

No. 2020-1425

---

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

---

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.*

---

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

---

**COMBINED PETITION FOR PANEL REHEARING  
AND REHEARING *EN BANC***

---

Robert J. Gajarsa  
rgajarsa@raklaw.com  
RUSS AUGUST & KABAT  
800 Maine Ave., SW, Suite 200  
Washington, DC 20004  
(310) 826-7474

Marc A. Fenster  
mfenster@raklaw.com  
Neil A. Rubin  
nrubin@raklaw.com  
RUSS AUGUST & KABAT  
12424 Wilshire Blvd., 12th Floor  
Los Angeles, CA 90025  
(310) 826-7474

November 16, 2021

---

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: 11/16/2021

Signature: /s/ Robert J. Gajarsa

Name: Robert J. Gajarsa

<p align="center"><b>1. Represented Entities.</b> Fed. Cir. R. 47.4(a)(1).</p>	<p align="center"><b>2. Real Party in Interest.</b> Fed. Cir. R. 47.4(a)(2).</p>	<p align="center"><b>3. Parent Corporations and Stockholders.</b> Fed. Cir. R. 47.4(a)(3).</p>
<p>Provide the full names of all entities represented by undersigned counsel in this case.</p>	<p>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.</p> <p><input checked="" type="checkbox"/> None/Not Applicable</p>	<p>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.</p> <p><input type="checkbox"/> None/Not Applicable</p>
<p>Corephotonics, Ltd.</p>		<p>Samsung Electronics Benelux B.V.</p>

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


**TABLE OF CONTENTS**

	<b>Page</b>
CERTIFICATE OF INTEREST .....	i
TABLE OF AUTHORITIES .....	v
FCR RULE 35(b) STATEMENT OF COUNSEL .....	1
FRAP 40(a)(2) AND FCR 35(e)(1)(F) STATEMENT OF POINTS OF LAW OR FACT THE COURT OVERLOOKED OR MISAPPREHENDED .....	1
I. INTRODUCTION .....	2
II. BACKGROUND .....	2
III. ARGUMENT .....	4
A. The Appointments Clause Violation Here Was Never Remedied.....	4
B. This Case Should Be Remanded For A Properly Appointed Director To Conduct The Required Director Review .....	8
IV. CONCLUSION.....	14

**TABLE OF AUTHORITIES**

**Page(s)**

**CASES**

*Agility Logistics Servs. Co. KSC v. Carter*,  
 No. 2015-1555, 2016 WL 11110465 (Fed. Cir. Mar. 10, 2016) .....12

*Ashford Univ., LLC v. Sec’y of Veterans Affs.*,  
 951 F.3d 1332 (Fed. Cir. 2020).....8, 9

*Corephotonics, Ltd. v. Apple Inc.*,  
 857 F. App’x 641 (Fed. Cir. 2021) .....3

*Federal Power Commission v. Metropolitan Edison Co.*,  
 304 U.S. 375 (1938).....9

*Fla. Power & Light Co. v. Lorion*,  
 470 U.S. 729 (1985).....11

*Guedes v. Bureau of Alcohol, Tobacco, Firearms*,  
 920 F.3d 1 (D.C. Cir. 2019) .....7

