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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/019,352	12/27/2023	9696868		4605

125600 7590 03/25/2024
Fitzsimmons IP Law
PO Box 199
Gardena, CA 90248

EXAMINER

CAMPBELL, JOSHUA D

ART UNIT	PAPER NUMBER
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3992

MAIL DATE	DELIVERY MODE
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03/25/2024

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

REEXAMINATION CONTROL NO. 90/019,352 .

PATENT UNDER REEXAMINATION 9696868 .

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. 90/019,352	Patent Under Reexamination 9696868	
	Examiner JOSHUA D CAMPBELL	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 27 December 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.

/JOSHUA D CAMPBELL/
Primary Examiner, Art Unit 3992

cc:Requester (if third party requester)

Decision on Request

1) A substantial new question (SNQ) of patentability affecting claims 1-20 of United States Patent Number 9,696,868 (hereinafter “ ‘868 Patent”) is raised by the request for *ex parte* reexamination filed December 27, 2023.

Information Disclosure Statement

2) Where the IDS citations are submitted but not described, the examiner is only responsible for cursorily reviewing the references. The initials of the examiner on the PTO-1449 indicate only that degree of review unless the reference is either applied against the claims, or discussed by the examiner as pertinent art of interest, in a subsequent office action.

See Guidelines for Reexamination of Cases in View of *In re Portola Packaging, Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997), 64 FR at 15347, 1223 Off. Gaz. Pat. Office at 125 (response to comment 6).

Consideration by the examiner of the information submitted in an IDS means that the examiner will consider the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner placed adjacent to the citations on the PTO-1449 or PTO/SB/08A and 08B or its equivalent mean that the information has been considered by the examiner to the extent noted above.

Regarding IDS submissions MPEP 2256 recites the following: "Where patents, publications, and other such items of information are submitted by a party (patent owner) 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."

Affidavits, Declarations, or Other Written Evidence

- 3) The Examiner 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.
- 4) The Examiner recognizes that a declaration of Dr. Chandrajit Bajaj (Exhibit 1011) has been referenced in support of Third-Party Requester. The declaration has been considered and made of record. In the instant case, the submitted Bajaj Declaration at least further explains the contents of the prior art patents and printed publications in more detail.
- 5) The Examiner also recognizes the declaration of Dr. Sylvia Hall-Ellis (Exhibit 1013) has been referenced in support of Third-Party Requester. In the instant case, the Hall-Ellis declaration further discusses the date of public availability to some of the pertinent references of this reexamination proceeding.

Prior art cited in the Request

- 6) The present request indicates that the Requester considers that a substantial new question of patentability is raised as to claims 1-20 of the '868 Patent by the following prior art references:
- a. **Miller '542** – U.S. Patent No. 6,229,542
 - b. **Holecek** – U.S. Patent No. 8,341,541
 - c. **XP** – “Mastering Windows XP Home Edition”
 - d. **Dalal** – U.S. Patent No. 6,271,858
 - e. **Miller '358** – U.S. Patent No. 6,597,358
 - f. **Koga** – Japan Patent Application Publication No. JP2002/132828 (Certified Translation)
 - g. **Anderson** – U.S. Patent No. 7,010,755

Prosecution History

7) The '868 Patent application was assigned serial number 14/614,708 (hereinafter “‘708 application”), filed February 5, 2015. During the original prosecution, the ‘708 application initially included claims 21-40, by way of a preliminary amendment filed on October 27, 2016. The ‘708 application is a continuation of U.S. patent application No. 14/503,142 (U.S. Patent No. 9,304,654), filed September 30, 2014, which is continuation of application No. 12/751,879 (U.S. Patent No. 8,881,048), filed on May 31, 2010, which is a continuation of application No. 11/531,676 (U.S. Patent No. 7,735,018), filed on September 13, 2006, all of which rely on Provisional Application 60/717,019, filed on September 13, 2005. Prior to any office action, the examiner contacted Patent Owner’s (PO) representative to recommend the filing of a terminal disclaimer in order to obviate a double patenting rejection. The patent owner filed a proper terminal disclaimer to U.S. Patent Nos. 9,304,654, 8,881,048, and 7,735,018, which was approved. In response, the application was passed to allowance in the Notice of Allowance mailed March 27, 2017. The examiner made the following statement of reasons for allowance in the notice of allowance:

The following is an examiner’s statement of reasons for allowance: The present invention teaches allowing a user to switch between a plurality of opened applications within a two-dimensional space, by generating specific images of each application and displaying them collectively within a three-dimensional space in a particular order. The prior art fail to explicitly teach all of the limitations of the amended claims.

The ‘708 application’s parent application 14/503,142 (U.S. Patent No. 9,304,654), was also allowed without any prior office action in response to the filing and approval of a terminal disclaimer to U.S. Patent Nos. 8,881,048, and 7,735,018. The following examiner’s amendment was made in the notice of allowance for the 14/503,142 application (using claim 67 as example):

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 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.

