

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZOOM COMMUNICATIONS, INC.
Petitioner

v.

RICOH COMPANY, LTD.
Patent Owner

IPR2026-00407
U.S. PATENT NO. 10,904,487

**PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL**

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PETITIONER'S EXHIBIT LIST

No.	Reference	Referred To As
1001	U.S. Patent No. 10,904,487	'487 Patent
1002	Prosecution History of U.S. Patent No. 10,904,487	'487 Patent File History
1003	Declaration of Dr. Kevin Almeroth	Almeroth Decl.
1004	U.S. Patent No. 8,593,502	Saleh-502
1005	U.S. Patent Publication No. 2016/0301729	Gurevich
1006	U.S. Patent Publication No. 2015/0002435	Shimizu
1007	U.S. Patent Publication No. 2002/0085030	Ghani
1008	U.S. Patent No. 8,872,879	Saleh-879
1009	U.S. Patent No. 9,363,448	Segal
1010	U.S. Patent No. 9,716,861	Poel
1011	U.S. Patent No. 7,694,234	Fleisher
1012	U.S. Patent No. 9,648,057	Thomas
1013	Chinese Patent CN 104135484	CN-484
1014	Chinese Utility Model CN 203984563	CN-563
1015	German Patent DE102004041884	Han
1016	"SMART Board(TM) Interactive Whiteboard Reaches 20-Year Milestone."	SMART Board 20-Year

	NBC News, 12 Jan. 2011, www.nbcnews.com/id/wbna41034457 .	
1017	SMART Technologies. "SMART Action Research." 2010, downloads.smarttech.com/media/edcompass/may2010/smartactionresearch.pdf .	Smart Technologies Research
1018	Patrick, Andrew S. "The Human Factors of Mbone Videoconferences: Recommendations for Improving Sessions and Software." June 23, 2006	Mbone Video Conferences
1019	Rollins, S., and K. Almeroth. Seminal: Additive Semantic Content for Multimedia Streams. Proceedings of Internet and Multimedia Systems and Applications (IMSA 2002), Aug. 2002	Content for Multimedia Streams
1020	Almeroth, Kevin, et al. Creating a Demarcation Point Between Content Production and Encoding in a Digital Classroom. Proceedings of ED-MEDIA 2003—World Conference on Educational Multimedia, Hypermedia & Telecommunications	Encoding in a Digital Classroom
1021	<i>Intel. 2nd Generation Intel® Core™ Processor Family Desktop, Intel® Pentium® Processor Family Desktop, and Intel® Celeron® Processor Family Desktop Datasheet</i> , Volume 1. June 2013	2nd Generation Intel Core
1022	<i>Panasonic Announces Panaboard Interactive Whiteboards with Integrated PC</i> . Tom's Hardware,	Panaboard Interactive Whiteboards
1023	von Neumann, John. Draft of a Report on the EDVAC. Moore School of Electrical Engineering, University of Pennsylvania, 1945	Von Neumann 1945

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1024	U.S. Patent Publication 2019/0335143	Nelson
1025	Ricoh's Prelim Disclosure of Asserted Claims & Infringement Contention	Ricoh's Litigation Infringement Contentions
1026	<i>Ddrops Co. v. MOM Enters., LLC, C.A. No. 1:22-cv-00332-GBW, Dkt 132 (D. Del. Oct. 23, 2023)</i>	D. Del. Order to Stay
1027	Docket Navigator Listing of Docket Entries for <i>Ricoh Company, Ltd. v. Zoom Communications, Inc.</i>, No. 1:25-CV-01095-JCG (D.Del.) dated October 6, 2026.	District Court Docket
1028	Petitioner's Stipulation for <i>Ricoh Company, Ltd. v. Zoom Communications, Inc.</i>, No. 1:25-CV-01095-JCG	Sotera+ Stipulation

I. INTRODUCTION

Ricoh's request for discretionary denial should be rejected. Zoom filed IPR petitions challenging all seven patents Ricoh asserted in an underlying litigation, and each petition presents compelling prior art grounds that the Patent Office never considered. Ricoh's arguments rest on inflated settled expectation timelines, mischaracterized procedural history, and the erroneous premise that efficient case management amounts to gamesmanship. None of these arguments withstand scrutiny.

