

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LENOVO (UNITED STATES) INC.,
Petitioner,

v.

TELEFONAKTIEBOLAGET LM ERICSSON,
Patent Owner.

Case No. IPR2025-00009
Patent 10,972,654

PATENT OWNER PRELIMINARY RESPONSE

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PATENT OWNER'S EXHIBITS

No.	Exhibit
2001	U.S. Patent Pub. No. 2007/0018069 to Higashino
2002	Screenshot of http://web.archive.org/web/20111125150721/http://service.us.panasonic.com/OPERMANPDF/DMCG2K.PDF , last accessed January 29, 2025

Patent Owner Telefonaktiebolaget LM Ericsson (“Ericsson”) submits this Preliminary Response to the Petition for *Inter Partes* Review (“Petition”) of claims 1, 3, 9, 10, 15, and 16 (“challenged claims”) of U.S. Patent No. 10,972,654 (“the ’654 Patent”). Ericsson respectfully requests that the Board deny institution because there is not a reasonable likelihood that Petitioner would prevail with respect to any challenged claim in the petition. 35 U.S.C. § 314(a).

With respect to Ground 1, the Petition fails to establish that *Park* in combination with *Kim* discloses or renders obvious a controller configured to “control the touch screen to display an indicator for indicating the current image capturing setting while maintaining the displayed auto focus guide at the specific point,” as recited in limitation 1[h]. The Petitioner additionally fails to establish a reasonable likelihood that a POSITA would have been motivated to combine *Park* with *Kim*. With respect to Grounds 2 and 3, the Petitioner fails to establish a reasonable likelihood that *Panasonic* qualifies as prior art to the ’654 Patent.

I. THE ’654 PATENT

A. Summary of the ’654 Patent

The ’654 Patent relates to “a mobile terminal and method of capturing image” “conveniently and efficiently” by focusing using an auto focus guide in response to a touch input at a specific point on a touch screen, and setting an image capturing setting with an indicator on the touch screen while maintaining the displayed auto

focus guide at the specific point. EX1001, Abstract, Claim 1. In particular, the '654 Patent discloses a mobile terminal comprising a camera, touch screen, and controller, where the controller is configured to, among other things, (1) “display an auto focus guide at a specific point of the touch screen in response to a first touch input to the specific point,” (2) “focus the preview images based on a location of the auto focus guide,” (3) “determine an image capturing setting of the camera responsive to an object dragged along the touch screen . . .” and (4) “control the touch screen to display an indicator for indicating the current image capturing setting while maintaining the displayed auto focus guide at the specific point.” *Id.*, Claim 1.

The '654 Patent discloses embodiments in which “an auto focus guide (AFG) indicating a position on which focusing will be performed or a focus window for an image to be captured” is displayed. *Id.*, 13:10-13. The user may “move[] the AFG to a specific position on the touch screen 151 such that auto focusing is performed on the specific position where the AFG is displayed.” *Id.*, 13:19-23. “[A]uto focusing is performed when the focus window is moved to a specific position on the touch screen 151 by a user’s touch input.” *Id.*, 13:32-35.

In certain embodiments, the controller may also “display an indicator or a progress bar that indicates an adjustment degree of the lens location on the touch screen 151 while adjusting the lens position according to the input of the touch trace.” *Id.*, 19:47-50.

B. Prosecution History

1. Prosecution of the '654 Patent

The '654 Patent was filed as Application No. 17/024,831 (“the '831 Application”) on September 18, 2020. EX1001, Cover. The '654 Patent claims priority through direct continuations to Application No. 13/174,549, which was filed on June 30, 2011. *Id.* The '549 Application also is a continuation-in-part of application No. 12/351,591, which was filed on January 9, 2009. *Id.* The *Kim* (EX1007) reference, relied on by Petitioner for Grounds 1 and 3, was among the prior art cited by the Applicant and considered by the Examiner during prosecution of the '831 Application. EX1003, 196.

The Examiner allowed the claims as originally filed. EX1003, 271-79. On January 13, 2021, the Examiner issued a Notice of Allowance stating as its reasons for allowance:

Regarding independent claim 1, the prior art of record fails to teach or fairly suggest control the touch screen to display an auto focus guide at a specific point of the touch screen in response to a first touch input to the specific point; focus the preview images based on a location of the auto focus guide; determine an image capturing setting of the camera responsive to an object dragged along the touch screen, wherein a value of the image capturing setting is increased responsive to the object being

dragged in a first direction and is decreased responsive to the object being dragged in a second direction; control the touch screen to display an indicator for indicating the current image capturing setting while maintaining the displayed auto focus guide at the specific point; and capture an image according to the current image capturing setting; in combination with other elements.

Id., 276-77.

2. Prosecution of the Parent '168 Patent

Claim 1 of the '654 Patent recites as part of limitation 1[h] that the controller is configured to “control the touch screen to display an indicator for indicating the current image capturing setting while maintaining the displayed focus guide at the specific point.” EX1001, Claim 1 (emphasis added). The limitation “while maintaining the displayed focus guide at the specific point” was first introduced during prosecution of Application No. 14/561,090 (“the '090 Application”), now Patent No. 9,888,168 (“the '168 Patent”), to which the '654 Patent claims priority. *Id.*, Cover; EX1019, 590-98. During prosecution of the '090 Application, the Examiner rejected Claim 21 under 35 U.S.C. § 102(b) in view of Higashino. *Id.*, 562-63.