The examiner made the following statement of reasons for allowance in the notice of allowance for application 14/503,142:

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.

Following the issuance of the '868 Patent, IPR2020-01419 was requested to challenge claims 1-5, 7-14, and 16-20 in view of Holecek, XP, and Dalal.

Ground	Claims	§ 103(a) Prior Art Basis
1	1-5, 7-11, 14, and 16-20	Holecek and XP
2	12-13	Holecek, XP, and Dalal

On March 15, 2021, the PTAB issued a decision to terminate the *Inter Partes* Review based on a settlement prior to institution of trial.

IPR2023-00344 was also requested to challenge claims 1-20 in view of Anthony, Hanggie, Matthews, and Robertson.

Ground	Claim(s)	\$103 Combination
1A	1-5, 9-14, and 18-20	Anthony in view of Hanggie
1B	6-8, 15-17	Anthony in view of Hanggie and Matthews
1C	7	Anthony in view of Hanggie and Matthews and Robertson
2A	1-5, 9-14, and 18-20	Hanggie in view of Anthony
2B	6-8, 15-17	Hanggie in view of Anthony and Matthews
2C	7	Hanggie in view of Anthony and Matthews and Robertson

On July 17, 2023, the PTAB issued a decision Granting Institution of *Inter Partes* Review. To date no final decision has been issued in this proceeding.

Additionally, IPR2023-00578 was requested to challenge claims 1-20 in view of Anthony, Hanggie, Matthews, and Robertson.

Ground	Claim(s)	\$103 Combination
1A	1-5, 9-14, and 18-20	Anthony in view of Hanggie
1B	6-8, 15-17	Anthony in view of Hanggie and Matthews
1C	7	Anthony in view of Hanggie and Matthews and Robertson
2A	1-5, 9-14, and 18-20	Hanggie in view of Anthony
2B	6-8, 15-17	Hanggie in view of Anthony and Matthews
2C	7	Hanggie in view of Anthony and Matthews and Robertson

On May 31, 2023, the PTAB issued a decision to terminate LG Electronics Inc. and LG Electronics U.S.A from the *Inter Partes* Review proceeding based on a settlement prior to institution of trial. On

August 7, 2023, the PTAB issued a decision Granting Institution of *Inter Partes* Review with Google LLC as the only remaining petitioner. In this decision, the PTAB also granted a Motion for Joinder with IPR2023-0344.

Thus, as it currently stands based on the prosecution history of the ‘708 application, it appears that the claims of the ‘868 Patent were allowed at least in part based on the limitations regarding “allowing a user to switch between said plurality of application, comprising; generating at least 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; replacing all objects corresponding to said plurality of applications that are visible in said 2D space with said plurality of images, said plurality of images being displayed in said 3D immersive space and 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, wherein a first one in said order is displayed in a foreground of said 3D immersive space, a second one in said order is displayed in a background of said 3D immersive space behind at least said first one in said order, and a third one in said order is displayed in said background of said 3D immersive space behind at least said second one in said order;” found in patent claim 1 (similar limitations found in claims 10 and 19).

Priority

8) As mentioned above, the ‘738 Patent is a continuation of U.S. patent application No. 14/503,142 (U.S. Patent No. 9,304,654), filed September 30, 2014, which is continuation of application No. 12/751,879 (U.S. Patent No. 8,881,048), filed on May 31, 2010, which is a continuation of application

No. 11/531,676 (U.S. Patent No. 7,735,018), filed on September 13, 2006, all of which rely on
Provisional Application 60/717,019, filed on September 13, 2005.

Substantial New Question of Patentability

9) The italicized sections of claim 1 (similar limitations found in claims 10 and 19) are utilized by the examiner to show how specific teachings of the proposed references create a substantial new question of patentability.

1. A method for using a two-dimensional (2D) space to selectively interact with a plurality of applications open on a device and a three-dimensional (3D) immersive space to switch between said plurality of application, said device having a fixed resolution display, 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 for each one of said plurality of applications (i) an object is generated having application-specific data, (ii) said object is displayed in said 2D space on said fixed resolution display, and (iii) said user is allowed to modify at least a portion of said application-specific data by interacting with said object;
allowing a user to switch between said plurality of application, comprising;
generating at least 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;

replacing all objects corresponding to said plurality of applications that are visible in said 2D space with said plurality of images, said plurality of images being displayed in said 3D immersive space and 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, wherein a first one in said order is displayed in a foreground of said 3D immersive space, a second one in said order is displayed in a background of said 3D immersive space behind at least said first one in said order, and a third one in said order is displayed in said background of said 3D immersive space behind at least said second one in said order;

allowing said user to move said plurality of images, wherein (i) movement of one of said plurality of images results in movement of all of said plurality of images, and (ii) continued movement in one direction of one of said plurality of images results in a perception to said user that said one of said plurality of images is moved off of said fixed resolution display; and allowing said user to delete at least one of said plurality of images from said 3D immersive space, wherein deletion of said second one in said order results in said third one in said order being moved to a location in said 3D immersive space where said second one in said order was located prior to said deletion; and

allowing said user to interact with one of said first, second, and third applications, comprising:

receiving a selection from said user of one of said plurality of images corresponding to one of said plurality of applications;

replacing said plurality of images within said 3D immersive space with one of said first, second, and third objects corresponding to said one of said plurality of applications within said 2D space in response to said selection;

receiving at least one interaction by said user with said one of said first, second, and third objects within said 2D space; and
modifying said one of said first, second, and third application-specific data in response to said at least one interaction.

