

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLACKBERRY CORPORATION,

Petitioner,

v.

MAXELL LTD.,
Patent Owner.

Case: IPR2019-00097

U.S. Patent No. 9,100,604

**PATENT OWNER'S PRELIMINARY RESPONSE
TO PETITION FOR *INTER PARTES* REVIEW
OF U.S. PATENT NO. 9,100,604**

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PATENT OWNER'S EXHIBIT LIST

Description	Exhibit #
US 5,668,597 ("Parulski")	2001
B. Haskell et al, <i>Digital Video: An Introduction to MPEG-2</i> , Digital Multimedia Standards Series (1997)	2002

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I. INTRODUCTION

Patent Owner Maxell, Ltd. ("Patent Owner") respectfully requests that the Board deny institution because Petitioner Blackberry Corporation (hereinafter "Petitioner") has failed to demonstrate a reasonable likelihood of success on the grounds submitted in its Petition for challenging the patentability of Claims 1-5 ("challenged claims") of U.S. Patent No. 9,100,604 ("the '604 Patent").

First, Petitioner fails to show a reasonable likelihood of prevailing with respect to Grounds 1 and 2. Under either of Petitioner's proposed constructions of "signal processing unit," the proffered prior art does not disclose elements 1[F] and 4[C], both requiring a signal processing unit configured to generate image signals by using the output signals of the image sensing device.

Second, Petitioner applies an incorrect interpretation of the phrase "a quantity M of effective scanning lines of a display screen of a television system" recited in Claims 1 and 4. In view of this interpretation, Petitioner fails to show a reasonable likelihood of prevailing on any challenged claim.

Third, Ground 2 should further be denied because Petitioner does not present a proper obviousness analysis, neglecting to show how or why a person of ordinary skill in the art would combine *Misawa* '607 and *Okino* '947 in the manner claimed.

Finally, throughout the Petition, Petitioner relies on nothing more than conclusory statements to support its arguments. Additionally, the "omnibus"

declaration provided by Mr. Saber spanning nearly 200 pages with over 1000 pages of appendices is nothing more than the bare adoption of another expert's declaration word-for-word, and one that simply parrots many of the same conclusory statements found in the Petition without any additional analysis. *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."). These conclusory statements by Petitioner and Petitioner's declarant do not provide the rational underpinning necessary to establish the unpatentability of the claims. As the evidence discussed herein will show, Petitioner has failed to meet its burden of showing a reasonable likelihood of prevailing because the Petition fails to establish how the cited references disclose each and every element of the challenged claims and Petitioner's declarant provides no additional support for many of the conclusory statements located throughout the Petition.

Accordingly, the Board should refuse to institute this *inter partes* review.

II. BACKGROUND

A. Technology Background

The '604 Patent relates to electric cameras. Electric (or, digital) cameras operate using image sensing devices sometimes called "image sensors." Ex. 1003 at 1:29-40. An exemplary image sensor disclosed in the '604 Patent contains an array of picture elements (or, pixels) arranged in a two-dimensional grid. *Id.* at 4:45-55.

Each pixel in the image sensor array will generate a digital signal in response to light incident on a photodiode within the pixel. *Id.* at 4:55-5:13. These signals are collected by specialized circuitry and output as a digital image. Ex. 1003 at 4:55-5:13.

At the time of the '604 Patent, around January 2000, it was "generally assumed" that the output images from electric cameras would be viewed on a display other than that contained on the camera itself. *Id.* at 1:33-37. The patent describes example displays such as "television monitors," such as those compatible with the NTSC and PAL television systems. *Id.* at 1:33-37. NTSC and PAL were the predominant systems in the US and Japan, respectively, around January 2000. Also known at the time were MPEG-1, MPEG-2, HDTV and the ATSC Standard A/63 (including 1080i, 1080p, and 720p), with MPEG-4 under development.

B. Overview of the '604 Patent Invention and Claims

Prior to the invention disclosed in the '604 Patent, conventional electric cameras could not effectively capture both still and moving images. For example, when taking still pictures with a camera designed for taking moving images, the number of pixels was insufficient for a high-quality image. *Id.* at 2:65-67. Conversely, when taking moving images with a camera designed for taking still images, the dynamic image quality of the moving image would deteriorate, and the required circuitry would increase. *Id.* at 3:1-3.

The inventors also recognized that users of electric cameras would want to view their recorded still images and videos on a variety of displays, such as those of a conventional television system at the time. Ex. 1003 at 2:31-38. They thus recognized that, “[w]hen taking a moving image or monitoring the video, it is necessary to generate signals that conform to the television system.” *Id.* at 2:33-35.

The inventors of the '604 Patent developed a system “which uses an image sensing device with a sufficient number of pixels for still images and enables taking of highly detailed still images and a moving video taking with reduced image quality degradation without increasing circuitry such as field memory.” *Id.* at 3:12-16.

The inventors of the '604 Patent solved these problems. For example, the claims of the '604 Patent recite an electric camera that are tied to the number of scanning lines of a television system. Specifically, the claims of the '604 Patent recite an improved electric camera that includes an image sensing device, a driver, a view angle change switch, and a signal processing unit, each of which is configured to perform specific operations.

C. Summary of Petitioner's Proposed Grounds of Unpatentability and the References Cited

Petitioner contends that Claims 1-5 would have been obvious under pre-AIA 35 U.S.C. § 103(a). The Petition raises these grounds of alleged invalidity based on the following references:

1. U.S. Patent No. 6,700,607 (“*Misawa '607*”); and
2. U.S. Patent No. 5,990,947 (“*Okino '947*”).

The Petition asserts the following two grounds of alleged invalidity.

Ground	'604 Patent Claim(s)	Type of Challenge	Primary Reference	Secondary Reference(s)
1	Claim 1	35 U.S.C. § 103	<i>Misawa '607</i>	<i>Knowledge of a POSITA</i>
2	Claims 1-5	35 U.S.C. § 103	<i>Misawa '607</i>	<i>Okino '947 and further in view of knowledge of a POSITA</i>

III. CLAIM CONSTRUCTION

The Petitioner generally takes the position that all claim terms in the '604 Patent should be afforded their ordinary and customary meanings, with the exception of the term “signal processing unit.” (Pet. at 15.)

A. “signal processing unit”

With respect to the claimed “signal processing unit,” Petitioner proposes that it should be construed as a “unit that performs signal processing on the output of the image sensing device.” Pet. at 15. Petitioner's only explanation for this construction is contained in one sentence: “The specification refers to a ‘signal processing circuit 7’ that ‘performs color signal processing and luminance signal processing.’” *Id.* First, this sole sentence does not support the construction Petitioner proposes. And,

second, this reference in the specification does not support Petitioner's position that the phrase "signal processing unit" requires construction. In fact, the specification confirms that the term should be accorded its plain and ordinary meaning.

