

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OmniVision Technologies, Inc.,
Petitioner,

v.

RE Secured Networks, LLC,
Patent Owner.

U.S. Patent No. 6,838,651

Inter Partes Review Case No. 2025-01019

**PATENT OWNER'S REPLY IN SUPPORT OF ITS REQUEST FOR
DISCRETIONARY DENIAL OF INSTITUTION**

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LIST OF PATENT OWNER’S EXHIBITS

Exhibit	Description
2001	Docket in parallel litigation as of Aug. 20, 2025
2002	Amended Answer (Docket No. 57 in parallel litigation), filed Oct. 28, 2024
2003	Excerpt of Plaintiff’s Preliminary Invalidity Contentions in parallel litigation, dated Jan 15, 2025
2004	Scheduling Order (Docket No. 35 in parallel litigation), dated Jul 31, 2024
2005	Amended Scheduling Order (Docket No. 56 in parallel litigation), dated Oct. 25, 2024
2006	Amended Scheduling Order (Docket No. 76 in parallel litigation), dated March 11, 2025
2007	Docket Navigator Time to Trial Statistics for the District of Delaware from Jan. 1, 2019 through Aug. 20, 2025
2008	Excerpt of OmniVision Technologies, Inc.’s Responses and Objections to Defendant’s First Set of Interrogatories (Nos. 1-6) in parallel litigation, dated Jan. 22, 2025
2009	Nov. 1, 2021 email asserting infringement against OmniVision
2010	Claim chart for U.S. Patent No. 6,838,651, attached to Nov. 1, 2021 email
2011	Excerpts of OmniVision Technologies, Inc.’s Identification of Prior Art References from the parallel litigation, dated Aug. 26, 2025
2012	Stipulation and [Proposed] Order to Amend Scheduling Order from the parallel litigation, dated Sept. 23, 2025
2013	Docket in parallel litigation as of Sept. 29, 2025

As authorized via email (Exhibit 3101), Patent Owner respectfully submits this Reply in Support of its Request for Discretionary Denial of Institution.

I. SETTLED EXPECTATIONS

Petitioner raises *Apple Inc. v. Allani*, IPR2025-00856, -00857, Paper 10 (P.T.A.B. Sept. 4, 2025) in its response to argue that settled expectations “can swing both ways.” Paper 12 at 6. While that may be true in some cases, Petitioner overlooks a number of factors that distinguish *Apple v. Allani* from the current case.

For example, Petitioner argues that “[the Allani patent owner] did not assert the challenged patents against [petitioner] until after they expired.” Paper 12 at 3 (alterations in original). But importantly, the *Allani* patent owner failed to bring suit against Apple “*or anyone else*” regarding the patent in question prior to its expiration. *See Allani*, IPR2025-00856, Paper 8 (Apple’s opp.) at 15. In contrast to *Allani*, here, Patent Owner’s predecessors in interest had asserted the ’651 Patent in multiple proceedings in the same technology space as Petitioner prior to the ’651 Patent’s expiration (Paper 9 at 11-12), some of which included assertions against some of Petitioner’s own customers—who made Petitioner aware of the assertions.¹

¹ Regarding assertion after expiration, Patent Owner is aware of two other cases—not cited by Petitioner—in which the Board considered patent expiration, both distinguishable because the patents were never asserted prior to expiration. *Globus*

Further, in *Allani*, in addition to never having been litigated, the *Allani* patent owner had contacted Apple about the challenged patent eleven years prior, Apple “concluded that it did not require a license to the patent *and advised Patent Owner of its position*” and the *Allani* patent owner then waited eleven years to assert the patent against Apple. Whereas Apple communicated to the *Allani* patent owner that it did not need a license, here, Petitioner’s customers *settled its litigations* against Patent Owner’s predecessors in interest. And the ’651 Patent has been licensed by some of the world’s largest technology companies. Thus, *Allani* is inapposite.

Moreover, Petitioner’s argument that it *thought* it had a license to the ’651 Patent because Apple settled a previous litigation against Patent Owner’s

Medical, Inc. v. Spinelogik, Inc. IPR2025-00225, Paper 8 at 2 (P.T.A.B. June 12, 2025) (patent in force for only four years, expired for failure to pay maintenance fee, never asserted until after expiration); *Google LLC v. Sandpiper CDN, LLC*, IPR2025-00806, Paper 13 (P.T.A.B. Sept. 12, 2025) (patent not previously asserted against anybody) (IPR2025-00806, Paper 9 (Google’s opp.) at 16). Further, under a totality of the circumstances, both parallel proceedings in question were stayed, *Sandpiper* pending institution (IPR2025-00806, Paper 13 at 2) and *Globus* for a transfer decision (IPR2025-00225, Paper 8 at 2). Here, there is no stay.

predecessor in interest (Paper 12 at 7) cannot swing the settled expectations analysis in Petitioner's favor. How a license granted to one of Petitioner's customers could lead to Petitioner believing that it had a blanket license to sell image sensors to other customers defies logic. If anything, that one of Petitioner's customers took a license only reinforces that Petitioner should have been aware that Petitioner itself needed a license in order to sell its image sensors to its customer base.

