

No. 2020-1425

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**United States Court of Appeals  
for the Federal Circuit**

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COREPHOTONICS, LTD.,

*Appellant,*

APPLE INC.,

*Appellee,*

ANDREW HIRSHFELD, PERFORMING THE FUNCTIONS AND  
DUTIES OF THE UNDER SECRETARY OF COMMERCE FOR  
INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED  
STATES PATENT AND TRADEMARK OFFICE,

*Intervenor.*

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Appeal from the United States Patent and Trademark Office, Patent Trial and  
Appeal Board, in No. IPR2018-01133.

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**APPELLANT'S COMBINED PETITION FOR PANEL  
REHEARING AND REHEARING *EN BANC***

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Corrected on  
November 17, 2021

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UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT

CERTIFICATE OF INTEREST

**Case Number** 2020-1425  
**Short Case Caption** COREPHOTONICS, LTD. v. APPLE INC.  
**Filing Party/Entity** COREPHOTONICS, LTD.

**Instructions:** Complete each section of the form. In answering items 2 and 3, be specific as to which represented entities the answers apply; lack of specificity may result in non-compliance. **Please enter only one item per box; attach additional pages as needed and check the relevant box.** Counsel must immediately file an amended Certificate of Interest if information changes. Fed. Cir. R. 47.4(b).

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: 11/17/2021

Signature: /s/ Robert J. Gajarsa

Name: Robert J. Gajarsa

<b>1. Represented Entities.</b> Fed. Cir. R. 47.4(a)(1).	<b>2. Real Party in Interest.</b> Fed. Cir. R. 47.4(a)(2).	<b>3. Parent Corporations and Stockholders.</b> Fed. Cir. R. 47.4(a)(3).
Provide the full names of all entities represented by undersigned counsel in this case.	Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.  <input checked="" type="checkbox"/> None/Not Applicable	Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.  <input type="checkbox"/> None/Not Applicable
Corephotonics, Ltd.		Samsung Electronics Benelux B.V.

Additional pages attached

**4. Legal Representatives.** List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

None/Not Applicable  Additional pages attached

Reza Mirzaie of Russ August & Kabat	C. Jay Chung, formerly of Russ August & Kabat	James S. Tsuei of Russ August & Kabat
Bahrad A. Sokhansanj, formerly of Russ August & Kabat		

**5. Related Cases.** Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. Do not include the originating case number(s) for this case. Fed. Cir. R. 47.4(a)(5). See also Fed. Cir. R. 47.5(b).

None/Not Applicable  Additional pages attached

Corephotronics, Ltd. v. Apple Inc., Case No. 20-1424 (Fed. Cir.)	Corephotronics, Ltd. v. Apple Inc., Case No. 5:17-cv-06457-LHK (N.D. Cal.)	Corephotronics, Ltd. v. Apple Inc., Case No. 20-1961 (Fed. Cir.)

**6. Organizational Victims and Bankruptcy Cases.** Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

None/Not Applicable  Additional pages attached


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**FCR RULE 35(b) STATEMENT OF COUNSEL**

Based on my professional judgment, I believe the panel decision is contrary to at least the following decision of the Supreme Court of the United States: *United States v. Arthrex, Inc.*, 141 S. Ct. 1970 (2021).

/s/ Robert J. Gajarsa  
ATTORNEY OF RECORD  
FOR APPELLANT

**FRAP 40(a)(2) AND FCR 35(e)(1)(F) STATEMENT OF POINTS OF LAW  
OR FACT THE COURT OVERLOOKED OR MISAPPREHENDED**

The Director Review by a principal officer required by the Supreme Court's *Arthrex* opinion was never performed below or made available to Corephotonics. The Board's decision in the IPR here thus still violates the Appointments Clause and requires withdrawing the Court's opinion and remanding to the PTO.