Zoom's IPR timing was responsible. When Ricoh sued in August 2025, Zoom moved to dismiss all seven patents as ineligible abstract ideas under Section 101 ("Motion"). Rather than reflexively filing seven IPR petitions, Zoom waited for the decision on its Motion. That maximized efficiency of the Board's resources: if the district court had invalidated the patents on eligibility grounds, the IPRs would have been unnecessary and would have wasted Board resources while the Motion was pending. Once the court denied the Motion under Step 2 in May 2026, Zoom filed all seven petitions within a two-month window. This is a resource-conscious approach the Board should encourage.

Ricoh's "settled expectations" argument is equally unavailing. The '487 Patent has been in force for only about five years, and the other six asserted patents challenged by Zoom issued *after* the '487 Patent and are even newer. Ricoh's

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attempts to inflate these timelines by bootstrapping ***parent*** patent dates and application publication dates are inconsistent with Director guidance, which focuses on how long the ***challenged patent's*** claims have been in force. Moreover, Zoom demonstrated material Examiner error: the Examiner never considered the most relevant art, including Saleh-502 and Gurevich, which disclose the limitation the Examiner identified as the basis for allowance.

In addition, the merits are strong in this Petition, and also across all seven petitions. Zoom's prior art challenges present focused, streamlined grounds built on references the Office never considered. Zoom is also submitting a broad stipulation exceeding the traditional *Sotera* framework, ensuring these IPRs serve as true alternatives to district court litigation. Therefore, Ricoh's request for discretionary denial should be denied.

II. ZOOM SEEKS EFFICIENCY, NOT GAMESMANSHIP

A. Zoom's IPR Timing Maximized Efficiency

Had Zoom filed IPRs immediately and then prevailed on its Motion, it would have wasted Board and party resources on unnecessary proceedings. Zoom pragmatically chose to let the district court resolve threshold eligibility first.

Zoom's assertion that it had strong grounds to believe its Section 101 defense would resolve the case was justified. In response to Zoom's Motion to Dismiss all seven asserted patents as ineligible, the Court ***agreed*** that all challenged claims are

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directed to an abstract idea as a matter of law. EX2004, 17, 25, 32, 38, 44, 50, 56.

The Court only denied Rule 12 dismissal on the basis that Ricoh's 212-page complaint presented questions of fact under *Alice*, Step Two. *Id.* Filing IPRs before the Court ruled on threshold eligibility issues would have committed the Board and both parties to multiple proceedings over patents that the Court might well have invalidated on Section 101 alone.

Once the Court ruled on Zoom's Section 101 motion on May 1, 2026, Zoom moved quickly. The '487 Patent IPR was filed just two months later, on July 1, 2026. Zoom then filed IPRs for the remaining six asserted patents in rapid succession: the '464 Patent (IPR2026-00411) on July 10, 2026; the '059 Patent (IPR2026-00424) on July 24, 2026; the '548 Patent (IPR2026-00435) on August 4, 2026; the '093 Patent (IPR2026-00461) and '917 Patent (IPR2026-00453) on August 24, 2026; and the '278 Patent (IPR2026-00470) on September 2, 2026. All seven IPRs were filed within an approximate two-month period, reflecting Zoom's diligent and efficient validity challenge to the asserted patents once its Motion was no longer pending.

This demonstrates precisely the kind of responsible strategy the Board should encourage, not penalize. Zoom waited only as long as necessary to see whether the district court would resolve the case on eligibility grounds, and then promptly pursued IPRs with streamlined prior art grounds as presented here.

B. The District Court Litigation Is At An Early Stage

The district court litigation remains at its infancy. Ricoh's brief fails to acknowledge that trial is not set until August 2028—seven months after any Final Written Decision in this case—and the bulk of the case schedule occurs *after* institution here.

Ricoh filed the underlying litigation on August 29, 2025, asserting seven patents against Zoom's videoconferencing products. EX2003. To date, the parties have only addressed initial motion practice, infringement contentions, and preliminary discovery—nothing more. EX2004; EX2010; EX1027. And, as discussed below, the case schedule provides that little litigation occurs by the time of institution.

