

No. 2019-1154

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**UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT**

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COLLABO INNOVATIONS, INC.,  
*Appellant*

v.

SONY CORPORATION,  
*Appellee*

UNITED STATES,  
*Intervenor.*

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On Appeal from the United States Patent and Trademark Office,  
Patent Trial and Appeal Board in IPR2017-00958

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**APPELLEE'S RESPONSE TO PETITION FOR  
PANEL REHEARING AND REHEARING EN BANC**

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**CERTIFICATE OF INTEREST**

Pursuant to Federal Circuit Rule 47.4, counsel for Appellee Sony Corporation certifies the following:

1. Full Name of Party Represented by me:

Sony Corporation

2. Name of Real Party in interest (Please only include any real party in interest NOT identified in Question 3) represented by me:

Sony Corporation  
Sony Corporation of America  
Sony Electronics Inc.

3. Parent corporations and publicly held companies that own 10% or more of stock in the party:

None

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court (and who have not or will not enter an appearance in this case):

Jacob Zweig, Zhuanjia Gu, Turner Boyd LLP

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal:

Collabo Innovations, Inc. v. Sony Corp., No. 19-1152 (Fed. Cir.)  
Collabo Innovations, Inc. v. Sony Corporation et al. DED-1-15-cv-01094

Date: May 4, 2020

/s/ Andrew S. Baluch  
Andrew S. Baluch  
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## INTRODUCTION

“A petition for rehearing en banc is rarely appropriate if the appeal was the subject of a nonprecedential opinion by the panel of judges that heard it.” Fed. Cir. Practice Notes to Rule 35. Here, the panel’s nonprecedential opinion applies black-letter law to specific facts. Collabo does not contend that the panel articulated any new rules of law or applied the wrong law. Rather, Collabo disagrees with how the Board and the panel *weighed* the facts and the equities in this case. Pointing to nothing in the panel’s opinion beyond the fact-bound specifics of this case, and demonstrating no clear error of fact or law in the opinion, Collabo has not articulated an adequate basis for rehearing on either of the two issues in its petition.

First, the panel’s decision correctly applied the substantial evidence standard in considering whether to affirm the Board’s finding that a particular limitation in two dependent claims was disclosed in a particular prior art reference. The panel’s decision cites to specific drawings and text in the reference, and cites to specific passages in the expert testimony submitted below, all of which the Board cited and discussed in its lengthy and well-reasoned decision. Collabo’s contrary arguments in its rehearing petition amount to nothing more than an improper attempt on appeal to second-guess the Board’s factual assessment and to reweigh the evidence.

Second, the panel correctly applied the abuse-of-discretion standard in considering whether the Board permissibly enforced its own procedural rules

regarding a party's untimely arguments raised for the first time at the oral hearing. Collabo expressly acquiesced to and applied Sony's and the Board's claim construction of "reflecting walls" in its patent owner response, and then waited until the oral hearing to raise a disagreement with that construction for the first time. But even at that late hour, Collabo could not articulate what its new construction actually required. Collabo finally articulated its new claim construction for the first time in its opening brief on appeal. Unsurprisingly, the panel declined to excuse Collabo's waiver. Collabo's rehearing petition cites no precedent requiring this Court to consider Collabo's belated claim construction.

