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Paper 31
Date: November 8, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

DDC TECHNOLOGY, LLC,
Patent Owner.

IPR2023-00711
Patent 11,093,001 B1

Before KALYAN K. DESHPANDE, *Acting Deputy Chief Administrative Patent Judge*, SHEILA F. McSHANE, and JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

McSHANE, *Administrative Patent Judge*.

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

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Patent 11,093,001 B1

I. INTRODUCTION

Google LLC. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–30 (the “challenged claims”) of U.S. Patent No. 11,093,001 B1 (Ex. 1001, “the ’001 patent”), along with the Declaration of Kurtis P. Keller (Ex. 1002). DDC Technology, LLC (“Patent Owner”) filed a Preliminary Response (Paper 13, “Prelim. Resp.”). With leave, Petitioner also filed Petitioner’s Reply To Patent Owner’s Preliminary Response (Paper 15, “Prelim. Reply”), and Patent Owner also filed a Sur-reply In Support of Its Preliminary Response (Paper 20, “Prelim. Sur-reply”).

The Board does not institute *inter partes* review unless the information in the petition and the preliminary response “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” *See* 35 U.S.C. § 314; 37 C.F.R. § 42.4(a).

For the reasons stated below, we determine that Petitioner has established a reasonable likelihood that it would prevail with respect to at least one claim. We therefore institute *inter partes* review as to all of the challenged claims of the ’001 patent and all of the asserted grounds of unpatentability in the Petition.

II. BACKGROUND

A. Related Matters

The parties indicate that the ’001 patent has been asserted in several district court lawsuits including:

- *DDC Technology LLC. v. Landsberg Orora*, No. 3:23-cv-01160 (N.D. Cal.);

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- *DDC Technology, LLC v. Emerge Technologies, Inc.*, No. 3:22-cv-01263 (N.D. Tex.); and
- *DDC Technology, LLC v. Unofficial Cardboard, Inc.*, No. 1:21-cv-05596 (N.D. Ill.) (“the UC Litigation”).

See Pet. 4; Paper 3 (Patent Owner Mandatory Notices), 3–4.

Patents related to the ’001 patent were previously the subject of three other Board proceedings, namely, IPR2018-00494, PGR2018-00019, and PGR2018-00020. See Pet. 3, Paper 3, 3. MerchSource, LLC was the petitioner in these proceedings, and each was terminated. See *id.*

Petitioner additionally challenges patents related to the ’001 patent in four co-pending proceedings: IPR2023-00707, IPR2023-00708, IPR2023-00709, and IPR2023-00710. The Board previously issued decisions on institution in IPR2023-00707, IPR2023-00708, and IPR2023-00710. Concurrent with this Decision, the Board institutes IPR2023-00709.

B. The ’001 Patent

The ’001 patent is titled “Virtual Reality Viewer and Input Mechanism” and issued on August 17, 2021 from an application filed on March 26, 2021. Ex. 1001, codes (22), (45), (54). The application for the ’001 patent is a continuation of several applications. *Id.* at code (63). The ’001 patent also claims priority to Provisional Application No. 62/161,857, filed on May 14, 2015, and Provisional Application No. 62/025,376, filed on July 16, 2014. *Id.* at code (60).

According to the Specification, many virtual reality (VR) viewers at the time of the invention were configured to use a smartphone as the display device instead of having a dedicated display. Ex. 1001, 1:51–53. A challenge identified with such a viewer is that “the touch sensitive display is

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concealed within the viewer housing, thereby making it difficult for a user to interact with the touch sensitive display of the device.” *Id.* at 2:6–9. The ’001 patent therefore is directed to “a virtual reality viewer including an input mechanism that can be used with mobile electronic device having a touchscreen contained within the viewer.” *Id.* at 2:36–39.

Figure 1 of the ’001 patent, reproduced below, shows an exemplary viewer “having a conventional construction without an input mechanism.” Ex. 1001, 3:45–48.

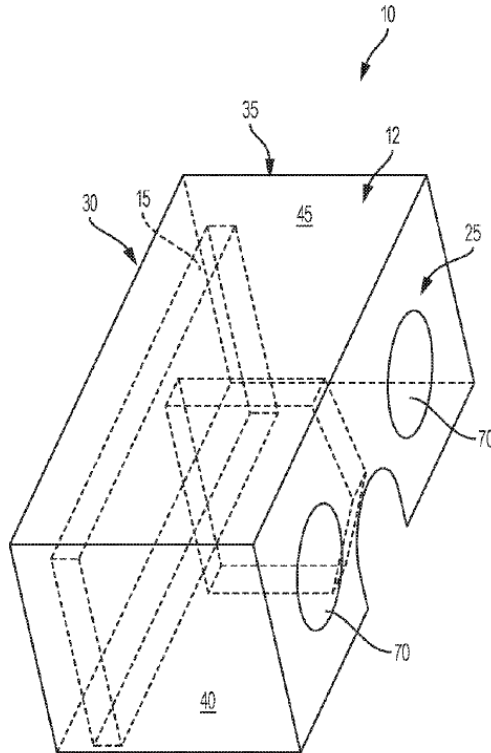


FIG. 1

As shown above, viewer 10 includes housing 12 into which electronic device 15 (e.g., a smartphone) can be placed such that device 15’s display is viewable when the user is looking through lenses 70 into housing 12. Ex. 1001, 3:52–64.