*Hyatt v. Hirshfeld*,  
 998 F.3d 1347 (Fed. Cir. 2021).....12

*In re Cumming*,  
 No. 18-2307, ECF No. 24 (Fed. Cir. March 28, 2019).....12

*In re Escobosa*,  
 No. 18-2259, ECF No. 20 (Fed. Cir. Jan. 30, 2019).....12

*In re Wella A.G.*,  
 787 F.2d 1549 (Fed. Cir. 1986).....13

*In re Wella A.G.*,  
 858 F.2d 725 (Fed. Cir. 1988).....13

*LM-M v. Cuccinelli*,  
 442 F. Supp. 3d 1 (D.D.C. 2020).....8

*Perricone v. Medicis Pharm. Corp.*,  
 432 F.3d 1368 (Fed. Cir. 2005).....12

	<b>Page(s)</b>
<i>Smith v. Berryhill</i> , 139 S. Ct. 1765 (2019) .....	13
<i>Sullivan v. Hudson</i> , 490 U.S. 877 (1989) .....	13
<i>United States v. Arthrex, Inc.</i> , 141 S. Ct. 1970 (2021) .....	<i>passim</i>
<i>Weinberger v. Salfi</i> , 422 U.S. 749 (1975) .....	9
<i>Windy City Innovations, LLC v. Am. Online, Inc.</i> , 217 F. App'x 980 (Fed. Cir. 2007) .....	12

**STATUTES**

5 U.S.C. § 3345(a)(3) .....	7
5 U.S.C. § 3346(a) .....	7
5 U.S.C. § 704 .....	9
28 U.S.C. § 1295(a)(10) .....	12
35 U.S.C. § 141(c) .....	9
35 U.S.C. § 3(b)(1) .....	7
35 U.S.C. § 3(b)(2) .....	5
41 U.S.C. § 7107(f) .....	12

**OTHER AUTHORITIES**

<i>U.S. Patent &amp; Trademark Office, Drew Hirshfeld</i> , <a href="https://www.uspto.gov/about-us/executive-biographies/drew-hirshfeld">https://www.uspto.gov/about-us/executive-biographies/drew-hirshfeld</a> .....	4, 7
--	------

**RULES**

Federal Rule of Appellate Procedure 12.1 .....	11
--	----

**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* Addendum at Add8-23. Over Corephotonics’s continued objection (*see id.* at Add21), that review was summarily denied by Commissioner Hirshfeld, who was purportedly “performing the functions and duties” of the Director. Addendum at Add24-25; *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

---

<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

---

<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

---

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.

---

<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 16, 2021

Respectfully submitted,

Marc A. Fenster  
mfenster@raklaw.com  
Neil A. Rubin  
nrubin@raklaw.com  
RUSS AUGUST & KABAT  
12424 Wilshire Blvd., 12th Floor  
Los Angeles, CA 90025  
(310) 826-7474

/s/ Robert J. Gajarsa  
Robert J. Gajarsa  
rgajarsa@raklaw.com  
RUSS AUGUST & KABAT  
800 Maine Ave., SW, Suite 200  
Washington, DC 20004  
(310) 826-7474

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

Add1-7	Court's May 20, 2021 Opinion
Add8-23	Corephotonics's Director Review Request Submitted Pursuant To The Court's July 29, 2021 Order
Add24-26	Decision In Response To Corephotonics's Director Review Request Submitted Pursuant To Court's July 29, 2021 Order

NOTE: This disposition is nonprecedential.

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

---

**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*

---

2020-1425

---

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

---

Decided: May 20, 2021

---

ROBERT J. GAJARSA, Russ August & Kabat, Washing-  
ton, DC, argued for appellant. Also represented by MARC

AARON FENSTER, NEIL RUBIN, Los Angeles, CA.

ANGELA OLIVER, Haynes & Boone, LLP, Washington, DC, argued for appellee. Also represented by ANDREW S. EHMKE, DEBRA JANECE MCCOMAS, Dallas, TX; DAVID W. O'BRIEN, HONG SHI, Austin, TX.

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.

---

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.

3

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>

---

<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

---

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.

COREPHOTONICS, LTD. v. APPLE INC.

5

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

---

<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-

COREPHOTONICS, LTD. v. APPLE INC.

7

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**

Paper No. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

APPLE INC.,  
Petitioner,

v.

COREPHOTONICS, LTD.,  
Patent Owner.

