

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STMICROELECTRONICS, INC.,
Petitioner,

v.

NEODRON LTD.,
Patent Owner.

IPR2021-01161
Patent 8,749,251 B2

Before MIRIAM L. QUINN, PATRICK M. BOUCHER, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

INTRODUCTION

A. *Background and Summary*

STMicroelectronics, Inc. (“Petitioner”) filed a Petition to institute an *inter partes* review of claims 1–20 of U.S. Patent No. 8,749,251 B2 (Ex. 1001, “the ’251 patent”). Paper 1 (“Petition,” “Pet.”). Neodron Ltd. (“Patent Owner”) did not file a Patent Owner Preliminary Response.

We have authority, acting on the designation of the Director, to determine whether to institute an *inter partes* review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). *Inter partes* review may not be instituted unless “the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (2018). “When instituting *inter partes* review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.” PTAB Rules of Practice for Instituting on All Challenged Patent Claims and All Grounds and Eliminating the Presumption at Institution Favoring Petitioner as to Testimonial Evidence, 85 Fed. Reg. 79,120, 79,129 (Dec. 9, 2020) (codified at 37 C.F.R. § 42.108(a) (2021)).

For the reasons set forth below, upon considering the Petition and the evidence of record, we determine that the information presented in the Petition establishes a reasonable likelihood that Petitioner will prevail with respect to at least one of the challenged claims. Accordingly, we institute *inter partes* review on all of the challenged claims based on all of the grounds identified in the Petition.

B. Real Parties in Interest

Petitioner identifies itself as the real party in interest. Pet. 44. Petitioner also states that “[a]lthough STMicroelectronics N.V., STMicroelectronics, Inc.’s parent company, and STMicroelectronics (North America) Holdings, Inc., which is under common ownership with STMicroelectronics, Inc., are not real parties-in-interest under the governing legal standard for making that determination, STMicroelectronics, Inc. identifies them as real parties-in-interest for purposes of this Petition.” *Id.*

Patent Owner identifies itself as the real party in interest. Paper 4, 1 (Patent Owner’s Mandatory Notices).

C. Related Matters

Petitioner and Patent Owner each identify *Neodron Ltd. v. STMicroelectronics, Inc.*, No. 6-20-cv-00560 (W.D. Tex.) and *Certain Capacitive Touch Sensing Systems, Capacitive Touch Sensing Controllers, Microcontrollers with Capacitive Touch Sensing Functionality, and Components Thereof*, No. 337-TA-1268 as proceedings involving the ’251 patent. Pet. 44; Paper 4, 2.

Petitioner also identifies (1) a number of terminated *inter partes* review proceedings and (2) other district court and ITC proceedings involving the the’251 patent. Pet. 44–45.

Petitioner also identifies *STMicroelectronics, Inc. v. Neodron Ltd.*, IPR2021-01161. Paper 3, 1. In a decision issued concurrently with this one, we institute *inter partes* review in that proceeding. *STMicroelectronics, Inc. v. Neodron Ltd.*, IPR2021-01160, Paper 7 (Institution Decision).

D. The ’251 Patent

The ’251 patent, which is entitled “Proximity Sensor,” issued from Application 13/116,764 (“the ’764 application”), which was filed on May

26, 2011. Ex. 1001, codes (21), (22), (54). The '764 application is a continuation of application 12/179,769 ("the parent '769 application") and claims the benefit of the filing date of provisional application 60/952,053 ("the provisional '053 application"). *Id.* at 1:5–9, codes (60), (63).

The '251 patent states that "[c]apacitive position sensors have recently become increasingly common and accepted in human interfaces and for machine control." Ex. 1001, 17–19. According to the '251 patent, "in the fields of portable media players it is now quite common to find capacitive touch controls operable through glass or plastic panels. Some mobile telephones are also starting to implement these kinds of interfaces." *Id.* at 1:19–24.

