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Paper 14
Date: August 29, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

IMMERVISION, INC.,
Patent Owner.

IPR2023-00471
Patent 6,844,990 B2

Before KRISTINA M. KALAN, JOHN D. HAMANN, and STEPHEN E. BELISLE, *Administrative Patent Judges.*

Opinion Dissenting filed by KALAN, *Administrative Patent Judge.*

PER CURIAM.

DECISION
Denying Patent Owner's Request for Rehearing of
Decision Granting Institution of *Inter Partes* Review
37 C.F.R. § 42.71(d)

I. INTRODUCTION

ImmerVision, Inc. ("Patent Owner") filed a Request for Rehearing (Paper 12, "Req. Reh'g") of our Decision Granting Institution of *Inter Partes* Review (Paper 10, "Dec. on Inst.") of U.S. Patent No. 6,844,990 B2 (Ex. 1001). In the Decision, the majority declined to exercise discretion to deny institution under 35 U.S.C. § 325(d). Dec. on Inst. 30. In particular, the majority determined that the second part of the *Advanced Bionics*[1] framework was not met. Dec. on Inst. 25–30. In its Request for Rehearing, Patent Owner argues that the majority misapprehended material matters in making this determination. Req. Reh'g 3–7. For the reasons below, we disagree with Patent Owner and deny Patent Owner's Request for Rehearing.

II. STANDARD OF REVIEW

A party requesting rehearing bears the burden of showing that the decision should be modified. 37 C.F.R. § 42.71(d). Under 37 C.F.R. § 42.71(d), a patent owner who requests rehearing of a decision denying institution must identify specifically all matters we misapprehended or overlooked. *Id.* When reconsidering a decision on institution, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may be determined if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing

[1] *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7 (PTAB Feb. 13, 2020) (precedential) ("*Advanced Bionics*").

relevant factors. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005).

III. ANALYSIS

Patent Owner argues that the majority misapprehended "the quantity and quality of expert testimony" relating to a specific claim element in declining to exercise discretion to deny institution under 35 U.S.C. § 325(d). Req. Reh'g 1. This claim element recites, in part, "correcting the non-linearity of the initial image, performed by retrieving image points on the obtained image in a coordinate system of center O' using at least the non-linear distribution function and a size L of the obtained image." Ex. 1001, 1:66–2:3. It is this claim element for which we found that the Examiner erred in evaluating the teachings of Baker and Shiota. Dec. on Inst. 28.

First, Patent Owner argues that the majority "attributes eight paragraphs from [Dr. Kessler's] declaration [(Ex. 1003)] as supporting a supposed 'detailed explanation and interpretation of Shiota from the vantage point of the skilled artisan,'" but "[i]n reality, only paragraph 205 addresses whether Shiota teaches the relevant claim element." Req. Reh'g 1.

We disagree with Patent Owner. As we found in the institution decision, Dr. Kessler's paragraphs 205–212 "walk[] through in detail how Baker and Shiota teach 'correcting the non-linearity of the initial image . . . by retrieving image points on the obtained image in a coordinate system of center O' using at least the non-linear distribution function and a size L of the obtained image.'" Dec. on Inst. 28 (citing Ex. 1003 ¶¶ 205–212; Pet. 49–55 (citing same)). Patent Owner's Request for Rehearing substantively addresses only paragraph 205, makes only bald

assertions as to paragraphs 206 and 207, and completely ignores the substance of paragraphs 208–212. *See* Req. Reh'g 3–5 & n.2. Hence, Patent Owner does not meet its burden in showing that we abused our discretion in finding that these paragraphs walk through how Baker and Shiota teach the relevant claim element.

We also disagree with Patent Owner that "Dr. Kessler's testimony relevant to the material error in question is confined to one conclusory paragraph." Req. Reh'g 3. The gravamen of Patent Owner's argument is that we should ignore at least paragraphs 208–212 of Dr. Kessler's testimony because Petitioner does not explicitly cite these paragraphs again in Petitioner's § 325(d) discussion that the Examiner materially erred when the Examiner found that Baker and Shiota do not teach the relevant claim element. *Id.* at 4. Petitioner, however, cited and discussed these paragraphs in its showing for how Baker and Shiota teach the relevant claim element, and thus, it is appropriate for us to consider this evidence for evaluating Examiner error as to what Baker and Shiota teach. *See* Pet. 49–55 (citing Ex. 1003 ¶¶ 205–212). To find otherwise would exalt form over substance, and would prevent us from properly "balanc[ing] [P]etitioner's desire to be heard against the interest of . . . [P]atent [O]wner in avoiding duplicative challenges to its patent." Consolidated Trial Practice Guide[2] (Nov. 2019), 62.

Second, we find unavailing Patent Owner's argument that paragraphs 205–207 of Dr. Kessler's testimony are conclusory, and should be afforded

[2] *Available at* https://www.uspto.gov/TrialPracticeGuideConsolidated.

little weight. Req. Reh'g 4–7. In particular, we disagree with Patent Owner that paragraph 205 "merely summarize[s] or quote[s] the text of Shiota's paragraph" 23, but rather we find that the discussed portions of paragraph 23 provide factual support for Dr. Kessler's testimony. *Id.* at 4; *compare* Ex. 1003 ¶ 205, *with* Ex. 1012 ¶ 23. Moreover, Dr. Kessler also relies on additional portions of Shiota for support for this testimony. *See* Ex. 1003 ¶ 205 (citing Ex. 1012 ¶¶ 23–26). In addition, at this stage, we view the portions of Shiota cited in Dr. Kessler's paragraph 205 as also supporting paragraph 206. *Id.* ¶¶ 205–206. Moreover, Patent Owner does not address the support Dr. Kessler provides for his testimony in paragraph 207. *See* Req. Reh'g 3–4 & n.2; Ex. 1003 ¶ 207 (citing Ex. 1006, 14:64–15:19; Ex. 1012 ¶¶ 22–23, 25, 49).

Third, we find unavailing Patent Owner's argument that our Decision on Institution "acknowledge[d] that Dr. Kessler's declaration testimony '***is the only evidence of record concerning what the skilled artisan would have considered Shiota to teach***,' and that "[w]ithout this singular piece of evidence, Petitioner would be unable to meet its burden to prove error by the Examiner." Req. Reh'g 3 (quoting Dec. on Inst. 29) (alteration in original). Simply put, Patent Owner overreads and takes out of context this statement. Rather, this statement is made in the context of additional evidence (i.e., Dr. Kessler's detailed testimony) that the Examiner did not have the benefit of, and is the only such evidence of record at this stage because Patent Owner did not submit an expert declaration. *See* Dec. on Inst. 28–29. The statement does not exclude Baker and Shiota's teachings, which are record evidence. Moreover, as we found in the institution decision, Petitioner cites to specific portions of Baker and

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