

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC., LG ELECTRONICS, INC.,
LG ELECTRONICS U.S.A., INC., and GOOGLE LLC,
Petitioner,

v.

GESTURE TECHNOLOGY PARTNERS, LLC,
Patent Owner.

IPR2021-00923¹
Patent 8,194,924 B2

Before PATRICK R. SCANLON, BRENT M. DOUGAL, and
SCOTT RAEVSKY, *Administrative Patent Judges*.

DOUGAL, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining No Challenged Claims Unpatentable
35 U.S.C. § 318(a)

¹ IPR2022-00093 (LG Electronics, Inc. and LG Electronics U.S.A., Inc.) and IPR2022-00361 (Google LLC) have been joined with this proceeding.

I. INTRODUCTION

A. *Background and Summary*

Applying the standard set forth in 35 U.S.C. § 314(a), we instituted an *inter partes* review challenging the patentability of claims 1–14 (“the challenged claims”) of U.S. Patent 8,194,924 B2 (Ex. 1001, “the ’924 patent”). Paper 10 (“Decision” or “Dec.”). Apple Inc., filed the request for an *inter partes* review (Paper 1, “Petition” or “Pet.”), which Patent Owner, Gesture Technology Partners, LLC, opposed (Paper 8). We subsequently granted requests filed by LG Electronics, Inc., LG Electronics U.S.A., Inc., and Google LLC to join this proceeding as a petitioner.² Papers 13, 15.

After institution, Patent Owner filed a Response (Paper 12, “PO Resp.”), Petitioner filed a Reply (Paper 17, “Reply”), and Patent Owner filed a Sur-reply (Paper 18, “Sur-reply”). An oral hearing was held on September 14, 2022, and a copy of the transcript is in the record. Paper 26 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This Decision is a Final Written Decision under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73 as to the patentability of the claims on trial. Having reviewed the arguments of the parties and the supporting evidence, we determine that Petitioner has not shown by a preponderance of the evidence that claims 1–14 are unpatentable.

B. *Related Matters*

The following are identified as related District Court cases: *Gesture Technology Partners, LLC v. Huawei Device Co., Ltd.*, No. 2:21-cv-00040 (E.D. Tex.); *Gesture Technology Partners, LLC v. Samsung Electronics Co.*,

² Apple Inc., LG Electronics, Inc., LG Electronics U.S.A., Inc., and Google LLC are referred to collectively hereinafter as “Petitioner.”

No. 2:21-cv-00041 (E.D. Tex.); *Gesture Technology Partners, LLC v. Apple Inc.*, No. 6:21-cv-00121 (W.D. Tex.); *Gesture Technology Partners, LLC v. Lenovo Group Ltd.*, No. 6:21-cv-00122 (W.D. Tex.); *Gesture Technology Partners, LLC v. LG Electronics, Inc.*, No. 6:21-cv-00123 (W.D. Tex.); *Gesture Technology Partners, LLC v. Motorola Mobility LLC*, No. 1:22-cv03535 (N.D. Ill); and *Gesture Technology Partners, LLC v. Katherine K. Vidal*, No. No. 1:22-cv-622 (E.D. VA). Paper 19, 1–3. Patent Owner identifies these related Board proceedings: IPR2021-00917; IPR2021-00920; IPR2021-00921; and IPR2021-00922. Paper 6, 2. Patent Owner identifies these related *Ex Parte* Reexaminations: No. 90/014,900; No. 90/014,901; No. 90/014,902; and No. 90/014,903. Paper 19, 3–4.

C. The '924 Patent

The '924 patent is entitled “Camera Based Sensing in Handheld, Mobile, Gaming or Other Devices.” Ex. 1001, code (54). The '924 patent “relates to simple input devices for computers, . . . and operating by optically sensing a human input to a display screen or other object and/or the sensing of human positions or orientations.” *Id.* at 2:7–11. In general, the '924 patent discloses numerous applications in which a user or an object held by a user can control a computer with one or more cameras as depicted in Figure 1A below.