---

Case No. IPR2018-01133  
U.S. Patent No. 9,538,152

---

PATENT OWNER'S REQUEST  
FOR REHEARING BY THE DIRECTOR

Case No. IPR2018-01133  
U.S. Patent No. 9,538,152

TABLE OF CONTENTS

I. BACKGROUND ..... 1

II. THE MEANING OF “POINT OF VIEW” IS DISPOSITIVE ..... 5

III. THE BOARD ERRONEOUSLY FAILED TO CONSTRUE “POINT OF VIEW” ..... 8

IV. THE DIRECTOR SHOULD REVIEW AND REVERSE THE BOARD’S FINAL WRITTEN DECISION.....10

V. CONCLUSION .....12

Case No. IPR2018-01133  
U.S. Patent No. 9,538,152

TABLE OF AUTHORITIES

**Cases**

*Corephotonics, Ltd. v. Apple Inc.*,  
No. 2020-1425, 2021 WL 2012601 (Fed. Cir. May 20, 2021)..... 5

*In re Sang Su Lee*,  
277 F.3d 1338 (Fed. Cir. 2002)..... 10

*Phillips v. AWH Corp.*,  
415 F.3d 1303 (Fed. Cir. 2005)..... 10

*Trivascular, Inc. v. Samuels*,  
812 F.3d 1056 (Fed. Cir. 2016)..... 10

*United States v. Arthrex, Inc.*,  
141 S.Ct. 1970 (2021) ..... 1, 11

*Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*,  
200 F.3d 795 (Fed. Cir. 1999)..... 9, 10

**Statutes**

5 U.S.C. §§ 3345, *et seq.* ..... 11



Case No. IPR2018-01133  
U.S. Patent No. 9,538,152

Patent Owner Corephotonics Ltd. (“Corephotonics”) respectfully requests review by the Director of the Final Written Decision issued by the Board in this matter. Pursuant to the Supreme Court’s recent decision in *United States v. Arthrex, Inc.*, 141 S.Ct. 1970 (2021), such review must be conducted by a principal officer properly appointed by the President and confirmed through advice and consent of the Senate. This matter has been remanded to the Patent and Trademark Office for purposes of requesting such review. *See Order at 2, Corephotonics, Ltd. v. Apple Inc.*, No. 20-1425, ECF No. 68 (Fed. Cir., July 29, 2021).

Corephotonics submits that the Board’s Final Written Decision in this matter must be reviewed and rejected because the Board failed to apply a proper construction for “point of view” in the patent. Indeed, the Board refused to construe that term, even though Corephotonics proposed construction for it would be dispositive of non-obviousness. That was clear legal and procedural error that requires the Board’s Final Written Decision of unpatentability be reversed and is the type of straightforward and important error that warrants Director review.

## **I. BACKGROUND**

The ’152 patent at issue in this proceeding involves an innovative a dual-aperture imaging (“DAI”) system that captures and combines image data from two separate cameras (a wide-angle camera and a tele-zoom camera), to output a single high-quality zoomed image. A “different magnification image of the same scene is

Case No. IPR2018-01133

U.S. Patent No. 9,538,152

grabbed by each [camera], resulting in field of view (FOV) overlap between the two [images],” as shown below in annotated Fig. 1B from the patent. ’152 patent (3:11–14, 6:3–5); Fig. 1b (label 110 indicting the “overlap area” and 112 the “non-overlap area” between the two images). Here, the red annotation indicates a desired output image field of view that is intermediate between the fields of view of the two images:

