

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 IPR2015-01928
Patent 7,265,494 B2

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

BUSCH, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

In this *inter partes* review, instituted pursuant to 35 U.S.C. § 314, Microsoft Corp. and Microsoft Mobile, Inc. (collectively, “Petitioner”) challenge the patentability of claims 1, 3, and 20 (“the challenged claims”) of U.S. Patent No. 7,265,494 B2 (Ex. 1001, “the ’494 patent”), owned by

Global Touch Solutions, LLC (“Patent Owner”). We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed below, Petitioner has shown by a preponderance of the evidence that the challenged claims of the ’494 patent are unpatentable.

A. Procedural History

Petitioner filed a Petition for *inter partes* review of the challenged claims of the ’494 patent. Paper 1 (“Pet.”). Patent Owner did not file a Preliminary Response. On March 14, 2016, we instituted an *inter partes* review of the challenged claims of the ’494 patent. Paper 7 (“Institution Decision” or “Dec.”). After institution, Patent Owner filed a Patent Owner Response, Paper 9 (“PO Resp.”), and Petitioner filed a Reply to the Patent Owner Response, Paper 18 (“Pet. Reply”). Oral hearing for this case was held on November 10, 2016. A transcript of the hearing has been entered into the record. Paper 27.

B. Related Matters

The parties identify the following district court proceedings as related matters: *Global Touch Solutions, LLC v. Microsoft Corp.*, Case No. 3:15-cv-2750-JD (N.D. Cal.); *Global Touch Solutions, LLC v. Toshiba Corp.*, Case No. 3:15-cv-2746-JD (N.D. Cal.); *Global Touch Solutions, LLC v. VIZIO Inc.*, Case No. 3:15-cv-2747-JD (N.D. Cal.); *Global Touch Solutions, LLC v. Apple Inc.*, Case No. 3:15-cv-2748-JD (N.D. Cal.); and *Global Touch Solutions, LLC v. Motorola Mobility, LLC*, Case No. 3:15-cv-2749-JD (N.D. Cal.). Pet. 5–6; Paper 6, 3. Petitioner filed another petition in IPR2015-01025 challenging claims of the ’494 patent. Pet. 6; Paper 6, 3. Petitioner also filed petitions for *inter partes* review of seven related patents: U.S.

Patent Nos. 8,035,623 (IPR2015-01023); 7,772,781 (IPR2015-01024); 7,994,726 (IPR2015-01147); 7,498,749 (IPR2015-01148); 7,329,970 (IPR2015-01149); 7,781,980 (IPR2015-01150); and 8,288,952 (IPR2015-01151). Pet. 6; Paper 6, 3–4. The parties also identify IPR2015-01616, which is a petition for *inter partes* review of the '494 patent, filed by a different petitioner. Pet. 6; Paper 6, 4.

C. The '494 Patent

The '494 patent is directed to electronic circuits that include microchips and touch sensors that differentiate between proximity and physical contact events. Ex. 1001, Abstract. A visible indicator such as a light emitting diode (LED) can be used to indicate the condition of the battery. *Id.* at 9:45–53, Fig. 11. The '494 patent also discusses a find-in-the-dark (“FITD”) indication, which may be an “element creating a visible, audible, or other human detectable signal that would assist a person to locate a product containing the abovementioned elements.” *Id.* at 14:11–14.

D. The Challenged Claims

We instituted an *inter partes* review based on Petitioner’s contention that the challenged claims are unpatentable as obvious under 35 U.S.C. § 103(a) in view of Jahagirdar¹ and Schultz.² Dec. 10. Claim 1, which is the only independent claim at issue, 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:

¹ U.S. Patent 6,125,286, issued Sept. 26, 2000 (Ex. 1004, “Jahagirdar”).

² U.S. Patent 4,053,789, issued Oct. 11, 1977 (Ex. 1005, “Schultz”).