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Figure 6A, reproduced below, depicts a cross-sectional view of a VR viewer according to an embodiment of the invention. Ex. 1001, 3:4–6.

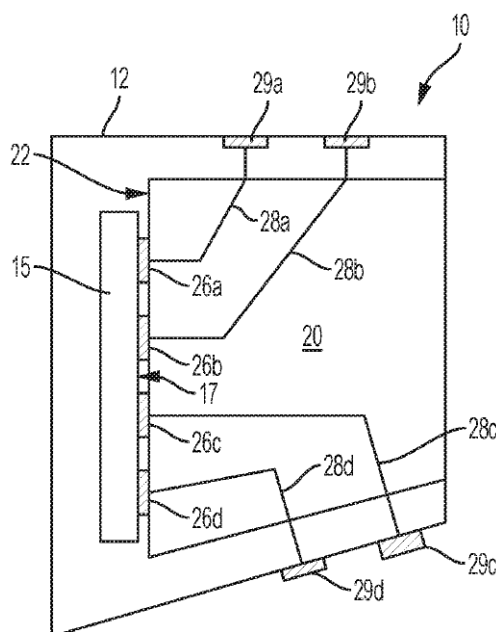


FIG. 6A

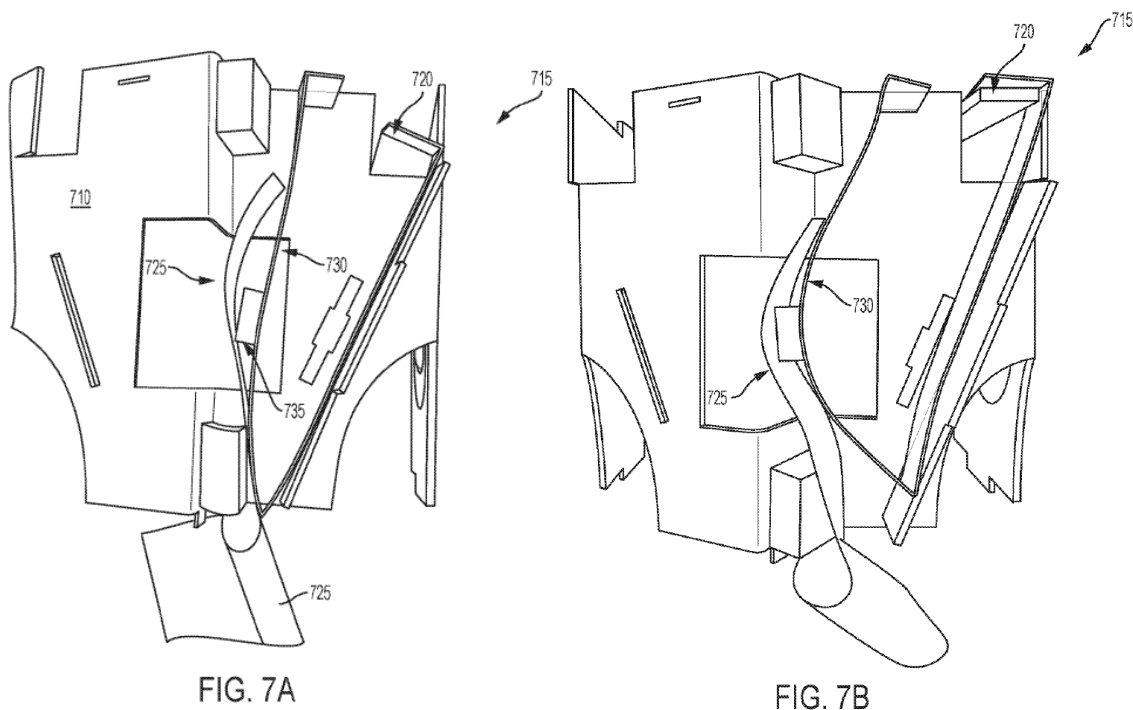
As shown in Figure 6A, above, viewer 10 includes housing 12 into which electronic device 15 has been placed such that touch sensitive display 17 is proximate to distal surface 22 of view divider 20 in housing 12. Ex. 1001, 5:24–33. User inputs 29a–29d are exposed on the outer surfaces of housing 12; touchscreen inputs 26a–26d are disposed on distal surface 22 of view divider 20; and input leads 28a–28d are each located between one user input 29 and a corresponding touchscreen input 26. *Id.* at 5:47–64. Inputs 29a–d may be constructed from a conductive material (*id.* at 5:65–6:3) so that “a user touch of a conductive user input (e.g., 29a), via the conductive lead (e.g., 28a) and touchscreen input (e.g., 26a), will alter the electrical properties of the portion of the display 17 that is in contact with the

