UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

IMMERVISION, INC.
Patent Owner

Case IPR2023-00471

Patent No. 6,844,990

PATENT OWNER'S AUTHORIZED PRE-INSTITUTION SUR-REPLY

I. PETITIONER FAILS TO MEET ITS BURDEN UNDER § 325

A. Petitioner's Reply Fails to Save its Flawed *Advanced Bionics* Analysis

Petitioner has the burden to show material error by the examiner when the petition relies on the same prior art previously presented to the Office. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential). Petitioner legally erred when it concluded the first part of the *Advanced Bionics* framework prevented discretionary denial in this case. *See e.g.*, Petition at 73-74 ("Petition relies upon grounds/arguments that are different than those previously presented to and considered by the Office")). Recognizing this flaw, Petitioner uses its Reply to belatedly repackage its analysis under the second part. Reply at 1-2. Patent Owner predicted this effort (POPR at 18-21) and Petitioner's new Reply argument fails for the same reasons Patent Owner previously presented.

First, neither the Petition nor the Reply cite any case or decision holding that an examiner is deemed to only have considered explicitly enumerated paragraphs or passages from a prior art reference. The only authority provided in the first section of the Reply is an easily distinguishable PTAB panel decision – one reference was submitted with 66 others in an information disclosure statement and was not used or mentioned by the examiner, and another reference at issue was only considered in later continuation applications. *Vizio, Inc. v. Maxell, Ltd.*,

IPR2022-01458, Paper 8 at 64-67 (PTAB Apr. 11, 2023). In contrast, the examiner here substantively considered Shiota on the record in granting reexamination, issuing a subsequent Office action, and allowing the claims. Ex. 1011 at 288-90, 308, 323, 343-44.

Second, Petitioner has not cured its defective expert testimony. Petitioner's Reply touts Dr. Kessler's declaration as evidence a POSA reading Shiota's paragraph [0023] would understand it to encompass the relevant claim feature. Reply at 1-2. But as Patent Owner previously explained (POPR at 20-21), the declaration merely repeats the Petition's conclusory assertions without citing any supporting evidence or offering any technical reasoning why a POSA would have understood paragraph [0023] in that manner. *See* Petition at 50-52; Ex. 1003 at ¶¶ 205-207. Dr. Kessler's testimony is entitled to no weight and is ineffective to show error by the examiner. *See e.g.*, *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15 (PTAB Aug. 24, 2022) (precedential); *Nespresso USA, Inc. v. K-Fee System GmbH*, IPR2021-01222, Paper 9 at 26 (PTAB Jan. 18, 2022). The Reply ignores the issue entirely and leaves Petitioner with no legitimate evidence to sustain its burden of showing material error by the Office.

B. Petitioner's Burden to Show the Examiner Did Not Review All of Shiota is Not Met by the Mere Lack of Citation to Paragraph [0023]

Petitioner now acknowledges the examiner reviewed more than just paragraphs [0033]-[0041] from Shiota, in contrast to its earlier argument in the Petition. *Compare* Petition at 74, 77-78 *with* Reply at 5. To distract from the admission that the examiner reviewed more than just paragraphs [0033]-[0041], Petitioner spends much of the Reply criticizing Patent Owner because many of the Shiota citations highlighted in the POPR related to other claims. Reply at 3-5. Petitioner's compartmentalizing of the file history irrationally suggests the examiner would intentionally ignore or forget portions of a prior art reference depending on the claim at issue. Petitioner has no basis to assume that if the examiner evaluated, *e.g.*, Shiota's paragraph [0024] with regard to claim 10, the examiner would discard such knowledge when analyzing claim 27. Petitioner's argument further ignores that claims 10 and 27 share numerous overlapping elements, including "correcting the non-linearity of the initial image" using "the non-linear distribution function," for which many of the relevant paragraphs were cited. Ex. 1011 at 117.

Ultimately, Petitioner's assertion of error rests on the absence of an explicit mention of Shiota's paragraph [0023], but Petitioner mischaracterizes the reexamination record to arrive at this conclusion. For example, Petitioner contends

that "the Examiner explicitly identified Shiota's paragraphs that she considered in finding claim 27 allowable." Reply at 4-5. Petitioner suggests the examiner reviewed only the listed paragraphs before allowing claim 27, but the examiner makes no such correlation. Per the examiner: "Shiota and Matsui each generally teach correcting the non-linearity of an image captured by a lens (Shiota, Figure 1; paragraphs [0001], [00022], and [0028]-[0041]; Matsui, Figures 2-4 and 6; Abstract and paragraph [0025]." Ex. 1011 at 323. Nothing here indicates the examiner considered ***only*** these paragraphs relevant to claim 27's allowability.

Other PTAB panels have found it proper to infer that an examiner has evaluated the entirety of a reference even though only specific portions are cited in an Office action. *See e.g.*, *Juniper Networks, Inc. v. Mobile Telecomms. Techs., LLC*, IPR2017-00642, Paper 31 at 17 (PTAB Mar. 14, 2018) ("In addressing [reference] substantively and citing to portions of [reference], we determine that the Examiner was aware of the entire reference and that he or she evaluated [reference]'s applicability to the pending claims, notwithstanding the citation to only certain portions of the reference"); *Gen. Elec. Co. v. United Techs. Corp.*, IPR2018-01172, Paper 7 at 18 (PTAB Nov. 29, 2018) ("The mere fact that the Examiner cited only paragraphs 3-5 and 18 of [reference] does not indicate that the Examiner failed to consider paragraphs 22 and 23 of [reference]"). Here,

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