Inter Partes Review of Patent No. 10,317,647

Apple Inc. v. Corephotonics, LTD., Case No. IPR2020-00896

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Grounds for challenging the claims of the ’647 pate

Ground	Challenged Claims	References	Ba
1	1-3 and 5	Iwasaki (Ex. 4) (undisputed)	§
2	1 and 4	Ogino (Ex. 5) and Chen II	§
3	2, 3, 5, and 8-11	Ogino (Ex. 5), Chen II, and Bareau	§
4	6	Ogino (Ex. 5), Chen II, Bareau, and Kingslake	§
5	7	Hsieh (Ex. 1) and Beich	§
6	12	Chen (Ex. 1), Iwasaki, and Beich	§

Petitio

Obviousness only requires a motivation to combine the
and a reasonable expectation of success in doing

- Obviousness is a question of whether a POSITA would have been:
  - "*motivated to combine the teachings of the prior art references to achiev claimed invention*, and
  - *that the skilled artisan would have had a reasonable expectation of succ doing so*."

> A party seeking to invalidate a patent on obviousness grounds must "demonstrate `by clear and convincing evid skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the cl invention, and that the skilled artisan would have had a reasonable expectation of success in doing so.'" *Procte Co. v. Teva Pharm. USA, Inc.*, 566 F.3d 989, 994 (Fed.Cir.2009) (quoting *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 13 (Fed.Cir.2007)). While an analysis of any teaching, suggestion, or motivation to combine elements from differen references is useful in an obviousness analysis, the overall inquiry must be expansive and flexible. *KSR Int'l Co*

InTouch Techs., Inc. v. VGO Comms., 751 F.3d 1327, 1347 (Fe
Note that in IPR, the standard is a "preponderance of the evidence." 35 U.S

"Motivation to combine" is whether there is an "apparent r combine" the prior art "in the fashion claimed" by the p

- The Sur-Reply argues throughout that Apple failed to provide reasons:
  - why a POSITA would have selected Ogino's Ex. 5 in the first place (*see* p.
  - why a POSITA would have ended up at Dr. Sasián's examples in the Petit pp. 6, 10-11, 16).

- **These arguments fail to apply the proper obviousness standard:**

> *Inc.*, 550 U.S. 398, 415, 419, 127 S.Ct. 1727, 167 L.Ed.2d 705 (2007). "Often, it will be necessary for a court to l interrelated teachings of multiple patents; the effects of demands known to the design community or present in th marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order t whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at is

InTouch Techs., Inc. v. VGO Comms., 751 F.3d 1327, 1347 (Fe

- The claims here are directed to five-lens miniature telephoto lens assemblies a Ogino teaches a five-lens miniature telephoto lens assembly in Ex. 5 that woul been modified based on other teachings in the prior art.

- The only relevant question here is what was presented in the Petition — *wheth POSITA would have been motivated to modify Ogino's Ex. 5 in "the fashion cla the patent at issue"* — not whether a POSITA could have chosen other referen

"Reasonable expectation of success" only means "reas probability of success," not absolute certainty.

- The Sur-Reply argues that a POSITA modifying a lens could have made variou modifications to achieve the desired goal (*e.g.*, a reduced F#) and that Petition show why a POSITA would have chosen the specific embodiment that meets t limitation (*see* pp. 6, 10-11, 16).
  - **These argument fail because they require showing a certainty of suc reaching the claimed limitation).**
- A "reasonable expectation of success" is simply "*a reasonable probability of su* achieving the claims at issue, "*not absolute*" certainty of achievement.

conclusion of non-obviousness based on that factual finding, however, is that case law is clear that obviousnes avoided simply by a showing of some degree of unpredictability in the art so long as there was a reasonable p success. *See* *In re Corkill*, 771 F.2d 1496, 1500 (Fed.Cir.1985) ("Although [the inventor] declared that it canno how any candidate will work in a detergent composition, but that it must be tested, this does not overcome [the teaching that hydrated zeolites will work."); *see also* *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 2 1125 (Fed.Cir.2000); *Merck & Co., Inc. v. Biocraft Labs., Inc.*, 874 F.2d 804, 809 (Fed.Cir.1989); *In re Merck &* F.2d 1091, 1097 (Fed.Cir. 1986). Indeed, a rule of law equating unpredictability to patentability, applied in this mean that any new salt — including those specifically listed in the '909 patent itself — would be separately pat simply because the formation and properties of each salt must be verified through testing. This cannot be the standard since the expectation of success need only be reasonable, not absolute. *Merck*, 874 F.2d at 809; *In r* 853 F.2d 894, 903 (Fed.Cir. 1988).

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