The '251 patent further describes how capacitive touch sensors may be used:

Many capacitive touch controls incorporated into consumer electronic devices for appliances provide audio or visual feedback to a user indicating whether a finger or other pointing object is present or approaches such touch controls. A capacitive sensing microprocessor may typically be comprised in touch-controlled devices which are arranged to provide an "on" output signal when a finger is adjacent to a sensor and an "off" output signal when a finger is not adjacent to a sensor. The signals are sent to a device controller to implement a required function dependent on whether a user's finger is in proximity with or touching an associated touch control.

Id. at 1:25–36. According to the '251 patent, a problem with those devices is that some "remain 'on' or 'active' despite the user having moved away from the device or a particular function no longer being required. This results in the device consuming a large amount of power, which is not efficient." *Id.* at 1:37–41.

The '251 patent addresses that problem by using a control circuit to “determine whether an object or a user’s finger is no longer in proximity with the sensor.” Ex. 1001, 4:47–54. “[B]ased on a predetermined time duration, the control circuit can produce an output signal automatically to prevent the capacitance measurement circuit from continually measuring changes in capacitance due to, for example, the perceived presence of an object in proximity with the sensor.” *Id.* According to the '251 patent, this allows the control circuit “to deactivate, turn-off, or power down the capacitance measurement circuit where an apparatus has inadvertently been left on or with the erroneous perception that a user is still present. This may, for example, be referred to as an ‘auto-off’ feature.” *Id.* at 4:55–59; *see also id.* at 10:41–13:57 (providing details of the auto-off feature).

Figure 1 of the '251 patent is reproduced below.

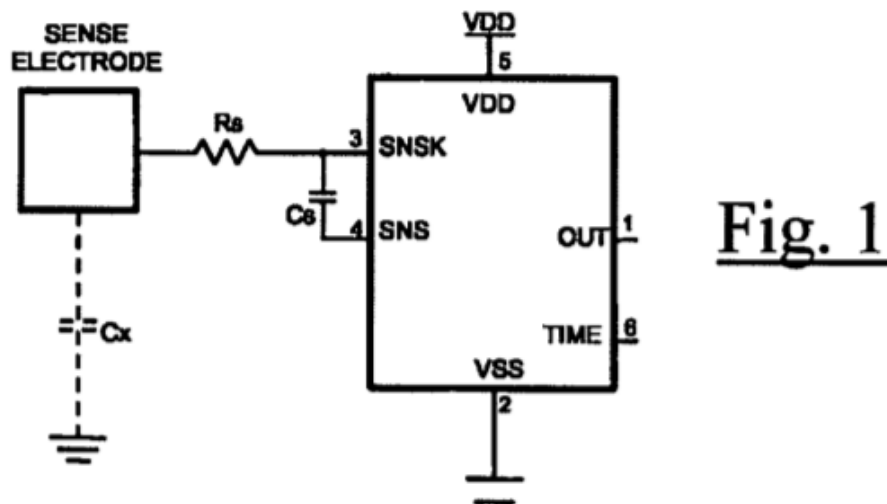


Figure 1 “schematically shows sense electrode connections for an example chip for implementing an auto-off function.” Ex. 1001, 3:13–15.

E. Illustrative Claims

Of the challenged claims, claims 1, 10, and 16 are independent. Each of challenged claims 2–9, 11–15, and 17–20 depends, directly or indirectly, from claim 1, 10, or 16.

Claim 1 is illustrative and reads as follows:

1. An apparatus comprising:
 - a sensing element of a touch screen; and
 - one or more computer-readable non-transitory storage media coupled to the sensing element and embodying logic that is operable when executed to:
 - determine an amount of time that has elapsed since the sensing element last detected a change of capacitance indicative of a key touch on the touch screen; and
 - if the amount of time that has elapsed exceeds a predetermined time duration, then initiate a particular function of the apparatus.

Ex. 1001, 17:44–54.

