter partes review should be denied”); *SB IP Holdings LLC v. Vivint, Inc.*, 4-21-cv-00912 (E.D. Tx.), Paper 59 at 3 (“a stay of these proceedings in advance of the PTAB’s decision on whether to grant the outstanding petition for IPR should be denied at this time”); *Parallel Network Licensing, LLC v. RamQuest, Inc. et al*, 4-19-cv-00487 (E.D. Tx.), Paper 46 at 8 (the

“IPRs are in the pre-institution phase, and under this procedural posture, the law from this district counsels against granting a stay”).

In granting a stay in the *OnPoint Systems* case, Judge Mazzant stated that “the most important factor bearing on whether to grant a stay ... is the prospect that the *inter partes* review proceeding will result in simplification of issues before the Court.” *OnPoint*, Paper 115 at 6. There, even though the district court case was at an advanced stage, Judge Mazzant granted the stay because “even if the PTAB does not invalidate any of these claims, the PTAB’s insight and expertise is likely to be of considerable assistance to the Court.” *Id.* at 7.

According to Judge Mazzant’s reasoning in *OnPoint*, this IPR would certainly simplify issues at the district court. Judge Mazzant’s deference to the PTAB’s expertise, and his granting the only post-institution stay motion counsels against a discretionary denial.

C. Factor 2: Panasonic’s trial will postdate the final written decision; Nikon’s trial date is uncertain. This counsels against denial.

The Patent Owner provides a cursory cite to a placeholder for a pre-trial conference date for Nikon on November 6, 2025, as evidence that trial will occur

before a final written decision here. But that citation without elaboration fails to tell the story.⁵

First, that November 2025 date does not apply to Panasonic. There are separate pending cases against the Petitioners on separate scheduling tracks. In the Panasonic district court matter, the scheduling order indicates a pre-trial conference on April 27, 2026, five months after the date touted in Petitioner’s Supplemental Brief. Ex. 1080, 4. Thus, the presently anticipated trial date for Panasonic will take place long after the timing implied by the Patent Owner, and after a final written decision by the PTAB.

Regarding Nikon, the Patent Owner noted its unavailability to attend a pre-trial conference on November 6, 2025 due to another trial. Ex. 1079, 12:21-13:7. In a telephone conference, Judge Mazzant explained that the pretrial conference date is “just a placeholder” and would be set if the case is going to trial. *Id.*, 13:8-11, 14:1-3. Judge Mazzant further noted that his “trial schedule ... backs up,” (*id.*, 13:15-17) making it clear that the actual pretrial conference date would be pushed beyond November 6 to accommodate Patent Owner’s conflict with Judge Mazzant’s docket.

⁵ The Patent Owner has settled with FUJIFILM and Olympus, so no trial will occur in their matters. Paper 15 at 1.

Id., 13:15-17. Thus, a trial date for Nikon is uncertain and will not take place according to the timing implied by the Patent Owner.

The PTAB has declined to speculate on trial timing in the past, and should not do so here. *See Dish Network v. Broadband iTV*, IPR2020-01280, Paper 17 at 16 (PTAB Feb. 4, 2021) (“We cannot ignore the fact that the currently scheduled trial date is more than nine months away and much can change during this time.”); *see also, Laboratory Corporation of America Holdings v. Ravgen, Inc.*, IPR2021-01054, Paper 11 at 17 (PTAB Nov. 5, 2021) (“Given the present uncertainty on this record about when trial in the district court might occur..., we determine that this factor does not weigh in favor of discretionary denial.”); *Sand Revolution II v. Continental Intermodal Group-Trucking*, IPR2019-01393, Paper 24, 12-13 (PTAB June 16, 2020) (informative) (weighing factor 2 against discretionary denial because of “uncertainty that continues to surround the scheduled trial date”).

Thus, Factor 2 weighs against discretionary denial.