(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. DISCUSSION

A. Claim Construction

We construe only those claim terms in controversy, and we do so only to the extent necessary to resolve the controversy. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999). We construe claim terms in an unexpired patent according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b). Consistent with the broadest reasonable construction, claim terms are presumed to have their ordinary and customary meaning as understood by a person of ordinary skill in the art in the context of the entire patent disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). To the extent it is necessary for us to construe any claim terms in this decision, we do so below in the context of analyzing whether the prior art renders the claims unpatentable.

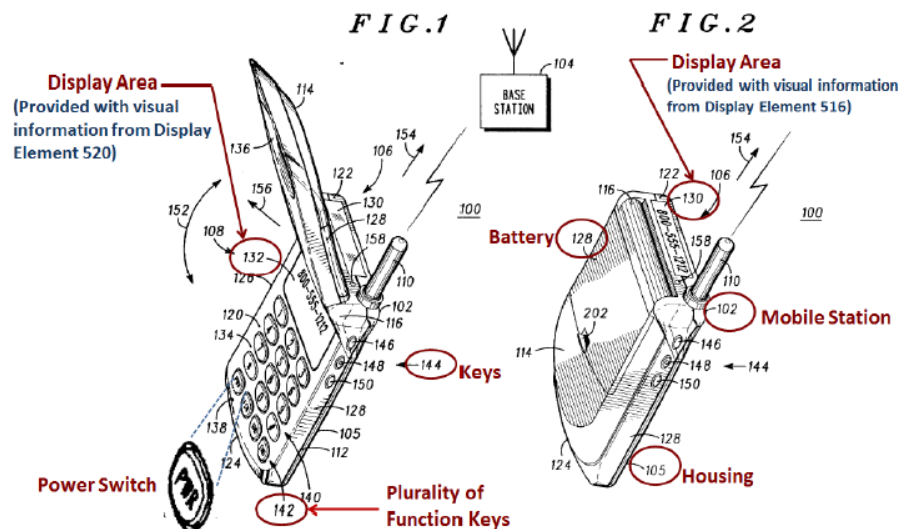
B. Obviousness of the Challenged Claims over the Combination of Jahagirdar and Schultz

Petitioner contends the challenged claims are unpatentable under 35 U.S.C. § 103(a) as obvious in view of Jahagirdar and Schultz. Pet. 31–55. Relying on the testimony of Mark N. Horenstein, Ph.D., *see* Ex. 1015, Petitioner explains how Jahagirdar and Schultz allegedly teach all the claim limitations, and argues a person of ordinary skill in the art would have combined Jahagirdar with Schultz. Pet. 31–55 (citing Ex. 1015).

We have reviewed the Petition, Patent Owner Response, Petitioner’s Reply, and the relevant evidence discussed therein. For the reasons that follow, we determine Petitioner has shown, by a preponderance of the evidence, that the challenged claims would have been obvious in view of the asserted combined teachings of Jahagirdar and Schultz.

