

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'S SUR-REPLY TO PETITIONER'S REPLY TO THE
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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I. PETITIONER'S SINGLE GROUND INVOLVES THE SAME OR SUBSTANTIALLY THE SAME ART AND/OR ARGUMENTS

Petitioner's Reply confirms that that the asserted prior art and/or arguments, Lawther, are substantially the same as previously presented art and/or arguments.

Petitioner's characterizations of previously presented art illustrate the similarity of its reliance on Lawther to how references were previously considered by the Office. For example, Petitioner characterizes features of Nozaki as "showing first and second digital cameras that communicate with each other" and controller actions "such that a slide show...can be shown." Reply 2. Similarly, Petitioner characterizes Koike as describing "storing of still image data....and transmission of the still image data...and also control commands such as a request for transfer of images, a response, and the size and position of a slide show start." Reply 2-3. These are exactly the features in Lawther upon which the Petition relies, which further highlight the cumulativeness of Lawther to Nozaki or Koike. *See, e.g.*, POPR 16-19.

Petitioner's identification of allegedly distinguishing features in Lawther are of no effect, because Petitioner does not rely on any of these characteristics as a basis for its arguments in the Petition. For example, Petitioner distinguishes Lawther on the basis that Lawther is directed to determining "the multi-dimensional relationship between digital media frames to determine their arrangement for presentation," or allowing presentation of "digital images in an efficient and intuitively

understandable fashion without resort to the conventional expedient of virtually combining a plurality of separate displays so that they appear to work as a single generally continuous display device.” Reply 2. But Petitioner fails to rely on this “multi-dimensional relationship between digital media frames” aspect of Lawther anywhere in its Petition. *See, e.g.*, POPR 16-19 (showing summary of Petitioner’s arguments failing to rely on the arrangement aspect of Lawther).

It is irrelevant that neither “the Examiner nor Patent Owner explain how, or why, the PHOSITA could have combined Nozaki and Koike.” Reply 3. There is nothing that supports the relevance of such a detail, such as evidence in the intrinsic record that states that the Examiner relied on a lack of combination between Nozaki and Koike to allow the claims. *See, e.g.*, EX1002 at 30-31. Nor would a combination of Nozaki and Koike diminish the cumulativeness of Lawther relative to those references, or a combination thereof.

Petitioner also argues that Patent Owner only applied a mapping of Nozaki/Koike to independent claim 1 and not the “other 19 claims in the Petition.” Reply 2. Petitioner relies solely on Lawther for all claims. Establishing the cumulativeness of Lawther to Nozaki and Koike for independent claim 1 carries through to the dependent claims, particularly where, as here, the Petition relies solely on the Lawther reference. For other independent claims, Petitioner’s arguments merely repeat its arguments in relation to claim 1. *See, e.g.*, Pet. at 50-60. In any

case, Petitioner fails to identify any part of the Petition in which it relies on parts of Lawther that are allegedly distinguished from teachings of Nozaki and Koike. As such, Lawther is cumulative to Nozaki and Koike and the first part of *Advanced Bionics* is met.

II. NO MATERIAL ERROR¹

Petitioner argues that “The Petition explains in detail why the ‘780 patent should not have issued over the prior art in view of the knowledge of the PHOSITA.” Reply 4. It is telling that Petitioner includes no citation to its Petition, because there is in fact, no detail on any “alleged material error” and the Petition is completely silent on this point. Pet. 10. Petitioner does not argue any deficiency in the Examiner’s original determination or how Lawther cures any alleged deficiencies in the prosecution of the ‘780 Patent besides the fact that the Lawther reference was “previously unapplied.” Pet. 9-10. Instead, Petitioner only points to its single ground, which cannot establish material error *per se*. See *Vital Connect, Inc. v. Bardy Diagnostics, Inc.*, IPR2023-00381, Paper 7, 20 (P.T.A.B. 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

¹ Petitioner’s heading, directed to “Archya” and “Robbins” appear to be unrelated to the references at hand or this IPR proceeding in general.

precedent. . . . Otherwise, the reasonable likelihood standard of § 314(a) and the second part of the Advanced Bionics framework ('material error') would collapse into one.").

As discussed above, Petitioner's art and arguments in relation to Lawther are merely a rehash of the same art and arguments already presented to the Examiner during prosecution and thus there was no material error.

III. PETITIONER'S CLAIM CONSTRUCTION ARGUMENTS FAIL

Petitioner's claim construction arguments fails for several reasons. For example, Petitioner fails to identify sufficient evidence in its Petition that its arguments support the District Court's claim construction. Second, its arguments would fail under any construction because it failed to properly articulate what in Lawther maps to these terms in the first place.

Petitioner's Reply only provides arguments that the Petition mapped "compressed image information" to "information describing the pixels that make up an image." Reply 5. There are numerous other recitations of "image information" in the challenged claims, such as "decoded image information," that are unrebutted by Petitioner. *See, e.g., id.*; Pet. at 27-28. Further, Petitioner cannot claim it applied the claim construction when the Petition failed to articulate what "decoded image information" comprises in the first place. *See, e.g.,* Patent Owner Preliminary Response at 31.

Similarly, while Petitioner states that it applied the District Court's claim construction of the displaying term, Petitioner fails to support this proposition. For example, Petitioner's cited portions of the Petition fail to discuss the "based on" portion of the limitation at all. *See, e.g.*, Patent Owner Preliminary Response 30-33; *see also* Pet. 27-28, 32-33. Regardless of whatever construction is applied to the displaying term, Petitioner has failed to address the causal language between the first part of the Displaying term and second part of the Displaying term and therefore its arguments would fail under any claim construction. *See* Patent Owner Preliminary Response 30-33.

IV. CONCLUSION

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

Dated: April 22, 2025

Respectfully submitted,

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Patent No. 10,650,780
Patent Owner's Sur-Reply

CERTIFICATE OF SERVICE

I hereby certify that on this 22nd day of April, 2025, a copy of the attached **PATENT OWNER'S SUR-REPLY** was served by electronic mail to the attorneys of record, at the following addresses:

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