

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner,

v.

COREPHOTONICS, LTD.,  
Patent Owner.

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IPR2020-00489  
U.S. Patent 10,015,408 B2

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Before GREGG I. ANDERSON, MONICA S. ULLAGADDI, and  
JOHN R. KENNY, *Administrative Patent Judges*.

ULLAGADDI, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request on Rehearing  
of the Final Written Decision

*37 C.F.R. § 42.71*

Denying Petitioner's Request to Admit and Consider New Evidence  
Denying Patent Owner's Request to Admit and Consider New Evidence

*37 C.F.R. § 42.5*

## I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition to institute *inter partes* review of claims 5 and 6 of U.S. Patent No. 10,015,408 B2 (Ex. 1001, “the ’408 patent”) on February 5, 2020. Paper 2 (“Petition” or “Pet.”). Corephotonics, Ltd. (“Patent Owner”) filed a Preliminary Response. Paper 7. We instituted an *inter partes* review of each of the challenged claims on the ground set forth in the Petition. Paper 8. Subsequent to institution, Patent Owner filed a Patent Owner Response (Paper 13, “PO Resp.”), Petitioner filed a Petitioner Reply (Paper 18), and Patent Owner thereafter filed a Sur-Reply (Paper 20).

An oral hearing was held on May 26, 2021 and a transcript of the hearing has been entered into the record. Paper 31. On July 26, 2021, we entered a Final Written Decision (Paper 32, “Decision” or “FWD”) determining that Petitioner did not demonstrate by a preponderance of the evidence that any of the challenged claims were unpatentable. Petitioner requests rehearing (Paper 33, “Req. Reh’g”) of our Decision.

In its Rehearing Request, Petitioner urges us to reconsider our Decision, and then also urges us to admit and consider new documents that became available after we entered our Decision. Specifically, Petitioner urges us to admit a brief (“Korean Brief”) prepared and submitted by Patent Owner in connection with a proceeding before the Patent Court of Korea (“Korean Court”).<sup>1</sup> Patent Owner filed a brief opposing the admission of the Korean Brief. Paper 34 (“PO Brief”). Patent Owner also urges us to admit and consider new documents. Specifically, Patent Owner filed a brief urging us to admit a certified translation of another brief,

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<sup>1</sup> Petitioner attaches a certified translation of the Korean Brief to its Rehearing Request.

filed by a third party, LG Innotek Co., Ltd. (“LG Brief”) in a proceeding before the 3rd Division of the Korean Court. Paper 35 (“PO LG Brief”). Petitioner opposed admission of the LG Brief. Paper 36 (“Opp. LG Brief”). For the reasons set forth below, Petitioner’s Rehearing Request is denied. We further do not admit either the Korean Brief or the LG Brief.

## II. LEGAL STANDARDS

A party requesting rehearing bears the burden of showing that a decision should be modified. 37 C.F.R. § 42.71(d). The party must specifically identify all matters it believes the Board misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a reply. *Id.* A request for rehearing, therefore, is not an opportunity merely to disagree with the Board’s assessment of the arguments or weighing of the evidence, or to present new arguments or evidence. *See, e.g., Presidio Components, Inc. v. AVX Corporation*, IPR2015-01332, Paper 21, 4 (PTAB Feb. 21, 2016) (“Patent Owner’s arguments in this regard amount to a mere disagreement with our analysis or conclusion. But mere disagreement with our analysis or conclusion is not a sufficient basis for rehearing. It is not an abuse of discretion to provide analysis or conclusion with which Patent Owner disagrees.”).

## III. THE PARTIES’ ARGUMENTS

In the Final Written Decision, we determined that Petitioner had not met its burden of showing, by a preponderance of the evidence, that claims 5 and 6 of the ’408 patent are unpatentable over U.S. Patent Application Publication No. 2012/0026366 A1 (Ex. 1005, “Golan”) and Japanese Patent Application Publication No. S58-62609 (Ex. 1007, “Kawamura”). FWD 2; *see* Pet. 13–20.

Petitioner now requests that we reconsider the conclusion rendered in our Decision and instead conclude that claims 5 and 6 are unpatentable over the combination of Golan and Kawamura. Req. Reh’g 3.

*A. Arguments Regarding the Final Written Decision*

In Section II.A of its Request for Rehearing, Petitioner argues that, in determining a person of ordinary skill in the art (“POSITA”) would not have been motivated to combine Golan and Kawamura, we relied on Patent Owner’s “unsupported representations that [a] ‘*rich literature*’ of miniature telephoto lens designs existed in 2013” and arguments that a POSITA would have looked to this “rich literature” instead of looking to Kawamura. Req. Reh’g 5 (quoting FWD 36 (“A POSITA would not have been motivated to go beyond [the] rich literature of miniature lens designs and try scaling old lenses.” (quoting Ex. 2003 ¶ 87))) (citing PO Resp. 39; Paper 31, 29:21–24; Sur-Reply 14). Petitioner contends that Patent Owner directly contradicted its representation about the “‘rich literature’ of miniature telephoto lens designs” in a proceeding before the Korean Court and that, accordingly, our determination that Petitioner’s challenge lacked a sufficient motivation to combine Golan and Kawamura is unsupported. *Id.* (emphasis omitted) (citing Ex. 1036, 2, 7).<sup>2</sup> *Infra* §§ IV.A–B.

In Section II.B of the Rehearing Request, Petitioner argues that neither Golan nor Kawamura are limited to their examples and that the Board misconstrued the scope of these references by limiting the disclosed devices to the specific dimensions set forth in the disclosed examples. *Id.* at 7–9 (“The Decision

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<sup>2</sup> When referring to the Korean Brief, Petitioner cites to Exhibit 1036. A certified translation of the Korean Brief was filed as an attachment to Petitioner’s Request for Rehearing, not as an exhibit.

effectively treated Golan’s teachings as excluding scope that does not require a miniature telephoto lens, based solely on an exemplary image sensor in Golan’s background. This is clear error.”). Petitioner contends that our Decision “explained that ‘disclosure of the 5 megapixel image sensor array in Golan supports the finding that Golan is at least applicable to miniature digital cameras and image sensors such as those used in mobile devices’, but provided no explanation of why and how such ‘at least applicable’ finding operated as a limitation on a POSITA’s understanding of Golan’s scope, by excluding scope beyond the ‘at least applicable’ finding.” Req. Reh’g 8 (citing FWD 34) (emphasis omitted). *Infra* §§ IV.C, IV.G.

Petitioner additionally argues that the Board improperly required that the supporting reference, U.S. Patent No. 8,896,697 B2 to Golan et al. (Ex. 1022, “Golan ’697”) “mention Golan or the invention described” to inform a POSITA’s understanding of Golan. *See id.* at 11. Petitioner further argues that the Board made unsupported factual findings by not finding there was sufficient support for image sensors of Golan ’697 to correspond to the device and method of Golan. *Id.* at 12 (“The Board’s statement that ‘[t]here is no ... evidence that Golan’s teachings are applicable to larger-scale imaging systems’ (FWD, at 34) is thus erroneous, because it ignores the disclosure in Golan ’697 (incorporating provisional application No. 61/167,226, ‘the ’226 Provisional’) of precisely such applications of the teachings of Golan to a larger-scale imaging system.”). Petitioner further argues that our Decision “overlooked that Golan (APPL-1005) and Golan 697 (APPL-1022) are related patents, both claiming priority to the same provisional . . . and incorporating that same provisional by reference” and “[a] POSITA would have understood—from the face, common priority and incorporated content—correspondence between a related patent and patent publication from the same

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