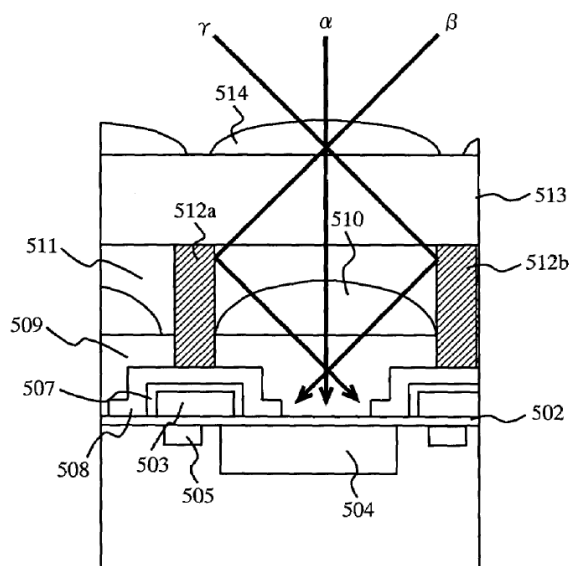
### **BACKGROUND**

U.S. Patent No. 7,023,034 ("the '034 patent") "is generally directed to a 'solid-state imaging device in which a plurality of light-sensitive elements are arranged in a matrix form.'" Op. 3 (quoting '034 patent, 1:7–10). "[T]he '034 patent describes and claims a pair of 'reflecting walls' that exist over each light-sensitive element (such as a photodiode), partitioning each element from neighboring light-sensitive elements." *Id.*

Collabo does not purport that using a pair of "reflective walls" to reflect oblique light onto a photodiode was new. Appx1476 (Collabo's counsel: "I agree that the reflecting walls are part of the prior art and that those reflecting walls existed in prior designs for the purpose of increasing the light sensitivity...."). What the '034

patent purports was innovative was to move the *location* of each pair of “reflecting walls” depending on the position of the photodiode within the device. Appx176, 3:4-18.<sup>1</sup> This displacement-related aspect of the claimed invention is recited in the last two elements of the independent claims. The “reflecting walls” themselves, however, are recited earlier in the body of the claim and are admittedly old. Indeed, the background section of the '034 patent expressly refers to “*reflecting walls 512a and 512b, as shown in FIG. 9,*” labeled as “PRIOR ART” by the '034 patent. Appx175 ('034 patent, 1:57-66) (emphasis added). Figure 9 of the '034 patent is reproduced below.

F I G . 9 PRIOR ART



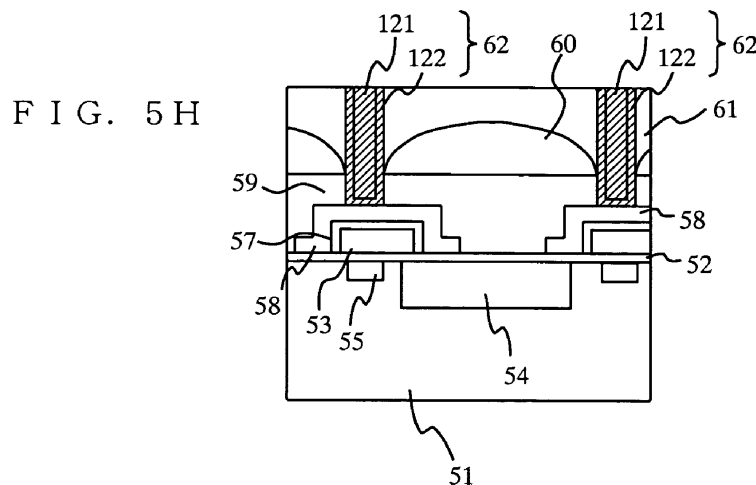
Appx0173 ('034 patent, Fig. 9). As depicted above, the admitted “PRIOR ART” cited in the background section of the '034 patent is Japanese Laid-Open Patent

<sup>1</sup> Appendix citations refer to the joint appendix filed in Appeal No. 19-1152.

Publication No. 2001-77339 (“Kimura”). Appx0175 (’034 patent, 2:1-3). The Board found that Kimura discloses the claimed “reflecting walls” as recited in the independent claims of the ’034 patent. Appx35-39.

The second alleged innovation of the ’034 patent is claimed only in two dependent claims: claims 3 and 12. In these two claims, the reflecting walls have a trapezoidal shape (having a cross section that is a “trapezoid whose upper base is longer than a lower base”), as opposed to a rectangular shape as shown above in the shaded areas 512a and 512b of Figure 9.

Nothing in the ’034 patent requires the reflecting walls to be made of only one material. To the contrary, the ’034 patent explicitly teaches that the reflecting walls can be composed of multiple materials. Figure 5H of the ’034 patent, reproduced below, depicts a reflecting wall made of a cup-shaped metal layer 122 filled with a second material 121.