Miller '542 in view of Holecek and XP

10) The Request shows that Miller '542 in view of Holecek and XP provide teachings relevant to the determination of patentability regarding the following limitations, for claim 1:

allowing a user to switch between said plurality of application, comprising;

XP describes a user's ability to use the taskbar to switch between windows and different applications (pages 14 and 181-182 of XP).

Holecek describes browsing among windows that represent application programs using an illustrative stack (Fig. 2C, column 10, lines 5-10, and column 11, lines 32-41 of Holecek).

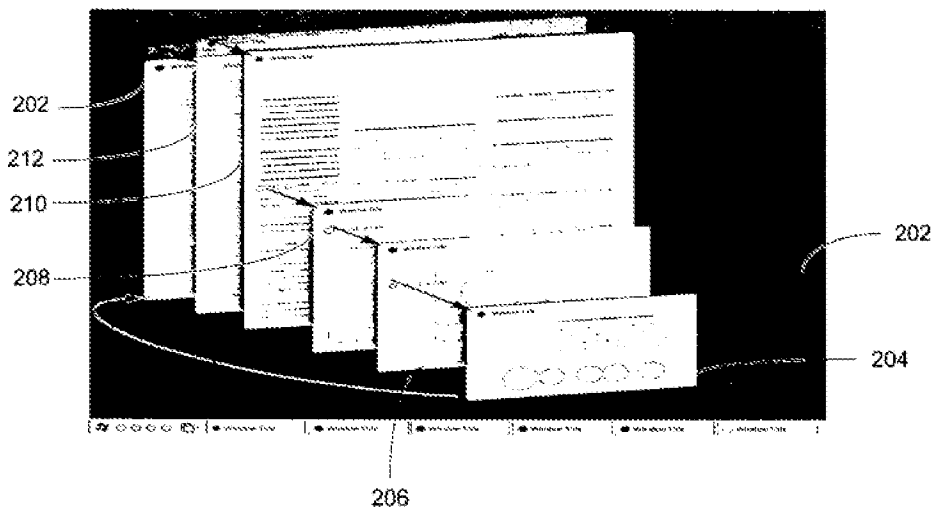


FIG. 2C

generating at least 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;

Miller '542 describes generating multiple windows by applications that contain application data for their respective applications, said windows being displayed in a 3D space (Fig. 5 and column 1, lines 16-20 of Miller '542).



Holecek describes generating windows that represent application programs, the windows containing application data for their respective programs. Holecek describes displaying said windows using an illustrative stack (Fig. 2B, column 9, lines 18-19, and column 9, line 67-column 10, line 24 of Holecek).

