IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC. AND
LG ELECTRONICS USA, INC.

Petitioners,

v.

MAXELL, LTD.,
Patent Owner

Case: IPR2025-00392

U.S. Patent No. 8,339,493

BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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PATENT OWNER'S EXHIBIT LIST

Description	Exhibit #
Notice Letter From Maxell to LG Electronics Sent July 19, 2021 and FedEx Tracking Showing Receipt July 28, 2021	2001
Joint Case Management Statement, *Maxell, Ltd. v. LG Electronics Inc. et al.*, No. 5:24-cv-04972-NW-SVK (N.D. Cal. Mar. 17, 2025)	2002
Docket Navigator Average Time to Trial and Markman Hearing Search Results (N.D. Cal.)	2003
Complaint, *Maxell, Ltd. v. LG Electronics Inc. et al.*, No. 5:23-cv-00152-RWS (E.D. Tex. Dec. 29, 2023)("Complaint")	2004
LGE Invalidity Contentions in No. 5:24-cv-04972-NW-SVK (N.D. Cal. Feb. 3, 2025)	2005
March 24, 2025 Guidance on USPTO's Recission of "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation"	2006
U.S. Patent No. 5,828,406 (Parulski '406)	2007
Translation of No. H11-355665, the Japanese priority publication to Misawa 6,700,607	2008

I. INTRODUCTION

Patent Owner Maxell, Ltd. ("Patent Owner") respectfully requests that the Board deny institution of the Petition filed by LG Electronics Inc. and LG Electronics U.S.A., Inc. (hereinafter "Petitioner" or "LG") challenging the patentability of claims 5-14 ("challenged claims") of U.S. Patent No. 8,338,493 ("the '493 Patent") (LG-1001).

The '493 Patent is expired. The '493 Patent was thoroughly examined by the Office *three* times: (1) during original prosecution, (2) in IPR2018-00236, and (3) during Reexamination No. 90/014,628. Petitioner admits that four out of its five references were previously presented to the Office. In light of these basic and undisputed facts, as set forth more fully below, the Petition is ripe for discretionary denial. Instituting IPR on the Petition would undermine the goals of the Acting Director's Memorandum dated March 26, 2025 ("the Memo") to "improve PTAB efficiency, maintain PTAB capacity to conduct AIA proceedings, . . . and promote consistent application of discretionary considerations in the institution of AIA proceedings."

More specifically, the Board should exercise its discretion pursuant to 35 U.S.C. § 314(a) or 35 U.S.C. §325(d) and deny the Petition. Application of the *Becton, Dickinson* factors weighs in favor of denying institution because all of the

art relied on in the Petition was in fact considered during prosecution or reexamination of the '493 Patent.

Application of the *Fintiv* factors under § 314(a) also weighs in favor of denial given the state of the parallel District Court litigation where the same validity challenges are being adjudicated. The Board has discretion to deny institution under these circumstances to promote fairness and efficiency and manage its docket, potentially considering factors beyond the established frameworks. Instituting an IPR here would contradict the goal of IPRs as an "effective and efficient alternative" to litigation, particularly given the substantial overlap and the finite resources of the Board. *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16-17 (PTAB Sept. 6, 2017) (precedential).

Accordingly, the Board should decline to institute the Petition.

II. THE MARCH 26, 2025 ACTING DIRECTOR'S MEMORANDUM

Pursuant to the Memo, which outlines "Interim Processes for PTAB Workload Management" including a bifurcated approach for considering discretionary denial, Patent Owner respectfully submits that the Director should deny institution of the Petition. This filing is being made within two months of the Notice of Filing Date dated February 11, 2025 (Paper #5), in accordance with the standard briefing schedule for discretionary denial arguments set forth in the Memo.

The Memo outlines relevant considerations for discretionary denial:

- Whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims;
- Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;
- The strength of the unpatentability challenge;
- The extent of the petition's reliance on expert testimony;
- Settled expectations of the parties, such as the length of time the claims have been in force;
- Compelling economic, public health, or national security interests; and
- Any other considerations bearing on the Director's discretion.

As explained more fully below, denial is warranted under 35 U.S.C. § 325(d) and 35 U.S.C. § 314(a). Furthermore, additional considerations warrant discretionary denial, including that the '493 Patent is expired, Petitioner's undue delay in filing this challenge despite years of notice (EX2001), and Petitioner's expert testimony that merely parrots the petition (Ex. LG-1003). Thus the petition is ripe for discretionary denial in light of the Memo's aim to "improve PTAB efficiency, maintain PTAB capacity to conduct AIA proceedings,…and promote consistent

application of discretionary considerations in the institution of AIA proceedings." Memo at 3.

III. DISCRETIONARY FACTORS FAVOR DENIAL OF INSTITUTION

The Petition should be denied pursuant to the Director's discretion to deny institution of petitions. **First**, the Petition should be denied pursuant to 35 U.S.C. § 325(d) because the petition argues the "same or substantially the same art previously presented to the Office" and fails to demonstrate "that the Office erred in a manner material to the patentability of the challenged claims."

Second, the Petition should be denied pursuant to 35 U.S.C. § 314(a) and the factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020), given the parallel District Court litigation. **Finally**, additional Factors set forth in the "Interim Processes for PTAB Workload Management" Memorandum favor the Board denying the Petition using its discretion.

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

The Petition should be denied pursuant to 35 U.S.C. § 325(d) because the Petition improperly seeks reconsideration of validity based on art and arguments already reviewed by the Office. Under the framework established in *Advanced Bionics*, denial is warranted where "(1) the same or substantially the same prior art was previously presented to the Office or (2) the same or substantially the same

arguments were previously presented to the Office." *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, 8 (P.T.A.B. Feb. 3, 2020) (precedential); *see also Becton, Dickinson & Co. v. B. Braun Melsungen AG,* IPR2017-01586, Paper 8, pp. 17-18 (P.T.A.B. Dec. 15, 2017) (Precedential). "Previously presented art includes art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent." *Advanced Bionics* at 7-8. Further, the Board has construed "previously presented" in 35 U.S.C. § 325(d) to refer to art and arguments presented to the Office prior to the filing of the petition at issue. *Ironsource Ltd. v. Digital Turbine Inc.*, PGR2021-00096, Paper 14 at 52 (P.T.A.B. Jan. 6, 2022). If this condition regarding prior presentation is met, the Board then considers whether the petitioner has demonstrated material error by the Office. *Advanced Bionics,* Paper 6 at 8.

Here, the first part of the framework is satisfied because the Petition primarily relies on references that were previously presented to the Office in the prosecution and reexamination of the '493 Patent. Many of the references were also presented in a prior IPR involving the '493 Patent. Furthermore, Petitioner fails to meet the second part of the framework, as it makes no credible showing that the Office, either during prosecution or reexamination, materially erred in allowing the '493 Patent Claims. Petitioner falsely asserts that some of the references were not previously

presented to the Board or the Patent Office. Pet. at 73. Petitioner also notes that one of many past IPRs settled before institution without addressing the numerous other presentations of the references to the Office, and notes that the Board did not consider two references together. Pet. at 73. As explained below, none of these are material errors and the Board should exercise its discretion to deny institution. *Albany Int'l Corp. v. Kimberly-Clark Worldwide, Inc.*, PGR2021-00019, Paper 22, 8-9 (P.T.A.B. 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.").

