

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TCL ELECTRONICS HOLDINGS LTD.
(f/k/a TCL MULTIMEDIA TECHNOLOGY HOLDINGS, LTD.)

Petitioner,

v.

MAXELL, LTD.,
Patent Owner

Case: IPR2025-00134

U.S. Patent No. 10,650,780

**PATENT OWNER PRELIMINARY RESPONSE TO PETITION FOR
INTER PARTES REVIEW OF U.S. PATENT NO. 10,650,780**

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Claim Construction Order
2002	Nozaki (U.S. Patent Publication No. 2004/0150724)
2003	Koike (U.S. Patent Publication No. 2008/0180551)
2004	Docket Control Order
2005	First Amended Docket Control Order
2006	Invalidity Contentions

LISTING OF CHALLENGED CLAIMS¹

Claim Element	Claim Text
Claim 1 Preamble	1. An image display apparatus, comprising:
[1A]	Universal Serial Bus (USB) interface circuitry configured to receive compressed first image information from a digital camera over a USB cable;
[1B]	wireless LAN interface circuitry configured to wirelessly receive compressed second image information from the digital camera over a network;
[1C]	a decoder configured to decode the compressed first image information received by the USB interface circuitry or the compressed second image information received by the wireless LAN interface circuitry; and
[1D]	a display screen configured to display at least one of first images based on decoded the first image information and second images decoded the second information obtained by the decoder,
[1E]	wherein if displaying the first images on the display screen, based on an operation on the input device of the image display apparatus for conducting a slide show,
[1F]	the USB interface circuitry transmits, over the USB cable, a first signal to the digital camera for causing the digital camera to output compressed first image information corresponding to first still pictures, and receives, over the cable, the compressed first image information corresponding to first still pictures output from the digital camera,
[1G]	the decoder decodes the compressed first image information corresponding to first still pictures received by the USB interface circuitry, and
[1H]	the display screen displays a slide show at predetermined time

¹ For convenience purposes only, Patent Owner adopts for this Preliminary Response a similar numbering of claim elements advanced by Petitioner in the Petition. Patent Owner does not concede the appropriateness of such grouping and numbering of claim elements.

Claim Element	Claim Text
	intervals with the first still pictures, as the first images, based on the decoded first image information obtained by the decoder, and
[1I]	wherein if displaying the second images on the display screen, based on an operation on the input device of the image display apparatus for conducting a slide show,
[1J]	the wireless LAN interface circuitry wirelessly transmits, over the network, a second signal to the digital camera for causing the digital camera to output compressed second image information corresponding to second still pictures, and wirelessly receives, over the network, the compressed second image information corresponding to second still pictures output from the digital camera,
[1K]	the decoder decodes the compressed second image information corresponding to second still pictures received by the wireless LAN interface circuitry, and
[1L]	the display screen displays a slide show at predetermined time intervals with the second still pictures, as the second images, based on the decoded second image information obtained by the decoder.
Claim 2	The image display apparatus according to claim 1, wherein the predetermined time intervals for the slide show for the first still pictures or the predetermined time intervals for the slide show for the second still pictures can be changed by an operation on the input device of the image display apparatus.
Claim 3	The image display apparatus according to claim 1, wherein the input device of the image display apparatus is a remote controller of the image display apparatus.
Claim 4	The image display apparatus according to claim 1, wherein the first image information received by the USB interface circuitry from the digital camera and the second image information received by the wireless LAN interface circuitry from the digital camera are compressed in JPEG format.
Claim 5 Preamble	The image display apparatus according to claim 1, further comprising:
[5A]	a decryptor,
[5B]	wherein the first image information from digital camera or the second image information from digital camera is encrypted,

Claim Element	Claim Text
	and
[5C]	the decryptor decrypts the encrypted first image information from digital camera or the encrypted second image information from digital camera.
Claim 6	The image display apparatus according to claim 1 is a television display apparatus for receiving and displaying a digital television broadcast program.
Claim 7 Preamble	The image display apparatus according to claim 1, further comprising:
[7A]	a resizing processor configured to change a number of horizontal pixels and/or a number of vertical lines of the first still pictures or the second still pictures to be displayed.
Claim 8 Preamble	The image display apparatus according to claim 1, further comprising:
[8A]	an effect addition processor configured to add a predetermined effect to the first still pictures or the second still pictures to be displayed.
Claim 9	The image display apparatus according to claim 1, wherein the wireless LAN interface circuitry wirelessly transmits, over the network, second signal with address information of the digital camera on the network to the digital camera.
Claim 10	The image display apparatus according to claim 9, wherein the address information of the digital camera on the network is IP address of the digital camera.
Claim 11 Preamble	The image display apparatus according to claim 1, further comprising:
[11A]	a sound outputting apparatus configured to output sound during the display screen displays the slide show.
Claim 13 Preamble	The image display apparatus according to claim 1, further comprising:
[13A]	a demodulator,
[13B]	wherein the wireless LAN interface circuitry receives a radio signal including the compressed second image information which is modulated by a predetermined modulation method, and
[13C]	the demodulator demodulates the radio signal received by the wireless LAN interface circuitry based on the predetermined modulation method.

Claim Element	Claim Text
Claim 15 Preamble	An image display apparatus, comprising:
[15A]	Universal Serial Bus (USB) interface circuitry configured to receive compressed first image information from a portable video processing apparatus over a USB cable;
[15B]	wireless LAN interface circuitry configured to wirelessly receive compressed second image information from the portable video processing apparatus over a network;
[15C]	a decoder configured to decode the compressed first image information received by the USB interface circuitry or the compressed second image information received by the wireless LAN interface circuitry;
[15D]	a resizing processor; and a display screen,
[15E]	wherein at least in the state that the USB interface circuitry connects with the portable video processing apparatus over the USB cable, based on an operation on the input device of the image display apparatus for conducting a slide show,
[15F]	the USB interface circuitry transmits, over the USB cable, a first signal to the portable video processing apparatus for causing the portable video processing apparatus to output compressed first image information corresponding to first still pictures, and receives, over the cable, the compressed first image information corresponding to first still pictures output from the portable video processing apparatus,
[15G]	the decoder decodes the compressed first image information corresponding to first still pictures received by the USB interface circuitry,
[15H]	the resizing processor resizes the first still pictures by changing a number of horizontal pixels and/or a number of vertical lines of the first still pictures obtained by the decoder, and
[15I]	the display screen displays a slide show at predetermined time intervals with the resized first still pictures, and
[15J]	wherein at least in the state that the wireless LAN interface circuitry connects with the portable video processing apparatus over the network, based on an operation on the input device of the image display apparatus for conducting a slide show,

Claim Element	Claim Text
[15K]	the wireless LAN interface circuitry wirelessly transmits, over the network, a second signal to the portable video processing apparatus for causing the portable video processing apparatus to output compressed second image information corresponding to second still pictures, and wirelessly receives, over the network, the compressed second image information corresponding to second still pictures output from the portable video processing apparatus, and
[15L]	the decoder decodes the compressed second image information corresponding to second still pictures received by the wireless LAN interface circuitry,
[15M]	the resizing processor resizes the second still pictures by changing a number of horizontal pixels and/or a number of vertical lines of the second still pictures obtained by the decoder, and
[15N]	the display screen displays a slide show at predetermined time intervals with the resized second still pictures.
Claim 16	The image display apparatus according to claim 15, wherein the portable video processing apparatus is a cellular phone.
Claim 17	The image display apparatus according to claim 15, wherein the portable video processing apparatus is a game machine.
Claim 18	The image display apparatus according to claim 15, wherein the portable video processing apparatus is a digital camera.
Claim 19	The image display apparatus according to claim 15, wherein the wireless LAN interface circuitry is capable of connecting internet and receiving internet content.
Claim 20 Preamble	A method for displaying slide show on a television display apparatus using still pictures from digital camera, comprising step of:
[20A]	establishing, by USB interface circuitry, a connection with a digital camera over a USB cable;
[20B]	transmitting, over the USB cable, a first signal to the digital camera in response to a first user's operation regarding to slide show on a remote controller of the television display apparatus;
[20C]	receiving, over the USB cable, first still pictures output from the digital camera in response to the first signal, the first still pictures are compressed;

Claim Element	Claim Text
[20D]	decoding the received first still pictures;
[20E]	resizing the decoded first pictures by changing a number of horizontal pixels and/or a number of vertical lines of the decoded first still pictures;
[20F]	displaying a slide show at predetermined time intervals with the resized first still pictures;
[20G]	establishing, by wireless LAN interface circuitry, a connection with the digital camera over a network;
[20H]	wirelessly transmitting, over the network, a second signal with IP address of the digital camera to the digital camera in response to a second user's operation regarding to slide show on the remote controller of the television display apparatus;
[20I]	wirelessly receiving, over the network, second still pictures output from the digital camera in response to the second signal, the second still pictures are compressed;
[20J]	decoding the received second still pictures;
[20K]	resizing the decoded second still pictures by changing a number of horizontal pixels and/or a number of vertical lines of the decoded second still pictures; and
[20L]	displaying a slide show at predetermined time intervals with the resized second still pictures.

I. INTRODUCTION

Patent Owner Maxell, Ltd. (“Patent Owner”) respectfully requests that the Board deny institution because Petitioner TCL Electronics Holdings Ltd. (hereinafter “Petitioner” or “TCL”) has failed to demonstrate a reasonable likelihood of success on the grounds submitted in its Petition for challenging the patentability of claims 1-11, 13, 15-20 (the “challenged claims”) of U.S. Patent No. 10,650,780 (“the ’780 Patent”).

