

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OMNIVISION TECHNOLOGIES, INC.,
Petitioner,

v.

RE SECURED NETWORKS, LLC,
Patent Owner.

Case IPR2025-01019
U.S. Patent No. 6,838,651

**PETITIONER'S RESPONSE TO PATENT OWNER'S
REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION**

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

TABLE OF CONTENTS

I.	Introduction.....	1
II.	Argument	1
	A. Petitioner’s Untimely Request Should be Deemed Waived.....	1
	B. The <i>Fintiv</i> Factors Favor Institution	2
	1. The district court case remains substantively in the early stages.....	2
	2. It is likely that the district court schedule will be extended	5
	3. Petitioner’s Stipulation would result in minimal overlap with the district court case	6
	4. The merits of the Petition weigh in favor of institution	6
	C. Settled Expectations Considerations Weigh in Favor of Institution.....	7
III.	Conclusion	9

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Apple Inc. v. Allani</i> , IPR2025-00856, -00857.....	7, 8
<i>Imperium (IP) Holdings v. Apple, Inc et al.</i> , Case No. 4:11-cv-00163-RC-ALM (E.D. Tex.).....	7, 8
<i>Sotera Wireless, Inc. v. Masimo Corp.</i> , Case No. IPR2020-01019, Paper 12 (P.T.A.B. Dec. 1, 2020)	5
Other Authorities	
37 C.F.R. § 42.5(c)(3).....	2
37 C.F.R. § 42.25(b)	2
37 C.F.R. § 42.100	5

EXHIBITS

Exhibit	Description
1001	U.S. Patent No. 6,838,651
1002	Declaration of Albert Theuwissen, Ph.D.
1003	Curriculum vitae of Albert Theuwissen, Ph.D.
1004	File History Items of U.S. Patent No. 6,838,651
1005	Japanese Patent Application Pub. No. 2000-12819 (“ <i>Isogai</i> ”) including English-language translation, Japanese-language version, translation certificate
1006	U.S. Patent No. 5,982,984 to Inuiya <i>et al.</i> (“ <i>Inuiya</i> ”)
1007	U.S. Patent No. 7,133,073 to Neter (“ <i>Neter</i> ”)
1008	U.S. Patent No. 6,704,049 to Fossum (“ <i>Fossum</i> ”)
1009	[RESERVED]
1010	Loinaz <i>et al.</i> , “A 200-mW, 3.3-V, CMOS Color Camera IC Producing 352 x 288 24-b Video at 30 Frames/s,” <i>IEEE Journal of Solid-State Circuits</i> , Vol. 33, No. 12, December 1998 (“ <i>Loinaz</i> ”)
1011	U.S. Patent No. 6,115,065 to Yadid-Pecht <i>et al.</i> (“ <i>Yadid-Pecht</i> ”)
1012	U.S. Patent No. 6,882,364 to Inuiya <i>et al.</i> (“ <i>Inuiya-364</i> ”)
1013	U.S. Patent No. 5,982,318 to Yiannoulous (“ <i>Yiannoulous</i> ”)
1014	Petition for Inter Partes Review of U.S. Patent No. 6,838,651; Proceeding No. IPR2021-00437 (“ <i>IPR2021-00437</i> ”)
1015	Declaration of R. Jacob Baker, Ph.D., P.E. in Support of Petition for Inter Partes Review of U.S. Patent No. 6,838,651; Proceeding No. IPR2021-00437 (“ <i>Baker Declaration</i> ”)
1016	<i>OmniVision Technologies, Inc. v. RE Secured Networks, LLC</i> , Case No. 24-187-JLH-CJB (D. Del.), Complaint (Dkt. No. 1) and Joint Claim Construction Brief (Dkt. No. 89)
1017	<i>OmniVision Technologies, Inc. v. RE Secured Networks, LLC</i> , Case No. 24-187-JLH-CJB (D. Del.), <i>Markman</i> Hearing Transcript
1018	<i>OmniVision Technologies, Inc. v. RE Secured Networks, LLC</i> , Case No. 24-187-JLH-CJB (D. Del.), Oral Order Pursuant to <i>Markman</i> Hearing (Dkt. No. 110)
1019	U.S. District Court Caseload Profiles (June 30, 2025), available at https://www.uscourts.gov/sites/default/files/document/fcms_na_distprofile0630.2025.pdf .