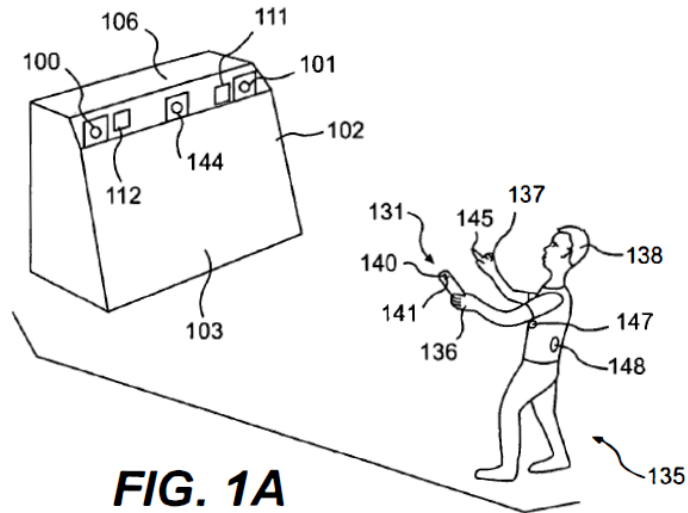


Figure 1A shows “a combination of one or more TV cameras (or other suitable electro-optical sensors) and a computer to provide various position and orientation related functions of use.” *Id.* at 3:19–23. As shown, there are multiple cameras (100, 101, 144) located on a monitor (102) with a screen (103) facing a user and connected to a computer (106). *Id.* at 3:27–57.

The '924 patent discloses a handheld computer with multiple cameras (1902, 1910) depicted in Figure 18 below. *Id.* at 25:40–45.

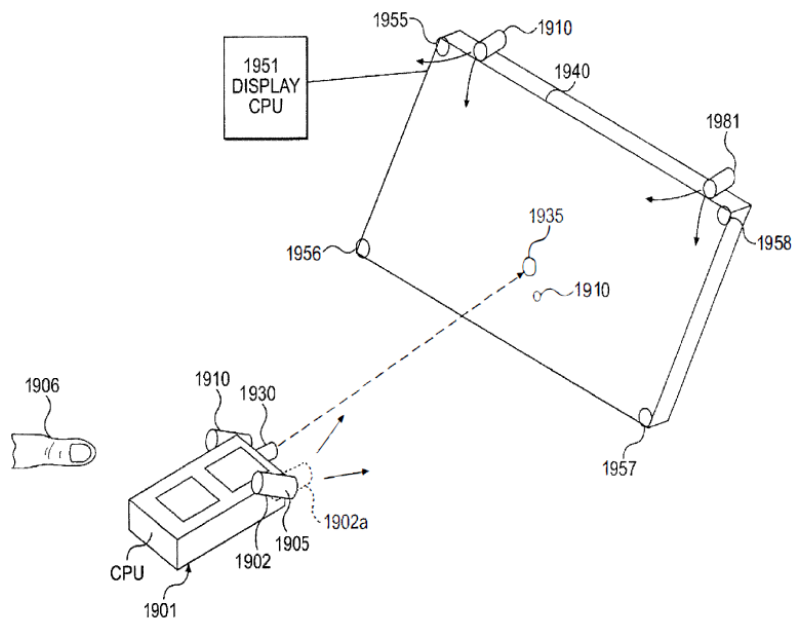


Fig. 18

As illustrated in Figure 18, a handheld computer (1901) with central processing unit (CPU) houses a camera (1902) that can be paired in stereo with another camera (1910), either of which may rotate about an axis to view a user or aspect of that user like a finger (1906). *Id.* at 25:40–43. When aimed at the user, the camera(s) can be used to obtain images and video images of a user’s fingers, hand, objects in the hand, gestures, and facial expressions. *Id.* at 25:50–63. Facing one or more of the cameras away from the user, they “can also be used to see gestures of others.” *Id.* at 26:25.