First, the Board should exercise its discretion pursuant to any of 35 U.S.C. §§ 314(a) and 325(d) and deny the Petition. Denial under 35 U.S.C. § 325(d) is appropriate because the Petition argues the same or substantially the same art and arguments previously presented and considered by the U.S. Patent & Trademark Office (“Office”), and fails to demonstrate that the Office erred in a manner material to the patentability of the challenged claims. Moreover, application of the *Fintiv* factors weigh in favor of denying institution and Petitioner’s stipulation is limited by timing and application such that it does not overcome the strong evidence that institution should be discretionarily denied under *Fintiv*.

Second, none of the cited references alone or in combination disclose or suggest the arrangement of each limitation of claims 1-11, 13, 15-20. Moreover, the Petition is filled with conclusory statements that fail to demonstrate a reasonable likelihood of success on any ground and are neither bolstered nor supported by Dr.

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Patent Owner Preliminary Response

Andrew Wolfe’s declaration, which simply parrots Petitioner’s conclusions without additional analysis or evidence. *See* 37 C.F.R. §42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”).

For at least these reasons, Petitioner has failed to meet its burden of showing a reasonable likelihood of prevailing. Accordingly, the Board should deny Petitioner’s request to institute *inter partes* review.

II. BACKGROUND

A. Overview of the ’780 Patent

The ’780 Patent, entitled “Display Apparatus,” is generally directed to improving operability of slide show image displays and their connected portable external devices (*e.g.*, digital cameras) and viewing images from portable external devices. *See* ’780 Patent at Abstract, 2:20-26.

Prior to the ’780 Patent, image display apparatuses, such as televisions, were not capable of seamlessly handling the different requirements between image interface circuitry and networks in order to received image information from different sources and in different manners in a uniform interface. The IEEE 1394 standard, the HDMI standard, the Universal Serial Bus (USB) standard, and different network standards used by local area networks (LAN) and wireless networks, have different requirements and limitations, and therefore created various problems of

interoperability and source switching for implementation in a single digital apparatus and uniform interface. *See id.* 1:58-2:6. For example, as explained in the '780 Patent, in the HDMI system, a baseband signal of an uncompressed high definition picture signals and audio signals are transmitted, and an apparatus which received the transmitted high definition picture signal does not record the received signal. *See id.* 1:46-2:5. Such interface is also capable of higher bandwidth and therefore may be subjected to different encryption processing such as High-Bandwidth Digital Content Protection (HDCP). *See id.* 1:46-54. On the other hand, the USB circuitry and LAN and wireless interfaces transmit still pictures as compressed picture information, but do so in different ways with their own set of requirements and limitations (such as bandwidth limitations), transmitted via a cable versus wirelessly. *See* 1:58-2:34. In addition to these interoperability issues, these dissimilarities also created difficulties in providing a single user interface for those devices. *See id.*

The asserted claims of the '780 Patent provide improvements over the prior art by the unconventional use of a first signal, a second signal, and a predetermined time interval, to conduct and display a slide show in a specific manner with one user interface, supporting images received by dissimilar interface circuitry, such as from USB and wireless LAN interfaces, and thus solving these conventional issues of interoperability and source switching in image display devices. More specifically, the claimed "first signal," "second signal," and "predetermined time interval" allow

the image display apparatus to better switch and interact with external image devices (e.g., digital cameras) connected through the distinct circuitry required by the claims, the USB and wireless LAN interface circuitry. *See* EX1001 2:6-30. The signals of the claimed invention are transmitted via the USB and wireless LAN and the processing from the transmission of the image request signal to the conversion processing of the picture signal for display by the image stream signalization circuit is repeated at predetermined time intervals. This enables the image signals to be subjected to the appropriate processing necessary to enable interoperability between the interface circuitry.

For example, the USB interface circuitry transmits, over the USB cable, a first signal to the digital camera for causing the digital camera to output compressed first image information corresponding to first still pictures, and receives, over the cable, the compressed first image information corresponding to first still pictures output from the digital camera. *See, e.g.,* EX1001 15:56-16:11. The wireless LAN interface circuitry wirelessly transmits, over the network, a second signal to the digital camera for causing the digital camera to output compressed second image information corresponding to second still pictures, and wirelessly receives, over the network, the compressed second image information corresponding to second still pictures output from the digital camera. *See id.* 16:12-25. The picture data may also be processed at predetermined time intervals, (e.g., resizing, rotation, and/or conversion) in order for

it to be properly displayed. *See, e.g.*, EX1001 15:56-16:11. This results in the convenience of viewing a slide show on an image display apparatus that connects to external devices, (e.g., digital cameras), without the interoperability issues caused by the diverse circuitry of those external devices. *See, e.g.*, 18:4-19.

Prior to the priority date of the '780 Patent, image display apparatuses did not conduct a slide show from images in an external image device connected to the display through interface circuitry containing different underlying operational requirements and limitations, and further could not provide for a single user interface for doing so. But, as explained above, the recitations of the asserted claims enable the switching of and interoperability between the USB and wireless LAN interfaces, resulting in an image display apparatus with different interfaces—an improved computer hardware device.

B. Patent Prosecution History

U.S. Patent Application No. 16/576,925—which would ultimately issue as the '780 Patent—was filed on September 20, 2019, as a continuation of U.S. Patent Application No. 16/424,804, which is a continuation of U.S. Application No. 16/021,246, which is a continuation of U.S. Application No. 15/287,403, which is a continuation of U.S. Application No. 14/941,666, which is a continuation of U.S. Application No. 14/521,282, which is a continuation of U.S. Application No. 13/868,840, which is a continuation of U.S. Application No. 12/252,422.

In the Notice of Allowance, the Examiner characterized the prior art and claims. For example, the Examiner noted the “representative closest prior art” as Nozaki (U.S. Patent Publication No. 2004/0150724) (EX2002) and Koike (U.S. Patent Publication No. 2008/0180551) (EX2003). *See* EX1002 at 29. The Examiner further characterized Nozaki and Koike as follows:

Nozaki discloses a digital camera system connecting plural units of digital cameras and letting the camera collaborate to work. Nozaki's invention provides a digital camera system includes a first digital camera and a second digital camera, wherein the first digital camera and the second digital camera are capable of communicating with each other and the first digital camera further includes a first input/output device that sends/receives a data to and from the second digital camera ... a first controller that controls the first digital camera based upon an operation of any of the second plurality of operating devices. Nozaki further discloses that with an instruction of reproduction, an automatic change of reproduced image data to be displayed can be made like a “slide show” involving the other digital camera

Koike discloses an image pickup apparatus and a control method for the image pickup apparatus, to an image display apparatus and a control method for the image display apparatus, and to a recording medium, and more particularly, to storing of still image data in a moving image format and transmission of the still image data stored in the moving image format. Koike further discloses control commands include information, such as a request for transfer of still image data, a transfer response for still image data, the sizes of the frame memories 11 and

21, the position of an image where a slide show starts, and the like EX1002 at 30-31. The Examiner also noted that “In regards to claims 1, 15 and 20 Nozaki nor Koike, alone, or in combination, do not provide a teaching, a suggestion or a motivation that could be found either in the art or within the skill of one of ordinary skill in the art at the time of the invention to modify or combine the prior art to disclose the cited claim limitations above of the claimed invention.” EX1002 at 31.

C. Summary of Petitioner’s Proposed Ground for Unpatentability

Petitioner alleges that claims 1-11, 13, 15-20 would have been obvious under pre-AIA 35 U.S.C. § 103 and raises one ground of alleged unpatentability based on one prior art reference, Lawther (U.S. Patent Pub. No. 2008/0165081) in view of the knowledge of a POSITA:

Ground	'780 Patent Claims	Type of Challenge	Primary Reference	Secondary References
1	1-11, 13, 15-20	§ 103	Lawther	Knowledge of a POSITA

D. The Relied-Upon Reference

The reference relied upon by Petitioner to challenge the patentability of claims 1-11, 13, 15-20 of the '780 Patent is summarized as follows:

1. Lawther (EX1004)

U.S. Patent Pub. No. 2008/0165081 (“Lawther”) is entitled “Multi-Frame

Display System with Perspective Based Image Arrangement.” Lawther was filed on [REDACTED] was filed on January 5, 2007, and was published on July 10, 2008.

Lawther is directed to presenting an aesthetic arrangement of images on digital media frames. See EX1004 ¶¶ [0007]-[0008]. Because digital media frames “can present ever changing content which can be refreshed every few seconds,” Lawther seeks to present specific content in a sequence, form, or format on one digital media frame that is flattering based on arrangement with another digital media frame. See EX1004 ¶¶ [0007]-[0008]. Figure 14 of Lawther shows a setup of digital media frames arranged on a wall.

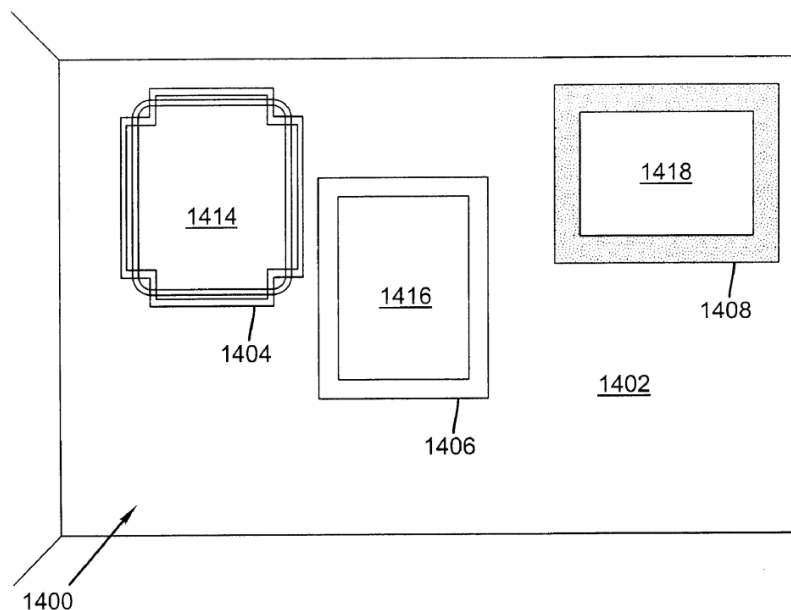


FIG. 14

Lawther discloses a system that can analyze images to determine an

arrangement of the images based on how the digital media frames are positioned.