## **I. INTRODUCTION**

The review of the Board’s decision in the IPR here conducted by Commissioner Andrew Hirshfeld after the Court’s limited remand was not the constitutionally required Director Review mandated by *United States v. Arthrex, Inc.*, 141 S. Ct. 1970 (2021). In *Arthrex*, the Supreme Court held that “[o]nly an officer properly appointed to a principal office may issue a final decision binding the Executive Branch in [an IPR] proceeding.” *Id.* at 1985-86. Commissioner Hirshfeld is not such an officer—he was appointed by the Secretary of Commerce, not the President. Nor is Commissioner Hirshfeld even “acting” as the PTO Director—he is only “performing the functions and duties of” the Director, as the caption in this case reflects (and doing so in violation of the Federal Vacancies Reform Act). Accordingly, in light of the continuing Appointments Clause violation, there was not—and there still is not—a “final decision” of the PTO in the IPR here for the Court to review. The Court’s opinion on the merits of that non-final decision should therefore be withdrawn and the case remanded for a properly appointed Director to conduct the Director Review that Corephotonics timely requested below.

## **II. BACKGROUND**

Corephotonics timely argued in its opening brief (and again in reply), that the Board’s decision in the IPR here had to be vacated pursuant to the Appointments

Clause. *See* ECF No. 25 at 14-26; ECF No. 37 at 2-10. In its opinion here, the Court disagreed, holding that this Court's *Arthrex* opinion inoculated any potential Appointments Clause violation because it was issued prior to the Board's decision and instantly made APJs removable at will. *Corephotonics, Ltd. v. Apple Inc.*, 857 F. App'x 641, 643 (Fed. Cir. 2021).

After the Supreme Court's *Arthrex* decision (and before the time for rehearing expired), the Court stayed this appeal and invited briefing on how to proceed. ECF No. 64 at 2. Corephotonics responded that the Supreme Court's opinion required vacatur of the Court's opinion because it made clear that the Appointments Clause violation here still existed at the time of the Board's decision and that there would be no ripe and final agency decision within this Court's appellate jurisdiction until a properly appointed Director had the opportunity to review (and thus finalize) the Board's decision. ECF No. 65 at 2-3. Appellee Apple argued, *inter alia*, that the Director could conduct Director Review immediately, even absent remand, and that the finality of the Board's decision was not affected by the absence of such review. ECF No. 66 at 5-9. And, in relevant part, the PTO argued that the case should be remanded for the limited purpose of requesting Director Review while the Court retained jurisdiction over it and that objections to a non-principal officer conducting that review be raised after remand. ECF No. 67 at 2-4.

The Court agreed with the PTO and ordered a “limited purpose” remand to allow Corephotonics “the opportunity to request Director rehearing” within 30 days. ECF No. 68 at 2. Pursuant to that order, Corephotonics filed a timely request for rehearing by the Director, raising a dispositive violation of this Court’s precedent and the Administrative Procedure Act (“APA”) by the APJs in this case (a legal error for which it would have been a clear abuse of discretion—and attendant secondary violation of the APA—by the Director not to correct upon review). *See* SAppx7-16. Over Corephotonics’s continued objection (*see* SAppx17), that review was summarily denied by Commissioner Hirshfeld, who was purportedly “performing the functions and duties” of the Director. SAppx1-2; *see also, e.g.*, ECF No. 68 at 1; *U.S. Patent & Trademark Office, Drew Hirshfeld*, <https://www.uspto.gov/about-us/executive-biographies/drew-hirshfeld>.

Following Commissioner Hirshfeld’s denial, the Court ordered any rehearing petition to be filed by November 16, 2021. ECF No. 70 at 2.

### **III. ARGUMENT**

#### **A. The Appointments Clause Violation Here Was Never Remedied**

“Decisions by APJs must be subject to review by the Director” of the PTO because “[o]nly an officer properly appointed to a principal office may issue a final decision binding the Executive Branch in [an IPR] proceeding.” *Arthrex*, 141 S. Ct. at 1985-86. That is consistent with “the traditional rule that a principal officer, if

not the President himself, makes the final decision on how to exercise executive power,” particularly “[w]hen it comes to the patent system.” *Id.* at 1984. Accordingly, “[a]lthough the APJs’ appointment by the Secretary allowed them to lawfully adjudicate the petition in the first instance, they lacked the power under the Constitution to finally resolve the matter within the Executive Branch.” *Id.* at 1987 (citation omitted).

