

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**IN THE UNITED STATES PATENT TRIAL AND APPEAL BOARD**

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AVER INFORMATION INC., AND IPEVO, INC.  
PETITIONER

V.

PATHWAY INNOVATIONS AND TECHNOLOGIES, INC.  
PATENT OWNER

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CASE: IPR2017-02108  
U.S. PATENT NO. 8,508,751

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**PETITIONER'S OPPOSITION TO PATENT OWNER'S  
MOTION TO AMEND**

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## CONTENTS

I.	Introduction.....	1
II.	State of the Art.....	2
	A.    Using Video Cameras as Document Cameras Was Known .....	3
	B.    Using a Mouse Scroll for Zooming Was Known.....	9
III.	The MTA Does Not Comply With 37 C.F.R. §42.6 and 37 C.F.R. §42.24 .....	11
IV.	The MTA Does Not Comply With 37 C.F.R. §42.121 .....	12
	A.    PO Has Not Proposed Substitute Claims .....	12
	B.    The Purported Substitute Claims Impermissibly Broaden the ‘751 Patent Claims .....	14
V.	The Proposed Substitute Claims Are Obvious .....	16
	A.    Combining <i>Morichika</i> and <i>Liang</i> .....	17
	B.    Each Proposed Substitute Claim is Obvious.....	19
	C.    PO’s Arguments About <i>Morichika</i> .....	25
VI.	Conclusion .....	25

List of Exhibits<sup>1</sup>

- Ex. 1001 U.S. Patent No. 8,508,751
- Ex. 1002 U.S. Patent Application Publication No. 2005/0078052 (“Morichika”)
- Ex. 1003 U.S. Patent No. 7,239,338 (“Krisbergh”)
- Ex. 1004 U.S. Patent Application Publication No. 2001/0012051 (“Hara”)
- Ex. 1005 U.S. Patent No. 7,148,911 (“Mitsui”)
- Ex. 1006 U.S. Patent Application Publication No. 2004/0174444 (“Ishii”)
- Ex. 1007 U.S. Patent No. 6,965,460 (“Gann”)
- Ex. 1008 RESERVED
- Ex. 1009 RESERVED
- Ex. 1010 ITC 337-TA-1045, PO’s Initial Claim Construction Brief
- Ex. 1011 ITC 337-TA-1045, PO’s Reply Claim Construction Brief
- Ex. 1012 RESERVED
- Ex. 1013 IPR2016-00661, PTAB Decision
- Ex. 1014 ITC 337-TA-1045, ITC Claim Construction Order

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<sup>1</sup> Citations to non-patent publications are to the original page number of the publication, and citations to U.S. patents are to column:line number of the patents, unless paragraph numbers are provided.

- Ex. 1015 U.S. Patent No. 6,744,109
- Ex. 1016 Correspondence with Patent Owner regarding claim 18
- Ex. 1017 Non-final Rejection for U.S. Patent No. 8,508,751, dated 11/6/2012
- Ex. 1018 Response to Non-final Rejection for U.S. Patent No. 8,508,751, dated  
2/5/2013
- Ex. 1019 Notice of Allowance for U.S. Patent No. 8,508,751, dated 4/18/2013
- Ex. 1020 Declaration of Dr. Vijay Madiseti
- Ex. 1021 U.S. Patent No. 6,540,415 (“Slatter”)
- Ex. 1022 Transcript of September 20, 2018 Deposition of Dr. Jeffrey Rodriguez
- Ex. 1023 U.S. Patent Application Publication No. 2009/0002548 (“Liang”)
- Ex. 1024 U.S. Patent No. 6,128,006 (“Rosenberg”)
- Ex. 1025 Second Declaration of Dr. Vijay Madiseti

## I. INTRODUCTION

AVer Information Inc. and IPEVO, Inc. (collectively, “Petitioner”) requested *inter partes* review (“IPR”) of claims 1-5, 7-10, 12-14, 16, 18, and 20 (“Challenged Claims”) of U.S. Patent No. 8,508,751 (“751 Patent”) (Ex. 1001) under 35 U.S.C. §§311–319 and 37 C.F.R. §42 on September 15, 2017.

The Institution Decision (“Decision,” Paper 9) instituted review of claims 1-5 and 7 as obvious over *Morichika* (Ex. 1002), but declined to institute review on any other Ground. (Paper 9, 26). Of particular relevance, the Board found that claims 8-10, 12-14, and 16 are indefinite. (*Id.*, 14-16). The Board later modified the Decision to include all grounds/all claims in the Petition. (Paper 10, 2-3 (*citing SAS Inst., Inc. v. Iancu*, 2018 WL 1914661, at \*10 (U.S., Apr. 24, 2018))).

Patent Owner (“PO”) filed its Patent Owner Response (“Response,” Paper 11) on July 23, 2017, along with a Motion to Amend (“MTA”, Paper 12). The MTA states that “PO seeks to substitute claims 1-3, 5, 8, 10, 12-14, and 16 with substitute claims 21-30, respectively. PO’s MTA *is not contingent upon the originally issued claims being found unpatentable.*” (Paper 12, 1).<sup>2</sup>

PO’s MTA exceeds the page limit requirements and thus fails to comply with 37 C.F.R. §42.6 and 37 C.F.R. §42.24(a)(1)(vi). PO’s MTA also seeks to

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<sup>2</sup> All emphasis added unless otherwise indicated.

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