Higashino (EX2001) discloses both moving the auto focus frame from one point to another on the display as well as changing the size of the focus area. *See*,

e.g., EX2001, ¶[0088] (“As described above, the user can move the position of the AF frame by touching on the touch screen 10. In addition to this, the size of the AF frame may be changed.”).

In response to the rejection, Applicant amended Claim 21 to additionally recite, among other things, “while maintaining the displayed focus guide at the specific point.” EX1019, 591. Applicant remarked:

In relying upon Figure 5 of Higashino, the Final Office Action asserts that determining the image capturing setting and “changing the image capturing setting from the determined image capturing setting” is equivalent to setting the AF frame, then the user moving the AF frame to a different location (other than the specific point). (See Final Office Action, pages 3-4: “user traces AF frame to a new location; image capturing setting being the location on the new AF frame.”). However, this fails to teach or suggest changing the image capturing setting from the determined image capturing setting of the specific point in response to a predetermined touch trace input to the touch screen while maintaining the displayed focus guide at the specific point. Since Examiner’s rejection relies upon repeated user movement of the AF frame in Figure 5, it necessarily involves movement of the displayed AF frame upon each determination of the image capturing setting, and subsequent change of the image capturing setting from

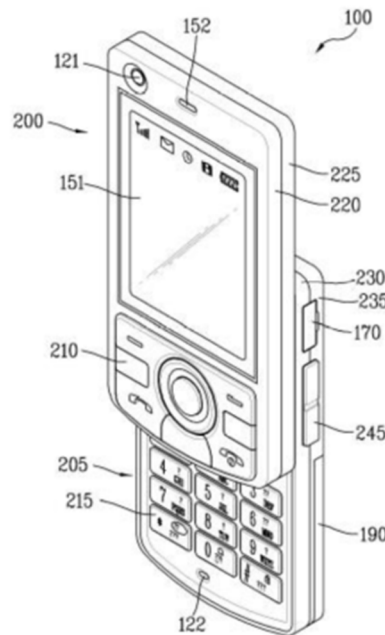
the determined image capturing setting. By contrast, claim 21 as amended requires that the displayed focus guide is *maintained at the specific point while the image capturing setting is changed* in response to the touch trace, which is not taught by the reference.

Id., 596 (some emphasis in original some added).

II. THE CITED ART

A. *Park* (EX1005)

Park discloses a “mobile terminal and a method of controlling the same” in which “utilization of the scroll bar displayed on the touchscreen” is “significantly expand[ed]” to use “various functions and menus.” EX1005, Abstract. *Park* illustrates an example of the mobile terminal of the invention in Figure 2, below.

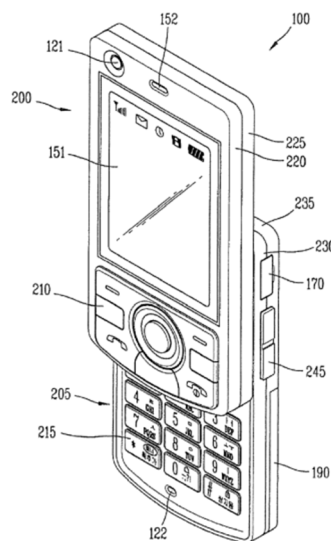


Id., ¶[0059] & Fig. 2.

Park recognizes “a continuing need for efforts to organize the various functions and menus so that they are convenient for users to operate.” *Id.*, ¶[0005]. *Park* is directed to a terminal where the user can “easily select a desired function or menu and enter a predetermined command within the selected function or menu as needed, even though various functions and menus exist on the terminal.” *Id.*, ¶[0006]. *Park* addresses this by “provid[ing] a touchscreen for displaying a screen associated with a predetermined menu of a terminal.” *Id.*, ¶[0007].

B. *Kim* (EX1007)

Kim relates to a “portable terminal” with functionality for “data/voice communications, capturing images or videos via a camera, recording audio, playing music files via a speaker system, and displaying images or videos.” EX1007, ¶[0005]. An example of the portable terminal is illustrated in Figure 2 below.



Id., Fig. 2. *Kim*'s portable terminal "may be implemented in various forms," including "mobile phones, user equipment, smart phones, notebook computers, digital broadcast receiver terminals, personal digital assistants (PDA), portable multimedia players (PMP) and mobile navigation units." *Id.*, ¶[0036].

Kim seeks to "enable a user to conveniently search for or select among available functions." *Id.*, ¶[0008]. Therefore, *Kim* "provide[s] a portable terminal that can automatically perform a touch sensing based image capture operation" and "to provide an image capture method for a portable terminal that can set and execute a variety of capture functions according to a touch input." *Id.*, ¶¶[0010]-[0011].

C. *Panasonic* (EX1008)

Panasonic is an instruction manual for a Panasonic digital camera model No. DMC-G2K. EX1008.

III. PROCEDURAL HISTORY

On October 11, 2023, Patent Owner sued Petitioner in the Eastern District of North Carolina in the pending action *Telefonaktiebolaget LM Ericsson et al v. Lenovo (United States), Inc.*, 5:23-cv-00570. The next day, Patent Owner initiated a proceeding before the International Trade Commission, Inv. No. 337-TA-1376. On February 9, 2024, the Eastern District of North Carolina stayed the district court case until a determination of the International Trade Commission became final.