1. Trial Does Not Occur Until August 2028

On June 15, 2026, the Court entered a Scheduling Order (D.I. 53). EX2012. The bulk of work in this case does not occur until after expected institution on January 6, 2027. For example, substantial completion of document production is not due until **June 1, 2027**. EX2012. The parties' Joint Claim Construction Chart is not due until January 12, 2027. *Id.* Claim construction briefing then extends through April 20, 2027, with the claim construction hearing not scheduled until **July 8, 2027**. *Id.* Fact discovery does not close until **August 17, 2027**, expert reports are not due until September through November 2027, and expert discovery does not close until

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December 9, 2027. *Id.* Dispositive motions are not due until January 20, 2028, and the pretrial conference is set for May 31, 2028. *Id.* Trial is set for August 14, 2028—***seven months after*** the January 2028 Final Written Decision date for this IPR. *Id.*

Ricoh fails to acknowledge that the case schedule confirms that the Board's proceedings will be well advanced, and likely concluded, before the district court reaches any comparable stage. Thus, the Board's resolution of the challenged claims will therefore conserve judicial and party resources by narrowing or eliminating the asserted claims before the parties undertake the expense of full merits discovery, claim construction, and trial preparation in the district court.

2. The District Court Has Invested Limited Resources On Invalidity

Moreover, the Court and the parties have invested only limited resources on prior art invalidity issues in the district court. Zoom has not even served invalidity contentions to date, and the district court has not yet conducted any substantive invalidity proceedings. Contrary to Ricoh's argument, Zoom's Motion addressed threshold ***eligibility*** issues under Section 101—not a merits-based invalidity determination like this IPR. Moreover, claim construction briefing does not begin until February 2027, and no invalidity-related expert discovery or dispositive motion practice has occurred or is imminent. Granting institution will therefore not

meaningfully duplicate any work the district court has performed, but instead will bring to bear the Board's specialized expertise on questions of validity and prior art.

3. Zoom Will Move for a Stay

Finally, if IPRs are instituted, Zoom intends to move to stay the district court litigation pending the Board's resolution of the petitions. Ricoh argues that a stay is unlikely, but the scheduling order confirms otherwise—trial is not scheduled until August 2028, nearly two full years away, and the court has not yet invested resources in claim construction, expert discovery, or dispositive motions on any of the seven asserted patents. These are precisely the circumstances in which district courts routinely grant stays. *See, e.g., Ddrops Co. v. MOM Enters., LLC*, C.A. No. 1:22-cv-00332-GBW, Dkt 132, 2-3 (D. Del. Oct. 23, 2023) (filed as EX1026) (granting a renewed motion to stay pending IPR once the PTAB instituted review of all asserted claims, where “fact discovery is ongoing,” “expert discovery has not yet begun,” and “dispositive motions and trial preparation has yet to begin”). A stay following institution would conserve judicial and party resources by allowing the Board to narrow or eliminate the asserted claims before the parties undertake the expense of full merits discovery, claim construction, and trial preparation on patents that should not survive *inter partes* review.

Therefore, the district court schedule, Zoom's anticipated motion to stay, and a Final Written Decision expected seven months before the district court trial date all warrant referring Zoom's petition for a merits determination.

C. Petitioner Has Submitted a Sotera+ Stipulation to Minimize the Duplication of Work

As set forth below, Petitioner has filed a broad *Sotera* stipulation (EX1028) negating the duplication raised by Ricoh. Petitioner recognizes the Director's interest in minimizing the duplication of work by two tribunals in resolving the same issue. *See, e.g., Intel Corp. v. VLSI Tech. LLC*, IPR2019-01192, Paper 15, 11 (P.T.A.B. Jan. 9, 2020) ("When considering the impact of parallel litigation in a decision to institute, the Board seeks . . . to minimize the duplication of work by two tribunals to resolve the same issue."). Therefore, to eliminate any potential overlap between these proceedings and the co-pending litigation within the bounds of what is permitted for IPRs under 35 U.S.C. §311(b), Petitioner has filed a broad *Sotera* stipulation. Specifically, Zoom agrees to be bound by the full scope of the estoppel under 35 U.S.C. §315(e)(2) in *Ricoh Company, Ltd. v. Zoom Communications, Inc.*, No. 1:25-cv-01095-JCG (D. Del.) as of the date of the PTAB's institution decision on the merits (*i.e.*, any ground that the petitioner raised or reasonably could have

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raised during that inter partes review). *See Sotera Wireless, Inc. v. Masimo Corp.*,

IPR2020-01019, Paper 12, 18-19 (P.T.A.B. Dec. 1, 2020) (Precedential).