See EX1004 at Abstract, ¶¶ [0007]-[0008]. A digital media frame can be attached to an external device to obtain images and then store the images in the storage of the digital media frame. See EX1004 ¶ [0041]. The digital media frame can then analyze the images and determine how the images should be arranged based on a multi-dimensional relationship between the digital media frame relative to other digital media frames. See *id.* at Abstract, ¶ [0041]. After determining this information and determining to display the images, the digital media frame can then retrieve the images from storage and then display the images. *Id.* ¶ [0041].

III. LEVEL OF ORDINARY SKILL

For purposes of this preliminary response, Patent Owner adopts the Petitioner's proposal that "[t]he person of ordinary skill in the art ("POSITA") with respect to this patent would have an educational background, such as a Bachelor of Science degree, in Electrical Engineering or Computer Engineering, as well as some understanding of wireless and serial protocols and image compression. Additionally, a POSITA would have 2 years of practical experience in consumer electronic product development. Additional practical or work experience could result in a lower level of education being necessary, and vice versa." Pet. at 11. However, Patent Owner reserves the right to provide its own definition of a POSITA should the Board institute review of the '780 Patent.

Petitioner states that it applied the Court’s tentative constructions, including construing image information as “information describing the pixels that make up an image” and the “the display screen displays a slide show at predetermined time intervals with the [first/second] still pictures, as the [first/second] images, based on the decoded [first/second] image information obtained by the decoder” (the “Displaying term”) in accordance with its own language (*e.g.*, plain and ordinary.” Pet. at 11. Petitioner further asserts that “no terms require express construction because the patent claims encompass the below prior-art mappings under *any* construction consistent with the *Phillips* standard.” Pet. at 12 (first emphasis added).

Since the filing of the Petition, the District Court has issued a Claim Construction Order that: (a) construes “image information” as “information describing the pixels that make up an image; and (b) construes the Displaying term as “the display screen displays a slide show at predetermined time intervals with the [first/second] still pictures, as the [first/second] images, the [first/second] images based on the decoded [first/second] image information obtained by the decoder.” EX2001 at 20-22.

Term	Court’s Construction
“image information”	“information describing the pixels that make up an image”
“the display screen displays a slide show at predetermined time intervals	“the display screen displays a slide show at predetermined time intervals

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with the [first/second] still pictures, as the [first/second] images, based on the decoded [first/second] image information obtained by the decoder”

with the [first/second] still pictures, as the [first/second] images, the [first/second] images based on the decoded [first/second] image information obtained by the decoder”

Because the same *Philips* standard applies, the claim terms at issue should be construed in the same way. *See also* 83 Fed. Reg. at 51342 (“[T]he scope of an issued patent should not depend on the happenstance of which court or governmental agency interpret it, at least as far as the objective rules go.”).

V. LEGAL STANDARD

Under 35 U.S.C. § 102(a) (pre-AIA), an issued patent is invalid if “the invention [therein] was . . . described in a printed publication . . . before the invention thereof by the applicant.” This statute “embodies the concept of novelty—if a device or process has been previously invented (and disclosed to the public), then it is not new, and therefore the claimed invention is ‘anticipated’ by the prior invention.” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008). To anticipate, “the prior art reference . . . must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’” *Id.* (citing *Connell v. Sears Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)).

A claim is also not patentable if the differences between the claim and the prior art are such that the subject matter as a whole would have been obvious to a

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person of ordinary skill in the art at the time of the invention. 35 U.S.C. § 103(a) (pre-AIA). Obviousness requires assessing (1) the “level of ordinary skill in the pertinent art,” (2) the “scope and content of the prior art,” (3) the “differences between the prior art and the claims at issue,” and (4) “secondary considerations” of non-obviousness such as “commercial success, long felt but unsolved needs, failure of others, etc.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966)).

It is the petitioner’s burden to prove unpatentability, *E.I DuPont de Nemours & Co. v. Synvina C.V.*, 904 F.3d 996, 1007 (Fed. Cir. 2018), and “to demonstrate both ‘that a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so.’” *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367-68 (Fed. Cir. 2016) (quotations and citations omitted). However, a petitioner must first show that all of the claimed elements are disclosed in the prior art. *See Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1164 (Fed. Cir. 2006) (considering motivation to combine and reasonable expectation of success only “if all the elements of an invention are found in a combination of prior art references”).

VI. DISCRETIONARY FACTORS FAVOR DENIAL OF INSTITUTION

The Petition should be denied pursuant to any of 35 U.S.C. §§ 314(a) and 325(d).

A. 35 U.S.C § 325(d) Weighs in Favor of Denying Institution

Employing a framework that “reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown,” the Director will discretionarily deny institution when: (1) “the same or substantially the same art previously was presented to the Office” **or** “the same or substantially the same arguments previously were presented to the Office”; and (2) the petitioner does not “demonstrate[] that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GMBH*, IPR2019-01469, Paper 6 at 8 (P.T.A.B. Feb. 13, 2020) (precedential) (“*Advanced Bionics*”).

Within this two-part framework, the Board considers a number of non-exclusive factors in evaluating whether to exercise its discretion under § 325(d). *See Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (P.T.A.B. Dec. 15, 2017) (precedential as to § III.C.5, first para.) (“*Becton, Dickinson*”); *see also Advanced Bionics* at 9–11. The factors set forth in *Becton, Dickinson* are as follows:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;

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- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art
- (e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson at 17–18.

For Part 1 of the *Advanced Bionics* framework, the Board first evaluates *Becton, Dickinson* factors (a), (b), and (d). *Advanced Bionics* at 10. If it is determined that the same or substantially the same art or arguments were previously presented to the USPTO, then under Part 2 Board considers factors (c), (e), and (f) to assess “whether the petitioner has demonstrated a material error by the Office” in its prior consideration of that art or arguments. *Id.* Notably, previously presented does not mean the Examiner must have “meaningfully addressed” or based a rejection on a particular reference. *Biocon Pharma Ltd. v. Novartis Pharm. Corp.*, IPR2020-01263, Paper 12 at 9 (P.T.A.B. Feb. 16, 2021) (holding that cited but unapplied references supported denying institution); *Sony Interactive Entm’t LLC v. Terminal Reality, Inc.*, IPR2020-00711, Paper 15 at 11 (P.T.A.B. Oct. 13, 2020) (finding

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reference was previously considered by the PTO because it was listed in the Examiner's Notice of References Cited).

Simply put, the Petition is a rehash of the art, rejections, arguments, and reasons for allowance already considered during the prosecution of the '780 Patent, making this Petition ripe for denial of institution under § 325(d).

1. Part 1: The Same or Substantially the Same Art/Arguments Were Previously Presented

The overlap between the IPR-asserted reference and those submitted during prosecution of the '780 Patent meets the first part of the two-part *Advanced Bionics* framework, which considers the similarities and material differences between the two sets of art, the cumulative nature of the art, and the extent of the overlap between the arguments. *Becton, Dickinson & Co. v. B. Braun Melsungen AAG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph) (factors (a), (b), and (d)).

Petitioner relies on a combination of Lawther and the knowledge of a POSITA for the only ground asserted in the Petition. However, Petitioner's arguments regarding Lawther and the knowledge of a POSITA are substantially the same as the art and arguments previously presented to the Examiner during prosecution of the '780 Patent.

For example, in the Notice of Allowance, the Examiner specifically identified "representative prior art" Nozaki and Koike and characterized specific features of

the prior art. EX1002 at 30-31; *see supra* Section II.B. The disclosures of Nozaki and Koike are substantially similar compared to Petitioner’s art and arguments. Petitioner’s asserted arguments compared to the disclosures of Nozaki and Koike are summarized below:

Claim Text	Petitioner’s Asserted Art and Arguments	Nozaki/Koike and Notice of Allowance
[Claim 1 Preamble] An image display apparatus, comprising:	Digital media frame with display . Pet. at 17.	Image display apparatus. EX1002 at 30-31.
[1A] Universal Serial Bus (USB) interface circuitry configured to receive compressed first image information from a digital camera over a USB cable;	USB port for receiving digital data and ability to receive JPEG images. Pet. at 18-20.	EX2002 ¶ [0005] (USB); EX1002 at 30-31 (“sends/receives data to and from the second digital camera”).
[1B] wireless LAN interface circuitry configured to wirelessly receive compressed second image information from the digital camera over a network;	Sending/receiving using Wi-Fi. Pet. at 23.	EX2002 ¶ [0005] (Wireless LAN); EX1002 at 30-31 (“sends/receives data to and from the second digital camera”).
[1C] a decoder configured to decode the compressed first image information received by the USB interface circuitry or the compressed second image information received by the wireless LAN interface circuitry; and	“image decoding, image data compression/decompression,” inherent due to ability to receive images. Pet. at 25.	EX1002 at 30-31 (“sends/receives data to and from the second digital camera”); EX2002 ¶ [0028] (“a compression ratio setting including decompression”).
[1D] a display screen configured to display at least one of first images based on decoded the first image information and	Display unit that can display received images. Pet. at 28.	EX1002 at 30 (“image display apparatus”) and “with an instruction of reproduction, an automatic change of