On November 25, 2024, the ITC issued an Initial Determination on Violation of Section 337 and Recommended Determination on Remedy and Bond. EX1024 (adopted in part by the ITC on Jan. 16, 2025). The determination addressed Claims 1, 3, and 16 of the '654 Patent. EX1024, 65. The ITC found that the priority date of the '654 Patent is October 11, 2010. *Id.*, 65 (adopted by the ITC on Jan. 16, 2025). The ITC gave the terms of the '654 Patent their plain and ordinary meaning. *Id.*, 66, 76.

Before the ITC, Petitioner relied on only system art for its allegations of anticipation and obviousness. *Id.*, 71. Specifically, Petitioner argued that “the Asserted Claims of the '654 Patent are invalid as anticipated and obvious over the Panasonic [Lumix DMC-G2] Camera and the Samsung Galaxy S.” *Id.* Petitioner also argued the claims were directed to patent ineligible subject matter. *Id.*

With respect to the Panasonic Lumix DMC-G2, the ITC determined that the Panasonic camera anticipated claims 1 and 3 but not claim 16. *Id.*, 73-80 (adopted by the ITC on Jan. 16, 2025). For claim 16, the ITC found: “Respondents map brightness to the image capturing setting (“Brightness Mapping”), as required by that claim, but for that functionality the auto focus guide and the indicator do not appear simultaneously and so do not satisfy claim 3.” *Id.*, 73. The ITC observed that “[r]espondents do not explain how causing the auto focus guide to appear, then causing it to disappear to adjust the image capturing setting, then causing it to

reappear (admittedly at the same location), constitutes ‘maintaining’ the ‘displayed’ auto focus guide, that is, their argument and evidence do not give effect to those words in the claim.” *Id.*, 80.

For obviousness, the ITC determined that claims 1 and 16 would have been obvious over the Panasonic Lumix DMC-G2, but not claim 3. *Id.*, 87-88 (adopted by the ITC on Jan. 16, 2025). With respect to claim 3, the ITC determined that Respondents’ Brightness Mapping failed because Respondent “point[ed] to no expert opinion or other evidence that it would have been obvious to display both the auto focus guide and the shutter speed or aperture value indicator in response to the first touch input, or that it would have been obvious to adjust the focus area without changing the size of the auto focus guide.” *Id.*, 88.

The ITC also determined that Respondents did not show that the Samsung Galaxy S anticipates any asserted claims, or that claim 3 was obvious over the Samsung Galaxy S. *Id.*, 81.

IV. CLAIM CONSTRUCTION

The Board applies the *Phillips* claim construction standard used by the district courts. *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). Because Patent Owner does not believe that it is necessary for the Board to construe any claim terms to deny institution, for purposes of this preliminary response, Patent Owner assumes the claims to have their plain and ordinary meaning. *See Nidec Motor Corp.*

v. Zhongshan Broad Ocean Motor Co., 868 F.3d 1013, 1017 (Fed. Cir. 2017) (citing *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (“only those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy”)).

V. LEVEL OF ORDINARY SKILL IN THE ART

Solely for purposes of this Preliminary Response, Patent Owner has used Petitioner’s proposed definition of a person of ordinary skill in the art (“POSITA”). Petition, 4. Ericsson reserves the right to propose its own definition if this IPR is instituted.

VI. PETITIONER FAILS TO ESTABLISH A REASONABLE LIKELIHOOD THAT *PARK* AND *KIM* RENDER ANY CLAIM UNPATENTABLE (GROUND 1)

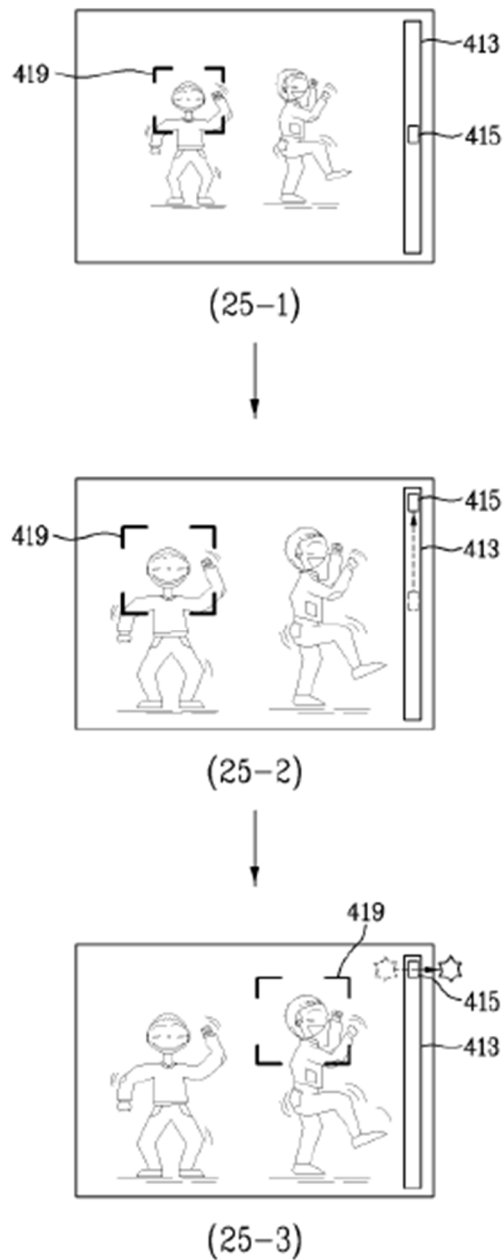
The Board should deny institution of Ground 1 because the Petition does not show a reasonable likelihood of prevailing with respect to any of the challenged claims. *See* 35 U.S.C. § 314(a) (the Board “may not authorize an inter partes review to be instituted unless . . . the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition”). The Petition alleges that the challenged claims are unpatentable over *Park* in view of *Kim* in Ground 1. Petition, 18-41. The challenge is deficient because Petitioner fails to establish a reasonable

likelihood that (1) *Park* or *Kim* teach limitation 1[h]; and (2) that a POSITA would have been motivated to combine *Park* and *Kim*.