1. The Same Or Substantially The Same Art Was Previously Presented To The Office

As explained below, the grounds presented by Petitioner are duplicative of the art and arguments applied by the Examiner during prosecution and examination of the '493 Patent. All references were directly presented during the prosecution and reexamination of the '493 Patent. Indeed, Petitioner admits four out of its five references were previously presented to the Office. Pet. at 72. But even the reference Petitioner refuses to admit was considered was presented to the Office in Reexamination 90/014,628. Ex. LG-1005 at 72. This alone is enough for the Board to exercise its discretion and deny institution. *See Clim-A-Tech Ind., Inc. v. William*

A. Ebert, IPR2017-01863, Paper 13, at 18-19 (P.T.A.B. Feb. 12, 2018) (denying institution even though the 'Examiner did not base a rejection' on the reference asserted in the petition); *Biocon Pharma Ltd. v. Novartis Pharm. Corp.*, IPR2020-01263, Paper 12, 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 reference was previously considered by the PTO because it was listed in the Examiner's Notice of References Cited); *Agrinomix, LLC v. Mitchell Ellis Prods., Inc.*, IPR2017-00525, Paper 6 (P.T.A.B. Jun. 14, 2017) (denying institution for grounds based on prior art that was considered during prosecution even though the prior art reference was not relied upon to reject all the challenged claims.)

a. Ground 1- Misawa '482, Parulski '218

Petitioner admits that Misawa '482 and Parulski '218 were presented to the Patent Office. Pet. at 72. Although the Board routinely denies institution where art was previously before the Examiner, even if not applied in a rejection, here Misawa '482 was used in a rejection during reexamination of the '493 Patent, and the parent of Parulski '218—Parulski '406—was considered by the Board in IPR2018-00236.

(1) **Misawa '482**

Misawa '482 was previously presented to the Office alongside Casio, Takase, Juen '162 under 35 U.S.C. § 103 and considered by the Examiner in Reexamination 90/014,628:

Request for Reexamination of U.S. Patent No. 8,339,493 B2

I. IDENTIFICATION OF CLAIMS FOR WHICH REEXAMINATION IS REQUESTED

In accordance with 37 C.F.R. § 1.510, reexamination of claims 5 and 6 of U.S. Patent No. 8,339,493 is requested in view of the following references:

A. Casio LCD Digital Camera QV-8000SX User's Guide ("*Casio*") (Ex. 1004);

B. U.S. Patent No. 7,903,162 to Juen ("*Juen*") (Ex. 1005);

C. U.S. Patent No. 5,444,482 to Misawa et al. ("*Misawa*") (Ex. 1006); and

D. U.S. Patent No. 5,502,483 to Takase et al. ("*Takase*") (Ex. 1013).

Re-examination of claim 5 is requested under 35 U.S.C. 103(a) as being unpatentable over *Casio* in view of *Juen* and/or *Takase*.

Re-examination of claim 6 is requested under 35 U.S.C. 103(a) as being unpatentable over *Casio* in view of *Juen* and/or *Takase* in further view of *Misawa*.

U.S. Patent No. 8,339,493 is still enforceable.

See Ex. LG-1005 at 4510.

The Examiner issued a non-final office action on September 1, 2021. Claim 6 was rejected under 35 U.S.C. § 103(a) over Casio in view of Juen '162, Takase '483 and Misawa '482. The Examiner's non-final rejection mapped the elements of the art against elements of Claim 5 and Claim 6. The Examiner also noted that "PO's declarations, filed on April 2021, and their supporting materials are insufficient to antedate the Smith and Reilly references." *See* Ex. LG-1005 at 43-47.

Ultimately the Examiner confirmed patentability of the Claims over these references, as the Patent Owner submitted new declarations, sufficient to antedate the Casio reference:

> **STATEMENT OF REASONS FOR PATENTABILITY AND/OR CONFIRMATION**
>
> Clams 5 and 6 are confirmed.
>
> The following is an examiner's statement of reasons for patentability and/or confirmation of the claims found patentable in this reexamination proceeding:
>
> Because Casio has been antedated as a valid reference, the 103 rejections applied against claims 5 and 6 are no longer valid and withdrawn. Since the only rejections applied against the claims 5 and 6 are withdrawn, claims 5 and 6 are confirmed.

Ex. LG-1005 at 9

Misawa '482 was also previously presented to the Office in IPR2020-00597 Ground 3 (alongside Casio, and Juen '162). The Board used its discretion to deny institution of IPR2020-00597 based on the merits of the presented grounds:

> [W]e have identified a potential deficiency in Petitioner's evidence regarding the use of different intervals when mixing or culling signal charges accumulated in the vertically arranged pixel lines based on whether the electric camera is monitoring in a static image mode or recording in a moving video mode.

Apple Inc. v. Maxell, Ltd., IPR2020-00597, Paper 9 at 16 (P.T.A.B. September 24, 2020).

(2) **Parulski '218**

Parulski '218 is the divisional of application 08/367,399 which later issued as US 5,828,406 (Parulski '406). Ex. LG-1007 at (62), 1:5-6; EX2007. Parulski '406 was previously presented to the Patent Office and considered by the Examiner during prosecution of the '493 Patent. Ex. LG-1002 at 169. The Examiner explicitly noted consideration of the references listed on the Information Disclosure Statements submitted during prosecution using the stamp: "All References Considered Except Where Lined Through."

U.S. PATENT DOCUMENTS

Examiner Initials*	Cite No.[1]	Document Number Number-Kind Code[2] (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		US- 6,661,451	12-2003	Kijima, et al.	
		US- 7,154,539	12-2006	Nishimura, et al.	
		US- 5,828,406	10-1998	Parulski et al.	
		US- 4,054,915	10-1977	Sughara, Yasumasa	
		US- 5,170,249	12-1992	Ohtsubo, et al.	
		US- 5,187,569	02-1993	Tani, Nobuhiro	
		US- 7,403,226	07-2008	Nakano, et al.	
		US-6,195,125	02-2001	Udagawa et al.	

FOREIGN PATENT DOCUMENTS

Examiner Initials*	Cite No.[1]	Foreign Patent Document Country Code[3]–Number[4]–Kind Code[5] (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T[6]
		JP 9-270959	10-97			
		JP 11-187306	07-99			
		JP 04-323973	11/13/1992	Hitachi, Ltd.		
		JP 11-004456	01/06/1999	Fuji Photo Film Co., Ltd.		
		JP 11-355665	12/24/1999	Fuji Photo Film Co., Ltd.		

NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No.[1]	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T[6]

Examiner Signature	/Luong Nguyen/	Date Considered	03/10/2012

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. 1 Applicant's unique citation designation number (optional). 2 See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. 3 Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). 4 For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. 5 Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. 6 Applicant is to place a check mark here if English language Translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /LN/

Ex. LG-1002 at 169.

