

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 PRELIMINARY RESPONSE

TABLE OF CONTENTS

I.	INTRODUCTION .....	1
II.	OVERVIEW OF THE '479 PATENT .....	3
III.	LEGAL STANDARDS .....	5
IV.	THE PETITION FAILS TO ESTABLISH THE REASONABLE LIKELIHOOD OF A <i>PRIMA FACIE</i> CASE OF OBVIOUSNESS.....	7
A.	The Petition Fails To Demonstrate A Motivation To Combine The Cited References .....	7
B.	The Petition Fails To Demonstrate [19.5.1] And [19.5.2] Because It Fails To Show That A Camera Controller Configured For Those Limitations .....	8
C.	Petitioner Has Failed To Show [19.3] Because Petitioner Has Not Demonstrated How Parulski's Wide Lens is Focused.....	11
V.	THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION OF MULTIPLE IPR PETITIONS ON THE '479 PATENT.....	12
VI.	CONCLUSION .....	15

## TABLE OF AUTHORITIES

### Cases

<i>ActiveVideo Networks, Inc. v. Verizon Commc 'ns, Inc.</i> , 694 F.3d 1312 (Fed. Cir. 2012).....	6
<i>Ariosa Diagnostics v. Verinata Health, Inc.</i> , 805 F.3d 1359 (Fed. Cir. 2015).....	6
<i>Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.</i> , 381 F.3d 1371 (Fed. Cir. 2004).....	8
<i>In re Dow Chem. Co.</i> , 837 F.2d 469 (Fed. Cir. 1988).....	7, 8
<i>In re Kahn</i> , 441 F.3d 977 (Fed. Cir. 2006).....	7
<i>In re Magnum Oil Tools Int'l, Ltd.</i> , 829 F.3d 1364 (Fed. Cir. 2016).....	6
<i>Innogenetics, N.V. v. Abbott Labs.</i> , 512 F.3d 1363 (Fed. Cir. 2008).....	7
<i>SAS Inst., Inc. v. Iancu</i> , 138 S. Ct. 1348 (2018) .....	12
<i>Wasica Finance GMBH v. Continental Auto. Systems</i> , 853 F.3d 1272 (Fed. Cir. 2017).....	6

### Statutes

35 U.S.C. § 314(a).....	12
-------------------------	----

### Other Authorities

Consolidated Trial Practice Guide November 2019 .....	13
---	----

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

**Rules**

37 C.F.R. § 42.108 ..... 5

## 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-

# 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.