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EXAMINER

BASEHOAR, ADAM L

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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***EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/019,351 .

PATENT UNDER REEXAMINATION 9304654 .

ART UNIT 3992 .

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Order Granting Request For Ex Parte Reexamination	Control No. 90/019,351	Patent Under Reexamination 9304654	
	Examiner Adam L Basehoar	Art Unit 3992	AIA (FITF) Status No

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The request for *ex parte* reexamination filed 12/27/2023 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) ☐ PTO-892, b) ☒ PTO/SB/08, c) ☐ Other: _____

1. ☒ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

/ADAM L BASEHOAR/
Primary Examiner, Art Unit 3992

cc:Requester (if third party requester)

Notice of Pre-AIA or AIA Status

1. The present application is being examined under the pre-AIA first to invent provisions.

DECISION

2. A substantial new question of patentability (SNQ) affecting claims 1-19 of United States Patent Number 9,304,654 B2 (hereafter the “Bakhash ‘654 patent”) is raised by the Request for *Ex Parte* Reexamination (hereafter the “Request”) filed on 12/27/2023.

The Bakhash ‘654 patent was filed on 09/30/2014 as U.S. Patent Application No. 14/503,142. The 14/503,142 application is a continuation of U.S. Patent Application No. 12/751,879 (now U.S. Patent No. 8,881,048, published 11/04/2014), filed on 03/31/2010, which is a continuation of U.S. Patent Application No. 11/531,676 (now U.S. Patent No. 7,735,018, published 06/08/2010), filed on 09/13/2006, which claims priority to U.S. Provisional Application No. 60/717,019, filed on 09/13/2005.

The Request was filed by an anonymous Third Party Requester (3PR).

Information Disclosure Statement

3. Regarding Information Disclosure Statement (IDS) submissions, MPEP 2256 recites the following: “Where patents, publications, and other such items of information are submitted by a party (patent owner or requester) in compliance with the requirements of the rules, the requisite degree of consideration to be given to such information will be normally limited by the degree to which the party filing the information citation has explained the content and relevance of the

information. The initials of the examiner placed adjacent to the citations on the form PTO/SB/08A and 08B or its equivalent, without an indication to the contrary in the record, do not signify that the information has been considered by the examiner any further than to the extent noted above.”

Accordingly, the IDS submission filed by Third Party Requester (3PR) on 12/27/2023 has been considered by the Examiner only with the scope required by MPEP 2256, unless otherwise noted.

References Cited in the Request

4. A total of seven references in specific combinations have been asserted in the Request as providing teachings relevant to claims 1-19 of the Bakhsh ‘654 patent. The proposed references which make up the combinations are as follows:

- **Miller ‘542** - (U.S. Patent No. 6,229,542, published 05/08/2001)
- **Holecsek** - (U.S. Patent No. 8,341,541, published 07/20/2006 via US 2006/0161861)
- **Mastering Windows** - (Guy Hart-Davis, “Mastering Windows XP Home Edition,” Second Edition, SYBEX Inc., 12/23/2002 - Any citation to the Mastering Windows reference will be made via its native page numbers (see: Exhibit 1005))
- **Hellyar** - (U.S. Patent No. 7,346,855, published 06/26/2003 via US 2003/0117440)
- **Miller ‘358** - (U.S. Patent No. 6,597,358, published 11/15/2001 via US 2001/0040571)
- **Koga** - (Japanese Patent Application Publication No. JP2002-132828, published 05/10/2002 - Any citation to the Koga reference will be made via its accompanying certified translation (see: Exhibit 1008, pp. 3-29))

- **Anderson** - (U.S. Patent No. 7,010,755, published 10/09/2003 via US 2003/0189597)

5. The Miller ‘542, Holecek, Mastering Windows, Hellyar, Miller ‘358, Koga, and Anderson references were neither previously cited/considered nor applied in a rejection to any of the claims during the original prosecution history of the Bakhsh ‘654 patent.

The Examiner notes that the Holecek, Mastering Windows, and Hellyar references were cited in a petition for *Inter Partes* Review (IPR2020-01418) against claims 1-5, 7-13, and 15-19 of the Bakhsh ‘654 patent. On 03/15/2021, the Patent Trial and Appeal Board (PTAB) stated that (1) “This proceeding is at an early stage, and we have not yet decided whether to institute a trial in the proceeding. In view of the early stage of the proceeding and the settlement between the Parties, we determine that good cause exists to dismiss the petition and terminate the proceeding with respect to the Parties” and ultimately concluded (2) “that the Joint Motion to Dismiss is *granted*, and the petition in IPR2020-01418 is dismissed and the proceeding is *terminated*.”

Affidavits, Declarations, or Other Written Evidence

6. The Examiner recognizes that declarations by Dr. Chandrajit Bajaj (executed on 12/18/2023 - hereafter the “Bajaj Dec.”) and Dr. Sylvia D. Hall-Ellis (executed on 12/15/2023 - hereafter the “Hall-Ellis Dec.”) have been referenced in support of Third Party Requester. The declarations have been considered and made of record.

The Examiner further notes that affidavits or declarations or other written evidence which explain the contents or pertinent dates of prior art patents or printed publications in more detail

may be considered in reexamination (see: MPEP 2258(I)(E)), but any rejection must be based upon the prior art patents or printed publications as explained by the affidavits or declarations or other written evidence. The rejection in such circumstances cannot be based on the affidavits or declarations or other written evidence as such, but must be based on the prior art patents or printed publications. In the instant case, the submitted Bajaj Dec. at least further explains the contents of the prior art patents and printed publications in more detail and the submitted Hall-Ellis Dec. at least further explains the pertinent dates of the Mastering Windows reference in more detail.

Identification of Every Claim for Which Reexamination is Requested

7. The seven references cited above are discussed in the Request regarding claims 1-19 of the Bakhshash '654 patent. Pages 3-4, 13-14, and 17-29 of the Request discuss and detail out proposed substantial new questions of patentability in light of specific combinations of said seven references.