Appx170 (’034 patent, Fig. 5H). Collabo does not dispute that a trapezoidal



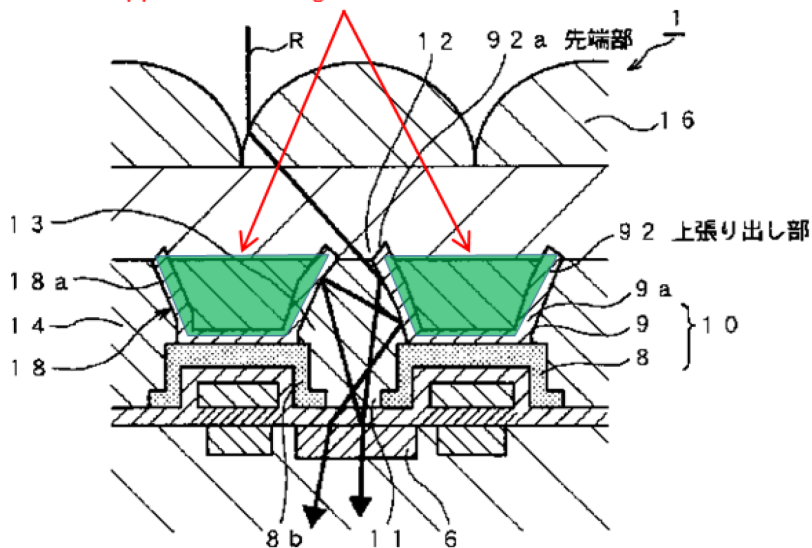
reflecting wall can be made of multiple materials. *See* Oral Arg. at 9:53–10:01, available at [www.cafc.uscourts.gov/oral-argumentrecordings](http://www.cafc.uscourts.gov/oral-argumentrecordings) (“We’re not arguing that you can’t have a trapezoidal reflecting wall that’s made of multiple materials.”).

Sony filed two *inter partes* review petitions against claims 1–18 of the ’034 patent. In its petitions, Sony proposed that the term “reflecting walls” be construed to mean “structures having approximately vertical surfaces that reflect light.” Appx88. For this claim element, Sony argued that the claimed “reflecting walls” were disclosed in the prior art, including Kimura—the same reference discussed in the background section of the ’034 patent as having the admitted “PRIOR ART” structure in Figure 9 of the ’034 patent. Appx98-99. Likewise, for the “trapezoid” recited in dependent claims 3 and 12, Sony argued that this limitation was disclosed in a reference called Abe.<sup>2</sup> Sony included the following annotated Figure 3 of Abe in its petition identifying the trapezoidal cross-section, with green highlighting added:

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<sup>2</sup> JP Pat. Appl. Pub. No. H11-087674.

vertical cross section of the reflecting wall is a trapezoid whose upper base is longer than a lower base



Appx127 (Pet. 53). As shown in Abe’s figure above, a light ray “R” (depicted as a black arrow) enters into the top opening between the pair of reflecting walls and bounces off the surfaces of the walls until the light ray enters the photodiode at the bottom.

The Board instituted Sony’s petitions and adopted Sony’s proposed construction of “reflecting walls,” observing that Collabo, in its preliminary response, “offers no construction” for that term. Appx777. The Board’s institution decision was accompanied by a scheduling order, in bold letters warning Collabo: **“The patent owner is cautioned that any arguments for patentability not raised in the response may be deemed waived.”** Appx815 (emphasis in original).

Collabo filed a patent owner response in which Collabo did not offer its own construction of the term “reflecting walls” but instead expressly applied the Board’s

construction in its analysis. Collabo's response expressly stated: "For the purposes of this proceeding only, **Patent Owner applies the Board's construction** for its analysis, but reserves the right to seek alternative constructions in other proceedings and matters." Appx871 (emphasis added). Collabo's response was accompanied by an expert declaration of Dr. Afromowitz. At his deposition, Dr. Afromowitz was asked whether he disagreed with the Board's construction of the term "reflecting walls," and he testified that "**I merely applied the constructions recommended by the board.**" Appx1262-1263 (emphasis added).

