

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

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

v.

IMAGE PROCESSING TECHNOLOGIES, LLC  
Patent Owner.

---

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

---

**PATENT OWNER IMAGE PROCESSING TECHNOLOGIES, LLC'S  
PRELIMINARY RESPONSE PURSUANT TO 37 C.F.R. § 42.107(a)**

**TABLE OF CONTENTS**

I.	Introduction.....	2
II.	Background.....	7
	A. Overview of the '293 Patent.....	7
	B. The Numerous Unsuccessful Validity Challenges to Claim 1 of the '293 Patent.....	11
	1. Original prosecution of claim 1 of the '293 Patent.....	11
	1. <i>Inter Partes</i> Review of Claim 1 of the '293 Patent .....	13
	2. <i>Ex Parte</i> Reexamination of Claim 1 of the '293 Patent .....	14
III.	Legal Standards .....	17
	A. Standard For Granting An <i>Inter Partes</i> Review .....	17
	B. Standard to Deny Institution Under Section 325(d).....	18
IV.	The Board Should Deny Institution, as it has Previously Considered the Art Presented and Confirmed the Patentability of Claim 1 .....	19
	A. The Same or Substantially the Same Art and Arguments Were Previously Presented to the Office .....	20
	B. Petitioners Failed to Demonstrated that the Office Erred in a Manner Material to the Patentability of Challenged Claims.....	26
V.	<i>General Plastic</i> Does Not Favor Institution.....	27
VI.	The Board Should Exercise its Discretion and Deny Institution of <i>Inter Partes</i> Review.....	31
VII.	Conclusion .....	34

**TABLE OF AUTHORITIES**

**Cases**

*Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*,  
Case No. IPR2019-01469, Paper No. 6,  
2020 WL 740292 (P.T.A.B. Feb. 13, 2020) ..... 17, 18, 19, 25

*Apple Inc. v. Fintiv, Inc.*,  
No. IPR2020-00019, Paper 11,  
2020 WL 2126495 (P.T.A.B. Mar. 20, 2020)..... 30, 31

*Becton, Dickinson & Co. v. B. Braun Melsungen AG*,  
Case No. IPR2017-01586, Paper No. 8,  
2017 WL 6405100 (P.T.A.B. Dec. 15, 2017) .....18

*Cultec, Inc. v. StormTech LLC*,  
Case No. IPR2017-00777, Paper No. 7,  
2017 WL 3635100 (P.T.A.B. Aug. 22, 2017) .....7

*Cuozzo Speed Techs., LLC v. Lee*,  
136 S. Ct. 2131 (2016) .....30

*General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*,  
Case No. IPR2016-01357, Paper No. 19,  
2017 WL 3917706 (P.T.A.B. Sept. 6, 2017) ..... 26, 30

*Telemec Cellular Corp. v. Topp Telecom, Inc.*,  
247 F.3d 1316 (Fed. Cir. 2001).....5

*Valve Corp. v. Elec. Scripting Prods., Inc.*,  
Case Nos. IPR2019-00062, IPR2019-00063, IPR2019-00084,  
Paper No. 11, 2019 WL 1490575 (P.T.A.B. Apr. 2, 2019) ..... 28, 29

**Statutes**

35 U.S.C. § 314..... 17, 29, 30

35 U.S.C. § 316.....31

35 U.S.C. § 325..... 7, 17

**Other Authorities**

Trial Practice Guide, 77 Fed. Reg. 48,756 (Aug. 14, 2012).....17

U.S. PATENT & TRADEMARK OFFICE, PATENT TRIAL AND APPEAL BOARD  
CONSOLIDATED TRIAL PRACTICE GUIDE (Nov. 2019), *available*  
at <https://www.uspto.gov/TrialPracticeGuideConsolidated> .....30

**Regulations**

37 C.F.R. § 1.104 ..... 5, 21

37 C.F.R. § 42.108 ..... 17, 29

37 C.F.R. § 42.4 .....30

**TABLE OF EXHIBITS**

<b>Petitioner's Exhibits Cited in this Preliminary Response</b>	
<b><u>No.</u></b>	<b><u>Exhibit</u></b>
Ex-1001	U.S. Patent No. 6,959,293
Ex-1004	Prosecution History of U.S. Patent No. 6,959,293
Ex-1005	<i>Samsung Elecs. Co., Ltd. v. Image Processing Technologies LLC</i> , Case No. IPR2017-00336, Paper 38 (May 9, 2018)
Ex-1007	Ex parte <i>Image Processing Techs, LLC</i> , Reexamination Control No. 90/014,056 (P.T.A.B. Aug. 29, 2019) (Decision on Appeal)
Ex-1018	WIPO Patent Publication WO 99/36893 ("Pirim") [cites to Ex-1018 refer to the original page number at the bottom center of the page]
Ex-1019	U.S. Patent No. 5,546,475 ("Bolle")
Ex-1021	PCT/EP98/05383 (document incorporated by reference in Pirim)
<b>Patent Owner's Exhibits</b>	
<b><u>No.</u></b>	<b><u>Exhibit</u></b>
Ex-2001	<i>Ex Parte</i> Reexamination Certificate for U.S. Patent No. 6,959,293
Ex-2002	International Publication No. WO 00/11610
Ex-2003	Request for <i>Ex Parte</i> Reexamination of U.S. Patent No. 6,959,293, Reexamination Control No. 90/014,056 (Dec. 15, 2017)
Ex-2004	Decision Granting <i>Ex Parte</i> Reexamination, Reexamination Control No. 90/014,056 (Jan. 26, 2018)
Ex-2005	Non-Final Office Action, Reexamination Control No. 90/014,056 (Mar. 26, 2018)
Ex-2006	Reply to Non-Final Office Action, Reexamination Control No. 90/014,056 (June 26, 2018)
Ex-2007	Information Disclosure Statement Under 37 C.F.R. 1.555, Reexamination Control No. 90/014,056 (July 5, 2018)
Ex-2008	Final Office Action, Reexamination Control No. 90/014,056 (Sept. 7, 2018)
Ex-2009	Notice of Appeal, Reexamination Control No. 90/014,056 (Dec. 15, 2017)
Ex-2010	Patent Owner's Appeal Brief, Reexamination Control No. 90/014,056 (Jan. 7, 2019)
Ex-2011	Examiner's Answer to Patent Owner's Appeal Brief, Reexamination Control No. 90/014,056 (Feb. 12, 2019)

# 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.