The Supreme Court’s teaching in *Arthrex* was thus unequivocal: the Constitution requires that APJs’ “first instance” decisions in IPRs be subject to plenary review by an Executive Branch officer “properly appointed to a principal office”—the Director of the PTO. *Id.* at 1986-87. As Corephotonics timely argued in its opening brief (and again in reply), that never happened here. *See* ECF No. 25 at 14-26; ECF No. 37 at 2-10. Nor did it happen after the Supreme Court’s *Arthrex* decision during the limited purpose remand the Court ordered here.

Corephotonics timely (and meritorious) request for Director Review was considered and denied by Commissioner Hirshfeld. Regardless of whether Commissioner Hirshfeld is a principal constitutional officer or not (he is not), he was not “properly appointed” as one by the President with advice and consent of the Senate. 35 U.S.C. § 3(b)(2) (Commissioner of Patents is appointed by Secretary of Commerce); *see Arthrex*, 141 S. Ct. at 1986 (whether presented in context of a principal officer not properly appointed or an inferior officer exceeding permissible

scope of duty, “both formulations describe the same constitutional violation” of the Appointments Clause).

Whether Commissioner Hirschfeld could conduct a review if he were “Acting Director” of the PTO is also irrelevant. There was a passing reference to the “appropriate remedy” being “remand to the Acting Director” in Chief Justice Roberts’s opinion in *Arthrex*. 141 S. Ct. at 1987. But that reference came in Part III of the Chief Justice’s opinion, a portion joined by only three other Justices, which means it is not part of the Court’s opinion. *See id.* at 1972. And the remedy only gained a majority vote with Justice Breyer’s concurrence in the judgment, which also made clear that (i) “any remedy should be tailored to the constitutional violation” and that (ii) under the majority’s construct, there was a violation “only because the APJ’s decisions are not reviewable by *the Director* alone.” *Id.* at 1997 (Breyer, J., concurring in the judgment in part and dissenting in part) (emphasis added). And even if that passing reference to “Acting Director” were to be considered part of the Court’s opinion, it could not displace the clear teaching of the Court’s repeated directive that “the Director” (not “Acting Director”) must conduct the necessary review as a properly appointed principal officer. *See id.* at 1984-86. Indeed, immediately following the reference to “Acting Director,” Part III of Chief Justice Roberts’s opinion unequivocally stated that “a limited remand *to the Director* provides an adequate opportunity for review by a principal officer.” *Id.* at 1987-88

(emphasis added). Commissioner Hirschfeld is not a properly appointed principal officer (i.e., the Director), regardless of “Acting” status or not.<sup>1</sup>

Commissioner Hirschfeld also is not an “Acting Director” of the PTO in any event. He is only “performing the functions and duties” of the Director. ECF No. 68 at 1; *see also U.S. Patent & Trademark Office, Drew Hirshfeld*, <https://www.uspto.gov/about-us/executive-biographies/drew-hirshfeld>. Thus, there can be no doubt that Commissioner Hirshfeld lacked the requisite constitutional authority to perform the Director Review required here under *Arthrex*. In addition, even if that were not the case (it is), any review conducted by Commissioner Hirshfeld in that capacity on behalf of the Director’s Office violated the Federal Vacancies Reform Act (“FVRA”) because he was not expressly directed to perform those duties by the President and has been performing those functions and duties for longer than 210 days. *See* 5 U.S.C. § 3345(a)(3) (unless a “first assistant” to a vacant PAS office—which Commissioner Hirschfeld is not, *see* 35 U.S.C. § 3(b)(1)—“the President (and only the President)” may direct another officer or employee to perform functions and duties of that office); 5 U.S.C. § 3346(a); *Guedes v. Bureau of Alcohol, Tobacco, Firearms*, 920 F.3d 1, 11 (D.C. Cir. 2019) (addressing FVRA

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<sup>1</sup> Apple previously argued that any issue relating to Director Hirshfeld should have been raised when he appeared in this case in January of this year. ECF No. 66 at 10. But Corephotonics could not have then challenged the unknown conditions of a purported Director Review that would be conducted eight months later after opinions by this Court and the Supreme Court and newly issued guidance by the PTO.

requirements); *LM-M v. Cuccinelli*, 442 F. Supp. 3d 1, 36 (D.D.C. 2020) (enforcement of rules promulgated under an interim officer performing “functions and duties” must await properly appointed principal officer).