Parulski '406 was also considered by the Office in IPR2018-00236. In denying institution, the Board made the following findings:

- "Petitioner fails to show Parulski '406 teaches a display screen of a television system or other screen compatible with the NTSC or PAL format."
- "Because Petitioner's obviousness analysis cites video modes rather than a 'static image mode' as recited in claim 6, Petitioner fails to demonstrate that Parulski '406 teaches or suggests the 'monitoring' limitation.
- "For at least these reasons, Petitioner has not shown that there is a reasonable likelihood that it would prevail with respect to its challenge to claim 5 in the ground in which Petitioner relies on Parulski '406 in the combination of cited references."

See ZTE Corp. Et al. v. Maxell, Ltd., IPR2018-00236, Paper 9 at 16-17 (P.T.A.B. June 1, 2018).

Both Parulski '406 (which was considered by the '493 Patent examiner) and Parulski '218 (cited in the Petition) have identical figures and substantially the same ten-column written description. *Compare* Ex. 2007 (Parulski '406) *with* Ex. LG-1007 (Parulski '218):

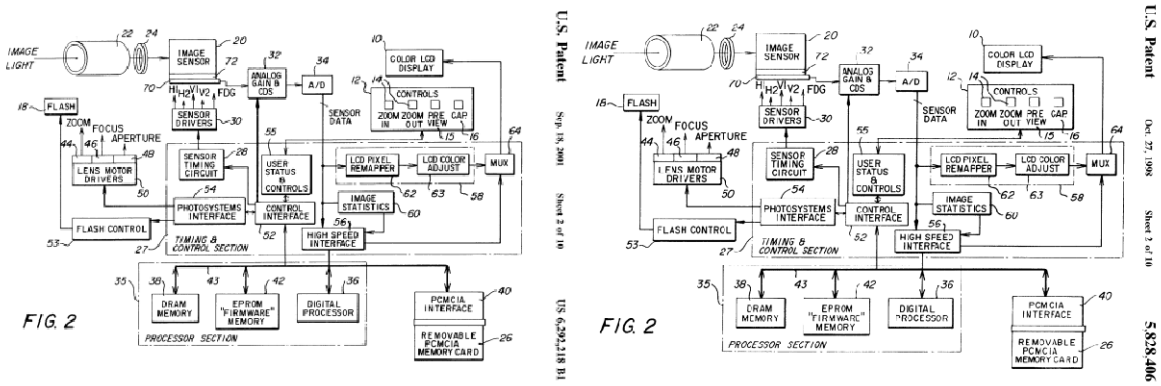
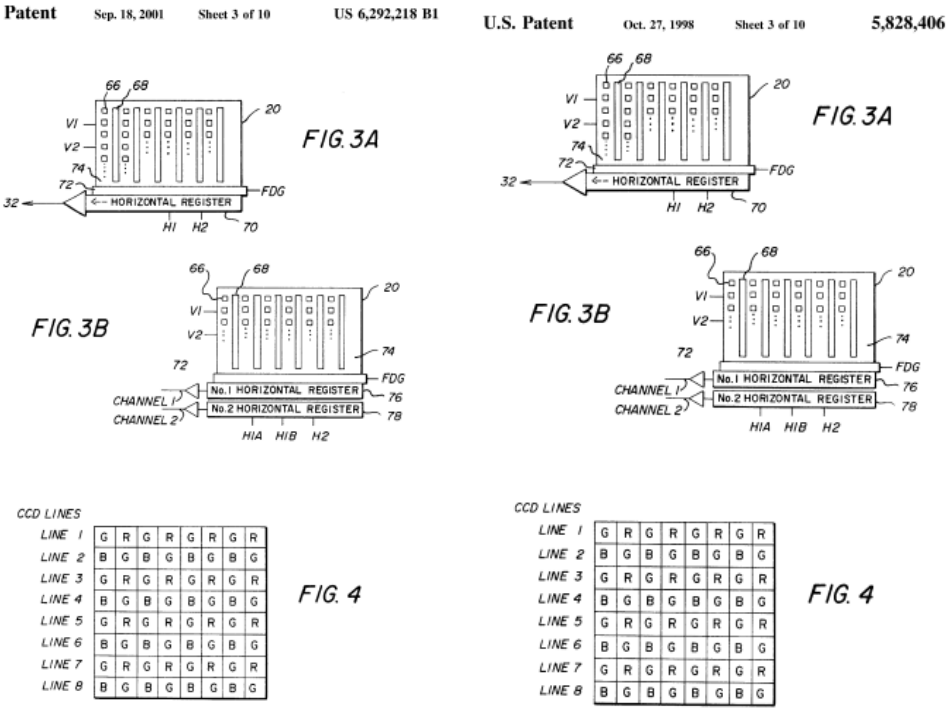


Figure 2 of '218 (Ex. LG-1007) on the left of Figure 2 of '406 (Ex. 2007)



Figures 3A-4 of '218 (Ex. LG-1007) on the left of Figures 3A-4 of '406 (Ex. 2007)

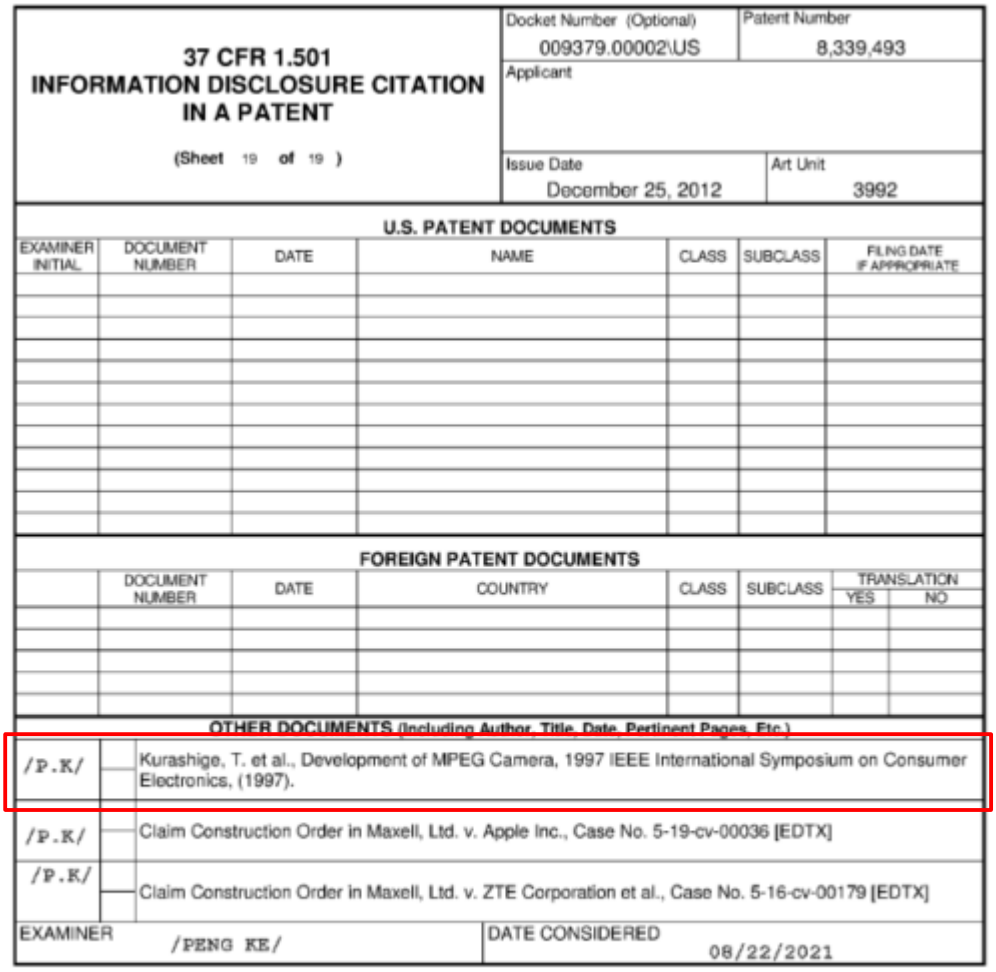
Petitioner fails to acknowledge that the examiner considered the same subject matter as Parulski '218 in allowing the '493 Patent claims, and denying institution

