

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

COREPHOTONICS, LTD.,
Patent Owner.

IPR2020-00896
Patent 10,317,647

Before BRYAN F. MOORE, MONICA S. ULLAGADDI, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

ULLAGADDI, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition to institute an *inter partes* review of claims 1–12 (“the challenged claims”) of U.S. Patent No. 10,317,647 (Ex. 1001, “the ’647 patent”). Paper 2 (“Pet.”). Patent Owner did not file a preliminary response.

We instituted trial on the challenged claims on all grounds set forth in the Petition on December 8, 2020. Paper 7 (“Inst. Dec.”). After institution, Patent Owner filed a Patent Owner Response (Paper 14, “PO Resp.”), Petitioner filed a Reply to Patent Owner’s Response (Paper 21, “Pet. Reply”), and Patent Owner filed a Sur-Reply (Paper 22, “PO Sur-Reply”). An oral hearing was held on September 8, 2021, and a copy of the transcript was entered in the record. Paper 32 (“Tr.”).

We have jurisdiction pursuant to 35 U.S.C. § 6. This Decision is a Final Written Decision under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73 as to the patentability of the claims on which we instituted trial. Having reviewed the arguments and the supporting evidence, we determine that Petitioner has shown, by a preponderance of the evidence, that claims 1–11 of the ’647 patent are unpatentable. We determine that Petitioner has not shown by a preponderance of the evidence that claim 12 of the ’647 patent is unpatentable.

II. BACKGROUND

A. *Related Proceedings*

Petitioner and Patent Owner identify the following corresponding district court proceeding: *Corephotonics, Ltd. v. Apple Inc.*, No. 5:19-cv-04809 (N.D. Cal.) (“’4809 case”). Pet. 1; Paper 5, 1.¹

From the IPR2020-00897 proceeding, we are aware of a pending civil action, *Corephotonics, Ltd. v. Apple Inc.*, No. 5-18-cv-02555 (N.D. Cal.) (’2555 case) that concerns a parent of the ’647 patent. The ’2555 and ’4809 cases were found related to a previously filed case in the Northern District of California between the same parties, No. 17-cv-06457 (N.D. Cal.). *See* ’2555 case, Dkt. 14; ’4809 case, Dkt. 16. The parties are reminded that they *must* keep the Board apprised of the status of related litigations and identify all related administrative matters.

We identify the following related administrative matters, including every application and patent claiming the benefit of the priority of the filing date of patents in the priority chain of the ’647 patent. *See* Patent Trial and Appeal Board Consolidated Trial Practice Guide² (Nov. 2019) at 18; *see also* 84 Fed. Reg. 64,280 (Nov. 21, 2019).

The ’647 patent, along with Application No. 15/976,391 (now U.S. Patent No. 10,330,897, “the ’897 patent”) claims priority to:

¹ Patent Owner cites *Corephotonics, Ltd. v. Apple Inc.*, No. 3:19-cv-04809-LHK (N.D. Cal.) (Paper 5, 1), but this case number appears to reflect a typographical error. A PACER search of Case No. 5:19-cv-04809 reveals that Patent Owner’s complaint in that case was erroneously identified as “Civil Action No. 3:19-cv-4809” on its cover page.

² Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

IPR2020-00896
Patent 10,317,647 B2

Application No. 15/817,235 (now U.S. Patent No. 10,324,277, “the ’277 patent”), which claims priority to

Application No. 15/418,925 (now U.S. Patent No. 9,857,568, “the ’568 patent”), which claims priority to

Application No. 15/170,472 (now U.S. Patent No. 9,568,712, “the ’712 patent”), which claims priority to

Application No. 14/932,319 (now U.S. Patent No. 9,402,032, “the ’032 patent”), which claims priority to

Application No. 14/367,924 (abandoned), which claims priority to PCT/IB2014/062465, which claims priority to Prov. No. 61/842,987.