Accordingly, there never was the required Director Review of the Board’s IPR decision in this case, as mandated by the Supreme Court’s *Arthrex* decision. The Appointments Clause violation here thus still stands.

**B. This Case Should Be Remanded For A Properly Appointed Director To Conduct The Required Director Review**

Because the constitutionally necessary Director Review was never conducted (or ever made available to Corephotonics), the panel’s opinion should be withdrawn and the case remanded to the PTO so that the required Director Review can be conducted by “an officer properly appointed to a principal office.” *Arthrex*, 141 S. Ct. at 1985. At minimum, the Court should follow the path it previously set forth for such remands—a limited remand while retaining jurisdiction. But it should instead vacate the opinion in this appeal and remand in full for the limited purpose of allowing proper Director Review.

Whether proceeding pursuant to a specific statutory review scheme established by Congress or the APA, final agency action is required to invoke a court’s jurisdiction over the underlying merits of an agency’s decision. *See Ashford Univ., LLC v. Sec’y of Veterans Affs.*, 951 F.3d 1332, 1343-46 (Fed. Cir. 2020) (holding that the Supreme Court has long “recognized that a finality requirement is

inherent in agency judicial review provisions generally,” discussing case law, and applying same standard) (citing *Federal Power Commission v. Metropolitan Edison Co.*, 304 U.S. 375, 383-84 (1938)); *see also, e.g.*, 5 U.S.C. § 704 (actions “made reviewable by statute and final agency action for which there is no other adequate remedy in a court are subject to judicial review”); *Weinberger v. Salfi*, 422 U.S. 749, 765 (1975) (teaching that “doctrine of administrative exhaustion should be applied with a regard for the particular administrative scheme at issue” and applying “final decision” requirement in statute at issue as “statutorily specified jurisdictional prerequisite”).

Here, Congress statutorily permitted review of only a “*final* written decision” of the Board on behalf of the PTO, and the Supreme Court’s holding in *Arthrex* was unequivocal: “[o]nly an officer properly appointed to a principal office”—i.e., the Director—“may issue a *final* decision binding the Executive Branch in the [IPR] proceeding before us.” 35 U.S.C. § 141(c) (emphasis added);<sup>2</sup> 141 S. Ct. at 1985

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<sup>2</sup> Some have argued or implied that this statute confirms the Board may issue final decisions that are judicially reviewable on their merits. Apple, for instance, has argued that it would be “absurd” to believe that the lack of Director Review or its availability could “retroactively render an earlier Final Written Decision un-final” in the jurisdictional sense because that would mean “the Supreme Court lacked jurisdiction to issue *Arthrex* in the first place.” ECF No. 66 at 8-9. But a court’s jurisdiction to determine whether agency action is unconstitutional and non-final is distinct from its jurisdiction to address the underlying merits of a constitutionally non-final agency decision. Such interlocutory review of non-final agency action is inconsistent with precedent. *See, e.g., Ashford Univ.*, 951 F.3d at 1343-46. And, in

(emphasis added). As the Supreme Court explained, that was particularly important to the IPR statutory construct because, “[w]hen it comes to the patent system in particular, adjudication has followed the traditional rule that a principal officer, if not the President himself, makes the *final* decision on how to exercise executive power.” *Arthrex*, 141 S. Ct. at 1984 (emphasis added).