Importantly, even setting aside the previous litigations, Petitioner here was aware of the potential assertion of the '651 Patent against it based on extensive pre-suit discussions specifically involving the '651 Patent for over two years prior to Petitioner's filing of the declaratory judgment action. *See, e.g.* Exs. 2009, 2010 (Nov. 1, 2021 email asserting infringement against OmniVision, and attached claim chart for '651 Patent). Thus, Petitioner had no settled expectations that the '651 Patent would not be asserted against it. And despite this, and despite copying grounds from a prior IPR and improperly re-submitting an expert declaration therefrom, Petitioner waited until the last possible day to file the instant Petition.

II. PETITIONER'S NEW STIPULATION IS INSUFFICIENT TO AVOID DUPLICATION IN CASE OF INSTITUTION

Petitioner submitted a stipulation as part of its response brief (Paper 12 at 5). Notably, this stipulation falls short of a *Sotera* stipulation, stating only that in case of institution, Petitioner will not assert invalidity in the parallel proceeding "based on any grounds that include prior art asserted in this proceeding." Paper 12 at 5.

Petitioner's stipulation, however, does not prohibit Petitioner from raising in the parallel litigation any ground that Petitioner "raised *or reasonably could have raised*" in the instant Petition. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (P.T.A.B. Dec. 1, 2020). Thus, Petitioner's stipulation is insufficient to make this proceeding a "true alternative" to the parallel litigation.

Though the core of Petitioner's invalidity case in the parallel litigation is the four references at issue in this IPR, as shown by the fact that it charted only the four references in its contentions (Ex. 2003), there are many potential combinations of the 100 references identified in the parallel litigation without the four references specifically at issue in the instant Petition. Thus, Petitioner's stipulation leaves much room for duplication of effort in the parallel litigation if review should be instituted. This stipulation is therefore insufficient to make the instant proceeding a "true alternative" to the validity challenge of the '651 in the parallel proceeding.²

² Even *Sotera* stipulations (which this is not), were found insufficient due to potential combinations in the parallel proceeding with unpublished system prior art. *See, e.g., Shenzhen Tuozhu Tech. Co. v. Stratasys, Inc.*, IPR2025-00354, Paper 11 at 2-3 (P.T.A.B. June 12, 2025). There is no asserted unpublished system art in the parallel proceeding, but Petitioner listed 100 printed publications for the '651 Patent (Ex. 2011 at 2), which Petitioner stated it will use alone or in combination.

III. THE TRIAL DATE HAS NOT MOVED

Any suggestion that the trial date in the parallel litigation will move is mere speculation. The parties filed a joint stipulation to amend the case schedule *one day* after Petitioner's response brief (where Petitioner speculated that, because of the *Markman* hearing, the trial date will move), which stipulation was then ordered by the court. Exs. 2012, 2013 at 22. Notably, while some earlier dates in the case schedule were shifted by a few weeks, the end of the schedule – the reply briefing on case dispositive motions and the hearing on those motions – was unchanged. Ex. 2012 at 2. And the joint stipulation noted that other dates in the prior scheduling order remain the same. *Id.* Thus, the October 2026 trial date *remains unchanged* and precedes the expected Final Written Decision herein. Paper 9 at 4-6.

Patent Owner notes that significant work has been done and will be done by the time of an institution decision herein, including final invalidity contentions, all remaining fact discovery, and opening and rebuttal expert reports. Ex. 2012 at 2. As previously argued, a stay in the parallel case is unlikely even if review is instituted herein (Paper 9 at 7-10), which argument Petitioner has not rebutted.

* * *

For these and all of the reasons in Patent Owner's opening brief, Patent Owner respectfully requests the Director to discretionarily deny institution.

Dated: September 29, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.205(b), the undersigned hereby certifies that on September 29, 2025, a complete and entire copy of the foregoing **Patent Owner's Reply in Support of its Request for Discretionary Denial of Institution** and Exhibits 2009-2013 were served on Petitioner by filing through the Patent Trial and Appeal Case Tracking System (P-TACTS) and via email to dbluestone@beneschlaw.com, cmcmahon@beneschlaw.com, tdamario@beneschlaw.com, and chemphill@beneschlaw.com, as authorized in Petitioner's mandatory notices:

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