F. Prior Art and Asserted Ground

Petitioner asserts that claims 1–20 are unpatentable on the following ground:

Claim(s) Challenged	35 U.S.C. § ¹	Reference(s)/Basis
1–20	103(a)	Philipp, ² QT60161 ³

Petitioner also relies on a Declaration of Dr. Tony Givargis, filed as Exhibit 1003 (“Givargis Decl.”).

ANALYSIS

A. *Legal Standards*

In *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), the Supreme Court set out a framework for assessing obviousness under 35 U.S.C. § 103 that requires consideration of four factors: (1) the “level of ordinary skill in the pertinent art,” (2) the “scope and content of the prior art,” (3) the “differences between the prior art and the claims at issue,” and (4) if in evidence, “secondary considerations” of non-obviousness such as “commercial success, long-felt but unsolved needs, failure of others, etc.” *Id.* at 17–18. “While the sequence of these questions might be reordered in any particular case,” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 407 (2007), the U.S. Court of Appeals for the Federal Circuit has repeatedly emphasized that “it is error to reach a conclusion of obviousness until all those factors are considered,” *WBIP, LLC v. Kohler*, 829 F.3d 1317, 1328 (Fed. Cir. 2016).

¹ The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. §§ 102, 103 that became effective on March 16, 2013. Because the ’251 patent issued from an application filed before March 16, 2013, we apply the pre-AIA versions of the statutory bases for unpatentability. See Ex. 1001, code (22) (application filed May 26, 2011).

² US 2007/0076897 A1, published Apr. 5, 2007 (Ex. 1023).

³ Quantum Research Group 1999-2004 “QT60161 16 Key QMatrix™ Keypanel Sensor IC Datasheet” (Ex. 1017). Petitioner asserts QT60161 was publicly available no later than February 12, 2002. Pet. 26.

We note that, with respect to the fourth *Graham* factor, no party has presented argument or evidence directed to secondary considerations of nonobviousness. *See generally* Pet. The analysis below addresses the first three *Graham* factors.

B. Level of Ordinary Skill in the Art

In determining whether an invention would have been obvious at the time it was made, we consider the level of ordinary skill in the pertinent art at the time of the invention. *Graham*, 383 U.S. at 17. “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991). The “person of ordinary skill in the art” is a hypothetical construct, from whose vantage point obviousness is assessed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). “This legal construct is akin to the ‘reasonable person’ used as a reference in negligence determinations” and “also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan.” *Id.* (citing *In re Carlson*, 983 F.2d 1032, 1038 (Fed. Cir. 1993)).

Factors pertinent to a determination of the level of ordinary skill in the art include “(1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field.” *Envtl. Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 696–697 (Fed. Cir. 1983) (citing *Orthopedic Equip. Co. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1381–82 (Fed. Cir. 1983)). “Not all such factors may be present in every

case, and one or more of these or other factors may predominate in a particular case.” *Id.*

Petitioner argues that a person having ordinary skill in the art at the time of the invention

would have been a person having at least a bachelor’s degree in electrical engineering, computer engineering, computer science, or a related field, and at least two years of experience in the research, design, development, and/or testing of human-machine interfaces such as touch sensors and the firmware or system software that govern said interfaces, or the equivalent, with additional education substituting for experience and vice versa.

Pet. 17 (citing Ex. 1003 ¶¶ 20–22). Patent Owner does not address this issue.

For purposes of this Decision, we adopt the level of ordinary skill in the art that Petitioner proffers, except that we delete the qualifiers “at least” to eliminate vagueness as to the amount of education and practical experience. The qualifiers expand the range indefinitely without an upper bound, and thus precludes a meaningful indication of the level of ordinary skill in the art.⁴

C. Claim Construction

We apply the same claim construction standard used in the federal courts, in other words, the claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b), which is articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). 37 C.F.R. § 42.100(b) (2020). Under the *Phillips* standard, the

⁴ If Patent Owner proposes a different level of ordinary skill in the art in its Response, the parties shall address whether there are any material differences between the two proposals and what impact, if any, the different level has on the obviousness analysis.