Thus, while the Board’s decision in this case is labeled a “Final Written Decision,” it was not the agency’s actual final, reviewable decision in the IPR. Only the Director, as a properly appointed principal officer, could have transformed the Board’s initial decision into such a decision reviewable on the merits. As Chief Justice Roberts’s opinion explains, while “the APJs’ appointment by the Secretary allowed them to lawfully adjudicate the [IPR] petition *in the first instance*, they lacked the power under the Constitution to *finally* resolve the matter within the Executive Branch.” *Id.* at 1987 (citation omitted) (emphasis added).

Accordingly, in light of the clear directive and teaching in *Arthrex*, there was not—and still is not—a final agency decision here to invoke this Court’s jurisdiction over the underlying merits of the Board’s “first instance” decision. The Court’s opinion in this appeal (which reaches the merits) should therefore be withdrawn and remand should be ordered for a properly appointed Director to conduct the Director

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context, it is clear that Congress had intended in that statute (incorrectly under the Appointments Clause) that the Board would be issuing final agency decisions on behalf of the PTO.

Review Corephotonics requested. And that remand should end this appeal, just like in any case where agency action is insufficient to permit proper judicial review. The reference to that remand being “limited” in *Arthrex* only meant, in context, that “a hearing before a new panel of APJs” was not required. 141 S. Ct. at 1987-88. It did not surreptitiously displace the bedrock principal of administrative law that “[t]he task of the reviewing court” in an appeal from a decision by a coordinate Executive Branch agency “is to apply the appropriate ... standard of review to the agency decision *based on the record the agency presents to the reviewing court.*” *Fla. Power & Light Co. v. Lorion*, 470 U.S. 729, 744 (1985) (emphasis added). Such review begins and ends on the administrative record as it was first presented. The agency cannot develop that record further and correct a constitutional infirmity with a new adjudication on the merits while a reviewing court retains jurisdiction over an original non-reviewable decision, maintains its opinion addressing the merits of that decision, and then potentially adjudicates the case anew based on that new administrative record (particularly when an appellant—like Corephotonics here—has not had a full opportunity to challenge the propriety of that new adjudication).

None of the authority that the PTO has cited in this case teaches otherwise. *See* ECF 67 at 2-3. Federal Rule of Appellate Procedure 12.1, for instance, concerns limited remands to district courts, not agencies, while an appellate court retains jurisdiction, and there is no corresponding rule authorizing such remands to

agencies. *Windy City* (decided before Rule 12.1 existed) and *Hyatt* likewise concerned such limited remands *to district courts*. See *Hyatt v. Hirshfeld*, 998 F.3d 1347, 1371 (Fed. Cir. 2021); *Windy City Innovations, LLC v. Am. Online, Inc.*, 217 F. App'x 980, 980 (Fed. Cir. 2007). *Agility Logistics* was an unpublished order retaining jurisdiction while directing an agency contract appeal board to determine the actual party-in-interest before that board, akin to the statutory advisory opinions Congress expressly authorized such boards to provide to district courts in similar circumstances. *Agility Logistics Servs. Co. KSC v. Carter*, No. 2015-1555, 2016 WL 11110465, at \*1-2 (Fed. Cir. Mar. 10, 2016); see 41 U.S.C. § 7107(f); 28 U.S.C. § 1295(a)(10) (review pursuant to § 7107). And while *Cumming* and *Escobosa* were two unpublished orders concerning interlocutory limited remands to the PTO, they merely allowed for entry of undisputed terminal disclaimers, which could have been entered at any time regardless of any pending Article III case. See *In re Cumming*, No. 18-2307, ECF No. 24 (Fed. Cir. March 28, 2019); *In re Escobosa*, No. 18-2259, ECF No. 20 (Fed. Cir. Jan. 30, 2019); *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005). As for the *Wella A.G.* cases, they teach that remand to address a limited or narrow issue is properly effected by ordinary remand to the agency, which, upon further action by that agency, requires a new appeal in due

course to address those new actions and the new administrative record.<sup>3</sup> See *In re Wella A.G.*, 858 F.2d 725, 729 (Fed. Cir. 1988) (Appeal No. 88-1150); *In re Wella A.G.*, 787 F.2d 1549, 1553 (Fed. Cir. 1986) (Appeal No. 85-2397).<sup>4</sup>

Put simply, the process that must be conducted on remand here is what provides finality to the Board's initial decision in the first instance, and that process is not mere ministerial procedure—it includes a new decision expanding the adjudication on the underlying merits of the case. And that new adjudication on a new administrative record, as shown in this instance, can be made erroneously and itself require further review, which must be conducted anew. Perhaps that is not the most efficient process, but Supreme Court precedent and the Constitution require it.