Claim Text	Petitioner's Asserted Art and Arguments	Nozaki/Koike and Notice of Allowance
second images decoded the second information obtained by the decoder,		reproduced image data to be displayed”).
[1E] wherein if displaying the first images on the display screen, based on an operation on the input device of the image display apparatus for conducting a slide show,	Displaying a sequence of digital images and receive control inputs related to displaying images. Pet. at 28-29.	Displaying received images like a “slide show” and receive control inputs related to displaying images. EX1002 at 30 (“with an instruction of reproduction , an automatic change of reproduced image data to be displayed can be made like a ‘ slide show ’”).
[1F] the USB interface circuitry transmits, over the USB cable, a first signal to the digital camera for causing the digital camera to output compressed first image information corresponding to first still pictures, and receives, over the cable, the compressed first image information corresponding to first still pictures output from the digital camera,	Generally exchanging data with another device. Pet. at 30-31.	EX1002 at 30-31 (“sends/receives data to and from the second digital camera”);
[1G] the decoder decodes the compressed first image information corresponding to first still pictures received by the USB interface circuitry, and	Asserts same arguments as [1C]. Pet. at 31-32.	See [1C].
[1H] the display screen displays a slide show at predetermined time intervals with the first still	Displays a slideshow and “determining time intervals” for presenting visual content. Pet. at 32.	EX1002 at 30 (“with an instruction of reproduction, an automatic change of

Claim Text	Petitioner's Asserted Art and Arguments	Nozaki/Koike and Notice of Allowance
pictures, as the first images, based on the decoded first image information obtained by the decoder, and		reproduced image data to be displayed can be made like a ‘ slide show ’”).
[1I] wherein if displaying the second images on the display screen, based on an operation on the input device of the image display apparatus for conducting a slide show,	Cites same reasons as [1E]. Pet. at 33.	See discussion of [1E].
[1J] the wireless LAN interface circuitry wirelessly transmits, over the network, a second signal to the digital camera for causing the digital camera to output compressed second image information corresponding to second still pictures, and wirelessly receives, over the network, the compressed second image information corresponding to second still pictures output from the digital camera,	Can receive via wireless LAN (with knowledge of POSITA. Pet. at 34-35.	Can send/receive data via wireless LAN. EX2002 ¶ [0005].
[1K] the decoder decodes the compressed second image information corresponding to second still pictures received by the wireless LAN interface circuitry, and	Transferring images via wireless LAN and ability to process compressed images. Pet. at 35-36.	EX2002 ¶ [0005] (Wireless LAN), ¶ [0028] (“a compression ratio setting including decompression”); EX1002 at 30-31 (“sends/receives data to and from the second digital camera”).

Claim Text	Petitioner's Asserted Art and Arguments	Nozaki/Koike and Notice of Allowance
[1L] the display screen displays a slide show at predetermined time intervals with the second still pictures, as the second images, based on the decoded second image information obtained by the decoder.	Displays a slideshow and “determining time intervals for presenting visual content. Pet. at 36-37.	EX1002 at 30 (“with an instruction of reproduction, an automatic change of reproduced image data to be displayed can be made like a ‘ slide show ’”).

As seen above, all arguments advanced by Petitioner are the same or substantially the same as features already evaluated by the Examiner, with most of the Petitioner's asserted art and arguments expressly noted in the Notice of Allowance. See EX1002 at 30-31; *see supra* Section II.B. Any differences between Lawther and Nozaki or Koike are irrelevant to the patentability of the claims. Thus, Part 1 is met because the same or substantially the same art and arguments were previously presented to the Office.

1. Part 2: Petitioner Has Not Demonstrated Material Error in Allowance of the '780 Claims

Because Part 1 is met, Petitioner must demonstrate material error under Part 2. However, the Petition is silent on this point and thus fails to demonstrate “that the Office erred in a manner material to the patentability of the challenged claims,” as required under Part 2. *Advanced Bionics*, IPR2019-01469 at Paper 8. In fact, the Petition makes no mention of §325(d) at all. Petitioner's failure to address Part 2

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validates denial under § 325(d). *Albany Int’l Corp. v. Kimberly-Clark Worldwide, Inc.*, PGR2021-00019, Paper 22, 8-9 (PTAB June 22, 2021) (denying institution because “[i]f a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute [] review.”).

Petitioner only remarks that Lawther was not included amongst the references listed on the face of the ’780 Patent and was not applied by the Examiner during prosecution of the ’780 Patent, and that “the Examiner did not have access to the expert analysis of Dr. Wolfe.” Pet. at 6. However, Petitioner fails to even address Part 2 with respect to the Office’s prior consideration of substantially similar references. See Pet. at 5. Petitioner completely fails to address why either the prior consideration of the combination of Nozaki and Koike is material error.

Petitioner’s lack of analysis is insufficient to meet the second part of the *Advanced Bionics* test, and denial under §325(d) is appropriate. Additionally, the mere presence of a declaration “alone does not overcome the circumstances presented here.” *Cloud9 Techs. LLC v. IPC Systems, Inc.*, IPR2017-0615, Paper 8 at 11 (PTAB Jan. 10, 2018); see *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15 (PTAB Aug. 24, 2022) (precedential) (denying institution and holding declaration is entitled to little weight when it contains an exact restatement of the petition’s unsupported, conclusory assertions without any additional supporting

evidence or reasoning); *see also* 37 C.F.R. § 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”).

Indeed, Petitioner does not meet its burden. To evaluate material error, the Board weighs *Becton, Dickinson* factors c, e and f. The Petition does not reference any of these factors, let alone analyze them. *Vital Connect, Inc. v. Bardy Diagnostics, Inc.*, IPR2023-00381, Paper 7, 20 (PTAB July 11, 2023) (“[W]hile there are no ‘magic words’ necessary to address material error, Petitioner’s alleged grounds of unpatentability cannot establish material error *per se* under our binding precedent. . . . Otherwise, the reasonable likelihood standard of § 314(a) and the second part of the *Advanced Bionics* framework (‘material error’) would collapse into one.”).

Accordingly, the *Advanced Bionics* framework is satisfied and the Director should exercise its discretion to deny institution. *See Advanced Bionics*, IPR2019-01469, Paper 6, 8; *Albany Int’l Corp.*, PGR2021-00019, Paper 22, 10-11.

B. 35 U.S.C. § 314(a) Weighs in Favor of Denying Institution

The Petition should be denied pursuant to 35 U.S.C. § 314(a) because, as set forth below, not only are there significant flaws in Petitioner’s analysis that fail the “compelling merits” standard, but the circumstances of the parallel District Court Litigation necessitate denial of the Petition under the Board’s precedent. In the Petition, Petitioner does not argue that any *Fintiv* factor supports institution. Every

factor considered in relation to efficiency, fairness, and the merits supports denial.

See Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11, at 6 (P.T.A.B. Mar. 20, 2020) (precedential).

Accordingly, the Board should exercise its discretion under § 314(a) and deny the Petition because institution of this proceeding would not be consistent with the objective of the AIA to “provide an effective and efficient alternative to district court litigation.” *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, at 16–17 (P.T.A.B. Sept. 6, 2017) (precedential)).

1. The Board Should Use Its Discretion To Deny Institution Even In Light Of Petitioner’s *Sotera* Stipulation

Petitioners’ *Sotera* stipulation does not change that the Board should deny institution under *Fintiv*. The former Director recently clarified in district court filings that the Board retains discretion to deny institution even when petitioner files a so-called *Sotera* stipulation; otherwise, the Director’s factors would violate statute and be unconstitutional. Particularly, the Director’s district court brief in *Apple Inc. v. Vidal* stated that “[i]n June 2022, the Director issued a guidance memorandum revising the *Fintiv* analysis.... In this Memorandum, the Director ... directed that ... the Board *should not* discretionarily deny institution under *Fintiv* when a petitioner stipulates not to pursue, in a parallel district court proceeding, the same grounds as in the petition or any grounds that could reasonably have been raised in the petition.” USPTO Director’s Brief in *Apple Inc. v. Vidal* at 6, No. 5:20-cv-06128- EJD (N.D.

Cal. Sept. 21, 2023) (emphasis added). The Director further clarified that “[T]he *Fintiv* factors are only a ‘general statement of agency policy’ that binds neither the Board nor actors beyond the agency ...” *Id.* at 8.

Relying on the Director’s statements, the district court held that because the Board always retains discretion to deny institution (even when, for example, petitioner files a *Sotera* stipulation) the Director’s *Fintiv* guidance does not violate the Administrative Procedure Act: Plaintiffs ... alleg[e] three violations of the Administrative Procedure Act (“APA”), 5 U.S.C. § 701 et seq. ... Based on the parties’ written and oral arguments, the Court finds that the NHK-*Fintiv* standard was not a substantive rule requiring notice-and-comment rulemaking. *Apple Inc. v. Vidal*, No. 5:20-cv-06128-EJD, Order Denying Plaintiffs’ Renewed Motion for Summary Judgment; Granting Defendant’s Motion for Summary Judgment (N.D. Cal. Mar. 31, 2024)).

Accordingly, even when petitioner files a purported “*Sotera*” stipulation, it is not dispositive of whether the Board should deny institution under *Fintiv*. Rather, the Director and district court have clarified that the Board should consider any such stipulation as just one non-dispositive factor in connection with all other circumstances of the case, just like the Board has done previously. *See e.g., Cisco Systems, Inc. v. Estech Systems, Inc.*, IPR2021-00333, Paper No. 12, at 12-13 (P.T.A.B. July 7, 2021) (denying institution under *Fintiv* based on holistic analysis

of all factors even when petitioner filed a Sotera stipulation because the Board was “not persuaded ... the stipulations proffered here are sufficient when weighed against the other factors”).

