

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

COREPHOTONICS, LTD.,
Patent Owner

Case IPR2020-00906
Patent 10,225,479

PETITIONER'S BRIEF POST-REMAND

TABLE OF CONTENTS

I. Introduction.....1

II. Discussion.....2

 A. APA-Compliant Decision on Remand2

 1. Board Should Base its Decisions on Arguments
 Advanced by a Party and to which the Opposing Party
 was Given a Chance to Respond.....3

 2. An Issue Raised *Sua Sponte* by the Board Requires
 Notice and Opportunity to Respond4

 B. Supposed Errors that the Panel Raised (or Raises) *sua
 sponte* Relative to Dr. Sasián’s Expert Testimony may
 Not be Considered without Notice *and* a Meaningful
 Opportunity to Respond5

 1. Supposed Error Regarding Abbe Number for Ogata’s
 Third Lens Element is a Red Herring6

 2. Supposed Discrepancy Regarding Fourth- and Tenth-
 Order Aspheric Terms is also a Red Herring.....7

 3. The Board’s Newly Articulated Concern Regarding Lens
 Prescription Data for Kawamura is Entirely Speculative8

 C. The Record Supports Petitioner’s Contention regarding
 Scaling of Ogata’s Lens for Parulski’s Digital Camera9

 D. The Record Supports Petitioner’s Contention regarding
 Scaling of Kawamura’s Lens for Parulski’s Digital
 Camera.....13

III. Conclusion17

CERTIFICATE OF SERVICE.....19

I. INTRODUCTION

This proceeding returns to the Board after an appeal of a final written decision (Paper 54) that found that Petitioner had “failed to muster sufficient evidence to demonstrate...that Ogata’s lens could have been scaled to work in Parulski’s camera with a reasonable expectation of success.” *See Apple Inc. v. Corephotonics, Ltd.*, 81 F.4th 1353, 1361 (Fed. Cir. 2023) (“Remand Decision”); IPR2020-00906, Dec. at 2, 19. The Court of Appeals determined that the Board, in violation of the Administrative Procedure Act (APA), had based its decision on a ground not raised by any party. Remand Decision, 81 F.4th at 1354.

“Because the Board based its decision on a typographical error without sufficiently explaining its significance, made *sua sponte* findings that lacked substantial evidence, and did not resolve the issue the parties presented,” the Court vacated and remanded for “further proceedings that meet APA’s requirements for notice and the opportunity to respond.” *Id.* at 1362. According to the Court, the Board focused on “an issue that no party meaningfully raised or asserted was relevant. And because the Board’s analysis was focused on this issue, it failed to thoroughly assess the critical issue outlined by the parties, *i.e.*, whether there would have been a reasonable expectation of success in combining Parulski and Ogata, considering manufacturing and scalability concerns.” *Id.* at 1362 (quoting from *Power Integrations v. Lee*, 797 F.3d 1318, 1325 (Fed. Cir. 2015)) (internal

quotation marks omitted).

In its post-remand Order, the Board requests briefing on: (1) what constitutes an APA-compliant decision on remand, (2) whether it can consider on remand issues that it has *sua sponte* considered to be errors, and (3) what evidence currently in the record supports Petitioner's contentions that Ogata's embodiment I lens and Kawamura's example 1 lens can be scaled to project images onto a 1/2.5" image sensor compatible with Parulski's digital camera, what weight should be given to that evidence, and why. *See* (Order of Conduct) Paper 60 at 11.

II. DISCUSSION

A. APA-Compliant Decision on Remand

The APA generally requires "the Board [to] base its decision on arguments that were advanced by a party, and to which the opposing party was given a chance to respond." *In re IPR Licensing, Inc.*, 942 F.3d, 1363, 1368-69 (Fed. Cir. 2019).

In limited circumstances the Board may raise issues *sua sponte*, but to do so it must "give[] the parties notice and an opportunity to respond." *Nike Inc. v. Adidas AG*, 955 F.3d 45, 53 (Fed. Cir. 2020). The Board ran afoul of these principles.

Specifically, the Board's determination that a typographical error in Dr. Sasián's declaration was dispositive of the issues in the case did not comport with notice requirements of the APA. *See* Remand Decision, 81 F.4th at 1362

("Apple...had no reason to anticipate that the typographical error would be the

basis for the Board's decision, given that the parties did not brief, argue, or even suggest this error was dispositive or would impact the claimed lens parameters.”)

On remand, the Board should base its decision on arguments that were actually advanced by a party. Doing so would help to ensure adequate grounds for the Board's decisions and avoid “red herring” arguments not tested by adversarial briefing or firmly anchored in an evidentiary record. To the extent that the panel's briefing order suggests that the Board may persist in *sua sponte* issues that were already addressed with disfavor by the reviewing court or that it posits further *sua sponte* issues (*see* Paper 60 at 3-7), it must afford Petitioner a meaningful right to respond, including testimonial evidence from its expert.

1. Board Should Base its Decisions on Arguments Advanced by a Party and to which the Opposing Party was Given a Chance to Respond

Under the APA's notice provisions relevant to Board proceedings, “persons entitled to notice of an agency hearing shall be timely informed of...the matters of fact and law asserted,” and the Board “shall give all interested parties opportunity for...the submission and consideration of facts [and] arguments.” 5 U.S.C.

§§554(b)(3), (c)(1). The Board “must base its decision on arguments that were advanced by a party, and to which the opposing party was given a chance to respond.” *Masimo Corp. v. Apple Inc.*, 2023 WL 5921622 (Fed. Cir. Sep. 12, 2023) (quoting *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.