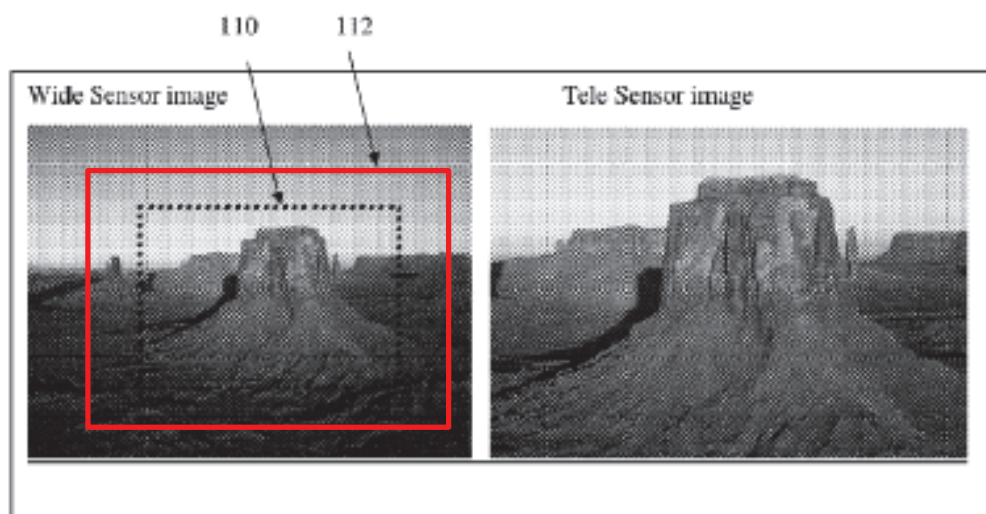


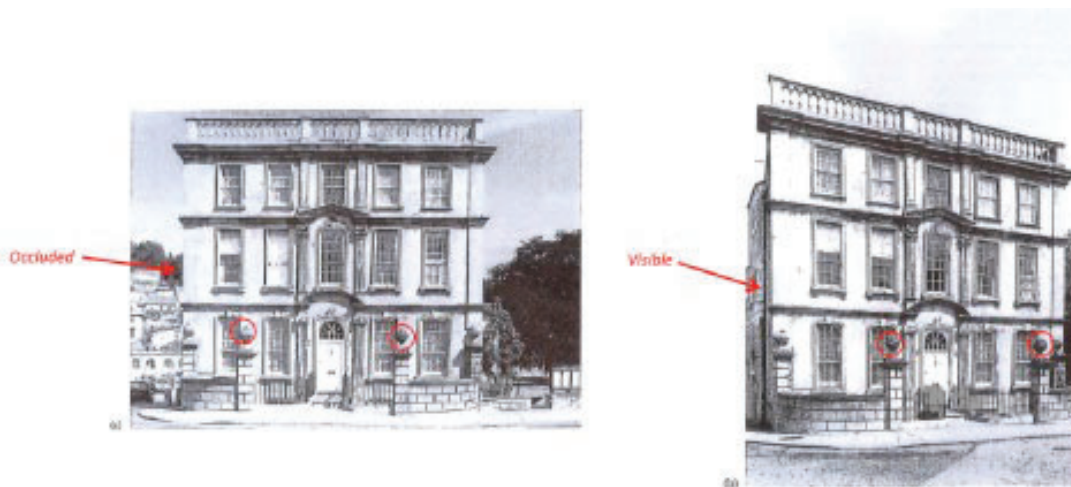
FIG. 1B

Since each camera is at a different spatial position, the images taken from the wide-angle and tele-zoom cameras also each have, even if only slightly, a different point of view (“POV”), which the patent expressly defines as the “camera angle” from which an image is captured. ’152 patent (9:26–28). As illustrated in the annotated images reproduced below from a textbook cited in Apple’s petition (Ex. 1008 at 29), the same objects in images taken at different camera angles (i.e., with different points of view) will appear to have (1) different relative positions (i.e., appear

Case No. IPR2018-01133

U.S. Patent No. 9,538,152

“shifted” in each relative frame) *and* (2) different “shapes” (i.e., look different because of the “different perspectives” of each camera). POPR at 14; *see also* Exhibit 2005, Kosmach Decl., ¶¶ 25-29.