2. Petitioner’s Stipulation Is Insufficient In View of Other Factors That Weigh Heavily Against Institution

Here, any stipulation does not overcome the strong evidence that institution should be denied under *Fintiv*, or the Director’s inherent discretion, as addressed above. Additionally, Petitioner’s *Sotera* stipulation is insufficient because it does not purport to bind the real parties-in-interest (the remaining defendants in the district court litigation). Pet. at 60-61.

a. No Stay Of The Parallel District Court Litigation

There is no stay of the parallel District Court Litigation. Even if the Petition were instituted and Petitioner filed a motion to stay the District Court Litigation, prejudice, tactical disadvantage to Maxell, the late stage of the litigation, and the lack of potential simplification would weigh strongly against such a motion. See *Lennon Image Techs., LLC v. Macy’s Retail Holdings, Inc.*, 2:13-CV-00235-JRG, 2014 WL 4652117, at *1 (E.D.Tex. Sept. 18, 2014). The statutory deadline for institution is not until after fact and expert discovery closes and the Court has already conducted a *Markman* hearing and issued a claim construction order. EX2005. Such facts make it unlikely that the District Court Litigation will be stayed. See *Intell.*

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Ventures II v. FedEx Corp., No. 2:16-cv-00980-JRG, Dkt. 141 at 5 (E.D.Tex. Oct. 24, 2017).

b. Proximity Of The District Court's Trial Date

The proximity of the District Court Litigation's trial date to the Board's projected statutory deadline for a Final Written Decision strongly weighs in favor of discretionary denial. The parties' trial is scheduled for September 22, 2025, less than four months after the deadline for institution. EX2005 at 2. Petitioner knew of this trial date seven months prior to filing the Petition. See EX2004 at 2. Pursuant to 35 U.S.C. §§ 314(b)(1) and 316(a)(11), the projected statutory deadline for a Final Written Decision of this Petition is May 26, 2026. 35 U.S.C. § 314(b)(1). As the District Court's trial will be almost eight months before the projected statutory deadline for a final written decision, this factor weighs strongly in favor of denying institution. See *Samsung Elecs. Am., Inc. v. Uniloc 2017 LLC*, IPR2019-01218, Paper 7, at 7-10 (P.T.A.B. Jan. 7, 2020) (denying institution where jury selection was scheduled for approximately six months before trial in the Board proceeding would conclude); *Next Caller Inc. v. TrustID, Inc.*, IPR2019-00961, -00962, Paper 10, at 8-16 (P.T.A.B. Oct. 16, 2019) (denying institution where trial was scheduled to conclude "several months," before a final decision would be due).

The proximity of the trial favors denial of institution.

c. Significant Investment In The Parallel Proceeding

The parties' investment in the parallel proceeding weighs in favor of discretionary denial. In the District Court Litigation, by the time the Board renders an institution decision, the parties will have already completed most of the work getting prepared for trial, such as fact and expert discovery and dispositive motion briefing. Fact discovery closes March 3, 2025 and expert discovery closes May 5, 2025. The Court has also conducted a *Markman* Hearing (Dkt. 117) and issued a claim construction order.

The parties have already exchanged infringement contentions pursuant to P.R. 3-1, and invalidity contentions pursuant to P.R. 3-3, completed claim construction briefing and a trial date is set for September 22, 2025, which is only four months after a decision on Institution. *See, e.g.*, EX2004; EX2005. Thus, the parties' and Court's substantial investment in this proceeding weighs in favor of denial of institution under this factor. *10X Genomics, Inc. v. President and Fellows of Harvard College*, IPR2023-01299, Paper 15, at 17-18 (P.T.A.B. March 7, 2024) (finding, under similar facts, that the parties have made a substantial investment in the parallel proceeding as of the time of the Institution Decision).

d. There Is Significant Overlap Between Issues Raised In The Petition And In The District Court Litigation

The issues in this proceeding are substantially the same as in the District Court Litigation. Here, Petitioner asserts that Claims 1-11, 13, 15-20 of the '780 Patent are

unpatentable. Pet. at 1. These claims include the asserted claims against Petitioner in the District Court Litigation. Not only will the District Court Litigation conclude long before this proceeding, but it will also resolve the invalidity arguments that Petitioner raises in the instant Petition. The prior art references relied on in this proceeding are the same, or substantially the same, as those at issue in the District Court Litigation. Indeed, Petitioner disclosed the Lawther reference in its contentions five months before filing its Petition. EX2006 at 8.

Given that the Petition is directed toward substantially the same grounds, arguments, and significantly overlapping evidence at issue in the parallel District Court Litigation, this factor favors denial of institution.

e. The Parallel District Court Litigation And The Petition Involve The Same Parties

Petitioners are parties to the District Court Litigation. This factor weighs in favor of discretionary denial.

f. Other Factors Favor Discretionary Denial

The Petition does not present a strong case on the merits, let alone a “compelling meritorious challenge,” further supporting denial of institution. *See infra* Section VII. Petitioner also does not identify any other factors which weigh against discretionary denial. Pet. at 61-62.

Though Petitioners make a *Sotera* stipulation, its effect is substantially muted because, in addition to not binding all real parties-in-interest, by the time the Board

renders a decision on institution, the parties will have already prepared expert reports and completed expert discovery. As a result, it would be much more efficient for the parties to address the validity issues in the district court rather than in this forum. *Inter partes* review was created as “a quick, inexpensive, and reliable alternative to district court litigation.” S. Rep. No. 110-259, at 20 (2008). None of these goals are achieved if Maxell is forced to prepare its validity case in the district court litigation—including engaging experts and going through expert discovery—all prior to the Board’s institution decision as a result of Petitioner’s filing of the petition at almost a year after the litigation was commenced.

Thus, when viewing the factors together, the Petition should be denied in the Director’s discretion under 35 U.S.C. § 314(a).

VII. THE PETITION DOES NOT SHOW A REASONABLE LIKELIHOOD OF PREVAILING WITH RESPECT TO ANY CHALLENGED CLAIM

The Petition should be denied because it does not establish a reasonable likelihood of prevailing on any of the asserted grounds against any of the challenged claims. Petitioner fails to establish that claims 1-11, 13, and 15-20 are rendered obvious by Lawther.

A. Petitioner Fails to Establish that Claim 1 Would Have Been Obvious to a POSITA in View of Lawther and Further in View of the Knowledge of a POSITA

As explained below, Petitioner has not shown a likelihood of prevailing with respect to Ground 1 (the only ground asserted in the Petition). Lawther in view of

the knowledge of a POSITA fails to disclose at least claim elements [1A], [1D], [1E], [1F], [1H], [1I], [1J], and [1L].

1. Petitioner Fails to Establish that Claim Limitation [1A] Would Have Been Obvious in View of Lawther and Further in View of the Knowledge of a POSITA

Petitioner fails to establish that Lawther in view of the knowledge of a POSITA discloses or suggests claim limitation [1A]: “Universal Serial Bus (USB) interface circuitry configured to receive compressed first image information from a digital camera over a USB cable.”

None of Petitioner’s citations to Lawther (paragraphs [0041], [0042], [0044], [0046], [0068]) disclose or suggest USB circuitry configured to receive compressed first image information from a digital camera over a USB cable. Pet. at 18-19. In fact, there is no mention of USB circuitry anywhere in these cited paragraphs of Lawther. Furthermore, the remainder of Petitioner’s discussion of limitation [1D] is directed towards justifying how a POSITA would understand the use of “compressed images,” and fails to articulate any rationale for why “USB circuitry” is obvious. See Pet. at 19-22.

Petitioner’s expert declaration is no better. See EX1003 ¶ 64. Petitioner’s expert declaration contains substantially similar language to its Petition with conclusory remarks about Lawther disclosing USB circuitry and cites *no* evidence (exhibits or otherwise) to support its conclusory statement that USB circuitry would

be obvious in light of Lawther or the knowledge of a POSITA. *See id.* “Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.” 37 C.F.R. § 42.65(a).

Therefore, Petitioner fails to establish that claim limitation [1A] would have been obvious in view of Lawther and the knowledge of a POSITA.

2. Petitioner Fails to Establish that Claim Limitation [1D] Would Have Been Obvious in View of Lawther and Further in View of the Knowledge of a POSITA

Petitioner fails to establish that Lawther in view of the knowledge of a POSITA discloses or suggests claim limitation [1D]: “a display screen configured to display at least one of first images based on the decoded first image information and second images based on the decoded second image information obtained by the decoder” (the “Displaying term”).

Petitioner fails to establish that Lawther and the knowledge of a POSITA disclose or suggest this limitation because Petitioner fails to apply the proper construction of the Displaying term, which should be construed such that “the first images are **based on** the decoded first image information obtained by the decoder.” *See supra* Section IV. While Petitioner states they applied the District Court’s tentative constructions, this is erroneous because Petitioner fails to address the “based on” portion of the limitation at all.

Instead, Petitioner excerpts a passage of Lawther with no explanation for

which components in the passage map to specific portions of the claim limitation.

See Pet. at 27-28. Petitioner's excerpt only discloses that the digital media frame "retrieves digital images from the memory" and then "displays the digital images on a display." See Pet. at 28 (citing EX1004 ¶ [0041]). However, this paragraph of Lawther fails to disclose that the "display[ing of] the digital images on a display" is ***based on the decoded first image information***, as recited in claim limitation [1D]. Petitioner fails to offer any discussion for how the "based on" language is disclosed or rendered obvious by Lawther and the knowledge of a POSITA.

Further, Petitioner fails to identify what "decoded information" is in the passage. Paragraph [0041] of Lawther merely discloses a process in which Lawther's digital media frame may receive digital images, generate auxiliary information relating to each digital image, and store the auxiliary information with the digital image. There is no decoding or "decoded first image information" described anywhere in this paragraph of Lawther. See EX1004 ¶ [0041]. Therefore, Petitioner cannot establish that the "digital images" displayed are based on decoded information when Petitioner fails to articulate at all what comprises decoded information in the first place.

