

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 REQUEST FOR REHEARING
UNDER 37 C.F.R. §§ 42.71(c)-(d)

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I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.71(d), Patent Owner respectfully requests rehearing of the Board’s July 11, 2023 Decision Granting Institution of *Inter Partes* Review (“Decision”) relating to U.S. Patent No. 6,844,990 (“the ‘990 patent”). The Decision misapprehended the quantity and quality of expert testimony in declining to exercise discretion under 35 U.S.C. § 325(d) despite the Petition being based on an exact reference combination from a prior reexamination.

The Decision recognized that the Petitioner’s expert’s (Dr. David Kessler) testimony constitutes the only evidence of record as to whether the reexamination Examiner erred when interpreting Shiota’s paragraph [0023]. But the Decision misapprehended how much Dr. Kessler provided in his declaration about whether Shiota teaches the specific element at issue. Specifically, the Decision attributes eight paragraphs from the declaration as supporting a supposed “detailed explanation and interpretation of Shiota from the vantage point of the skilled artisan.” In reality, only paragraph 205 addresses whether Shiota teaches the relevant claim element, and that paragraph includes nothing more than a rehash of the reference’s language and a conclusory assertion it meets the claim. When this

evidence is assigned proper weight under *Xerox*¹ (*i.e.*, little to none), Petitioner has nothing left to satisfy its burden for demonstrating Examiner error. For at least this reason, Patent Owner respectfully requests the Board grant rehearing of the Decision and decline institution of this proceeding.

II. REHEARING STANDARD OF REVIEW

When reconsidering a decision on institution, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may be found where the decision is based on an erroneous legal interpretation, a factual finding is unsupported by substantial evidence, or there is an unreasonable judgment in weighing relevant factors. *See e.g., Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005). The party requesting rehearing has the burden to show the relevant decision should be modified. 37 C.F.R. §§ 42.71(d). The party must specifically identify all matters that the Board is believed to have misapprehended or overlooked, and where each matter was previously addressed in the record. *Id.*

¹ *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 (PTAB Aug. 24, 2022) (precedential).

III. THE DECISION MISAPPREHENDED THE EXTENT OF DR. KESSLER’S TESTIMONY ON THE RELEVANT ISSUE

The Decision acknowledges that Dr. Kessler’s declaration testimony “*is the only evidence of record concerning what the skilled artisan would have considered Shiota to teach.*” Decision at 29 (emphasis added). Without this singular piece of evidence, Petitioner would be unable to meet its burden to prove error by the Examiner. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential); *see* POPR at 17; Sur-Reply at 1. The Decision erroneously credits Dr. Kessler with providing a “detailed explanation and interpretation of Shiota from the vantage point of the skilled artisan.” DI at 29. However, Dr. Kessler’s testimony relevant to the material error in question is confined to one conclusory paragraph. The precedential *Xerox* decision requires the Board to give such a declaration little weight – stripping Petitioner of its only evidence of Examiner error.

A. Support for the Alleged Examiner Error Came from a Single Conclusory Paragraph of Dr. Kessler’s Declaration

The sole issue is whether the Examiner erred in interpreting Shiota’s paragraph [0023] during the ‘990 patent’s reexamination. DI at 26, FN9; POPR at 19-21; Sur-Reply at 2. Petitioner contends Shiota’s teaching of an assumed radius of 1 for a fisheye image and “[a]t the time of actually [sic] use, magnification

adjustment is performed” (Ex. 1012 at [0023]) equates to the claimed “correcting the non-linearity...using at least...a size L of the obtained image” (Pet. at 77-78).

The Decision generously lists paragraphs 205-212 from Dr. Kessler’s declaration as “detailed testimony” showing Examiner error. Decision at 28. This goes beyond even Petitioner’s arguments, which only relied upon paragraphs 205-207 relating to using “the size of the image disk...to correct the image.” *See* Pet. at 77-78; POPR at 20; Reply at 2; Sur-Reply at 2. Of that, **only** paragraph 205 addresses how a skilled artisan would allegedly interpret Shiota’s paragraph [0023] to read on the ‘990 patent claim language.² Ex. 1003 at ¶ 205; POPR at 20.