of IPR2018-00236. Parulski '218 is thus duplicative of the art already considered during examination of the '493 Patent.

Parulski '218 also was previously presented to the Office in Reexamination 90/014,628. *See* May 17, 2021 IDS Statement; Ex. LG-1005 at 266. The Examiner explicitly noted consideration of the references listed on the Information Disclosure Statements submitted during prosecution using the stamp: "All References Considered Except Where Lined Through." Ex. LG-1005 at 64 (August 22, 2021 Signed IDS Statement). Art reviewed by the Examiner during their search constitutes art "previously presented to the Office" under § 325(d). *See Advanced Bionics*, Paper 6 at 7-9.

b. Ground 2- Kurashige, Parulski '218

Petitioner admits that Parulski '218 was presented to the Patent Office. Pet. at 72. Petitioners explicitly state that "Kurashige was **never** before the Office." *See* Pet. at 73 (emphasis added). This is false. Kurashige *was* previously presented to the Office during reexamination of the '493 Patent. *See* Ex. LG-1005 at 274. The Examiner explicitly noted consideration of the references listed on the Information Disclosure Statements submitted during prosecution using the stamp: "All References Considered Except Where Lined Through." Ex. LG-1005 at 72.



37 CFR 1.501
INFORMATION DISCLOSURE CITATION IN A PATENT

(Sheet 19 of 19)

Docket Number (Optional)	Patent Number
009379.00002\US	8,339,493
Applicant	
Issue Date	Art Unit
December 25, 2012	3992

U.S. PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE

FOREIGN PATENT DOCUMENTS

	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION YES	TRANSLATION NO

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)

/P.K/		Kurashige, T. et al., Development of MPEG Camera, 1997 IEEE International Symposium on Consumer Electronics, (1997).
/P.K/		Claim Construction Order in Maxell, Ltd. v. Apple Inc., Case No. 5-19-cv-00036 [EDTX]
/P.K/		Claim Construction Order in Maxell, Ltd. v. ZTE Corporation et al., Case No. 5-16-cv-00179 [EDTX]

EXAMINER	DATE CONSIDERED
/PENG KE/	08/22/2021

ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /P.K/

Art reviewed by the Examiner during their search constitutes art "previously presented to the Office" under § 325(d). *See Advanced Bionics*, Paper 6 at 7-9.

Additionally, Kurashige is cumulative to art explicitly cited and considered by the Examiner during prosecution and reexamination. Kurashige is described by Petitioner as disclosing:

> (1) a camera head block including a 720-pixel by 480-pixel CCD image sensor, (2) a camera processing block that receives data from the

> camera head block, includes scanning circuits for both a still picture (JPEG) mode and a moving picture (MPEG) mode, drives the image sensor in a non-line-mixed readout in the JPEG mode to produce 704-pixel by 480-pixel still picture imagery, and drives the image sensor in a line-mixed readout in the MPEG mode to produce 352-pixel by 240-pixel motion picture imagery, and (3) an LCD block that has an 279-pixel by 220-pixel LCD and that receives data from the camera processing block."

Petition at 30-31.

For example, the Casio reference used in reexamination and IPR2020-00597 was described as teaching a CCD image sensor, a processing block for receiving still image and moving image and an LLD block that receives data from the camera:

> Casio teaches a digital camera with multiple modes, each having different pixel resolutions. Casio teaches a megapixel CCD and maximum "Recorded Image Size" for static images of "1280 x 960 pixels." (Casio, 10, 76, 118). An image to be composed is viewable on an LCD viewfinder having 555x220 pixels. (Casio, 119). A moving video is recorded in a 320x240-pixel AVI format. (Casio, 61). Thus, Casio IPR2020-00597 U.S. Patent No. 8,339,493 3 teaches multiple modes, including monitoring (viewing) a still image on an included LCD, recording a still image, and recording a moving video, where each mode has a different pixel resolution.

IPR2020-00597 Paper 1 at 2-3; Ex. LG-1005 at 4512-513.

As an additional example, Misawa '607, the divisional child of a patent examined during prosecution (as explained below), was described in IPR2018-00904, as disclosing a CCD image sensor, control circuitry that processes still and moving images, and an LCD electronic viewfinder:

> **2. *Misawa '607* (Ex.1006)**
>
> U.S. Patent No. 6,700,607 ("*Misawa '607*") is a patent filed by Takeshi Misawa. It was filed on June 4, 1999, issued on March 2, 2004, and was assigned to Fuji Photo Film Co., Ltd. It is prior art under 35 U.S.C. § 102(e).
>
> *Misawa '607* teaches an electronic camera and an image sensor driving method. (Ex.1006 1:8-13; Ex.1004 ¶130-131.) The camera includes a color CCD image sensor with a photosensitive array of 1280x1024 or 1280x960 pixels. (Ex.1006 4:8-10; Ex.1004 ¶132.) The pixels can be arranged in a "G-stripe arrangement in which every one horizontal line includes R, G and B color information" to facilitate interlaced readout. (Ex.1006 4:63-5:3; Ex.1004 ¶134.)

A control circuit and CPU drive the image sensor, whose output signal is processed by analog and digital circuits and then stored in memory. (Ex.1006 4:24-31, 5:50-60, 6:34-58; Ex.1004 ¶140.) The camera also includes an LCD electronic viewfinder, to *inter alia* display a captured still image or a "moving image" captured "before the input of the image-recording start signal" (*i.e.* a preview image). (Ex.1006 6:63-7:1, 7:63-8:3; Ex.1004 ¶138.) *Misawa '607* teaches driving the sensor to read "1/2 of the photoelectric elements or all the photoelectric elements" to enable *inter alia* (1) an "outside output mode" for an external display connected to a video output terminal and (2) a central part enlarging function. (Ex.1006 8:47-9:27; Ex.1004 ¶¶137, 141-146.)