A. Petitioner Fails to Establish a Reasonable Likelihood that 1[h] is Rendered Obvious by the Combination of *Park* and *Kim*.

Limitation 1[h] recites that the controller is configured to “control the touch screen to display an *indicator for indicating the current image capturing setting while maintaining the displayed auto focus guide at the specific point.*” EX1001, Claim 1 (emphasis added).

In Ground 1, Petitioner relies solely on *Park*’s Figure 25 and associated disclosure ¶[0228] as allegedly disclosing limitation 1[h]. Petition, 35-36. Specifically, Petitioner alleges that the “relative position of the box, number 415, on the scroll bar, number 413” is the “image capture setting indicator” and the “focus region indicator, labeled 419” is the displayed AFG. *Id.*



EX1005, Fig. 25. Petitioner's theory requires the position of the scroll bar to be the indicator for indicating the current image capturing setting. Petition, 35 ("As set forth above, a POSITA would have understood the relative position of the box, number 415, on the scroll bar, number 413, to be an image capture setting indicator

. . . .”); *id.*, 58 (“Because the position of the slide bar within the vertical rectangle indicates the size of the AF area, a POSITA would have understood the displayed position of the slide bar to indicate the current size of the AF area.”); *id.*, 77-78. Petitioner relies solely on this theory for limitation 1[h] in Ground 1; Petitioner does not advance any theory that the image capturing setting is brightness for Ground 1. *See id.*

Petitioner’s theory fails for two reasons: (1) *Park*’s scroll bar 415 does not teach or disclose an “indicator for indicating the current image capturing setting” as recited in limitation 1[h]; and (2) “control[ling] the touch screen” to display *Park*’s scroll bar 415 does not “maintain[] the displayed auto focus guide at the specific point” even under Petitioner’s interpretation of the “maintaining” limitation.

First, *Park*’s scroll bar 415 is not an indicator for an image capturing setting. *Park* discloses that the scroll 415 is an indicator for the size of the *preview image* displayed on the touch screen, not an indicator for the image capturing setting. For example, *Park* discloses:

As shown at 25-2 of FIG. 25, the scroll bar 415 is touched and dragged from bottom to top. Then, the preview image is enlarged. [T]he scroll bar 415 may also be configured to collapse the preview image when touched and dragged from bottom to top. Additionally, the scroll bar 415 may

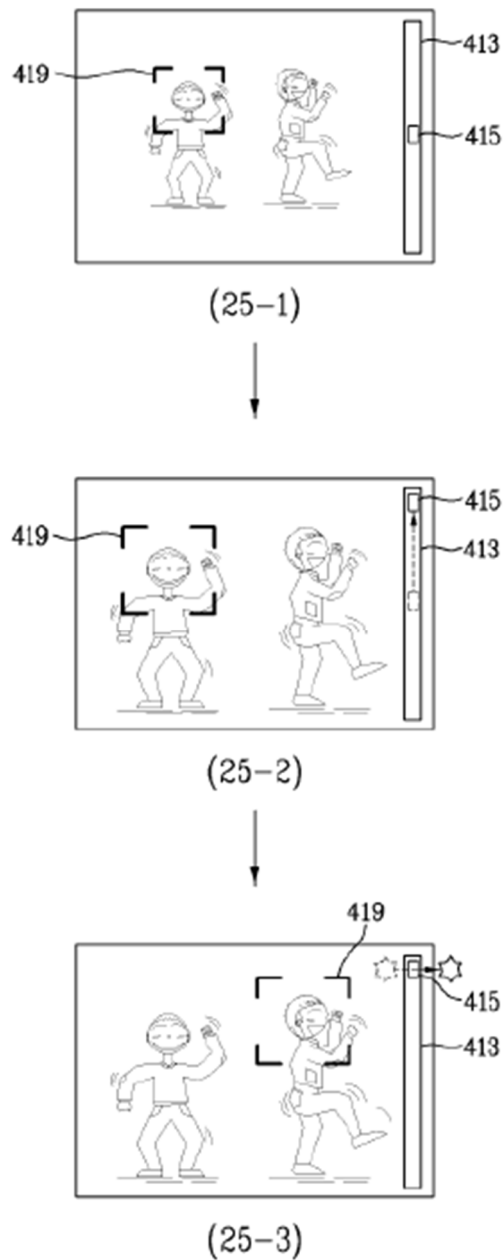
be configured to zoom in on the preview video when the scroll bar 415 is touched and dragged from top to bottom.

EX1005, ¶[0229]. As illustrated in Figure 25 above, Park does not disclose that dragging the scroll bar 415 up or down affects any setting by which the image is captured—it merely changes the size of the preview image displayed on the screen. *See id.* Petitioner admits that dragging the scroll bar 415 up or down merely “enlarges” or “collapses” *the preview image*. Petition, 36. In contrast to *Park*’s scroll bar 415 merely indicating the size of the displayed preview image, example embodiments of the ’654 Patent disclose indicating settings by which the image is captured, such as “indicating a degree to which the lens position is adjusted” in order to focus the camera lens. *See, e.g.*, EX1001, 19:47-20:18 (describing Figs. 22-23). Petitioner thus fails to show a reasonable likelihood that *Park* teaches or suggests an indicator for an image capturing setting as recited in limitation 1[h].