Application No. 16/296,272 (now U.S. Patent No. 10,488,630), which, along with Application No. 16/296,275 (now U.S. Patent No. 10,437,020) claim priority to the ’647 patent.

The following AIA trial proceedings challenge patents in the chain of priority for the ’647 patent:

IPR2020-00878 (challenges the ’878 patent);

IPR2020-00897 (challenges the ’277 patent);

IPR2019-00030 (challenges the ’568 patent);

IPR2018-01146 (challenged the ’712 patent); and

IPR2018-01140 (challenged the ’032 patent).

B. The ’647 Patent

The ’647 patent issued on June 11, 2019, and is based on an application filed on May 10, 2018, which claimed priority back to a provisional application filed July 4, 2013. Ex. 1001, codes (22), (45), (60). The ’647 patent discloses an optical lens assembly with five lens elements. *Id.* at code (57). Figure 1A of the ’647 patent is reproduced below.

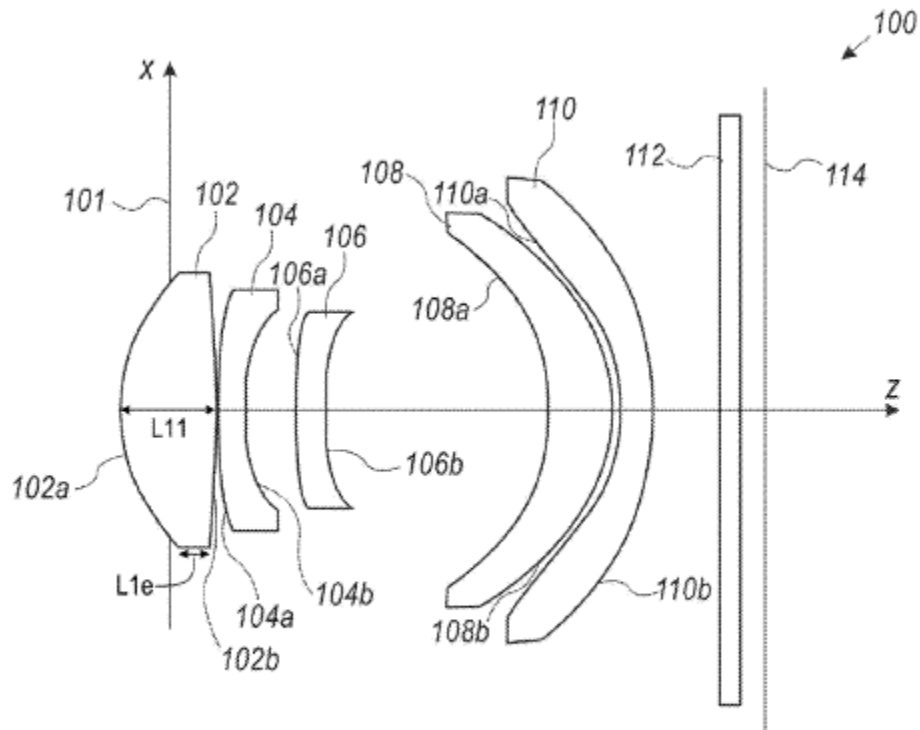


FIG. 1A

Figure 1A of the '647 patent illustrates a first embodiment of an optical lens system.

The embodiments disclosed refer to an optical lens assembly comprising, in order from an object side to an image side: optional stop 101; first plastic lens element 102 with positive refractive power having a convex, object-side surface 102a; second plastic lens element 104 with negative refractive power having a meniscus, convex, object-side surface 104a; third plastic lens element 106 with negative refractive power having a concave, object-side surface 106a; fourth plastic lens element 108 with positive refractive power having a positive meniscus with a concave, object-side surface marked 108a; fifth plastic lens element 110 with negative refractive power having a negative meniscus with a concave, object-side surface 110a. *Id.* at 3:25–42.

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