D. Illustrative Claim

Petitioner challenges claims 1–14 of the ’924 patent. Claim 1 is the sole independent claim and is illustrative:

1. A handheld device comprising:

a housing;

a computer within the housing;

a first camera oriented to view a user of the handheld device and having a first camera output; and

a second camera oriented to view an object other than the user of the device and having a second camera output, wherein the first and second cameras include non-overlapping fields of view, and wherein the computer is adapted to perform a control function of the handheld device based on at least one of the first camera output and the second camera output.

Ex. 1001, 26:54–65.

II. ANALYSIS

A. Summary of Issues

In the below analysis, we first address the grounds of unpatentability. We then address Patent Owner’s jurisdiction argument.

B. Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability (Pet. 6), supported by the declaration of Benjamin B. Bederson (Ex. 1003):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–6, 11, 14	103(a) ³	Mann, ⁴ Numazaki ⁵
7, 8, 10, 12, 13	103(a)	Mann, Numazaki, Amir ⁶
6, 9	103(a)	Mann, Numazaki, Aviv ⁷

1. Legal Standards for Unpatentability

Petitioner bears the burden to demonstrate unpatentability. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

A claim is unpatentable as obvious under 35 U.S.C. § 103 if “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (quoting 35 U.S.C. § 103(a)). We resolve the question of obviousness based on underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the prior art and the claims; (3) the level of skill in the art; and (4) when in evidence,

³ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. § 103 effective March 16, 2013. Because the challenged patent claims priority before March 16, 2013, we refer to the pre-AIA versions.

⁴ Canadian Published Patent Application 2,237,939, published Aug. 28, 1998 (“Mann”) (Ex. 1004).

⁵ U.S. Patent 6,144,366, issued Nov. 7, 2000 (“Numazaki”) (Ex. 1005).

⁶ U.S. Patent 6,539,100 B1, issued Mar. 25, 2003 (“Amir”) (Ex. 1006).

⁷ U.S. Patent 5,666,157, issued Sept. 9, 1997 (“Aviv”) (Ex. 1007).

objective indicia of nonobviousness. *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

We apply these principles to the Petition’s challenges.

2. *Level of Ordinary Skill in the Art*

Petitioner asserts that “[a] person having ordinary skill in the art (‘PHOSITA’) at the time of the ’924 Patent would have had at least a bachelor’s degree in electrical engineering or equivalent with at least one year of experience in the field of human computer interaction” and that “[a]dditional education or experience might substitute for the above requirements.” Pet. 5 (citing Ex. 1003 ¶¶ 29–31). Patent Owner does not dispute Petitioner’s level of ordinary skill in the art. PO Resp. 7.

We are persuaded, on the present record, that Petitioner’s declarant’s statement is consistent with the problems and solutions in the ’924 patent and prior art of record. We adopt this definition for the purposes of this Decision.

3. *Obviousness over Mann and Numazaki*

Petitioner argues that the combination of Mann and Numazaki would have rendered obvious claims 1–6, 11, and 14. Pet. 7–49. Patent Owner provides a number of different arguments contesting the combination of Mann and Numazaki. PO Resp. 7–29.