Misawa '607 teaches that, when capturing still images, a frame of image data is read from "all the photoelectric elements" of the image sensor. (Ex.1006 4:45-47, 6:32-34; Ex.1004 ¶139) In contrast, when composing a still picture, preview images can be captured at a high refresh rate by driving the image sensor to read every fourth or eighth pixel line. (Ex.1006 1:65-2:5, 7:60-8:3; Ex.1004 ¶139.) When capturing preview images, the image sensor can be driven at a refresh rate "equal to the frame frequency of a color television signal format" such as NTSC, PAL and SECAM "that is adopted for the display on the LCD 40." (Ex.1006 2:20-24, 8:4-11, 10:64-11:3, 11:21-27, 12:9-15, 12:57-63; Ex.1004 ¶147.)

Olympus Cor. v. Maxell, Ltd., IPR2018-00904 Paper 2 at 21-23 (P.T.A.B. Jun. 20, 2018).

c. Ground 3- Juen '162, Misawa '607

Petitioner admits that Juen '162 and Misawa '607 were previously presented to the Patent Office. Pet. at 72. Juen '162 was previously presented to the Office alongside Casio, Takase, Misawa '482 and considered by the Examiner in Reexamination 90/014,628:

Request for Reexamination of U.S. Patent No. 8,339,493 B2

I. IDENTIFICATION OF CLAIMS FOR WHICH REEXAMINATION IS REQUESTED

In accordance with 37 C.F.R. § 1.510, reexamination of claims 5 and 6 of U.S. Patent No. 8,339,493 is requested in view of the following references:

A. Casio LCD Digital Camera QV-8000SX User's Guide ("*Casio*") (Ex. 1004);

B. U.S. Patent No. 7,903,162 to Juen ("*Juen*") (Ex. 1005);

C. U.S. Patent No. 5,444,482 to Misawa et al. ("*Misawa*") (Ex. 1006); and

D. U.S. Patent No. 5,502,483 to Takase et al. ("*Takase*") (Ex. 1013).

Re-examination of claim 5 is requested under 35 U.S.C. 103(a) as being unpatentable over *Casio* in view of *Juen* and/or *Takase*.

Re-examination of claim 6 is requested under 35 U.S.C. 103(a) as being unpatentable over *Casio* in view of *Juen* and/or *Takase* in further view of *Misawa*.

U.S. Patent No. 8,339,493 is still enforceable.

See Ex. LG-1005 at 4510.

The Examiner issued a non-final office action on September 1, 2021. Claim 5 was rejected under 35 U.S.C. § 103(a) over Casio in view of Juen '162 and Takase '483. Claim 6 was rejected under 35 U.S.C. § 103(a) over Casio in view of Juen '162, Takase '483 and Misawa '482. The Examiner's non-final rejection mapped the elements of the art against elements of Claim 5 and Claim 6. The Examiner also noted that "PO's declarations, filed on April 2021, and their supporting materials are insufficient to antedate the Smith and Reilly references." *See* Ex. LG-1005 at 43-47.

Ultimately the Examiner allowed the Claims of the '493 Patent over these references, as Patent Owner submitted new declarations, sufficient to antedate the Casio reference.

STATEMENT OF REASONS FOR PATENTABILITY AND/OR CONFIRMATION

Clams 5 and 6 are confirmed.

The following is an examiner's statement of reasons for patentability and/or confirmation of the claims found patentable in this reexamination proceeding:

Because Casio has been antedated as a valid reference, the 103 rejections applied against claims 5 and 6 are no longer valid and withdrawn. Since the only rejections applied against the claims 5 and 6 are withdrawn, claims 5 and 6 are confirmed.

Ex. LG-1005 at 9

Juen '162 was also previously presented to the Office in IPR2020-00597 Ground 1 (alongside Casio), Ground 2 (alongside Casio and Takase) and Ground 3 (alongside Casio, Takase, and Misawa '482). As set forth above, the Board used its discretion to deny institution of IPR2020-00597 based on the merits of the presented grounds. *See Apple Inc. v. Maxell, Ltd.*, IPR2020-00597, Paper 9 at 16 (P.T.A.B. September 24, 2020). ("[W]e have identified a potential deficiency in Petitioner's evidence regarding the use of different intervals when mixing or culling signal charges accumulated in the vertically arranged pixel lines based on whether the electric camera is monitoring in a static image mode or recording in a moving video mode.").

Japanese publication No. H11-355665, the priority publication for Misawa '607, was presented to the Office during prosecution and is cited on the face of the '493 Patent. Ex. LG-1002 at 169. A complete translation of this reference (attached as EX2008) is available using the Japan Patent Office's "J-PlatPat" search tool. The examiner of the '493 Patent would have had access to a similar translation of this reference using the JPO website during examination of the '493 Patent and thus would have considered the same subject matter disclosed in Misawa '607.

No. H11-355665 and Misawa '607 have identical figures and substantially the same written description. *Compare* Ex. 2008 (H11-355665) *with* Ex. LG-1012 (Misawa '607). Petitioner fails to acknowledge that the examiner considered the

same subject matter as Misawa '607 in deciding to allow the '493 Patent's claims. Misawa '607 is thus duplicative of the art already considered during examination of the '493 Patent. Art reviewed by the Examiner during their search constitutes art "previously presented to the Office" under § 325(d). *See Advanced Bionics*, Paper 6 at 7-9.

Misawa '607 was previously presented to the Office in Reexamination 90/014,628. Ex. LG-1005 at 267 (May 17, 2021 IDS Statement). The Examiner explicitly noted consideration of the references listed on the Information Disclosure Statements submitted during prosecution using the stamp: "All References Considered Except Where Lined Through." Ex. LG-1005 at 65 (August 22, 2021 Signed IDS Statement). Misawa '607, the divisional child of a patent examined during prosecution (as explained below), was considered by the examiner during prosecution. *See* Pet. at 73-74. Art reviewed by the Examiner during their search constitutes art "previously presented to the Office" under § 325(d). *See Advanced Bionics*, Paper 6 at 7-9.

2. Petitioner Fails To Demonstrate A Material Error By The Office

Regarding part two, Petitioner's attempt to detail material error by the Office utilizes sleight of hand and is cursory. Petitioner argues that i) "neither the Board nor the Office considered Kurashige, (ii) the Board did not make factual findings as

to the teachings of Misawa '607 in IPR2018-00904, (iii) the Board made no factual findings as to the teaching of the combination of Misawa '482 and Parulski '218 in IPR2018-00904, (iv) the Board failed to consider Juen in combination with Misawa '607 as presented in this Petition." Pet. at 74. All Petitioner's arguments fall short.

As explained in the section above, all art used in the Petition was considered by the Patent Office during prosecution, IPRs, or reexamination, and several of the references formed the basis for office actions. This alone is enough for the Board to exercise its discretion and deny institution. *See Clim-A-Tech Ind.*, IPR2017-01863, Paper 13, at 18-19; *Biocon Pharma Ltd.*, IPR2020-01263, Paper 12, 9; *Sony Interactive Entm't LLC*, IPR2020-00711, Paper 15, at 11; *Agrinomix, LLC*, IPR2017-00525, Paper 6 .

