

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AVER INFORMATION INC. AND IPEVO, INC.,
Petitioner,

v.

PATHWAY INNOVATIONS AND TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2017-02108
Patent 8,508,751 B1

Before JONI Y. CHANG, THOMAS L. GIANNETTI, and
NORMAN H. BEAMER, *Administrative Patent Judges*.

BEAMER, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
U.S.C. § 318(a) and 37 C.F.R. § 42.73

DECISION ON MOTION TO AMEND
35 U.S.C. § 316(d) and 37 C.F.R. § 42.121

I. INTRODUCTION

On September 15, 2017, Aver Information Inc. and IPEVO, Inc. (“Petitioner”) filed a Petition (Paper 3, “Pet.”) pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 1–5, 7–10, 12–14, 16, 18, and 20 of U.S. Patent No. 8,508,751 B1 (Ex. 1001, “the ’751 patent”). On December 27, 2017, Pathway Innovations and Technologies, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”). Applying the standard set forth in 35 U.S.C. § 314(a), which requires demonstration of a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim, we granted Petitioner’s request and instituted an *inter partes* review on claims 1–5 and 7, but not claims 8–10, 12–14, 16, 18, and 20. Paper 9 (“Institution Dec.”). Following the Supreme Court’s decision in *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348 (2018), we modified our Institution Decision to institute trial on all of the claims challenged and all of the grounds presented in the Petition. Paper 10.

Following institution, Patent Owner filed a Response to the Petition (Paper 11, “PO Resp.”) and Petitioner filed a Reply (Paper 16, “Pet. Reply”). Also, Patent Owner filed a Motion to Amend (Paper 12, “Mot. to Amend”). Petitioner filed an Opposition to the Motion (Paper 17, “Mot. Amend Opp.”), Patent Owner filed a Reply (Paper 19, “Mot. Amend Reply”), and Petitioner filed a Sur-Reply (Paper 29, “Mot. Amend Sur-Reply”).

In addition, Patent Owner filed a Motion for Observations on Cross Examination of Vijay Madisetti (Paper 20) and Petitioner filed a Response (Paper 25.) Finally, Patent Owner filed a Motion to Exclude Madisetti Declarations (Paper 23), Petitioner filed an Opposition to the Motion (Paper 26), and Patent Owner filed a Reply (Paper 28.)

During a November 27, 2018 conference held between the panel and counsel for the parties, counsel for Patent Owner confirmed that the Motion to Amend is non-contingent. Paper 27. In addition, on November 30, 2018, we ordered that the Motion to Amend is directed to “proposed substitute claims 21–25, 27–30, 32–34, and 36 set forth in [the Reply to the Motion to Amend], Appendices A and B.” Paper 27, 5. These proposed claims are intended to substitute for challenged claims 1–5, 7–10, 12–14, and 16. Mot. Amend Reply Appendix A.

An Oral Hearing was held on December 13, 2018. The Hearing Transcript (“Tr.”) is included in the record as Paper 30. Having considered the evidence of record, and for the reasons set forth below, we determine that Petitioner has failed to demonstrate by a preponderance of the evidence that claims 18 and 20 of the ’751 patent are unpatentable. In addition, for the reasons that follow, we deny the Motion to Amend as to proposed substitute claims 21–25, 27–30, 32–34, and 36. In addition, we grant the Motion to Amend to order cancellation of claims 1–5, 7–10, 12–14, and 16. We also deny the Motion to Exclude.

II. BACKGROUND

A. The ’751 Patent

The ’751 patent, titled “Capturing Real-Time Video With Zooming Capability And Scanning High Resolution Still Images Of Documents Using The Same Apparatus,” was issued on August 13, 2013, from an application that was filed on April 4, 2012. Ex. 1001 at [10], [22], [45], [54]. The ’751 patent “generally relates to document cameras . . . for both capturing real-time video with zooming capability and scanning high resolution still images.” *Id.* at col. 1, ll. 15–18. The ’751 patent describes a video camera

that acquires both real-time video and still images of, for example, a document, and provides an output video image for display of either the video image or the still image by, for example, a projector. *Id.* at Title, Abstract, col. 3, ll. 18–34. The images are captured at resolutions multiple times larger than the resolution of the output display, to preserve the quality of the image while zooming-in or zooming-out digitally in real-time using computer software. *Id.* at Abstract, col. 6, ll. 34–38.

An embodiment of the document imaging system described in the '751 patent is illustrated in Figure 3a of the patent, reproduced below.