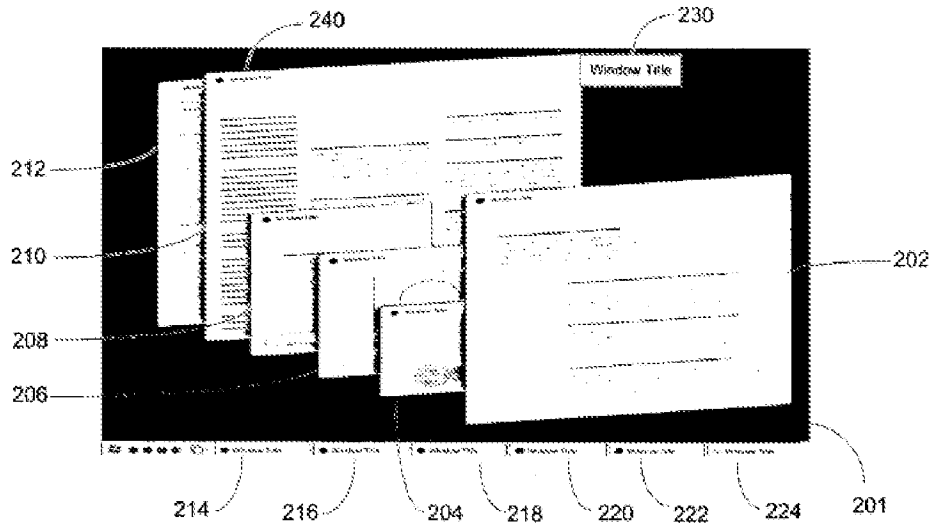
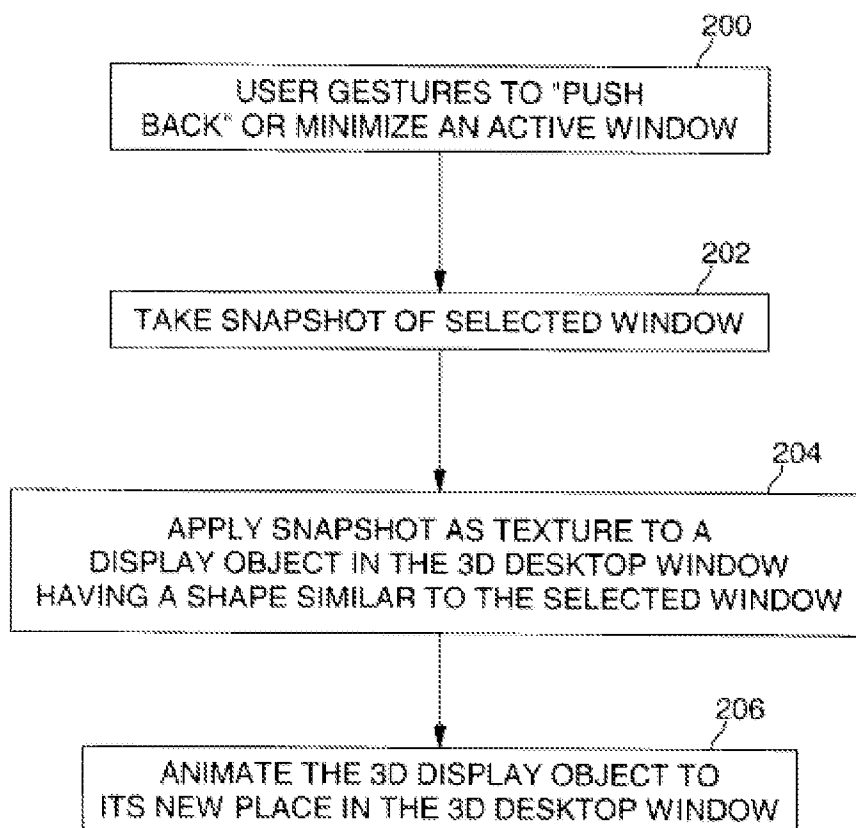


FIG. 2B

XP describes generating windows that represent application programs, the windows containing application data for their respective programs (pages 272 and 639 of XP).
replacing all objects corresponding to said plurality of applications that are visible in said 2D space with said plurality of images, said plurality of images being displayed in said 3D immersive space and 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, wherein a first one in said order is displayed in a foreground of said 3D immersive space, a second one in said order is displayed in a background of said 3D immersive space behind at least said first one in said order, and a third one in said order is displayed in said background of said 3D immersive space behind at least said second one in said order;

Miller '542 describes a process of transforming the pixels of 2D windows onto similarly shaped 3D display objects based on a "Push Back" gesture by the user at which point the objects are displayed in a 3D space (Figs. 5 and 7, column 3, lines 36-39, column 4, lines 6-8 and 17-21, column 6, line 66-column 7, line 19, and column 7, line 60-column 8, line 16 of Miller '542).



Holecek describes the ordering of the windows in a 3D space may be based on the order in which the windows were last in focus from most recent to least recent (column 10, lines 31-42 of Holecek).

The Miller '542, Holecek, and XP references were not previously discussed by the examiner nor applied to claims 1-20 in the prior examination of the patent as discussed above. Additionally, claims 1-20 were not subject to any Final Written Decision in view of Miller '542, Holecek, or XP in the IPR proceedings discussed above.

It is agreed that Miller '542 in view of Holecek and XP raises a substantial new question of patentability with respect to at least independent claims 1, 10, and 19 of the '868 Patent. There is a substantial likelihood that an examiner would consider these new, non-cumulative technological teachings important in deciding whether or not these claims are patentable.

Accordingly, Miller '542 in view of Holecek and XP raises a substantial new question of patentability with respect to at least claims 1-11 and 14-20 of the '868 Patent, a question which has not been decided in a previous examination of the '868 Patent nor was there a final holding of invalidity by the Federal Courts regarding the '868 Patent.

Miller '542 in view of Holecek, XP, and Dalal

11) The Dalal reference has been cited in combination with Miller '542, Holecek, and XP in the Request as part of the asserted SNQ. As stated above, the combination of Miller '542, Holecek, and XP was not previously discussed by the examiner nor applied to claims 1-20 in the prior examination of the '868 patent. The Dalal reference was not previously discussed by the examiner nor applied to claims 1-20 in the prior examination. The Dalal reference, in combination with the Miller '542, Holecek, and XP references raises an SNQ at least based on the discussion found of above regarding the combination of Miller '542, Holecek, and XP. The Request shows that the combination of Miller '542, Holecek, and XP provide teachings that are relevant to the limitations noted above which may have been material in determining the patentability of the '868 Patent claims at the time of allowance.