Petitioner then states a "POSITA would have understood the term 'signal processing unit' to connote definite structure within the claims of the '604 Patent... [and] [a]ccordingly Petitioner submits that 35 U.S.C. § 112¶6 does not apply to this term." (Pet. at 15 (citation omitted)). Patent Owner agrees that 35 U.S.C. § 112 ¶6 does not apply to the term "signal processing unit."

Nevertheless, Petitioner alternatively argues that if the Board were to conclude that 35 U.S.C. §112 ¶6 applies that the corresponding structure in the specification of the '604 Patent is at least "gain adjust circuit 5, analog-digital (A/D) conversion circuit 6, signal processing circuit 7, vertical interpolation circuit 8, horizontal interpolation circuit 9, and control circuit 11." (Pet. at 15).

As used in the claims and the specification, the phrase "signal processing unit" is easily understood and should be given its plain and ordinary meaning. The claim recites "a signal processing unit configured to generate image signals by using the output signals of the image sensing device." Ex. 1003, Claim 1. The specification explains that: "The output signal from the image sensing device 3 is adjusted in gain by the gain adjust circuit 5 and then converted by the A/D conversion circuit 6 into a digital signal. The digital signal is then processed by the signal processing circuit 7

. . . .” *Id.*, 6:15-19; *see also id.*, at 8:6-12. Therefore, the phrase “signal processing unit” does not require construction and should be given its plain and ordinary meaning.

B. “a quantity M of effective scanning lines of a display screen of a television system” and “a quantity M of effective vertical lines of a television system”

Petitioner does not propose a construction of the phrase “a quantity M of effective scanning lines of a display screen of a television system” recited in Claim 1 and “a quantity M of effective vertical lines of a television system” recited in Claim 4. However, based on Petitioner’s application of this phrase to the prior art and the interpretation of the phrase in Claim 1 and 4, it is clear that Petitioner is applying an incorrect claim construction. Therefore, as discussed below, this phrase in Claim 1 and 4 requires construction.

Petitioner *de facto* provides a construction for this term in their analysis that is inconsistent with the intrinsic evidence. Petitioner incorrectly asserts that a “POSITA would have understood the ‘quantity M’ in this claim element to refer to the number of effective scanning lines *per field* (and not per frame) as applied to a display screen for displaying interlaced television signals.” Pet. at 26, 54. However, as made clear in the specification, the term “effective scanning lines of a display screen of a television system” is not the same as “effective scanning lines *in a field to be interlaced*” of a display screen of a television system. Petitioner is improperly

interpreting this term to an incorrect construction as to define “M=240” in an effort to make their math work when analyzing the claims. *Id.* Instead, as is further discussed below, both the phrase “a quantity M of effective scanning lines of a display screen of a television system” and “a quantity M of effective vertical lines of a television system” should be construed as “a quantity M which is the number of effective pixel lines in a frame to be displayed on a display screen of a television system (e.g., M=480 lines for NTSC).”

First, the claim language supports this construction. Claim 1 broadly recites “a display screen” and both Claims 1 and 4 broadly recite “lines . . . of a television system.” Ex. 1003, Claim 1 and 4. The claims do not recite *a field of* the display screen or a *field* of a television system. In addition, the language in Claims 1 and 4 is the same or substantially the same as language in Claim 1 of related U.S. Patent No. 6,765,616 (the ‘616 Patent) in the same family, as opposed to the different language in Claim 13 of the ‘616 Patent, also supporting Patent Owner’s construction.¹ Claim 1 and similarly Claim 4 (and Claim 1 of the ‘616 Patent) each recite “M” to refer to the number of scanning lines of a display screen of a television

¹ The ‘604 Patent lists and incorporates the ‘616 Patent as a related patent in the same family, as listed in the “Cross Reference to Related Application” section of its specification. The ‘616 Patent is currently under inter-partes review by a different petitioner, Case No. IPR2019-00087.

system or vertical lines of a television system. In contrast, claim 13 of the '616 Patent expressly recites "M" to refer to the number of scanning lines of "*each field* of a display screen." (emphasis added). In view of this difference in claim language, the claimed "display screen" of claim 1 of the '616 Patent (and Claims 1 and 4 here) is not limited to one of the two fields of the display screen of a television system. And the number/quantity "of effective scanning lines of a display screen of a television system" or "vertical lines of a television system" should not be construed differently in the '604 Patent as is construed in the '616 Patent. "As a general rule, claim language used in one patent of a family is presumed to have the same meaning when used in another patent of the same family, absent clear evidence to the contrary." *iLife Techs. v. Body Media, Inc.*, 90 F. Supp. 3d 415, 423 (W.D. Pa. 2015) (citing *NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282, 1293 (Fed. Cir. 2005)).

Second, the specification supports Patent Owner's proposed construction. For example, the specification explains that the NTSC display screen contains two fields, each having 240 scanning lines. Thus, the disclosed number of scanning lines for a NTSC display is 480. Indeed, the '604 Patent combines both fields to get the total number of scanning lines displayed on the screen, which is also the effective number 480 of vertically arranged pixels.

The NTSC system, for example, performs interlaced scanning on **two fields, each of which has an effective scanning line number of about**

240 lines (the number of scanning lines actually displayed on the monitor which is equal to the number of scanning lines in the vertical blanking period subtracted from the total number of scanning lines in each field). To realize this, the image sensing device has about **480 pixel rows as the standard effective number of vertically arranged pixels**.

Ex. 1003, at 1:40-48 (emphases added). Petitioner contends that the “quantity M” in the ’604 Patent must be *per field* (and not per frame) because that is how its disclosed embodiments were arguably defined. Pet. at 26. Even if true, any limitation from a single embodiment should not be imported into claim language, especially considering the differing claim languages found in the family of the ’604 Patent. And the specification accounts for this at least by noting that “[t]he use of this image sensing device can form a variety of constructions essentially equal in the working principle to this embodiment.” Ex. 1003, at 12:55-57.

Finally, the prior art of record demonstrates that a POSITA would have understood that the number/quantity “of effective scanning lines of a display screen of a television system” or “vertical lines of a television system” would refer to the entire frame. Specifically, for a NTSC system, the number of scanning lines for the screen was known to be 480, which applies to the entire frame. “For example, an **NTSC format interlaced image sensor with 480 lines** and 640 pixels per line requires a clock rate of approximately 12 MHz to read out the 640 lines in the 52.4

mSec NTSC standard active line time, which provides a field rate of 1/60 second.”

Ex. 2001, US 5,668,597 (“Parulski”)² (emphasis added).