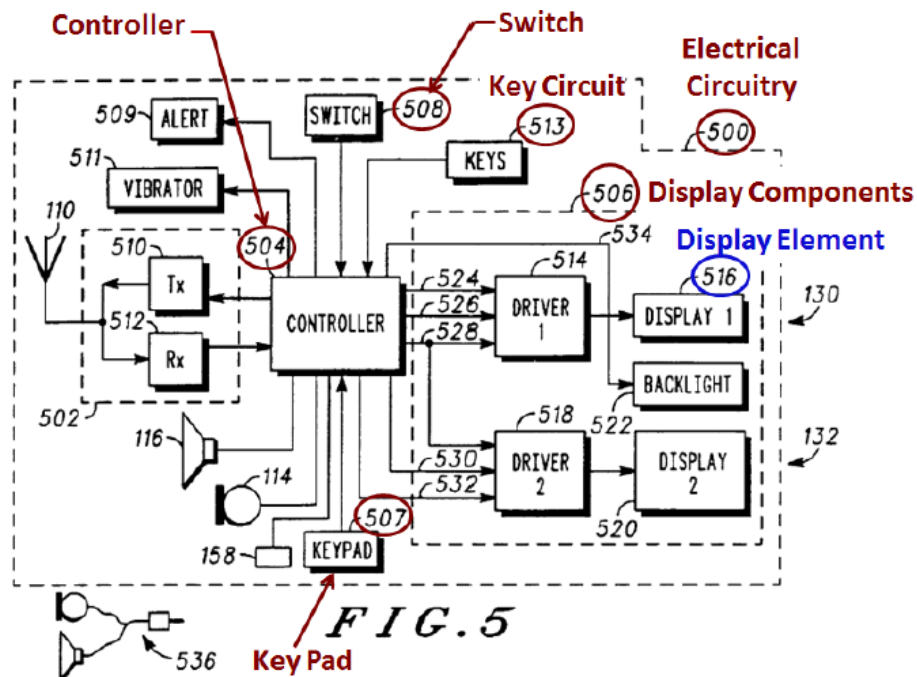
1. Jahagirdar

Jahagirdar describes a mobile phone that has a microchip-controlled user interface and mechanical push-button switches. Ex. 1004, 3:59–67; Ex. 1015 ¶ 33. Figures 1 and 2 of Jahagirdar (with Petitioner’s annotations) are reproduced below.



Pet. 33. Figures 1 and 2 are illustrations of a mobile station having a first display area and a second display area. Ex. 1004, 1:38–40, 3:33, 4:28–29. Figures 1 and 2 also depict various keys, a battery, and housings. *Id.* at 2:18–20, 2:64–65, 3:17–41.

Figure 5 of Jahagirdar (with Petitioner’s annotations) is reproduced below:



Pet. 26. Figure 5 is a schematic block diagram of electrical circuitry 500 of mobile station 102, including display components 506 (with drivers 514 and 518, backlight 522, and displays 516 and 520), key circuit 513, controller 504, switch 508, and keypad circuit 507. Ex. 1004, 1:46–47, 3:59–64, 4:17–63.

2. Schultz

Schultz describes “a reliable touch actuated system . . . responsive to the touch of an animal,” such as “human beings, pets and domestic animals.”

Ex. 1005, 1:27–31. Schultz discloses touch responsive area 67. *Id.* at 4:47–48; Ex. 1015 ¶ 41.

3. Analysis of Obviousness Challenge to Claims 1, 3, and 20

Petitioner asserts the combination of Jahagirdar and Schultz teaches or suggests every limitation recited in claims 1, 3, and 20. *See* Pet. 31–53; Pet. Reply 1–18. Patent Owner contends an ordinarily skilled artisan would not have combined Jahagirdar and Schultz. PO Resp. 4–12. Patent Owner also asserts the proposed combination fails to teach or suggest a “find-in-the-dark indication, when the load is not activated.” *Id.* at 12–19. Patent Owner provides no separate arguments for the patentability of claims 3 and 20, which depend from claim 1. *See id.* at 2, 20.

Petitioner provides detailed mappings of teachings from Jahagirdar to the individual elements of claim 1 and the additional limitations recited in claims 3 and 20, as summarized below. We agree with Petitioner’s assertions, as supported by Dr. Horenstein’s testimony that the combination of Jahagirdar and Schultz teaches or suggests the uncontested limitations recited in claim 1 and the additional limitations recited in dependent claims 3 and 20, and we adopt those assertions as our findings. *See* Pet. 31–47, 50–53.

First, Petitioner contends Jahagirdar teaches each element recited in claim 1 except “a touch sensor” and, accordingly, that the recited “microchip is coupled . . . to the touch sensor” and “configured for activating a visible find-in-the-dark indication,” “in response to at least a signal from the touch sensor.” For example, Petitioner argues Jahagirdar’s mobile station 102, which is connected to battery 128, display element 520, and electronic circuitry 500, teaches the recited “electronic unit . . . connected to a power

source, an energy consuming load and a power circuit that connects the power source to the load.” Pet. 31–32 (citing Ex. 1004, 3:33, 3:59–67, 4:27–30, 4:33–34; Ex. 1015 ¶¶ 53–55). Petitioner further contends the “microchip at least controlling the flow of power from the power source to activate the load” is taught by Jahagirdar’s controller 504, which controls power flow from battery 128 to display element 520. *Id.* at 33 (citing Ex. 1004, 3:60–67; Ex. 1015 ¶¶ 56, 57).