Apple’s Petition challenged claims 1–4 of ’152 patent. Among other elements, each of those claims (directly or through dependence) require the final output image to be from the “point of view of the first camera” (e.g., the wide-angle camera) if the desired field of view is between that of the two images generated by the cameras (e.g., as shown by the red box in annotated Fig. 1b above). But because each image has a different point of view (i.e., taken from different camera angle), the image generated by the tele-zoom camera cannot simply be “stitched” (i.e., pasted) onto the appropriate overlapping area of the image from the wide-angle camera, otherwise objects in the pasted portions would have inconsistent positions and shapes or perspective versus the rest of the image. The clearest example of that inconsistency that

Case No. IPR2018-01133  
U.S. Patent No. 9,538,152

would arise from such simple “stitching” is shown in the image of the buildings reproduced above, where part of the building is entirely occluded in one image, yet is visible in the other. Solving that problem was one of the innovative aspects of the claimed invention—the prior art cited by Petitioner did not account for different shapes and perspectives when combining two images generated at different camera angles.

The Board’s Final Written Decision held that claims 1 through 4 are obvious over the prior art Border and Parulski references. The Board found, *inter alia*, that Border disclosed the required claim element of outputting an image from a “point of view” of the first camera when the field of view is between that of the two cameras. Border, though, only disclosed image “stitching” using basic mathematical techniques (called “homography”) to paste one image with a narrower field of view into a small part of another image with a wider field of view, *without* altering the shape or perspective of objects in that narrow-field image to account for camera angle, as the claimed invention does. *See infra* at II. To reach that finding, the Board expressly refused to construe “point of view,” which Corephotonics had asked to be construed as “camera angle” (as it was defined in the patent) which encompasses *both* position *and* shape or perspective. FWD at 7-8.

Corephotonics appealed the Final Written Decision to the Federal Circuit. The panel that heard the appeal affirmed the Board’s decision in a short nonprecedential

Case No. IPR2018-01133  
U.S. Patent No. 9,538,152

opinion, but neglected to address the construction of “point of view.” *Corephotonics, Ltd. v. Apple Inc.*, No. 2020-1425, 2021 WL 2012601, at \*3 (Fed. Cir. May 20, 2021). Instead, after addressing arguments related to *Arthrex*, the Court curtly affirmed by referencing the Board’s conclusion that Border disclosed how to mathematically transform “coordinates from the telephoto to the wide-angle image” (i.e., changing relative *position*) and the testimony of Apple’s expert that such alterations satisfied *Apple’s definition* for “point of view,” which required position *or* shape/perspective to be addressed. *Id.* Before Corephotonics could file a petition for rehearing to remind the panel about the unadjudicated dispute over the construction of “point of view” and permit the panel to address it, the Court remanded Corephotonics’s appeal (along with dozens of others) to allow for Director review in light of the Supreme Court’s decision in *Arthrex*.

Corephotonics now seeks Director review to correct the significant error committed by the Board related to the construction of “point of view.”

## **II. THE MEANING OF “POINT OF VIEW” IS DISPOSITIVE**

Border fails to disclose providing an output image from a “point of view” of the first camera, as required by the claims. The patent defines “point of view” as “camera angle.” ’152 patent (9:26-28) (“The output image point of view is determined according to the primary image point of view (camera angle).”). And, as Corephotonics explained to the Board, “camera angle” is understood by a POSITA as

Case No. IPR2018-01133

U.S. Patent No. 9,538,152

reflecting *both* the position of objects in the field of view *and* the shape or perspective of those objects. POPR at 14; *see also* PO Sur-Reply at 2-8. In other words, the same objects in images taken from different camera angles are “shifted *and* have different perspectives” (i.e., “shapes”) because of the different points of view. *Id.*; *see also* Exhibit 2005, Kosmach Decl., ¶¶ 25-29.<sup>1</sup>

Thus, “an output image from a *point of view* of the first camera” must reflect the position *and* shape/perspective of objects relative to the camera angle for the first camera. And that point of view must be from the first camera *alone*. *See* PO Sur-Reply at 5. Indeed, the ’152 inventors recognized that an output image could have a “combination” of the “shape or position” of objects from both cameras, but the claims here require the output be from the point of view of just *one* camera at a time. *See id.*; Ex. 2009 (4:60-65).