A POSITA would have known that each row of picture elements in a frame is a scan line because “A row of pels [pixel elements] is called a *scan line*.” Ex. 2002, Haskell, at 5. Specifically, “the NTSC color video image has 29.97 frames per second; approximately 480 visible scan lines per frame.” *Id.* at 5-6; *see also* pages 81-82 (raster scan and interlace raster scan), page 113 (“In progressive scanning, within each frame all the raster lines are scanned from top to bottom.”). Thus, the 480 pixel rows that form the standard effective number of vertically arranged pixels in the ’604 Patent constitute 480 visible NTSC scan lines.

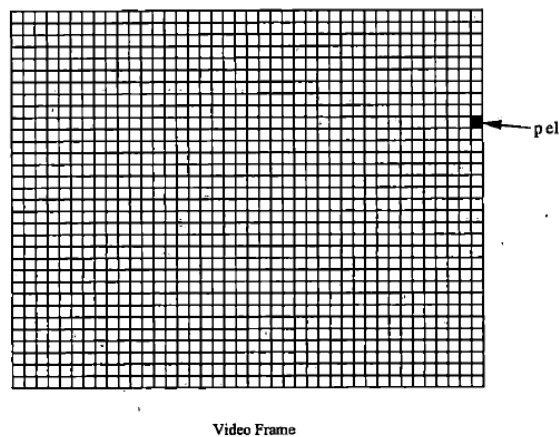


Fig. 1.2 Frames to be digitized are first partitioned into a large number of *picture elements*, or *pels* for short, which are typically arranged in rows and columns. A row of pels is called a *scan line*.

² Parulski was cited by Examiner in the ’616 Patent prosecution and was listed in the Information Disclosure Statement by Applicant and considered by the Examiner in the ’604 Patent prosecution history. *See* Ex. 1014, at 66, 144.

Ex. 2002, at 5.

The reference to “interlaced scanning” in the specification of the ’604 Patent also confirms that the total number of scanning lines for the display screen takes into account both fields in the frame. Indeed, a POSITA would have known that in interlaced scanning, all the lines, even and odd lines, in the frame are scanned. Ex. 2002, at 113 (“In analog interlaced scanning (see Fig. 6.2) all the odd-numbered lines in the entire frame are scanned first, and then the even-numbered lines are scanned . . . All the current analog TV systems (NTSC, PAL, SECAM) use interlace scanning.”). Specifically, interlaced scanning uses “frames that are composed of two fields sampled at different times, with lines of the two fields interleaved, such that two consecutive lines of a frame belong to alternate fields.” *Id.* at 82.

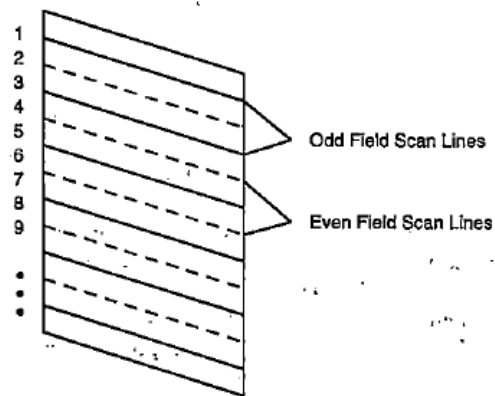


Fig. 6.2 Scanning pattern for 2:1 interlace. Odd-numbered lines (field 1) are scanned and displayed first, followed by the even-numbered lines (field 2). In this way, low spatial frequencies are displayed twice as often as high spatial frequencies, thus better matching the characteristics of human vision. Compared to scanning both the odd and even lines at the field rate, this also reduces the line rate (and bandwidth) by a factor of two.

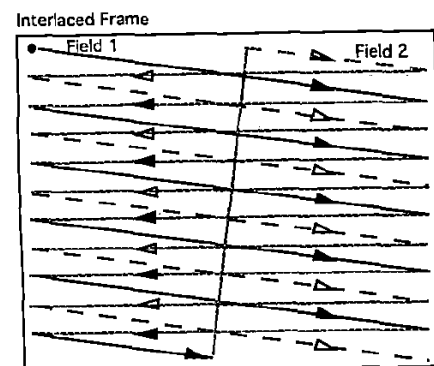


Fig. 5.2 Interlaced raster scan of an image

Ex. 2002, at 113.

In addition, the '604 Patent discloses that the captured images were to be recorded in an MPEG format. Ex. 1003, at 7:14-16 ("the signals may be compressed in the MPEG (Moving Picture Expert Group) format"). A POSITA would have known that the number of scanning lines for MPEG corresponds to an entire frame of video. Indeed, "MPEG-1 was developed specifically for coding progressive scanned video . . . MPEG-2 aims at higher bit rates and contains all of the progressive coding features of MPEG-1. In addition, MPEG-2 has a number of techniques for coding interlaced video." Ex. 2002, at 146. As shown above, "[i]n progressive scanning, within each frame all the raster lines are scanned from top to bottom," and "[i]n analog interlaced scanning (see Fig. 6.2) all the odd-numbered lines in the entire frame are scanned first, and then the even-numbered lines are scanned . . . All the current analog TV systems (NTSC, PAL, SECAM) use interlace scanning." Ex. 2002, at 113.

Therefore, both the phrase "a quantity M of effective scanning lines of a display screen of a television system" and "a quantity M of effective vertical lines of a television system" should be construed as "a quantity M which is the number of effective pixel lines in a frame to be displayed on a display screen of a television system (e.g., M=480 lines for NTSC)."

To the extent Patent Owner has further objections to Petitioner's proposed or implicit constructions, such objections are not pertinent to this Preliminary Response. Accordingly, Patent Owner reserves all rights to provide additional arguments relating to Petitioner's claim construction positions if institution occurs.

IV. LEGAL STANDARDS

A claim is not patentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious to a person of ordinary skill in the art at the time of the invention. 35 U.S.C. § 103(a) (pre-AIA). Obviousness requires assessing (1) the "level of ordinary skill in the pertinent art," (2) the "scope and content of the prior art," (3) the "differences between the prior art and the claims at issue," and (4) "secondary considerations" of non-obviousness such as "commercial success, long felt but unsolved needs, failure of others, etc." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966)).

It is Petitioner's burden "to demonstrate both 'that a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so.'" *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367-68 (Fed. Cir. 2016) (quotations and citations omitted). However, a petitioner must first show that all of the claimed elements are disclosed

in the prior art. *See Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1164 (Fed. Cir. 2006) (considering motivation to combine and reasonable expectation of success only “if all the elements of an invention are found in a combination of prior art references”).

Obviousness of a patent cannot properly be established by mere conclusory statements. Instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. A reason for combining disparate prior art references is a critical component of an obviousness analysis. The obviousness analysis should be made explicit and needs to provide an articulated reasoning with some rational underpinning to identify the reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *See InTouch Techs., Inc. v. VGo Commc'ns, Inc.*, 751 F.3d 1327, 1347 (Fed. Cir. 2014). The Petition fails under this legal standard.