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<sup>3</sup> Accordingly, Corephotonics has filed both an amended notice of appeal of the board's decision and a new notice of appeal of that decision following the purported Director Review conducted by Commissioner Hirshfeld here.

<sup>4</sup> Perhaps the closest corollary would be limited remands in context of the Social Security Act, but the "Social Security Act and the APA are different statutes and courts must remain sensitive to their differences"—"[a]s provisions for judicial review of agency action go," the Social Security Act permits "a degree of direct interaction between a federal court and an administrative agency alien to APA review." *Smith v. Berryhill*, 139 S. Ct. 1765, 1776 (2019) (internal quotation marks omitted) (citing *Sullivan v. Hudson*, 490 U.S. 877, 885 (1989)).

#### IV. CONCLUSION

Rehearing by the panel or the Court *en banc* should be granted, the panel's opinion withdrawn, and the case remanded for the requested Director Review to be conducted by a properly appointed principal officer.

November 17, 2021

Respectfully submitted,

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**ADDENDUM PURSUANT TO  
FEDERAL CIRCUIT RULE 35(e)(1)(H)**

NOTE: This disposition is nonprecedential.

**United States Court of Appeals  
for the Federal Circuit**

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**COREPHOTONICS, LTD.,**  
*Appellant*

v.

**APPLE INC.,**  
*Appellee*

**ANDREW HIRSHFELD, PERFORMING THE  
FUNCTIONS AND DUTIES OF THE UNDER  
SECRETARY OF COMMERCE FOR  
INTELLECTUAL PROPERTY AND DIRECTOR OF  
THE UNITED STATES PATENT AND TRADEMARK  
OFFICE,**  
*Intervenor*

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2020-1425

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Appeal from the United States Patent and Trademark  
Office, Patent Trial and Appeal Board in No. IPR2018-  
01133.

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Decided: May 20, 2021

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MAUREEN DONOVAN QUELER, Office of the Solicitor, United States Patent and Trademark Office, Alexandria, VA, for intervenor. Also represented by MICHAEL S. FORMAN, THOMAS W. KRAUSE, FARHEENA YASMEEN RASHEED.

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Before NEWMAN, REYNA, and TARANTO, *Circuit Judges*.

REYNA, *Circuit Judge*.

Corephotonics, Ltd. appeals a final written decision of the Patent Trial and Appeal Board in an inter partes review brought by Apple Inc. Corephotonics argues that the Board issued its decision in violation of the Appointments Clause because the Board's decision came after this court's decision in *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320, 1335 (Fed. Cir. 2019) but before this court issued its mandate. On this basis, Corephotonics argues that the Board's decision should be vacated and remanded. On the merits, Corephotonics argues that substantial evidence does not support the Board's findings as to patentability. Because we determine that the Board issued its decision after this court's decision in *Arthrex* we decline to vacate and remand the Board's decision underlying this appeal. Moreover, because substantial evidence supports the Board's patentability determination, we affirm.

#### BACKGROUND

On May 22, 2018, Apple Inc. ("Apple") filed a petition for inter partes review at the Patent Trial and Appeal Board ("Board"), asserting that claims 1–4 of U.S. Patent

COREPHOTONICS, LTD. v. APPLE INC.

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No. 9,538,152 (the “152 patent”) would have been obvious over U.S. Patent Publication No. 2008/0030592 to Border et al. (“Border”) in view of U.S. Patent No. 7,859,588 to Parulski et al. (“Parulski”). J.A. 102.