Prosecution History

8. The Examiner generally agrees with the basic summation of the original prosecution history of the Bakhshash '654 patent set forth in the Request (see: Request, pp. 13-14 and 28). That is to say, during the original prosecution history of the Bakhshash '654 patent, the examiner eventually allowed claims 67-73 and 75-86 (renumbered claims 1-19) after an examiner's amendment, and provided the following as their examiner's statement of reasons for allowance:

Allowable Subject Matter

6. Claims 67-73 and 75-86 are allowed.

7. The following is an examiner's statement of reasons for allowance: The present invention teaches converting outputs of a plurality of applications into a plurality of images displayed in a three-dimensional space, replacing the plurality of images with the output of the first application in a two-dimensional space in response to first user interaction with the first image, and modifying the first application specific data in response to second user interaction with the output. The claims are allowable over the prior art in view of the examiner's amendment and the applicant's remarks filed on 09/30/2014.

The examiner's amendment to representative independent claim 67 (renumbered claim 1) is further provided below:

Claim 67. (Currently amended) A method for displaying a timeline associated with a plurality of applications and allowing a user to modify an output of one of said plurality of applications by interacting with said timeline, comprising:

receiving a plurality of inputs from a user, said plurality of inputs comprising at least first, second, and third inputs;

opening said plurality of applications in response to said plurality of inputs, said plurality of applications comprising at least first, second, and third applications, wherein each one of said plurality of applications is configured to (i) generate an object having application-specific data, (ii) display said object on a display device, and (iii) allow said user to modify at least a portion of said application-specific data by interacting with said object; and

displaying on said display device said timeline associated with said plurality of applications, comprising:

generating a plurality of images, said plurality of images comprising at least first, second, and third images, wherein said first image is an image of at least a portion of a first object generated by said first application and having first application-specific data, said second image is an image of at least a portion of a second object generated by said second application and having second application-specific data, and said third image is an image of at least a portion of a third object generated by said third application and having third application-specific data; and

displaying said plurality of images in a three-dimensional space on said display device in an order based on a last time that said user one of (i) opened said first application and interacted with said first object, (ii) opened said second application and interacted with said second object, and (iii) opened said third application and interacted with said third object, such that a first one in said order is displayed in a foreground of said three-dimensional space, a second one in said order is displayed in a background of said three-dimensional space, behind at least said first one in said order, and a third one in said order is displayed in a background of said three-dimensional space, behind at least said second one in said order; and

allowing said user to modify at least a portion of one of said first, second, and third application-specific data, comprising:

receiving a first interaction from said user with one of said plurality of images corresponding to one of said plurality of applications;

replacing said plurality of images within said three-dimensional space with one of said first, second, and third objects corresponding to said one of said plurality of applications within a two-dimensional space in response to said first interaction;

receiving a second interaction by said user with said one of said first, second, and third objects within said two-dimensional space; and

modifying said one of said first, second, and third application-specific data in response to said second interaction.

9. The Examiner generally agrees with the basic summation of the prosecution history of IPR2020-01418 set forth in the Request (see: Request, pp. 4 and 27). In IPR2020-01418, the petition for *Inter Partes* Review was initially filed on 08/04/2020. And the petition for *Inter*

Partes Review, as noted directly below, specifically concerned claims 1-5, 7-13, and 15-19 of the Bakhsh '654 patent as well as the Holecek, Mastering Windows (designated as the "XP" reference in IPR2020-01418), and Hellyar references.

In accordance with 35 U.S.C. § 311, Petitioner requests cancellation of the '654 patent's claims 1-5, 7-13, and 15-19 in view of the following grounds.

Ground	Claims	§ 103(a) Prior Art Basis
1	1-4, 7-13, 15-19	Holecek and XP
2	5	Holecek, XP, and Hellyar

Thereafter, on 03/15/2021, the Patent Trial and Appeal Board (PTAB) stated that (1) "This proceeding is at an early stage, and we have not yet decided whether to institute a trial in the proceeding. In view of the early stage of the proceeding and the settlement between the Parties, we determine that good cause exists to dismiss the petition and terminate the proceeding with respect to the Parties...This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a)" and ultimately concluded (2) "that the Joint Motion to Dismiss is *granted*, and the petition in IPR2020-01418 is dismissed and the proceeding is *terminated*" (underline emphasis added).

IPR2020-01418 was filed by Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (hereafter "Samsung").

10. The Examiner generally agrees with the basic summation of the prosecution history of IPR2023-00343 set forth in the Request (see: Request, pp. 3-4 and 27). In IPR2023-00343, the petition for *Inter Partes* Review was initially filed on 12/13/2022. And the petition for *Inter*

Partes Review, as noted directly below, specifically concerned claims 1-19 of the Bakhsh '654 patent.

Petitioner requests IPR of the Challenged Claims on the 35 U.S.C. §103 grounds identified in the table below. Accompanying explanations and support are provided in Dr. Fuch's Declaration. APPLE1003, ¶¶[1]-[165].

Ground	'654 Patent Claims	Basis for Rejection
1A	1-5, 7-8, 10-13, 15-17, 19	Anthony in view of Hanggie
1B	6, 9, 14, 18	Anthony in view of Hanggie and Matthews
2A	1-5, 7-8, 10-13, 15-17, 19	Hanggie in view of Anthony
2B	6, 9, 14, 18	Hanggie in view of Anthony and Matthews

Thereafter, on 07/06/2023, the PTAB granted institution of *Inter Partes* review by noting that (1) "we determine that the information presented establishes that there is a reasonable likelihood that Petitioner would prevail in showing the unpatentability of at least one challenged claim. Accordingly, we institute an *inter partes* review of all challenged claims of the '654 patent, based on all grounds raised in the Petition" and ultimately concluded (2), "At this stage of the proceeding, we have not made a final determination as to the patentability of any of the challenged claims...it is ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review is hereby instituted as to claims 1–19 of the '654 patent on all grounds presented in the Petition."

IPR2023-00343 was filed by Apple Inc. (hereafter "Apple").

11. The Examiner generally agrees with the basic summation of the prosecution history of IPR2023-00579 set forth in the Request (see: Request, pp. 3-4 and 27). In IPR2023-00579, the petition for *Inter Partes* Review was initially filed on 02/10/2023. And the petition for *Inter Partes* Review, which was substantively the same as IPR2023-00343, as noted directly below, specifically concerned claims 1-19 of the Bakhsh '654 patent.

Petitioner requests IPR of the Challenged Claims on the 35 U.S.C. §103 grounds identified in the table below. Accompanying explanations and support are provided in Dr. Fuch's Declaration. APPLE1003, ¶¶[1]-[165].

