

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

IMMERVISION, INC.,
Patent Owner.

Case IPR2023-00472
Patent 10,795,120

**PETITIONER'S REBUTTAL TO
PATENT OWNER'S SUR-REPLY**

None of the pre-institution filings cited by Immervision provided notice of its proposed claim construction prior to the submission of the Petition, much less identified the key issue raised by that construction that Immervision emphasizes in its Sur-Reply: “that the downward slope in the ’120 Patent’s Fig. 7 had no significance to claim 1.” Paper 14, 1. In its Sur-Reply, Immervision argues that, “even if the dispute were considered a matter of claim interpretation, Petitioner clearly had prior knowledge and should have addressed it at the Petition stage.” Paper 14, 2. None of Immervision’s prior briefing or contentions—including Immervision’s preliminary infringement contentions in the parallel district court case (Ex. 2012)—argued that the downward slope in the ’120 Patent’s Fig. 7 had no significance to claim 1, or explained why. Thus, Apple had proper basis to respond to these new arguments in its Reply, which was the first opportunity for it to do so in this proceeding. *Axonics Inc. v. Medtronic*, 75 F.4th 1374, 1380-82 (Fed. Cir. Aug. 7, 2023).

Infringement and invalidity contentions alone do not necessarily provide sufficient notice of a party’s position on the metes and bounds of claim language, much less the justification for those metes and bounds. Claims may be worded broadly so that they cover “a wide scope of subject matter.” MPEP § 2173.04. For example, a genus claim can cover multiple species, any one of which would either infringe the claim or, if disclosed in the prior art, render it invalid. *See* MPEP

2131.02. Infringement and invalidity contentions thus may identify only a species without identifying the full genus scope—*e.g.*, whether Fig. 7 is within that scope.

Faced for the first time in the POPR and POR with Immervision’s contention “that the downward slope in the ’120 Patent’s Fig. 7 had no significance to claim 1,” Apple rightly replied. Nowhere in the preliminary infringement contentions does Immerivion mention Fig. 7 of the ’120 Patent, much less its belief that the teachings related to Fig. 7 are not encompassed by claim 1—a position first articulated in many pages of claim constuction briefing that was all served well after the Petition was filed. *See* Ex. 2012, 10-12. Indeed, the *preliminary* infringement and invalidity contentions relied upon by Immervision were not due to be made *final* until well after the claim constrution hearing that has yet to happen in the stayed litigation. Ex. 1022, 19-20. In other words, the schedule in the district court recognizes what Immervision seeks to ignore here: determination of the proper scope of the claims is essential to the parties’ ability to set forth their final infringement and invalidity contentions. So too is Apple reasonably permitted here to respond to Immervision’s arguments about the scope of the claims. *Axonics*, 75 F.4th at 1380-82.

There are no new mappings in the Reply. Paper 13, 12-19. The only “new” evidence and arguments were properly presented in direct reply to Immervision’s new claim construction arguments, and reaffirm the propriety of the original grounds under any construction presented by the parties. *Id.*

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Attorney Docket: 50095-0115IP1

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4), the undersigned certifies that on March 20, 2024, a complete and entire copy of this Petitioner's Rebuttal to Patent Owner's Sur-Reply was provided by email to the Patent Owner by serving the correspondence address of record as follows:

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