Regarding the trapezoid limitation in dependent claims 3 and 12, Dr. Afromowitz testified about the trapezoidal structures of Abe's Figure 3, highlighted green in Sony's petition, stating: "**The areas highlighted by Petitioner in green in his figure at page 53, a modification of Fig. 3 by Abe, certainly look like trapezoids.**" Appx937 (emphasis added).

An oral hearing was held before the Board on May 9, 2018. For the first time in the entire proceeding, Collabo at the oral hearing argued that the term "reflecting walls" should not be construed as proposed by Sony and as adopted by the Board in its institution decision, but instead should be given its "plain and ordinary" meaning—without further specifying what that might be. Appx1456. When the Board pressed Collabo to explain why it waited until the oral hearing to raise its "plain and ordinary meaning" construction, Collabo's counsel could not do so.

Appx1457-1458. When the Board asked Collabo whether it previously raised any disagreement with the Board's construction, Collabo's counsel admitted, "**Your Honor, no, we did not.**" Appx1462 (emphasis added). When the Board pressed Collabo to articulate what Collabo's "plain and ordinary" construction actually meant, Collabo's counsel could not articulate a construction. Appx1458.

At the oral hearing, the Board also pressed Collabo's counsel to explain why Abe does not disclose a trapezoidal structure as claimed in claims 3 and 12. The colloquy went as follows:

JUDGE McKONE: Your argument is that this is not a trapezoid because the surface does not continue to the top of the structure?

MR. SAAD: Our argument is that it's not a trapezoid because there is no top to the structure. Their trapezoidal structure has no top.

JUDGE McKONE: Because it's a cup, it's not a trapezoid?

MR. SAAD: That's right.

JUDGE McKONE: **There's no other reasons?** That's what we have to consider?

MR. SAAD: **I think that's correct. That's the only consideration necessary,** in our view.

Appx1472 (emphases added).

The Board denied Collabo's request for post-hearing briefing on Collabo's new "plain and ordinary meaning" construction, whatever it might be. Appx1427-1430. The Board explained that Collabo had ample opportunity to argue for an alternative construction in its patent owner response but failed to do so, and that

Collabo never attempted to request additional briefing until the oral argument itself. Appx1429.

The Board issued a final written decision on August 31, 2018. Regarding Collabo's belated new claim construction, the Board explained that "even at the oral hearing, Patent Owner never proposed an alternative express construction for 'reflecting walls,' at most arguing construction is not necessary and that plain and ordinary meaning should be applied." Appx13. The Board also pointed to the scheduling order's requirement that all arguments for patentability must be raised in the patent owner response, and thus concluded that Collabo "expressly or impliedly waived" its new claim construction argument. *Id.* The Board also cited this Court's decision in *Dell Inc. v. Acceleron, LLC*, 884 F.3d 1364, 1369 (Fed. Cir. 2018), where this Court held that the Board was not obligated to consider an "untimely argument . . . raised for the first time during oral argument." Appx0014.

Despite finding that Collabo had waived its claim construction challenge, the Board nevertheless reevaluated its original construction of "reflecting walls" to confirm whether it was still correct in view of the record developed in the proceeding. Appx14. The Board determined that its original construction of "reflecting walls" was the broadest reasonable construction consistent with the specification and prosecution history. Appx16. Applying this construction, the Board ultimately determined that the independent claims were unpatentable.

Appx64. Regarding dependent claims 3 and 12, the Board determined that Abe disclosed reflecting walls whose cross section is a trapezoid, finding “the entire cup shaped structure, including the material within, is the recited ‘reflecting wall.’” Appx47-48. Given that Figure 5 of the ’034 patent shows reflecting walls made of multiple materials, the Board explained that “the claimed ‘reflecting walls’ do not require a ‘uniform composition.’” Appx49-50.

On appeal, a unanimous panel of this Court affirmed the Board’s determination that Collabo had waived its new claim construction of “reflecting wall.” Op. 5-9 (§ II.A). A majority of the panel also affirmed the Board’s finding that Abe discloses the claimed “trapezoid” of dependent claims 3 and 12. Op. 9-16 (§ II.B). The opinion is designated as nonprecedential. Op. 1.