Petitioner asserts Jahagirdar discloses controller 504 turning display element 520 on or off in response to a signal from either switch 508 (when housing portions are opened or closed) or pressing the on/off key that is one of function keys 144. *Id.* at 34–36, 44–47 (citing Ex. 1004, 3:16–24, 4:17–18, 4:21–23, 4:33–34, Fig. 5; Ex. 1015 ¶¶ 58–61, 77–82). Petitioner contends these disclosures in Jahagirdar teach “a switch, wherein the switch is not a serial element in the power circuit, and wherein the switch is a user interface . . . wherein the microchip is coupled to the switch [and] controls the activation and the deactivation of the load in response to a signal from the switch,” as recited in claim 1. *Id.*

Petitioner acknowledges that Jahagirdar alone does not teach touch sensors, but contends touch sensors were well known in the art by the earliest claimed priority date of the ’494 patent. Pet. 36. In particular, Petitioner points to Schultz, which discloses a touch sensor (touch responsive area 67). Pet. 37 (citing Ex. 1005, 1:27–31, 4:46–47; Ex. 1015 ¶ 65). Petitioner asserts the proposed modification of Jahagirdar to incorporate Schultz’s touch sensors into at least some of keys 144 would result in “the microchip [being] coupled . . . to the touch sensor.” *Id.* at 45 (citing Ex. 1004, 4:19–20; Ex. 1015 ¶ 78). As discussed in more detail

below, Petitioner asserts that adding these touch sensors to Jahagirdar would have been obvious to an ordinary skilled artisan.

Regarding dependent claim 3, Petitioner argues Jahagirdar's disclosure of setting a timer to automatically deactivate the visible indicator teaches "the microchip performs an automatic delayed termination of a function that was activated in response to an activation signal receive from the switch or the touch sensor." *Id.* at 50–51. Petitioner asserts claim 20's recitation that "the switch is a push button type switch" would have been obvious because Jahagirdar depicts push button type switches in its keypad and because the '494 patent discloses that push button type switches were well known. *Id.* at 51–52.

Rationale for Combining Schultz and Jahagirdar

Petitioner argues a person having ordinary skill in the art "would have sought to incorporate touch sensors into keys 144 . . . such that Jahagirdar's electrical circuitry included the claimed touch sensor." *Id.* at 36. Petitioner asserts the combination of Schultz's touch sensor with Jahagirdar's mobile phone is merely the combination of known elements performing known functions and yielding predictable results. *Id.* at 42 (citing Ex. 1015 ¶ 75). Petitioner points to various references and to Dr. Horenstein's testimony regarding an ordinarily skilled artisan's knowledge and understanding of the prior art and ability to combine the respective teachings from that prior art. *Id.* at 42–43.

Specifically, Petitioner argues "[i]ncorporating a touch sensor into Jahagirdar would have asked little of a person of ordinary skill, because a touch sensor would have improved Jahagirdar in the same way a touch sensor would have improved any such electronic device." Pet. 42 (citing Ex.