Ground	'654 Patent Claims	Basis for Rejection
1A	1-5, 7-8, 10-13, 15-17, 19	Anthony in view of Hanggie
1B	6, 9, 14, 18	Anthony in view of Hanggie and Matthews
2A	1-5, 7-8, 10-13, 15-17, 19	Hanggie in view of Anthony
2B	6, 9, 14, 18	Hanggie in view of Anthony and Matthews

Thereafter, on 08/07/2023, the PTAB granted institution of *Inter Partes* review by noting that (1) “we determine institution of *inter partes* review of all challenged claims of the '654 patent is warranted on the same grounds instituted in the Apple IPR, and we grant Petitioner's Motion for Joinder” and ultimately concluded (2), “ORDERED that pursuant to 35 U.S.C. § 314, an *inter partes* review is hereby instituted as to claims 1–19 of the '654 patent on all grounds presented in the Petition; FURTHER ORDERED that the Motion for Joinder with IPR2023-00343 is *granted*, and Petitioner is joined as a petitioner to IPR2023-00343.”

IPR2023-00579 was filed by LG Electronics Inc., LG Electronics U.S.A., Inc., and Google LLC (hereafter “LG Electronics Inc. et al.”). Afterward, the Examiner notes that LG

Electronics Inc. and LG Electronics U.S.A., Inc. (“LGE”) and Patent Owner (PO) filed a Joint Motion to Terminate Proceeding as to LGE, which was granted, terminating LGE from the IPR2023-00579 proceeding. As the result, Google LLC remains as the only petitioner in the IPR2023-00579 proceeding.

12. Therefore, in light of the original prosecution history of the Bakhsh ‘654 patent, the following limitations (e.g., see: Notice of Allowability mailed 02/22/2016 in U.S. Patent Application No. 14/503,142) are considered important to the patentability of at least independent claim 1:

“generating a plurality of images...wherein said first image is an image of at least a portion of a first object generated by said first application...said second image is an image of at least a portion of a second object generated by said second application...and said third image is an image of at least a portion of a third object generated by said third application” (related to the examiner’s statement of reasons for allowance);

“displaying said plurality of images in a three-dimensional space...such that a first one in said order is displayed in a foreground of said three-dimensional space, a second one in said order is displayed in a background of said three-dimensional space, behind at least said first one in said order, and a third one in said order is displayed in a background of said three-dimensional space, behind at least said second one in said order” (related to the examiner’s amendment);

“replacing said plurality of images within said three-dimensional space with one of said first, second, and third objects corresponding to said one of said plurality of applications within a two-dimensional space in response to said first interaction” (related to the examiner’s statement of reasons for allowance); and

“modifying said one of said first, second, and third application-specific data in response to said second interaction” (related to the examiner’s statement of reasons for allowance).

Substantial New Question of Patentability

13. The presence or absence of “a substantial new question of patentability” determines whether or not reexamination is ordered. For a substantial new question of patentability to be present, it is only necessary that: (A) the prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and (B) the same question of patentability as to the claim has not been decided by the Office in an earlier concluded examination or review of the patent, raised to or by the Office in a pending reexamination or supplemental examination of the patent, or decided in a final holding of invalidity (after all appeals) by a federal court in a decision on the merits involving the claim. If a reexamination proceeding was terminated/vacated without resolving the substantial question of patentability question, it can be re-presented in a new reexamination request. It is not necessary that a “prima facie” case of unpatentability exist as to the claim in order for a substantial new question of patentability to be present as to the claim. Thus, a substantial new question of patentability as to a patent claim could be present even if the examiner would not necessarily reject the claim as either fully anticipated by, or obvious in view of, the prior art patents or printed publications (see: MPEP 2242(I)).

In a decision to order reexamination made on or after November 2, 2002, reliance on old art does not necessarily preclude the existence of a substantial new question of patentability that is based exclusively on that old art. See Public Law 107-273, 116 Stat. 1758, 1899-1906 (2002), which expanded the scope of what qualifies for a substantial new question of patentability upon which a reexamination may be based. Determinations on whether a substantial new question of patentability exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis. For example, a substantial new question of patentability may be based solely on old art where the old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request. Such material new argument or interpretation may be based solely on claim scope of the patent being reexamined (see: MPEP 2242(II)(A)).

14. For purposes of determination, independent claim 1 is used as a representative claim for the proposed rejections in the Request. The Examiner notes that independent claims 10 and 19 each contain substantially similar features as those disclosed in independent claim 1. The italicized/bolded sections of representative independent claim 1, shown directly below, are utilized by the Examiner to show how specific teachings of the proposed references create a substantial new question of patentability in light of the prosecution history as discussed above.

Claim 1:

A method for displaying a timeline associated with a plurality of applications and allowing a user to modify an output of one of said plurality of applications by interacting with said timeline, comprising:

receiving a plurality of inputs from a user, said plurality of inputs comprising at least first, second, and third inputs;

opening said plurality of applications in response to said plurality of inputs, said plurality of applications comprising at least first, second, and third applications, wherein each one of said plurality of applications is configured to (i) generate an object having application-specific data, (ii) display said object on a display device, and (iii) allow said user to modify at least a portion of said application-specific data by interacting with said object; and

displaying on said display device said timeline associated with said plurality of applications, comprising;

generating a plurality of images, said plurality of images comprising at least first, second, and third images, ***wherein said first image is an image of at least a portion of a first object generated by said first application*** and having first application-specific data, ***said second image is an image of at least a portion of a second object generated by said second application*** and having second application-specific data, ***and said third image is an image of at least a portion of a third object generated by said third application*** and having third application-specific data; and

displaying said plurality of images in a three-dimensional space on said display device in an order based on a last time that said user one of (i) opened said first application and interacted with said first object, (ii) opened said second application and interacted with said second object, and (iii) opened said third application and interacted with said third object, ***such that a first one in said order is displayed in a foreground of said three-dimensional space, a second one in said order is displayed in a background of said three-dimensional space, behind at least said first one in said order, and a third***

one in said order is displayed in a background of said three-dimensional space, behind at least said second one in said order; and

allowing said user to modify at least a portion of one of said first, second, and third application-specific data, comprising:

receiving a first interaction from said user with one of said plurality of images corresponding to one of said plurality of applications;

replacing said plurality of images within said three-dimensional space with one of said first, second, and third objects corresponding to said one of said plurality of applications within a two-dimensional space in response to said first interaction;

receiving a second interaction by said user with said one of said first, second, and third objects within said two-dimensional space; and

modifying said one of said first, second, and third application-specific data in response to said second interaction.