### **REASONS FOR DENYING THE PETITION**

#### **I. The Majority Opinion Correctly Stated and Applied the Substantial Evidence Standard in Affirming the Obviousness of Claims 3 and 12**

Both parties agree that the substantial evidence standard is the applicable standard of review of the Board’s finding that Abe discloses a “trapezoid whose upper base is longer than a lower base” as claimed in dependent claims 3 and 12. Collabo’s Opening Br. 33-34, 49; Sony’s Br. 61-62.

The majority opinion correctly set forth the substantial evidence standard. Op. 9 (“We review the PTAB’s factual findings for substantial evidence and its legal conclusions de novo.”) (quoting *Redline Detection, LLC v. Star Envirotech, Inc.*,

811 F.3d 435, 449 (Fed. Cir. 2015)); *id.* (“Substantial evidence is something less than the weight of the evidence but more than a mere scintilla of evidence. It is such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.”) (quoting *In re NuVasive, Inc.*, 842 F.3d 1376, 1379–80 (Fed. Cir. 2016)); *id.* at 16 (“[O]ur analysis is not whether we agree with [the agency]’s conclusions, nor whether we would have come to the same conclusions reviewing the evidence in the first instance, but only whether [the agency]’s determinations were reasonable.”) (quoting *AK Steel Corp. v. U.S.*, 192 F.3d 1367, 1371 (Fed. Cir. 1999)).

The majority opinion does not announce any new rule of law with respect to court-agency review, nor does Collabo contend as much. Instead, Collabo simply disagrees with the majority’s conclusion that substantial evidence supports the Board’s obviousness determination. Collabo’s disagreement with the majority opinion is merely factual and does not warrant rehearing.

Moreover, the majority opinion is correct on the facts. Collabo’s principal argument in its rehearing petition—that a cup-shaped structure *can* be a trapezoid, but *only if* the material inside is “combined” with the cup (Pet. 2, 10-11)—was never previously made before the Board or this Court. Collabo’s *sole* argument against Abe at the Board was, categorically, because “it’s a cup, it’s not a trapezoid.” Appx1472 ([Q:] “There’s no other reasons? That’s what we have to consider?” [A:]

“That’s the only consideration necessary, in our view.”). The Board expressly found, however, that “the ’034 patent includes the example of Figure 5 in which a wall is formed as a *cup-like structure* 122 filled with another material 121.” Appx50 (citing ’034 patent, 8:26-33) (emphasis added). To this day, Collabo has not disputed this finding by the Board that Figure 5 of the ’034 patent shows a “cup-like structure” made of two different materials and that this structure constitutes a “reflecting wall.” Thus, according to the Board, a “cup-like structure,” made of different materials, can be a trapezoidal reflecting wall, and it need not have a “uniform composition.” Appx47-50.

This Court’s majority opinion agreed with the Board’s finding concerning the ’034 patent’s cup-like structure. As the majority opinion expressly states, “the ’034 patent itself depicts a reflecting wall made of a cup-shaped metal layer filled with a second material.” Op. 14 n.5 (citing ’034 patent, Fig. 5H). Again, Collabo does not dispute this finding regarding Figure 5 in its rehearing petition, and this omission is fatal to Collabo’s argument. If the ’034 patent’s understanding of a reflecting wall can encompass a “cup-like structure” filled with a different material as shown in Figure 5, then it must encompass the prior art Abe reference as well.

The majority opinion also correctly concluded that substantial evidence supported the Board’s finding that the structure identified in Abe was a reflecting wall having “a vertical cross section of the reflecting wall [that] is a trapezoid whose



upper base is longer than a lower base.” Op. 13, 16; Appx47-50. This evidence was in the form of Abe’s disclosure itself and the testimony of Sony’s expert, Mr. Guidash. Appx47 (citing Abe ¶44, corresponding to Appx458 and Guidash Decl. ¶341, corresponding to Appx381). Abe shows the trapezoidal structure in Figure 3, and expressly discloses in ¶44 that “in FIG. 3, the upper extended portions 92 may be extended so as to incline upwardly from the upper ends of the lateral faces 9a of the second light shielding film 9.” Appx458; *see id.* ¶46 (“In producing the second light shielding film 9, . . . contact holes 18 can be formed in the second insulating film 14 so that the lateral faces 18a are tapered”); *see also* Appx992 (Mr. Guidash referring to insulating film 14 as the “top of the structure comprising the reflecting walls” during his deposition).