Second, *Park* fails to teach or suggest “control[ling] the touch screen to display an indicator for indicating the current image capturing setting while maintaining the displayed auto focus guide at the specific point.” Petitioner fails to expressly map limitation 1[h]’s requirement that the controller be configured to “control the touch screen to display” the recited image capturing setting indicator. *See* Petition, 35-36. Petitioner does not show—and cannot show—“control [of] the touch screen to display” *Park*’s alleged image capturing setting indicator scroll bar

415 “while maintaining the displayed auto focus guide at the specific point” as recited in limitation 1[h].

In the paragraph immediately following *Park*’s ¶¶[0228]-[0229] cited by Petitioner, and in Figure 25-3 selectively omitted by Petitioner from the Petition (*see* Petition, 35-36), *Park* discloses the opposite. *Park* expressly discloses that when a touch operation is performed on scroll bar 415, *Park*’s focus region indicator 419 moves. EX1005, ¶[0230] (“Next, a first touch operation or a second touch operation is performed on the scroll bar 415, as shown at 25-3 of FIG. 25. Then, the focus region indicator 419 *is moved* to correspond to the right person of the two people in the preview image.”). Specifically, the focus region indicator changes location from one person to the other person, as illustrated in Figure 25-3. *Id.*, ¶¶[0230]-[0231] (“Thus, the device user can easily adjust the focus *of the desired member of the picture* when taking the picture.”) & Fig. 25-3.



EX1005, Fig. 25-3.

Petitioner argues that “‘maintaining the displayed auto focus guide at the specific point’ requires only that the position of the AFG at the specific point be maintained.” Petition, 17. *Park* thus fails to teach or disclose “*control[ing] the touch*

screen to display an indicator for indicating the current image capturing setting *while maintaining the displayed auto focus guide at the specific point*” even under Petitioner’s view of the “maintaining” limitation.¹

This is further supported by the prosecution history of the parent ’168 Patent, where Applicant first introduced the limitation “while maintaining the displayed focus guide at the specific point” to distinguish cited prior art Higashino. *See supra*, § I.B.2. Higashino discloses both changing the location and the size of the focus area. *See id.* In its remarks, Applicant distinguished “movement of the AF frame” as taught by Higashino from the recited amendment “while maintaining the displayed focus guide at the specific point.” EX1019, 595-96.

Kim does not overcome these deficiencies, nor does Petitioner contend that it does. *See* Petition, 35-36. For other claim elements, Petitioner points to *Kim*’s Figures 9 and 12 as allegedly disclosing an auto focus guide at a specific point. *See* Petition, 27-29. But as illustrated in Figures 9 and 12 below, *Kim* does not disclose “control[ling] the touch screen to *display an indicator for indicating the current*

¹ Because Petitioner’s theory fails even under Petitioner’s interpretation of the “maintaining” limitation, Patent Owner does not believe that it is necessary for the Board to address any dispute regarding whether, *e.g.*, changing the size of the AFG is “maintaining” the AFG.

image capturing setting while maintaining the displayed auto focus guide at the specific point.”

FIG. 9



EX1007, Fig. 9.

FIG. 12

*Id.*, Fig. 12.

Petitioner accordingly fails to establish a reasonable likelihood that *Park* in combination with *Kim* teaches or discloses limitation 1[h].

B. Petitioner Fails to Establish a Reasonable Likelihood That a POSITA Would Have Been Motivated To Combine *Park* and *Kim* (Ground 1)

The Petition does not establish a reasonable likelihood that it would have been obvious to combine *Park* with *Kim* to “control the touch screen to display an auto focus guide at a specific point of the touch screen in response to a first touch input to the specific point” as recited in limitation 1[e].

Park teaches a different solution than what is recited in limitation 1[e]. Rather than touching “the specific point” where the auto focus guide is displayed on the touch screen, *Park* discloses touching a scroll bar to move the auto focus guide. EX1005, ¶¶[230]-[231].

The Petition asserts that *Park* modified by *Kim* renders claim element 1[e] obvious. Specifically, the Petition’s proposed combination requires modifying the scroll bar of *Park* “to move the AFG with *Kim*’s touch on the preview image.” Petition, 31-32. However, the Petition fails to specifically identify how *Park*’s scroll bar would be modified to result in “control[ling] the touch screen to display an auto focus guide at a specific point of the touch screen in response to a first touch input to the specific point” as recited in limitation 1[e]. *See id.*

The Petition also fails to specifically identify the reasons why a POSITA would make the specific modifications. *See id.* For example, the Petition fails to explain why a POSITA would have been motivated to incorporate *Kim*’s solution of touching the screen at “the specific point” to display the auto focus guide when *Park* already includes displaying the auto focus guide with a scroll bar solution. *See id.* As the Petition admits, *Park*’s technology “implicitly requires face recognition,” rendering *Kim*’s solution of touching the screen at the specific point redundant and unnecessary, and needlessly clunky. *See id.*, 31-32.

