

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

COREPHOTONICS, LTD.,
Patent Owner

IPR2020-00906
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 because Apple had failed to show that Ogata’s¹ lens could be scaled to work as a wide-angle lens in Parulski’s² digital camera. Paper 54 (Decision” or “Dec.”). Our conclusion was based on our observation that Petitioner’s declarant, Dr. Sasian, did not scale Ogata’s lens but a different lens having different lens prescription data, namely, a lens whose third lens element had an Abbe number that was 38% smaller than the Abbe number of Ogata’s third lens element. *Id.* at 15. Although Corephotonics (“Patent Owner”) had identified this discrepancy in its Patent Owner Response (Paper 16 (“PO Resp.”), 31), the Court of Appeals for the Federal Circuit found that because Corephotonics had only noted the error in the background section of its’ Response, our Decision violated the notice requirement due Petitioner pursuant to the Administrative Procedure Act (“APA”). Paper 59 (*Apple Inc. v. Corephotonics Ltd.*, Case Nos. 2022-1350, 2022-1351, *slip op.* 15, 16 (Fed. Cir. 2023) (“*Corephotonics I*”).

On December 1, 2023, consistent with the procedures set forth in the Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019)³ (“CTPG”), the parties held a conference call with the Board after having met and conferred to discuss a remand procedure. *See* CTPG, 87–90.

¹ U.S. Patent No. 5,546,236

² U.S. Patent No. 7,859,588 B2

³ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

Participating in the conference call were Mr. O'Brien for Petitioner, Mr. Rubin for Patent Owner, and Judges Anderson, Horvath, and Ullagaddi. A number of issues were raised and discussed during the call, as summarized below.

DISCUSSION

1. Whether the Errors in the Sasian Declaration are Before the Board

Petitioner argued that a threshold question on remand is whether the lens prescription data errors in the Sasian declaration are before the Board or are material to any decision on remand that would be APA-compliant. Therefore, Petitioner requested briefing on this question.

According to Petitioner, the Federal Circuit found the Board's Decision was not APA compliant because the Board addressed the lens prescription data errors in the Sasian declaration rather than the issue briefed by the parties during trial, namely, "whether there would have been a reasonable expectation of success in combining Parulski and Ogata, considering manufacturing and scalability concerns." *Corephotonics I* at 17. Thus, Petitioner argues, the Federal Circuit instructed the Board to consider and decide the manufacturability of Ogata's scaled lens in its decision on remand, which can be done on the current record without additional briefing or evidence.

Patent Owner, by contrast, argued the Federal Circuit did not decide that it was improper for the Board to consider the errors in the Sasian declaration and that the Board should not simply ignore them for the purpose of simplifying the decision on remand. Instead, Patent Owner argued, the Board should determine whether and how the errors in the Sasian declaration impact the credibility of Dr. Sasian's testimony in its decision on remand.

Upon consideration of the parties' arguments, we find the Board would benefit from briefing regarding how the case on remand can be decided in an APA-compliant manner. Although the Federal Circuit found our Decision did not comply with the APA, it is not clear that the Federal Circuit instructed us to address only the manufacturability of the Ogata and Kawamura lenses on remand. For example, the Federal Circuit noted that "the Board is entitled to set aside technical expert testimony that it finds not scientifically reliable on the record" and is "free to make credibility determinations, weight the evidence, and decide for itself what persuades it," provided the Board's conclusions are "supported by substantial evidence" and "reached only after the parties have been provided fair notice and an opportunity to be heard." *Id.* at 14.

Accordingly, for the reasons stated above, each party shall be provided the opportunity to brief whether the decision on remand is limited to considering the manufacturability of the Ogata and Kawamura lenses or can consider other factors, including errors in the Sasian declaration.

2. Should the Parties be Afforded Additional Briefing to Address Errors in the Sasian Declaration

During the call, the parties were asked whether additional briefing was required to address the errors in the Sasian declaration and, if so, the scope of that briefing, including whether it can or should be accompanied by new evidence. As noted above, Petitioner argued that no briefing is required on this issue because it is not before the Board on remand. Nonetheless, Petitioner argued that should the Board order briefing on the issue only Petitioner should be permitted to submit briefing because only Petitioner's

APA rights were violated. Petitioner similarly argued that should the Board permit new evidence to be introduced, only Petitioner should be permitted to introduce new evidence. Patent Owner argued that if Petitioner is provided the opportunity to brief the errors in the Sasian declaration or introduce new evidence, fairness and the APA require the Board to provide Patent Owner with the same opportunity.

We find additional briefing on the significance of the errors in the Sasian declaration would be helpful to the Board. We note that in addition to the Abbe number error for Ogata's third lens element, discussed at length in our Decision (Dec. 13–16), Dr. Sasian's declaration appears to contain additional errors with respect to Kawamura's lens. According to Dr. Sasian, a person of ordinary skill in the art would have known that Kawamura's example 1 lens could have been scaled to project an image onto a 1/2.5" image sensor that is compatible with Parulski's digital camera. Ex. 1021 ¶¶ 42–45. But it appears that the lens prescription data for Kawamura's lens that Dr. Sasian entered into the Zemax Lens Data Editor, shown in Figure 4C of the Sasian declaration, differs from the lens prescription data for Kawamura's example 1 lens. *Compare* Ex. 1012, 3 with Ex. 1021, p. 39.⁴ These differences are illustrated in the table below, where n is the index of refraction of a lens element and v is its' Abbe number:

⁴ We refer here to page 39 of the Sasian declaration, labelled Fig. 4C – Prescription Data, under section A titled “Fig. 4 – Kawamura scaled to fill a 1/2.5” image sensor using Zemax (v.02/14/2011).” Ex, 1021, pp. 37, 39.

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