The ’152 patent is directed to a “multi-aperture imaging system comprising a first camera with a first sensor that captures a first image and a second camera with a second sensor that captures a second image.” ’152 patent, Abstract. The ’152 patent discloses a dual-aperture camera used to capture synchronous images from both a wide-angle lens and a miniature telephoto lens with higher resolution in a narrower field. *Id.*, col. 2, ll. 30–43; *see also id.* col. 2 l. 64–col. 3 l. 10. A “different magnification image of the same scene is grabbed by each subset, resulting in field of view (FOV) overlap between the two subsets.” ’152 patent at col. 3 ll. 11–14. The wide-angle and telephoto images are then fused to output one combined image. *Id.* at col. 3 ll. 11–24.

The claims of the ’152 patent require a processor configured to “register the overlap area” of a “second image as non-primary image” to a “first image as primary image to obtain the output image,” where the output image must be from either the “point of view of the first camera” or the “point of the view of the second camera.” *Id.* at col. 13 ll. 5–17. The image registration enables the “output image point of view” to be “determined according to the primary image point of view (camera angle).” *Id.* at col. 9 ll. 26–29. As a result of this image registration process, “the point of view of the output image is that of the first camera,” if the field of view, or FOV, of the second camera (2) is less than the FOV of the first camera (1) based on a zoom factor (ZF) input, or if  $FOV_2 < FOV_{ZF} < FOV_1$ . *Id.* at col. 13 ll. 8–11.<sup>1</sup>

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<sup>1</sup> The patent further explains how the first or second image become the primary image as follows: the “choice of the Wide image or the Tele image as the primary and

Specifically, the representative asserted claims of the '152 patent recite:

1. A multi-aperture imaging system comprising:

a) a first camera that provides a first image, the first camera having a first field of view ( $FOV_1$ ) and a first sensor with a first plurality of sensor pixels covered at least in part with a standard color filter array (CFA);

b) a second camera that provides a second image, the second camera having a second field of view ( $FOV_2$ ) such that  $FOV_2 < FOV_1$  and a second sensor with a second plurality of sensor pixels, the second plurality of sensor pixels being either Clear or covered with a standard CFA, the second image having an overlap area with the first image; and

c) a processor configured to provide an output image from a point of view of the first camera based on a zoom factor (ZF) input that defines a respective field of view ( $FOV_{ZF}$ ), the first image being a primary image and the second image being a non-primary image, **wherein if  $FOV_2 < FOV_{ZF} < FOV_1$  then the point of view of the output image is that of the first camera**, the processor further configured to register the overlap area of the

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auxiliary images is based on the ZF chosen for the output image. If the chosen ZF is larger than the ratio between the focal-lengths of the Tele and Wide cameras, the Tele image is set to be the primary image and the Wide image is set to be the auxiliary image. If the chosen ZF is smaller than or equal to the ratio between the focal-lengths of the Tele and Wide cameras, the Wide image is set to be the primary image and the Tele image is set to be the auxiliary image.” '152 patent col. 9 ll. 33–40.

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second image as non-primary image to the first image as primary image to obtain the output image.

2. The multi-aperture imaging system of claim 1, wherein, if  $FOV_2 \geq FOV_{ZF}$ , then the processor is further configured to provide an output image from a point of view of the second camera.

'152 patent col. 12 l. 59–col. 13 l. 17 (emphasis added).<sup>2</sup>

The Board issued its final written decision on December 2, 2019, concluding that all challenged claims are unpatentable as obvious. J.A. 1–33; *see also Apple Inc. v. Corephotonics Ltd.*, IPR2018-01133, 2019 WL6523190 (P.T.A.B. Dec. 2, 2019). Of particular importance to the merits of this appeal, the Board found that the Border reference disclosed the limitation “the point of view of the output image is that of the first camera” appearing in claim 1. J.A. 24.

Corephotonics appeals. This court has jurisdiction pursuant to 28 U.S.C. § 1295(a)(4)(A).