The Petition instead relies on only improper hindsight reconstruction to allege that a POSITA would have modified the teachings of *Park* with *Kim* to perform the functionality from limitation 1[e]. See *Opticon Medical AB v. Cochlear Ltd.*, IPR2019-00975, Paper 52, *29-30 (PTAB Oct. 14, 2020) (determining that “Petitioner’s proposed combination is based on improper hindsight and that Petitioner has not persuasively proven its stated rationale for [the proposed modification]”). Specifically, the Petition borrows the rationale of the ’654 Patent—convenience—to argue that “[a] POSITA would have been motivated to substitute the first or second touch operation on the scroll bar of *Park* to move the AFG with *Kim*’s touch on the preview image, to make a device that allows a user to conveniently adjust the settings of an image during the capturing of the image.” Petition, 31-32; see also EX1001, 1:63-67 (Patent describing “conveniently and efficiently” controlling the camera when taking a photograph). The Petition’s argument for “convenience” and “simplicity” is merely hindsight bias that does not sufficiently identify or address why a POSITA would have made the specific modifications necessary to the teachings of *Park* and *Kim* to perform the functionality of limitation 1[e].

Nor does Petitioner demonstrate a reasonable expectation of success when *Park* does not disclose touching objects in the preview image directly, but rather through the use of scroll functions and menus. EX1005, ¶¶[0108]-[0114], [0119-

0125], [0228]-[0235]. *Park* and *Kim* involve completely different focusing technologies, with *Kim* implementing a touch-to-focus technology and *Park* implementing an auto focusing technology, as Petitioner's expert recognizes. EX1002, ¶[0088].

VII. PETITIONER FAILS TO ESTABLISH A REASONABLE LIKELIHOOD THAT *PANASONIC* RENDERS ANY CLAIM UNPATENTABLE ALONE OR IN COMBINATION (GROUNDS 2 AND 3)

In Grounds 2 and 3, Petitioner relies on *Panasonic* for all challenged claims. Petition, 3, 41-68, 74-78. Grounds 2 and 3 should be rejected at the outset, because Petitioner has failed to demonstrate that *Panasonic* (EX1008) qualifies as prior art.

Petitioner bears the burden “to identify with particularity evidence sufficient to establish a reasonable likelihood that the reference was publicly accessible before the critical date of the challenged patent, and therefore that there is a reasonable likelihood that it qualifies as a printed publication.” *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29, *16 (PTAB Dec. 20, 2019) (precedential). Public accessibility requires more than technical accessibility. *Id.* (citing *Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 773 (Fed. Cir. 2018)).

Petitioner provides a single sentence in its Petition arguing that *Panasonic* qualifies as prior art: “*Panasonic* was published prior to October 11, 2010 and is

prior art at least under pre-AIA 35 U.S.C. § 102(a). *See generally* EX1020.” Petition, 2-3 (assuming a priority date of October 11, 2010). The only evidence that Petitioner identifies in its Petition to support its assertion is a declaration of its PTAB counsel, Sima Lotfi (EX1020). *Id.*²

Petitioner has not met its burden to establish a reasonable likelihood that *Panasonic* (EX1008) qualifies as a prior art printed publication to the '654 Patent. As a threshold matter, the Board should disregard the attorney declaration of Petitioner's own PTAB counsel (EX1020) as improperly skirting the page limits by improper incorporation by reference, and as lacking personal knowledge and offering improper expert opinion. Even if considered, this evidence fails to establish a reasonable likelihood that *Panasonic* (EX1008) qualifies as prior art. And the WayBackMachine affidavit (EX1021) that Petitioner submits as an exhibit but fails to cite in its Petition or in its attorney declaration, does not compel a different result.

² Although Petitioner does not identify the 2010 copyright date on the face of *Panasonic* in its Petition (*see* EX1008, 220), and even if that copyright date was accurate and not hearsay, that copyright date nonetheless is insufficient to meet Petitioner's burden because it does not reveal whether *Panasonic* was publicly accessible before or after *October* of 2010.

A. The Board Should Decline to Consider EX1020.

The sole evidence that Petitioner identifies in its Petition to support its assertion that *Panasonic* qualifies as prior art is a “see generally” citation to the declaration of its own PTAB counsel (EX1020). Petition, 3. The attorney declarant opines that the “*Panasonic* manual was publicly available in the United States no later than May 29, 2010, when the DMC-G2 was on sale, and publicly available for download no later than July 10, 2010.” EX1020, ¶ 23. The declarant, Petitioner’s PTAB counsel, does not establish personal knowledge of these facts, nor does she establish that she is qualified as an expert to opine on matters of public accessibility of prior art printed publications. *See id.*

Petitioner fails to reproduce any of the arguments, evidence, or rationale presented in the declaration of its own PTAB counsel into its Petition. *Compare* EX1020 (citing, for example, EX1010-1017) *with* Petition, 3. This equates to improper incorporate by reference. 37 C.F.R. § 42.6(a)(3). The Board should reject Petitioner’s attempts to skirt the Board’s rules, including the Word limit, by setting forth evidence and analysis in an attorney declaration instead of in the Petition. *See, e.g., General Access Solutions v. Sprint Spectrum L.P.*, 811 F. App’x 654, 658-59 (Fed. Cir. 2020) (affirming the Board’s decision to decline to consider a declaration and accompanying claim chart as improperly incorporated by reference where Patent

Owner included its substantive arguments and analysis in the declaration and claim chart and made only “general allegation[s]” in its Patent Owner Response).