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touchscreen input” (*id.* at 6:3–7). “[T]he device 15 having a capacitive touch sensitive display 17 can detect the particular location of a change in the electrical property that is caused by the user touch of the user input (e.g., 29a).” *Id.* at 6:8–12.

Figures 7A and 7B, reproduced below, depict a cross-sectional view of a VR viewer of another embodiment of the invention. Ex. 1001, 3:8–12, 6:61–7:9.



As shown above, Figures 7A and 7B each illustrate view divider 710 with one side of the view divider folded back so as to expose a portion of user input mechanism 715, which is located in the interior of the viewer. Ex. 1001, 7:35–39, 9:56–60. When the proximal end of a lever (not shown) is activated by a user, distal end 720 moves, thereby deforming coupling 730 and causing input mechanism 715 to move from unactuated state (shown in Figure 7A) to an actuated state (shown in Figure 7B), in which electrical

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shield 725 contacts the touchscreen. *Id.* at 7:40–53, 8:13–17, 8:23–38. A capacitive touchscreen can detect electrical shield 725 when input mechanism 715 is in the extended position. *Id.* at 7:46–53.

C. Illustrative Claim

Claims 1–30 of the ‘001 patent are challenged. Claims 1, 21, and 30 are independent claims. Claim 1 is illustrative of the claimed subject matter and is reproduced below, with bracketed designations added for reference purposes.

1[a] An apparatus comprising:

1[b] a housing having a portion configured to receive a mobile electronic device having a touchscreen display, the housing further including multiple lenses;

1[c] an input device accessible from an exterior of the housing;
and

1[d] a contact element located within an interior of the housing, the contact element responsive to the input device and the contact element moveable within the interior of the housing between at least a first position and a second position, wherein in the second position a surface of the contact element is configured to generate a detectable touch event at the touchscreen display of the mobile electronic device.

Ex. 1001, 12:58–13:4.

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D. Asserted Grounds of Unpatentability

Claims Challenged	35 U.S.C. § ¹	Reference(s)
1–30	103	Kondo, Chu

Pet. 8.

III. ANALYSIS

A. Level of Ordinary Skill in the Art

Petitioner asserts that a person of ordinary skill in the art at the time of the alleged invention would have at minimum:

[a]n undergraduate degree (or equivalent) in mechanical engineering or a related field, with knowledge of mechanical actuation systems, basic optical design with lenses, head-mounted displays, a basic understanding of touchscreen technology, and at least two years of professional experience in mechanical and basic optical design or engineering.

Pet. 24.

Patent Owner does not dispute the qualifications for a person of ordinary skill in the art as proposed by Petitioner. *See generally* Prelim. Resp. Patent Owner does, however, criticize Petitioner’s reliance on Mr. Keller’s opinions because “Mr. Keller evinces no particular expertise regarding touchscreens.” Prelim. Resp. 28. Patent Owner asserts that Mr. Keller’s description of his qualifications does not mention touchscreens; his primary field of study is optics; and Petitioner modified Mr. Keller’s standard *curriculum vitae* to place qualifications related to the technology

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. § 103, effective March 16, 2013. Because the application and provisional applications for the ’001 patent were filed after this date, the AIA version of § 103 applies. *See* Ex. 1001, codes (22), (60).

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here higher as well as to omit or place lower qualifications that are unrelated. *Id.* (citing Ex. 1002 ¶¶ 1, 8–14, App. A). Patent Owner argues that, to the extent Petitioner relies on Mr. Keller’s statements contradicting the actual state of the art at the time of the invention of the ’001 patent, they should be disregarded. *Id.*

For the purposes of this Decision, we adopt the assessment of the qualifications of one of ordinary skill in the art offered by Petitioner as it is consistent with the ’001 patent and the prior art before us. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001). Additionally, at this stage, we do not agree with Patent Owner’s assertion that Mr. Keller is not qualified to serve as a person of ordinary skill in the art in this proceeding. *See* Prelim. Resp. 45–46. Mr. Keller testifies that he has a B.S. in Mechanical Engineering, an M.S. in Integrated Manufacturing Systems Engineering, and over two decades of experience including direct involvement in “the mechanical, electrical, optical and integration aspects” of hardware and software, including the design of head-mounted displays and Virtual and Augmented Reality hardware/systems. Ex. 1002 ¶¶ 8, 10–11. Accordingly, at this juncture, we are preliminarily persuaded that Mr. Keller is qualified to provide expert testimony in this proceeding.