Therefore, Petitioner fails to establish that claim limitation [1D] would have been obvious in view of Lawther and the knowledge of a POSITA.

3. Petitioner Fails to Establish that Claim Limitation [1E] Would Have Been Obvious in View of Lawther and Further in View of the Knowledge of a POSITA

Petitioner fails to establish that Lawther in view of the knowledge of a POSITA discloses or suggests claim limitation [1E]: “wherein if displaying the first images on the display screen, **based on** an operation on the input device of the image display apparatus for conducting a slide show.”

Petitioner fails to establish this limitation is obvious in light of its cited prior art because Petitioner fails to address the “based on” portion of the limitation at all. For example, Petitioner fails to address any linkage between an alleged “operation on the input device of the image display apparatus for conducting a slide show” and “wherein if displaying the first images on the display screen.”

For example, Petitioner discusses determining time intervals for presenting the visual content or time transition types between images. *See* Pet. at 28. Even if these could be considered an “operation on the input device of the image display apparatus,” Petitioner fails to address whether “displaying the first images on the display screen” occurs based on an operation on the input device to determine time intervals.

Petitioner also discusses altering a “sequence of digital images to be displayed” but fails to link this alteration to displaying the first images on the display screen. Instead, this is merely a discussion of altering images that are queued **to be**

displayed, but does not discuss that **displaying** of images is based on an operation to alter potential images to be displayed. Petitioner also identifies a “pause signal” which appears to be a way of **preventing** “**displaying** the first **images** on the display screen.” See Pet. at 29.

This lack of explanation is linked to Petitioner’s failure to map Lawther or “knowledge of a POSITA” to any actual language in claim limitation [1E].² Petitioner’s entire description of limitation [1E] includes no recitation of the claim language at all after the first sentence which generically states that “Lawther teaches [exact language of claim limitation].” See Pet. at 28-30.

Therefore, Petitioner fails to establish that Lawther in view of the knowledge of a POSITA discloses or suggests claim limitation [1E].

4. Petitioner Fails to Establish that Claim Limitation [1F] Would Have Been Obvious in View of Lawther and Further in View of the Knowledge of a POSITA

Petitioner fails to establish that Lawther in view of the knowledge of a POSITA discloses or suggests claim limitation [1F]: “wherein if displaying the first images on the display screen, based on an operation on the input device of the image display apparatus for conducting a slide show, the USB interface circuitry transmits, over the USB cable, a first signal to the digital camera for causing the digital camera to output compressed first image information corresponding to first still pictures,

² Petitioner does not cite “the knowledge of a POSITA” at all for this limitation.

and receives, over the cable, the compressed first image information corresponding to first still pictures output from the digital camera.”

a. Petitioner fails to satisfy 35 U.S.C. § 312(a)(3)

Petitions must “identif[y], in writing and *with particularity*, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3). Furthermore, the Petition must include “[a] full statement of the reasons for the relief requested, including *a detailed explanation of the significance of the evidence* including material facts, and the governing law, rules, and precedent.” 37 C.F.R. §§ 42.22(a)(2). The Petition lacks detailed explanation and should not be instituted.

Petitioner provides virtually no analysis of how Lawther, the knowledge of a POSITA, or a combination of both would disclose or suggest limitation [1F]. Petitioner’s entire “discussion” of limitation [1F] is essentially comprised only of quoted language from Lawther with no analysis or explanation for how these quotes map to the actual language of the claim. *See* Pet. at 30-31. The sole exception to asserting any commentary of Lawther’s disclosures is a conclusory statement asserted specifically in relation to “integrating compressed images” in the Lawther

system.³ See Pet. at 31 (“Further, and as discussed in § XI.B.1.ii. above, the POSITA would have understood to integrate compressed images with the Lawther system.”). The remainder of Petitioner’s discussion that is not a direct quote from Lawther solely consists of: “Lawther teaches [claim limitation [1F]]. More specifically, Lawther describes that the [first quotation from Lawther], and the [second quotation from Lawther].” Pet. at 30-31 (citations omitted).

Actual claim language is not referenced past the first sentence of this section. This was necessary because the quoted language of Lawther is not identical or even similar to the language of claim limitation [1F]. For example, limitation [1F] recites that “the USB interface circuitry transmits, over the USB cable, a first signal to the digital camera for causing the digital camera to output compressed first image information corresponding to first still picture.” Petitioner fails to even reference USB interface circuitry or a USB cable anywhere in its supposed discussion of limitation [1F], fails to cite any paragraph in Lawther that references USB interface circuitry, and even fails to cite back to any of its own previous discussion that may

³ The only clear takeaway may be that since Petitioner only cites an obviousness combination with a POSITA with respect to integrating compressed images with the Lawther system, Petitioner is asserting that Lawther alone discloses the rest of limitation [1F]. See Pet. at 30-31 (asserting a “POSITA would have understood” argument only with respect to integrating compressed images).

have referenced USB interface circuitry.⁴ Further, a citation to a previous discussion of a claim limitation would be insufficient, because limitation [1F] discloses actions performed by the USB interface circuitry not recited in previous limitations.⁵

The USB example is non-limiting. Virtually no term recited in the language of limitation [1F] is referenced in Petitioner’s “evidence,” including terms that are **not** recited in previous claim limitations like “a first signal...for causing the digital camera to output compressed first image information” or “corresponding to first still pictures.”

The result is that the Patent Owner is forced to “cobble together assertions from different sections of a petition or citations of various exhibits in order to infer every possible permutation of a petitioner’s arguments.” *Microsoft Corp. v. FG SRC, LLC*, 860 Fed. Appx. 708, 713 (Fed. Cir. 2021). This is improper and also prejudicial. Instituting an IPR on such a Petition would prejudice Patent Owner because Patent Owner is unable to discern the manner in which limitation [1F] is disclosed or suggested, and is thus limited in its ability to address some unspecified

⁴ Petition only cites to its discussion in § XI.Bi.1.ii in relation to compressed images and not USB. See Pet. at 31.

⁵ Limitation [1A] requires USB circuitry to **receive** compressed first image information from a digital camera, while limitation [1E] requires at least USB circuitry that **transmits** a first signal to the digital camera for **causing the digital camera to output compressed first image information**.

combination of disclosures from the Petition. *See T-Mobile US, Inc. v. TracBeam LLC*, IPR2015-01687, Paper 10 at 20 (PTAB Feb. 12, 2016) (“We will not...improperly shift the burden of deciphering the arguments onto the Patent Owner.”).

As another example, some of Petitioner’s quoted language does not appear to be related to any part of limitation [1F]. For example, Petitioner quotes Lawther in describing that “[p]rocessing circuit 206 causes [components of the digital media frame] **to display images in response to signals received from interface circuit 204**, user input system 214, and/or optional sensors 216 and audio system 218.” Pet. at 30 (second alteration added). This is a disclosure that Lawther’s digital media frame (the alleged “image display apparatus”) will **display images** in response to a **received** signal. Petitioner fails to explain the relevance of this passage to limitation [1F], which describes: (a) **transmitting** a signal **to a digital camera** via a USB cable, and (b) receiving, over the USB cable, compressed first image information.

The fact that Lawther’s digital media frame **receives** a signal and **displays images** is irrelevant to **transmitting a signal** to a digital camera. If there is some sort of linkage between (a) the signal that causes Lawther’s DMF to display images and (b) transmitting a signal to a digital camera, this argument is not articulated nor supported by any of Petitioner’s cited evidence. *See* Pet. at 30-31.

Although of different scope, independent claims 15 and 20 recite similar

features. The failure to articulate “a detailed explanation of the significance of the evidence” is not cured in other independent claims 15 and 20. *See* Pet. at 53-54 (discussing that limitation [15F] is disclosed for the same reasons asserted with respect to limitation [1F] and only providing additional rationale to address “portable video processing apparatus instead of a digital camera”); *id.* at 60 (merely referring back to discussion to claim 15 to disclose claim 20). Claims 2-11, and 13 depend from independent claim 1, and claims 16-19 depend from independent claim 15. Thus, this deficiency is perpetuated throughout the entire Petition, affects every claim and ground,⁶ and thus institution should be denied for this reason alone.

b. Petitioner fails to show Lawther in view of the knowledge of a POSITA discloses “the USB interface circuitry transmits, over the USB cable, a first signal to the digital camera for causing the digital camera to output compressed first image information corresponding to first still pictures”

None of Petitioner’s cited evidence supports a disclosure or suggestion of claim limitation [1F]. For example, Petitioner fails to show that Lawther discloses or suggests that “the USB interface circuitry transmits, over the USB cable, a first signal to the digital camera for causing the digital camera to output compressed first image information corresponding to first still pictures.”

This portion of limitation [1F] provides that: (a) the USB interface circuitry

⁶ Only one Ground is asserted.

of an image display apparatus ***transmits a first signal to a digital camera***; and (b) that the first signal is for “***causing the digital camera to output first image information*** corresponding to first still pictures.” Petitioner’s citations to Lawther cannot even satisfy a high level description of this: transmitting a signal to a digital camera; and for that signal to be for causing the digital camera to output particular information.

For example, Petitioner’s first quotation from Lawther discloses that Lawther’s digital media frame displays images in response to signals received from interface circuit 204 (among other components). Thus, the digital media frame receives signals, and these signals cause components of the digital media frame to display images. The ***receipt of signals by the DMF*** is irrelevant to the ***transmission of a signal to a digital camera*** (an external device). Further, these signals are for causing the ***DMF*** to ***display images*** and not to cause a ***digital camera*** to ***output first image information***.

