

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS INC.,
Petitioner,

v.

IMMERVISION, INC.,
Patent Owner.

IPR2020-00179
Patent 6,844,990 B2

Before KRISTINA M. KALAN, WESLEY B. DERRICK, and
KIMBERLY McGRAW, *Administrative Patent Judges*.

DERRICK, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

On November 27, 2019, LG Electronics Inc. (“Petitioner” or “LG Electronics”) filed a Petition requesting an *inter partes* review of claim 5 (“the challenged claim”) of U.S. Patent No. 6,844,990 B2 (Ex. 1001, “the ’990 patent”). Paper 2 (“Pet.”). ImmerVision, Inc. (“Patent Owner” or “ImmerVision”) filed a Preliminary Response to the Petition. Paper 5 (“Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314(b) (2018); 37 C.F.R. § 42.4(a). To institute an *inter partes* review, we must determine that the information presented in the Petition shows that there is “a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Applying that standard, for the reasons set forth below, we institute an *inter partes* review as to all grounds raised in the Petition.

II. BACKGROUND

A. *Real Parties in Interest*

Petitioner LG Electronics Inc. identifies LG Electronics U.S.A., Inc. and LG Innotek Co. Ltd. as additional real parties-in-interest. Pet. 2. Patent Owner ImmerVision, Inc., identifies itself as the real party-in-interest. Paper 4, 2. The parties do not raise any issue about real parties-in-interest.

B. *Related Proceedings*

The parties identify two pending district court cases involving the ’990 patent as related matters: *ImmerVision, Inc. v. LG Electronics U.S.A.*, Case No. 1-18-cv-01630 (D. Del.) and *ImmerVision, Inc. v. LG Electronics U.S.A.*, Case No. 1-18-cv-01631 (D. Del.). Pet. 2; Paper 4, 2–3.

Petitioner concurrently filed another petition that challenges claim 21 of the '990 patent. *See LG Electronics Inc. v. Immervision, Inc.*, IPR2020-00195, Paper 2.

In addition, Petitioner states the '990 patent: (1) was the subject of *Ex Parte* Reexamination Control No. 90/013,410; (2) was challenged in an *inter partes* proceeding, *Panasonic System Networks Co., Ltd. v. 6115187 CANADA INC.*, IPR2014-01438; and (3) was the subject of three other district court cases, now closed. *See* Pet. 2–3; *see also* *Panasonic System Networks Co., Ltd. v. 6115187 CANADA INC.*, IPR2014-01438, Paper 11 (PTAB Nov. 26, 2014) (terminating proceeding prior to institution following settlement).

C. The '990 Patent (Ex. 1001)

The '990 patent is titled “Method for Capturing and Displaying a Variable Resolution Digital Panoramic Image” and issued on Jan. 18, 2005, from an application filed on Nov. 12, 2003. Ex. 1001, code (22), (45), (54). The application for the '990 patent is a continuation of application No. PCT/FR02/01588, filed on May 10, 2002, and claims priority to foreign application FR 01 06261, filed May 11, 2001. *Id.* at code (30), (63).

The '990 patent is directed to capturing a digital panoramic image that includes using a panoramic objective lens having “a distribution function of the image points that is not linear relative to the field angle of the object points of the panorama.” *Id.*, Abstract. The image obtained using such a panoramic objective lens has at least one zone that is expanded and another zone that is compressed. *Id.* The patent further provides for correcting the non-linearity of the panoramic image initially obtained. *Id.*

The '990 patent was the subject of an *ex parte* reexamination. *Id.* at 25–27 (Ex Parte Reexamination Certificate (10588th)). The

Reexamination Request—Control No. 90/013,410—was filed November 26, 2014. *Id.* at 25; Ex. 1003, 328–339 (“Request by Patent Owner for *Ex Parte* Reexamination of U.S. Patent No. 6,844,990”). Patent Owner cancelled, *inter alia*, claim 1 by way of preliminary amendment that accompanied its request for *ex parte* reexamination of claims 1–4, 6, 7, 10, 11, 15–20, 22, 23, and 25. *See* Pet. 17–18; Ex. 1003, 330, 341. The Patent Office granted Patent Owner’s request for reexamination of the identified claims. Ex. 1003, 52–63. The Patent Office declined to reexamine claims 5, 8, 9, 12–14, 21, 24, and 26 on the basis that “the requester did not request reexamination of . . . and did not assert the existence of a substantial new question of patentability for those claims.” *Id.* at 56 (citing 35 U.S.C. § 311(b)(2)). At the conclusion of the proceeding, the Patent Office issued an *Ex Parte* Reexamination Certificate cancelling claims 1, 6, 7, 17–20, 22, 23, and 25; determining claims 2–4, 10, and 15 to be patentable as amended; determining claims 11 and 16 dependent on an amended claim to be patentable; and adding and determining to be patentable new claims 27–47. Ex. 1001, 25–27; Ex. 1003, 1–3.

D. Claimed Subject Matter

Challenged claim 5 incorporates the limitations of cancelled claim 1, from which it depends. *See* MPEP § 2260.01 (“the content of the canceled base claim . . . [is] available to be read as part of the confirmed or allowed dependent claim”). Both claims are reproduced below.

1. A method for capturing a digital panoramic image, by projecting a panorama onto an image sensor by means of a panoramic objective lens, the panoramic objective lens having an image point distribution function that is not linear relative to the field angle of object points of the panorama, the distribution function having a maximum divergence of at least $\pm 10\%$ compared to a linear distribution function, such that the

panoramic image obtained has at least one substantially compressed zone.

Ex. 1001, 19:28–37.

5. The method according to claim 1, wherein the objective lens compresses the center of the image and the edges of the image and expands an intermediate zone of the image located between the center and the edges of the image.

Ex. 1001, 19:49–52.

E. Evidence

Petitioner relies upon the following prior art references in the asserted grounds of unpatentability:

| Reference | Date | Exhibit No. |
|--------------------------|---------------------------------------|-------------|
| US 5,861, 999 (“Tada”) | Jan. 19, 1999, filed Aug. 21, 1997 | 1007 |
| US 6,128,145 (“Nagaoka”) | Oct. 3, 2000, filed Apr. 28, 1999 | 1004 |
| US 5,686,957 (“Baker”) | Nov. 11, 1997, filed Jun. 30, 1995 | 1005 |

Petitioner also relies on the Declaration of Russell Chipman, Ph.D. (Ex. 1008).

F. The Asserted Grounds of Unpatentability

Petitioner contends that the challenged claim is unpatentable based on the following grounds:

| Claim(s) Challenged | 35 U.S.C. § ¹ | Reference(s)/Basis |
|---------------------|--------------------------|--------------------|
| 5 | 103 | Tada |

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, 125 Stat. 284, 287–88 (2011), revised 35 U.S.C. § 103 effective March 16, 2013. Because the challenged patent was filed before March 16, 2013, we refer to the pre-AIA version of 35 U.S.C. § 103.

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