B. Claim Construction

In this *inter partes* review, claims are construed using the same claim construction standard that would be used to construe the claims in a civil action under 35 U.S.C. § 282(b). 37 C.F.R. § 42.100(b) (2022). Under the principles set forth by our reviewing court, the “words of a claim ‘are generally given their ordinary and customary meaning,’” as would be

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understood by a person of ordinary skill in the art in question at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)). “In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17).

Petitioner asserts that a “virtual reality viewer” should be interpreted as “[a] viewer of an artificial environment,’ where ‘viewer’ includes both handheld devices and headsets.” Pet. 25–26. Petitioner contends that the ordinary and customary meaning of terms should be used for the remainder of the terms.

Patent Owner takes no position regarding the construction of any claim terms or phrases at this phase of the proceedings. *See generally* Prelim. Resp.

We determine that we need not expressly construe any claim terms at this juncture. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

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C. Principles of Law

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) when in evidence, objective indicia of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

D. Obviousness of Claims 1–30 over Kondo and Chu

Petitioner contends that claims 1–30 would have been obvious over the combination of Kondo and Chu. Pet. 30–88. To support its contentions, Petitioner provides explanations as to how the combination of the prior art teaches each claim limitation and provides rationale to combine the references. *Id.* Petitioner also relies upon the Keller Declaration (Ex. 1002) to support its positions. Patent Owner contends that Petitioner fails to establish a reasonable likelihood of prevailing because the asserted motivation to combine is flawed. Prelim. Resp. 21–30. Patent Owner also argues that secondary considerations favor a conclusion of non-obviousness. *Id.* at 30–38.

We begin our discussion with brief summaries of Kondo and Chu, and then address the evidence and arguments presented.

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1. Kondo (Ex. 1003)

Kondo is titled “Remote Touch Circuit and Attachment” and seeks “[t]o provide an attachment that achieves remote control input to a touch panel mounted on an electronic device.” Ex. 1003, codes (54), (57). Kondo discloses “a stereoscope product attachment . . . for enjoying three-dimensional stereoscopic images provided with a remote touch circuit for enabling remote operation input to a touch panel with fingers supporting the attachment by equipping a smartphone having a touch panel.” *Id.* ¶ 21. Kondo discloses one embodiment including left and right eyepieces 7 on a rear end of the attachment and smartphone 1500 mounted inside a holding part 4 of the attachment and facing the eyepieces. *Id.* ¶¶ 22, 27. A user interacts with the smartphone’s touchscreen by pressing button 77, which is conductively connected to electric wire 72 and conductive pads 76. *Id.* ¶¶ 41, 47–49. The conductive pads are in physical contact with virtual button positions W31–W34 on the touchscreen. *Id.*

2. Chu (Ex. 1004)

Chu is titled “Waterproof Housing for Digital Devices Having Capacitive Touch Screen and its Actuator Mechanism.” Ex. 1004, code (54). Chu discloses waterproof housing 10 for holding a smartphone and having actuator mechanism 12 including actuator shaft 14, press button 16, and probe head 18. *Id.* ¶¶ 38, 40, 41. The actuator mechanism is movable by a user’s finger from a rest position, in which the probe head does not touch the smartphone’s capacitive touch screen 20, to an actuation position, wherein the probe head physically contacts the touch screen. *Id.* ¶¶ 40, 41, 53–56, Figs. 3, 4.

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3. Discussion

a. Rationale to Combine Kondo and Chu and Proposed Combinations

Petitioner asserts that a person of ordinary skill in the art would have been motivated to combine Kondo and Chu: (1) to allow Kondo to work with both capacitive and resistive touchscreens; (2) to allow the use of Chu's swipe input; and (3) to allow the advantageous use of Chu's waterproof design in certain applications. Pet. 36–38. More specifically, as to the first rationale, Petitioner contends that because Kondo's electrical input mechanism can only work with capacitive screens and Chu's mechanical input mechanism can work with both capacitive and resistive screens, a VR designer would have been motivated to replace Kondo's input mechanism with Chu's input mechanism in order to “increase the usability and consumer appeal for their device by making it work with both capacitive and resistive screens.” *Id.* at 36 (citing Ex. 1002 ¶ 55). For the second rationale, Petitioner asserts that a person of ordinary skill in the art would have been motivated to use Chu's input mechanism in Kondo because the Chu input mechanism transmits different levels of pressure and allows for a swipe input. *Id.* at 36–37 (citing Ex. 1002 ¶¶ 57–58). For the third rationale, Petitioner argues that a designer would also have been motivated to include Chu's waterproof design in Kondo because it would be less susceptible to damage from water and other environmental factors and would allow the device to be cleaned without cleaning fluid reaching the device's inner parts for applications in sanitary environments. *Id.* at 38 (citing Ex. 1002 ¶¶ 59–61).