Discussion of References that Raise a SNO

15. All of the proposed references raise a substantial new question as noted below.

Miller '542 in view of Holecek and Mastering Windows

First, the teachings of the Miller '542 reference have been briefly summarized in the instant Request (see: Request, pp. 18-19). In general, the Miller '542 reference teaches a system for managing a plurality of windows (e.g., objects representing display output data from one or

more application programs) in a graphical user interface (GUI) by allowing the windows to be positioned and arranged within a true three-dimensional (3D) space (Miller '542: Abstract, column 1, lines 12-45, and column 3, lines 5-25; Figs. 4 and 5). The Miller '542 reference additionally teaches that when a window is selected by a user to be brought to the foreground, the window's corresponding 3D display object in the 3D desktop image may be oriented such that an actual 2D window is positioned over the top of the 3D display object, thereby giving the illusion that the 2D window actually exists in the 3D space (Miller '542: column 3, lines 26-52 and column 7, lines 20-37; Figs. 5 and 8).

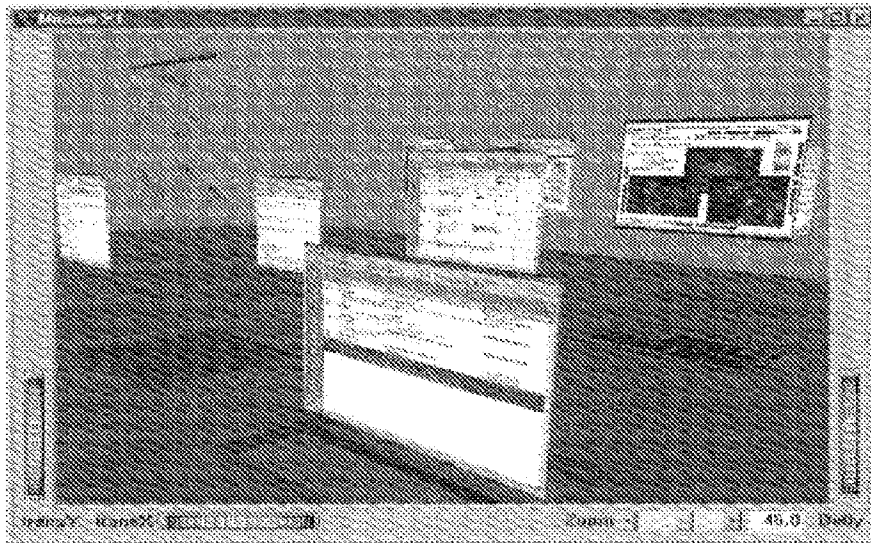


FIG. 5

Second, the teachings of the Holecek reference have been briefly summarized in the instant Request (see: Request, pp. 19-21). In general, the Holecek reference teaches a system for browsing through a plurality of windows (corresponding to application programs) on a user's desktop via a visual stack wherein the topmost window in the stack is in focus (Holecek: Abstract, column 1, line 61-column 2, line 4, and column 9, line 1-column 10, line 65; Fig. 2B).

The Holecek reference also specifically teaches wherein the ordering of the windows in the visual stack can be based on the order in which the windows were last in focus from most recent to least recent (Holecek: column 10, lines 16-42).