In fact, Zoom's broad stipulation goes **beyond** the traditional *Sotera* stipulation. EX1028. Zoom has further stipulated to forgo any **other** ground based on a combination of system art with any prior art reference asserted as the basis of a ground in this IPR. By also including combinations of system art with the prior art asserted in this proceeding, the stipulation ensures that IPR2026-00407 serves as a "true alternative" to the district court invalidity proceeding (*Sotera*, Paper 12, 18-19). It covers not only the full breadth of estoppel that Congress prescribed under §315(e)(2) but also the combinations of printed publications with unpublished system art that might otherwise be pursued in district court. This approach "mitigates any concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions" such that this consideration "weighs strongly in favor of not exercising discretion to deny institution under 35 U.S.C. §314(a)." *Sotera*, Paper 12, 19.

The Director has specifically credited this type of broad stipulation in recent decisions. In *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9 (P.T.A.B. June 13, 2025) (Informative), the Acting Director referred the petitions to the Board, noting among the factors counseling against discretionary denial that "Petitioner has filed a broad stipulation." Similarly, in *Tesla, Inc. v. Bulletproof*

(Informative), Director Squires credited a broad stipulation that went beyond *Sotera* by encompassing any other ground based on a combination of system art with “any prior art reference asserted as the basis of a ground in each IPR” and declined to discretionarily deny institution of seven IPR petitions. *Id.*, 2. As in those cases, Petitioner's broad stipulation here “reduces the concern of inconsistent outcomes or significant duplication of efforts.” *Tesla*, IPR2026-00204, Paper 14, 3.

Petitioner's stipulation completely moots Patent Owner's overlap arguments. Contrary to Patent Owner's criticism that Petitioner had not filed a *Sotera* stipulation (Request, 8-9), no invalidity contentions have been exchanged and no issue of duplication had been raised. Regardless, Zoom's broad *Sotera* stipulation filed herewith fully addresses any overlap concern. Indeed, Petitioner's broad stipulation ensures that this IPR will serve as the sole vehicle for the prior art printed patent and publication invalidity challenges raised here, making it the very “alternative” to district court litigation that AIA reviews are intended to be. *See Magnolia Med. Techs. v. Kurin, Inc.*, IPR2026-00097, Paper 17, 2-4 (P.T.A.B. May 14, 2026) (Precedential).

In view of the foregoing, there is no overlap between these proceedings and the district court litigation to support discretionary denial. Petitioner's broad stipulation ensures that this IPR will function as a true alternative to, rather than an

III. SETTLED EXPECTATIONS DO NOT FAVOR DENIAL

Ricoh's settled expectations argument does not support discretionary denial. The '487 Patent has been in force for only roughly five years, and Ricoh cannot manufacture additional age by relying on parent patents, an abandoned published claim, or notice of different patents. The other Ricoh patents challenged by Petitioner are even newer. In any event, the Examiner's failure to consider the most relevant prior art, together with the breadth and technological diversity of Ricoh's seven-patent campaign, independently warrants merits review by the Board.

A. The '487 Patent Has Not Been in Force For Over Six Years

Acting Director Stewart explained that “the *longer* the patent has been in force, the more settled expectations should” weigh against institution. *Dabico Airport Solutions Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21, 3 (P.T.A.B. June 18, 2025) (Informative). But there is “no bright-line rule on when expectations become settled,” and the Director takes a “holistic” approach, weighing all relevant considerations on a case-by-case basis. *Id.*, 3. As a preliminary matter, Ricoh stretches the settled expectations analysis beyond its intention through several moves designed to “age” the '487 Patent. But Ricoh cannot escape that the '487 Patent issued *less than six years* before this IPR was filed.

First, Ricoh attempts to bootstrap patent age by relying on the '487 Patent's

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parent patents, which issued in 2017 and 2019. But the '487 Patent did not exist to be challenged at that time. Moreover, a recently-issued patent does not automatically inherit settled expectations from older family members. *Embodiment, Inc. v. LifeNet Health*, IPR2025-00248, Paper 13, 2-3 (P.T.A.B. June 26, 2025) (finding no strong settled expectations for a patent issued in 2022 notwithstanding its relationship to a challenged parent patent, and referring both petitions). The '487 Patent has its own claims, its own prosecution history, and its own issue date. That the '411 and '520 Patents share a priority chain does not transform a five-year-old patent into a nine-year-old one.

