

During the conference with Mr. Sheerin on 07/15/2022 (and in the days following), Mr. Sheerin counseled the Defendant on three additional invalidity arguments that should be asserted against the claims of the '337 patent (see Exhibit 1). The first invalidity argument is an obviousness argument based on two new prior art references which were not considered by the examiner during prosecution of the '337 patent application, and which are not cumulative to any prior art reference of record in the prosecution history. Defendant has already provided these references to the Plaintiff, doing so on July 15, 2022. Accordingly leave to amend should be granted since the Defendant was made aware of the new prior art less than 14 days from the date of this motion.

Mr. Sheerin also counseled the Defendant (less than 14 days from the date of this motion) about the availability of two additional invalidity arguments against the '337 patent (see Exhibit 1). The Court should grant leave to amend since these two additional invalidity arguments involve only questions of law regarding claim interpretation. That is, the issues of whether a claim is invalid under 35 USC § 112 (pre-AIA), second paragraph, for omitting essential matter, or whether a claim is invalid under 35 USC § 112 (pre-AIA), first paragraph, due to the Specification failing to enable the broad scope of the claims, is a matter of law which can be decided by this Court without the need for expert testimony. In addition, the Plaintiff can respond to these invalidity contentions similar to responding to an examiner's rejection which is not unduly burdensome.

Mr. Sheerin also counseled the Defendant (less than 14 days from the date of this motion) about an additional invalidity argument that should be asserted against the claims of the '718 patent (see Exhibit 2). The invalidity argument is an obviousness argument based on a new prior art reference, discovered by the Defendant on 07/27/2022), which was not considered by the examiner during prosecution of the '718 patent application, and which is not cumulative to any prior art

reference of record in the prosecution history. Accordingly leave to amend should be granted since the Defendant was made aware of the new prior art less than 14 days from the date of this motion.

The Court should also grant leave to amend since this case is still early in the proceedings, and the defense to date has been relatively limited. That is, the Plaintiff has had to contend with a very limited number of invalidity issues, and so adding these additional invalidity arguments should not be considered unfairly prejudicial to the Plaintiff. Justice is best served by allowing the Defendant the opportunity to provide a comprehensive defense rather than punishing the Defendant for not strictly complying with the formal scheduling deadlines.

Finally, judicial efficiency weighs in favor of granting the Defendant leave to amend since excluding these invalidity issues from the current proceeding means these issues will likely be raised during subsequent litigation against other defendants. Disposing of these additional non-invalidity issues will aid all parties impacted by this case by helping the patent holder and other prospective defendants understand the validity and scope of the claims, thereby helping avoid unnecessary future litigation.

Accordingly, the Defendant asks this Court for leave to amend its invalidity contentions with Defendant's Amended Final Invalidity Contentions included with this motion.

Dated: July 28, 2022

Respectfully Submitted,

/s/ Geoffrey E. Dobbin

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‘337 Patent – Invalid under 35 USC § 103

The claims of the ‘337 patent are invalid (see Exhibit 1) for being unpatentable over the prior art relied on by the examiner to reject the claims during prosecution of the patent application in view of new prior art that was not considered by the examiner during prosecution of the patent application, nor can it be considered cumulative to any prior art reference of record in the prosecution history.

‘337 Patent – Invalid for Omitting Essential Matter under 35 U.S.C. § 112 (pre AIA), second paragraph

The claims of the ‘337 patent are invalid (see Exhibit 1) because the claims omit essential matter. A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. § 112 (pre-AIA), second paragraph, for failing to claim the subject matter that the inventor or a joint inventor regards as the invention, where such essential matter may include missing elements, steps or necessary structural cooperative relationships of elements described by the applicant(s) as necessary to practice the invention (see, e.g., *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968)). See Exhibit 1 for a description of the essential matter omitted from the claims of the ‘337 patent.

‘337 Patent – Invalid as Non-Enabling under 35 U.S.C. § 112 (pre-AIA), first paragraph

35 U.S.C. § 112 (pre-AIA), first paragraph, provides that “the specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best

mode contemplated by the inventor of carrying out his invention.” In *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993), the court stated that “[n]aturally, the specification must teach those of skill in the art ‘how to make and use the invention as broadly as it is claimed.’” *Id.* at 1050, 29 USPQ2d at 2013. See Exhibit 1 for the Defendant’s argument as to why the claims of the ‘337 patent are not enabled by the specification.