V. THE PETITION DOES NOT SHOW A REASONABLE LIKELIHOOD OF PREVAILING WITH RESPECT TO ANY CHALLENGED CLAIM

The Petition should be denied because it does not establish a reasonable likelihood of prevailing on any of the grounds against any of the asserted claims. Therefore, institution should be denied.

A. Petitioner Does Not Show A Reasonable Likelihood of Success For Any Ground Because It Failed to Show the Prior Art Discloses the

Claimed “signal processing unit configured to generate image signals by using the output signals of the image sensing device.”

All the challenged claims require a “signal processing unit.” As discussed below, Petitioner has not shown a reasonable likelihood of success on both Ground 1 and 2 because it failed to show how the term “signal processing unit configured to generate image signals by using the output signals of the image sensing device” is disclosed under both grounds. As such, the Petition should be denied.

1. *Ground 1: Misawa '607 In View of The Knowledge of POSITA Does Not Disclose Element 1[F], “a signal processing unit configured to generate image signals by using the output signals of the image sensing device.”*

Petitioner proposes two constructions for the term “signal processing unit.” See Pet. 1 at 15-17. Petitioner has not shown how *Misawa '607* in view of a POSITA discloses the “signal processing unit” under either construction. As such, Petitioner has not shown a reasonable likelihood of success under Ground 1.

For Element 1[F], Petitioner argues:

Misawa '607 teaches **a signal processing unit** (“analog signal processing part 30,” “A/D converter 32,” and “digital signal processing part 34”) **configured to generate image signals by using the output signals of the image sensing device** (“CCD 10” and “solid-state imaging device 28”). (Ex.1006 5:50-60, 6:34-58; Ex.1004 ¶488.)

Pet. at 32 (emphasis added). Petitioner's argument additionally sets forth in a footnote that the structure in *Misawa '607* would meet this claim element whether or not this claim term is construed under 35 U.S.C. § 112 ¶6.

First, Petitioner's one sentence argument is conclusory and merely repeats the claim language (shown above in bold text). This alone fails to satisfy Petitioner's burden for Ground 1.

Second, Petitioner fails to explain how the prior art discloses the claimed "signal processing unit" under either construction. Petitioner cites to two passages in *Misawa '607* and one paragraph of the omnibus Saber Declaration, however, nowhere does Petitioner explain how the cited evidence discloses element 1[F] under each construction. *See* 37 C.F.R. § 42.22(a)(2). Indeed, the Saber citation is identical to the text of the Petition regarding element 1[F] with no further explanation. Petitioner and its expert's approach is improper. *See Initiative for Medicines, Access & Knowledge (I-MAK), Inc. v. Gilead Pharmasset LLC*, Case IPR2018-00122, Paper 10 at 21 (PTAB May 21, 2018); *Halliburton Energy Serv., Inc. v. Schlumberger Tech. Corp.*, Case IPR2017-02072, Paper 11 at 18 (PTAB April 12, 2018). For its primary construction, Petitioner argues that the phrase "signal processing unit" should be construed as a "unit *that performs signal processing* on the output of the image sensing device." Pet. at 15 (emphasis added). But Petitioner fails to explain how the cited passages disclose a "unit that performs signal processing on the output

of the image sensing device.” Therefore, Petitioner fails to demonstrate a reasonable likelihood of success for Ground 1 under its primary construction for the phrase “signal processing unit.”

In the alternative, Petitioner argues that if the phrase is construed as a means-plus-function term, the corresponding structure in the '604 specification is “at least gain adjust circuit 5, analog-digital (A/D) conversion circuit 6, signal processing circuit 7, vertical interpolation circuit 8, horizontal interpolation circuit 9, and control circuit 11.” Pet. at 15. Petitioner, however, only identifies the following structures in *Misawa* '607: “analog signal processing part 30,” “A/D converter 32,” and “digital signal processing part 34.” Pet. at 33. Petitioner fails to identify structure for a gain adjust circuit, vertical interpolation circuit, horizontal interpolation circuit, control circuit in *Misawa* '607. Petitioner also fails to explain how the cited passages it identifies disclose the “signal processing unit” under its alternative construction. Thus, Petitioner also fails demonstrate a reasonable likelihood of success for Ground 1 under its alternative construction for the phrase “signal processing unit.”

Therefore Petitioner's Ground 1 should be denied.

2. *Ground 2: Petitioner Failed to Establish that Claims 1-5 Are Obvious Over Misawa '607 in View of Okino '947 and Further in View of The Knowledge of a POSITA*

Petitioner's Ground 2 fails for the same reasons. First, Petitioner makes the identical statement for *Misawa '607* as it does for Ground 1 and, therefore, it fails for the same reasons above. *See* Pet. 1 at 41-42; *see supra* Section VI.A. Second, Petitioner also fails to meet its burden for *Okino '947* under either construction. Petitioner makes the following conclusory argument regarding *Okino '947*:

Okino '947 teaches a similar signal processing unit (“sample & hold (S/H) circuit 6,” “process circuit 7,” “A/D conversion circuit 8,” “image memory 9,” “memory controller 10,” “D/A conversion circuit 11,” “operation circuit 12,” and “encoder circuit (converter) 13”) which, among other tasks, performs interpolation operations for an “enlargement function” when generating image signals. (Ex.1009 7:38-54; Ex.1004 ¶510.) Such interpolation teachings could readily be implemented in the signal processing unit of *Misawa '607*, which includes both analog and digital signal processing parts for performing pixel-level or line-level modifications of an image signal, as set forth below. (Ex.1004 ¶510.)

Pet. 1 at 42. Petitioner's argument additionally sets forth in a footnote that the structure in *Misawa '607* and *Okino '947* would meet this claim element whether or not this claim term is construed under 35 U.S.C. § 112 ¶6.

Again, Petitioner's argument fails to explain how *Okino '947* discloses a “unit that performs signal processing on the output of the image sensing device.” Pet. at

15 (emphasis added). In addition, Petitioner fails to explain the significance of the citations it identifies in *Okino '947* or how they disclose the “signal processing unit” under Petitioner’s primary construction. Petitioner makes the same arguments for the “signal processing unit” in Claim 4. *See* Pet. 1 at 58-59. Therefore, Petitioner fails to demonstrate a reasonable likelihood of success for Claims 1-5 of Ground 2 under its primary construction for “signal processing unit.”

Petitioner also fails to identify all of the structures in *Okino '947* under its alternative construction. Petitioner identifies the following structures: “sample & hold (S/H) circuit 6,” “process circuit 7,” “A/D conversion circuit 8,” “image memory 9,” “memory controller 10,” “D/A conversion circuit 11,” “operation circuit 12,” and “encoder circuit (converter) 13.” Pet. at 41-42. However, Petitioner fails to identify structure for a gain adjust circuit, vertical interpolation circuit, and horizontal interpolation circuit in *Okino '947*. Petitioner makes the same arguments for the “signal processing unit” in Claim Element 4[C]. *See* Pet. 1 at 57-58. Thus, Petitioner also fails to demonstrate a reasonable likelihood of success for Claims 1-5 of Ground 2 under its alternative construction for the phrase “signal processing unit.”