Next, Petitioner’s second quotation from Lawther discusses that an interface circuit of Lawther’s digital media frame “can also be adapted to enable exchange with a connected external device using optical signals, radio frequency signals or other forms of signals.” Even if this description can be interpreted to disclose that Lawther’s digital media frame can generally exchange information with external devices via signal transmission, there is still no disclosure that these signals are

transmitted from the digital media frame to the digital camera ***for causing the digital camera to output first image information***. In other words, a general disclosure of “data exchange” between the digital media frame and external devices cannot disclose a specific situation in which a transmission of a signal from the digital media frame is for causing a digital camera to output first image information.

Whether the digital media frame ***receives*** signals to cause a display of ***the digital media frame*** is irrelevant to proving that the digital media frame ***transmits*** a signal to cause a ***digital camera*** to perform an action, as recited in limitation [1E].

Further, as asserted above in relation to Section VII.A.2, Lawther explicitly discloses that when displaying images, the image is retrieved from storage of the digital media frame. EX1004 ¶ [0041]. It is therefore unclear why displaying images or any operations to display images would cause any signal to be sent to the digital camera, since the digital media frame can retrieve the image to be displayed from its own storage.

Thus, Petitioner fails to show Lawther in view of the knowledge of a POSITA discloses “the USB interface circuitry transmits, over the USB cable, a first signal for causing the digital camera to output compressed first image information corresponding to first still pictures.”

5. Petitioner Fails to Establish that Claim Limitation [1H] Would Have Been Obvious in View of Lawther and Further in View of the Knowledge of a POSITA

Petitioner fails to establish that Lawther and the knowledge of a POSITA discloses “the display screen displays a slide show at predetermined time intervals with the first still pictures, as the first images, based on the decoded first image information obtained by the decoder.”

Petitioner fails to establish that Lawther and the knowledge of a POSITA discloses limitation [1H] because Petitioner fails to address the language of “based on” at all. In relation to this limitation, Petitioner only cites back to limitation [1D]. See Pet. at 32-33 (“Further element 1[D] claims [language] which is substantially the same to the limitation claimed in this element...Thus the arguments and analysis regarding element 1[D] as indicated above in § XI.B.1..v [sic] help to demonstrate that Lawther renders this element 1[H] obvious.”).

However, Petitioner’s discussion of limitation [1D] only discloses that the digital media frame “retrieves digital images from the memory” and then “displays the digital images on a display.” As described above, Petitioner fails to establish that decoding occurs or even assert an argument for what the decoded information is. Therefore, Petitioner cannot establish that the “digital images” displayed are **based on** decoded information when Petitioner fails to establish what decoded information is in the first place. Further, because the cited section of Lawther fails to disclose

any sort of format conversion between receiving the digital image and displaying the digital image, it appears that the displayed digital image is not based on any “converted” digital image.

6. Petitioner Fails to Establish that Claim Limitation [1I] Would Have Been Obvious in View of Lawther and Further in View of the Knowledge of a POSITA

In relation to this limitation, Petitioner fails to introduce new arguments or evidence and merely cites back to previous discussion regarding limitation [1E]. Thus, the same reasons why limitation [1E] was not rendered obvious similarly apply to limitation [1I].

7. Petitioner Fails to Establish that Claim Limitation [1J] Would Have Been Obvious in View of Lawther and Further in View of the Knowledge of a POSITA

In relation to this limitation, Petitioner fails to introduce new arguments or evidence except discussing that “it would have been obvious to a POSITA from the disclosure of Lawther to include both USB and wireless LAN connectivity capability in the same digital camera.” Pet. at 34. Besides briefly discussing the combination of a “digital camera capable of both wired (USB) and wireless connections,” Petitioner merely cites back to previous discussion regarding limitation [1F]. Thus, the same reasons why limitation [1F] was not rendered obvious similarly apply to limitation [1J].

Next, Petitioner fails to support its assertion that a digital camera of Lawther

would include both USB and wireless LAN connectivity. The disclosure of including both USB and wireless LAN connectivity is in relation to the ***digital media frame*** of Lawther, a different device and system from a ***digital camera***. Petitioner fails to provide any evidence whatsoever for why a POSITA would look to Lawther's disclosure of including wireless LAN on a ***digital media frame*** to benefit a system like a digital camera.

8. Petitioner Fails to Establish that Claim Limitation [1L] Would Have Been Obvious in View of Lawther and Further in View of the Knowledge of a POSITA

Petitioner fails to establish that Lawther and knowledge of a POSITA disclose or suggest limitation [1L]. For example, Petitioner fails to address the “based on” portion of the limitation at all. As described above in relation to limitation [1D], Petitioner fails to establish that any displayed image is “based on” decoded information. *See supra* Section VII.A.2. Petitioner fails to establish at all what “decoded information” is in the first place and therefore cannot establish that the displayed image is based on any decoded information.

B. Petitioner Fails to Establish that Claims 2-11 and 13 Would Have Been Obvious to a POSITA in View of Lawther and Further in View of the Knowledge of a POSITA

Claims 2-11 and 13 depend from independent claim 1 and are therefore not obvious for at least the same reasons asserted for independent claim 1. *See supra* Section VII.A.

C. Petitioner Fails to Establish that Claim 15 Would Have Been Obvious to a POSITA in View of Lawther and Further in View of the Knowledge of a POSITA

1. Petitioner Fails to Establish that Claim Limitation [15F] Would Have Been Obvious in View of Lawther and Further in View of the Knowledge of a POSITA

Petitioner states that limitation [15F] is “identical” to limitation [1F] with the exception of claiming a portable video processing apparatus instead of a digital camera. *See* Pet. at 53. Petitioner only advances additional discussion in relation to “portable video processing apparatus,” and argues that it would have been obvious in view of Lawther and the knowledge of a POSITA that the “portable video processing apparatus” portion is disclosed. Pet. at 53-54. For the remainder of its discussion, Petitioner argues that Lawther teaches this limitation for the same reasons regarding limitation [1F]. *See* Pet. at 53-54. Therefore, for at least the same reasons provided above in relation to limitation [1F], limitation [15F] is similarly not rendered obvious. *See supra* Section VII.A.4.

2. Petitioner Fails to Establish that Claim Limitation [15J] Would Have Been Obvious in View of Lawther and Further in View of the Knowledge of a POSITA

Petitioner depends on its discussion of limitation [1L] to disclose limitation [15J]. *See* Pet. at 55. Therefore, this limitation is not rendered obvious for at least the same reasons asserted above with respect to [1L]. *See supra* Section VII.A.8.

Furthermore, limitation [15J] comprises different limitations than limitation [1L]. For example, limitation [15J] recites “wherein at least in the state that the

wireless LAN interface circuitry connects with the portable video processing apparatus over the network, based on an operation on the input device of the image display apparatus for conducting a slide show,” while limitation [1L] discloses “the display screen displays a slide show at predetermined time intervals with the second still pictures, as the second images, based on the decoded second image information obtained by the decoder.” Therefore, limitation [15J] recites features such as “at least in the state that the wireless LAN interface circuitry connects with the portable video processing apparatus over the network” and “***based on an operation on the input device*** of the image display apparatus for conducting a slide show” that are not recited in limitation [1L]. Petitioner cannot rely on ***only*** the rationale provided for a limitation that does not share the same scope as the limitation at hand. Petitioner’s rationale with respect to [1L] fails to address any of the specific language of limitation [15J]. *See* Pet. at 36-37.

Therefore, Petitioner fails to show that limitation [15J] is disclosed or rendered obvious by Lawther and the knowledge of a POSITA.

3. Petitioner Fails to Establish that Claim Limitation [15K] Would Have Been Obvious in View of Lawther and Further in View of the Knowledge of a POSITA

Petitioner depends on its discussion of limitation [1J] to disclose limitation [15K]. *See* Pet. at 56. Petitioner’s only additional discussion is asserting that a “portable video capture device” would have been obvious to a POSITA. *See id.*

Therefore, this limitation is not rendered obvious for at least the same reasons asserted above with respect to [1J]. *See supra* Section VII.A.7.

D. Petitioner Fails to Establish that Claims 16-19 Would Have Been Obvious to a POSITA in View of Lawther and Further in View of the Knowledge of a POSITA

Claims 16-20 depend from independent claim 15. Therefore, claims 16-20 are not rendered obvious by Lawther and the knowledge of a POSITA for at least the same reasons asserted above in relation to claim 15. *See supra* Section VII.C.

E. Petitioner Fails to Establish that Claim 20 Would Have Been Obvious to a POSITA in View of Lawther and Further in View of the Knowledge of a POSITA

For Claim 20, Petitioner asserts that “Lawther is a method claim corresponding to the independent apparatus claim 15, and claim 15 is disclosed or rendered obvious by Lawther as discussed above.” Therefore, claim 20 is not rendered obvious by Lawther and the knowledge of a POSITA for at least the same reasons asserted above in relation to claim 15. *See supra* Section VII.C.

Additionally, Petitioner’s assertion the claim 20 and claim 15 are identical is erroneous. Petitioner fails to address a plethora of limitations of claim 20 that are not recited in claim 15, including:

- “transmitting, over the USB cable, a first signal to the digital camera ***in response to a first user's operation*** regarding to slide show on a remote controller of the television display apparatus;”

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- “receiving, over the USB cable, first still pictures output from the digital camera in response to the first signal, the first still pictures are compressed;”
- “**resizing the decoded first pictures** by changing a number of horizontal pixels and/or a number of vertical lines of the decoded first still pictures;”
- “**wirelessly transmitting**, over the network, **a second signal with IP address of the digital camera** to the digital camera **in response to a second user's operation regarding to slide show** on the remote controller of the television display apparatus;”
- “wirelessly receiving, over the network, second still pictures output from the digital camera **in response to the second signal**, the second still pictures are compressed;” and
- “resizing the decoded second still pictures by changing a number of horizontal pixels and/or a number of vertical lines of the decoded second still pictures.”