1015 ¶ 68). Petitioner further asserts claim 1 of the '494 patent “does not specify the details of the claimed touch sensor” and “Schultz’s touch sensor could have been integrated into Jahagirdar’s keys 144 in multiple ways depending upon what might have been convenient or desirable.” *Id.* (citing Ex. 1015 ¶ 75). In particular, Petitioner contends Jahagirdar’s keys 144 could have been replaced by one or more touch sensors, such that the touch sensors would perform the functions that Jahagirdar’s keys 144 perform. *Id.* (citing Ex. 1015 ¶ 75 (testifying that, if a person having ordinary skill in the art were to integrate Schultz’s touch sensors into Jahagirdar’s keys 144, it would have been within that person’s technical grasp and knowledge of options to relocate keys 144 or program Jahagirdar’s controller to recognize input to keys 144 when mobile station 102 was in either an open or closed position)). Accordingly, Petitioner argues combining Schultz’s touch sensor with Jahagirdar’s mobile phone would have been obvious because “Jahagirdar and Schultz demonstrated that the elements of claim 1 were well known, and the combination of the techniques described therein would have yielded no more than one would expect from such an arrangement.” *Id.* (citing Ex. 1015 ¶ 75).

Patent Owner’s expert, Dr. Morley, agrees with Petitioner’s underlying assertions as to why the challenged claims would have been obvious: the flip-phone of Jahagirdar and touch sensor of Schultz are prior art; there was no technical barrier to combining the prior art elements; and the result of combining the prior art elements was predictable. Ex. 1017, 176:2–177:13; Ex. 2005 ¶ 32 (correctly stating that “[c]ombining prior art elements according to known methods to yield predictable results” is one exemplary rationale for obviousness). As Dr. Morley explains, the Schultz

touch sensors were not limited by size or arrangement, and a person of ordinary skill could have taken the Schultz sensors and put them into touch sensors the size of the buttons on Jahagirdar. Ex. 1017, 138:17–21, 140:2–13. Additionally, as Dr. Morley acknowledges, the claims of the '494 patent contain no limitations as to the physical form, internal architecture, or arrangement of the touch sensors. *Id.* at 172:12–173:10. Patent Owner presents no argument that the proposed combination would have been beyond the capabilities or knowledge of a person having ordinary skill in the art.

As the Supreme Court has stated, “when a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious.” *KSR*, 550 U.S. at 417 (internal quotation marks omitted). “If a person of ordinary skill can implement a predictable variation . . . § 103 likely bars its patentability.” *Id.* As illustrated by Schultz, the use of a touch sensor as an alternative to a mechanical push button was well known in the prior art. *See* Ex. 1005; Ex. 1015 ¶¶ 40–43. We agree that the combination of Jahagirdar and Schultz teaches the elements of claim 1 as arranged, and we determine the proposed combination would have been obvious, because it merely involves substitution of familiar elements, the combination of which yields predictable results. *See KSR*, 550 U.S. at 417. In particular, we agree that the proposed combination is the simple substitution or modification of Jahagirdar’s keys with Schultz’s known touch sensor. This is, in other words, a textbook case of obviousness. *See Agrizap, Inc. v. Woodstream Corp.*, 520 F.3d 1337, 1344 (Fed. Cir. 2008) (“This is a textbook case of

when the asserted claims involve a combination of familiar elements according to known methods that does no more than yield predictable results.”). Patent Owner does not point us to objective evidence of nonobviousness to overcome the textbook case of obviousness here.

Furthermore, Petitioner offers additional reasons an ordinarily skilled artisan would have modified or replaced Jahagirdar’s keys with Schultz’s touch sensor. In particular, Petitioner contends Schultz explicitly identified certain advantages of its touch sensor, including minimizing accidental actuation and eliminating contamination and mechanical failures associated with switches having moving parts. Pet. 38 (citing Ex. 1015 ¶ 67); Ex. 1005, 1:9–24. Petitioner further contends an ordinarily skilled artisan would have incorporated Schultz’s touch sensor switches into Jahagirdar’s mobile phone “to enhance convenience and aesthetics for the user.” *Id.* (citing Ex. 1015 ¶ 67).

