

Keeping the Burdens in Focus

Apple Inc. v. Corephotonics, Ltd., No. 2020-1438 (Fed. Cir. June 23, 2021)

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The Court of Appeals for the Federal Circuit (“CAFC”) [held](#) that the Patent and Trademark Appeal Board (“PTAB”) erred by placing the burden of establishing that a purportedly anticipatory prior art reference was enabling on the challenger rather than requiring the patentee to establish that it was non-enabling. Notwithstanding that error, the Court affirmed the PTAB’s finding of no anticipation but vacated the PTAB’s non-obviousness determination as tainted by a mathematical error. This rollercoaster followed Apple Inc. (“Apple”)’s appeal of the PTAB decision sustain the validity of Corephotonics, Ltd.’s (“CorePhotonics”)’s cell phone camera patents.

The U.S. Patent No. 9,568,712 (“the ’712 Patent”) claims a miniature telephoto multi-lens assembly with a total track length (the length of the lens assembly) that is smaller than its effective focal length. Longer focal lengths can improve image quality and reduce optical distortion. However, increasing focal length usually entails increasing total length, which is a problem for a camera meant to fit in a phone.

Apple’s anticipatory reference, Konno, disclosed a lens assembly (right) with the required focal length ratio. However, the PTAB found it non-anticipating because the embodiment was inoperable: as disclosed, the fourth and fifth lenses slightly overlapped (marked orange). While the patent owner typically bears the burden of providing inoperability in other proceedings, the PTAB distinguished those situations as not “in the context of AIA trial proceedings,” and not only placed the burden to prove enablement on the challenger, but further refused to consider Apple’s “new” enablement evidence submitted with its Reply. The Federal Circuit found the PTAB’s burden allocation and refusal to consider Apple’s Reply evidence constituted error.

However, the CAFC found these errors were harmless because Apple itself had asserted in its Petition that Konno’s asserted embodiment contained the error, arguing it was obvious for a Person of Ordinary Skill in the Art, or “POSA,” to correct. The law of anticipation, though, is inflexible: inoperative embodiments cannot anticipate. Apple’s argument may have succeeded for an obviousness-based ground, but its Petition asserted only anticipation against most claims, and only asserted obviousness against select dependent claims. As such, the CAFC affirmed the PTAB’s decision that Konno did not anticipate.

Although non-precedential, the decision is important because requiring the petitioner to have addressed this defense *in the petition*, as the PTAB did, rather than letting the dispute develop, would have caused confusion and inefficiency for this defense and other potential defenses. The case also underscores the importance, when practicing within the AIA trial framework where a challenger is restricted to the grounds asserted in its petition, of backstopping anticipation-based grounds with obviousness, just in case.