Like the Patent Owner Response in *General Access*, here, the Petition “makes only the general allegation” that *Panasonic* qualifies as prior art, and “fails to explain with any specificity” how or why it so qualifies, instead attempting to incorporate by reference the evidence and analysis set forth in a declaration. *See* Petition, 3. Here, Petitioner’s violation is even more egregious than that of the Patent Owner in *General Access*, because Petitioner attempts to dodge the page limits by submitting its analysis not just in a declaration of a witness like in *General Access* but in a declaration of its own PTAB counsel. *See id.* Petitioner here also fails to even cite directly in its Petition the evidence (EX1010-1017) discussed in that attorney declaration. *See id.*

The Board should thus decline to consider EX1020 and EX1010-1017 discussed therein. *General Access Solutions*, 811 F. App’x at 658; *see also Universal Imaging Indus., LLC v. Lexmark Int’l, Inc.*, IPR2019-01387, Paper 9, *10 (PTAB May 4, 2020) (Board rejected claim analysis presented solely in Petitioners’ expert declaration instead requiring the evidence be shown with “particularity in the Petition”); 37 C.F.R. § 42.6(a)(3). Petitioner thus has failed to identify particular evidence establishing a reasonable likelihood that *Panasonic* qualifies as a prior art printed publication. *See Hulu*, *16.

B. Even if the Board Considers EX1020, Petitioner Fails to Meet its Burden.

Even if considered, none of Petitioner’s evidence establishes a reasonable likelihood that the substantive contents of *Panasonic* (EX1008) relied on by Petitioner to challenge the ’654 Patent claims was publicly available before October 11, 2010. *See id.*

First, the attorney declarant improperly conflates the public accessibility of the manual with the alleged sale of the camera itself, the latter of which is not an issue before the Board. EX1020, ¶¶ 17-19 (relying on EX1010-1015, EX1018).³ The attorney declarant provides no testimony or evidence that the manual allegedly published “[a]t or around the same time the DMC-G2 was released for sale” or allegedly “included in the box with the DMC-G2 camera when sold” is the particular manual relied on by Petitioner as EX1008, or contains the substantive content relied on by Petitioner to challenge the ’654 Patent claims. *See id.* For example, EX1008 identifies version number VQT2S30 on its cover, but the documents cited by the attorney declarant (EX1010-1015 and EX1018) do not identify any version number.

³ Before the ITC, the prior art relied on by Petitioner for its §§ 102 and 103 grounds was the alleged prior art system camera, not the manual (EX1008) as an alleged standalone printed publication, as Petitioner asserts here.

Compare EX1010-1015, 1018 *with* EX1008, 1. And the attorney declarant does not establish that her allegations are based on her personal knowledge—for example, she does not testify that she personally accessed the manual in the box or accessed an alleged publication of the manual before October 11, 2010. *See id.* The webpages and press releases allegedly showing sales activities of an unknown version of the Panasonic DMC-G2 *camera* thus are not sufficient to show that the *manual* for version VQT2S30 of the camera relied on by Petitioner as EX1008 was publicly accessible at the relevant time. *Accord ServiceNow, Inc. v. Hewlett-Packard Co.*, IPR2015-00716, Paper 13, *19 (PTAB Aug. 25, 2015) (“Thus, on this record, we are not persuaded that Petitioner demonstrates that the press releases (Exs. 1011 and 1013) discussing activities of BEA Systems, Inc. are sufficient to show a reasonable likelihood that Exhibits 1004-1006 were publicly accessible more than one year prior to May 14, 2003.”).

Next, the attorney declarant discusses two webpages to opine that *Panasonic* was “publicly available for download no later than July 10, 2010.” EX1020, ¶¶ 20-22. But the Board has distinguished evidence showing that a download webpage was available from evidence showing that the contents of the alleged prior art publication was publicly available. *See, e.g., id.*, *12-14. For example, in *ServiceNow*, the Petitioner relied on a WayBackMachine archive to show that a download page

allegedly containing a link to a document was available by a certain date. *Id.*, *12-

14. The Board found:

Petitioner fails to make the critical link between the alleged identification of the Collaborate References on the ‘download page’ and the exhibits relied upon in support of the asserted grounds. Despite Petitioner’s arguments and assertion that this “page” was publicly accessible “by no later than August 19, 2001,” Petitioner fails to demonstrate Exhibits 1004-1006, which Petitioner relies upon in support of each of the asserted grounds, were publicly accessible through the webpages included in Exhibit A to the Butler Affidavit more than one year prior to May 14, 2003. *See* Pet. 21; EX 1002 ¶ 205.

Id., *14.

Similarly, here, Petitioner fails to make the “critical link” between the alleged identification of a manual on certain webpages and the manual relied on as EX1008. *See id.* As a threshold matter, Petitioner fails to provide sufficient evidence that EX1016 or EX1017 were archived at the July 2010 dates alleged. EX1020, ¶¶ 20-22. While Petitioner provides a WayBackMachine affidavit for other exhibits, that affidavit does not address when EX1016 or EX1017 were archived. *See* EX1021. The attorney declarant fails to establish that she is an expert qualified to offer opinions that EX1016 or EX1017 were archived on the July 2010 dates alleged, or

that she has personal knowledge of when they were archived or accessible, for example by having personally accessed the webpages in July 2010. EX1020, ¶¶ 20-22; *see ServiceNow*, *18 (recognizing that the declarant “does not testify that he downloaded [the alleged prior art] from the download page before [the relevant date] or that he is aware of anyone who did”) (citing *Dish Network L.L.C. v. Dragon Intellectual Property, LLC*, IPR2015-00499, Paper 7, *10-11 (PTAB July 17, 2015)). Additionally, similar to EX1010-1015 and EX1018 discussed above, EX1016 does not identify any version number of the DMC-G2 camera linking it to the VQT2S30 version listed on the face of EX1008. *Compare* EX1016 *with* EX1008, 1.

