

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA MOBILITY LLC
Petitioner,

v.

LARGAN PRECISION CO., LTD.
Patent Owner.

Case IPR2024-00689
U.S. Patent No. 9,366,845

PATENT OWNER PRELIMINARY SUR-REPLY

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Motorola's preliminary reply ("PR"; Paper 7) does nothing to backfill the Petition's deficiencies regarding § 325(d) or the POSA's general knowledge. For § 325(d), the PR does not respond to the POPR arguments and instead tries to present new arguments that remain unavailing. As for the POSA's general knowledge, the PR again dodges the issue and fails to confront the clear mandate of the case law that such knowledge is assessed as of the effective filing date, not after.

§ 325(d). Just as it did in the Petition, Motorola effectively concedes in the PR that it must prove the Examiner "materially erred" in allowing the challenged claims, thus acknowledging that the Petition's Cai + POSA-knowledge and Fukaya + POSA-knowledge arguments were already considered and overcome during prosecution, in the form of the Examiner's application of Baik + Cai (via Cai's U.S. counterpart). Though maintaining that the Examiner erred in finding Baik's failure to teach the " $0.5 < Y_{c62}/Y_{c72} < 1.5$," the PR fails to meaningfully confront Largan's POPR points (at pp. 4–13) and presents two impermissible new but still defective arguments.

Motorola's first new argument is the Examiner's alleged "failure to apprehend the simplicity of the supposedly 'allowable' [$0.5 < Y_{c62}/Y_{c72} < 1.5$] condition, and the satisfaction of that condition by known lens forms." PR, 3. This argument holds, in essence, that POSAs would have seen this condition as being met by any design having "two gullwing lenses with meniscus shapes on the optical axis, having convex curvature on the object side and concave curvature on the image side." *Id.*, 2. This

begs the question: how? The only apparent answer is by looking at the figures—at least that is how the PR goes about it, with new annotated images of figures from Baik and the '845 patent. *Id.*, 2, 4. Motorola essentially argues it is error for an examiner not to (i) assume all figures are drawn to scale and (ii) measure each in evaluating whether the prior art disclosed a particular dimensional relationship. It is a rather bold premise, especially when Baik states that “the shapes and dimensions of elements may be exaggerated,” and one that would certainly be accompanied by citation to authority. Motorola cites none. In contrast, Motorola’s own patents specifically caution readers (including examiners) that “elements illustrated in the figures have not necessarily been drawn to scale.” *See, e.g.*, US12,081,907 at 1:51–53.

The second new argument is that “[t]he Examiner failed to appreciate that POSITAs would have been motivated to improve the designs of Fukaya (Ground 1) and Cai (Ground 2)—which suffered from off-axis aberrations and steep ray angles—by optimizing the sixth and seventh lenses to form a meniscus-gullwing lens pair that was known to solve these issues.” PR, 3. This argument is somewhat circular as it relies on the acceptance of an unfounded premise directly exposed in the POPR: that Fukaya and Cai needed improvement. POPR, 27–33 (establishing Fukaya’s lack of need of improvement), 37–43 (same, for Cai). In addition, the argument proposes that it was error to not consider an obtuse argument when a more direct one was available; that is, the Examiner’s error was treating Baik as the base reference instead of Cai or

Fukaya. The Examiner allowed the claims over Baik and its “double gullwing” sixth and seventh lens elements, in combination with Cai’s U.S. counterpart. But the PR argues that it was error to treat Baik as the base reference—despite its “double gullwing design form”—and that the Examiner should instead have started with Cai or Fukaya and modified their respective bi-convex and bi-concave sixth and seventh lens elements to achieve the alleged benefits already present in Baik’s “double gullwing” sixth and seventh lens elements. Here again one would expect some legal authority for such a unique argument, but Motorola does not provide any.

While the PR derides the condition as “creative claim drafting, not actual invention,” the fact remains unrebutted—and indeed admitted—that Baik does not expressly discuss or disclose any way to measure the distance from the optical axis to the critical point on the image-side surfaces of the sixth and seventh lens elements, i.e., Yc62 and Yc72. Baik also cautions against relying on the dimensions of its figures, so no reliable information to be gleaned there either. *See* POPR, 7 (*citing* EX1007, [0051] (“[i]n the drawings, the shapes and dimensions of elements may be exaggerated for clarity”)). And Motorola has not shown a clear teaching in any other reference, beyond measuring drawings that are cautioned as not drawn to scale. Motorola thus has failed to prove that the Examiner materially erred in concluding that “none of the prior art either alone or in combination disclose or teach ... the claimed photographing optical lens assembly specifically including, as the

distinguishing feature(s) in combination with the other limitations, ...

0.5<Yc62/Yc72<1.5.” EX1002, 823.

POSA knowledge. Motorola decided to center its Petition arguments on two single-reference obviousness grounds, both of which fail to disclose Yc62, let alone the missing 0.5<Yc62/Yc72<1.5 element. Motorola resorts to the POSA’s alleged general knowledge for this missing element. The bounds of the POSA’s general knowledge, however, are not co-extensive with the bounds of everything that qualifies as “prior art” under § 102. The PR’s reliance on *Hazeltine* is thus misplaced as Largan does not contend that “secret prior art” under pre-AIA § 102(e) or AIA § 102(a)(2) is not “prior art” under § 103. Rather, the case law makes clear that such secret prior art does not show POSA knowledge because it was not publicly available before the effective filing date. The context-free quotation from *In re Glass* distinguishing the policy goals of § 112 and former § 102(e) is inapposite for the same reason. What is relevant is that *Glass*’s § 112 rationale is directly linked to defining the POSA’s knowledge for purposes of a § 103 analysis; enablement for § 112 purposes is based on what was public before the effective filing date, just as obviousness under § 103 is judged on whether “the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art.” 35 U.S.C. § 103 (emphasis added); *see also In re Glass*, 492 F.2d 1228, 1232 (C.C.P.A. 1974) (“[W]e now rule that application sufficiency under § 112, first

paragraph, must be judged as of its filing date. It is an applicant's obligation to supply enabling disclosure without reliance on what others may publish after he has filed an application on what is supposed to be a completed invention."). Notably, Motorola does not confront the *Sicor* case cited in the POPR, or its citation to *Glass* for the holding that secret prior art, "while ... available for assessing obviousness under 35 U.S.C. § 103 as of its [] effective filing date, **it is not evidence of what was generally known in the art as of that [effective filing] date** and may not be used as of that date to supplement what are otherwise inadequate disclosures or **priority proofs** of others." *Eli Lilly and Co. v. Sicor Pharmaceuticals, Inc.*, 705 F.Supp.2d 971, 996 n. 30 (S.D. Ind. 2010) (emphasis added).

The factual distinction the PR attempts to make is illusory. All but two of the cited references published after the '845 patent's effective filing date, so they are ineffective for establishing what POSAs knew before that date. As for the remaining two references, Motorola cites no authority for the proposition that two references alone can establish what constitutes general POSA knowledge, especially to the "searching" standard required by *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1363 (Fed. Cir. 2016), where the missing $0.5 < Y_{c62}/Y_{c72} < 1.5$ is an important limitation "that is not evidently and indisputably within the common knowledge of those skilled in the art," *id.* (emphasis added).

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Respectfully submitted,

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CERTIFICATE OF SERVICE

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