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Patent Owner argues that an ordinarily skilled artisan would not have combined Kondo and Chu. Prelim. Resp. 22–30. Patent Owner argues that resistive touchscreens comprised little market share in 2014, the time of invention, and a skilled artisan would not have been motivated to accommodate this type of touchscreen in a VR viewer. *Id.* at 23–28 (citing Ex. 2033 ¶¶ 18–19; Ex. 2034; Ex. 2036, 74–75; Ex. 2021, 2, 7–10, 9–10). Patent Owner also asserts that “Chu and Kondo . . . are non-analogous art and/or teach away from the challenged claims” because Chu describes a waterproof case rather than a VR viewer. *Id.* at 29 (citing Ex. 1004 ¶ 2).²

At this juncture, we determine that Petitioner has made a sufficient showing that a person of ordinary skill in the art would have been motivated to combine Kondo and Chu. We have considered Patent Owner’s arguments, but we determine the issues raised are best resolved at trial with the benefit of a full record.

Patent Owner’s arguments address the first basis of Petitioner’s rationale for the combination, but do not specifically dispute the second and third bases, except to the extent that Patent Owner argues that the prior art is non-analogous, which is an argument we do not find persuasive for the reasons discussed below. At this juncture, we find that the second and third rationale provided for the combination are sufficient.

² Patent Owner also argues that Petitioner did not make the proposed combination. Prelim. Resp. 1, 30–31. We address this argument below in connection with Patent Owner’s arguments regarding objective indicia of nonobviousness.

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Moreover, for Petitioner’s first rationale, that is, that there is motivation to modify Chu to operate with both capacitive and resistive touch screens, the record includes evidence that appears to support each party’s position. For instance, Petitioner asserts that, as of 2012, the most common type of touchscreens were resistive and capacitive (Pet. 11), and refers to Chu’s statement that “[t]he most common types [of touchscreens] being used by handheld devices, such as smart phones, tablet computers and digital cameras are resistive and capacitive touch screens” (Ex. 1004 ¶ 3). On the other hand, Patent Owner’s position is, for instance, supported by evidence indicating that in 2013 and 2014, the market share of mobile phones with resistive touchscreens was significantly smaller than those with capacitive touchscreens and the and trending downward. *See* Prelim. Resp. 26–27 (citing Ex. 2034).

Patent Owner also asserts that resistive touchscreens would not be usable in a virtual reality viewer. Prelim. Resp. 23 (citing Ex. 2023 ¶¶ 18–19; Ex. 2036, 74–75). Mr. Buckley, the inventor and a fact witness, provides a declaration (Ex. 2023), which identifies the alleged largest and highest resolution resistive touchscreen devices ever released, and concludes they “would not have had the necessary hardware components . . . necessary for a mobile phone to be used in a [virtual reality] headset,” relying on a Google Android specification as “set[ting] forth specific hardware requirements for a smartphone to be [virtual reality] ready.” Ex. 2023 ¶¶ 18–19. We note, however, that the Google Android specification reflects the state of the art in 2017, rather than in 2014, the date of the invention. *See* Ex. 2036, 1. The Google Android specification also only appears to

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apply to requirements for “compatib[ility] with Android 7.0” and best practices for “high performance virtual reality.” Ex. 2048, 6, 75–76. In view of these issues, this evidence does not appear to provide sufficient support for Patent Owner’s contention that resistive touchscreens were not used in connection with virtual reality viewers. On this issue, as well as other issues related to any motivation to operate with both capacitive and resistive touch screens, we would welcome additional argument and evidence at trial.

Patent Owner additionally argues that Chu and Kondo are non-analogous art. Prelim. Resp. 29. Petitioner contends that Kondo is directed to the same problem as the ’001 patent, that is, “[t]o provide an attachment that achieves remote control input to a touch panel mounted on an electronic device.” Pet. 27. Similarly, Petitioner asserts that Chu addresses a similar problem (*id.* at 36). A reference is considered analogous prior art: (1) if the reference is from the same field of endeavor as the claimed subjected matter, regardless of the problem addressed; or (2) if “the reference still is reasonably pertinent to the particular problem with which the inventor is involved,” even though the reference is not within the field of the inventor’s endeavor. *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). At this juncture we are not persuaded by Patent Owner’s arguments on the issue of analogous art because both Kondo and Chu are directed to the problem addressed by the ’001 patent, which is accessing a mobile device touchscreen from the exterior of an enclosed housing.