Petitioner's failure to further discuss these limitations at all comprise a failure to disclose or suggest the limitations of claim 20.

As another example, Petitioner fails to even recite the specific limitations of claim 15 that correspond to limitations of claim 20. This lack of particularity forces analyzing various sections in order to determine Petitioner's arguments. This,

coupled with Petitioner's failure to address claim language that is never recited in claim 15 or any other challenged claim, cannot meet the particularity requirements set forth for a Petition.

1. Petitioner Fails to Establish that Claim Limitation [20B] Would Have Been Obvious in View of Lawther and Further in View of the Knowledge of a POSITA

Petitioner fails to establish that Lawther in combination with a POSITA discloses or suggests limitation [20B]: “transmitting, over the USB cable, a first signal to the digital camera in response to a first user's operation regarding to slide show on a remote controller of the television display apparatus.”

Because Petitioner merely cites back to its discussion of claim 15 for the entirety of claim 20, Petitioner fails to provide any discussion of portions of limitation [20B] that are not recited anywhere in claim 15 or any other challenged claim. For example, Petitioner fails to address “a first user's operation *regarding to slide show* on a remote controller” or establishing that “transmitting...a first signal to digital camera” occurs *in response to* a first user's operation regarding to slide show.

In addition, there is no discussion of “remote control” or “a first user's operation regarding to slide show on a remote controller of the television display apparatus” anywhere in claim 15, so it is unclear how Petitioner attempts to map this limitation. However, regardless of whatever unidentified section Petitioner

meant to refer to, Petitioner will still fail to establish that Lawther in combination with a POSITA discloses or suggests limitation [20H].

At a basic level, this limitation requires that a first signal be transmitted to a digital camera *in response to* a first user's operation regarding to slide show on a remote controller. Petitioner fails to address any linkage between any "operation for conducting a slide show" and a transmittal of a first signal to a digital camera. Even assuming Petitioner's mapping for "operation for conducting a slide show" could be used to disclose the different language of "first user's operation regarding to slide show," Petitioner fails to establish that transmitting any signal to a digital camera occurs *in response to* an operation for conducting a slide show.

Because Petitioner fails to provide any evidence or even argument regarding linkage or a relationship between the "operation for conducting a slide show" and transmittal of a first signal to the digital camera, Petitioner fails to establish this limitation is rendered obvious by Lawther and the knowledge of a POSITA.

Further, as asserted above in relation to Section VII.A.2, Lawther explicitly discloses that when displaying images, the image is retrieved from storage of the digital media frame. EX1004 ¶ [0041]. It is therefore unclear why displaying images or any operations to display images would cause any signal to be sent to the digital camera, since the digital media frame can retrieve the image to be displayed from its own storage.

Therefore, Lawther and the knowledge of a POSITA fail to render obvious limitation [20B].

2. Petitioner Fails to Establish that Claim Limitation [20C] Would Have Been Obvious in View of Lawther and Further in View of the Knowledge of a POSITA

Petitioner fails to establish that Lawther in combination with a POSITA discloses or suggests limitation [20C]: “receiving, over the USB cable, first still pictures output from the digital camera in response to the first signal, the first still pictures are compressed.”

Petitioner fails to address this limitation because Petitioner fails to address that receipt of “first still pictures output from the digital camera” occurs *in response to* the first signal. As described above in relation to limitation [1E], Petitioner fails to address the first signal properly at all, and thus cannot disclose any limitation based on the first signal, such as limitations that occur *in response to* the first signal.

Because Petitioner fails to map the limitations of claim 15 to claim 20, it is unclear which discussion Petitioner is alleging discloses limitation [20C]. Regardless of whatever limitation Petitioner is using to disclose “the first signal,” Petitioner cannot establish limitation [20C], because Petitioner has failed to address relational language throughout the entire Petition. *See, e.g., supra* Sections VII.A.2, VII.A.3, VII.A.5.

Therefore, Lawther and the knowledge of a POSITA fail to render obvious

3. Petitioner Fails to Establish that Claim Limitation [20E] Would Have Been Obvious in View of Lawther and Further in View of the Knowledge of a POSITA

Petitioner fails to establish that Lawther in combination with a POSITA discloses or suggests limitation [20E]: “resizing the decoded first pictures by changing a number of horizontal pixels and/or a number of vertical lines of the decoded first still pictures.”

For example, Petitioner never identifies what “decoded first pictures” are, and therefore fails to establish further actions that would be performed on the “decoded first pictures,” such as “resizing the decoded first pictures.” *See supra* Section VII.A.2.

Therefore, Petitioner fails to establish that Lawther in combination with a POSITA discloses or suggests limitation [20E].

4. Petitioner Fails to Establish that Claim Limitation [20H] Would Have Been Obvious in View of Lawther and Further in View of the Knowledge of a POSITA

Petitioner fails to establish that Lawther in combination with a POSITA discloses or suggests limitation [20H]: “wirelessly transmitting, over the network, a second signal with IP address of the digital camera to the digital camera in response to a second user's operation regarding to slide show on the remote controller of the television display apparatus.”

Because Petitioner merely cites back to its discussion of claim 15 for the entirety of claim 20, Petitioner fails to provide any discussion of portions of limitation [20D] that are not recited anywhere in claim 15 or any other challenged claim. For example, Petitioner fails to address “a first user’s operation **regarding to slide show** on a remote controller” or establishing that “transmitting...a first signal to digital camera” occurs **in response to** a first user’s operation regarding to slide show.

In addition, there is no discussion of “remote control” or “a second signal with IP address of the digital camera” anywhere in claim 15, so it is unclear how Petitioner intended to map this limitation. However, regardless of whatever unidentified section Petitioner meant to refer to, Petitioner will still fail to establish that Lawther in combination with a POSITA discloses or suggests limitation [20H].

That is because, as discussed above, this limitation requires that a second signal be wirelessly transmitted to the digital camera **in response to** a second user’s operation regarding to slide show on a remote controller. As described above in relation to limitation [20C], Petitioner fails to address any relational language at all in its Petition. *See, e.g., supra* Sections VII.A.2, VII.A.3, VII.A.5. Even assuming Petitioner’s mapping for “operation for conducting a slide show” of limitation [1I] could be used to disclose the different language of “second user’s operation regarding to slide show,” Petitioner fails to establish that transmitting any signal to

a digital camera occurs *in response to* an operation for conducting a slide show.

Because Petitioner fails to provide any evidence or even argument regarding linkage or a relationship between the “operation for conducting a slide show” and transmittal of a signal to the digital camera, Petitioner fails to establish this limitation is rendered obvious by Lawther and the knowledge of a POSITA.

Further, as asserted above in relation to Section VII.A.2, Lawther explicitly discloses that when displaying images, the image is retrieved from storage of the digital media frame. EX1004 ¶ [0041]. It is therefore unclear why displaying images or any operations to display images would cause any signal to be sent to the digital camera, since the digital media frame can retrieve the image to be displayed from its own storage.

Therefore, Lawther and the knowledge of a POSITA fail to render obvious limitation [20H].

5. Petitioner Fails to Establish that Claim Limitation [20I] Would Have Been Obvious in View of Lawther and Further in View of the Knowledge of a POSITA

Petitioner fails to establish that Lawther in combination with a POSITA discloses or suggests limitation [20I]: “wirelessly receiving, over the network, second still pictures output from the digital camera in response to the second signal, the second still pictures are compressed.”

Because Petitioner fails to map the limitations of claim 15 to claim 20, it is

unclear which discussion Petitioner is alleging discloses limitation [20J].

Regardless of whatever limitation Petitioner is using to disclose “the second signal,” Petitioner cannot establish limitation [20I], because Petitioner has failed to address relational language throughout the entire Petition. *See, e.g., supra* Sections VII.A.2, VII.A.3, VII.A.5. Thus, Petitioner fails to address this limitation because Petitioner fails to address that receipt of “second still pictures output from the digital camera” occurs *in response to* the second signal.

Moreover, as described above in relation to limitation [20H], Petitioner fails to address the second signal properly at all, and thus cannot disclose any limitation that is based on the second signal, such as limitations that occur *in response to* the second signal.

Therefore, Lawther and the knowledge of a POSITA fail to render obvious limitation [20I].

6. Petitioner Fails to Establish that Claim Limitation [20K] Would Have Been Obvious in View of Lawther and Further in View of the Knowledge of a POSITA

Petitioner fails to establish that Lawther in combination with a POSITA discloses or suggests limitation [20K]: “resizing the decoded second still pictures by changing a number of horizontal pixels and/or a number of vertical lines of the decoded second still pictures; and.”

For example, Petitioner never identifies what “decoded second still pictures”

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are, and therefore fails to establish further actions that would be performed on the “decoded second still pictures,” such as “resizing the decoded second still pictures.”

See supra Section VII.A.5; *see also supra* Section VII.A.3.

Therefore, Petitioner fails to establish that Lawther in combination with a POSITA discloses or suggests limitation [20K].

VIII. CONCLUSION

For at least the foregoing reasons, the Board should deny institution of the Petition.

Dated: February 26, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 26th day of February, 2025, a copy of the attached **PATENT OWNER'S PRELIMINARY RESPONSE** was served by electronic mail to the attorneys of record, at the following addresses:

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Dated: February 26, 2025

Respectfully submitted,

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CERTIFICATION PURSUANT TO 37 C.F.R. § 42.24(d)

Pursuant 37 CFR 42.24(d), the undersigned certifies that this Preliminary Response complies with the type-volume limitation of 37 CFR §42.24(a). The word count application of the word processing program used to prepare this Preliminary Response indicates that the Preliminary Response contains 12,600 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

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