

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION AND MICROSOFT MOBILE, INC.,
Petitioner,

v.

GLOBAL TOUCH SOLUTIONS, LLC,
Patent Owner.

Case IPR2015-01025
Patent 7,265,494 B2

Before JUSTIN BUSCH, LYNNE E. PETTIGREW, and BETH Z. SHAW,
Administrative Patent Judges.

BUSCH, *Administrative Patent Judge.*

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Microsoft Corporation and Microsoft Mobile, Inc. (collectively “Petitioner”) filed a Petition to institute an *inter partes* review of claims 1, 3, 5, 12–14, 18, 20, 29, 30, 34, and 35 of U.S. Patent No. 7,265,494 B2 (“the ’494 patent”). Paper 1 (“Pet.”). Global Touch Solutions, LLC (“Patent

Owner”) filed a Preliminary Response pursuant to 35 U.S.C. § 313. Paper 10 (“Prelim. Resp.”). In its Preliminary Response, Patent Owner indicated that it filed a disclaimer under 35 U.S.C. § 253(a) and in compliance with 37 C.F.R. § 1.321(a), disclaiming claims 5, 12–14, 18, 29, 30, 34, and 35 of the ’494 patent. Patent Owner’s disclaimer appears to be in compliance with 37 C.F.R. § 1.321(a). *See* Ex. 2003. Therefore, no *inter partes* review will be instituted as to claims 5, 12–14, 18, 29, 30, 34, and 35, and we will address the Petition only with respect to Petitioner’s challenges to claims 1, 3, and 20 (“the challenged claims”). 37 C.F.R. § 42.107(e).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314; 37 C.F.R. § 42.4(a). Upon consideration of the Petition and the Preliminary Response, and for the reasons explained below, we determine that the information presented does not demonstrate a reasonable likelihood that Petitioner would prevail with respect to showing that at least one of the challenged claims is unpatentable. Accordingly, we do not institute an *inter partes* review.

A. *Related Matters*

The ’494 patent is involved in *Global Touch Solutions, LLC v. Microsoft Corp.*, No. 3:15-cv-02750 (N.D. Cal.), filed on August 1, 2014, which involves Petitioner. Pet. 3; Paper 6, 2; Paper 11, 3. The ’494 patent is also involved in three other district court proceedings in the Northern District of California. Paper 6, 2; Paper 11, 3.

B. *The ’494 Patent*

The ’494 patent is directed to an electronic circuit including a microchip that uses touch sensor technology to detect proximity and

physical contact events. Ex. 1001, Abstract. A touch sensor and “a non-latching push button or latching MMI switch” may be combined “to achieve specific operational features that may be attractive to the user in that certain comforts or user friendliness may be facilitated.” *Id.* at 13:49–55. For example, a flashlight operated by a push button switch may have a touch sensor for proximity detection that activates a find-in-the-dark (“FITD”) indicator when the user’s hand is close to a touch sensor. *Id.* at 14:42–46, 15:9–11 (“In simple terms the physical switch (pb) surface that a user must press, may glow (in the dark) when the user brings his/her hand close to the switch”). The user then must press the push button to activate the flashlight. *Id.* at 15:14–16. The proximity-based indication (e.g., illumination of the switch) may be discontinued a certain period of time after the proximity signal has disappeared. *Id.* at 14:56–58.

Independent claim 1 is directed to an electronic unit with a microchip that controls power flow from a power source of a product to the load of that product, a non-serial, user-interface switch, and a touch sensor, wherein the microchip controls activation and deactivation of the load in response to a signal from the switch and activates a FITD indication in response to a signal from the touch sensor when the load is not activated. Ex. 1001, 17:27–43. Claim 3, which depends from claim 1, further recites that “the microchip performs an automatic delayed termination of a function that was activated in response to an activation signal received from the switch or the touch sensor.” *Id.* at 17:48–51. Claim 20, which also depends from claim 1, recites the additional limitation that “the switch is a push button type switch.” *Id.* at 18:49–50.

C. The Challenged Claims

Petitioner asserts that claims 1, 3, and 20 are unpatentable under 35 U.S.C. § 103(a) as obvious in view of Bruwer.¹ Claim 1, which is the only independent claim, is illustrative and reproduced below:

1. An electronic unit for use with a product connected to a power source, an energy consuming load and a power circuit that connects the power source to the load to power the load, said electronic unit, comprising:

(a) a microchip; the microchip at least controlling the flow of power from the power source to activate the load;

(b) a switch, wherein the switch is not a serial element in the power circuit, and wherein the switch is a user interface; and

(c) a touch sensor;

wherein the microchip is coupled to the switch and to the touch sensor; wherein the microchip controls the activation and the deactivation of the load in response to a signal from the switch; and wherein the microchip, in response to at least a signal from the touch sensor, is configured for activating a visible find-in-the-dark indication, when the load is not activated.