Patent Owner argues Petitioner’s additional reasons are insufficient rationales for an ordinarily skilled artisan to combine Jahagirdar and Schultz. PO Resp. 6–12. Specifically, Patent Owner argues that replacing Jahagirdar’s keys 144 with Schultz’s touch sensor would actually increase accidental actuations because a user would contact the touch sensors while carrying or using the phone due to the location of touch sensors on the side of the phone. *Id.* at 6–7. Patent Owner also argues incorporating touch sensors into Jahagirdar’s mobile device would decrease convenience due to increased accidental actuation and would result in aesthetic losses, not gains. *Id.* at 8–9. Finally, Patent Owner contends Jahagirdar’s keys 144 would not be subject to contamination or mechanical failure and, to the extent they are, a person of ordinary skill in the art would have replaced keys 144 with

switches other than touch sensors, such as membrane switches. *Id.* at 9–11 (citing Ex. 2005 ¶¶ 64–67; Ex. 1001, 8:4–10).

Notwithstanding Patent Owner’s position that the proposed combination would increase accidental actuations when grabbing or holding Jahagirdar’s mobile station, Petitioner points to Dr. Morley’s testimony that touch sensors would alleviate accidental actuation by *inanimate* objects (e.g., “clothes, objects in a bag, [and] surfaces of furniture”). Pet. Reply 2 (citing Ex. 1017, 157:20–158:23; Ex. 2006 ¶ 63). Accordingly, Petitioner argues a person having ordinary skill in the art looking to reduce inadvertent actuation by inanimate objects would be motivated to incorporate Schultz’s touch sensor. *Id.* at 2–3 (citing Ex. 1023 ¶¶ 4–5). Moreover, Petitioner’s un rebutted evidence in the record demonstrates Schultz’s touch sensor could have been integrated into Jahagirdar’s keys 144 in multiple ways, depending upon what might have been convenient or desirable. *Id.* at 3–4 (citing Ex. 1015 ¶ 75); Ex. 1023 ¶ 5. For example, a person of ordinary skill would have been readily able to relocate those touch sensors to different locations, or “one of skill could have easily programmed Jahagirdar’s controller such that touch sensor inputs were only recognized at appropriate times for example, depending on whether the mobile station 102 was opened or closed.” Ex. 1015 ¶ 75. In such a way, inadvertent actuation of the touch sensors would be minimized or eliminated.

Even assuming that other switches, such as membrane switches, would have been available or preferable for reducing contamination and mechanical failures, Petitioner argues that would not render the proposed combination nonobvious. Pet. Reply at 8–10. Finally, regarding the argument that a person having ordinary skill would look to add Schultz’s

touch sensor to Jahagirdar's keys 144 due to aesthetic concerns, Petitioner asserts Dr. Morley admitted aesthetics might be a reason to design a product with touch sensors and has offered no reasons why some phone designers or users would ignore aesthetics. *Id.* at 6 (citing Ex. 1017, 171:24–172:3).

Petitioner also points to examples of products that integrated touch sensors into user interfaces. Pet. 40–41 (citing Exs. 1006, 1008, 1009); Pet. Reply 6.

We have reviewed the parties' arguments and evidence and determine that a preponderance of the evidence in the record supports a conclusion that it would have been obvious to combine the asserted teachings. Patent Owner's primary argument against Petitioner's additional reasons for its proposed combination is that touch sensors on Jahagirdar's mobile phone would increase inadvertent actuations when grabbing or holding the modified mobile phone. See PO Resp. 4–12. However, we determine an ordinarily skilled artisan would have been capable of assessing any benefits and harms of integrating a touch sensor into Jahagirdar's mobile phone and, using ordinary creativity, deciding whether to modify the arrangement of keys 144 or program the phone to recognize touch sensor inputs only in certain circumstances in order to minimize or eliminate inadvertent actuation. See *KSR*, 550 U.S. at 417 (“If a person of ordinary skill can implement a predictable variation . . . § 103 likely bars its patentability”); *id.* at 421 (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”); Ex. 1015 ¶ 75. Moreover, we determine one of ordinary skill in the art would have been motivated to pursue the desirable properties of touch sensors, as taught by Schultz, even at the potential expense of forgoing a benefit of the push buttons taught by Jahagirdar. See *In re Urbanski*, 809 F.3d 1237, 1243 (Fed. Cir. 2016).