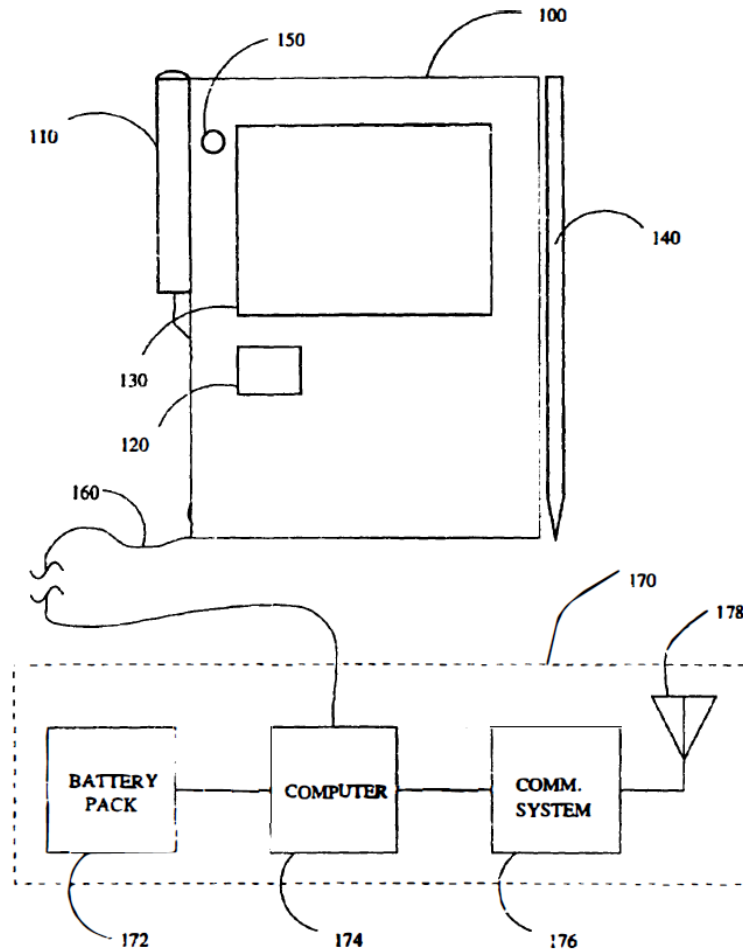
We first give an overview of Mann. This is followed by a summary of Petitioner’s position and Patent Owner’s argument that Petitioner fails to establish that Mann is analogous art to the ’924 patent.

a) *Mann*

Mann is directed to “a personal camera with viewfinder means and a personal video annotation system.” Ex. 1004, Abstract. Mann states that

“[t]he camera system integrates the process of making a personal handwritten diary or the like, with the capture of video.” *Id.*

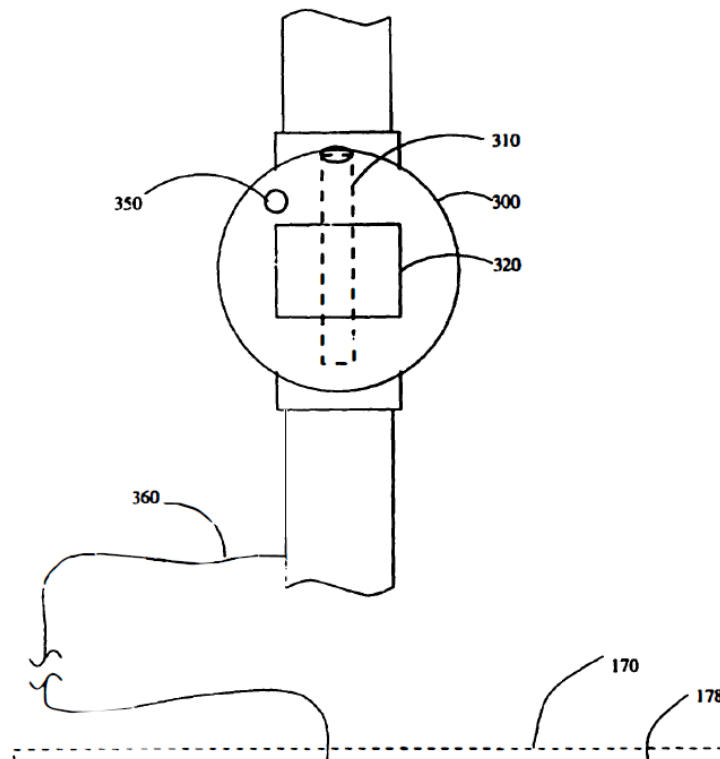
Figure 1 depicts an embodiment with “a camera borne by a personal digital assistant (PDA).” *Id.* at 10.