Paragraph 205 from Dr. Kessler’s declaration is reproduced below in its entirety with colored highlighting. The first sentence (highlighted in red) is a conclusory introductory statement. Ex. 1003 at ¶ 205. The next two sentences (highlighted in yellow) merely summarize or quote the text of Shiota’s paragraph [0023]. *Id.*; *see* POPR at 20. The final sentence (highlighted in red) makes the conclusory assertion that the person of ordinary skill in the art would have

² Paragraph 206 contains another conclusory, unsupported assertion and goes on to posit that a person of ordinary skill in the art would have modified Baker’s system to include Shiota’s teachings, and paragraph 207 supposes it would have been obvious to represent the image size in pixels. Ex. 1003 at ¶¶ 206-207.

understood the “magnification adjustment” to refer to the claimed size L of the image. Ex. 1003 at ¶ 205; POPR at 20.

205. The combination would have also rely upon Shiota’s teaching of using the actual size of the image in performing the above-described image transformation. For its described image transformation operations, Shiota assumes a normalized radius of 1 of the image circle at a field angle of 90° (from the front of the lens). APPLE-1012, [0023]. However, Shiota acknowledges that the image circle diameter (i.e., the size of the image) “differs according to at least the size of the image pickup device” and that “at the time of actual[] use, magnification adjustment is performed.” *Id.* A POSITA would have thus understood that this reference to “magnification adjustment” refers to an adjustment that accounts for the actual size of the image pickup device—and by extension, the actual size of the image—as part of the image transformation. *See also* APPLE-1012, [0025]-[0026] (explaining that necessary parameters for the image transformation operations include, e.g., the magnification of the image), [0024] (using “the scale factor (zoom ratio) as the size of the plane image” to perform the described image transformation).

Conclusory introductory sentence

Summary or quotation from Shiota ¶ [0023]

Conclusory assertion with no explanation

Such is the extent of Dr. Kessler’s discussion of whether Shiota teaches correcting an image’s non-linearity using the size L of the obtained image. Dr. Kessler provides no further evidentiary support or any kind of technical explanation regarding this conclusion or the relevant topic. *See* POPR at 20-21. The Decision misapprehended the degree of detail in Dr. Kessler’s testimony related to the specific inquiry of how the skilled artisan would interpret Shiota’s paragraph [0023].

B. The Evidence is Entitled to No Weight Under *Xerox* and Cannot Satisfy Petitioner’s Burden to Show Error

Once its true extent is revealed, Dr. Kessler’s relevant testimony clearly falls within the scope of evidence the Director indicated must be given little weight. *See Xerox*, Paper 9 at 14-15 (disregarding conclusory expert assertion that the prior art’s “blocking the purchaser” requires claimed storing in a data record associated with the user); 37 C.F.R. § 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight”); POPR at 20; Sur-Reply at 2.

Where, as here, the only recognized evidence of Examiner error derives from conclusory expert testimony entitled to little weight, a Petitioner is unable to meet its burden to show error. *See e.g., Autel Intelligent Tech. Corp., Ltd. V. Orange Elec. Co., Ltd.*, IPR2021-01545, Paper 8 at 26 (PTAB Apr. 8, 2022) (“Petitioner does not demonstrate error in the Examiner’s finding that [reference] does not disclose the [] limitation” where expert cites no “objective support that would give his testimony persuasive weight”); *Becton, Dickinson and Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 28 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph) (“[The expert’s] declaration does not provide persuasive facts, data, or analysis to support the stated opinion. Without such testimony, we are not persuaded that the mere existence of the elements in the prior art warrants reconsideration of the prior art and arguments presented earlier

to the Office”); POPR at 20-21. Considering the nature of Dr. Kessler’s testimony on this particular issue, and the Decision’s recognition that it constitutes “the only evidence of record concerning what the skilled artisan would have considered Shiota to teach,” Petitioner cannot be said to have satisfied its burden to show Examiner error.

IV. CONCLUSION

For at least the reasons recited above, Patent Owner respectfully requests that the Board grant rehearing of the Decision, vacate that Decision, and exercise its discretion under 35 U.S.C. § 325(d) to deny institution of the Petition in this matter.

Date: July 21, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE UNDER 37 CFR § 42.6(e)

I hereby certify that a true copy of the foregoing PATENT OWNER'S REQUEST FOR REHEARING UNDER 37 CFR §§ 42.71(c)-(d) has been served in its entirety this 21st day of July 2023, by electronic mail on Petitioner's lead and back-up counsel, as follows:

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