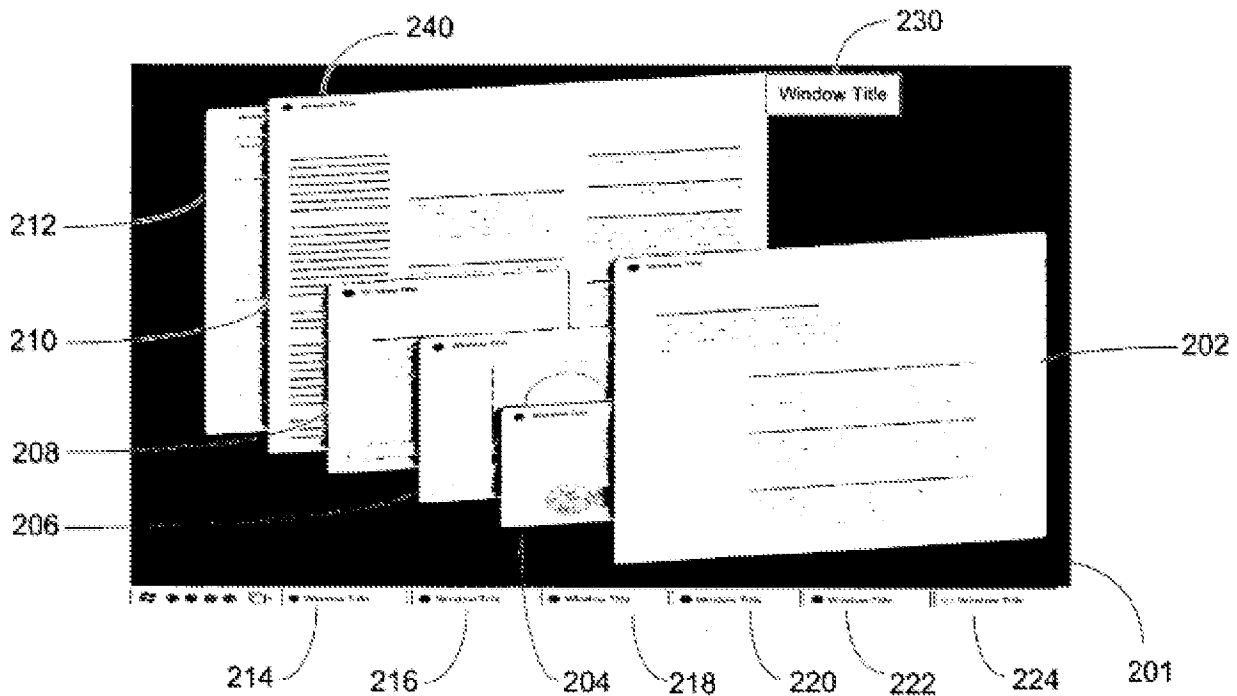


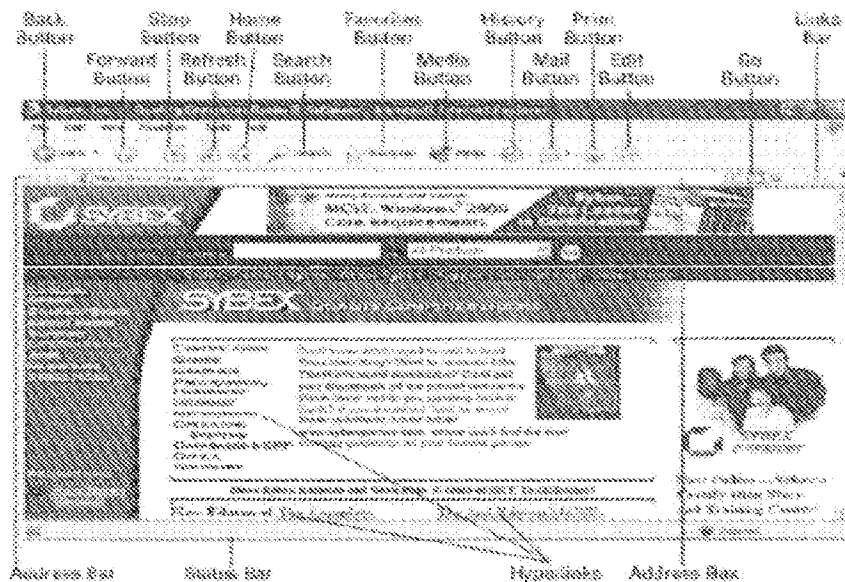
FIG. 2B

Third, the teachings of the Mastering Windows reference have been briefly summarized in the instant Request (see: Request, pp. 21-22). In general, the Mastering Windows reference is an all-encompassing book that details the specific functionality of the Windows XP (Home Edition) operating system. For example, p. 575 (Mastering Windows: Fig. 19.1) highlights the main features of the Internet Explorer (application program) window.

Using the Internet Explorer Interface

Figure 19.1 shows the main features of the Internet Explorer window.

FIGURE 19.1
The main features of
the Internet Explorer
window



Miller '542 in view of Holecek and Mastering Windows are cited in the Request as references used in combination to at least read on representative independent claim 1. As shown in the Request and discussed above, Miller '542 in view of Holecek and Mastering Windows appears to at least teach or suggest:

(Claim 1)

“generating a plurality of images...wherein said first image is an image of at least a portion of a first object generated by said first application...said second image is an image of at least a portion of a second object generated by said second application...and said third image is an image of at least a portion of a third object generated by said third application”
(e.g., see: Request, pp. 59-65);

“displaying said plurality of images in a three-dimensional space...such that a first one in said order is displayed in a foreground of said three-dimensional space, a second one in said order is displayed in a background of said three-dimensional space, behind at least said

first one in said order, and a third one in said order is displayed in a background of said three-dimensional space, behind at least said second one in said order” (e.g., see: Request, pp. 66-73);

“replacing said plurality of images within said three-dimensional space with one of said first, second, and third objects corresponding to said one of said plurality of applications within a two-dimensional space in response to said first interaction” (e.g., see: Request, pp. 77-81); and

“modifying said one of said first, second, and third application-specific data in response to said second interaction” (e.g., see: Request, pp. 82-86).

As noted above, the Miller ‘542 reference was neither previously cited/considered nor applied in a rejection to any of the claims during the original prosecution history of the Bakhsh ‘654 patent. Additionally, the Miller ‘542 reference was also never cited in any of the three AIA petitions (i.e., IPR2020-01418, IPR2023-00343, and IPR2023-00579) involving the Bakhsh ‘654 patent.

As also noted above, the Holecek and Mastering Windows references were neither previously cited/considered nor applied in a rejection to any of the claims during the original prosecution history of the Bakhsh ‘654 patent. Additionally, the Holecek and Mastering Windows references were also never cited in two of the three AIA petitions (i.e., IPR2023-00343 and IPR2023-00579) involving the Bakhsh ‘654 patent. As further noted above, the Holecek and Mastering Windows references were cited in IPR2020-01418 against claims 1-5, 7-13, and 15-19 of the Bakhsh ‘654 patent. However, the IPR2020-01418 proceeding was terminated before the PTAB decided whether to institute a trial or produce a final written decision. Thus, the Board did not address the merits of the Holecek and Mastering Windows references. Further,

the Holecek and Mastering Windows references are now being cited in new/different combinations, as compared to IPR2020-01418, with at least the primary Miller ‘542 reference.

It is agreed that the consideration of Miller ‘542 in view of Holecek and Mastering Windows raises a SNQ as to representative independent claim 1 of the Bakhsh ‘654 patent as pointed out above. Therefore, there is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not claims 1-19 are patentable.

Accordingly, Miller ‘542 in view of Holecek and Mastering Windows raises a substantial new question of representative independent claim 1, which question has not been decided in a previous examination of the Bakhsh ‘654 patent nor was there a final holding of invalidity of said claim by the Federal Courts regarding the Bakhsh ‘654 patent.

Miller ‘542 in view of Holecek, Mastering Windows, Miller ‘358, and Koga

The teachings of the Miller ‘542, Holecek, and Mastering Windows references have been described directly above.

First, the teachings of the Miller ‘358 reference have been briefly summarized in the instant Request (see: Request, p. 23). In general, the Miller ‘358 reference teaches organizing two and/or three-dimensional computer applications on a display in a three-dimensional viewing perspective (Miller ‘358: Abstract; Figs. 4 and 6). The Miller ‘358 reference also teaches causing one of the application windows of a cube (3D) to occupy an entire application workspace, by performing a predetermined input via a user-input device (Miller ‘358: column 6, line 37-column 7, line 12; Fig. 6).