Patent Owner additionally argues that Kondo requires that the user provides the impedance imparting component, which is “contrary to the

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challenged claims of the '001 [p]atent.” Prelim. Resp. 29. Patent Owner asserts that Kondo’s suggestion that some other capacitive reservoir could replace a human is a teaching away from the claims. *Id.* At this juncture, we do not find this argument persuasive because it is unrelated to any limitation in the claim. Moreover, Kondo discloses an embodiment where its button “connects to a capacitive element instead of the human body.” *See* Ex. 1003 ¶ 52.

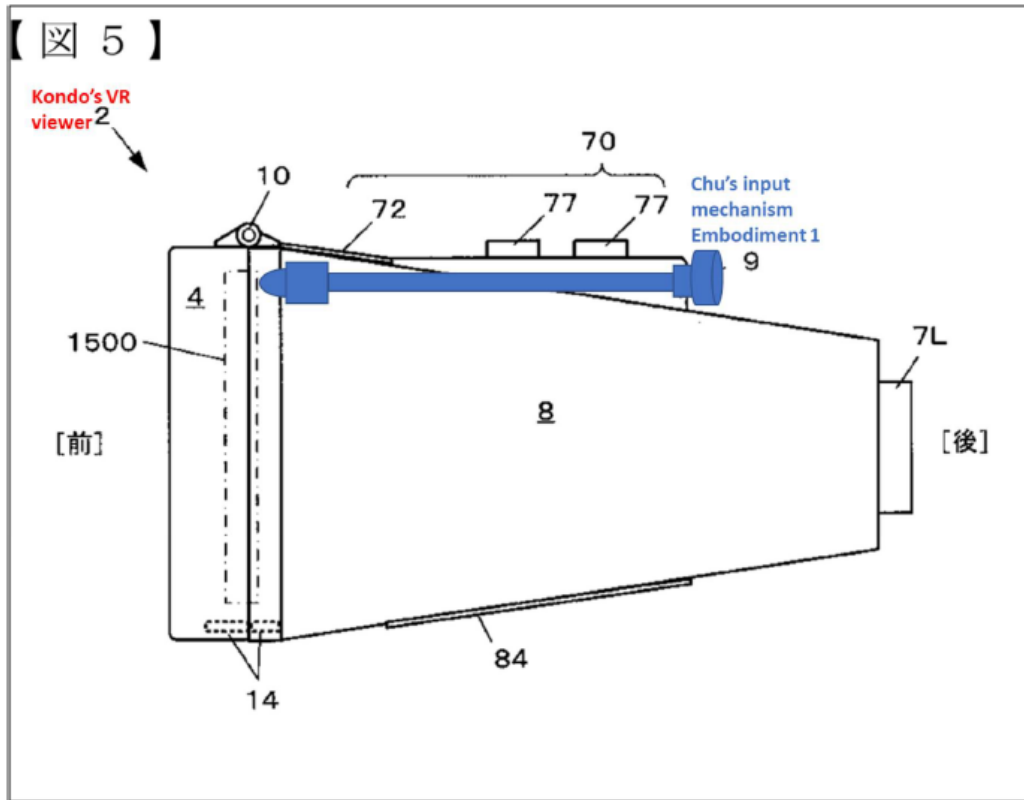
For other of Patent Owner’s arguments, we preliminarily do not find them persuasive. For instance, Patent Owner argues Petitioner is proposing replacing a capacitive touchscreen with a resistive touchscreen (Prelim. Resp. 25), but this represents a misunderstanding of Petitioner’s assertions, which are that the proposed modifications would allow Kondo to accommodate phones having different types of touchscreens (*see* Pet. 36). Patent Owner also contends that Petitioner uses the present tense in its description of the state of the art rather than referring using the past tense in describing the state of the art in 2014. Prelim Resp. 25–26 (citing Pet. 40). The Petition, however, refers to the time frame of the '001 patent invention (*see* Pet. 36), where a person of skill in the art would be motivated to combine Kondo and Chu (*id.* at 36–42). In context, Petitioner’s use of present tenses in sentences (*id.* at 40) appears to be inadvertent.