“words of a claim are generally given their ordinary and customary meaning,” which is “the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” *Phillips*, 415 F.3d at 1312–13.

Petitioner proposes constructions for two terms. *See* Pet. 24; *see also id.* at 11–17 (arguments regarding proposed constructions).

Because no express construction is needed to resolve any dispute in this proceeding, we do not construe any of the claim limitations. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (noting that “we need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

D. Discretionary Denial under 35 U.S.C. § 314(a)

Institution of an *inter partes* review is discretionary, not mandatory. *See Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”).

Pursuant to the Consolidated Trial Practice Guide,⁵ Petitioner filed a Petitioner’s Reasons For and Ranking of Parallel Petitions. Paper 3.

⁵ Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) (“CTPG”), 59–60, available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

Petitioner argues that the '251 patent added “new matter in 2011 that severed the priority chain back to its July 26, 2007 provisional or to its July 25, 2008 utility application.” *Id.* at 2–3. According to Petitioner, the different petitions “rely on completely distinct prior art combinations asserted to address different effective filing dates for the Challenged Claims.” *Id.* at 2.

Patent Owner did not submit a response to Petitioner’s Reasons For and Rankings.

In deciding whether to institute *inter partes* review, we consider the guidance in the Consolidated Trial Practice Guide, which sets forth the following:

Parallel Petitions Challenging the Same Patent. Based on the Board’s experience, one petition should be sufficient to challenge the claims of a patent in most situations. Two or more petitions filed against the same patent at or about the same time (e.g., before the first preliminary response by the patent owner) may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns. *See* 35 U.S.C. § 316(b).

CTPG, 59. Nonetheless, the Consolidated Trial Practice Guide recognizes that “more than one petition may be necessary, including for example, . . . when there is a dispute about priority date requiring arguments under multiple prior art references.” *Id.*

The present circumstance is consistent with the exception referenced in the Consolidated Trial Practice Guide because there is a potential dispute about the effective filing date of the '251 patent, which may require arguments to be made under multiple prior art references. *See* Paper 3, 2–3. Moreover, Patent Owner has not requested that we exercise our discretion to

only consider, at most, one petition. Accordingly, we do not exercise our discretion to deny this Petition under § 314(a).

E. Philipp and QT60161

Petitioner argues that claims 1–20 would have been obvious over Philipp and QT60161. Pet. 25–43. Based on the current record and for the reasons that follow, we are persuaded that Petitioner has established a reasonable likelihood of prevailing with respect to claims 1–20.

1. Philipp

a) Summary of Philipp

Philipp is the published version of the parent '769 application. See Ex. 1024, code (21). Because the '251 patent is a continuation of the parent '769 patent, they share the same written description. See Ex. 1001, code (63). Accordingly, Philipp has the same disclosure as discussed in Section D of the Introduction, *supra*.

b) Whether Philipp is Prior Art

Petitioner argues that the '251 patent is not entitled to rely on the filing date of the parent '769 application or the provisional '053 application. See Pet. 4–17. Specifically, Petitioner argues that when filing the '764 application, the applicant added new matter—the terms “touch screen” and “key touch on a/the touch screen”—into the abstract and the claims. *Id.* at 10. Accordingly, Petitioner argues that the claims of the '251 patent have an effective filing date of May 26, 2011, the date the '294 application was filed. *Id.* at 9.

(1) Principles of Law Regarding Relying on Earlier-Filed Patent Applications

“It is elementary patent law that a patent application is entitled to the benefit of the filing date of an earlier filed application *only* if the disclosure

of the earlier application provides support for the claims of the later application, as required by 35 U.S.C. § 112.” *In re Chu*, 66 F.3d 292, 297 (Fed. Cir. 1995) (emphasis added). Section 112 requires the specification to include “a written description of the invention.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1344 (Fed. Cir. 2010) (en banc) (quoting 35 U.S.C. § 112).