As shown in Figure 1, the PDA includes a video camera (110), an auxiliary screen (120) for displaying the image captured by the video camera, a screen for notetaking (130), and a pen (140). *Id.* at 11–12. Mann teaches that the PDA can optionally include a second camera (150) “if the user wishes to make a video recording of himself/herself while recording another person with camera 110,” so as to record “both sides of the conversation.” *Id.* at 12. The PDA is connected, via wire (160) that may “run up the sleeve of the user” to a separate body worn pack (170). *Id.* The body pack includes a

battery pack (172), a computer system (174), and a communications system (176). The communications system contains a “packet radio terminal node controller (high level data link controller with modem) and radio, which typically establishes an Internet connection by way of antenna 178.” *Id.*

Mann also teaches a “wristwatch embodiment 300 of the invention depicted in Fig[ure] 1,” which is shown in Figure 3. *Id.* at 13. A detail view of Figure 3 is reproduced below, where the separate body worn pack (170) is not fully depicted, as it is identical to that shown in Figure 1.



In the detail view of Figure 3 above, a wristwatch (300) is illustrated which houses a first camera (310) pointed to record another person from the wearer and a second camera (350) to record the wristwatch wearer interviewing the other person. *Id.* The wristwatch also includes a viewfinder in the form of an auxiliary screen (320) which shows what the first camera is seeing. *Id.* As in the prior embodiment, cabling runs to the separate body worn pack (170) which includes a battery pack (172), a computer system

(174), and a communications system (176). In this way the “video from camera 310 may be transmitted and recorded at remote sites, while the wearer of the wristwatch may be advised by a remote legal expert on the best approach for dealing with the corrupt or disrespectful official.” *Id.* at 13–14. Mann teaches that “[i]nteraction with the wristwatch version of the invention . . . may be done through a pen-based or touch-based interface to the screen.” *Id.* at 14.

b) General Overview of Petitioner’s Position for Claim 1

Petitioner relies on two different combinations of Mann and Numazaki for teaching or suggesting all of the elements of claim 1. Pet. 18–42. Petitioner combines the PDA shown in Mann’s Figure 1 with aspects of the compact portable information device shown in Numazaki’s Figure 78. *Id.* Petitioner alternatively combines Mann’s wristwatch shown in Figure 3, with aspects of Numazaki’s wristwatch shown in Figure 79. Petitioner appears to be arguing that though the form factors are different (PDA v. wristwatch), the disclosed hardware and functionality are essentially the same. Petitioner further appears to be arguing that, at least with respect to claim 1, either combination satisfies all limitations.

c) Analogous Art

Patent Owner argues that “Petitioner has failed to establish that *Mann* is analogous art [to the ’924 patent] and thus *Mann* cannot be used in an obviousness rejection.” PO Resp. 23.

A reference qualifies as prior art for an obviousness determination only when it is analogous to the claimed invention. *See In re Klein*, 647 F.3d 1343, 1348 (Fed. Cir. 2011). The Federal Circuit has laid out two separate tests to determine whether a reference is analogous art to the claimed invention, i.e., whether one of ordinary skill in the art would even look to the

teachings of that reference. *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). They are: “(1) whether the art is from the same field of [the inventor’s] endeavor” and “(2) if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.” *Id.*; *see also In re Klein*, 647 F.3d at 1348.

Petitioner only addresses the first test (“field of endeavor”) and has thus waived any arguments related to the second test (“reasonably pertinent to the particular problem”).

The Petition alleges that

Because *Mann*, like the ’924 Patent, discloses a portable camera system that may be controlled by human gesture input, *Mann* is in the same field of endeavor as the ’924 Patent. *Compare Mann* (Ex. 1004), 1 (describing a “new photographic or video means and apparatus typically comprising a hand-held portable electronic camera system with viewfinder means and electronic pen-based annotation means” in the form of a PDA and wristwatch with a touch-based interface screen), 11, 12, 14 (describing clock face gestures used to control device) *with ’924 Patent* (Ex 1001), Abstract, 25:40-41, 25:50-63 (describing a “[m]ethod and apparatus . . . to enable rapid TV camera and computer based sensing in . . . handheld devices” used to detect a user’s fingers and gestures)).

Id. at 13 (alterations in original).

