

Is It In or Is It Out?



2 MIN READ

October 26, 2023, 1:32 PM

By: Ramya Auroprem

Whether an argument raised in a Petitioner Reply falls within the scope of permissible arguments following a Patent Owner Response (POR) in IPR proceedings is a frequent source of dispute. As Axinn reported back in August, the Federal Circuit issued two precedential opinions on the subject earlier this year, to clarify to the Board and the parties where the boundary lines are drawn: Arguments addressing a new claim construction position raised in the POR are good. *Axonics v. Medtronic*, 74 F.4th 1374, 1383 (Fed. Cir. 2023). Similarly, the Board found no fault with new arguments on a POSA's motivation to modify the asserted prior art-- as long as the Petitioner is not relying on any embodiment not cited in the Petition. See *Rembrandt Diagnostics v. Alere*, 76 F.4th 1376, 1385 (Fed. Cir. 2023).

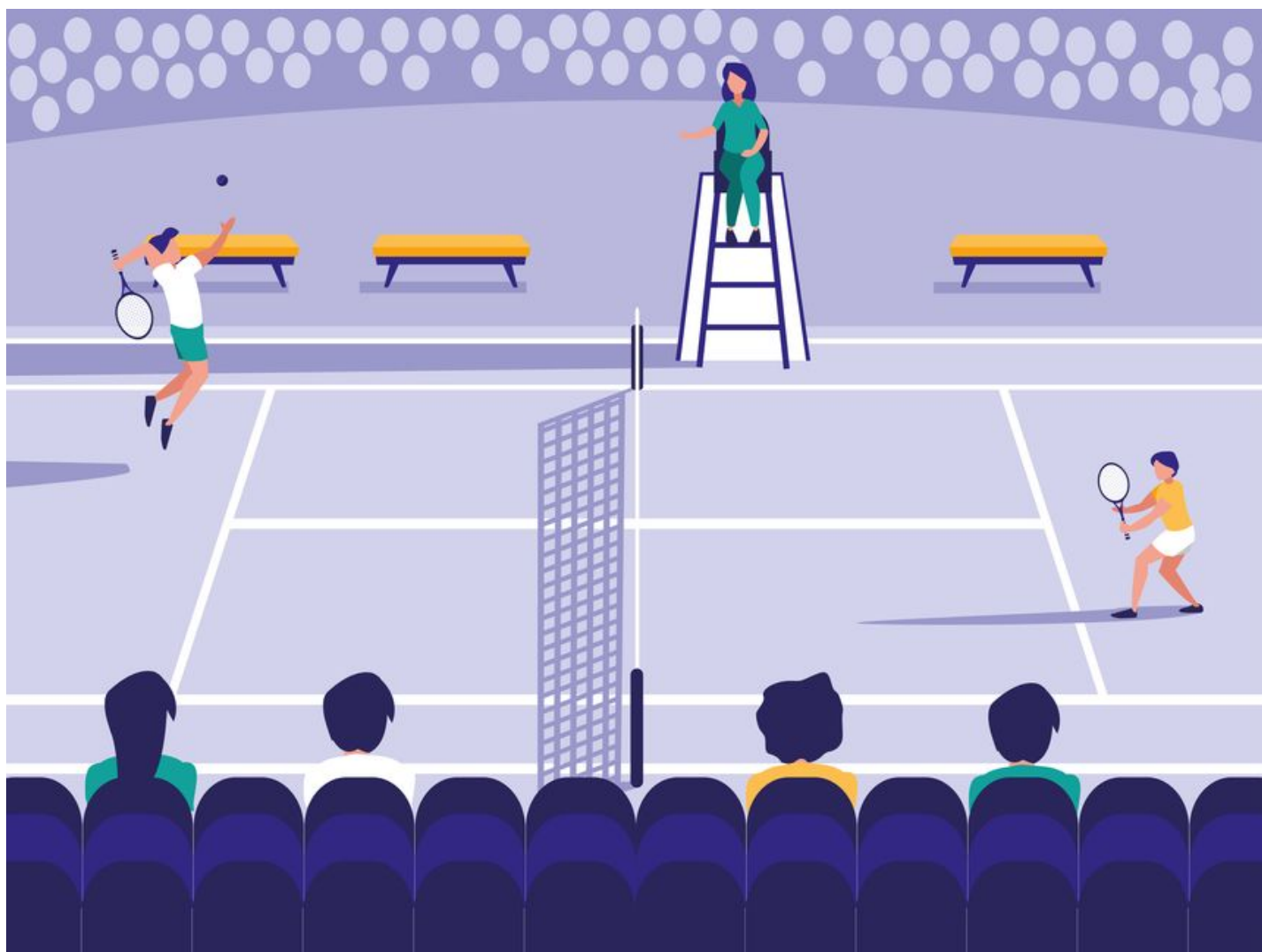
On October 16, 2023, the Federal Circuit refereed another line dispute, holding in *Corephotonics* that an argument addressing whether the asserted prior art is in the same field of endeavor as the challenged patent, *i.e.*, analogous art, also landed inside the line (or at least on the line). Specifically, because the new arguments in Reply relied on the same references, disclosures, and invalidity theories as the Petition, there was sufficient notice to the Patent Owner. *Corephotonics v. Apple*, 2023 WL 6798899, at *12-13 (Fed. Cir. Oct. 16, 2023).

Corephotonics serves as a reminder that Petitioners need to be as inclusive as possible in their citations in the Petition (obviously while still directing the Board to instructive parts of prior art

references to facilitate the institution decision analysis) in order to avoid a return ace from the Patent Owner. So far this year, 40-Love.

The Federal Circuit found that Corephotonics had adequate notice of Apple’s position on analogous art, and that Apple satisfied the newness restriction by focusing on the same references and obviousness theories. On responsiveness, the appellate court found that Corephotonics’ “broad attack” on Apple’s argument deficiencies “made it appropriate for Apple to respond with an elaboration of the bases on which its prior art references satisfy the analogous art requirement.”

🐕 ipwatchdog.com/...



Related People



Ramya Auroprem

Related Services

Intellectual Property

To subscribe to our publications, [click here](#).

News & Insights

- ACI Forum on Pharma & Biotech Patent Litigation USA 2025
SPEAKING ENGAGEMENT INTELLECTUAL PROPERTY
- CCWC 21st Annual Career Strategies Conference
SPEAKING ENGAGEMENT
- Fordham 52nd Annual Conference on International Antitrust Law and Policy
SPEAKING ENGAGEMENT ANTITRUST
- Kisaco Research Trade Secret Legal Protection Conference 2025
SPEAKING ENGAGEMENT INTELLECTUAL PROPERTY
- SCCE 23rd Annual Compliance & Ethics Institute
SPEAKING ENGAGEMENT ANTITRUST
- 29th Annual IBA Competition Conference
SPONSORSHIP ANTITRUST
- Key Appellate Decisions Shaping Antitrust Strategy
WEBINAR ANTITRUST

- New Frontiers of Antitrust – 16th Annual International Conference of Concurrences Review

SPEAKING ENGAGEMENT ANTITRUST

- MCCA Pathways Conference

SPONSORSHIP ANTITRUST

- HNBA/VIA Annual Convention 2025

SPONSORSHIP ANTITRUST

© 2025 Axinn, Veltrop & Harkrider LLP. All Rights Reserved