

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

COREPHOTONICS, LTD.,
Patent Owner.

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

PATENT OWNER'S RESPONSE TO PETITIONER'S MOTION TO
SUBMIT APPL-1042 UNDER 37 C.F.R. § 42.123(B)

Petitioner’s motion to submit Ex. 1042 fails to meet the standard for late submission of supplemental information under 37 C.F.R. § 42.123(b). In particular, it fails to meet the requirement that consideration of this untimely information “would be in the interests-of-justice.” § 42.123(b). Apple would have the Board conclude from Ex. 1042 that “miniature telephoto designs *were not widely available* in 2013 or prior.” Paper 50 at 3 (underlining added). But, that is not what the brief says, and nothing in Ex. 1042 contradicts Corephotonics’ arguments in this IPR.

The statements in Ex. 1042 that Apple has latched on to concern telephoto lens assemblies for “portable terminals.” *Id.* at 2–3. And those statements must be understood in the context of the brief as a whole and of the legal dispute it concerns. LG Innotek (LG) supplies a majority of the camera modules used by Apple, and Apple accounts for a majority of LG Innotek’s revenue.¹ Corephotonics sued LG in Korea, alleging the camera modules it sells Apple infringe patent 10-1757101, which claims priority to the same PCT application as the patents in IPR2018-01140 and -01146. Apple and LG strongly share an interest in invalidating this patent asserted against Apple’s camera modules.

LG brought a proceeding at the Korean IPTAB seeking to invalidate Corephotonics’ patent. In response, Corephotonics amended its claims to add limitations that

¹ <https://www.kedglobal.com/newsView/ked202106070009>; <https://asia.nikkei.com/Business/Electronics/LG-Innotek-invests-500m-to-boost-iPhone-parts-output>; <https://pulsenews.co.kr/view.php?sc=30800028&year=2021&no=238336>

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the $TTL < 6.5$ mm and $F\# < 2.9$. The IPTAB rejected the amendments on grounds akin to U.S. § 112. Corephotonics sought review at the Patent Court, and Ex.1042 was filed in that Patent Court case.

In context, the statements in Ex. 1042 concerning “portable terminals” are statements about terminals that require a $TTL < 6.5$ mm. (Ex. 1042 at 4 (“the 6.5 mm upper limit of TTL (related to $TTL < 6.5$ mm configuration) is related to the limit of the lens assembly according to the thickness of the portable terminal”); *id.* at 5 (“at the time of the priority date of the invention of the subject patent (July 4, 2013), the lower limit of the thickness of the portable terminal was 6.5 mm or greater”); *id.* at 4–5 (“Table of thicknesses of portable terminals by portable terminal manufacturers at the time of priority date of the invention of the subject patent” showing values between 6.5 mm and 7.9 mm). Lenses with $TTL < 6.5$ mm were the legally relevant category of lenses, given the limitations of the claims at issue, and Ex. 1042 regularly equates lenses with $TTL < 6.5$ mm with lenses for “portable terminals.”

Assuming for the sake of argument that *no telephoto lens* with a $TTL < 6.5$ mm had *ever* existed prior to the '479 patent, that would be of little relevance to the claims at issue in this IPR. The '479 patent claims do not recite a TTL (beyond requiring $EFL/TTL > 1$), and under Apple’s obviousness theory the claim are satisfied by a lens scaled to have a TTL of 15.343 mm, much larger than the lenses for “portable terminals” discussed in Ex. 1042. (Paper 48, slide 15; Petition at 20–21.)

For Apple to be permitted to argue that Corephotonics' statements about lenses for "portable terminals" with TTL < 6.5 mm are binding "admissions" as to lenses with larger TTL would be to permit a gross injustice. This is because this new position of Apple's is directly opposite to one Apple has repeatedly taken to this Board. In *six* different IPR petitions, where Apple has prevailed in the FWD or that are still pending, Apple has asserted that "lens assemblies for [mobile/cell] phones were well known, including telephoto [lenses/lens assemblies]" (IPR2018-01140, Pet. at 5; IPR2019-00030, Pet. at 7; IPR2020-00896, Pet. at 4; IPR2020-00878, Pet. at 4; IPR2020-00897, Pet. at 4), or "mobile devices with an integrated camera having Telephoto and Wide lenses were well known" (IPR2020-00877, Pet. at 4). Across these 6 petitions, Apple has cited at least 5 unrelated references—Ogino, Chen, Iwasaki, Hsieh, and Parulski—that predate the '479 patent and that Apple alleges show telephoto lenses in mobile phones or mobile devices. And in his deposition in this very IPR, Apple's expert again confirmed his view that "telephoto lens designs for mobile phones were well-known prior to June 2013." (Ex. 2042 at 79:3–80:2.)

Further, attached to this brief is a certified translation of LG's brief submitted in response to Ex. 1042. Pages 2–5 of LG's brief respond to the statements in Ex. 1042 that Apple seeks to rely on in this IPR. Apple's camera module supplier argues in its brief that "it is clearly recognized that the telephoto lens assembly mounted on a mobile phone was researched and developed at least before 2005." Att. at 2.

The LG brief shows that Corephotonics’ statement about “only one prior document that mounted the telephoto lens assembly on a portable terminal” in Ex. 1042 was based on an incompletely developed factual record. LG’s brief cites four new prior art references that purportedly show telephoto lens assemblies in a mobile phone. Att. at 2–5. In total, Apple’s lens supplier has cited five examples of a “telephoto lens assembly mounted on a mobile phone” that predate the ’479 patent: Konno (a.k.a. Reference 1 in Ex. 1042 at 1), Kubota, Labaziewicz, Hideo, and Yasauki (Att. at 2). Labaziewicz has a disclosure that overlaps with Parulski, but at least *nine* of the examples of telephoto lens assemblies in mobile phones or mobile devices by Apple and its supplier that predate the ’479 patent are unique.

Not only were the statements in Ex. 1042 addressing limitations of different patent claims and a different factual record, but they also reflected a substantive law of “inventive step” that is different from that in the U.S. and which excludes patent applications from the inventive step analysis until they have been published. (*See KIPO Patent Examination Guidelines*, January 2021 at 303–04, 341–43.)

The statements Apple points to in Ex. 1042 concern lenses with TTL < 6.5 mm, something of little relevance to this IPR. The conclusion Apple asks the Board to draw from them is contrary to Apple’s repeated statements to the Board and its expert’s sworn testimony. Admitting Ex. 1042 for the purposes Apple proposes would be contrary to the interests of justice, and Apple’s motion should be denied.

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