UNITED STATES PATENT AND TRADEMARK OFFICE

———————

BEFORE THE PATENT TRIAL AND APPEAL BOARD

———————

MOTOROLA MOBILITY LLC,
Petitioner,

v.

MAXELL, LTD.,
Patent Owner.

———————

IPR2022-01287
Patent 8,059,177 B2

———————

Before LYNNE E. PETTIGREW, KEVIN C. TROCK, and
KARA L. SZPONDOWSKI, *Administrative Patent Judges.*

TROCK, *Administrative Patent Judge.*

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

I. INTRODUCTION

Motorola Mobility LLC ("Petitioner") filed a Petition (Paper 1, "Pet.") requesting *inter partes* review of claims 1–6 (the "challenged claims") of U.S. Patent No. 8,059,177 B2 (Ex. 1001, "the '177 patent"). Maxell, Ltd. ("Patent Owner") filed a Preliminary Response (Paper 6, "Prelim. Resp."). Petitioner requested and, with our authorization, filed a Preliminary Reply (Paper 9, "Pet. Prelim. Reply"), and Patent Owner filed a Preliminary Sur-reply (Paper 10, "PO Prelim. Sur-reply"). *See* Ex. 3001.

The Board has authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314; 37 C.F.R. § 42.4(a). Under 35 U.S.C. § 314(a), we may not authorize an *inter partes* review unless the information in the petition and the preliminary 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."

The Petition challenges claims 1–6 as unpatentable under 35 U.S.C. § 103. Generally, Patent Owner contends that the Petition should be denied as to all challenged claims (*see* Prelim. Resp.). We do not, however, reach whether the Petition has shown a reasonable likelihood of prevailing on at least one claim. For the reasons discussed below, we exercise our discretion to deny the Petition under 35 U.S.C. § 325(d).

II. BACKGROUND

A.   Related Matters

The parties identify the following district court proceeding involving the '177 patent: *Maxell, Ltd. v. Lenovo Group Ltd.*, No. 6:21-cv-01169 (W.D. Tex.). Pet. vii; Paper 4, 1.

Petitioner identifies the following district court proceeding that "may affect, or be affected by, decisions in this proceeding": *Motorola Mobility LLC v. Maxell, Ltd.*, No. 1-22-cv-00256 (N.D. Ill.). Pet. vii.

Patent Owner identifies the following Board and district court proceedings that have involved the '177 patent: IPR2018-00910; *Maxell, Ltd. v. Olympus Corp.*, No. 1:18-cv-00216 (D. Del.); and *Maxell, Ltd. v. BLU Products, Inc.*, 1:18-cv-21231 (S.D. Fla.). Paper 4, 1.

B. *Real Parties-in-Interest*

Petitioner identifies itself as the real party-in-interest, but also indicates that it is "a direct, wholly-owned subsidiary of Motorola Mobility Holdings LLC, which is an indirect wholly-owned subsidiary of Lenovo Group Ltd." Pet. vii. Petitioner "names Lenovo (United States) Inc. and Lenovo Group Ltd. as potential RPIs because they are named defendants in the co-pending litigation." *Id.* (footnote omitted).

Patent Owner identifies itself as the real party-in-interest. Paper 4, 1.

C. *The '177 Patent*

The '177 patent is titled "Electric Camera" and issued on November 15, 2011 from an application filed on September 12, 2003. Ex. 1001, codes (22), (45), (54). The patent includes a Notice indicating the term of the patent is extended or adjusted and the patent is subject to a terminal disclaimer. *Id.* at code (*). The application for the '177 patent is a divisional of an application filed on March 8, 2000, and also claims priority to a foreign application filed on January 11, 2000. *Id.* at codes (30), (62).

The '177 patent observes that "[t]aking both moving and static images of satisfactory quality with a single camera is difficult to achieve." *Id.* at 2:62–64. In particular, "to photograph moving images, it is generally

assumed that the video is viewed on a display such as [a] television monitor and thus the camera is designed to produce output signals conforming to a television system such as NTSC [National Television Standards Committee] and PAL [Phase Alternate Line]." *Id.* at 1:24–28. Accordingly, "the effective number of vertically arranged pixels or picture elements on the image sensing device" must enable the generation of television signals for such systems. *Id.* at 1:28–21.