Dated: July 28, 2022

Respectfully Submitted,

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Claim Elements		Summary	
		<p>Defendant asserts that claims 1 and 27 of U.S. Pat. No. 10,585,337 are invalid under 35 U.S.C. §103 (Pre-AIA) over at least the following references: U.S. Pat. No. 6,773,172 (2003) in view of U.S. Pat. No. 6,439,515 (2000) and U.S. Pat. No. 2,459,676 (1948) and U.S. Pat. No. 6,135,435 (1996). The '172 patent and the '515 patent were cited in the 1st Office Action (06/20/2019) during prosecution of the '337 patent application in which the examiner rejected all of the claims except original dependent claims 6, 7 and 12. In a response to the office action filed on 06/28/2019 the applicant amended claim 1 to incorporate the limitations of allowed claim 6 and amended claim 27 (now claim 25) to incorporate the limitations of allowed claim 12. The applicant did not traverse any of the rejections based on the relied upon prior art, and consequently the applicant concedes these rejections are valid. Therefore the analysis below need only address the validity of claims 1 and 25 since the applicant has conceded the remaining asserted claims are invalid based on the prior art as established by the prosecution history. The below claim chart also includes argument for invalidity based on the claims omitting essential matter and therefore invalid under 35 U.S.C. § 112 (pre-AIA), second paragraph, as well as an argument for invalidity under 35 U.S.C. § 112 (pre-AIA), first paragraph, due to the Specification failing to enable the broad scope of the claims.</p>	
Invalidity based on prior art			
#	Claims	Images	Reasoning
<u>1</u>	An integrated panoramic device comprising:		Met. '172 patent. Conceded by the applicant during prosecution.
	(a) a base having a lower surface suitable for supporting said base;		Met. '172 patent. Conceded by the applicant during prosecution.
	(b) a first clamp member secured for rotation to said base and comprising a first clamp surface rotatable about a single axis substantially normal to said lower surface, said panoramic device being free from and incapable of said first clamp surface being rotatable about an axis other than said single axis substantially normal to said lower surface;		Met. '172 patent. Conceded by the applicant during prosecution.

	<p>(c) a second clamp member including a second clamp surface slidably secured to said first clamp member and movable as a result of movement of a first member to approach said second clamp surface relative to said first clamp surface to clamp an article therebetween and movable as a result of movement of said first member to separate said second clamp surface relative to said first clamp surface to release an article clamped between said first clamp surface and said second clamp surface;</p>		<p>Met. '172 patent. Conceded by the applicant during prosecution.</p>
	<p>(d) a second member as a result of movement to selectively impede relative rotation of said first clamp member and said base, said first clamp member and said second clamp member not releasable from said base by movement of said second member, said first clamp member rotatable through 360 degrees with respect to said base; and</p>		<p>Met. '172 patent in view of '515 patent. Conceded by the applicant during prosecution.</p>

(e) wherein said first member is engaged with said first clamp member, wherein said first member passes through a portion of said second clamp member.