Finally, Collabo points to no requirement in the claims or in the specification that *all four sides* of the claimed trapezoidal structure of claims 3 and 12 must be made of a reflective material. The only surfaces of the trapezoid that must reflect light, under the Board’s construction of “reflecting walls,” are the two “approximately vertical surfaces.” Appx16. Based on this claim construction and the stated purpose of the “trapezoid” shape disclosed in the specification (’034 patent, 9:16-22), it does not matter whether the *top* surface of Abe’s trapezoid structure is made of an insulating material that transmits light, as Collabo now seems to contend. Pet. 12-13. Had Collabo wanted to claim a trapezoid whose *all four sides* reflect

light, Collabo should have claimed such a structure, or at least proposed such a construction. But Collabo did not do so.

Collabo has not demonstrated any error in the majority's opinion which would warrant rehearing on the "trapezoid" limitation of the two dependent claims.

## **II. The Unanimous Opinion Correctly Stated and Applied the Abuse-of-Discretion Standard in Affirming the Board's Waiver Determination**

The panel was unanimous in affirming the Board's determination that Collabo had waived its new claim construction by raising it too late. Op. 8-9. In reviewing this issue on appeal, the panel applied an abuse-of-discretion standard, as both parties urged the panel to do. *See* Collabo's Reply Br. 14 n.3 ("Collabo agrees with Sony that the Board's finding of waiver is reviewed for abuse of discretion.") (citing Sony's Br. 28-29).

Collabo does not contend that the panel misstated the applicable legal standard or announced any new rule of law with respect to waiver. The opinion correctly cites this Court's precedent, including *Dell Inc. v. Accelaron, LLC*, 884 F.3d 1364, 1369 (Fed. Cir. 2018) (applying abuse of discretion standard to Board's refusal to consider "untimely argument"). Citing *Dell*, the panel explained: "The Board's authority to consider timely arguments, and to find untimely arguments waived, is a matter of compliance with 37 C.F.R. § 42.5 and the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012), which states that '[n]o new evidence or arguments may be presented at the oral argument.'" Op. 6 (citing *Dell*, 884 F.3d at

1369).

Nowhere in its petition does Collabo address this Court's *Dell* decision or the Board's procedural rules prohibiting new arguments raised for the first time at the oral hearing. To this day, Collabo has never explained why it chose to acquiesce to the Board's construction in its patent owner response and then wait until the eleventh hour to register any sort of disagreement with the construction at the oral hearing. As the Board found, "even at the oral hearing, Patent Owner never proposed an alternative express construction for 'reflecting walls,' at most arguing construction is not necessary and that plain and ordinary meaning should be applied." Appx13. When asked point-blank what its "plain and ordinary meaning" even meant, Collabo's counsel could not articulate a definition. Appx14 ("At the oral hearing, Patent Owner did not explain sufficiently how we should apply the plain and ordinary meaning."). Collabo does not challenge these factual findings.

The standard of review, as discussed above, is abuse of discretion, and Collabo has identified no precedent *requiring* the Board or the Federal Circuit to consider a party's new claim construction advanced for the first time at the oral hearing or on appeal. To the contrary, far from requiring consideration of a party's belated argument, *Dell* holds that "[u]nless [the Board] chose to exercise its waiver authority under 37 C.F.R § 42.5(b), the Board was obligated to dismiss [a party's] untimely argument given that the untimely argument in this case was raised for the

first time during oral argument.” 884 F.3d at 1369.

Collabo identifies no conflict between the unanimous panel’s opinion and this Court’s or the Supreme Court’s precedents. To this end, Collabo’s petition relies on three cases not previously cited to the panel: *Norsk Hydro Can., Inc. v. United States*, 472 F.3d 1347 (Fed. Cir. 2006), *Nelson v. Adams USA, Inc.*, 529 U.S. 460 (2000), and *Lebron v. Nat’l R.R. Passenger Corp.*, 513 U.S. 374 (1995). None of those cases involves patent claim construction. And more importantly, none of those cases stands for the proposition that an appellate court is *required* to address a party’s new argument on appeal.