Whether Jahagirdar Teaches or Suggests a Load

As discussed above, Petitioner argues display element 520 teaches the recited load. *See, e.g.*, Pet. 32. Petitioner contends display element 520 is sufficient to teach the recited load because display element 520 “was a part of the product (mobile station 102) as illustrated, and the display element 520 consumed energy, because it was, for example, an LED or LCD device, and because it received power under the direction of the controller 504.” *Id.* at 53 (citing Ex. 1004, 4:31–32, 4:43–46; Ex. 1015 ¶ 95).

Patent Owner argues a “load” must be “an energy consuming drain that – if not placed under the control of the microchip – threatens to drain the exhaustible power supply such as the battery 128 of Jahagirdar.” PO Resp. 15 (citing Ex. 2005 ¶¶ 10–15). Patent Owner asserts that because Jahagirdar is a mobile phone that is dependent on its transceiver to communicate, only its transceiver can be a load. PO Resp. 16–17. Patent Owner further contends only the transceiver is “a significant drain on the battery.” *Id.* at 19.

Petitioner counters Patent Owner has no support for its contention that the recited load should depend “on assessing the ‘essential character’ of a given electronic device.” Pet. Reply 16. Petitioner contends the specification of the ’494 broadly describes energy consuming load 105 as being “for example a bulb, LED or other light generating element.” *Id.* (quoting Ex. 1001, 14:4–6). Moreover, Petitioner argues display element 520 teaches a load, even when considering Patent Owner’s proposed construction of a load as one that threatens to drain the battery if not placed under the control of the microchip. *Id.* at 18. Specifically, Petitioner asserts “[c]ontrolling display element 520 to conserve battery life is exactly the goal

of Jahagirdar: “[a]ccordingly, what is needed is a communication device . . . that does not substantially increase a power consumption or cost of the communication device.” *Id.* (quoting Ex. 1004, 1:31–35).

First, we note that even Patent Owner’s declarant, Dr. Morley, disagrees with the statement in the Patent Owner Response that display element 520 cannot be considered the load recited in claim 1. *See* Ex. 1017, 105:7–14 (explaining that the assertion that display element 520 cannot be considered a load was not his opinion), 111:21–112:8. Applying the broadest reasonable interpretation consistent with the specification, we disagree with Patent Owner’s implication that the recited load can be only the characteristic element of an electrical device or that whether an element is a load depends on an objective determination of whether the drain from that element is “significant.” Nor are we persuaded that the load should be limited to “an energy consuming drain that – if not placed under the control of the microchip – threatens to drain the exhaustible power supply such as the battery 128 of Jahagirdar,” as explicitly proposed by Patent Owner.

Patent Owner does not direct us to anything in the specification of the ’494 patent sufficient to support a narrower construction of “load” than its plain and ordinary meaning as an element in an electrical circuit that draws power from a power source. Ex. 1017:8–13 (Dr. Morley testifying that “[a]ny energy-consuming module or element in a circuit can be considered to be a load, and an LED . . . could be considered to be a load”). Therefore, we determine display element 520 teaches the recited load because it is an element in electrical circuitry 500 of mobile station 102 that draws energy from battery 128. Moreover, even under Patent Owner’s proposed construction, we determine display element 520 teaches the recited load

because the evidence suggests display 520 would drain battery 128 if not controlled by controller 504.

*Whether the Combination of Jahagirdar and Schultz
Teaches or Suggests a Activating a FITD Indication
When the Load is Not Activated*

Petitioner argues Jahagirdar's display element 516 teaches the recited FITD indication. Pet. 47. Specifically, Petitioner asserts display element 516 teaches a FITD indication because it includes an LED that emits light, which "would have created a visible, audible or other human detectable signal that would assist a person to locate a product in the dark." *Id.* at 54 (citing Ex. 1015 ¶ 96).