In view of the above, Petitioner failed to show a likelihood of succeeding in establishing unpatentability of Claims 1-5, and therefore the Board should deny institution of Ground 2 of the Petition.

B. Petitioner Does Not Show A Reasonable Likelihood of Success For Any Ground Because It Failed to Show the Prior Art Discloses the Claimed “a quantity M of effective scanning lines of a display screen of a television system” and “a quantity M of effective vertical lines of a television system”

In addition to the arguments above, Petitioner fails to establish a reasonable likelihood of success with respect to Grounds 1 and 2 because Petitioner applies an incorrect interpretation of the phrase “a quantity M of effective scanning lines of a display screen of a television system” in Claim 1, and the similar phrase “a quantity M of effective vertical lines of a television system” in Claim 4. As explained below, because Petitioner misinterprets the claims, it has not shown that the prior art discloses elements 1[B] and 4[B]. Furthermore, even taking Petitioner's construction, Petitioner fails to show why other related elements are disclosed by the prior art.

Therefore, because all the other claims depend on either Claim 1 or 4, for all the reasons discussed below, Grounds 1 and 2 should be denied.

1. *Ground 1: Petitioner Failed to Establish That Element 1[B] is Obvious Over Misawa '607 in View of The Knowledge of a POSITA*

Petitioner argues that *Misawa '607* discloses that $N=960$ and $M=240$ because “[a] POSITA would have understood the ‘quantity M’ in this claim element to refer to the number of effective scanning lines per field (and not per frame) as applied to a display screen for displaying interlaced television signals. (Ex.1004 ¶474.)” Pet. at

26. As previously explained, Petitioner's interpretation of M is based on an incorrect claim construction.

As already demonstrated, the phrase "a quantity M of effective scanning lines of a display screen of a television system" and "a quantity M of effective vertical lines of a television system" should be construed as "a quantity M which is the number of effective pixel lines in a frame to be displayed on a display screen of a television system (e.g., M=480 lines for NTSC)." As such, Petitioner has not shown that *Misawa '607* teaches an image sensing device "wherein N is greater than or equal to three times a quantity M of effective scanning lines of a display screen of a television system."

First, contrary to Petitioner's argument, the NTSC television system in *Misawa '607* has a number M of 480 effective scanning lines for a screen or frame, which consists of two interlaced fields. Therefore, Petitioner is wrong by stating that M=240.

Second, Petitioner states that "a POSITA would have understood the 240-line LCD display of *Misawa '607* to meet that limitation, and in particular, a display screen of the NTSC television system. (Ex.1004 ¶476.)" Pet. at 27. However, the LCD display of *Misawa '607* is not an NTSC display because it is limited to 240 lines for the entire screen, while NTSC is specified to contain about 480 lines per frame displayed. *See* Ex. 1006, Fig. 7. Contrary to Petitioner's characterization,

Misawa '607 does not disclose that the LCD uses the same signal format as a television signal format. Pet. at 27. Although *Misawa '607* discloses that the LCD display can operate at the same frame refresh rate as a color television, each of the embodiments disclosed in *Misawa '607* require using less than the available pixels specified for the disclosed television formats (NTSC, PAL, SECAM). Moreover, Petitioner has not disclosed any television signal format that matches the 320x240 pixel arrangement of the LCD of *Misawa '607* at the required frame rate of NTSC (or PAL or SECAM).

Therefore, because Petitioner applied the wrong claim construction, Petitioner has not shown that *Misawa '607* in view of the knowledge of a POSITA renders obvious claim element 1[B].

2. *Ground 2: Petitioner Failed To Establish That Each of Element 1[B] and 4[B] is Obvious Over Misawa '607 and Okino '947*

Petitioner relies on the same arguments made for Element 1[B] under Ground 1 to meet Element 1[B] under Ground 2. In addition, Petitioner argues in one sentence that *Okino '947* also meets this limitation because, combined with *Misawa '607*, *Okino '947*'s output signal “would be provided as the 240 effective scanning lines per field of the NTSC television system to the *Misawa '607* LCD display screen. (Ex.1004 ¶505.).” Pet. at 40. Similarly, for Claim 4 under Ground 2, Petitioner argues that “[t]he phrase ‘effective vertical lines’ is not used in the ‘604

Patent specification, but the similar phrase 'effective scan[ning] lines' is used in the '604 Patent specification to refer only to lines per field, and never lines per frame." Pet. at 54. However, without more, these arguments fail for the same reasons as above.

Therefore, because Petitioner applied the wrong claim construction, Petitioner has not shown that *Misawa* '607 in view of *Okino* '947 renders obvious Claim element 1[B] and 4[B].

3. *Petitioner Fails To Establish That Element 1[C] is Obvious Under both Grounds 1 and 2*

Element 1[C] requires "a driver configured to drive the image sensing device to vertically mix or cull signal charges accumulated in individual pixels, at intervals of a quantity K of pixels, in order to produce a quantity of lines of output signals **which corresponds to** the quantity M of effective scanning lines." Ex. 1003, Claim 1. (emphasis added).

Petitioner has not shown that *Misawa* '607 discloses producing a number of lines of output signals which corresponds to the number of effective scanning lines under either its own interpretation of M or under Patent Owner's correct construction. Under Petitioner's interpretation of M, the number of output lines would be 480 because Petitioner's interpret M as the number of effective scanning lines per field. If M=240, under Petitioner's interpretation, the output would be two

times M or 480. However, Petitioner argues that “[i]n both driver modes, the 240 lines of output signals correspond to the M=240 effective scanning lines of the NTSC television system. (Ex.1004 ¶481.)” Pet. at 29. Therefore, Petitioner has not shown that *Misawa '607* discloses element 1[C] under its interpretation of M. Further, under Patent Owner's proposed construction, M is interpreted as the number of effective pixel lines in a frame to be displayed on a display screen of a television system or M=480. As stated above, *Misawa '607* only discloses an output of 240 lines. Therefore, Petitioner has not shown that *Misawa '607* discloses element 1[C] under either interpretation.

More specifically, although *Misawa '607* discloses adapting the frame frequency of NTSC signal format for displaying on the LCD (*see* Ex. 1006, at 8:4-8), none of the disclosed adaptations implicates driving the image sensing signals in the claimed manner.

In the first driving mode of *Misawa '607* (normal image-capturing mode), $\frac{1}{4}$ of the photoelectric elements are read to output 240 lines, which represents the number of lines in one displayed screen. *See* Ex. 1006, at 7:63–8:3 (“although the obtained image is rough (if there are 960 pixels in a vertical direction, 240 pixels are read (in $\frac{1}{4}$) or 120 pixels are read (in $\frac{1}{8}$)), a refresh rate, which is the number of times the *images of one screen* are refreshed in unit of time, can be high.”). However, 240 lines in one screen is not the number of effective scanning lines M of a display screen

of a television system, e.g., NTSC. That number is 480.