Under a correct construction of “point of view,” there can be no dispute that Border fails to teach outputting an image from the “point of view” of the first camera when combining images from two cameras. As depicted below in Fig. 6 from Border (replicated from Apple’s Petition at 38), Border transforms two images (204 and 206) with different fields of view into one composite image (208) with an intermediate field of view by “stitching” the image from the camera with a narrower field of view (e.g., a tele-zoom camera producing image 206) into the appropriate position for the

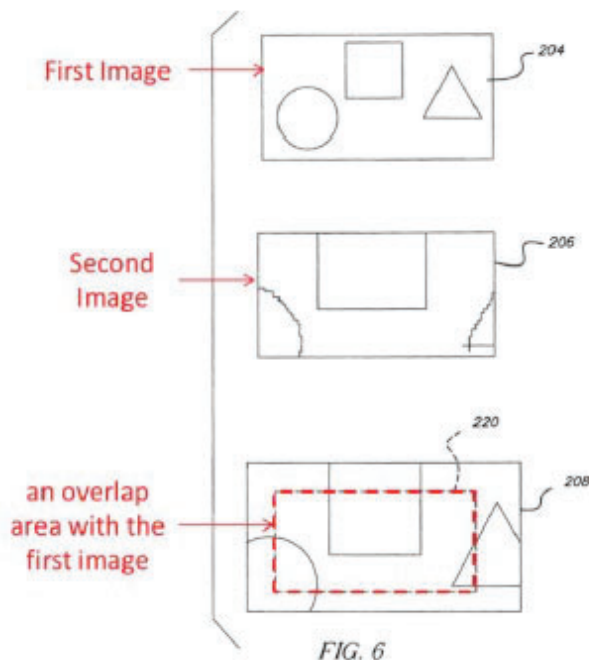
---

<sup>1</sup> All emphasis added throughout unless otherwise noted.

Case No. IPR2018-01133

U.S. Patent No. 9,538,152

same objects depicted in the image from a camera with a wider field of view (e.g., a wide-angle camera producing image 204).



(APPL-1006), Border, Fig. 6, annotated

As Border explains, that image-stitching technique creates a “composite image 208 us[ing] pixel *data from the telephoto image 206* for those portions ... within the dashed line 220 that are in the view of the telephoto image 206 *and us[ing] pixel data from the wide image 204 otherwise.*” Exhibit 1006 ¶ 47. And as Border teaches, that simple pasting of the tele-zoom camera’s image into the wide-angle camera’s image is accomplished by just mathematically “transform[ing] the *coordinates* of the telephoto image 206 to the wide image 204” with a simple, well-known “homography” function that places the pixels corresponding to certain objects in 206 in their



Case No. IPR2018-01133

U.S. Patent No. 9,538,152

correct relative *position* within the x/y coordinate frame of image 204 while retaining their original pixel data and resolution so that “*the telephoto image 206 covers a smaller portion of the scene, but with greater resolution.*” Exhibit 1006 ¶ 47; *see id.* ¶¶ 38-40 (showing simple math). Cut and paste/squeeze image 206 into image 204—that is all that Border does.

Accordingly, under a correct construction of the claims, there can be no dispute that Border’s output image will not be entirely from the required “*point of view of the first camera*” (e.g., the point of view of the wide-camera 204). Though placed in the relatively correct *position* in the final scene in the output image, objects inside the dashed line 220 will be reproduced with the *shape and perspective* for the point of view of the telephoto camera 206 (the *second* camera).