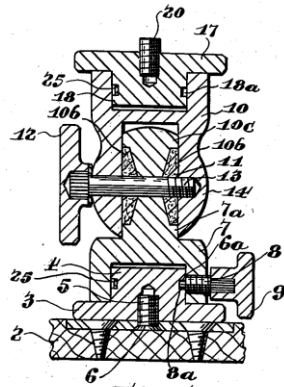


Fig. 2

US 2,459,676

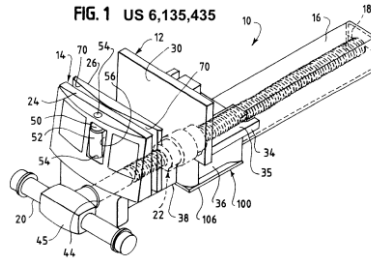
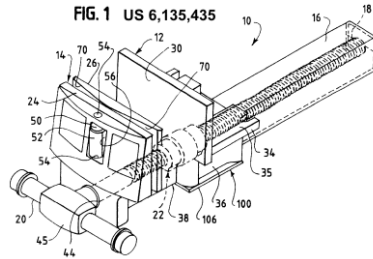
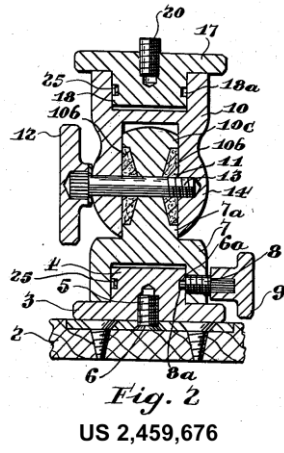


FIG. 1 US 6,135,435

Met. FIG. 2 of the '676 patent shows a panoramic camera clamp comprising a first clamp member and a second clamp member 14 configured to clamp an article 10c therebetween, and a first member 13 passes through a portion of said second clamp member. In the '676 patent, the second clamp member is not *slidably* secured to said first clamp member as recited in element (c). However, the configuration of a second clamp member being slidably secured to a first clamp member has been employed in the basic mechanical device generally known as a vice clamp, an example of which is shown in FIG. 1 of the '435 patent. Accordingly, it would have been obvious to one of ordinary skill in the art to modify the '172 patent or the '676 patent in order to use the well known vice clamp device for the clamping assembly.

25	An integrated panoramic device comprising:		Met. '172 patent. Conceded by the applicant during prosecution.
	(a) a base having a lower surface suitable for supporting said base;		Met. '172 patent. Conceded by the applicant during prosecution.
	(b) a first clamp member secured for rotation to said base and comprising a first clamp surface rotatable about a single axis substantially normal to said lower surface, said panoramic device being free from and incapable of said first clamp surface being rotatable about an axis other than said single axis substantially normal to said lower surface;		Met. '172 patent. Conceded by the applicant during prosecution.
	(c) a second clamp member including a second clamp surface slidably secured to said first clamp member and movable as a result of movement of a first member to approach said second clamp surface relative to said first clamp surface to clamp an article therebetween and movable as a result of movement of said first member to separate said second clamp surface relative to said first clamp surface to release an article clamped between said first clamp surface and said second clamp surface;		Met. '172 patent. Conceded by the applicant during prosecution.
	(d) a second member as a result of movement to selectively impede relative rotation of said first clamp member and said base, said first clamps member and said second clamp member not releasable from said base by movement of said second member, said first clamp member rotatable through 360 degrees with respect to said base; and		Met. '172 patent in view of '515 patent. Conceded by the applicant during prosecution.

(e) wherein said second member is engaged with said base and wherein said second member includes a knob attached thereto.



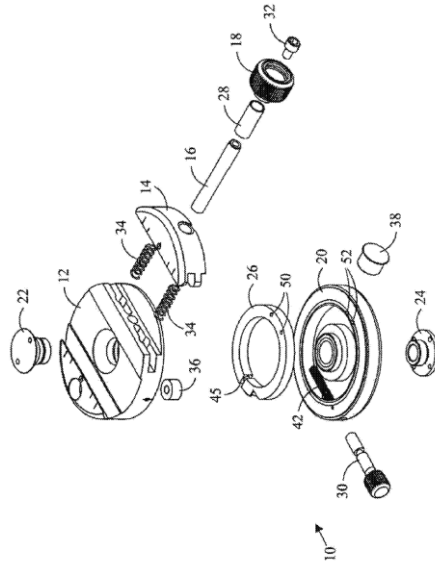
Met. FIG. 2 of the '676 patent shows a panoramic camera clamp comprising a first clamp member and a second clamp member 14 configured to clamp an article 10c therebetween. In the '676 patent, the second clamp member is not *slidably* secured to said first clamp member as recited in element (c). However, the configuration of a second clamp member being slidably secured to a first clamp member has been employed in the basic mechanical device generally known as a vice clamp, an example of which is shown in FIG. 1 of the '435 patent. Accordingly, it would have been obvious to one of ordinary skill in the art to modify the '172 patent or the '676 patent in order to use the well known vice clamp device for the clamping assembly. The '676 patent further shows a second member 8 engaged with said base and wherein said second member 8 includes a knob 9 attached thereto.

