

Inter Partes Review of Patent No. 10,324,277

Apple Inc. v. Corephotonics, LTD., Case No. IPR2020-00897

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Grounds for challenging the claims of the '277 pate

Ground	Challenged Claims	References	Ba
1	1-3 and 5-8	Obvious over Ogino (Ex. 4) and Bareau	§
2	1-24	Obvious over Ogino (Ex. 5) and Bareau	§

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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 achieve the claimed invention, and
 - that the skilled artisan would have had a reasonable expectation of success in doing so.”

A party seeking to invalidate a patent on obviousness grounds must "demonstrate `by clear and convincing evidence that a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so.'" *Procter & Gamble Co. v. Teva Pharm. USA, Inc.*, 566 F.3d 989, 994 (Fed.Cir.2009) (quoting *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1347, 1354 (Fed.Cir.2007)). While an analysis of any teaching, suggestion, or motivation to combine elements from different prior art references is useful in an obviousness analysis, the overall inquiry must be expansive and flexible. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 405 (2007).

InTouch Techs., Inc. v. VGO Comms., 751 F.3d 1327, 1347 (Fed. Cir. 2014).
Note that in IPR, the standard is a "preponderance of the evidence." 35 U.S.C. § 42(c)(2)(B).

“Motivation to combine” is whether there is an “apparent reason to combine” the prior art “in the fashion claimed” by the patent at issue.

- The Sur-Reply argues throughout that Apple failed to provide reasons:
 - why a POSITA would have selected Ogino’s Ex. 4 or Ex. 5 in the first place (see pp. 9, 12) and
 - why a POSITA would have ended up at Dr. Sasián's examples in the Petition (see pp. 5-6, 11-12, 15-16).
- **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 look to the interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.”

InTouch Techs., Inc. v. VGO Comms., 751 F.3d 1327, 1347 (Fed. Cir. 2014).

- The claims here are directed to **five-lens miniature telephoto lens assemblies** and Ogino teaches **five-lens miniature telephoto lens assemblies** in Ex. 4 and Ex. 5 of APPL-1005, Figs. 4-5, *cited in* Petition at 10, 51.
- The only relevant question here is what was presented in the Petition — **whether a POSITA would have been motivated to modify Ogino’s Ex. 4 and Ex. 5 in “the fashion claimed by the patent at issue”** — not whether a POSITA could have chosen one of the alternatives.

“Reasonable expectation of success” only means “reasonable probability of success,” not absolute certainty.

- The Sur-Reply argues that a POSITA would have used Dr. Milster’s lens modification technique (many parameters vary at the same time) and not Dr. Sasián's (few parameters vary at the same time) (see pp. 5, 13-14).
 - This argument fails because Dr. Sasián testified that a POSITA would use Dr. Milster's technique (see APPL-1003, ¶158), and there is no evidence that a POSITA would use it where the POSITA desired to change one limitation (e.g., f-number)
 - **When a POSITA chose to use Dr. Sasián's technique, there was a reasonable probability of success.**
- A “reasonable expectation of success” is simply “a reasonable probability of success” of achieving the claims at issue, “not absolute” certainty of achievement. (See case law on previous slide)
- A showing of obviousness requires only proof of motivation to combine in the way set out by the Petition, not motivation *not* to combine in some other way.

of issued patents.” *KSR*, 550 U.S. at 419. Any motivation to combine references, whether articulated in the references themselves or supported by evidence of common knowledge of a skilled artisan, is sufficient to show that those references to arrive at the claimed product.

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