*Norsk* involved the interpretation of a statute by the Court of International Trade. 472 F.3d at 1359. This Court concluded it was proper for this Court to construe the statute for the purpose of resolving the issue on appeal, explaining that “preserving an issue for appeal does not require ‘the incantation of particular words; rather, it requires that the lower court be fairly put on notice as to the substance of the issue.’” *Id.* (quoting *Consolidation Coal v. United States*, 351 F.3d 1374, 1378 (Fed. Cir. 2003)). There is no indication that the appellants in *Norsk* had previously “acquiesced to” and “expressly applied” the trial court’s prior construction of the statute, similar to how “Collabo acquiesced to Sony and the Board’s construction, and expressly applied that construction in its analysis.” Op. 8. Moreover, as the Board found, Collabo’s claim construction position below was “ambiguous and does

not provide ‘adequate notice,’” thus further distinguishing this case from *Norsk*. Appx14 (quoting *Pub. Serv. Comm’n of Ky. v. FERC*, 397 F.3d 1004, 1012 (D.C. Cir. 2005) (Roberts, J.)).

*Nelson* involved a constitutional due process challenge in a writ of certiorari to the Supreme Court. 529 U.S. at 469. *Nelson* merely confirms the Supreme Court’s practice of permitting review on certiorari of an issue that had been “considered and passed upon by the court below.” *Id.* at 470. Issue preservation, according the Court, “requires that the lower court be fairly put on notice as to the substance of the issue.” *Id.* at 469. But here again, Collabo’s claim construction below “was ambiguous” and did “not provide ‘adequate notice’” to the Board. Appx14 (quoting *Pub. Serv. Comm’n of Ky.*, 397 F.3d at 1012).

*Lebron* likewise involved a constitutional challenge at the Supreme Court. 513 U.S. at 378. The petitioner had argued consistently below that Amtrak had violated his First Amendment rights. Although the petitioner had argued below that Amtrak was subject to constitutional constraints as a private entity, the petitioner raised an alternative argument, after certiorari was granted, arguing that Amtrak itself was a federal entity. The Court went ahead and considered the alternative argument because the Court held that this was not a new claim but a new argument in support of his original claim that Amtrak had violated his First Amendment rights. *Id.* at 379. Here, by contrast, Collabo acquiesced to the Board’s construction and never staked

out a position of its own on the meaning of “reflecting walls,” and was unable to articulate its own construction when asked to do so. Appx13-14; Appx1458.

Finally, this Court’s decision in *Interactive Gift Express, Inc. v. CompuServe Inc.*, 256 F.3d 1323, 1347 (Fed. Cir. 2001), held that “arguments that are based on a specification in evidence and that are *in support of an existing claim construction* are not barred by the doctrine of waiver for the sole reason that they were not first presented to the trial court.” (emphasis added). Again, Collabo never staked out a claim construction below, so Collabo had no “existing claim construction” to support on appeal with new arguments based on the specification.

### CONCLUSION

For the foregoing reasons, rehearing and rehearing en banc should be denied.

Date: May 4, 2020

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**CERTIFICATE OF COMPLIANCE**

1. This brief complies with the type-volume limitation of Federal Circuit Rule 32(a) because this brief contains 3,889 words, excluding the parts of the brief exempted by Fed. R. App. P. 32(f).

2. This brief complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. P. 32(a)(6) because this brief has been prepared in a proportionally spaced typeface using Microsoft Word in 14 point Times New Roman.

Date: May 4, 2020

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**CERTIFICATE OF SERVICE**

I hereby certify that on May 4, 2020, I electronically filed the foregoing brief with the Clerk of the Court of the United States Court of Appeals for the Federal Circuit using the Appellate CM/ECF system.

Accordingly, I certify that all participants in this case that have appeared as CM/ECF users shall be served by the Appellate CM/ECF system.

/s/ Andrew S. Baluch  
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