Moreover, Petitioner fails to offer any evidence or testimony that the contents of EX1008 relied on to challenge the '654 Patent were publicly accessible before October 11, 2010. Petitioner cites pages 1, 14-16, 40, 59, 78-80, 82, 94-98, and 106-107 of EX1008 in its Petition, yet fails to offer any evidence or testimony showing that the contents of those cited pages were publicly accessible before October 11, 2010. The attorney declarant points to pages 179-180 reproduced in EX1017, but those pages are in an entirely different section of the manual. EX1020, ¶¶ 21-22. Petitioner primarily relies on pages in the “Advanced (Recording Pictures)” section of EX1008 to challenge the '654 Patent, yet pages 179-180 are in an “Other Features” section in a different portion of the manual. *See* EX1008, 6-8.

C. Petitioner's WayBackMachine Affidavit (EX1021) Does Not Compel a Different Result.

Petitioner also submits as an exhibit a WayBackMachine affidavit (EX1021), but fails to cite that affidavit *anywhere* in its Petition or in its attorney declaration. *See* Petition, 3 & EX1020. Petitioner accordingly has not identified the WayBackMachine affidavit (EX1021) with particularity in its Petition as evidence supporting its allegations. 35 U.S.C. § 312(a). To the extent Petitioner refers to this affidavit at all, for the same reasons explained above, the Board should decline to consider the WayBackMachine affidavit as an improper incorporation by reference. *See supra*, § VII.A.

Even if considered, the WayBackMachine affidavit (EX1021) also is not sufficient evidence establishing a reasonable likelihood that *Panasonic* qualifies as a prior art printed publication. The affidavit does not show that the version and contents of *Panasonic* relied on by Petitioner was publicly accessible before October 11, 2010. EX1021. None of the links in the affidavit link to the actual manual submitted as EX1008 relied on by Petitioner to challenge the '654 Patent. *Id.* At best, the WayBackMachine affidavit shows when certain webpages showing sales activity for the Panasonic camera were archived, not when the Panasonic manual relied on as EX1008 was publicly accessible. *See ServiceNow*, *13-14 (“Despite Petitioner’s arguments and assertion that this ‘page’ was publicly accessible ‘by no later than

August 29, 2001,’ Petitioner fails to demonstrate Exhibits 1004-1006, which Petitioner relies upon in support of each of the asserted grounds, were publicly accessible through the webpages included in Exhibit A to the Butler Affidavit for more than one year prior to [the relevant date].”).

Rather, accessing the manual submitted as EX1008 through the WayBackMachine reveals an archive date of November 25, 2011, more than one year after October 11, 2010. EX2002 (bearing an archive date of November 11, 2025); EX1021 ¶ 5 (explaining how the URL indicates the archive date). Thus, similar to *ServiceNow*, the Internet Archive reflects capture dates for the *Panasonic* manual relied on as EX1008 that post-dates the application date. *See ServiceNow*, *14-15.

For all of these reasons, Petitioner fails to establish a reasonable likelihood that Panasonic (EX1008) qualifies as a prior art printed publication. Petitioner relies on *Panasonic* for all claims of Grounds 2 and 3. Petition, 3, 41-68, 74-78. Petitioner accordingly has not demonstrated a reasonable likelihood of success for Grounds 2 and 3.

VIII. CONCLUSION

For at least the foregoing reasons, Patent Owner respectfully requests that the Board decline to institute *inter partes* review of the ’654 Patent.

Respectfully submitted,

BAKER BOTTS L.L.P.

A handwritten signature in black ink, appearing to read "Chad C. Walters". The signature is fluid and cursive, with the first name "Chad" being more prominent.

Chad C. Walters (Reg. No. 48,022)

Lead Counsel for Patent Owner

Date: January 30, 2025

2001 Ross Ave., Suite 900

Dallas, TX 75201-2980

Phone: (214) 953-6511

Fax: (214) 661-4511

chad.walters@bakerbotts.com

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), the undersigned hereby certifies that the foregoing Preliminary Response has a word count under 37 C.F.R. § 42.24(b)(1) of 6,211, within the 14,000 word limit allowed under § 42.24(a)(1)(i).

BAKER BOTTS L.L.P.

A handwritten signature in black ink, appearing to read "Chad C. Walters", written in a cursive style.

Chad C. Walters (Reg. No. 48,022)
Lead Counsel for Patent Owner

Date: January 30, 2025

CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. § 42.6(e), the undersigned certifies that on January 30, 2025, a complete and entire copy of this PATENT OWNER'S PRELIMINARY RESPONSE and Exhibits 2001-2002 was served on Petitioner via electronic mail at the following addresses:

dmelwani@boncip.com

jma@bomcip.com

slotfi@bomcip.com

docketing@bomcip.com

BAKER BOTTS L.L.P.



Chad C. Walters (Reg. No. 48,022)
Lead Counsel for Patent Owner

Date: January 30, 2025

2001 Ross Ave., Suite 900

Dallas, TX 75201-2980

Phone: (214) 953-6511; Fax: (214) 661-4511

chad.walters@bakerbotts.com