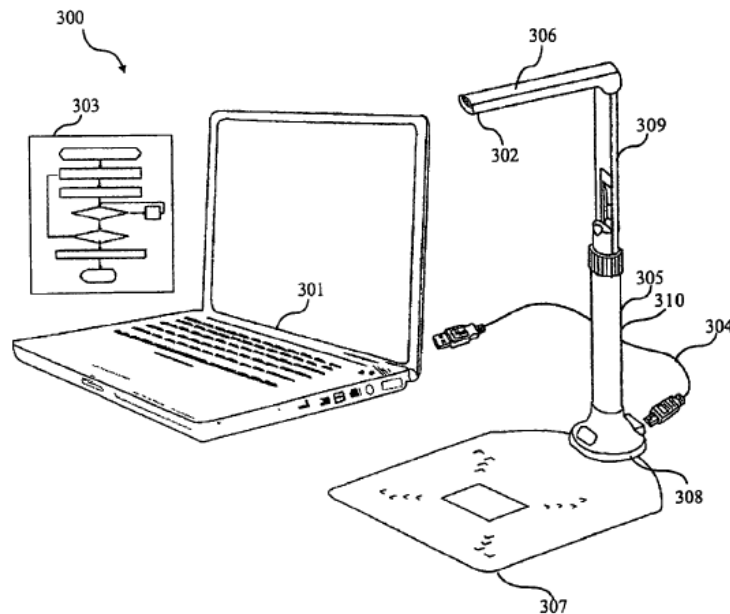


Figure 3a illustrates a document imaging system including personal computer 301 programmed with software 303, and miniaturized video camera 302 mounted so that it can capture images documents placed on surface 307. *Id.* at col. 4, l. 66–col. 5, l. 34. Not shown, but referred to as exemplary output displays, are projector and monitor displays. *See id.* at col. 3, ll. 30–34.

Figure 5 of the '751 patent, reproduced below, is a flow chart that illustrates the image processing and display steps of an exemplary embodiment.

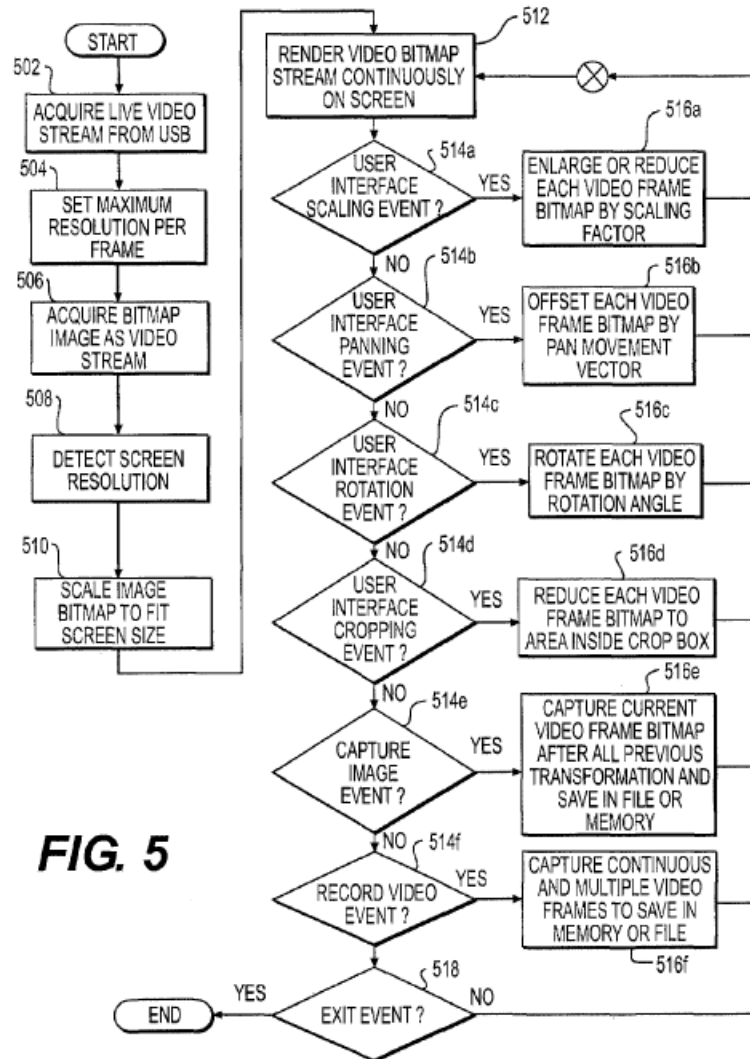


FIG. 5

Figure 5 illustrates the acquisition at the computer of a live video stream from the camera via a USB connection, the acquisition of the video stream as a bitmap image, the scaling of the bitmap image to fit the output screen resolution, the rendering of the scaled image on the display, the various image manipulation events performed on the image in real time, including

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