### **III. THE BOARD ERRONEOUSLY FAILED TO CONSTRUE “POINT OF VIEW”**

Corephotonics repeatedly explained to the Board how Border does not disclose outputting an image from the “point of view” of a first camera as required by a proper construction of that term, which addresses *both* position *and* shape/perspective of objects. *See, e.g.*, POPR at 14; PO Resp. 22-23; PO Sur-Reply at 2-8. And the Board recognized that in its opinion. *See* FWD 20-22 (discussing how Corephotonics argued that Border failed to produce an output image that accounted for “shape *and* perspective” of objects in the first image, including the obvious potential “occlusion” of those objects based on the camera angle of the second camera, as shown in the



Case No. IPR2018-01133  
U.S. Patent No. 9,538,152

picture of buildings above). But even though there was significant dispute over whether the term “point of view” required accounting for position *and* shape/perspective of objects (as Corephotonics argued), the Board refused to construe the term because it concluded that Corephotonics’s proffered construction “does not change the analysis in this case.” FWD at 8.

The Board therefore did not conduct the required full claim construction inquiry for “point of view,” including consideration of all of the evidence put forth by the parties. *See, e.g., Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (terms in dispute must be construed if relevant to inquiry); FWD at 8 (acknowledging same precedent). Compounding that error even further, the Board then purported to reject Corephotonics’s “approach to construing the ‘point of view’ limitation.” FWD at 22. But again, the Board did not actually conduct a claim construction inquiry that addressed the construction that Corephotonics advanced for “point of view” (“camera angle,” which would have required replicating *both* position *and* shape/perspective for objects in the first camera image). *See, e.g.,* POPR at 14; PO Resp. 22-23; PO Sur-Reply at 2-8. Instead, the Board “decline[d] to import a limitation to *resolving ‘occlusions’* into the claims” because the claimed invention would supposedly not be “enabled” if “*occlusions*” were included—a point that neither party raised, since enablement is irrelevant to the claim construction inquiry here. *Id.* at 22-23; *see, e.g., Phillips v. AWH Corp.*, 415 F.3d 1303, 1327 (Fed. Cir.

Case No. IPR2018-01133

U.S. Patent No. 9,538,152

2005) (*en banc*) (claims may be construed to preserve validity only if still ambiguous “after applying all the available tools of claim construction”—a rule that does not apply to “point of view,” which is amenable to construction).

The meaning of “point of view” was dispositive of whether Border’s disclosure met the claim limitations here, as discussed above. The Board, therefore, should have conducted a full claim construction analysis of that term—but it did not. *See, e.g., Vivid Techs.*, 200 F.3d at 803; FWD at 8 (acknowledging same precedent). That was legal and procedural error under controlling precedent and the Administrative Procedure Act. *See, e.g., Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1062 (Fed. Cir. 2016) (the Board does not have “unfettered license to interpret the words in a claim” under the broadest reasonable interpretation standard—it has to follow appropriate procedure and precedent); *In re Sang Su Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002) (“Omission of a relevant factor required by precedent is both legal error and arbitrary agency action” under the “Administrative Procedure Act”).

#### **IV. THE DIRECTOR SHOULD REVIEW AND REVERSE THE BOARD’S FINAL WRITTEN DECISION**

The meaning of “point of view” is dispositive here and the Board’s decision was erroneously grounded in a failure to construe that limitation. The Director should remedy the Board’s error by adopting the correct definition of “point of view” and, accordingly, reverse the finding of invalidity for the reasons discussed above. Legal and APA errors like those committed by the Board here should not be left to

Case No. IPR2018-01133

U.S. Patent No. 9,538,152

fester while awaiting correction by the Federal Circuit after further action on appeal, particularly when there are unadjudicated issues that the appellate court cannot address in the first instance. The clear and concise yet critical errors by the Board here are exactly the type that warrant Director review.<sup>2</sup>

Corephotonics respectfully submits that, consistent with the Supreme Court's holding, the review requested herein must be conducted by a principle constitutional officer properly appointed by the President with the advice and consent of the Senate. Because Andrew Hirshfeld is not an appointed principle officer, he may not conduct the requested review without creating the same Constitutional infirmity held to exist in *United States v. Arthrex*, 141 S.Ct. 1970 (2021). *See, e.g., id.* at 1985 (“Only an officer *properly appointed to a principal office* may issue a final decision binding the Executive Branch.”). Also, even if an “Acting Director” (*Arthrex*, 141 S.Ct. at 1987) could conduct such review (he may not), there is no Acting Director to do so at present within the meaning of the Federal Vacancies Reform Act of 1998. 5 U.S.C. §§ 3345, *et seq.*

---

<sup>2</sup> Alternatively, the Board's decision should be vacated and the matter remanded for adjudication under a proper construction of “point of view.”