Similarly, in the second driving mode of *Misawa* '607 (macro image-capturing mode), for the third method relied upon by Petitioner, $\frac{1}{2}$ of the photoelectric elements are read from the central reading area 52B (of 480 lines) to also output 240 lines, which represents the number of lines in one displayed screen. *See* Ex. 1006, Fig. 10 and 9:5-14. Again, 240 lines in one screen is not the number of effective scanning lines M of a display screen of a television system, e.g., NTSC, 480 lines is.

Moreover, Petitioner's arguments are internally inconsistent because Petitioner matches 240 lines per field of an NTSC frame with 240 lines per displayed screen of the LCD of *Misawa* '607. Indeed, as shown in Fig. 7, 240 lines represent the number of lines in the entire LCD display area, not per field. *See* Ex. 1006, Fig. 7 and 8:57-59 ("the image display such as the LCD 40 has approximately 320×240 pixels"). Thus, in *Misawa* '607, the corresponding number of lines per field would be 120 (not 240). This is inconsistent with Petitioner's proposed construction that M=240 refers to "the number of effective scanning lines per field (and not per frame)." Pet. at 26.

Petitioner makes no further arguments in regards to Element 1[C] in Ground 2 as to how a combination with *Okino* '947 would overcome these flaws. For all

these reasons, Petitioner has not shown that Element 1[C] is rendered obvious under either Ground 1 or 2.

4. *Petitioner Failed To Establish That Element 1[D] is Obvious Under both Grounds 1 and 2*

Element 1[D] requires that “wherein the quantity K is an integer less than or equal to an integer portion of a quotient of N divided by M;” Ex. 1003, Claim 1. Petitioner has not shown that *Misawa* '607 discloses this element.

As explained above, under the proper interpretation of M, M=480. If M=480 and N=960, then the integral part of the quotient of N divided by M is 2 and K=2. As Petitioner explains, in *Misawa* '607, K1=4 and K2=2. Because K1=4 is greater than K=2, Petitioner has not shown that *Misawa* '607 discloses K being less than or equal to a quotient of N divided by M.

C. *Ground 2: Petitioner Failed To Establish Why a POSITA would combine Misawa '607 and Okino '947*

Petitioner argues that “a POSITA would have known to combine the teachings of *Misawa* '607 and *Okino* '947 in the manner set forth in Claims 1-5” of Ground 2. Pet. at 34. Petitioner first sets forth that *Misawa* '607 “does not provide any details describing the design of the zoom lens, nor how such a zoom lens is controlled ‘according to the signals inputted from the control part 50,’ nor how the focus and zoom are operated together.” Pet. at 35. Petitioner then concludes that due to this, “a POSITA would have looked to a reference such as *Okino* '947 for its teachings

concerning control of ‘an optical zoom function using a zoom lens.’ (Ex.1009 1:12-13; Ex.1004 ¶492.)” Pet. at 35. Petitioner then relies on a premise that a POSITA would have combined *Misawa* ’607 with *Okino* ’947 to overcome flaws in its focusing mechanism. However, not only is Petitioner’s conclusion entirely misplaced, Petitioner also fails to explain both *how* and *why* one of ordinary skill in the art would have combined *Misawa* ’607 with *Okino* ’947 to produce the claimed invention.

First, Petitioner’s conclusion that a POSITA would have looked to *Okino* ’947 for its “optical zoom functioning using a zoom lens” is erroneous. The inventor of *Misawa* ’607 “does not provide any details describing the design of the zoom lens” (See Pet. at 35) not because it lacks in detail, but instead because such details are irrelevant to its goal. *Misawa* ’607 discloses three image-capturing methods, all which disclose different ways of driving the image sensor of its image-capturing apparatus to read the signals from a certain portion of the photoelectric elements. Ex. 1009 5:8-10, 5:46-47. It discloses how in normal-mode, it obtains rough images but has a high refresh rate. *Id.* at 7:55-67, 8:1-3 It then discloses a macro image-capturing mode that can help confirm the camera’s focus due to its ability to obtain a higher quality image by, for example, reading ½ of the photoelectric elements. *Id.* at 8:29-31, 8:42-44, 8:59-60. And lastly, it discloses an outside output mode that can also properly adjust the driving of its image sensor appropriately. But the

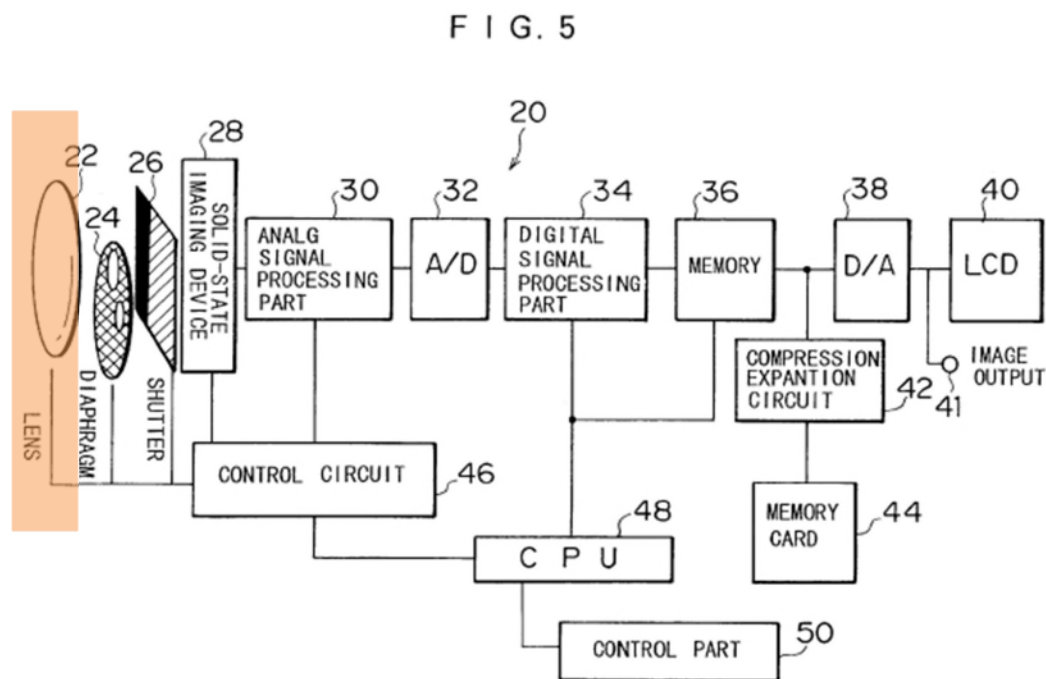
function of an optical zoom lens plays no role in any of these steps. The details of an optical zoom lens are purposefully outside the disclosures of *Misawa* '607 for that very reason. Therefore, a POSITA would not have looked to *Okino* '947's optical zoom functionality.