The Petition does not expressly define the field of endeavor of either the ’924 patent or *Mann*. Rather, the Petition takes the approach that because there is overlap in a general category of disclosure, “a portable camera system that may be controlled by human gesture input,” *Mann* and the ’924 patent are “in the same field of endeavor.” PO Resp. 24.

Because of this unique approach, the Petition when discussing the prior art references Amir and Aviv in the later obviousness grounds,

characterizes the disclosure differently: “the ’924 Patent, discloses a portable camera system that controls the operation of the device based on captured image information,” and “the ’924 Patent, discloses a camera system that controls the operation of the device based on captured image information” Pet. 49–50, 61 (citing Ex 1001, Abstr., 25:40–41, 25:50–63). Though these characterizations are similar, one requires a “portable” camera system, and the other is merely a “camera system.”

In response to Patent Owner’s arguments, Petitioner simply states that these cited disclosures are the fields of endeavor. Reply 24. Petitioner’s Reply provides no further explanation or discussion. *See id.* For example, Petitioner does not explain why it is appropriate to determine that the same cited disclosures in the ’924 patent (Ex 1001, Abstr., 25:40–41, 25:50–63) define different fields of endeavor as Petitioner now asserts.⁸ Petitioner also does not acknowledge that the Petition’s characterizations of the disclosure of the ’924 patent with relation to Amir and Aviv does not cover Mann. Mann does not “disclose[] a camera system that controls the operation of the device based on captured image information.” *See* Ex. 1004; *see also* Pet. 13 (citing Ex. 1004, 1, 11, 12, 14 as teaching pen-based and touch-based inputs).

At the hearing, Petitioner characterized the asserted field of endeavor with relation to Amir and Aviv as “slightly broader” than that discussed with respect to Mann, and stated that they are not competing. Tr. 24. However, this is not the case. Petitioner’s asserted field of endeavor covering Mann does not require that the human gesture input be “captured image

⁸ During the hearing, Petitioner acknowledged that this is not consistent with common practice. Tr. 23–24.

information” as it does for Amir and Aviv. On the other hand, if the field of endeavor of “a portable camera system that may be controlled by human gesture input” requires that the human gesture input be “captured image information,” then the field of endeavor does not cover Mann for the reason discussed above.

We find that Petitioner has not satisfied its burden to show that Mann is analogous art to the ’924 patent. As noted above, Petitioner waived all arguments related to the question of “reasonably pertinent to the particular problem” and only addresses the “field of endeavor.” Though it may be sufficient to provide no or minimal analysis in the Petition concerning analogous art, including field of endeavor (*see e.g.*, IPR2021-00564, Paper 58, 24–25), Petitioner’s Reply did not provide any additional analysis as to why the identified field of endeavor is correct or supported by the ’924 patent or Mann (*see* Reply 24). Rather, Petitioner merely asserts that its different characterizations of the disclosure of the ’924 patent are the field of endeavor for the ’924 patent. *Id.* As noted above, the asserted fields of endeavor with respect to Amir and Aviv do not cover Mann.

Petitioner provides no analysis as to why it is appropriate to have different fields of endeavor all based on the same disclosure. For example, the Petition takes the contradictory positions that the cited portions of the ’924 patent teach that the field of endeavor may or may not require “control[of] the operation of the device based on captured image information.” In addition, the Petition takes the contradictory positions that the cited portions of the ’924 patent teach that the field of endeavor may or may not require “human gesture input.”

Of the three citations to the ’924 patent relied on by Petitioner (Pet. 13 (citing Ex 1001, Abstr., 25:40–41, 25:50–63)), none support Petitioner’s

position as to the field of endeavor of the '924 patent—the Abstract refers to camera based sensing, 25:40–41 says a handheld computer includes a camera, and 25:50–63 describes a camera obtaining an image of many things, including gestures. None of these citations describe controlling a portable camera system by human gesture input. None of these citations describe controlling a camera system based on captured image information. Thus, even if any of Petitioner's positions as to the field of endeavor of the '924 patent were correct, Petitioner provides no citations to the '924 patent that support its position.