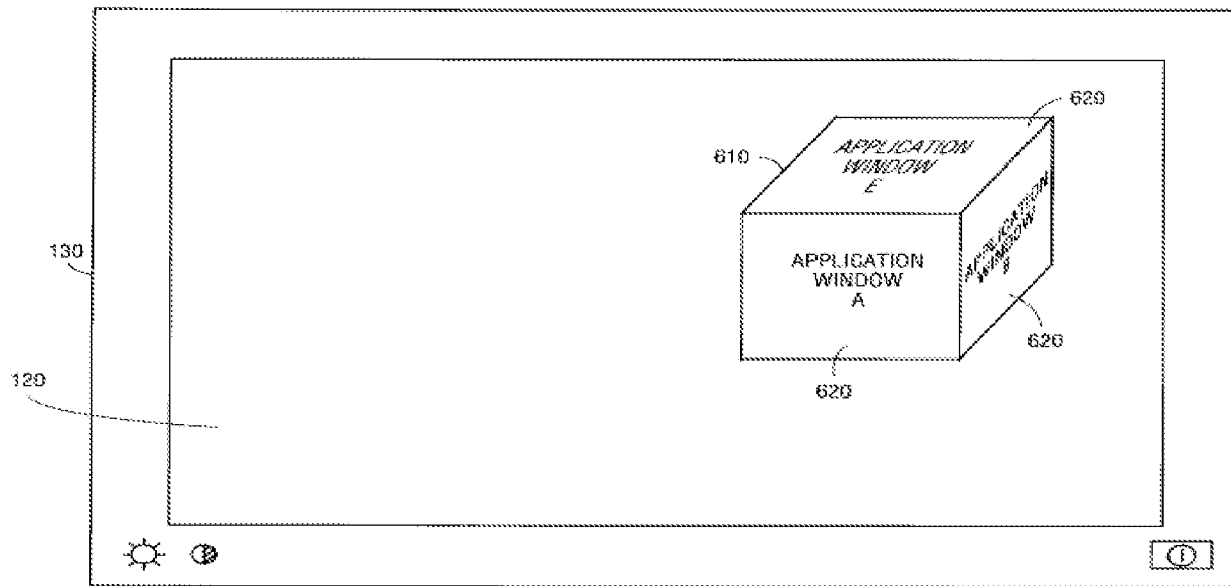


FIG. 6

Second, the teachings of the Koga reference have been briefly summarized in the instant Request (see: Request, pp. 23-24). The Koga reference teaches displaying user-selectable objects (e.g., thumbnail display images of web pages) in a three-dimensional display space using a three-dimensional coordinate system (Koga: Paragraphs 11, 13, and 19; Fig. 5). The Koga reference also teaches replacing a user-selectable object in the three-dimensional display space with a corresponding web page in a two-dimensional page display area (Koga: Paragraphs 28 and 29; Fig. 6).

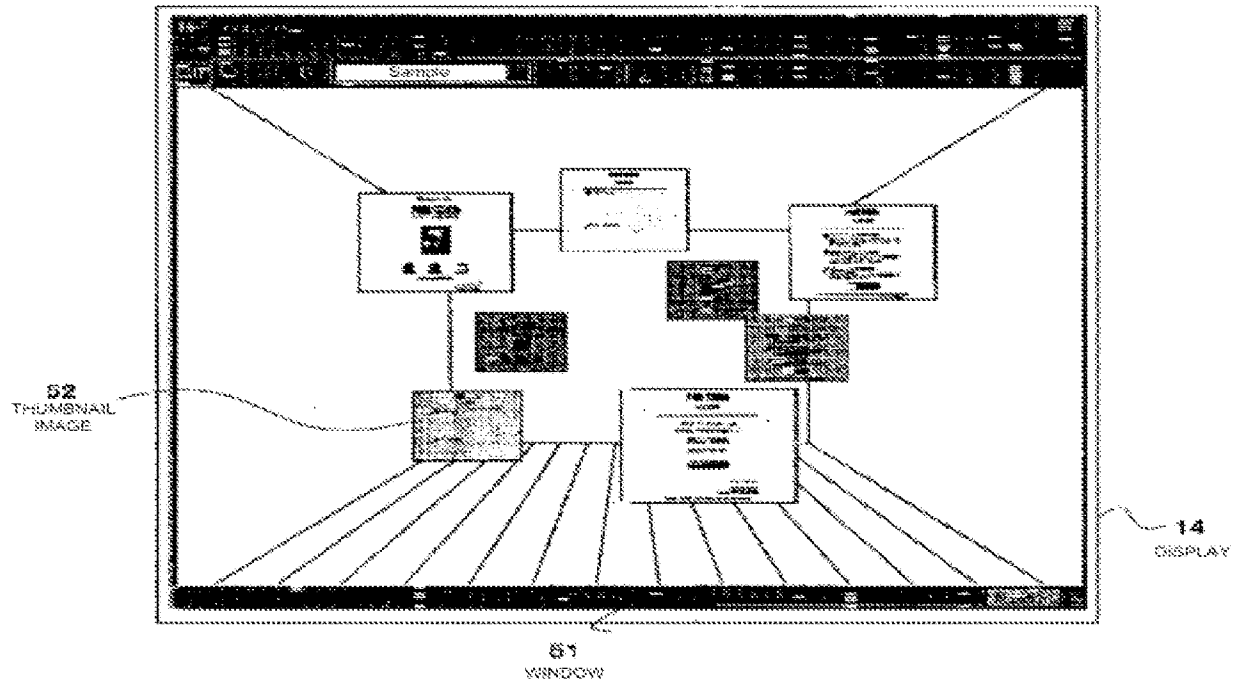


FIG. 5

Miller '542 in view of Holecek, Mastering Windows, Miller '358, and Koga are cited in the Request as references used in combination to at least read on representative independent claim 1. As shown in the Request and discussed above, Miller '542 in view of Holecek, Mastering Window, Miller '358, and Koga appears to at least teach or suggest:

(Claim 1)

“generating a plurality of images...wherein said first image is an image of at least a portion of a first object generated by said first application...said second image is an image of at least a portion of a second object generated by said second application...and said third image is an image of at least a portion of a third object generated by said third application”

(e.g., see: Request, pp. 59-65);

“displaying said plurality of images in a three-dimensional space...such that a first one in said order is displayed in a foreground of said three-dimensional space, a second one in said order is displayed in a background of said three-dimensional space, behind at least said

first one in said order, and a third one in said order is displayed in a background of said three-dimensional space, behind at least said second one in said order” (e.g., see: Request, pp. 66-73 and 145-148);

“replacing said plurality of images within said three-dimensional space with one of said first, second, and third objects corresponding to said one of said plurality of applications within a two-dimensional space in response to said first interaction” (e.g., see: Request, pp. 77-81 and 148-151); and

“modifying said one of said first, second, and third application-specific data in response to said second interaction” (e.g., see: Request, pp. 82-86).

As noted above, the Miller ‘542, Miller ‘358, and Koga references were neither previously cited/considered nor applied in a rejection to any of the claims during the original prosecution history of the Bakhshash ‘654 patent. Additionally, the Miller ‘542, Miller ‘358, and Koga references were also never cited in any of the three AIA petitions (i.e., IPR2020-01418, IPR2023-00343, and IPR2023-00579) involving the Bakhshash ‘654 patent.