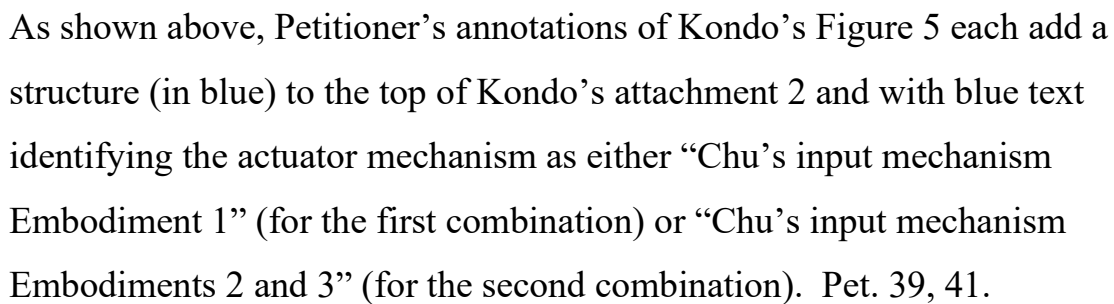
Petitioner proposes two variations of combinations of Kondo and Chu, each of which replace Kondo’s electrical input mechanism with Chu’s mechanical input mechanism. Pet. 38–42. Petitioner illustrates each proposed combination with annotations to Kondo’s Figure 5 (*id.* at 39, 41), reproduced below.

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b. Objective Indicia of Nonobviousness

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comes from “(a) Google’s own admission of failure to develop the invented technologies— including its failure to combine Kondo and Chu at the time of [the] invention; and (b) Google’s recognition at the time of [the] invention that the inventions of the ’001 [p]atent were ‘genius,’ ‘ingenious,’ and ‘really neat.’” *Id.* at 30 (emphasis omitted). Patent Owner argues that Petitioner identified “that there was a need for a VR viewer with an improved input mechanism” and Petitioner developed a VR viewer with a magnetic input. *Id.* at 31 (citing Ex. 2033 ¶¶ 23–25). Patent Owner asserts that Petitioner “highlighted DODOcase at [a] conference as the first company to sell a VR viewer based on the GCV1 Viewer design (only four or five hours after [Ppetitioner] posted its GCV1 Viewer designs on its website for manufacturers to use).” *Id.* (citing Ex. 2033 ¶ 27; Ex. 2004 ¶ 25). Patent Owner contends that “[Ppetitioner] acknowledged that there was a need for [a] better input mechanism” and the ’001 patent solves a “long-felt but unresolved need” in the art, based on the statements of Mr. Andrew Nartker of Petitioner’s Google Cardboard team. *Id.* at 32 (citing Ex. 2024, 3–4). Patent Owner further contends that the ’001 patent received industry praise. *Id.* at 33; Exs. 2033, 2034.

“In order to accord substantial weight to secondary considerations in an obviousness analysis, the evidence of secondary considerations must have a nexus to the claims, i.e., there must be a legally and factually sufficient connection between the evidence and the patented invention.” *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1373 (Fed. Cir. 2019) (internal quotation marks omitted). “The patentee bears the burden of showing that a nexus exists.” *Id.* A patentee is entitled to a rebuttable presumption of nexus

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“when the patentee shows that the asserted objective evidence is tied to a specific product and that product ‘embodies the claimed features, and is coextensive with them.’” *Id.*

On this record, we find that Patent Owner has not sufficiently established nexus between objective indicia of nonobviousness and the challenged claims of the ’001 patent. Because Patent Owner does not provide an analysis demonstrating that its products (or prototypes) are coextensive (or nearly coextensive) with the challenged claims, a presumption of nexus is inappropriate. *See Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 33 (PTAB Jan. 24, 2020)(precedential). However, “[a] finding that a presumption of nexus is inappropriate does not end the inquiry into secondary considerations.” *Fox Factory*, 944 F.3d at 1375. “To the contrary, the patent owner is still afforded an opportunity to prove nexus by showing that the evidence of secondary considerations is the ‘direct result of the unique characteristics of the claimed invention.’” *Id.* at 1373–1374 (citation omitted). On the preliminary record, we are not persuaded that Patent Owner shows this. For example, although Patent Owner asserts that Petitioner highlighted DODOcase and Petitioner’s Google Cardboard team praised Patent Owner’s conductive touch button, Patent Owner did not provide analysis and evidence to support that praise was directed to a specific claimed feature of the ’001 patent. The present record does not include any specific information or detail on the conductive button³ that was praised or demonstrate nexus between the conductive

³ The July 25, 2014 email from Mr. Buckley indicates that video clips that were sent with the email show the operation of the conductive button, but

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button and features of the challenged claims. Similarly, although Patent Owner argues that there was a long-felt unresolved need in the art, Patent Owner does not set forth sufficient analysis identifying that the claimed features of the '001 patent solved this need. Further, Patent Owner alleges the commercial success of its viewer, but does not demonstrate the commercial success is a direct result of the unique characteristics of the claimed invention.

