UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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LG ELECTRONICS INC. AND LG ELECTRONICS USA, INC.,
Petitioners,

v.

IMAGE PROCESSING TECHNOLOGIES, LLC
Patent Owner.

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Case IPR2023-00104
U.S. Patent No. 6,959,293

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**PATENT OWNER IMAGE PROCESSING TECHNOLOGIES, LLC'S PRELIMINARY SUR-REPLY**

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Petitioners offer nothing but attorney argument in their Reply to Patent Owner's Preliminary Response (Paper No. 8) and variously:

- misstate the record of the U.S. Patent & Trademark Office's ("the Office") multiple and detailed reviews of the validity of claim 1 of U.S. Patent No. 6,959,293 ("the '293 Patent");
- misrepresent Patent Owner's arguments in the Patent Owner Preliminary Response; and
- misinterpret the consequence of the District Court's denial of their Motion to Stay the parallel litigation.

Petitioners' Reply simply re-argues positions that Patent Owner has already rebutted in its Preliminary Response. The Board should deny institution of *Inter Partes* Review ("IPR") of claim 1 of the '293 Patent.

## I. THE OFFICE HAS REPEATEDLY CONSIDERED THE PIRIM REFERENCES IN RELATION TO CLAIM 1 OF THE '293 PATENT

Petitioners continue to assert that their "Petition presents new arguments and art." (Paper No. 8 at 1.) But that assertion is belied by their previous admissions. Grounds 1 and 2 of Petitioners' Petition rely on (1) Pirim[1], and (2) Pirim 2.[2] (Paper No. 1 at 4.) Petitioners confess that both Pirim and Pirim 2 were of record during original prosecution of claim 1 of the '293 Patent. As they wrote in their Petition:

[1] WIPO International Publication No. WO 99/36893 (Ex-1018).

[2] PCT Application Serial No. PCT/EP98/05383 (Ex-1021).

> During the original prosecution, Pirim ***was of record*** . . . . Additionally, [Pirim 2], discussed further in Part VII.A.2, below) ***was of record*** . . . .

(Paper No. 1 at 4 (emphases added) (citations omitted).) In other words, Petitioners concede that their Petition ***does not*** present new art.

Unable to argue that their Petition actually presents any new art, Petitioners are forced to assert that they have discovered two previously unrecognized details—details that Petitioners allege escaped even their own counsel at O'Melveny & Myers LLP when that firm represented Samsung in the '336 IPR and '056 EPR. (*See* Paper No. 6 at 13 n.3.) *First*, Petitioners assert that Pirim incorporates Pirim 2. *Second*, they assert that Pirim 2 allegedly contains invalidating disclosures of the "common parameter" requirement.

As Patent Owner has already explained, the extent of any incorporation of Pirim 2 in Pirim (if any) is irrelevant in these circumstances. (Paper No. 6 at 5–6.) If Pirim incorporates Pirim 2 today as Petitioners assert, then Pirim has always incorporated Pirim 2 and the Office has considered Pirim 2 every time it previously considered Pirim in the process of confirming the validity of claim 1 of the '293 Patent. (*Id.*) Alternatively, if Pirim does not incorporate Pirim 2 as Petitioners claim, then Pirim 2 is irrelevant to either their anticipation (Ground 1) or single-reference-obviousness (Ground 2) theories. (*Id.* at 5.)

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