II. ANALYSIS

D. Priority Date of the Challenged Claims

Petitioner argues Bruwer qualifies as prior art for the challenged claims at least under 35 U.S.C. § 102(b) because the patent application of Bruwer was filed in the United States before October 12, 2004, the earliest effective priority date of the challenged claims of the '494 patent. Pet. 5–6.

¹ Int'l Patent Publ'n No. WO 00/22890, published April 20, 2000. Ex. 1004 ("Bruwer").

Patent Owner argues Bruwer is not prior art to the challenged claims because the challenged claims have written description support in applications filed in 1998 and 1999, to which the '494 patent claims priority. Prelim. Resp. 3–22. Because we deny institution of *inter partes* review for the reasons explained below, we need not and do not reach the issue of whether the challenged claims of the '494 patent are entitled to a priority date earlier than October 12, 2004.

E. Obviousness of Claims 1, 3, and 20 in view of Bruwer

1. Bruwer (Ex. 1004)

Bruwer describes a microchip or circuit that can “handle both current conducting functions and man-machine-interface [MMI] functions in an electrical device.” Ex. 1004, Abstract. The MMI functions can be “controlled by very low current signals, touch pads, carbon coated membrane type switches, or other low current type switches.” *Id.* Some of the functions that may be controlled by switches include “delayed switching, dimming, delayed automatic shut off,” and “provid[ing] indication of power strength.” *Id.*

2. Obviousness Challenge

Petitioner asserts that the subject matter of claims 1, 3, and 20 would have been obvious in view of Bruwer under 35 U.S.C. § 103(a). Pet. 30–42, 50. Petitioner provides a limitation-by-limitation analysis, quoting portions of Bruwer that Petitioner alleges teach each limitation and including portions of testimony from the Declaration of Dr. Mark N. Horenstein (Ex. 1017). *Id.*

We have reviewed the Petition, the Preliminary Response, and the evidence of record, and we determine Petitioner has not demonstrated a reasonable likelihood of prevailing in establishing that claims 1, 3, and 20 are unpatentable as obvious in view of Bruwer. Although Patent Owner does not specifically contest Petitioner's assertions that Bruwer's disclosures render the subject matter of the challenged claims obvious we find Petitioner has not met its burden of establishing that the subject matter of the challenged claims would have been obvious in view of Bruwer.

Petitioner asserts Bruwer discloses or teaches every limitation recited in claim 1. Pet. 30–41. Because it is determinative of the outcome in this matter, we address only Petitioner's argument that Bruwer discloses the recited limitation that the “microchip, *in response* to at least a *signal from the touch sensor*, is configured for activating a visible find-in-the-dark indication, when the load is not activated.” Petitioner asserts Bruwer discloses an LED, which provides a visible FITD indication, and that “Bruwer further disclosed that microchip 1113 is configured for activating the LED 1104 in response to a signal from the touch sensor.” *Id.* at 40–41. In support of that argument, Petitioner quotes language in Bruwer stating that “LED 1104 may also shine when switch 1111 is closed by the user.” *Id.* (quoting Ex. 1004, 13:29–30; citing Ex. 1017 ¶ 101). Petitioner's declarant offers testimony that mirrors the language in the Petition. Ex. 1017 ¶ 101. Petitioner then asserts that, in “modified Figure 11 . . . the LED 1104 is controlled by touch sensor 1111.” Pet. 41 (citing Ex. 1017 ¶ 102).

Figure 11 and its accompanying description, however, describe a circuit that activates the FITD indication *either* “when switch 1111 is closed by the user” or “[w]hen microchip 1113 pulls the line 1114 to high.” Ex.

1004, 13:29–30. Thus, contrary to Petitioner’s assertion, the portion of Bruwer cited by Petitioner and Dr. Horenstein does not disclose that the *microchip* activates the FITD indication *in response* to input from switch 1111, as required by claim 1. Although Petitioner provides a rationale as to why it would have been obvious to activate the FITD indication *when the load is inactive*, Petitioner provides no persuasive analysis or rationale for modifying Bruwer’s disclosed circuit to teach that the “microchip, *in response* to at least a *signal from the touch sensor*, is configured for activating a visible find-in-the-dark indication, when the load is not activated,” as recited in claim 1.

Claims 3 and 20 depend from claim 1, thereby incorporating each limitation of claim 1. Thus, based on the record, we find Petitioner has not demonstrated a reasonable likelihood of prevailing in showing that claims 1, 3, and 20 are unpatentable as obvious in view of Bruwer.

III. CONCLUSION

For the foregoing reasons, based on the information presented in the Petition, we determine Petitioner has not shown a reasonable likelihood that it would prevail in demonstrating that claims 1, 3, and 20 are unpatentable.

IV. ORDER

Accordingly, it is

ORDERED that an *inter partes* review of U.S. Patent No. 7,265,494 B2 is not instituted based on this Petition.

IPR2015-01025
Patent 7,265,494 B2

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