Second, Ricoh also inflates the timeline by pointing to the '487 Patent's October 2019 publication, claiming "over seven years" of public notice. But a published application is not a patent "in force." The settled expectations doctrine rests on the length of time the claims have been in force—not the date an application happened to publish. *See Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12, 3 (P.T.A.B. July 16, 2025) (Informative) ("the challenged patents . . . have not been in force for a significant period of time (**issued** in 2022 and 2023)"). Even if the Board were to look back at the publication, the original claim that was published was canceled in its entirety. *See* EX1024 (showing published claim 1); EX1002, 11-12, 49-56 (showing replacement of original claim 1 with amended claims 2-21). Any "public notice" the '143 Publication provided was notice of a claim that Ricoh

Third, Ricoh cites Zoom's purported awareness of the parent '520 and '411 Patents through IDS filings and Office Actions as evidence of "actual notice." But the cases Ricoh relies on are distinguishable. In *JinkoSolar Co. v. LONGi Green Energy Tech. Co.*, IPR2025-00859, Paper 10, 3 (P.T.A.B. Sept. 3, 2025), and *Belden Inc. & PPC Broadband, Inc. v. CommScope, Inc. of N.C.*, IPR2025-00833, Paper 13, 2 (P.T.A.B. Sept. 12, 2025), the petitioners had notice of the challenged patent itself. Here, Zoom's IDS citations referenced **entirely different patents**—the parent '411 and '520 Patents—**not** the '487 Patent. A single April 2024 letter is the **only** communication referencing the '487 Patent specifically.

Fourth, the other six asserted patents challenged by Petitioner have been in force for **less** time and are thus even newer. Four of them—the '464, '093, '278, and '548 Patents—issued in 2022 and 2023. EX2004, 3-4. By the time of institution, the '278 and '548 Patents will only have been in force for roughly four years, and the '464 and '093 Patents for roughly five.

B. This Case Falls Within Recognized Exceptions to Settled Expectations

Discretionary denial is also unwarranted because this case falls squarely within recognized exceptions to the settled expectations doctrine.

First, as discussed in detail below, the Examiner never considered the most relevant prior art, which Petitioner presents here for the first time. This is material

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Examiner error. Neither Saleh-502 nor Gurevich was cited or considered during prosecution of the '487 Patent. Pet., 20. Yet these references expressly disclose the limitation the Examiner identified as the basis for allowance. *Id.*, 18-19. The Director has repeatedly referred petitions for merits-based review even where challenged patents were in force for a greater number of years, particularly where the petitioner demonstrates material examiner error. *See, e.g., TSMC v. Marlin Semiconductor Ltd.*, IPR2025-00847, Paper 11, 3-4 (P.T.A.B. Sept. 3, 2025) (referring petition despite patent in force for 15 years where petitioner showed material examiner error); *Volkswagen Grp. of Am., Inc. v. Longhorn Auto. Grp. LLC*, IPR2025-01064, Paper 9, 2-3 (P.T.A.B. Oct. 10, 2025) (referring petition based on persuasive showing of material examiner error despite patent in force for 13 years).

The prosecution history of the '487 Patent underscores the material nature of the Examiner's error. The '487 Patent is a second-generation continuation that issued after a **single** non-final Office Action containing only a § 112(b) indefiniteness rejection of one dependent claim. EX1002, 61-65. **The Examiner never rejected any claim on prior art grounds under §§ 102 or 103.** *Id.* The Examiner cited only five U.S. patents and zero non-patent literature references, one of which was simply the named inventor's own prior publication. *Id.*, 59. The Examiner's stated reason for allowance was a single conclusory paragraph asserting that the cited art "fail[ed] to teach or fairly suggest" the claimed overlay of a videoconferencing window on

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an interactive whiteboard session window. *Id.*, 64, 91.

