

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

COREPHOTONICS LTD.,
Patent Owner.

IPR2020-00906
Patent 10,225,479 B2

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

HORVATH, *Administrative Patent Judge*.

ORDER

Denying Petitioner's Motion to Admit Supplemental Information
37 C.F.R. §§ 42.5(a), 42,123(a)

I. INTRODUCTION

Apple Inc. (“Petitioner”) moves to submit as supplemental information a brief (Ex. 1042, “KPO brief”) that Corephotonics Ltd. (Patent Owner) submitted to the Korean Patent Office containing statements regarding the availability of miniature camera lens designs circa 2013. Paper 50 (“Mot.”), 1–3. Patent Owner opposes. Paper 51 (“Opp.”), 1–4.

“A party seeking to submit supplemental information more than one month after the date the trial is instituted . . . must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice.” 37 C.F.R. § 42.123(b).

Petitioner argues good cause exists for admitting the KPO brief because it could not have been obtained earlier than August 2, 2021, when it was submitted to the Korean Patent Office, approximately 1 month before Petitioner submitted this motion. *See* Mot. 1; Ex. 1042, 29.¹ Petitioner further argues good cause exists for admitting the KPO brief because Patent Owner “has taken opposite positions in this proceeding.” *Id.* Specifically, Petitioner argues that Patent Owner argued in its Patent Owner Response (Paper 40, “PO Resp.”) that a person skilled in the art in 2013 would not have looked beyond the “rich literature of miniature lens designs” to miniaturize Kawamura’s² “200-mm lens designed in 1981,” but would instead have looked to miniaturize “designs that were purpose-made for miniature cameras.” *Id.* (quoting PO Resp., 45). By contrast, Petitioner

¹ We cite to the page number of the underlying document (i.e., the English translation of the KPO brief) rather than to the page number of the exhibit, as does Petitioner.

² JP S5862609 A

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argues, Patent Owner argued in its KPO brief that “there were hardly any telephoto lens assemblies applied to portable terminals” in 2013. *Id.* at 2 (quoting Ex. 1042, 3). Petitioner argues Patent Owner thereby “concede[s] that miniature telephoto [lens] designs were not widely available in 2013.” *Id.* at 3. Petitioner further argues that Patent Owner also admitted to the Korean Patent Office that a person skilled in the art in 2013 would have used “the ‘structure and shape’ of ‘the conventional telephoto lens assembly for general cameras,’” i.e., for cameras other than smartphone cameras. *Id.* at 3 (quoting Ex. 1042, 4–5).

Patent Owner disputes Petitioner’s contentions, arguing that the statements it made to the Korean Patent Office concerned the availability of telephoto lenses having a total track length (“TTL”) of less than 6.5 mm. Opp. 2 (citing Ex. 1042, 4–5). Patent Owner argues these statements do not concern telephoto lenses with larger TTL, which are encompassed by the claims of the ’479 patent. *Id.* Patent Owner further argues that Petitioner has cited at least five references in *inter partes* reviews — Ogino,³ Chen,⁴ Iwasaki,⁵ Hsieh,⁶ and Parulski⁷ — that illustrate the availability of telephoto lens designs for mobile phones and digital cameras that predate June 13, 2013, which is the earliest possible priority date of the ’479 patent. *Id.*

³ US 9,128,267 B2 (foreign filing date: Mar. 29, 2013 (code 30))

⁴ US 10,324,273 B2 (foreign filing date: Aug. 29, 2016 (code 30)). We note that Chen does not predate the earliest possible ’497 patent priority date.

⁵ US 9,678,310 B2 (foreign filing date: Mar. 25, 2013 (code 30))

⁶ US 9,864,171 B2 (foreign filing date: July 24, 2015 (code 30)). We note that Hsieh does not predate the earliest possible ’497 patent priority date.

⁷ US 7,859,588 B2 (filing date: Mar. 9, 2007 (code 22))

II. ANALYSIS

Considering the evidence and argument presented by the parties, we do not find admitting Exhibit 1042 into evidence would be in the interest of justice. Although Petitioner has shown that it timely submitted its motion to admit the KPO brief, Petitioner has not shown that the KPO brief contains admissions that are contrary to statements Patent Owner has made in this proceeding.

Here, Patent Owner contends that a person skilled in the art in 2013 “would not have looked to [Kawamura’s] 200-mm lens designed in 1981 in selecting a design for Parulski’s narrow lens,” but would instead have “look[ed] to designs that were purpose-made for miniature cameras” for which there was “no shortage of miniature lens designs.” PO Resp. 45. Before the Korean Patent Office, Patent Owner did make the seemingly contradictory statements that in 2013 “there was only one prior document that mounted the telephoto lens assembly on a portable terminal” and that doing so required a telephoto lens assembly having “a new structure and shape different from those of the conventional telephoto lens assembl[ies] for general cameras.” Ex. 1042, 2–3. However, Patent Owner’s statements were made in the context of arguing for the patentability of claims that expressly required mounting a telephoto lens having $TTL < 6.5$ mm in cell-phones that were between 6.5 and 7.9 mm thick. *Id.* at 3 (“the invention of the subject patent adopted a new structure that: (1) has a short total track length ($TTL < 6.5$)”); *id.* at 3–4 (table showing the 6.5–7.9 mm thickness of smartphones released by major smartphone manufacturers in 2012 and 2013).

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As Patent Owner admits here, the claims of the '479 patent do not require a telephoto lens having $TTL < 6.5$ mm. Opp. 2. Indeed, Petitioner's combination of Parulski and Kawamura scales Kawamura's lens to have a TTL of 15.343 mm and mounts the scaled lens in Parulski's 23 mm thick digital camera. *See* Pet. 19–20 (scaling Kawamura's lens to focus an image on the 1/2.5" sensor of the EasyShare camera); Ex. 1033, 64 (EasyShare camera thickness of 2.3 cm (23 mm)). When viewed in context, Patent Owner's statements to the Korean Patent Office are not inconsistent with its statements made here, when the statements made here are understood to refer to the availability of telephoto lens designs for telephoto lenses having a $TTL > 6.5$ mm.

Accordingly, for the reasons discussed above, we deny Petitioner's motion to admit Exhibit 1042 as evidence in this proceeding.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's motion to admit Exhibit 1042 as Supplemental Information is *denied*.

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