D. Factor 3: The trial court matters remain in an early stage, indicating against denial.

The Patent Owner implies that much work has been invested in the trial court matter, such that institution should be denied. But that is not so when measured against the benchmarks identified in *Fintiv*. There, claim construction and other substantive orders are the indicators of trial court investment. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 9-10 (PTAB March 20, 2020) (precedential); *see*

also, Snap, Inc. v. SRK Technology LLC, IPR2020-00820, Paper 15 at 11 (PTAB Oct. 21, 2020) (precedential as to § II.A) (“Where the District Court has not issued claim construction orders and the discovery process is not yet complete, the remaining investment of time and effort likely necessary to bring co-pending litigation to trial appears to far outweigh that which has already been invested.”).

Here, no claim construction or substantive orders have been issued in either case. Much work remains in the district court as it relates to invalidity. Fact discovery in the Nikon case is ongoing. *See* Ex. 2002. No depositions have been taken by either side, expert reports are not yet due, and dispositive motions are months away. *Id.* The claim construction hearing set for March 27 has been postponed. Ex. 1082. By the time the institution decision issues, expert discovery, dispositive motions, and other pretrial motions will still lie ahead. The Panasonic case is at a far earlier stage. Fact discovery has yet to begin, invalidity contentions are not yet due, and the parties have not even begun the claim construction process. Thus, in both cases, trial court investment, according to the *Fintiv* measuring posts, is low, indicating that a discretionary denial is not appropriate.

The Patent Owner further accuses the Petitioners of having been dilatory in filing their Petitions. But the Patent Owner starts its clock for measuring the purported delay at an unprincipled time. IPR petition timeliness is based on “serv[ice of] a complaint alleging infringement of the patent.” 35 U.S.C. § 315(b).

The Patent Owner provides no support for the “awareness of the complaint” standard in its Supplemental Brief. Paper 15 at 6. Applying the correct starting time, the present Petition (filed October 8, 2024) was filed less than five months after Nikon was served on May 22, 2024, where Panasonic was served much later in 2024.⁶ Ex. 1081; Paper 15, 6-7. Petitioners’ filing of the present Petition less than five months after service—more than seven months before the statutory deadline—was unquestionably prompt. That timing is not a basis for denial.

E. Factor 6: The Petition is strong, such that trial should be instituted.

Factor 6 considers other circumstances that impact the Board’s exercise of discretion, including the merits. The Petition presents a strong case for unpatentability, demonstrating that the challenged claims are obvious in view of the cited prior art. The prior art renders the claimed invention obvious, fully describing all the claim limitations with clear motivations to combine presented. The Petition’s unpatentability assertions are backed by expert testimony, with no counter-testimony from an expert on the patent owner side. Thus, Factor 6 also favors institution.

III. Conclusion

Because Petitioners’ *Sotera* stipulations eliminate the possibility of overlap between the present IPR and the trial court proceedings, because Judge Mazzant

⁶ Panasonic was served in October 2024. Paper 15 at 6.

granted the only post-institution stay motion that he ruled on, and because the balance of the *Fintiv* factors strongly favors institution, the Board should institute review.

Dated: April 2, 2025.