The Director has repeatedly found that this type of thin prosecution constitutes material error warranting Board review. *See Alliance Laundry Sys., LLC v. PayRange LLC*, IPR2025-00573, Paper 9, 2 (P.T.A.B. July 17, 2025) (referring petitions where “the patent examiner did not apply any art or reference during prosecution. . .”); *Anthony, Inc. v. ControlTec, LLC*, IPR2025-00559, Paper 12, 2 (P.T.A.B. July 16, 2025) (referring petition despite patents in force for approximately seventeen and eighteen years where patent examiner “issued a notice of allowance . . . as the first office action” and petitioner persuasively showed the examiner “erred by overlooking the teachings of” prior art.) Here, as well, the Examiner never tested the challenged claims against any prior art, and the most relevant references were never cited or considered during prosecution.

Second, the broad-sweeping scope of this dispute weighs against denial. Ricoh asserted seven patents belonging to ***seven distinct patent families*** against Zoom across different technical subject matters, and Zoom has filed IPR petitions challenging all seven.

Patent	Title	Subject
10,904,487 (IPR2026-00407)	Integration of Videoconferencing with Interactive Electronic Whiteboard Appliances	Displaying a menu and videoconference on a whiteboard window (i.e., overlapping displayed

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		information) (Claim 15).
11,256,464 (IPR2026-00411)	Communication System, Communication Device, and Computer Program	Controlling where images are displayed on two screens (Claim 1).
10,909,059 (IPR2026-00424)	Transmission Terminal, Non- Transitory Recording Medium, Transmission Method, and Transmission System	Displaying the number of attendees in a conference and image data of fewer than all attendees (Claim 1).
11,546,548 (IPR2026-00435)	Transmission Management Apparatus	Displaying and updating name and attendance information in a conference (Claim 1).
10,931,917 (IPR2026-00453)	Transmission Terminal, Transmission Method, and Computer-Readable Recording Medium Storing Transmission Program	Forwarding information from one computer to another (Claim 1).
11,289,093 (IPR2026-00461)	Apparatus, System, and Method of Display Control, and Recording Medium	Controlling a display based on selection of text from recorded voices (Claim 1).
11,516,278 (IPR2026-00470)	Transmission Management System, Transmission System, and Recording Medium	Transmitting and updating name information (Claim 1).

The Director has recognized that where a patent owner asserts “a large number of patents involving diverse subject matter,” the Board is “better suited to review” those patents than the district court. *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9, 3 (P.T.A.B. June 13, 2025) (Informative); *see also*

11 (P.T.A.B. Oct. 10, 2025) (“The large number and wide scope of the patents asserted weighs against discretionary denial.”). That reasoning applies here, where Ricoh’s seven-patent campaign places an enormous burden on the district court and the Board is the more efficient forum for reviewing the validity of each patent on the merits.

For these reasons, the settled expectations doctrine does not warrant discretionary denial of this petition.

IV. THE MERITS ARE STRONG

Zoom filed IPR petitions on all seven of Ricoh’s asserted patents, and the merits of each petition strongly favor institution. Here, the petition challenging the ’487 Patent is particularly strong.

First, the strength of the Petition is supported by its streamlined nature and focused grounds. Pet., 19-20. Namely, the Petition includes only two grounds, using only two prior art references, to challenge all twenty claims of the ’487 Patent. *Id.*

Second, the ’487 Patent itself admits how little is being claimed. Specifically, the ’487 Patent claims nothing more than integrating a known videoconferencing application (Microsoft Lync) with a known interactive whiteboard device (SMART Board) using standard Windows OS functions to layer one application window on top of another. Pet., 15-17. These functions are routine API calls available to any

Windows developer for over a decade before the May 2015 priority date. Pet., 10-11.

Third, Petitioner's Grounds explain how Saleh-502 and Gurevich (neither considered by the Examiner) disclose the exact limitations the Examiner noted as the basis for allowance. Pet., 4, 18-19, 20-23, 49-51; EX1002, 59-65. Significantly, the references the Examiner considered did not involve a combined videoconferencing-whiteboard system like Polycom's SMART Board disclosed in Petitioner's prior art. *Id.*

Finally, as explained below, Patent Owner's attempt to argue weakness based on one limitation is contradicted by clear disclosures in the prior art relied upon in the Petition.