It is agreed that the consideration of Dalal in combination with Miller '542, Holecek, and XP raises an SNQ with respect to at least independent claims 1, 10, and 19 of the '868 Patent based on the teachings of Miller '542, Holecek, and XP cited above. 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 combination of the Dalal reference with Miller '542, Holecek, and XP raises a substantial new question of patentability with respect to at least independent claims 1, 10, and 19 of the '868 Patent, a question which has not been decided in a previous examination. In addition, there has been no final holding of invalidity by the Federal Courts regarding the '868 Patent.

Miller '542 in view of Holecek, XP, Miller '358, and Koga

12) The Request shows that Miller '542 in view of Holecek, XP, Miller '358, and Koga provide teachings relevant to the determination of patentability regarding the following limitations, for claim 1:

allowing a user to switch between said plurality of application, comprising;

XP describes a user's ability to use the taskbar to switch between windows and different applications (pages 14 and 181-182 of XP).

Holecek describes browsing among windows that represent application programs using an illustrative stack (Fig. 2C, column 10, lines 5-10, and column 11, lines 32-41 of Holecek).

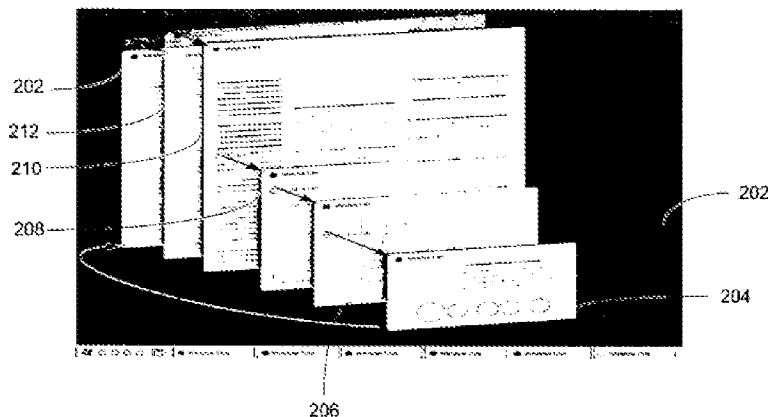


FIG. 2C

generating at least 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;

Miller '542 describes generating multiple windows by applications that contain application data for their respective applications, said windows being displayed in a 3D space (Fig. 5 and column 1, lines 16-20 of Miller '542).



Holecek describes generating windows that represent application programs, the windows containing application data for their respective programs. Holecek describes displaying said windows using an illustrative stack (Fig. 2B, column 9, lines 18-19, and column 9, line 67-column 10, line 24 of Holecek).

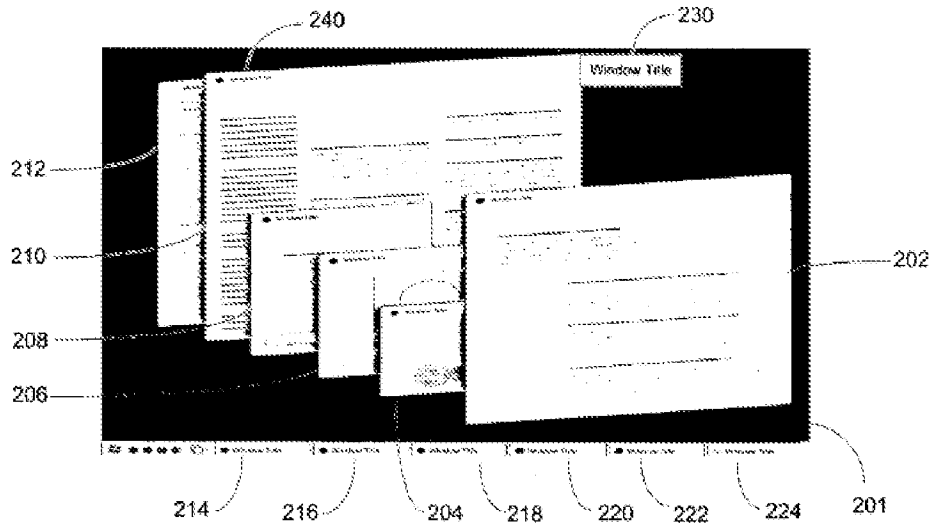
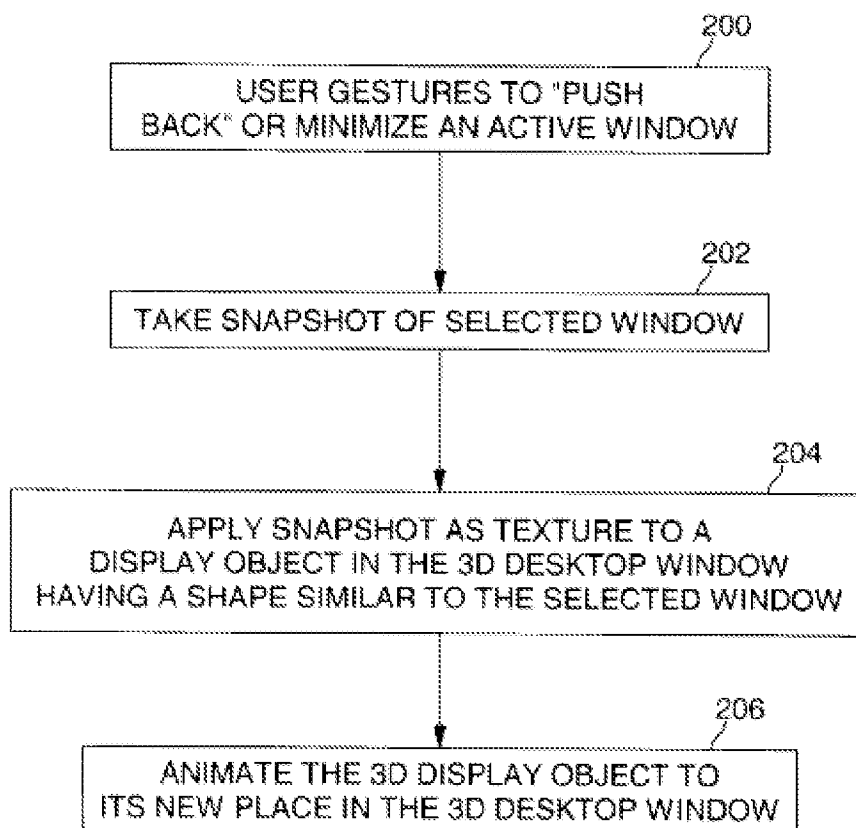