Patent Owner argues "[a]n essential aspect of the recited [FITD] feature is that it provides assistance to the user who does not know precisely where the device, or the switch to activate it, is in the dark." PO Resp. 12. Patent Owner discusses an embodiment disclosed in the '494 patent involving proximity detection in which "a proximity detector is provided such that if the user passes their hand close to the device, the switch to be pressed glows." *Id.* Patent Owner asserts that disclosure "is the nature of an FITD feature – it allows the user to 'find it in the dark.'" *Id.* at 12–13. Patent Owner argues Jahagirdar's display element 516 is not a FITD indication because "the user must hold the phone in his hand – the user *must know where the external display* is 'and close the flap of the flip phone to activate it.'" *Id.* at 13 (citing Ex. 2005 ¶ 57); *see id.* at 13–15.

Petitioner argues display element 516 enables someone to find the phone in the dark from the time display element 516 is activated until expiration of the timer that automatically deactivates display element 516. Pet. Reply 12; *id.* (asserting "Dr. Morley admitted that Jahagirdar's LED

would have indicated the phone's location while the LED was on" (citing Ex. 1017, 198:15–199:11)). Petitioner notes claim 1 does not recite any required length of time for the FITD indication to be active. *Id.*

Petitioner also disputes Patent Owner's assertion that display element 516 cannot be a FITD indication because the user must know the location of the touch sensor. *Id.* at 13. Petitioner contends the claim requires activating the FITD indication using the touch sensor, which requires that the "user must at least know the location of the touch sensor of the electronic device." *Id.* Moreover, Petitioner provides examples of situations where Jahagirdar's display element 516 may serve to aid a user in finding the phone, or particular parts of the phone. *Id.* at 13–14 (citing Ex. 1023 ¶ 3).

We agree with Petitioner that display element 516, configured as an LED display, is a "find-in-the-dark indication," as recited in claim 1. *See* Pet. 47, 54; Pet. Reply 11–14. First, as Petitioner points out, Patent Owner's expert Dr. Morley admits that Jahagirdar's LED display element 516 indicates the location of the phone "until the battery dies." Ex. 1017, 198:15–21; *see* Pet. Reply 12–13. Moreover, even when LED display element 516 turns off after expiration of a timer, Dr. Morley admits the LED display would help a person find the phone in the dark during the time that it remains illuminated. Ex. 1017, 198:15–199:11; *see* Pet. Reply 12; *see also* Ex. 1004, 5:64–65, Fig. 8A (timer for display element 516 set in step 818 and expired in step 826). Notably, because the claim language does not place any limitation on how long the location indicator must function, the length of time display element 516 is visible does not preclude display element 516 from teaching a FITD. Finally, to the extent Patent Owner argues that a FITD indication can aid in finding the product only if its

location is unknown, Patent Owner identifies no support in the '494 patent for such an interpretation. *See* PO Resp. 12–15; Pet. Reply 12–14. Thus, Jahagirdar's display element 516 teaches the recited “find-in-the-dark indication.”

Patent Owner also argues that, even to the extent display element 516 constitutes a FITD indication, display element 516 is never activated when the transceiver is not activated. *Id.* at 17–18. Based on Patent Owner's contention that only the transceiver teaches the recited load, Patent Owner argues the FITD indication is therefore not activated “when the load is not activated.” *Id.* However, as discussed above, we are not persuaded that only the transceiver teaches the recited load. Because we find Jahagirdar's display element 520 teaches a load, Patent Owner's argument that Jahagirdar does not teach activating the FITD indication when the load is not active fails.

III. CONCLUSION

Based on the evidence and arguments, Petitioner has demonstrated, by a preponderance of the evidence, that claims 1, 3, and 20 of the '494 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over Jahagirdar and Schultz.

IV. ORDER

Accordingly, it is:

ORDERED that claims 1, 3, and 20 of the '494 patent have been shown to be unpatentable; and

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FURTHER ORDERED that, because this is a final written decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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