I. INTRODUCTION

Petitioner OmniVision Technologies, Inc. (“Petitioner”) respectfully requests that the Director decline to exercise her discretion to deny institution of *inter partes* review. Patent Owner RE Secured Networks, LLC’s (“Patent Owner”) request is not only untimely, but it also overlooks critical factors necessary to perform a proper analysis under *Fintiv*. Furthermore, Patent Owner’s arguments with respect to settled expectations ignore the fact that it waited for nearly a decade to assert the now expired ’651 patent, a delay which the Director has recently found counsels against exercising discretion to deny institution. Moreover, Patent Owner has engaged in dilatory conduct that has delayed claim construction and has yet to take a single deposition in the parallel district court case.

II. ARGUMENT

A. Petitioner’s Untimely Request Should be Deemed Waived

The Director’s Memorandum is clear that any request for discretionary denial of institution must be filed “within two months of the date on which the PTAB enters a Notice of Filing Date Accorded to a petition.” Director’s Memorandum at 2. The PTAB entered a Notice of Filing Date Accorded to the petition in the instant proceeding on June 18, 2025 (Paper 3), meaning Patent Owner’s Request was due on August 18, 2025. Patent Owner did not file its request until August 20, 2025, nor did it request any excuse for its untimely filing.

The Board's rules provide that "[a] party should seek relief promptly after the need for relief is identified. Delay in seeking relief may justify a denial of relief sought." 37 C.F.R. § 42.25(b). "A late action will be excused on a showing of good cause or upon a Board decision that consideration on the merits would be in the interests of justice." 37 C.F.R. § 42.5(c)(3). Patent Owner has made no such showing. As Patent Owner failed to follow the Director's March 26, 2025 guidance, its request for discretionary denial should be deemed waived.

B. The *Fintiv* Factors Favor Institution

1. The district court case remains substantively in the early stages

The bulk of the work and investment in the litigation (particularly as it relates to the validity of the '651 patent) lies ahead. For example, the district court has not yet issued a claim construction order. Patent Owner noted, without elaboration, that "[t]he Markman hearing took place on August 11, 2025, with any disputes remaining following subsequent discussions between the parties to be addressed by the Court at a later date." Mot. at 9. Yet Patent Owner ignores that the Court declined to rule on any disputes concerning the '651 patent and was frustrated with Patent Owner's failure to be forthcoming regarding its claim constructions. EX1017 (*Markman* Hearing Transcript) at 202:5 – 203:1.

After the *Markman* hearing, the district court issued an order stating that “[d]uring the August 11, 2025 *Markman* hearing in this case, the Court discussed with the parties how the parties’ pre-hearing work did not sufficiently identify and tee up the core claim construction disputes as to a number of the terms at issue (exacerbated by RE Secured Networks’ failure to clearly articulate its proposed claim constructions for certain terms in writing during the briefing process)—and how this led to an inefficient *Markman* hearing and a waste of judicial resources.” EX1018 (Oral Order Pursuant to *Markman* Hearing). Indeed, the Court never even heard any argument from the parties concerning Patent Owner’s position that “combining the first, second, third, and fourth digital signals” does not require combining the four digital signals. *See* EX1016 (Joint *Markman* Briefing) at 128-131, 134-137; EX1017 at 202:20 – 203:1. Patent Owner’s general unwillingness to set forth their understanding of the claim scope was primarily to blame. EX1017 at 202:5-19.

In light of the wasted efforts during the hearing, the Court ordered the parties to further meet and confer regarding various disputed terms and advise the Court of any such remaining disputes no later than 21 days prior to the summary judgment motion filing deadline. Indeed, based on the Court’s order, there is a likelihood that further claim construction issues will arise throughout the case, necessitating extensions to the current schedule.

