

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZTE CORPORATION and ZTE (USA), INC.,
Petitioners,

v.

MAXELL, LTD.,
Patent Owner.

Case IPR2018-00236
Patent 8,339,493 B2

Before MINN CHUNG, TERRENCE W. McMILLIN, and
JOHN A. HUDALLA, *Administrative Patent Judges*.

McMILLIN, *Administrative Patent Judge*.

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

I. INTRODUCTION

ZTE Corporation and ZTE (USA), Inc. (“Petitioner”)¹ filed a Petition (“Pet.”) (Paper 2) to institute an *inter partes* review of claims 5 and 6 of Patent 8,339,493 B2 (the “’493 patent”) (Ex. 1001) pursuant to 35 U.S.C. § 311 *et seq.* Patent Owner Maxell, Ltd. (“Patent Owner”)² filed a Preliminary Response (“Prelim. Resp.”) (Paper 6) to the Petition.

This is a preliminary proceeding to decide whether *inter partes* review of the ’493 patent should be instituted under 35 U.S.C. § 314(a), which provides that *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . and any response . . . 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.” *See* 35 U.S.C. § 314(a) (regarding institution of *inter partes* review); 37 C.F.R. § 42.4(a) (delegating authority to institute trial to the Board).

Upon consideration of the Petition, the Preliminary Response, and the evidence of record, we conclude that the information presented fails to show that there is a reasonable likelihood that Petitioner will prevail in establishing the unpatentability of at least one of the challenged claims of

¹ In the caption of the Petition, both ZTE Corporation and ZTE (USA), Inc. are identified as Petitioner. In the body of the Petition, ZTE (USA), Inc. is identified as the sole Petitioner and ZTE Corporation is identified as an additional real party in interest. Pet. 1.

² In the caption of the Petition, the Patent Owner is identified by the Petitioner as Hitachi Maxell, Ltd. In the caption of Patent Owner’s Mandatory Notices, the Patent Owner is identified as Hitachi Maxell, Ltd. but, in the body of this same document, the Patent Owner is identified as Maxell, Ltd. (Paper 5, 2). In the caption and body of the Preliminary Response (Paper 6, 1), Patent Owner identifies itself as Maxell, Ltd.

the '493 patent. For the reasons that follow, the Board has determined not to institute an *inter partes* review.

A. Related Matters

Both parties identify one related matter under 37 C.F.R. § 42.8(b)(2), *Maxell, Ltd. v. ZTE Corporation and ZTE USA Inc.*, 5:16-cv-00179-RWS (E.D. Tex.),³ that would affect, or be affected by, a decision in this proceeding. Pet. 1; Paper 5, 2.

B. The '493 Patent (Ex. 1001)

The '493 patent, is titled “Electric Camera.” Ex. 1001, (54). It issued on December 25, 2012, based on an application filed July 28, 2010. *Id.* at (22), (45). It claims priority as a continuation of a U.S. application filed September 12, 2003, which in turn claims priority as a division of a U.S. application filed March 8, 2000. *Id.* at (60). Priority is also claimed to a Japanese patent application filed January 11, 2000. *Id.* at (30), 1:6–14.

The '493 patent relates to “video cameras, camcorders, digital still cameras and others using a solid-state image sensing device, and more particularly to an electric camera using a solid-state image sensing device with a large number of pixels.” *Id.* at 2:57–61. An object of the invention is to provide an electric camera “which uses an image sensing device with a sufficient number of pixels for still images and enables the 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 3:8–

³ Petitioner identifies the plaintiff as Hitachi Maxell, Ltd. Pet. 1. Patent Owner identifies the plaintiff as Maxell, Ltd. Paper 5, 2.

13. “It is also an object of the present invention to provide an electric camera that can also realize the image stabilizing function.” *Id.* at 3:13–15.

C. The Challenged Claims

Of the challenged claims of the ’493 patent, claim 5 is independent, and claim 6 depends from claim 5. Claims 5 and 6 recite:

5. An electric camera comprising:
 - an image sensing device with a light receiving sensor having an array of pixels arranged vertically and horizontally in a grid pattern, in an N number of vertically arranged pixel lines;
 - a signal processing unit that generates image signals by processing the output signals of the image sensing device; and
 - a display unit with a display screen, that displays an image corresponding to the image signals;wherein when recording an image in a static image mode, the signal processing unit generates the image signals by using all signal charges accumulated in all N number of vertically arranged pixel lines of the image sensing device, to provide N pixel lines;
 - wherein when monitoring the image in the static image mode, the signal processing unit generates the image signals by using pixel lines that have been mixed or culled from the N number of vertically arranged pixel lines to only include pixel lines separated from one another by intervals of a first distance; and
 - wherein when recording the image in a moving video mode, the signal processing unit generates the image signals by using a portion of, or the entirety of, pixel lines which have been mixed or culled from the N number of vertically arranged pixel lines to only include pixel lines separated from one another by intervals of a second distance, where the second distance is different from the first distance.
6. An electric camera according to the claim 5, further comprising:
 - an image-instability detector which detects an image-instability of the electric camera; and

wherein when recording in the moving video mode, in order to correct the image-instability, the signal processing unit generates the image signals by changing the pixel lines used, and the portion of the pixel lines used, according to an amount of image-instability detected by the instability detector.

Ex. 1001, 16:32–17:3.

D. The Prior Art

Petitioner relies on the following prior art:

U.S. Patent 5,493,335, issued February 20, 1996 (“Parulski ’335”)

(Ex. 1003);

U.S. Patent 5,440,343, issued August 8, 1995 (“Parulski ’343”)

(Ex. 1004);

U.S. Patent 5,497,192, issued March 5, 1996 (“Ishizuka”) (Ex. 1005);

U.S. Patent 5,828,406, issued October 27, 1998 (“Parulski ’406”)

(Ex. 1006); and

U.S. Patent 6,512,541 B2, filed December 8, 1997 (“Dunton”)

(Ex. 1007). Pet. 3–4

E. The Asserted Grounds

Petitioner challenges claims 5 and 6 of the ’493 patent on the following grounds:

Claim 5 as obvious under 35 U.S.C. § 103 in view of Parulski ’335 and Parulski ’343;

Claim 6 as obvious under 35 U.S.C. § 103 in view of Parulski ’335, Parulski ’343, and Ishizuka;

Claim 5 as obvious under 35 U.S.C. § 103 in view of Parulski ’406 and Dunton; and

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