For these reasons, Petitioner has not satisfied its burden to show that Mann is analogous art to the '924 patent.

Further, we determine that Petitioner's identified field of endeavor for the '924 patent and Mann ("a portable camera system that may be controlled by human gesture input") is incorrect. Pet. 13.

We find the evidence of record from both Petitioner and Patent Owner from before this dispute arose to be very informative as to the proper field of endeavor of the '924 patent. Petitioner and Petitioner's declarant both introduce the '924 patent as being directed to "computer devices that 'optically sens[e] human input' using one or more cameras, contemplating applications in a "variety of fields such as computing, gaming, medicine, and education." Ex. 1003 ¶ 32 (quoting Ex. 1001, 2:7–23); Pet. 1 (identical); *see also* Paper 8, 2 (Patent Owner highlighting similar disclosure). Petitioner and Petitioner's declarant then go on to describe both the embodiments of the '924 patent and the claims as requiring computer devices that optically sense human input using one or more cameras. Ex. 1003 ¶¶ 32–34; Pet. 1–3; *see also* Paper 8, 2–5 (Patent Owner highlighting similar disclosure).

Petitioner highlights that during prosecution all of the claims were amended to require two cameras. Pet. 4–5.

The parties’ summaries of the ’924 patent are generally consistent with the title, abstract, field of invention, and claims of the ’924 patent. Ex. 1001, code (54) (“Camera based sensing . . .”), Abstr. (“TV camera and computer based sensing”), 2:7–23 (“optically sensing a human input”), claim 1 (“a first camera . . . and a second camera” “perform a control function of the handheld device based on at least one of the first camera output and the second camera output”).

From the above disclosures, as well as the ’924 patent generally, we agree with the parties that the ’924 patent is directed to “computer devices that ‘optically sens[e] human input’ using one or more cameras.” Ex. 1003 ¶ 32 (quoting Ex. 1001, 2:7–23); Pet. 1 (identical); *see also* Paper 8, 2 (Patent Owner highlighting similar disclosure). Implicit in this statement is that the human input is used to control the computer device.

Thus, Petitioner’s field of endeavor of “a portable camera system that may be controlled by human gesture input” (Pet. 13) for the ’924 patent, is both too narrow, “portable,” and yet also too general, “human gesture input” not tied to optically sensing the input with a camera. If anything, camera based sensing of the input is the one feature that is present in all of the noted sections of the ’924 patent and is highlighted by the parties. Interestingly, camera based sensing of the input is included in the fields of endeavor with respect to Amir and Aviv in the Petition, but absent without explanation in the first. This is a further reason why Petitioner does not satisfy its burden; the proper field of endeavor of the ’924 patent should include camera based sensing of the input.

Further, as previously discussed, Mann does not disclose controlling a computer with human gesture input that is optically sensed with a camera.

For all of these reasons, Petitioner has not established by a preponderance of the evidence that Mann is analogous art to the '924 patent. Nor has Petitioner established that Mann is a proper reference for use in an obviousness challenge.

d) Conclusion for Claims 1–6, 11, 14

As Petitioner has not established that Mann is a proper reference for use in an obviousness challenge, Petitioner has not established by a preponderance of the evidence that claims 1–6, 11, and 14 are obvious over the combination of Mann and Numazaki.

4. Obviousness over Mann, Numazaki and Amir or Aviv

Petitioner argues that the combination of Mann, Numazaki and Amir renders obvious dependent claims 7, 8, 10, 12, and 13. Pet. 49–59. Petitioner argues that the combination of Mann, Numazaki, and Aviv renders obvious dependent claims 6 and 9. *Id.* at 59–65.

As Petitioner has not established that Mann is a proper reference for use in an obviousness challenge, Petitioner has not established by a preponderance of the evidence that claims 6–10, 12, and 13 are obvious over any combination involving Mann.