Case No. IPR2018-01133

U.S. Patent No. 9,538,152

**V. CONCLUSION**

For the foregoing reasons, the Director should reverse the decision of the Board or, at a minimum, vacate that decision and remand for adjudication under a proper construction of “point of view.”

Dated: August 30, 2021

*/Neil A. Rubin/*

Neil A. Rubin (Reg. No. 67,030)

RUSS AUGUST & KABAT

12424 Wilshire Boulevard, 12th Floor

Los Angeles, CA 90025

Telephone: 310-826-7474

Attorney for Patent Owner,  
COREPHOTONICS, LTD.

Case No. IPR2018-01133  
U.S. Patent No. 9,538,152

CERTIFICATE OF SERVICE

I hereby certify that “Patent Owner’s Request for Rehearing by the Director” was served on August 30, 2021 by email sent to:

David W. O’Brien  
Hong Shi  
HAYNES AND BOONE, LLP  
600 Congress Ave. Suite 1300  
Austin, TX 78701  
Telephone: 512-867-8400  
Email: david.obrien.ipr@haynesboone.com  
Email: hong.shi.ipr@haynesboone.com

Andrew S. Ehmke  
Michael S. Parsons  
Jamie H. McDole  
HAYNES AND BOONE, LLP  
2323 Victory Ave. Suite 700  
Dallas, TX 75219  
Telephone: 214-651-5000  
Email: andy.ehmke.ipr@haynesboone.com  
Email: michael.parsons.ipr@haynesboone.com  
Email: jamie.mcdole@haynesboone.com

/Neil A. Rubin/

[Trials@uspto.gov](mailto:Trials@uspto.gov)  
571.272.7822

Paper 37  
Entered: October 15, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE OFFICE OF THE UNDERSECRETARY AND DIRECTOR OF  
THE UNITED STATES PATENT AND TRADEMARK OFFICE

---

APPLE INC.,  
Petitioner,

v.

COREPHOTONICS, LTD.,  
Patent Owner.

---

IPR2018-01133  
Patent 9,538,152 B2

---

Before ANDREW HIRSHFELD, *Commissioner for Patents, Performing the  
Functions and Duties of the Under Secretary of Commerce for Intellectual  
Property and Director of the United States Patent and Trademark Office.*

ORDER

IPR2018-01133  
Patent 9,538,152 B2

The Office has received a request for Director review of the Final Written Decision in this case. Ex. 3100. The request was referred to Mr. Hirshfeld, Commissioner for Patents, Performing the Functions and Duties of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

It is ORDERED that the request for Director review is denied; and  
FURTHER ORDERED that the Patent Trial and Appeal Board's Final Written Decision is the final decision of the agency.

IPR2018-01133  
Patent 9,538,152 B2

For PETITIONER:

David Obrien  
Andrew S. Ehmke  
Hong Shi  
HAYNES & BOONE, LLP  
David.obrien.ipr@haynesboone.com  
Andy.ehmke.ipr@haynesboone.com  
Hong.shi.ipr@haynesboone.com

For PATENT OWNER:

Neil Rubin  
C. Jay Chung  
Reza Miraie  
RUSS AUGUST & KABAT  
nrubin@raklaw.com  
jchung@raklaw.com  
mirzaie@raklaw.com



## CERTIFICATE OF COMPLIANCE

I hereby certify that the foregoing 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 3,078 words, excluding the parts exempted under those Rules.

November 16, 2021

/s/ Robert J. Gajarsa  
Robert J. Gajarsa

*Counsel for Appellant*