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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

COREPHOTONICS, LTD.,
Patent Owner

IPR2020-00905
U.S. Patent No. 10,225,479 B2

Before GREGG I. ANDERSON, JOHN F. HORVATH, MONICA S. ULLAGADDI, *Administrative Patent Judges*

HORVATH, *Administrative Patent Judge*.

ORDER
Conduct of Proceeding
37 C.F.R. § 42.5

INTRODUCTION

On November 8, 2021, we issued a Final Written Decision, finding Apple, Inc. ("Petitioner") had failed to demonstrate by a preponderance of evidence that any of the challenged claims of U.S. Patent No. 10,255,479 ("the '479 patent") were unpatentable. Paper 51 ("Decision" or "Dec."). Our conclusion was based on our construction of the term "fused image with a point of view (POV) of the Wide camera" ("the fused image limitation"), which we construed to mean "a fused image having a Wide perspective POV and a Wide position POV." *Id.* at 12. Although finding the case presented "a close issue of claim construction," the Court of Appeals for the Federal Circuit construed the fused image limitation to require a fused image that "maintain[s] Wide perspective point of view or Wide position point of view, but does not require both." Paper 54 (*Apple Inc. v. Corephotonics Ltd.,* Case Nos. 2022-1350, 2022-1351, *slip op*. 8–9, 12 (Fed. Cir. 2023)). Thus, the Federal Circuit vacated the Final Written Decision and remanded the case "for further proceedings consistent with this opinion." *Id.* at 17.

On December 1, 2023, consistent with the procedures set forth in the Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019)[1] ("CTPG") and after having met and conferred to discuss a remand procedure, the parties held a conference call with the Board. *See* CTPG, 87–90. Participating in the conference call were Mr. O'Brien for Petitioner, Mr. Rubin for Patent Owner, and Judges Anderson, Horvath, and Ullagaddi. A summary of the call is provided in the discussion below.

[1] Available at https://www.uspto.gov/TrialPracticeGuideConsolidated.

DISCUSSION

Petitioner argued that Patent Owner had raised an improper new argument in its Sur-reply, namely, that Petitioner was combining separate embodiments of Parulski to teach the limitations of the challenged claims. Therefore, Petitioner requested the parties be granted the opportunity to simultaneously file 10-page briefs regarding whether Patent Owner's Sur-Reply raised an improper new argument, followed by simultaneous 5-page reply briefs.

Patent Owner disagreed that it had raised any improper new arguments in its Sur-Reply or that any briefing on that issue is required. Nonetheless, Patent Owner agreed to Petitioner's proposed briefing schedule and brief lengths should the Board decide additional briefing is required.

The Board indicated that no additional briefing was required on this issue. In deciding this case on remand, the Board will consider whether Patent Owner's Sur-Reply arguments are improper and treat them accordingly. That is, should the Board decide the arguments are improper new arguments as Petitioner contends, the Board will identify but not consider them. Conversely, should the Board decide the arguments are not improper new arguments, the Board will consider the arguments and accord them whatever weight they are due.

The Board also indicated during the call that no additional briefing is required on any issue for the Board to issue its decision on remand. Instead, the decision on remand will be issued based on the complete trial record currently before the Board, considering the arguments and evidence provided by Petitioner and Patent Owner, subject to the Federal Circuit's construction of the "fused image" limitation.

ORDER

It is:

ORDERED that Petitioner's request for additional briefing regarding the properness of Patent Owner's Sur-Reply arguments is denied; and

FURTHER ORDERED that no additional briefing shall be submitted in this case; a decision on remand shall issue in due course.

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