Invalidity based on omitting essential matter (35 U.S.C. § 112 (pre-AIA), second paragraph)

#	Claims	Images	Reasoning
<u>1</u> , <u>25</u>	An integrated panoramic device comprising:		N/A
	(a) a base having a lower surface suitable for supporting said base;		N/A

	<p>(b) a first clamp member secured for rotation to said base and comprising a first clamp surface rotatable about a single axis substantially normal to said lower surface, said panoramic device being free from and incapable of said first clamp surface being rotatable about an axis other than said single axis substantially normal to said lower surface;</p>		N/A
	<p>(c) a second clamp member including a second clamp surface slidably secured to said first clamp member and movable as a result of movement of a first member to approach said second clamp surface relative to said first clamp surface to clamp an article therebetween and movable as a result of movement of said first member to separate said second clamp surface relative to said first clamp surface to release an article clamped between said first clamp surface and said second clamp surface;</p>		N/A

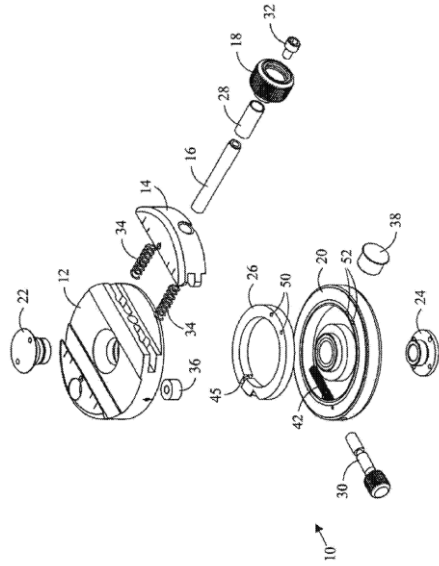
(d) a second member as a result of movement to selectively impede relative rotation of said first clamp member and said base, **said first clamp member and said second clamp member not releasable from said base by movement of said second member**, said first clamp member rotatable through 360 degrees with respect to said base; and



Claims 1 and 25 omit essential matter that enables the limitation “**said first clamp member and said second clamp member not releasable from said base by movement of said second member.**” FIG. 1 of the ‘337 patent (shown left) discloses elements 22 and 24 in order enable this limitation as described at col. 2, lines 61-64: “A retaining member 24 is secured to the plug 22 in such a manner to maintain the panning base and the body 12 together with the desired ability to freely rotate.” Without these retaining elements 22 and 24 the “releasability” limitation is rendered inoperable since the ability of “non releasable” depends on there being some other element (other than the second member) that retains the clamping assembly (body 12) and the panning base together. This “other element” is not included in the claims, and therefore the claims are invalid under 35 USC § 112 (pre-AIA), second paragraph, for omitting essential matter.

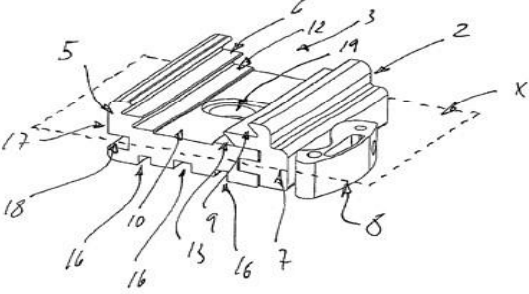
Invalidity under 35 U.S.C. § 112 (pre-AIA), first paragraph.			
#	Claims	Images	Reasoning
<u>1</u> , <u>25</u>	An integrated panoramic device comprising:		N/A
	(a) a base having a lower surface suitable for supporting said base;		N/A
	(b) a first clamp member secured for rotation to said base and comprising a first clamp surface rotatable about a single axis substantially normal to said lower surface, said panoramic device being free from and incapable of said first clamp surface being rotatable about an axis other than said single axis substantially normal to said lower surface;		N/A
	(c) a second clamp member including a second clamp surface slidably secured to said first clamp member and movable as a result of movement of a first member to approach said second clamp surface relative to said first clamp surface to clamp an article therebetween and movable as a result of movement of said first member to separate said second clamp surface relative to said first clamp surface to release an article clamped between said first clamp surface and said second clamp surface;		N/A