Respectfully Submitted

/Matthew W. Johnson/

Matthew W. Johnson, Reg. No. 59,108
for Nikon

/Joseph M. Casino/

Joseph M. Casino, Reg. No. 57,224
for Panasonic

PETITIONERS' UPDATED TABLE OF EXHIBITS

Ex-1001	U.S. Pat. No. 10,877,266 (“the ’266 patent”)
Ex-1002	Prosecution History of the ’266 patent
Ex-1003	Declaration of Dr. Robert L. Stevenson
Ex-1004	U.S. Pat. No. 5,477,264 (“Sarbadhikari”)
Ex-1005	Certified English Translation of Japanese Pat. App. Pub. No. 2000- 41179 (“Iwasawa”)
Ex-1006	Certified English Translation of Japanese Pat. App. Pub. No. 2004- 289225 (“Katagiri”)
Ex-1007	U.S. Pat. App. Pub. No. 2002/0113884 A1 (“Tanii”)
Ex-1008	Certified English Translation of Japanese Pat. App. Pub. No. 2005-25703 (“Yamada”)
Ex-1009	Certified English Translation of Japanese Pat. App. Pub. No. 2004- 320567 (“Uchino”)
Ex-1010	International Pat. App. Pub. No. WO 2005/065283 (“Walker”)
Ex-1011	U.S. Pat. App. Pub. No. 2005/0001024 (“Kusaka”)
Ex-1012	U.S. Pat. App. Pub. No. 2006/0274170 (“Azuma”)
Ex-1013	U.S. Pat. App. Pub. No. 2004/0080621 (“Fisher”)
Ex-1014	Kodak EasyShare-One User’s Guide (“Kodak EasyShare”)
Ex-1015	U.S. Pat. No. 6,603,885 (“Enomoto”)
Ex-1016	U.S. Pat. No. 6,360,362 (“Fichtner”)
Ex-1017	U.S. Pat. App. Pub. No. 2004/0150726 (“Gallagher”)
Ex-1018	U.S. Pat. App. Pub. No. 2002/0135688 (“Niikawa”)
Ex-1019	U.S. Pat. No. 7,245,319 (“Enomoto II”)
Ex-1020	U.S. Pat. No. 5,227,832 (“Kawasaki”)
Ex-1021	U.S. Pat. App. Pub. No. 2005/0280877 (“Watanabe”)

Ex-1022	U.S. Pat. App. Pub. No. 2004/0239771 (“Habe”)
Ex-1023	U.S. Pat. App. Pub. No. 2004/0189825 (“Kawashima”)
Ex-1024	U.S. Pat. No. 5,596,387 (“Takagi”)
Ex-1025	U.S. Pat. App. Pub. No. 2002/0015111 (“Harada”)
Ex-1026	U.S. Pat. App. Pub. No. 2004/0263887 (“Kotani”)
Ex-1027	U.S. Pat. App. Pub. No. 2005/0168591 (“Proidl”)
Ex-1028	U.S. Pat. App. Pub. No. 2003/0071905 (“Yamasaki”)
Ex-1029	U.S. Pat. No. 4,453,811 (“Yamasaki II”)
Ex-1030	U.S. Pat. No. 5,510,837 (“Takei”)
Ex-1031	U.S. Pat. App. Pub. No. 2004/0005915 (“Hunter”)
Ex-1032	U.S. Pat. App. Pub. No. 2004/0109063 (“Kusaka II”)
Ex-1033	U.S. Pat. App. Pub. No. 2002/0044157 (“Wolf”)
Ex-1034	U.S. Pat. App. Pub. No. 2004/0201688 (“Wolf II”)
Ex-1035	U.S. Pat. App. Pub. No. 2005/0008236 (“Hachiyama”)
Ex-1036	U.S. Pat. App. Pub. No. 2003/0017846 (“Estevez”)
Ex-1037	U.S. Pat. No. 7,936,392 (“Ng”)
Ex-1038	Certified English Translation of Japanese Pat. App. Pub. No. H06- 113309 (“Ito”)
Ex-1039	Prosecution History of U.S. Pat. No. 8,451,339 (the “’339 patent”)
Ex-1040	U.S. Pat. No. 7,683,950 (“Kelly”)
Ex-1041	U.S. Pat. No. 5,414,782 (“Carasso”)
Ex-1042	U.S. Pat. No. 4,903,204 (“Dobbins”)
Ex-1043	U.S. Pat. No. 6,791,608 (“Miyazawa”)
Ex-1044	U.S. Pat. App. Pub. No. 2002/0158977 (“Hamilton”)
Ex-1045	U.S. Pat. App. Pub. No. 2004/0080636 (“Dong”)