> The '177 patent explains that the NTSC system
>
> performs interlaced scanning on two fields, each of which has an effective scanning line number of about 240 lines (the number of scanning lines actually displayed on the monitor which is equal to the number of scanning lines in the vertical blanking period subtracted from the total number of scanning lines in each field). To realize this, the image sensing device has about 480 pixel rows as the standard effective number of vertically arranged pixels. That is, the signals of two vertically adjoining pixels in each field are mixed together inside or outside the image sensing device to generate about 240 scanning lines, and the combinations of pixels to be cyclically mixed together are changed from one field to another to achieve the interlaced scanning.

Id. at 1:31–44.

The limited standard effective number of vertically arranged pixels for generating television signals, however, "mak[es] it impossible to produce more detailed static image signals." *Id.* at 1:60–61. The '177 patent addresses this problem by describing an electric camera that "enables taking of highly detailed still images and a satisfactory moving video taking by using an image sensing device with a large enough pixel number even for still images." *Id.* at 3:30–33.

Figure 1, reproduced below, is a block diagram showing an
embodiment of an electric camera. *Id.* at 3:38–39.

FIG.1
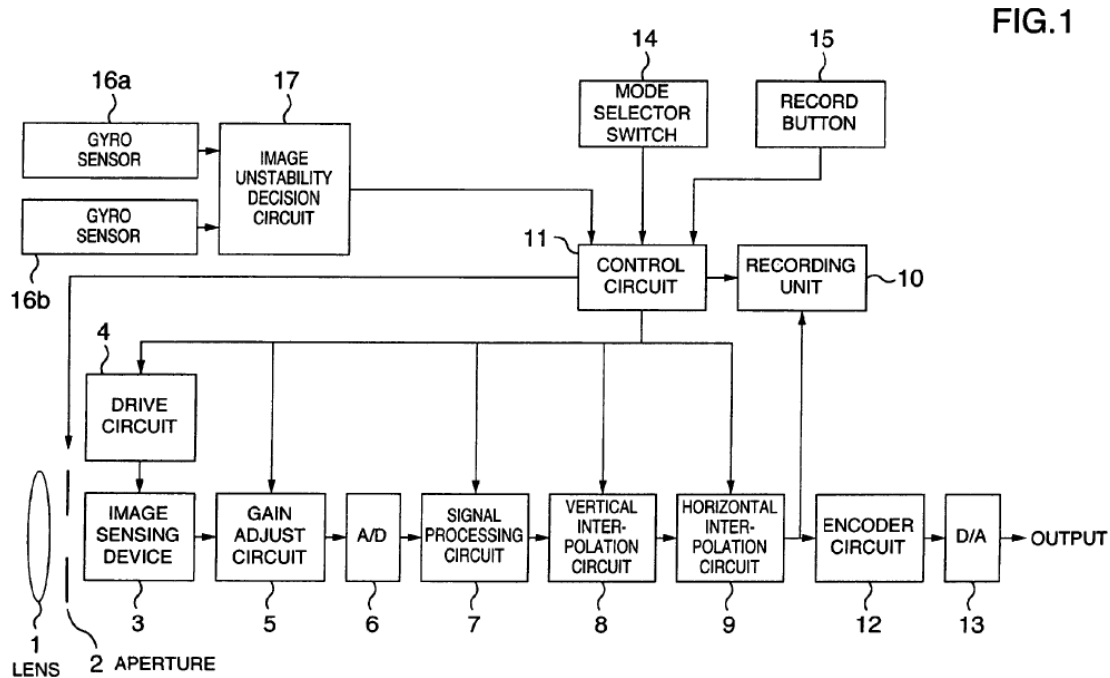
In Figure 1, above, depicting an embodiment of an electric camera,
"light coming from the lens 1 through the aperture 2 is focused on a light
receiving surface of the image sensing device 3 where it is converted into an
electric signal." *Id.* at 4:31–34. Image sensing device 3 is of a CCD
[charge-coupled device] type, with pixels formed from photodiodes and
arranged in a grid pattern. *Id.* at 4:34–38, Fig. 2.

The electric camera in Figure 1 includes mode selector switch 14 "to
change over the operation mode between the moving video taking and the
still image taking." *Id.* at 4:24–26. In this embodiment, the number of
vertically arranged pixels on image sensing device 3 is 1200. *Id.* at 4:63–65.
So, in a moving video mode, "if the number of effective scanning lines in
the field of the NTSC system is assumed to be 240 lines, then vertically
mixing five pixels (=1200 pixel rows/240 scanning lines) can match the

DOCKET ALARM

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.

fastcase®
Smarter legal research.