(d) a second member as a result of movement to selectively impede relative rotation of said first clamp member and said base, **said first clamp member and said second clamp member not releasable from said base by movement of said second member**, said first clamp member rotatable through 360 degrees with respect to said base; and

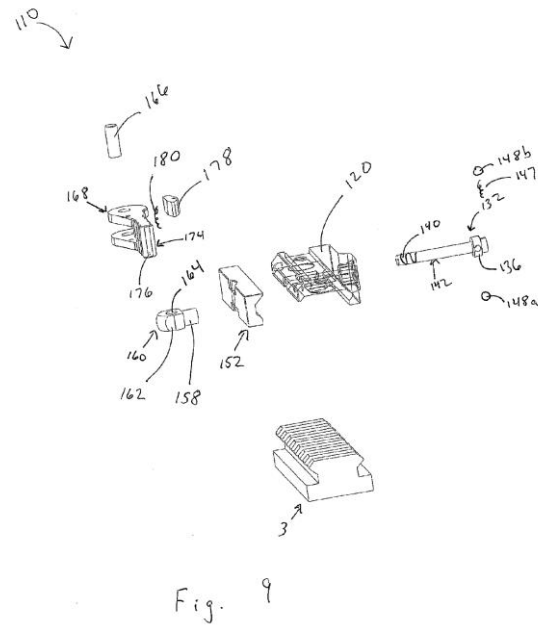


Claims 1 and 25 are invalid under 35 U.S.C. § 112 (pre-AIA), first paragraph, since the specification does not enable every embodiment of the broad limitation “**said first clamp member and said second clamp member not releasable from said base by movement of said second member.**” FIG. 1 of the ‘337 patent (shown left) discloses a single means for enabling this limitation as described at col. 2, lines 61-64: “A retaining member 24 is secured to the plug 22 in such a manner to maintain the panning base and the body 12 together with the desired ability to freely rotate.” However, the “releasability” limitation is drafted broadly in the claim to cover ever means possible for performing the function, instead of the single means disclosed in the specification. The claims are therefore invalid under 35 U.S.C. § 112 (pre-AIA), first paragraph, since the claims are not fully enabled by the specification.

Claim Elements		Summary	
		<p>Defendant asserts that claim 1 of U.S. Pat. No. 10,612,718 (2017) is invalid under 35 U.S.C. §103 (Pre-AIA) over at least the following references: US Pat. No. 8,348,214 (2007) in view of US Pat. Pub. No. 2008/0168696 (2007). In the 1st Office Action (08/20/2019) of the '718 patent application, the examiner rejected all of the claims (except withdrawn claims 17 and 18) in view of prior art. In a response to the office action filed on 09/24/2019 the applicant amended claim 1 to overcome a rejection under 35 U.S.C. §102 (Pre-AIA) based on the '214 patent. The applicant did not traverse any of the other rejections based on the relied upon prior art, and consequently the applicant concedes these rejections are valid. Therefore the analysis below need only address the validity of claim 1 since the applicant has conceded the remaining asserted claims are invalid based on the prior art as established by the prosecution history.</p>	
Invalidity based on prior art			
#	Claims	Images	Reasoning
<u>1</u>	An apparatus for selectively engaging a plate for photographic equipment and a Picatinny rail assembly for a firearm, said apparatus comprising:		Met. '214 patent. Conceded by the applicant during prosecution.
	(a) a body defining a portion of an upper channel having a first side wall;		Met. '214 patent. Conceded by the applicant during prosecution.
	(b) an arm defining a portion of said upper channel having a second side wall capable of lateral movement with respect to said first side wall suitable to detachably engage a pair of dovetail slots of said plate;		Met. '214 patent. Conceded by the applicant during prosecution.
	(c) said body defining a portion of a lower channel having a third side wall;		Met. '214 patent. Conceded by the applicant during prosecution.