Beyond claim construction, much of fact discovery remains left to complete. For example, no depositions have been taken (party or third-party, individual or 30(b)(6)). Expert discovery, where much of the pre-trial effort by the parties in addressing the validity of the '651 patent will lie, will not start until the end of October 2025. EX2004 at 5-6. Briefing and the hearing on *Daubert* and dispositive motions lie even further in the future, in February and March 2026. EX2004 at 6, 13-15.

Because there is much work left to be done in the district court litigation and there is no claim construction order, the current investment in the parallel proceeding is likely to result in the duplication of efforts and costs. *See Fintiv*, Paper 11 at 10 (“This investment factor is related to the trial date factor, in that more work completed by the parties and court in the parallel proceedings tends to support the arguments that the parallel proceeding is more advanced, a stay may be less likely, and instituting would lead to duplicative costs.”).

Patent Owner also suggests that Petitioner was less than diligent in filing the Petition and that the timing of the filing supports its Request. *See* Paper 9 at 11-12. Patent Owner is mistaken. Petitioner diligently filed its well-supported Petition within the statutory deadline, without the benefit of Patent Owner’s amended infringement contentions (which were just supplemented on September 10, 2025, and for which Petitioner raised new arguments for the first time), and

many months before Petitioner's final invalidity contentions are due. EX2005 at 2. *See, e.g., Sotera Wireless, Inc. v. Masimo Corp.*, Case No. IPR2020-01019, Paper 12 at 17 (P.T.A.B. Dec. 1, 2020) ("*Sotera*") (finding the timing of the petition was reasonable where "Petitioner filed its Petition approximately two months after serving its initial invalidity contentions, and approximately two weeks before the statutory deadline.").

2. It is likely that the district court schedule will be extended

The discussion in the Section above assumes that the district court case will proceed on its current schedule. However, multiple factors suggest that the district court schedule will be extended. A final written decision in this proceeding is expected to issue in December 2026. *See* 37 C.F.R. § 42.100. The current schedule in the parallel district court proceedings indicates that a jury trial will take place in October 2026. EX2004 at 16-17. However, based on the Court's statements during the *Markman* hearing and the resulting order (discussed above), it remains likely that the schedule will need to be adjusted further in order to account for the parties' additional claim term disputes. *See* EX1017 at 201:22-25 ("there's not much I can do about [the remaining disputes] right now, except to implore you and Delaware counsel as well, that something different would have to happen the next *Markman* you have."). This is consistent with the June 30, 2025 statistics for civil cases filed in Delaware, which indicates that the median time

from filing to trial for civil cases is 35 months, putting the estimated trial date in January 2027, after the Board's final written decision deadline. *See* EX1019 (U.S. District Court Caseload Profiles) at 14.

3. Petitioner's Stipulation would result in minimal overlap with the district court case

To the extent that any concern remains regarding potential inefficiency or duplication of efforts with respect to the parallel district court case, Petitioner provides the following stipulation:

Petitioner stipulates that if *inter partes* review is instituted for a claim of U.S. Patent No. 6,838,651 in IPR2025-01019, Petitioner will not assert that the claim is invalid in the related district court proceeding based on any grounds that include prior art asserted in this proceeding.

In the event that any claims survive this *inter partes* review, Petitioner's stipulation minimizes the possibility of overlapping issues between this proceeding and the district court case.

4. The merits of the Petition weigh in favor of institution

For starters, neither the PTAB nor another forum has fully adjudicated the validity or patentability of the challenged patent claims to a final decision. As noted in the Petition, none of the prior art presented in the Petition was identified during prosecution. Pet. at 5. The failure to identify and appreciate such material prior art references should not only weigh against discretionary denial generally, it

should also weigh specifically against any alleged “settled expectations” of Patent Owner, as further explained below.