C. Jurisdiction over Expired Patents

Patent Owner argues that the USPTO does not have jurisdiction over expired patents. PO Resp. 1–2. Rather, Patent Owner argues, the USPTO only has jurisdiction over patents with claims that can be amended or cancelled. *Id.* Patent Owner states that, as explained by the Supreme Court, “Congress [has] significant latitude to assign [the] adjudication of public rights to entities other than Article III courts,” including for the USPTO to

“reexamine—and perhaps cancel—a patent claim in an inter partes review.” *Id.* (quoting *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 138 S. Ct. 1365, 1368, 1374 (2018)). However, Patent Owner argues that this authority does not extend to expired patents because the public franchise associated with an issued patent no longer exists after expiration. *Id.* at 2. Thus, it is argued, the USPTO no longer has jurisdiction, even though the patent owner “may be entitled to collect damages” for patent infringement, because “the patent owner[] no longer has the right to exclude others” and the USPTO has nothing to cancel or amend. *Id.*

Patent Owner reasons that:

Expiration removes the patent from the [US]PTO’s jurisdiction and returns it to the sole jurisdiction of the Article III courts, which have exclusive authority to govern claims for damages. If this were not so, the [US]PTO would purport to have authority to retroactively modify a public franchise that no longer exists, in a setting where the expired public franchise does not enjoy any presumption of validity and in which amendment of claims is no longer permitted.

Id.

Inter partes review of patents, whether expired or not, fits within the USPTO’s mandate “for the granting and issuing of patents” (35 U.S.C. § 2(a)(1)), for as the Supreme Court has stated, “[i]nter partes review is ‘a second look at an earlier administrative grant of a patent’” (*Oil States Energy Servs.*, 138 S. Ct. at 1374 (quoting *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144 (2016))). Our rules have also made clear that *inter partes* review covers expired patents. 37 C.F.R. 42.100(b) (2012); *see also*, e.g., 83 Fed. Reg. 51341 (Oct. 11, 2018) (Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial

and Appeal Board)⁹ (“The claim construction standard adopted in this final rule also is consistent with the same standard that the Office has applied in interpreting claims of expired patents and soon-to-be expired patents. *See, e.g., Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.*, 853 F.3d 1272, 1279 (Fed. Cir. 2017) (noting that ‘[t]he Board construes claims of an expired patent in accordance with *Phillips* . . . [and] [u]nder that standard, words of a claim are generally given their ordinary and customary meaning’).”).

Further, the statutes governing *inter partes* review do not limit them to non-expired patents. For example, 35 U.S.C. § 311(b), which sets forth the scope of *inter partes* review merely refers to patents, with no mention of the expiration date. Further, 35 U.S.C. § 311(c) entitled “Filing Deadline” makes no mention of the expiration date of the patent. Elsewhere, 35 U.S.C. § 315 does limit the filing of IPRs based on civil actions and the serving of complaints, but again makes no mention of the expiration date of the patent. Patent Owner does not identify any statute or legal precedent that expressly limits *inter partes* review to non-expired patents.

Patent Owner fails to adequately explain why the Patent Office’s authority to take a second look at an earlier administrative grant of a patent ends when the patent term expires even though the rights granted by the patent are not yet exhausted.

For all of these reasons, we do not agree that the Board lacks jurisdiction over expired patents.

⁹ Available at <https://www.federalregister.gov/d/2018-22006/p-13>.

III. CONCLUSION

For the foregoing reasons, we determine that Petitioner has not proven, by a preponderance of the evidence, that the challenged claims are unpatentable, as summarized in the following table:

Claims	35 U.S.C. §	Reference(s) /Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1–6, 11, 14	103(a)	Mann, Numazaki		1–6, 11, 14
7, 8, 10, 12, 13	103(a)	Mann, Numazaki, Amir		7, 8, 10, 12, 13
6, 9	103(a)	Mann, Numazaki, Aviv		6, 9
Overall Outcome				1–14

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, claims 1–14 of U.S. Patent 8,194,924 B2 have not been shown to be unpatentable; and

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.

IPR2021-00923
Patent 8,194,924 B2

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