Petitioner's first argument, that Kurashinge has never been considered, is incorrect. As explained above, Kurashige **was** presented to the Office in Reexamination 90/014,628. Regardless, Kurashige is duplicative of many of the references considered by the Board and Examiner such as Casio and Misawa '607.

Petitioner's second and third arguments rely on the fact that IPR2018-00904 was resolved before the Board issued an institution decision. Pet. at 74. Petitioner asserts that this shows the Board's consideration of the art was not well developed. Petitioner fails to continue its analysis and explain why the Examiner's consideration

of Misawa '607, Misawa '482, and Parulski '218 during prosecution, and Reexamination 90/014,628, and IPR2020-00597 are not sufficient or identify specific material error.

That the Board has not specifically considered Juen '162 in combination with Misawa '607 also is not material error. Petitioner fails to explain why the Examiner's consideration of Juen '162 and Misawa '607 during prosecution, Reexamination 90/014,628, and in IPR2020-00597 are insufficient. For instance, Petitioner does not explain how the combination of Juen '162 and Misawa '607 overcomes the reasoning the Board used to deny institution in IPR2020-00597. There, the Board found that the combination of Casio, Juen '162 and Misawa '482 did not teach aspects of the 8,339,493 Patent: "[W]e have identified a potential deficiency in Petitioner's evidence regarding the use of different intervals when mixing or culling signal charges accumulated in the vertically arranged pixel lines based on whether the electric camera is monitoring in a static image mode or recording in a moving video mode." *See Apple Inc. v. Maxell, Ltd.*, IPR2020-00597, Paper 9 at 16 (P.T.A.B. September 24, 2020).

All the Petition's references were previously considered during original prosecution, prior IPRs, and reexamination. Some of the references were the subject of prior rejections. There was no material error by the Office. "If reasonable minds can disagree regarding the purported treatment of the art or arguments" by the

examiner, then "it cannot be said that the Office erred in a manner material to patentability." *Advanced Bionics*, Paper 6 at 9.

B. Application of 35 U.S.C. § 314(a) Weighs in Favor of Discretionary Denial

The Petition should also be denied pursuant to 35 U.S.C. § 314(a) because the factors established in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (precedential), weigh in favor of denial due to the parallel District Court Litigation. *Maxell, Ltd. v. LG Electronics Inc. et al.*, No. 5-24-cv-04972 (N.D. Cal.) ("District Court Litigation"). Petitioner's analysis of these factors in the Petition is self-serving and ignores the actual progress and status of the District Court Litigation, thereby minimizing the substantial inefficiencies and prejudice inherent in instituting this duplicative proceeding on an expired patent, particularly given Petitioner's failure to file a *Sotera* stipulation. When properly analyzed based on the court docket, a holistic analysis of the *Fintiv* factors favors denial. Institution would be inconsistent with the AIA's goal of providing an "effective and efficient alternative" where, as here, the District Court is actively adjudicating the same core validity issues. *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, at 20 (P.T.A.B. Sept. 12, 2018).

1. Status of Motion to Stay in Parallel Litigation (Factor 1)

Petitioner LG has filed a Motion to Stay the District Court Litigation Pending Inter Partes Reviews (Dkt. 124, filed Jan 24, 2025). The motion has been fully briefed by the parties (Dkt. 126, 128). However, the scheduled hearing was vacated (Dkt. 130), and the motion remains pending. While the motion is pending, no stay is currently in place, and the outcome is uncertain. Furthermore, significant resources were expended briefing the motion itself. This uncertainty, combined with the fact the case continues to proceed, means this factor weighs in favor of, or at least does not weigh against, denial.

2. Proximity Of The District Court's Trial Date (Factor 2)

Currently, no trial date is set in the parallel District Court Litigation. Following the case's transfer to the Northern District of California and initial scheduling (EX2001), the matter was reassigned to a different judge (Docket #130). Pursuant to the Court's Reassignment Order, all previously scheduled hearing dates were vacated (Docket #130). Therefore, the schedule remains.

While the specific timeline is subject to the Court's scheduling, the *Fintiv* analysis considers the likely timing of trial relative to the Board's statutory deadline. Recent guidance confirms the Board may consider evidence beyond merely a set trial date, including average time-to-trial statistics for the district, recognizing that schedules can change. Based on averages for patent cases in the Northern District of

California, trial often commences approximately 9 months following the Markman hearing. *See* EX2003 (showing that the average time to trial is 31 months and the average time to a Claim Construction order is approximately 22 months). Applying this average timeframe suggests a trial start date around late March 2026, assuming claim construction proceeds without significant delay once rescheduled.

A projected trial start date months before the Board's statutory deadline (approximately August 2026) constitutes significant proximity under *Fintiv*'s holistic framework. The intensive, resource-heavy final trial preparations in the district court would substantially overlap with the concluding months of this IPR proceeding, generating the exact type of parallel litigation inefficiencies that discretionary denial aims to prevent. Petitioner's statistics (LG-1014) are misleading because they fail to account for the work the parties did prior to transfer, and thus the time to trial in the transferee district is likely to be shorter than average.

Importantly, Factor 2 must be weighed holistically with all other *Fintiv* factors. Here, Factor 3 and Factor 4 provide compelling reasons for denial. As detailed below, the parties and the District Court have already invested substantial resources, including extensive motion practice on transfer and pleadings, exchange of detailed infringement and invalidity contentions, and significant discovery. This substantial investment, coupled with the significant overlap between the issues presented here and in the District Court, and the fact the parties are identical (Factor

5), strongly favors denial. Therefore, even when considering the current schedule uncertainty, Factor 2, viewed in light of trial proximity around the time of the Final Written Decision, and the overwhelming weight of other factors, supports the exercise of discretion to deny institution.

3. Significant Investment In The Parallel Proceeding (Factor 3)

The parties' and the court's investment in the parallel District Court Litigation weighs heavily in favor of discretionary denial. Since the case was filed approximately 15 months ago in the Eastern District of Texas on December 29, 2023, significant activity has occurred across two district courts. After contested motion practice regarding venue, the case was transferred to the Northern District of California in August 2024. Notably, Defendants waited nearly a full year after the initial complaint – until late December 2024 and January 2025 – to file the first of their IPR petitions, allowing considerable litigation activity to proceed in the interim.

