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Paper No. 31
Entered: October 29, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

COREPHOTONICS LTD.,
Patent Owner.

Case IPR2018-01140
Patent 9,402,032 B2

Before MARC S. HOFF, BRYAN MOORE, and
MONICA S. ULLAGADDI, Administrative Patent Judges.

HOFF, *Administrative Patent Judge.*

ORDER

Conduct of Proceeding

37 C.F.R. § 42.5

I. BACKGROUND

Petitioner requested *inter partes* review of claims 1 and 13-15 (the "challenged claims") of U.S. Patent No. 9,402,032 B2 (Ex. 1001, "the '712 patent"). Paper 2 ("Petition" or "Pet."). We instituted review as to all claims and all grounds challenged in the Petition. Paper 10 ("Decision" or "Dec."). Patent Owner filed a Patent Owner's Response. Paper 14 ("PO Resp."). Petitioner thereafter filed a Petitioner's Reply. Paper 22 ("Reply"). Patent Owner filed a Sur-Reply to Petitioner's Reply. Paper 24 ("PO Sur-Reply"). Oral arguments were heard on October 8, 2019.

II. CONSTRUCTION OF "TOTAL TRACK LENGTH"

With respect to the construction of the term "total track length" (TTL), Petitioner contends that the meaning of the term "total track length (TTL)" should include "the length of the optical axis spacing between the object-side surface of the first lens element and the image plane." Pet. 9. Petitioner relies on the '032 patent disclosure that "the electronic sensor or image sensor 'is disposed at image plane 114 for the image formation.'" Pet. 9 (quoting Ex. 1001, 3:14–16). Petitioner further contends that the electronic sensor is not shown in the figures of the '032 patent and TTL is defined in terms of the image plane. Reply 6 (quoting Ex. 1001, 3:13–15, 5:10–11, 6:27–28). Petitioner also supports its construction of TTL with Chen (Ex. 1008), which states that "TTL is defined as the on-axis spacing between the object-side surface of the first lens element and the image plane when the first lens element is positioned closest to the imaged object." Pet. 9 (quoting Ex. 1008, 3:24–26). Patent Owner did not suggest a construction for this term prior to institution because it did not file a Preliminary Response.

At institution, we preliminarily concluded that TTL should be construed as "the length of the optical axis spacing between the object-side surface of the first lens element and the image plane." Dec. 11.

Patent Owner contends that the disclosure in the '032 patent of "the total track length on an optical axis between the object-side surface of the first lens element and the electronic sensor is marked 'TTL'" constitutes an express definition. PO Resp. 17 (quoting Ex. 1001, 1:60–63). Patent Owner further contends that extrinsic evidence, Exhibits 2004, 2005, 2006, and 2007, each define TTL in terms of the electronic sensor as opposed to the image plane. *Id.* at 17–18.

Patent Owner suggested at the hearing that the image plane or the physical surface of the imaging device are both legitimate ways to construe TTL[1]. Additionally, at the hearing, Patent Owner suggested that TTL does not have to be measured to an electronic sensor, but rather that TTL can be measured to the physical surface of the imaging device whether it be an electronic sensor, sensor film or otherwise.

We reviewed the briefing from the parties and determine that the briefing on this issue is insufficient given discussion regarding this claim limitation at the oral hearing. We invite the parties to provide their respective positions on whether TTL should be construed as "the length of the optical axis spacing between the object-side surface of the first lens element and one of: an electronic sensor, a film sensor, and an image plane

[1] The oral hearing transcript is not available at the time of this order. Nevertheless, given the schedule to enter the Final Written Decision, we characterize the comments at the hearing in order to clarify what is requested in this order.

corresponding to either the electronic sensor or a film sensor," in light of Patent Owner's position taken during oral argument, and in light of the conflicting extrinsic definitions cited by the parties (Ex. 1008, 2004, 2005, 2006, and 2007). The parties may address this issue and the issue below in a brief and responsive brief, as outlined in the orders at the conclusion of this paper. No new evidence or testimony may be attached to the briefs.

III. CONCLUSION

Accordingly, it is,

ORDERED that Petitioner and Patent Owner each file briefs, limited to 2100 words or less, addressing claim construction and enablement issues discussed above on or before November 5, 2019. No new evidence or testimony may be attached to the briefs; and

FURTHER ORDERED that Petitioner and Patent Owner file responsive briefs, limited to 1500 words or less, addressing the other parties' arguments on or before November 12, 2019. No new evidence or testimony may be attached to the briefs.

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