

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARASHI VISION (U.S.) LLC (D/B/A
INSTA360),
Petitioner,

v.

GOPRO, INC.,
Patent Owner.

Case No. IPR2025-00017
U.S. Patent No. 10,529,052

**PATENT OWNER'S SUPPLEMENTAL BRIEF IN SUPPORT OF
DISCRETIONARY DENIAL UNDER 35 U.S.C. §314(a) AND *FINTIV***

I. INTRODUCTION

Pursuant to the Board’s authorization, Patent Owner GoPro, Inc. respectfully submits this supplemental brief in support of discretionary denial under 35 U.S.C. § 314(a) and *Fintiv*.

On February 28, 2025, the USPTO rescinded its June 21, 2022, memorandum entitled “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation.” Subsequently, on March 24, 2025, the Office issued guidance clarifying that, following the rescission, the Board will apply the precedential *Fintiv* and *Sotera* decisions to parallel proceedings, including those before the ITC.

Here, the ITC trial has already occurred—and the ITC will decide the *identical grounds of invalidity* raised in the Petition. The ITC’s initial determination is expected on May 8, 2025, and the target date for completion of the investigation is September 8, 2025, more than seven months before the expected due date for the Board’s final written decision. Thus, institution would lead to unnecessary duplication and the potential for inconsistent results.

All six *Fintiv* factors support discretionary denial.

II. THE PETITION PRESENTS THE SAME INVALIDITY GROUNDS ALREADY BEING DECIDED BY THE ITC

The Petition challenges claims 1-20 of the '052 Patent on the following obviousness grounds: (1) Okubo; (2) Okubo in combination with Sokeila; and (3) Eder. In the ITC trial that already occurred, the Petitioner challenged asserted claims 1, 2, 5 and 6 on the *identical grounds*.

The Office's March 2025 guidance specifically notes that the Board is "more likely to deny institution where the ITC's projected final determination date is earlier than the Board's deadline to issue a final written decision" (March 2025 memo at 2). And prior to the Office's June 2022 memorandum, the Board repeatedly denied institution under *Fintiv* in view of advanced stage ITC proceedings, including where the ITC hearing had already occurred. *See, e.g.,*:

- IPR2020-00754, Paper 11 at 7 (denying institution where ITC trial already occurred, and target date was four months before due date for written decision);
- IPR2020-01197, Paper 13 at 12 (denying institution where ITC trial already occurred, and target date was five months before due date for written decision);
- IPR2021-00264, Paper 11 at 10-11 (denying institution where the hearing was "currently underway," and target date was eight months before due date for final written decision);
- IPR2021-00794, Paper 14 at 19-21 (denying institution where ITC trial already occurred, and target date was seven months before due date for final written decision).

In addition to these illustrative examples, the Board has denied institution under *Fintiv* in numerous other proceedings, citing to the advanced stage of parallel ITC investigations, including, *e.g.*: IPR2019-00567; IPR2019-00568; IPR2020-00800; IPR2020-00968; IPR2020-00981; IPR2020-00982; IPR2020-00987; IPR2020-00991; IPR2020-00992; IPR2020-01036; IPR2020-01239; IPR2020-01240; IPR2020-01317; IPR2021-00328; IPR2021-00661; IPR2021-01578; and IPR2022-00132.

Most recently, the Acting Director vacated institution in four proceedings despite a *Sotera* stipulation and a parallel district court case that had been stayed by the court, emphasizing that the Board “did not give enough weight to the investment in the parallel proceeding” and that such an approach “misapprehends the relevant inquiry” under *Fintiv. Motorola Solutions Inc. v. Stellar LLC*, IPR2024-01205, -01206, -01207, -01208, Paper 19 at 2-3 (Director Review, Mar. 28, 2025). That reasoning applies with even greater force here, where the ITC trial has already occurred, and an initial determination is imminent.

These decisions confirm that where, as here, an advanced-stage ITC proceeding—particularly one involving identical grounds—has a target date well before the Board’s expected due date for a final written decision,

discretionary denial is not only appropriate but fully consistent with longstanding Board precedent.

III. ALL *FINTIV* FACTORS SUPPORT DISCRETIONARY DENIAL

Factor 1: Likelihood of Stay in the ITC. The ITC proceeding is not subject to a stay. The district court case is automatically stayed pursuant to 28 U.S.C. § 1659. *This factor supports denial.*

Factor 2: Proximity of ITC trial date to PTAB's Written Decision. The ITC hearing concluded in January 2025. The ALJ's initial determination is expected on May 8, 2025, and the target date for completion of the investigation is September 8, 2025—seven months before the PTAB's expected final written decision in April 2026. *This factor strongly supports denial.*

Factor 3: Investment in the ITC proceeding. Both parties and the ITC have invested substantial resources. The record includes expert testimony, claim construction, post-hearing briefing, and fully developed invalidity positions. *This factor strongly supports denial.*

Factor 4: Overlap of issues between the ITC and IPR. Petitioner raises the *identical grounds* to challenge the '052 Patent in both proceedings: Okubo, Okubo with Sokeila, and Eder. These grounds are asserted against claims 1, 2, 5, and 6 in both proceedings. While the Petition challenges

additional claims, it asserts the same invalidity grounds against the same four claims already tried in the ITC. The direct overlap, coupled with the ITC's advanced stage, weighs heavily in favor of denial. *This factor strongly supports denial.*

Factor 5: Whether the Parties Are the Same. The parties are the same in both proceedings. *This factor supports denial.*

Factor 6: Other Considerations, Including the Merits. As set forth in Patent Owner's Preliminary Response, the Petition suffers from significant substantive flaws. *This factor supports denial.*

IV. CONCLUSION

For the foregoing reasons, GoPro respectfully requests that the Board deny institution under 35 U.S.C. § 314(a) and *Fintiv*.

Date: April 3, 2025

By: /s/ James Glass

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CERTIFICATE OF LENGTH (37 C.F.R. §§ 42.24)

The undersigned hereby certifies that this document is 5 pages and thus complies with the Board's authorized page limit.

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CERTIFICATE OF SERVICE (37 C.F.R. §§ 42.6(E), 42.105(A))

The undersigned hereby certifies that the foregoing document was served on April 3, 2025 upon the following parties via Electronic Mail:

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