Second, Petitioner further relies on the premise that a POSITA would be motivated to combine *Okino* '947's architecture into *Misawa* '607 to "overcome known difficulties in maintaining focus during a zooming operation." Pet. 35. To achieve this combination, a POSITA would purportedly replace the "taking lens" in *Misawa* '607 with the "lens groups" for optical zooming disclosed in *Okino* '947. For this preposition, Petitioner relies on a single sentence of *Misawa* '607 that explains the taking lens 22 "may be a fixed-focus lens or a variable focal-length lens such as a zoom lens and a step zoom lens." Pet. at 33. However, for the reasons detailed below, this premise is also flawed.

A POSITA would not look to *Okino* '947 because it provides no "fix" or improvement to *Misawa* '607's camera focus. Replacing *Misawa* '607's taking lens with *Okino* '947's lens groups would not help to "overcome" difficulties in the focusing solution already provided by *Misawa* '607, but would instead create a new problem, the very problem that *Okino* '947 then attempts to solve. *Okino* '947 explains that its "so-called rear focus zoom lens . . . has characteristics in that an in-focus state cannot be obtained unless the fourth lens group (focusing lens) is moved

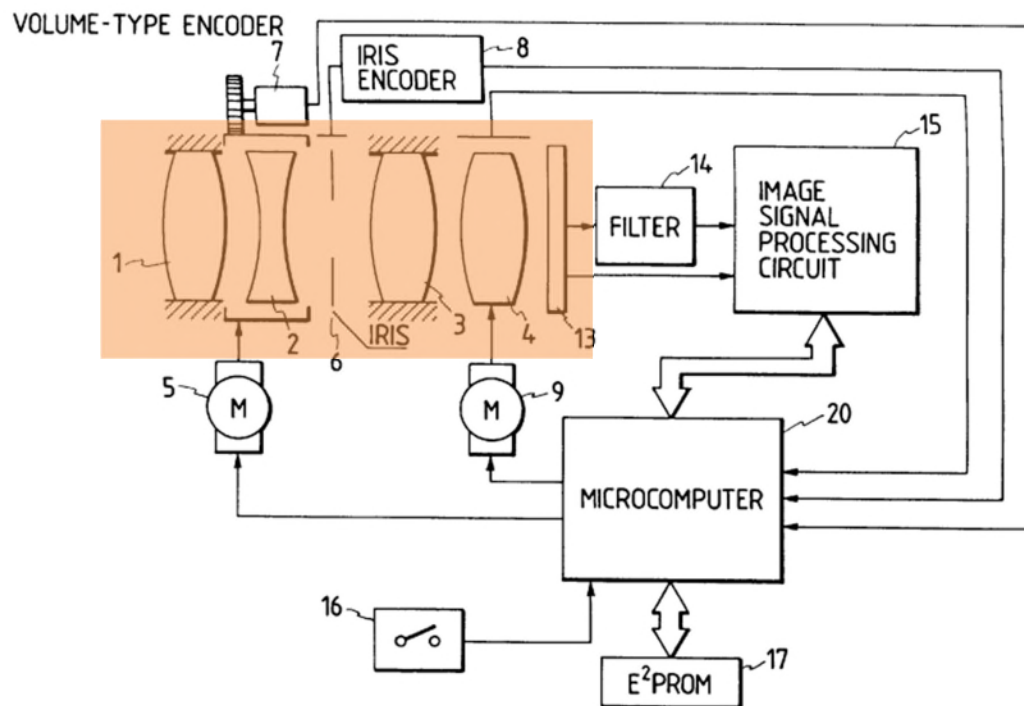
along a predetermined zoom path during a zooming operation even when the object distance remains the same, unlike in a conventional front focus type zoom lens.” Ex. 1009, at 4:65-5:4. Therefore, a POSITA's replacement of *Misawa '607's* taking lens 22 with *Okino '947's* rear focus zoom lens would only impair its camera focus, not help to overcome any problems in it. A POSITA would then only arguably turn to *Okino '947* to solve the very problem it just created.

Misawa '607's architecture is displayed below, with taking lens 22 displayed as a single fixed-focus or variable focus lens:



Ex. 1006, Fig. 5. On the other hand, *Okino '947's* much more complicated lens architecture is displayed below, with its unconventional rear-focus zoom lens:

FIG. 1



Ex. 1009, Fig. 1. A POSITA practicing *Misawa* '607 would have no motivation or desire to complicate its operational focusing design with another completely different and distinct architecture, that serves no improvement to its camera focus, but is instead dedicated to solving *Okino* '947's unique lens focusing problem in its unconventional lens type, one that *Misawa* '607 does not even have. Petitioner argues that the silence of *Misawa* '607 in regards to any "incompatibility with the zoom lens configuration taught by *Okino* '947" suggests this is possible. Pet. at 38. But to the contrary, such silence only re-enforces the undesirability of a POSITA practicing *Misawa* '607 to perform this proposed architectural redesign.

In addition, and contrary to Petitioner's assertion, it would not be so "simple and straightforward" to modify the electric camera of *Misawa* '607 with the continuous optical and electronic zooming of *Okino* '947. Pet. at 39. Instead, it would require a complete replacement of *Misawa* '607's image sensor driving method to account for *Okino* '947's "two zooming operations [that] overlap each other." Ex. 1009, at 6:32-33. For example, *Okino* '947 has complex needs of "switching between the optical and electronic zoom functions" with "one zooming operation [that] is started before the other zooming operation is stopped." *Id.* at 64-66. Furthermore, doing so would break some of *Misawa* '607's own functionalities at the time such as the ability to shut off power to its memory 36 in normal mode when "there is no need for temporally storing the image in the memory." Ex. 1006, at 8:8:11. Such features that simplify the structure of the camera were important at the time, as highlighted by the '604 Patent itself. *See* Ex. 1003, at 3:12-17 ("[a]n object of the present invention is to provide an electric camera . . . without increasing circuitry such as field memory.").

Therefore, Petitioner has not shown why a POSITA would be motivated to combine *Misawa* '607 with *Okino* '947, and thus there is no reasonable likelihood of success of any claim under Ground 2.