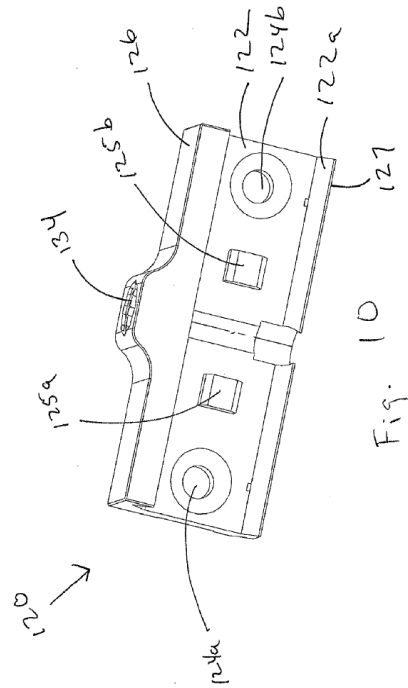
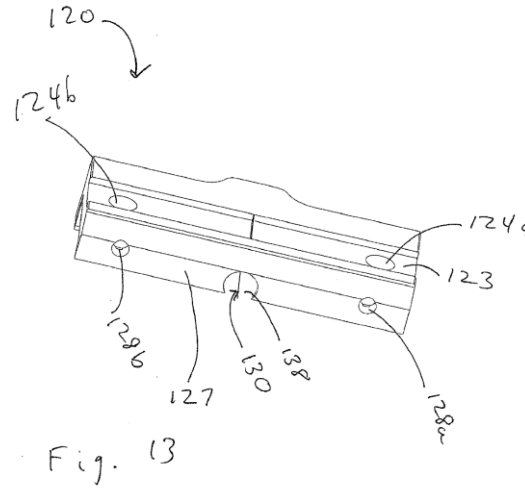
	<p>(d) said arm defining a portion of said lower channel having a fourth side wall capable of lateral movement with respect to said third side wall suitable to detachably engage a rail of said Picatinny rail assembly;</p>		<p>Met. '214 patent. Conceded by the applicant during prosecution.</p>
	<p>(d) said arm defining a portion of said lower channel having a fourth side wall capable of lateral movement with respect to said third side wall suitable to detachably engage a rail of said Picatinny rail assembly;</p>		<p>Met. '214 patent. Conceded by the applicant during prosecution.</p>
	<p>(e) wherein said upper channel is at a higher elevation than said lower channel;</p>		<p>Met. '214 patent. Conceded by the applicant during prosecution.</p>
	<p>(f) said body defining a lower surface between said third side wall and said fourth side wall;</p>	<p>Fig. 1</p> 	<p>Met. FIG. 1 of the '214 patent discloses a lower surface 10 between said third side wall and said fourth side wall.</p>

(g) said arm is slidably engaged with a stud extending between said base and said arm;



Met. FIG. 9 of the '696 patent publication: element 132 is the recited "stud".

(h) said stud extending between said base and said arm at a location at least partially directly above a plane defined by said lower surface and said stud at least partially located within a region defined by a perimeter of said lower surface.



Met. FIGs. 10 and 13 of the '696 patent publication: element 130 is a "bore" configured to receive the stud 132. The figure clearly shows the "bore" is a semi-circle meaning that at least part of the stud extends above the plane defined by the lower surface and stud is at least partially located within a region defined by a perimeter of said lower surface. It would have been obvious to one skilled in the art to modify the '214 patent in view of the '696 patent publication since all of the structural benefits that are derived from the design of the '696 patent publication would flow to the modified '214 patent. That is because the 696 patent publication is structurally equivalent to the '718 patent regarding the design of the "stud" assembly, one skilled in the art would be motivated to modify the '214 in view of the '696 patent publication in order to realize the benefits of this structurally equivalent "stud" assembly design.

CERTIFICATE OF SERVICE

I hereby certify that a copy of these DEFENDANT'S MOTION FOR LEAVE TO AMEND INVALIDITY CONTENTIONS has been served on the Plaintiff through its attorneys as listed below on July 28, 2022 via email, to:

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