

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner,

v.

COREPHOTONICS, LTD.,  
Patent Owner.

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Case No. IPR2020-00906  
U.S. Patent No. 10,225,479

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PATENT OWNER'S PRELIMINARY RESPONSE

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## I. INTRODUCTION

This Petition should be denied because Petitioner has failed to make out a *prima facie* case for invalidity for a number of reasons.

First, Petitioner has failed to provide a motivation to combine Parulski, Ogata, Kawamura, and Soga (the basis of Ground 1). Instead of showing a motivation to create this four-reference combination, Petitioner has purportedly identified a motivation to create three different two-reference combinations: Parulski and Ogata; Parulski and Kawamura; and Parulski and Soga. But Petitioner has not asserted that any of these two-reference combinations invalidate any claim of the '479 patent. The Petition's second ground, asserting the five-reference combination of Parulski, Ogata, Kawamura, Soga and Morgan-Mar, also fails to include a motivation of combine all five references. Because it is Petitioner's burden to provide a motivation to combine all of the invalidating references, the Petition must be denied.

Second, the Petition has failed to demonstrate that the claim elements styled [19.5.1] and [19.5.2] (portions of claim element 19e) are disclosed by Parulski because it ignores the requirement that the claimed "camera control-

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