A. Ground 1

Contrary to Patent Owner's arguments, Saleh-502 makes clear that the button for invoking the transparent menu 310 "is available from all screens including those containing video of participants and content." EX1004, 10:66-11:5; Pet., 31. Saleh-502 is assigned to Polycom—a video collaboration company founded long before Ricoh's patents. Saleh-502 discloses a videoconferencing unit coupled to the same SMART Board display device used in the '487 Patent, with a transparent menu 310 overlaid on the touch screen that allows a user to "place a videoconference call through a directory, speed dial, or manual dial menu; answer an incoming

videoconference call; hang-up a videoconference call; mute or change volume of audio; select camera and content sources,” and more. EX1004, 7:55-8:12; 10:61-11:5. Saleh-502's system already displays both videoconference video and whiteboard content on the same display and implements picture-in-picture overlay of one content stream on top of another. Pet., 33-36.

Patent Owner's argument cherry-picks patent citations and ignores the clear disclosure of Saleh-502 as a whole. Specifically, Patent Owner argues that the transparent menu 310 appears only over a video feed in Saleh-502's FIG. 6, not over the whiteboard content 452 shown in FIG. 9. Paper 6, 13-14. But again, Saleh-502 expressly teaches that the menu-invoking button “is available from ***all screens*** including those containing video of participants and ***content***.” EX1004, 10:66-11:5. Saleh-502 also expressly teaches that the display device operates in whiteboard mode and videoconference mode ***on the same screen*** 202, with the user switching between them. EX1004, 9:33-54, 13:25-60; Pet., 32. Overlaying the menu on the whiteboard mode is precisely what Saleh-502's disclosure means when it explains that the menu is available from “all screens.” Any argument that Saleh-502 limits its transparent menu to video-only screens is contrary to the express disclosure in the reference.

B. Ground 2

Patent Owner's discrete criticism of the same single limitation in Ground 2

fares no better. Patent Owner's attempt to isolate paragraph 177 of Dr. Almeroth's declaration (Paper 6, 16) ignores the Petition's motivation to combine arguments and mapping of the selection menu limitation to Saleh-502's express disclosures (Pet., 49-54) and the additional support Dr. Almeroth provides across paragraphs 153-158, 177-181 of his declaration. *See, e.g.*, EX1003, ¶¶ 153-158, 177-181. As an initial matter, Patent Owner ignores that Gurevich discloses ***the same system*** as the '487 Patent itself: Microsoft Lync 2010 integrated with a SMART Technologies interactive whiteboard. EX1005, ¶¶[0002]-[0003], [0037], [0041]-[0043]. Gurevich already provides the Lync video stream, the SMART Board whiteboard workspace, and an alternative presentation interface with selectable tool bar controls and participant icons overlaid on the interactive surface. EX1005, ¶¶[0041]-[0045], [0050]-[0053]. Saleh-502 supplies the complementary and conventional on-screen menu controls for launching, controlling, and terminating videoconference sessions on the same type of integrated SMART Board system. Pet., 49-54. The motivation to combine is simple: both references are directed to the similar problem of integrating videoconferencing with SMART Technologies interactive whiteboards to improve the user experience, and combining Gurevich's Lync-integrated whiteboard with Saleh-502's well-known call-initiation menus yields nothing more than a predictable result. Pet., 51-53.

Overall, Patent Owner's argument that the prior art does not disclose a

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“selection menu” is undermined by how Ricoh itself has mapped this very limitation in its infringement contentions. EX1025, 26-27. Ricoh cannot credibly tell the Board that the prior art's on-screen controls for initiating a videoconference do not qualify as a “selection menu” while simultaneously telling the district court that analogous on-screen controls in Zoom's products satisfy that same limitation.

The remaining six petitions are equally well grounded. Each relies on prior art the Patent Office never considered during prosecution. And each presents focused, streamlined challenges with most grounds built on a single anticipatory reference or a simple two-reference obviousness combination. The district court's own Section 101 analysis independently confirms how narrow the inventive contribution of each patent actually is. EX2004.

V. CONCLUSION

For the reasons set forth above, discretionary denial is unwarranted. Petitioner respectfully requests institution of *inter partes* review and cancellation of all challenged claims of the '487 Patent.

Date: October 6, 2026

Respectfully submitted,

By:/ Amanda S Bonner /

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6, I hereby certify that on October 6, 2026, a copy of the attached PETITIONER'S DISCRETIONARY DENIAL OPPOSITION, together with all exhibits was served on Patent Owner via email at the following email addresses:

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