The challenged claims are predated by two separate anticipatory references as set forth in the Petition. The invalidity case here is straightforward and does not include complicated analysis. Moreover, Petitioner has asserted that “circuit” can include any hardware or software implementations and that combining four digital signals does not even require all four signals being combined. *See* EX1016 at 128-31, 134-37. There is no perceivable basis by which Petitioner can assert that the claims are not invalid in view of the cited prior art references.

C. Settled Expectations Considerations Weigh in Favor of Institution

Patent Owner’s arguments regarding settled expectations ignore that reliance on such expectations can swing both ways. *See Apple Inc. v. Allani*, IPR2025-00856, -00857, Paper 10 (P.T.A.B. Sept. 4, 2025). Petitioner became aware of the ’651 Patent as of late October 2012. The ’651 patent was previously asserted by Patent Owner’s predecessor in interest to the ’651 patent (Imperium (IP) Holdings (“Imperium”)) against companies that incorporated Petitioner’s image sensors in *Imperium (IP) Holdings v. Apple, Inc et al.*, Case No. 4:11-cv-00163-RC-ALM (E.D. Tex.) (the “Apple Litigation”). Petitioner was made aware of the ’651 patent by one or more defendants in the matter. *See* EX2008. Imperium undoubtedly became aware of Petitioner’s image sensors as part of the same litigation. But the

Apple Litigation settled (*see* EX2008 at 3-4), and for years thereafter, Petitioners heard nothing regarding the '651 patent. Petitioners naturally assumed that they had become licensed to the '651 patent through Imperium's settlement with Apple Inc. As such, Petitioners had no reason to challenge the '651 patent. However, in 2022—almost ten years after the Apple Litigation settlement—Patent Owner acquired the '651 patent and attempted to assert it against Petitioner.

Similar factors have been found to weigh against discretionary denial. In *Apple Inc. v. Allani*, IPR2025-00856, -00857, Paper 10 (P.T.A.B. Sept. 4, 2025), petitioner acknowledged that it was aware of the challenged patent in 2012. *Id.* at 3. At the time of the petition, the challenged patent had been in force for 13 years. *Id.* The *Allani* petitioner contended that it “did not expect enforcement” of the challenged patent because it had concluded that it did not require a license to the patent. *Id.* The patent owner in *Allani* was aware of petitioner in 2012, having exchanged communications regarding the very patent that was later challenged, but it refrained from asserting the patent against petitioner until many years later. *Id.* Furthermore, “[the Allani patent owner] did not assert the challenged patents against [petitioner] until after they expired”—identical to the instant proceeding. *Id.* “Under these circumstances, discretionary denial is not appropriate.” *Id.*

III. CONCLUSION

For the reasons stated above, Petitioner respectfully asks the Director to deny Patent Owner's request for discretionary denial of institution in this proceeding.

Date: September 18, 2025

Respectfully submitted,

/David H. Bluestone/

David H. Bluestone (Reg. No. 44,542)

BENESCH FRIEDLANDER

COPLAN & ARONOFF LLP

71 South Wacker Drive, Suite 1600

Chicago, IL 60606

Tel: (312) 312-4949

Fax: (312) 767-9192

dbluestone@beneschlaw.com

CERTIFICATE OF WORD COUNT UNDER 37 C.F.R. § 42.24

I, the undersigned, do hereby certify that the foregoing Patent Owner Preliminary Response, including footnotes, contains 1,912 words, as measured by the Word Count function of Microsoft Word as specified by 37 C.F.R. § 42.24.

/David H. Bluestone/

David H. Bluestone

CERTIFICATE OF SERVICE

I hereby certify that on September 18, 2025, a true and correct copy of the foregoing was served by electronic mail upon the following counsel of record for

Petitioners:

ari.jaffess@listonabramson.com
ron.abramson@listonabramson.com
michael.lewis@listonabramson.com
gina.kim@listonabramson.com
asewanan@kasowitz.com
tgilman@kasowitz.com
dapgar@kasowitz.com

/David H. Bluestone/

David H. Bluestone