“[T]he hallmark of written description is disclosure,” and “the test [for satisfaction of the written description requirement] requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art.” *Ariad*, 598 F.3d at 1351. The written description “must ‘clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed,’” and “reasonably” convey to those skilled in the art “that the inventor had possession of the claimed subject matter as of the filing date.” *Id.* (alteration in original, internal citations omitted). Stated another way, “one skilled in the art, reading the original disclosure, must immediately discern the limitation at issue in the claims.” *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000).

In evaluating the effective filing date of the ’251 patent, we first address the parties’ respective burdens. In an *inter partes* review, Petitioner bears the ultimate burden of persuasion regarding unpatentability, which never shifts to patent owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1379 (Fed. Cir. 2015). *Dynamic Drinkware* also establishes that Petitioner has the initial burden of production to show a reference is prior art. *Dynamic Drinkware*, 800 F.3d at 1379. However, the burden of production then shifts to Patent Owner to refute Petitioner’s argument by either showing the prior art does not actually render the claims

unpatentable or does not qualify as prior art. *Id.* at 1380. The burden of production then shifts back to Petitioner to respond to Patent Owner’s argument. *Id.* The Board then evaluates all of the evidence and determines whether Petitioner has satisfied its burden of persuasion regarding unpatentability. *Id.* We apply the same framework when considering whether the parties have met their respective burdens at this stage of the proceeding.

(2) Application of Dynamic Drinkware

Based on the current status of the proceedings, we are sufficiently persuaded that Petitioner satisfied its initial burden of production under *Dynamic Drinkware*. Specifically, Petitioner identifies two claim terms—“touch screen” and “key touch on a/the touch screen”—that are recited in each of the independent claims and were added to the ’274 application. Pet. 10 (citing Ex. 1002, 38–41); *see also id.* at 11–17. Additionally, as discussed below, Petitioner has also sufficiently shown that the combination of Philipp and QT60161 teaches each of the limitations of the claims of the ’251 patent. *See Dynamic Drinkware*, 800 F.2d at 1379 (finding Petitioner satisfied its initial burden of production by arguing that the prior art rendered the claims unpatentable).

Because Petitioner satisfied its initial burden of production, the burden of production now shifts to Patent Owner to argue or produce evidence that either (1) the prior art does not render the claims unpatentable or (2) that Philipp is not prior art because the asserted claims of the ’251 patent are entitled to the benefit of a filing date (constructive or otherwise) prior to Philipp. *See Dynamic Drinkware*, 800 F.3d at 1380. Because Patent Owner—as is its right—chose not to file a Patent Owner’s Preliminary Response, for purposes of institution only, Patent Owner did not meet its

burden of production to show that the '251 patent is entitled to a filing date earlier than Philipp.

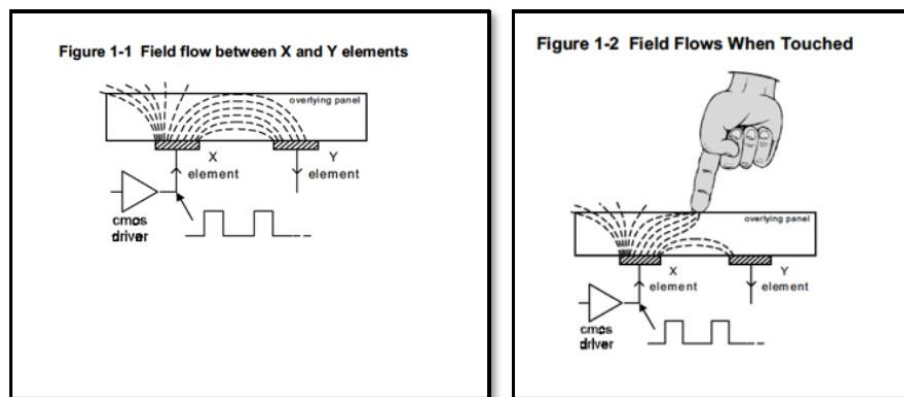
Accordingly, based on the current record, and for purposes of institution only, we treat Philipp as prior art to the '251 patent.