The substantial work and investment by the parties and the courts before the anticipated Institution Decision deadline is demonstrated by the following completed milestones:

- Complaint Filed in E.D. Texas (December 29, 2023);
- Contested Motion to Transfer Practice in E.D. Tex. (Briefing/Hearing Completed before July 1, 2024);
- Case Transferred to N.D. Cal. (August 9, 2024);

- Defendants' Motion for Judgment on Pleadings (§101) Fully Briefed (Filed October 4, 2024; Opp. and Reply followed);
- Initial Case Management Conference Held in N.D. Cal. (December 4, 2024);
- Entry of Case Management & Scheduling Order (Setting path through Claim Construction) (December 5, 2024);
- Entry of Stipulated Protective Order (December 10, 2024);
- Plaintiff's N.D. Cal. Infringement Contentions Served (December 18, 2024);
- Defendants' Motion to Stay Pending IPRs Fully Briefed (Filed January 24, 2025; Opp. and Reply followed);
- Defendants' Invalidity Contentions Served (February 3, 2025);
- Parties Exchanged Proposed Terms for Construction under Patent L.R. 4-1 (February 18, 2025);
- Parties Exchanged Preliminary Claim Constructions & Extrinsic Evidence under Patent L.R. 4-2 (March 11, 2025);
- Filing of Detailed Joint Case Management Statement (March 17, 2025);
- Substantial Document Production Completed (Parties collectively produced over 300,000 pages as of March 17, 2025);

See EX2002. This extensive activity clearly shows a significant investment by both the parties and the courts. The *Fintiv* analysis for Factor 3 requires assessing this investment as of the date the Institution Decision is anticipated (early August 2025). While Petitioner may have asserted investment was minimal when filing the Petition, that timeframe is not controlling. By the time the Institution Decision is due, the parties and courts will have made a substantial investment progressing this case through significant discovery and the entire claim construction preliminary exchange process. Therefore, the third *Fintiv* factor weighs strongly against institution.

4. There Is Significant Overlap Between Issues Raised In The Petition And In The District Court Litigation (Factor 4)

The issues in this proceeding are substantially the same as in the District Court Litigation. Here, Petitioner asserts that Claims 5-15 of the '493 Patent are unpatentable (Pet. at 1)**.** These claims cover and expand upon the claims asserted by Maxell against Petitioner in the District Court Litigation (claims 10, 12-14). Ex. 2004, ¶ 94**.** Furthermore, the prior art references that Petitioner relies on in supporting its Petition – **are the exact same references Petitioner relies upon to challenge the validity of the '493 Patent in the District Court Litigation**. These references are explicitly listed in Petitioner's (as Defendant LG) own Invalidity Contentions served in the district court case on February 3, 2025. EX2005.

Petitioner's failure to make a *Sotera* stipulation also weighs heavily against institution. As the Board recognized in *Sotera*, such stipulations mitigate concerns regarding "potentially conflicting decisions and duplicative efforts between the district court and the PTAB." *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (P.T.A.B. Dec. 1, 2020). Contrary to making a *Sotera* stipulation, Petitioner, by challenging validity here while litigating in parallel without such a stipulation, evidently intends to pursue the same or similar invalidity defenses using overlapping prior art in this proceeding and the District Court Litigation.

Given that the Petition is directed toward the same patent, encompasses the claims at issue in the parallel District Court proceeding, involves overlapping prior art and arguments, and since Petitioner has not sought to mitigate concerns regarding duplicative efforts or potentially conflicting decisions via a *Sotera* stipulation, this factor strongly favors denial of institution.

5. The District Court Litigation And The Petition Involve The Same Parties (Factor 5)

As noted in Patent Owner's Mandatory Notice, there exists a parallel District Court Litigation between the same parties regarding the same subject patent (the '493 Patent). Petitioner is party to the District Court Litigation. Accordingly, this factor weighs in favor of discretionary denial.

6. Other Factors Favor Discretionary Denial (Factor 6)

Petitioner waited years after receiving notice of the '493 patent on **July 28, 2021** (EX2001) to file this IPR, only after substantial litigation progress. This delay suggests tactical gamesmanship aimed at disrupting the District Court case. As recognized in the Memo regarding discretionary denials, such considerations regarding case management, efficient use of resources, and potential abuse of process may be relevant to the denial analysis and weigh against institution here. This factor favors denial.

Additionally, the '493 Patent expired March 8, 2020. Instituting IPR on a patent that expired over 5 years ago strikes at the core of inefficiency, particularly where Petitioner is pursuing the same invalidity grounds in the District Court litigation.

IV. ADDITIONAL FACTORS SET FORTH IN THE MEMORANDUM SUPPORT DISCRETIONARY DENIAL

Beyond the established frameworks of 35 U.S.C. § 325(d) and *Fintiv*, the Memo clarifies that the Director may weigh additional considerations relevant to fairness and efficiency. Several such considerations further support denying institution here.

A. Settled Expectations

The Memo notes that "settled expectations of the parties, such as the length of time the claims have been in force" may be considered. The '493 patent issued in

December 2012 and relates to technology covered by a family of patents. On August 15, 2012, Patent Owner filed a terminal disclaimer disclaiming term beyond March 8, 2020. This history, coupled with reexamination and multiple past IPRs directed at the '493 Patent, and the expiration of the '493 Patent, contribute to settled expectations regarding the patent's validity.

B. Patent Expiration and Efficient Resource Allocation

The Memo explicitly states that discretionary denial decisions will consider factors bearing on the efficient use of PTAB resources and overall workload management. Instituting review of the '493 Patent, which is expired, presents a clear case of inefficiency warranting denial.

The institution decision in this matter is anticipated around late early August 2025. Proceeding with an IPR on an expired patent is a demonstrably inefficient use of the Board's and the parties' resources. While the Board clearly has jurisdiction to do so in its discretion, committing substantial Board and party resources to adjudicate this patent under these circumstances, particularly while the same validity challenges are concurrently proceeding in the District Court Litigation, is contrary to the goals of improving PTAB efficiency and managing workload, as highlighted in the Memo. This warrants discretionary denial.

C. Petitioner’s Undue Delay and Gamesmanship

The Memo permits consideration of factors bearing on the efficient use of PTAB resources and potential abuse of process. Here, Petitioner waited years to file this IPR petition. Petitioner received notice of the ’493 patent on July 28, 2021, yet did not file this Petition until early 2025 – a delay of over three and a half years. This IPR was filed only after significant progress had been made in the parallel District Court litigation, including transfer, extensive motion practice, and exchange of contentions. Such a lengthy and unexplained delay strongly suggests tactical gamesmanship aimed at disrupting the District Court case rather than seeking an efficient alternative to litigation early in the dispute. This weighs in favor of discretionary denial.

D. Petitioner's Reliance on Expert Testimony

Significant portions of Mr. Hoarty's declaration appear to mirror the Petition’s language, restating arguments and assertions made by Petitioner's counsel often nearly verbatim, without offering sufficient independent analysis, supporting data, or reasoning grounded in specific evidence beyond the Petition's own assertions.