As also noted above, the Holecek and Mastering Windows references were neither previously cited/considered nor applied in a rejection to any of the claims during the original prosecution history of the Bakhshash ‘654 patent. Additionally, the Holecek and Mastering Windows references were also never cited in two of the three AIA petitions (i.e., IPR2023-00343 and IPR2023-00579) involving the Bakhshash ‘654 patent. As further noted above, the Holecek and Mastering Windows references were cited in IPR2020-01418 against claims 1-5, 7-13, and 15-19 of the Bakhshash ‘654 patent. However, the IPR2020-01418 proceeding was terminated before the PTAB decided whether to institute a trial or produce a final written decision. Thus, the Board did not address the merits of the Holecek and Mastering Windows references. Further,

the Holecek and Mastering Windows references are now being cited in new/different combinations, as compared to IPR2020-01418, with at least the primary Miller ‘542 reference.

It is agreed that the consideration of Miller ‘542 in view of Holecek, Mastering Windows, Miller ‘358, and Koga raises a SNQ as to representative independent claim 1 of the Bakhsh ‘654 patent as pointed out above. Therefore, there is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not claims 1-19 are patentable.

Accordingly, Miller ‘542 in view of Holecek, Mastering Windows, Miller ‘358, and Koga raises a substantial new question of representative independent claim 1, which question has not been decided in a previous examination of the Bakhsh ‘654 patent nor was there a final holding of invalidity of said claim by the Federal Courts regarding the Bakhsh ‘654 patent.

Hellyar

The Hellyar reference is cited in the Request (e.g., see: Request, pp. 22-23, 142-144, and 153) as a reference used in combination with (1) the Miller ‘542, Holecek, and Mastering Windows references, and (2) the Miller ‘542, Holecek, Mastering Windows, Miller ‘358, and Koga references, each of which are cited and discussed above, to only read on dependent claim 5 of the Bakhsh ‘654 patent. Therefore, the Hellyar reference alone does not raise a SNQ. However, in light of the SNQs raised above in view of (1) the Miller ‘542, Holecek, and Mastering Windows references, and (2) the Miller ‘542, Holecek, Mastering Windows, Miller ‘358, and Koga references, the Hellyar reference also raises an SNQ at least in view of its dependency.

As noted above, the Hellyar reference was neither previously cited/considered nor applied in a rejection to any of the claims during the original prosecution history of the Bakhshash '654 patent. Additionally, the Hellyar reference was also never cited in two of the three AIA petitions (i.e., IPR2023-00343 and IPR2023-00579) involving the Bakhshash '654 patent. As further noted above, the Hellyar reference was cited in IPR2020-01418 against claim 5 of the Bakhshash '654 patent. However, the IPR2020-01418 proceeding was terminated before the PTAB decided whether to institute a trial or produce a final written decision. Thus, the Board did not address the merits of the Hellyar reference. Further, the Hellyar reference is now being cited in new/different combinations, as compared to IPR2020-01418, with at least the primary Miller '542 reference.

It is agreed that the consideration of the Hellyar reference in combination with (1) the Miller '542, Holecek, and Mastering Windows references, and (2) the Miller '542, Holecek, Mastering Windows, Miller '358, and Koga references, raises a SNQ as to the claims of the Bakhshash '654 patent as pointed out above. Therefore, there is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not these claims are patentable.

Accordingly, the Hellyar reference in combination with (1) the Miller '542, Holecek, and Mastering Windows references, and (2) the Miller '542, Holecek, Mastering Windows, Miller '358, and Koga references, raises a substantial new question, which question has not been decided in a previous examination of the Bakhshash '654 patent nor was there a final holding of invalidity of said claims by the Federal Courts regarding the Bakhshash '654 patent.

Anderson

The Anderson reference is cited in the Request (e.g., see: Request, pp. 25-26 and 153-158) as a reference used in combination with (1) the Miller ‘542, Holecek, and Mastering Windows references, and (2) the Miller ‘542, Holecek, Mastering Windows, Miller ‘358, and Koga references, each of which are cited and discussed above, to only read on dependent claims 6 and 14 of the Bakhash ‘654 patent. Therefore, the Anderson reference alone does not raise a SNQ. However, in light of the SNQs raised above in view of (1) the Miller ‘542, Holecek, and Mastering Windows references, and (2) the Miller ‘542, Holecek, Mastering Windows, Miller ‘358, and Koga references, the Anderson reference also raises an SNQ at least in view of its dependency.

As noted above, the Anderson reference was neither previously cited/considered nor applied in a rejection to any of the claims during the original prosecution history of the Bakhash ‘654 patent. Additionally, the Anderson reference was also never cited in any of the three AIA petitions (i.e., IPR2020-01418, IPR2023-00343, and IPR2023-00579) involving the Bakhash ‘654 patent.

It is agreed that the consideration of the Anderson reference in combination with (1) the Miller ‘542, Holecek, and Mastering Windows references, and (2) the Miller ‘542, Holecek, Mastering Windows, Miller ‘358, and Koga references, raises a SNQ as to the claims of the Bakhash ‘654 patent as pointed out above. Therefore, there is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not these claims are patentable.

Accordingly, the Anderson reference in combination with (1) the Miller ‘542, Holecek, and Mastering Windows references, and (2) the Miller ‘542, Holecek, Mastering Windows,

Miller ‘358, and Koga references, raises a substantial new question, which question has not been decided in a previous examination of the Bakhsh ‘654 patent nor was there a final holding of invalidity of said claims by the Federal Courts regarding the Bakhsh ‘654 patent.

Scope of Reexamination

16. Therefore, claims 1-19 **will be** reexamined as requested in the Request.

35 USC 325(d)

17. 35 USC 325(d) states in part that “[i]n determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.”. Thus, in order for the Director to exercise discretion as to whether to Order a reexamination proceeding under chapter 30, the request must first be determined to be based on the same or substantially the same prior art or arguments that previously were presented to the Office.

18. A review of the Office post grant history for the Bakhsh ‘654 patent, indicates that the patent has been the subject of three prior Office post grant challenges.