2. Summary of QT60161

QT60161 is a Quantum Research Group datasheet entitled “16 Key QMatrix™ Keypanel Sensor IC.” Ex. 1017, 2.⁶

“The QT60161 digital charge-transfer (“QT”) QMatrix™ IC is designed to detect human touch on up (sic) 16 keys when used in conjunction with a scanned, passive X-Y Matrix.” Ex. 1017, 2. “The part can scan matrix touch keys over LCD panels or other displays when used with clear ITO electrodes arranged in a matrix.” *Id.*

QT60161 Figures 1-1 and 1-2 are reproduced below.



“Figure 1-1 shows how charge is transferred across an electrode set to permeate the overlying panel.” Ex. 1017, 5. Figure 1-2 shows the change in

⁶ All citations are to the pagination added by Petitioner, not the native pagination. See 37 C.F.R. § 42.64(d)(2)(i).

the field flows as “[t]he charge flows are absorbed by the touch of a human finger.” *Id.*⁷ The touch results “in a decrease in coupling from X to Y.” *Id.*

3. *Analysis of Claim 1*

Claim 1 recites “[a]n apparatus.” Ex. 1001, 17:44. Petitioner argues that to the extent the preamble is limiting, Philipp teaches “an apparatus comprising a capacitive touch sensor and a control circuit.” Pet. 33 (citing Ex. 1024, code (57), ¶¶ 6, 48, Figs. 1, 3, 17, 18).⁸

Claim 1 further recites “a sensing element of a touch screen.” Ex. 1001, 17:45. Petitioner argues that QT60161 teaches this limitation. *See* Pet. 34. Specifically, Petitioner argues that QT60161 teaches “an array of X-Y matrix electrodes used to sense changes in capacitance on its capacitive touch screen.” *Id.* (citing Ex. 1017, 2, 5). According to Petitioner, “[t]his X-Y matrix format forms touch keys of interdigitated electrode material at the intersection of the X and Y lines—creating up to sixteen touch keys projected through a dielectric (e.g., glass) and formed over an LCD panel or other display.” *Id.* (citing Ex. 1017, 2, 5).

Claim 1 further recites

one or more computer-readable non-transitory storage media coupled to the sensing element and embodying logic that is operable when executed to: determine an amount of time that has elapsed since the sensing element last detected a change of capacitance indicative of a key touch on the touch screen; and if

⁷ The text erroneously refers to Figure 1-1. *See* Ex. 1017, 5.

⁸ On the current record, there is no dispute that Philipp teaches an apparatus. Accordingly, for purposes of institution, we need not decide whether the preamble is limiting. *See Nidec*, 868 F.3d at 1017 (noting that “we need only construe terms ‘that are in controversy’” (quoting *Vivid*, 200 F.3d at 803)).

the amount of time that has elapsed exceeds a predetermined time duration, then initiate a particular function of the apparatus.

Ex. 1001, 17:46–54. Petitioner argues that the combination of Philipp and QT60161 teaches that limitation. *See* Pet. 35–37. Specifically, Petitioner argues that Philipp teaches “two distinct functions that are initiated when an amount of time since the last ‘touch’ exceeds a predetermined duration:” recalibration timeout and auto-off. *Id.* at 35 (footnote omitted) (citing Ex. 1024 ¶¶ 51, 76, 114–124). Petitioner further argues that a person having ordinary skill in the art “would have understood that the disclosed control circuit [in Philipp] executes logic in accordance with firmware or software stored on internal memory to effectuate the functions discussed.” *Id.* at 36–37 (citing Ex. 1003 ¶¶ 97–103).