Ex-1046	U.S. Pat. No. 6,611,288 (“Fossum”)
Ex-1047	U.S. Pat. No. 5,805,216 (“Tabei”)
Ex-1048	U.S. Pat. App. Pub. No. 2002/0093577 (“Kitawaki”)
Ex-1049	U.S. Pat. App. Pub. No. 2006/0050158 (“Irie”)
Ex-1050	U.S. Pat. No. 5,382,976 A (“Hibbard”)
Ex-1051	U.S. Pat. App. Pub. No. 2001/0008418 (“Yamanaka”)
Ex-1052	U.S. Pat. No. 6,590,617 (“Kanai”)
Ex-1053	U.S. Pat. App. Pub. No. 2004/0179131 (“Honda”)
Ex-1054	U.S. Pat. No. 4,423,936 (“Johnson”)
Ex-1055	U.S. Pat. No. 6,151,171 (“Kenin”)
Ex-1056	U.S. Pat. App. Pub. No. 2004/0066980 (“Gindele”)
Ex-1057	U.S. Pat. App. Pub. No. 2003/0052988 (“Kurosawa”)
Ex-1058	U.S. Pat. No. 6,900,841 (“Mihara”)
Ex-1059	U.S. Pat. App. Pub. No. 2004/0228005 (“Dowski”)
Ex-1060	U.S. Pat. No. 6,920,443 (“Cesare”)
Ex-1061	U.S. Pat. No. 6,301,440 (“Bolle”)
Ex-1062	U.S. Pat. App. Pub. No. 2004/0032490 (“Uchida”)
Ex-1063	U.S. Pat. App. Pub. No. 2004/0165101 (“Miyanari”)
Ex-1064	U.S. Pat. App. Pub. No. 2005/0231615 (“Kitani”)
Ex-1065	U.S. Pat. No. 6,323,934 (“Enomoto III”)
Ex-1066	Japanese Pat. App. Pub. No. 2000-41179 (“Iwasawa-JP”)
Ex-1067	[Reserved]
Ex-1068	Japanese Pat. App. Pub. No. 2005-25703 (“Yamada-JP”)
Ex-1069	Japanese Pat. App. Pub. No. 2004-320567 (“Uchino-JP”)
Ex-1070	Japanese Pat. App. Pub. No. H06-113309 (“Ito-JP”)

Ex-1071	Japanese Pat. App. Pub. No. 2004-289225 (“Katagiri-JP”)
Ex-1072	Certified English Translation of Japanese Pat. App. Pub. No. H11- 205652 (“Ichiyama”)
Ex-1073	Japanese Pat. App. Pub. No. H11-205652 (“Ichiyama-JP”)
Ex-1074	U.S. Pat. No. 3,522,764 (“Biber”)
Ex-1075	U.S. Pat. No. 5,752,115 (“McIntyre”)
Ex-1076	U.S. Pat. App. Pub. No. 2003/0098914 (“Easwar”)
Ex-1077	Curriculum Vitae of Dr. Robert L. Stevenson
Ex-1078	Sotera Stipulation
Ex-1079	Transcript of 9/19/2024 in Nikon Matter
Ex-1080	Scheduling Order of 3/26/2025 in Panasonic Matter
Ex-1081	Extension of Time for Answering Complaint in Nikon Matter
Ex-1082	Minute Order of 3/27/2025 in Nikon Matter

CERTIFICATE OF SERVICE

The undersigned hereby confirms that the foregoing PETITIONERS' RESPONSE TO PATENT OWNER'S SUPPLEMENTAL BRIEF REGARDING § 314(a) and associated exhibits were caused to be served on April 2, 2025 via electronic email on Patent Owner's counsel of record:

Lead Counsel	Back-Up Counsel
Thomas M. Dunham Cherian LLP 1901 L Street NW, Suite 700 Washington, D.C. 20036 Tel. (202) 838-1567 Fax (202) 478-1715 tomd@cherianllp.com tom@dunham.cc USPTO Customer No. 144371 USPTO Reg. No. 39,965	Robert W. Molitors Cherian LLP 1901 L Street NW, Suite 700 Washington, D.C. 20036 Tel. (202) 838-1563 Fax (202) 478-1715 rmolitors@cherianllp.com USPTO Customer No. 144371 USPTO Reg. No. 66,726 Elizabeth A. O'Brien Cherian LLP 1901 L Street NW, Suite 700 Washington, D.C. 20036 Tel. (202) 838-1726 Fax (202) 478-1715 elizabetho@cherianllp.com USPTO Customer No. 144371 USPTO Reg. No. 76,105

Dated: April 2, 2025

/Matthew W. Johnson/
Attorney for Petitioners