FIG. 2B

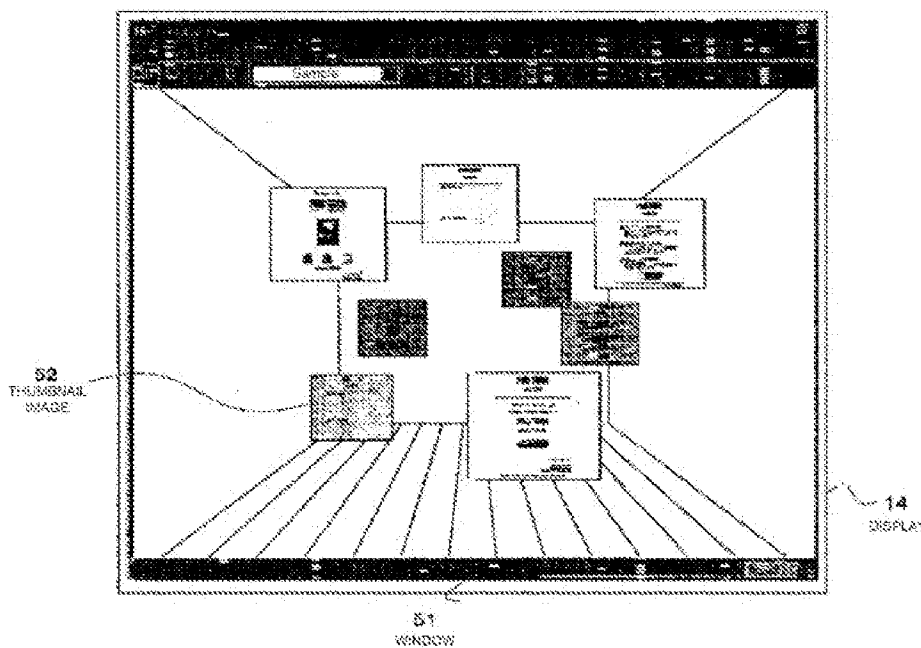
XP describes generating windows that represent application programs, the windows containing application data for their respective programs (pages 272 and 639 of XP).
replacing all objects corresponding to said plurality of applications that are visible in said 2D space with said plurality of images, said plurality of images being displayed in said 3D immersive space and 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, wherein a first one in said order is displayed in a foreground of said 3D immersive space, a second one in said order is displayed in a background of said 3D immersive space behind at least said first one in said order, and a third one in said order is displayed in said background of said 3D immersive space behind at least said second one in said order;

Miller '542 describes a process of transforming the pixels of 2D windows onto similarly shaped 3D display objects based on a "Push Back" gesture by the user at which point the objects are displayed in a 3D space (Figs. 5 and 7, column 3, lines 36-39, column 4, lines 6-8 and 17-21, column 6, line 66-column 7, line 19, and column 7, line 60-column 8, line 16 of Miller '542).



Holecek describes the ordering of the windows in a 3D space may be based on the order in which the windows were last in focus from most recent to least recent (column 10, lines 31-42 of Holecek).

Koga describes implementing 3D virtual space which relies on X, Y, and Z coordinates for display positioning of objects within said virtual space (Fig. 5 and paragraphs [0013] and [0019] of Koga).