For example, the entirety of Ground 2 element [5.4] the Petition and Mr. Hoarty’s declaration are almost identical:

Petition (Pet. at 38-39)	Hoarty Decl. (Ex.1003, at ¶¶ 167-170)
[5.4] Kurashige-Parulski renders obvious this element. LG-1003 ¶¶167-70. For example, a user operates Kurashige's camera so that a readout mode for the CCD scanning circuits is selected to generate a still picture in the JPEG format (e.g., "*when recording an image in a static image mode a signal processing unit generates image signals*"). LG-1009, 1 tbl.1, 2 §2.2; LG-1003 ¶167. A POSITA would have been motivated, based on the teachings of Parulski, to modify Kurashige's camera to generate the image signals by *using all signal charges accumulated in all N number of vertically arranged pixel lines of the image sensing device, to provide N pixel lines*. LG-1003 ¶168. The still picture produced using Kurashige's camera has a resolution of 704 pixels by 480 pixels, while Kurashige's image sensor has a resolution of 720 pixels by 480 pixels. LG-1009, 1 tbl.1. Parulski describes that in its still mode for producing a still image, all rows of image pixel charge corresponding to each line are progressively read out during a single scan. LG-1007, 6:27-31. A POSITA would have been motivated to modify Kurashige to produce a still image in this manner to obtain a 3:2 aspect ratio image consistent with the aspect ratio of traditional still photography prints produced from the 35-mm film format. *Id.*, 5:4-7; LG-1003 ¶169. This modification would also be desirable to improve the quality of images obtained from the image sensor and improve the quality of these images when displayed on a high-resolution display or printed on a high-quality printer. LG-1007, 4:35-37, 5:49-52; LG-1003 ¶169. And this modification would have had a reasonable expectation of success because Kurashige's and Parulski's image sensors and still image modes have the same purpose of capturing still images. LG-1009, 1 Abstract, 1 tbl.1, 2 §2.2; LG-1007, 1:9-13, 3:29-33; LG-1003 ¶170. A POSITA would have understood that Kurashige's device, as modified, would include a 720-pixel by 480-pixel image sensor that produces a 720-pixel by 480-pixel still image. LG-1003 ¶170.	***[5.4] "wherein when recording an image in a static image mode, the signal processing unit generates the image signals by using all signal charges accumulated in all N number of vertically arranged pixel lines of the image sensing device, to provide N pixel lines;"*** 167. Kurashige-Parulski renders obvious this element. Kurashige discloses that *when recording an image in a static image mode a signal processing unit generates image signals*. For example, a user operates Kurashige's camera so that a readout mode for the CCD scanning circuits is selected to generate a still picture in the JPEG format. LG-1009 at 1 tbl.1, 2 §2.2. 168. A POSITA would have been motivated, based on the teachings of Parulski, to modify Kurashige's camera such that Kurashige's camera generates the image signals by *using all signal charges accumulated in all N number of vertically arranged pixel lines of the image sensing device, to provide N pixel lines*. The still picture produced using Kurashige's camera has a resolution of 704 pixels by 480 pixels, while Kurashige's image sensor has a resolution of 720 pixels by 480 pixels. *Id.* at 1. Parulski describes that in its still mode for producing a still image, all rows of image pixel charge corresponding to each line are progressively read out during a single scan. LG-1007 at 6:27–31. 169. A POSITA would have been motivated to modify Kurashige to produce a still image in this manner—by reading all rows of image pixel charges—so that the aspect ratio of the still picture produced by Kurashige's image sensor would be a 3:2 aspect ratio consistent with the aspect ratio of traditional still photography prints produced from 35 mm film format. *Id.* at 5:4–7; *see supra* Section IX.A. This modification would also be desirable to improve the quality of images obtained from the image sensor and improve the quality of these images when displayed on a high-resolution display or printed on a high-quality printer. LG-1007 at 4:35–37, 5:49–52; *see supra* Section IX.A. 170. Such a modification would have had a reasonable expectation of success because Kurashige's and Parulski's image sensors and still image modes have the same purpose of capturing still images. LG-1009 at 1 Abstract, 1 tbl.1, 2 §2.2; LG-1007 at 1:9–13, 3:29–33. In particular, Kurashige and Parulski both provide still image capture modes, and both use their image sensors to capture the still images in this still image capture mode. LG-1009 at 1 Abstract, 1 tbl.1, 2 §2.2; LG-1007 at 1:9–13, 3:29–33. A POSITA would have understood that Kurashige's device, as modified, would include a 720-pixel by 480-pixel image sensor that produces a 720-pixel by 480-pixel still image and therefore would *generate image signals by using all signal charges accumulated in all N number of vertically arranged pixel lines of an image sensing device, to provide N pixel lines*, as taught in Parulski.

The above examples are exemplary and pervade the Hoarty declaration.

Such parroting of attorney argument diminishes the weight, if any, that should be accorded to the testimony. *See Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 12 (P.T.A.B. Feb. 10, 2023) (precedential) (according "little weight" to declaration testimony that contains a verbatim restatement of a petition's conclusory assertions without additional supporting evidence or reasoning); *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1340–41 (Fed. Cir. 2020) (affirming Board decision giving no weight to expert testimony that "merely repeated Petitioner's argument, nearly verbatim, without citation to the basis for his testimony"); *see also Wowza Media Sys., LLC v. Adobe Sys. Inc.*, IPR2013-00054, Paper 12 at 12 (P.T.A.B. Apr. 8, 2013) ("The Declaration . . . appears, for the most part, simply to track and repeat the arguments for unpatentability presented in the Petition [and] . . . is therefore no more helpful tha[n] the Petition in determining where the challenged recitation is found in the references."). This practice raises concerns under 37 C.F.R. § 42.65(a). *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.").

Accordingly, Petitioner's improper use of expert testimony further supports discretionary denial under 35 U.S.C. § 314(a).

E. The Board Should Reject Any Late *Sotera* Stipulation

Petitioner has not made a *Sotera*-style stipulation—that "if IPR is instituted, [Petitioner] will not pursue in the District Court Litigation any ground raised or that could have been reasonably raised in an IPR"—in its Petition, which weighs further in favor of discretionarily denying institution. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, 13-14 (P.T.A.B. Dec. 1, 2020) (precedential). The Board should not accept any late *Sotera* stipulation potentially offered after this Request for Discretionary Denial. Any withholding of the *Sotera* stipulation in the Petition is gamesmanship and prejudicial to Patent Owner in this proceeding, and is inconsistent with 37 C.F.R. § 42.1(b)'s mandate to "secure the just, speedy, and inexpensive resolution of every proceeding." Indeed, Petitioner's gamesmanship in this regard prejudices Maxell because Maxell is forced to prepare overlapping validity defenses in the District Court Litigation and this proceeding throughout the pendency of this Petition.

Additionally, on February 28, 2025 the Office *rescinded* former Director Vidal's 2022 memorandum on discretionary denials which placed significant weight on such stipulations. The announcement rescinding former Director Vidal's 2022 memorandum went on to state that decisions relying on the 2022 memo will be "*neither binding or persuasive on the PTAB*." On March 24, 2025 the Office released a memo providing guidance following the rescission of Director Vidal's 2022 memo.

That memo provided that a *Sotera* stipulation would be "highly relevant, but will not dispositive in itself." Ex. 2006 at 2-3. Petitioner's failure to provide a *Sotera* stipulation along with its Petition has prejudiced and continues to prejudice Maxell. In view of the above and in the event the Petitioner files a late *Sotera* stipulation, the stipulation should not be considered persuasive.

These additional factors, highlighted by recent USPTO guidance, provide further independent bases for the Director to exercise discretion and deny institution of this IPR petition.

V. CONCLUSION

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

Dated: April, 11, 2025

Respectfully submitted,

/Robert G Pluta Reg No 50970 /

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CERTIFICATE OF SERVICE

I hereby certify that on this 11th day of April, 2025, a copy of the attached Brief in Support of Patent Owner's Request for Discretionary Denial, together with all exhibits was served by electronic mail to the attorneys of record, at the following addresses:

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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 and 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 6,259 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

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