Petitioner also further argues that “it would have been obvious to implement these functions with a touch screen and to trigger the claimed time duration from detecting a ‘key touch on a/the touch screen’ pursuant to the touch screen teachings of QT60161.” Pet. 36.⁹ More specifically, Petitioner argues that it would have been obvious to apply the timed features of Philipp “to a ‘touch screen’ and to trigger the claimed time duration from detecting a ‘key touch on a/the touch screen.’” *Id.* at 29. According to Petitioner, a person having ordinary skill in the art would have made such a combination because

(1) “the primary timer-based functions described and claimed in the ’251 Patent are not only compatible with the touch screen described in QT60161, but are expressly discussed in QT60161” (*id.* at 30; *see also id.* at 3031 (citing Ex. 1001, 6:61–7:2; Ex. 1017, 7)),

⁹ The Petition emphasizes the names of prior art references. The emphasis is omitted throughout this Decision.

(2) QT60161 and Philipp “are compatible with the same sensor technology” (*id.* at 31; see also *id.* at 31–32 (citing Ex. 1017, 5, Figs. 1-1, 1-2; Ex. 1024 ¶ 48, 49; Ex. 1003 ¶ 52; Ex. 1028, Figs. 1b, 7)),

(3) both the ’251 patent and QT60161 are directed to saving power after the passage of time (*id.* at 32–33 (citing Ex. 1001, 4:55–65, 10:41–13:59; Ex. 1017, 11; Ex. 1003 ¶¶ 97–103)), and

(4) implementing Philipp “with QT60161’s touch screen would have yielded predictable results” (*id.* at 33 (citing Ex. 1003 ¶¶ 97–103)).

After reviewing Petitioner’s arguments and information, including the Givargis Declaration (Ex. 1003), which Patent Owner does not address at this stage, we are persuaded that Petitioner sufficiently demonstrates, for purposes of this Decision, that the combination of Philipp and QT60161 teaches each claim limitation recited in claim 1 and that a person having ordinary skill in the art would have combined the teachings of the references in the manner set forth in the Petition. Accordingly, Petitioner has demonstrated, on this record, a reasonable likelihood of prevailing on its assertion that claim 1 is unpatentable over Philipp and QT60161.

4. *Claims 2–20*

Because Petitioner has demonstrated a reasonable likelihood of success in proving that at least one claim of the ’251 patent is unpatentable, we institute on all grounds and all claims raised in the Petition. See *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018) (indicating that a decision whether to institute an *inter partes* review “requires a simple yes-or-no institution choice respecting a petition, embracing all challenges included in the petition”); 37 C.F.R. § 42.108(a). Therefore, at this stage of the proceeding, it is not necessary for us to provide an assessment of every

challenge raised by Petitioner, especially as Patent Owner has not presented any responsive argument.

Nevertheless, we note that Petitioner provides detailed explanations supported by the testimony of Dr. Givargis, and specific citations to the relevant references indicating where in the references Petitioner argues the limitations of claims 2–20 are taught, and why a person of ordinary skill in the art would have combined or modified the teachings of the relevant references. *See* Pet. 37–43. Accordingly, at this stage of the proceeding, we are persuaded the information presented in the Petition establishes there is a reasonable likelihood that Petitioner would prevail with respect to claims 2–20 based on the combination of Philipp and QT60161.

CONCLUSION

Following 35 U.S.C. § 314, we have determined whether the totality of the information presented at this stage shows there is a reasonable likelihood that Petitioner would prevail with respect to at least one of the claims challenged in the Petition. Because Petitioner has demonstrated a reasonable likelihood of success in proving that at least one claim of the ’251 patent is unpatentable, we institute on all grounds and all claims raised in the Petition.

Our factual findings, conclusions of law, and determinations at this stage of the proceeding are preliminary, and based on the evidentiary record developed thus far. This is not a final decision as to the patentability of claims for which *inter partes* review is instituted. Our final decision will be based on the record as fully developed during trial.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, an *inter partes* review of all challenged claims of the '251 patent is instituted with respect to all grounds set forth in the Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of the '251 patent is hereby instituted commencing on the entry date of this Decision, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial.

IPR2021-01161
US 8,749,251 B2

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