The Miller '542, Holecek, XP, Miller '358, and Koga references were not previously discussed by the examiner nor applied to claims 1-20 in the prior examination of the patent as discussed above. Additionally, claims 1-20 were not subject to any Final Written Decision in view of Miller '542, Holecek, XP, Miller '358, or Koga in the IPR proceedings discussed above.

It is agreed that Miller '542 in view of Holecek, XP, Miller '358, and Koga raises a substantial new question of patentability with respect to at least independent claims 1, 10, and 19 of the '868 Patent. There is a substantial likelihood that an examiner would consider these new, non-cumulative technological teachings important in deciding whether or not these claims are patentable.

Accordingly, Miller '542 in view of Holecek, XP, Miller '358, and Koga raises a substantial new question of patentability with respect to at least claims 1-11 and 14-20 of the '868 Patent, a question which has not been decided in a previous examination of the '868 Patent nor was there a final holding of invalidity by the Federal Courts regarding the '868 Patent.

Miller '542 in view of Holecek, XP, Miller '358, Koga, and Dalal

13) The Dalal reference has been cited in combination with Miller '542, Holecek, XP, Miller '358, and Koga in the Request as part of the asserted SNQ. As stated above, the combination of Miller '542, Holecek, XP, Miller '358, and Koga was not previously discussed by the examiner nor applied to claims 1-20 in the prior examination of the '868 patent. The Dalal reference was not previously discussed by the examiner nor applied to claims 1-20 in the prior examination. The Dalal reference, in combination with the Miller '542, Holecek, XP, Miller '358, and Koga references raises an SNQ at least based on the discussion found of above regarding the combination of Miller '542, Holecek, XP, Miller '358, and Koga. The Request shows that the combination of Miller '542, Holecek, XP, Miller '358, and Koga provide teachings that are relevant to the limitations noted above which may have been material in determining the patentability of the '868 Patent claims at the time of allowance.

It is agreed that the consideration of Dalal in combination with Miller '542, Holecek, XP, Miller '358, and Koga raises an SNQ with respect to at least independent claims 1, 10, and 19 of the '868 Patent based on the teachings of Miller '542, Holecek, XP, Miller '358, and Koga cited above. 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 combination of the Dalal reference with Miller '542, Holecek, XP, Miller '358, and Koga raises a substantial new question of patentability with respect to at least independent claims 1, 10, and 19 of the '868 Patent, a question which has not been decided in a previous examination. In addition, there has been no final holding of invalidity by the Federal Courts regarding the '868 Patent.

Miller '542 in view of Holecek, Mastering Windows, and Anderson

14) The Anderson reference has been cited in combination with Miller '542, Holecek, and XP in the Request as part of the asserted SNQ. As stated above, the combination of Miller '542, Holecek, and XP was not previously discussed by the examiner nor applied to claims 1-20 in the prior examination of the '868 patent. The Anderson reference was not previously discussed by the examiner nor applied to claims 1-20 in the prior examination. The Anderson reference, in combination with the Miller '542, Holecek, and XP references raises an SNQ at least based on the discussion found of above regarding the combination of Miller '542, Holecek, and XP. The Request shows that the combination of Miller '542, Holecek, and XP provide teachings that are relevant to the limitations noted above which may have been material in determining the patentability of the '868 Patent claims at the time of allowance.

It is agreed that the consideration of Anderson in combination with Miller '542, Holecek, and XP raises an SNQ with respect to at least independent claims 1, 10, and 19 of the '868 Patent based on the teachings of Miller '542, Holecek, and XP cited above. 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 combination of the Anderson reference with Miller '542, Holecek, and XP raises a substantial new question of patentability with respect to at least independent claims 1, 10, and 19 of the '868 Patent, a question which has not been decided in a previous examination. In addition, there has been no final holding of invalidity by the Federal Courts regarding the '868 Patent.

Miller '542 in view of Holecek, XP, Miller '358, Koga, and Anderson

15) The Anderson reference has been cited in combination with Miller '542, Holecek, XP, Miller '358, and Koga in the Request as part of the asserted SNQ. As stated above, the combination of Miller '542, Holecek, XP, Miller '358, and Koga was not previously discussed by the examiner nor applied to claims 1-20 in the prior examination of the '868 patent. The Anderson reference was not previously discussed by the examiner nor applied to claims 1-20 in the prior examination. The Anderson reference,

in combination with the Miller ‘542, Holecek, XP, Miller ‘358, and Koga references raises an SNQ at least based on the discussion found of above regarding the combination of Miller ‘542, Holecek, XP, Miller ‘358, and Koga. The Request shows that the combination of Miller ‘542, Holecek, XP, Miller ‘358, and Koga provide teachings that are relevant to the limitations noted above which may have been material in determining the patentability of the ‘868 Patent claims at the time of allowance.

