

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,
Petitioner,

v.

VEDANTI SYSTEMS LIMITED,
Patent Owner.

Case IPR2016-00212¹
U.S. Patent No. 7,974,339 B2

**PATENT OWNER'S CONTINGENT MOTION TO AMEND
PURSUANT TO 35 U.S.C. § 316(d)(1) and 37 C.F.R. § 42.121**

¹ Case IPR2016-00215 has been consolidated with this proceeding.

TABLE OF CONTENTS

SUMMARY 1

ARGUMENT 1

 I. The Substitute Claims Do Not Enlarge the Scope of Any Original Claim 1

 II. The Substitute Claims Do Not Introduce New Matter and Are Supported
 by the Original Disclosures 2

 III. The Substitute Claims Are Patentable Over the Alleged Art 4

 A. Proposed Substitute Claims 14-15 5

 1. The Substitute Claims Are Patentable Over the Art Cited by and to
 the Board..... 5

 2. Other References and Alleged Prior Art 11

 B. Proposed Substitute Claims 16-17 19

 1. The Substitute Claims Are Patentable Over the Art Cited by and to
 the Board..... 19

 2. Other References and Alleged Prior Art 23

CONCLUSION..... 25

TABLE OF AUTHORITIES

Statutes

35 U.S.C. § 316..... 1, 2

Rules

37 C.F.R. § 42.121 1, 2

SUMMARY

Patent Owner's contingent motion to amend seeks the following:

- First, in the event that independent claim 7 is found unpatentable, substitute claim 14 for claim 7, and substitute dependent claim 15 for dependent claim 9 (to update the dependency).
- Second, in the event that independent claim 10 is found unpatentable, substitute claim 16 for claim 10, and substitute dependent claim 17 for dependent claim 12 (to update the dependency).

The Appendix accompanying this motion sets forth the substitute claims in markup form to identify the amendments (additions underlined and deletions stricken). Only one substitute claim is proposed for each of the challenged claims 7, 9, 10, and 12. *See* 37 C.F.R. § 42.121(a)(3).

ARGUMENT

Patent Owner's conditional motion presents allowable substitute claims.

I. The Substitute Claims Do Not Enlarge the Scope of Any Original Claim

Each of the substitute claims includes a new limitation in addition to the limitations found in each respective original claim, satisfying the statutory requirement that the changes “may not enlarge the scope of the claims of the patent.” 35 U.S.C. § 316(d)(3); *see also* 37 C.F.R. § 42.121(a)(2)(ii).

Proposed substitute claim 14 includes all of original independent claim 7's

limitations as well as the following new limitation: “wherein the optimized matrix data defines at least two regions having different aspect ratios.” Proposed substitute dependent claim 15 corresponds to original claim 9. Proposed claim 15 was amended to update the dependency to new claim 14.

Proposed substitute claim 16 includes all of words of original independent claim 10, including the following underlined additions: dividing an array of pixel data into two or more regions defined by region data; and selecting a non-predetermined set of pixel data from each region to produce selection pixel data for each region. The “non-predetermined” language is a new limitation. The other added language was necessarily implied by the original text of original claim 10. Proposed substitute dependent claim 17 corresponds to original claim 12. Proposed claim 17 was amended to update the dependency to new claim 16.

II. The Substitute Claims Do Not Introduce New Matter and Are Supported by the Original Disclosures

The substitute claims do not introduce new matter, 35 U.S.C. § 316(d)(3), and are supported by the July 16, 2004 original application (Ex. 1002) as well as the January 16, 2002, PCT application (Ex. 1018), 37 C.F.R. § 42.121(b).

Substitute claim 14 adds a requirement that the optimized matrix data that is generated “defines at least two regions having non-uniform aspect ratio” The original and PCT applications each disclose that, after receiving frame data, optimized matrix data is generated, and that the matrix data can define regions

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.