#### DISCUSSION

This court reviews the Board’s factual determinations for substantial evidence and its legal determinations de novo. *In re Stepan Co.*, 868 F.3d 1342, 1345 (Fed. Cir. 2017). Obviousness is a question of law based on subsidiary findings of fact. *Id.*

#### I

Before reaching the merits, we address Corephotonics, Ltd.’s (“Corephotonics”) initial argument. Corephotonics argues that the Board’s decision was issued in violation of the Appointments Clause because the Board issued its

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<sup>2</sup> Claims 3 and 4 parallel the limitations of claims 1 and 2, but are method claims rather than system claims. '152 patent col. 13 l. 18–col. 14 l. 22.

final written decision on December 2, 2019, which was after this court's decision in *Arthrex*, but before the associated mandate was issued. Specifically, Corephotonics contends that only the mandate in *Arthrex* would have ordered compliance by the agency to this court's opinion in *Arthrex*.

In *Caterpillar*, this court determined that final written decisions issued by the Board after the *Arthrex* decision do not require a remand because they do not implicate the Appointments Clause issues raised in *Arthrex*. See *Caterpillar Paving Prods. Inc. v. Wirtgen Am., Inc.*, 957 F.3d 1342, 1343 (Fed. Cir. 2020) (denying a motion to vacate and remand based on *Arthrex* where the Board's decision issued in November 2019, after the opinion in *Arthrex*). While the appellant in *Caterpillar* may not have raised the specific argument regarding the mandate implication that Corephotonics raises here, we see no reason to depart from our holding in *Caterpillar* for purposes of resolving this appeal. Accordingly, we decline to vacate the Board's decision and remand to the Board.

## II

As to the merits of its appeal, Corephotonics argues that substantial evidence does not support the Board's finding because Border does not teach providing "an output image from a point of view of the first camera," as required by the claims. '152 patent col. 13 ll. 5–6. Instead, Corephotonics contends that Border teaches stitching two images together to provide a composite image with portions from the point of view of the first camera and other portions from the point of view of the second camera. Appellant's Br. 1–2, 13. In other words, Border's teaching produces a composite image with parts having two different points of view, not an image with the "point of view of the first camera." *Id.*

The Board concluded that Border's express disclosure of transforming coordinates from the telephoto to the wide-

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angle image, along with the testimony of Apple’s expert, Dr. Oliver Cossairt, is sufficient to meet the limitation. J.A. 24. We agree. Specifically, Border states that it “transforms the coordinates of the telephoto image 206 to the wide image 204.” Border at ¶ 38 (J.A. 694). In addition, Dr. Cossairt testified that transforming the coordinates has the effect of making the telephoto portion of the composite image have the same point of view as the wide image. J.A. 19; *see also* J.A. 651–52 (Declaration of Dr. Oliver Cossairt). Notably, Corephotonics’s expert did not, and could not, testify to the contrary as he stated that he was not an expert on this particular topic. J.A. 19; *see also* J.A. 1553–54 (Declaration of Dr. James Koshmach). Accordingly, because substantial evidence supports the Board’s determination, we affirm. The court has considered the remainder of Corephotonics’s arguments and finds them unpersuasive.

#### CONCLUSION

The court declines to vacate and remand the Board’s decision in view of *Arthrex*, because the final written decision underlying this appeal issued after this court issued its decision in *Arthrex*. In addition, substantial evidence supports the Board’s well-reasoned decision, and thus the court affirms the Board’s unpatentability findings as to claims 1–4 of the ’152 patent.

**AFFIRMED**

## CERTIFICATE OF COMPLIANCE

I hereby certify that the foregoing Appellant's Combined Petition For Panel Rehearing And Rehearing *En Banc* complies with the relevant type-volume limitations of the Federal Rules of Appellate Procedure and Federal Circuit Rules because it has been prepared using a proportionally-spaced typeface and includes 3,069 words, excluding the parts exempted under those Rules.

November 17, 2021

/s/ Robert J. Gajarsa  
Robert J. Gajarsa

*Counsel for Appellant*