It is agreed that the consideration of Anderson in combination with Miller ‘542, Holecek, XP, Miller ‘358, and Koga raises an SNQ with respect to at least independent claims 1, 10, and 19 of the ‘868 Patent based on the teachings of Miller ‘542, Holecek, XP, Miller ‘358, and Koga cited above. 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 combination of the Anderson reference with Miller ‘542, Holecek, XP, Miller ‘358, and Koga raises a substantial new question of patentability with respect to at least independent claims 1, 10, and 19 of the ‘868 Patent, a question which has not been decided in a previous examination. In addition, there has been no final holding of invalidity by the Federal Courts regarding the ‘868 Patent.

35 USC 325(d)

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.

A review of the Office post grant history for the ‘868 patent, indicates that the patent has been the subject of 3 prior Office post grant challenges

IPR2020-01419

On October 4, 2020, Petitioner Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. filed a petition for *inter partes* review of claims 1-5, 7-14 and 16-20 the ‘868 patent (IPR2020-01419) which asserted the following grounds as raising a reasonable likelihood in prevailing (RLP):

RLP #	Claims Challenged	35 USC §	References
1	1-5, 7-11, 14, and 16-20	103(a)	Holecek, XP
2	12-13	103(a)	Holecek, XP, Dalal

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.

IPR2023-00344

On December 13, 2022, Petitioner Apple Inc., filed a petition for *inter partes* review of claims 1-20 the ‘868 patent (IPR2023-00344) which asserted the following grounds as raising a reasonable likelihood in prevailing (RLP):

RLP #	Claims Challenged	35 USC §	References
1	1-5, 9-14 and 18-20	103(a)	Anthony, Hanggie
2	6-8 and 15-17	103(a)	Anthony, Hanggie, Matthews
3	7	103(a)	Anthony, Hanggie, Matthews, Robinson
4	1-5, 9-14 and 18-20	103(a)	Hanggie, Anthony
5	6-8 and 15-17	103(a)	Hanggie, Anthony, Matthews
6	7	103(a)	Hanggie, Anthony, Matthews, Robinson

On July 17, 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.

IPR2023-00578

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 1-20 of the ‘868 patent (IPR2023-00578) which

copied and asserted the identical grounds as presented in IPR2023-00344 and filed a motion for joinder with IPR2023-00344.

On August 7, 2023, the PTAB granted institution of the petition and also granted petitioner's motion for joinder with IPR2023-00344.

Prior to institution and joinder, Petitioner LG Electronics U.S.A., Inc. and LG Electronics USA, Inc. settled with patent owner, and thus, Google LLC and Apple Inc., are now the remaining petitioners in 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 '868 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.

90/019,352

As stated above, the current reexamination request (90/019,352) filed by an anonymous third-party requester asserted the following grounds as raising a substantial new question of patentability (SNQ) as to claims 1-20 of the '868 patent.

SNQ #	Claims Challenged	35 USC §	References
1	1-5, 7-11, 14 and 16-20	103(a)	Miller '542, Holecek, Mastering Windows ¹
2	12 and 13	103(a)	Miller '542, Holecek, Mastering Windows, Dalal
3	1-5, 7-11, 14 and 16-20	103(a)	Miller '542, Holecek, Mastering Windows, Mille '358, Koga
4	12-13	103(a)	Miller '542, Holecek, Mastering Windows, Dalal, Miller '358, Koga
5	6-8 and 15-17	103(a)	Miller '542, Holecek, Mastering Windows, Miller '358, Anderson
6	6-8 and 15-17	103(a)	Miller '542, Holecek, Mastering Windows, Miller '358, Koga, Anderson

As an initial matter, there are no grounds asserted as raising and SNQ in the current request that are identical to any grounds previously presented to the Office and any of the 3 prior IPR petitions discussed above. While the Holecek, Mastering Windows (a.k.a. XP) and Dalal prior art references were previously presented in IPR202-00419, each of the six grounds presented in the 90/019,352 Request now

¹ While the 90/019,352 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 in IPR2020-01419, and is thus the same reference.

includes the Miller ‘542 prior art reference as a primary reference. The Miller ‘542 reference contains a different disclosure and presents different teachings than Holecek, Mastering Windows, Hellyar or any of the prior art presented in the 3 prior petitions. Thus, the art and arguments presented in the 90/019,352 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 Dalal, such that that 90/019,352 Request was based on substantially the same prior art and or substantially the same arguments as IPR2020-01419, 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 IPR2020-01419, and
- 2.) Since the PTAB terminated the IPR2020-01419 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 ‘868 patent by third party requester.

Accordingly, *ex parte* reexamination is Ordered for the ‘868 patent, in view of the determination above that SNQ has been raised in the instant Request for Reexamination.

Scope of Reexamination

- 16) Claim 1-20 will be reexamined as requested.

Conclusion

17) 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).

18) 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. 9,696,868 throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

19) **All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

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 Joshua Campbell at telephone number (571) 272-4133.

/JOSHUA D CAMPBELL/
Primary Examiner, Art Unit 3992

Conferees:

/ADAM L BASEHOAR/
Primary Examiner, Art Unit 3992

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