VI. THE PETITION SHOULD BE DENIED AS A RESULT OF DEFICIENCIES IN THE DECLARATION OF PETITIONER'S PROPOSED EXPERT

A. Mr. Saber's "Omnibus" Declaration Provides a Separate Basis for Denying the Petition

The Petition should also be rejected because the Petitioner has not provided a record with which the Board could "secure the just, speedy, and inexpensive resolution" of a resulting proceeding. *See* 37 C.F.R. § 4.21. In its decision denying institution of *inter partes* review of U.S. Patent No. 8,001,053 in *Apple v. Contentguard Holdings, Inc.*, the Board stated that it could not provide for the "just, speedy, and inexpensive resolution" of a proceeding where the petitioner had submitted an "omnibus declaration" used by Petitioner in eight separate petitions that included voluminous information not relevant to the actual petition itself, and contained numerous self-citations. *Apple v. Contentguard Holdings, Inc.*, Case IPR2015-00356, Paper 9, at 18-19. The Board noted in particular the large number of documents submitted by petitioner that were not cited in the petition itself, and recognized that mere citation of certain documents in the omnibus declaration "should not be equated with being relied upon in the Petition, because the Declaration is being offered in seven other IPR petitions, each of which challenges a different patent and/or asserts a different set of prior art." *Id.* at 18.

In this case, Mr. Saber's declaration includes thousands of pages of extraneous exhibits, appendices, and materials that are never actually cited in the Petition. In fact, the declaration contains references to almost 1000 pages of appendixes, several that are part of declarations in other proceedings and are not cited here at all.

As the Office Patent Trial Practice Guide cautions, petitioners should "avoid submitting a repository of all the information that a judge could possibly consider, and instead focus on concise, well-organized, easy-to-follow arguments." 77 Fed. Reg. at 48,763. Just like the petitioner in the *Apple v. Contentguard Holdings*, the Petitioner here "widely misses the mark."

B. Mr. Saber's Declaration is an Improper Bare Adoption of Another Expert Without His Own Assessment

Furthermore, Mr. Saber's declaration is nothing more than an improper wholesale adoption of Mr. Parulski's declaration, offering no opinion of its own at all. "Although an expert may rely on the opinion of another expert, the expert may not simply repeat or adopt the findings of other experts without investigating them and attempting to assess the validity of the opinion." *Lawson v. Dep't of Corr.*, No. 4:04-cv-105-WTH-GRJ, 2018 U.S. Dist. LEXIS 180945, at *8-9 (N.D. Fla. Feb. 16, 2018) (citing *In re TMI Litig.*, 193 F.3d 613, 715-16 (3d. Cir. 1999) (finding blind reliance by expert on other expert opinions demonstrates flawed methodology)). Quite simply, when "an expert does not simply rely upon data or facts collected

by another expert for use in forming an opinion but, instead, adopts wholesale the opinion of another expert, Rule 703 does not render the testimony admissible.” *Sims v. State Farm Mut. Auto. Ins. Co.*, No. 4:13CV00371 JLH, 2016 U.S. Dist. LEXIS 86918, at *2-3 (E.D. Ark. Jan. 13, 2016) (explaining that “an expert’s opinion must be based upon his own application of principles within his expertise to the facts of the case.”).

Mr. Saber does not provide any opinion that is his own, or even discuss why and how it agrees or disagrees with any part of Mr. Parulski’s declaration. Although Mr. Saber does assert that he supposedly “independently formed [his] own opinions concerning the patentability of Claims 1-5 of the ’604 Patent,” none of those opinions are actually expressed in his declaration. Ex. 1004, ¶ 3. Instead, Mr. Saber provides a blanked statement of adoption, asserting that “[t]o the extent that I agree with Mr. Parulski’s analysis in his declaration, I have incorporated that analysis into my declaration.” *Id.* But without Mr. Parulski’s adoption, Mr. Saber’s declaration is completely bare. Indeed, the over 500 paragraphs of Mr. Saber’s declaration that provide any substance or analysis are a mere copy-and-paste of Mr. Parulski’s declaration paragraphs 23-553. *Compare* Ex. 1004, ¶¶ 22-553 *with* Ex. 1008, ¶¶ 22-553. They are identical. Mr. Saber even “kept the same paragraph numbers as in” Mr. Parulski’s declaration, as to make it easier for the Petition to also be a mere

copy-and-paste of the Petition in separate proceedings that were never joined. Ex. 1004, ¶ 22.

For this reason alone, Mr. Saber's declaration should be afforded little or no weight, and because the Petition entirely relies on Mr. Saber's declaration, it should be denied.

C. Mr. Saber's Declaration is Unsupported and Simply Repeats the Language of the Petition

Moreover, as noted above, Mr. Parulski's statements, even if adopted as Mr. Saber's, fail to provide any articulated reasoning with a rational underpinning necessary to support the conclusory statements regarding the arguments made in the Petition. *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.").

Mr. Parulski's adopted statements, to the extent they address the instant Petition, largely parrot the conclusory statements in the Petition, and it is impossible to tell whether they are his own or are those of Petitioner's lawyers. For example, Mr. Parulski's adopted statements regarding Claim elements 1[A] and 1[B], (Ex. 1004, ¶¶ 471-475), are nearly identical copies of the Petition's statements regarding those claim elements. (Pet. at 25-28.) Similarly, numerous pages of Mr. Parulski's adopted statements regarding Ground 2, (Ex. 1004, ¶¶ 502-517), are almost word-

for-word identical to the Petition's statements. (Pet. at 39-48.) Accordingly, Mr. Parulski's adopted statements should be afforded no probative value. *Kinetic Techs., Inc. v. Skyworks Sols., Inc.*, IPR2015-00529, Paper 8 at 15 (PTAB Sep. 23, 2014) ("Merely repeating an argument from the Petition in the declaration of a proposed expert does not give that argument enhanced probative value."); *id.* at 18 ("Paragraphs 28, 29, and 30 of [declarant's] Declaration essentially are identical to the corresponding text of the Petition. Based on our analysis above, we give [declarant's] Declaration no probative weight."); *see also Wowza Media Sys., LLC v. Adobe Sys. Inc.*, IPR2013-00054, Paper 12 at 12 (PTAB 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.").

For at least these additional reasons, Mr. Saber's declaration and voluminous appendices should be afforded little or no weight, and the conclusory Petition should be denied.

VII. CONCLUSION

The Board should not institute *inter partes* review on any of the grounds set forth in the Petition. As Patent Owner has shown, Petitioner has not established a

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reasonable likelihood that the cited references render any of the challenged claims of the '604 Patent are anticipated or obvious.

Dated: March 12, 2019

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 12th day of March, 2019, a copy of the attached PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 9,100,604, was served by electronic mail to the attorneys of record for Petitioner at the following addresses:

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By:

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CERTIFICATION PURSUANT TO 37 C.F.R. § 42.24(d)

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that this PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 9,100,604 complies with the type-volume limitation of 37 C.F.R. § 42.24(b). The word processing program used to prepare this paper states that the paper contains 8,286 words, excluding the parts of the paper exempted by 37 C.F.R. §§ 42.24(a)(1) and 42.24(b).

Dated: March 12, 2019

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