IPR2020-01418

19. On August 4, 2020, Petitioner Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. filed a petition for *inter partes* review of claims 1-5, 7-13 and 15-19 the Bakhsh ‘654 patent (IPR2020-01418) which asserted the following grounds as raising a reasonable likelihood in prevailing (RLP):

RLP #	Claims Challenged	35 USC §	References
1	1-4, 7-13 and 15-19	103(a)	Holecek, XP
2	5	103(a)	Holecek, XP, Hellyar

On March 15, 2021, the Patent Trial and Appeal Board (PTAB) issued a decision dismissing the petition and terminating the proceeding in light of a joint motion to dismiss the proceeding in view of a settlement between the parties prior to any decision on institution.

IPR2023-00343

On December 13, 2022, Petitioner Apple Inc., filed a petition for *inter partes* review of claims 1-19 the Bakhsh '654 patent (IPR2023-00343) which asserted the following grounds as raising a reasonable likelihood in prevailing (RLP):

RLP #	Claims Challenged	35 USC §	References
1	1-5, 7-8, 10-13, 15-17 and 19	103(a)	Anthony, Hanggie
2	6, 9, 14 and 18	103(a)	Anthony, Hanggie, Matthews
3	1-5, 7-8, 10-13, 15-17 and 19	103(a)	Hanggie, Anthony
4	6, 9, 14 and 18	103(a)	Hanggie, Anthony, Mathews

On July 6, 2023, the PTAB issued a decision instituting *inter partes* review as to all challenged claims. As of the mailing date of this Order, the PTAB has yet to issue a final written decision.

IPR2023-00579

On February 10, 2023, Petitioner LG Electronics Inc., LG Electronics U.S.A., Inc., and Google LLC, filed a petition for *inter partes* review of claims 1-19 of the Bakhsh '654 patent (IPR2023-00579) which copied and asserted the identical grounds as presented in IPR2023-00343 and filed a motion for joinder with IPR2023-00343.

On August 7, 2023, the PTAB granted institution of the petition and also granted petitioner's motion for joinder with IPR2023-00343.

Prior to institution and joinder, Petitioner LG Electronics Inc. and LG Electronics U.S.A., Inc. settled with patent owner, and thus, Google LLC and Apple Inc., are now the remaining petitioners in the joined proceeding. As of the mailing date of this Order, the PTAB has yet to issue a final written decision.

A comparison between the prior art and arguments presented in the instant Request for *Ex Parte* reexamination of the Bakhsh '654 patent indicates that the Request is not based on the same or substantially the same prior art or arguments as previously presented to the Office.

90/019,351

As stated above, the current reexamination request (90/019,351) filed by an anonymous third-party requester asserted the following grounds as raising a substantial new question of patentability (SNQ) as to claims 1-19 of the Bakhsh '654 patent.

SNQ #	Claims Challenged	35 USC §	References
1	1-19	103(a)	Miller '542, Holecek, Mastering Windows ¹
2	5	103(a)	Miller '542, Holecek, Mastering Windows, Hellyar
3	6 and 14	103(a)	Miller '542, Holecek, Mastering Windows, Anderson
4	1-19	103(a)	Miller '542, Holecek, Mastering Windows, Miller '358, Koga
5	5	103(a)	Miller '542, Holecek, Mastering Windows, Miller '358, Koga, Hellyar
6	6 and 14	103(a)	Miller '542, Holecek, Mastering Windows, Miller '358, Koga, Anderson

As an initial matter, there are no grounds asserted as raising an SNQ in the current request that are identical to any grounds previously presented to the Office and any of the three prior IPR petitions discussed above. While the Holecek, Mastering Windows (a.k.a. XP) and Hellyar prior art references were previously presented in IPR2020-00418, each of the six

¹ While the 90/019,351 cites the Mastering Windows prior art reference in each of the asserted grounds in their request, it is noted that it is identical to the XP reference cited IPR2020-01418, and is thus the same reference.

Art Unit: 3992

grounds presented in the 90/019,351 request now includes the Miller '542 prior art reference as a primary reference. The Miller '542 contains a different disclosure and presents different teachings than Holecek, Mastering Windows, Hellyar or any of the prior art presented in the three prior petitions. Thus, the art and arguments presented in the 90/019,351 request are both not the same or substantially the same as the art or arguments previously presented to the Office and therefore the statutory threshold pursuant to 35 USC 325(d) for the Director to exercise discretion so as to reject this request is not met.

However, even if it was determined that the Miller '542 reference provided cumulative teachings to Holecek, Mastering Windows, or Hellyar, such that that 90/019,351 request was based on substantially the same prior art and or substantially the same arguments as IPR2020-01418, the Director would decline to exercise discretion under 325(d) to reject this request in view of the following facts:

- 1.) There is no evidence that the anonymous third-party requester is the same RPI as the petitioner for IPR2020-01418, and
- 2.) Since the PTAB terminated the IPR2020-01418 petition prior to any decision on institution, the Office never evaluated any of the prior art references or associated arguments, and
- 3.) There has been no prior finding of abusive challenges to the Bakhshash '654 patent by third party requester.

Accordingly, *Ex Parte* reexamination is Ordered for the Bakhshash '654 patent, in view of the determination above that a SNQ has been raised in the instant Request for Reexamination.

Conclusion

20. Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to “an applicant” and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that reexamination proceedings “will be conducted with special dispatch” (37 CFR 1.550(a)). Extension of time in *Ex Parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

The Patent Owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 9,304,654 B2 throughout the course of this reexamination proceeding. The Third Party Requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

21. All correspondence relating to this *Ex Parte* reexamination proceeding should be directed as follows:

Electronically: Registered users may submit via Patent Center at <https://patentcenter.uspto.gov/>.

By Mail to: Mail Stop *Ex Parte* Reexam
 Central Reexamination Unit
 Commissioner for Patents
 United States Patent & Trademark Office
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
 Central Reexamination Unit

By hand: Customer Service Window

Randolph Building
401 Dulany Street
Alexandria, VA 22314

For electronic transmissions, 37 CFR 1.8(a)(1)(i)(C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the USPTO patent electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

Any inquiry concerning this communication should be directed to Adam Basehoar at telephone number 571-272-4121.

/Adam L Basehoar/
Primary Examiner, Art Unit 3992

Conferees:

/JOSHUA D CAMPBELL/
Primary Examiner, Art Unit 3992

/ALEXANDER J KOSOWSKI/
Supervisory Patent Examiner, Art Unit 3992