Additionally, at this stage, we are not persuaded by some of Patent Owner's evidence of non-obviousness. Although Patent Owner's capacitive/conductive touch button was described by a few individuals as "genius," "ingenious," and "really neat" (Ex. 2024, 1), we question whether these isolated statements by themselves are indicative of industry praise indicative of non-obviousness. Similarly, we are not persuaded that there was a long-felt unresolved need in the art based on Mr. Nartker's statements that Petitioner "experimented briefly with this but didn't fully refine" without more explanation. *See id.* at 3. Patent Owner will have the opportunity during the trial to further develop its arguments that the challenged claims are non-obvious based on objective indicia, including establishing a nexus between the evidence and the challenged claims.

Patent Owner has not submitted those clips. Ex. 2024, 2. Patent Owner also asserts that the video clips depict a working prototype that was based on embodiments disclosed in a first provisional application (Prelim. Resp. 32–33), but the provisional application is not in the record.

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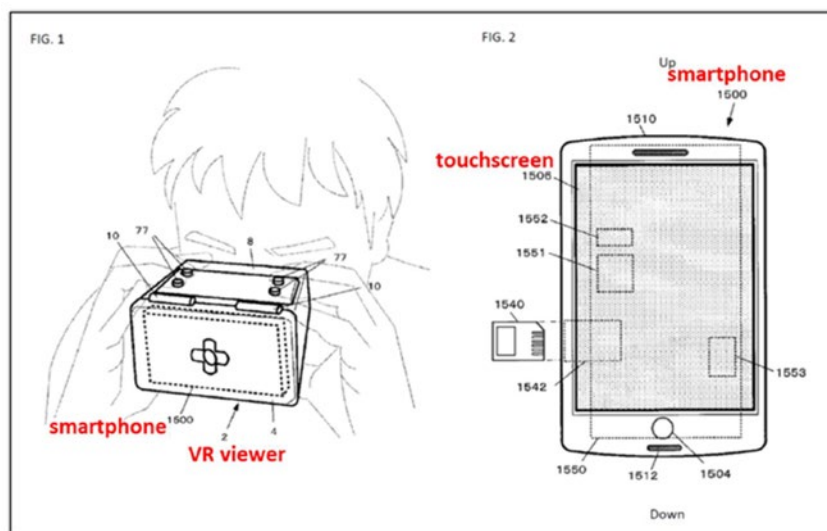
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c. Claim 1

i. Preamble 1[a]

Petitioner asserts that the preamble is taught by Kondo, which discloses “an apparatus, a virtual reality viewer.” Pet. 43–45 (citing e.g., Ex. 1003 ¶¶ 21 (“a stereoscopic product attachment (hereinafter simply referred to as an “attachment”) for enjoying three-dimensional stereoscopic images. . .”), 22, 27, Fig. 3). Petitioner asserts that Kondo teaches an apparatus as a virtual reality viewer, as depicted in Petitioner’s annotated Kondo Figures 1 and 2, reproduced below. *Id.* at 44.



Petitioner’s annotated Kondo Figures 1 and 2, above, depict a perspective view and front external view, respectively, of a viewer. Pet. 44; Ex. 1003 ¶ 20.

Petitioner also asserts that Chu discloses “an apparatus, a device that holds a mobile phone.” Pet. 45 (citing Ex. 1004, Fig. 1; Ex. 1004 ¶¶ 11, 38).

Patent Owner presents no arguments specific to the preamble.

On this preliminary record, we agree that Kondo teaches an apparatus, a virtual reality viewer. *See* Pet. 43 (citing Ex. 1003, Figs. 1, 2). We also

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agree that Chu teaches an apparatus in the form of a device that holds a mobile phone. *Id.* at 45–46 (citing Ex. 1004, Fig 1, ¶¶ 11, 38; Ex. 1002, §VIII(A)(1)).

ii. Limitation 1[b]

Petitioner primarily relies on Kondo for the teaching of limitation 1[b]. *See* Pet. 46–57. Petitioner asserts that Kondo discloses “a housing . . . configured to receive a smartphone 1500, and a user viewing the smart phone through two lenses on a side known as the ‘rear end.’” *Id.* at 46–47 (citing Ex. 1003, Fig. 1). In support, Petitioner asserts that Kondo discloses a housing, “the VR viewer’s housing.” *Id.* Further, Petitioner asserts that Kondo teaches that its housing has a portion configured to receive a mobile electronic device (smartphone 1500). *Id.* In further support, Petitioner asserts that Kondo teaches the use of a smartphone having a touchscreen display (touch panel 1506). *Id.* at 55–56 (citing Ex. 1003, Fig. 8). Petitioner also asserts that Kondo teaches a housing that includes multiple lenses (Kondo right eyepiece 7R and left eyepiece 7L). *Id.* at 46, 48 (citing Ex. 1003 Fig. 4(2)).

Patent Owner presents no arguments specific to this limitation. On this preliminary record, we determine that sufficient evidence has been presented that Kondo teaches limitation 1[b].

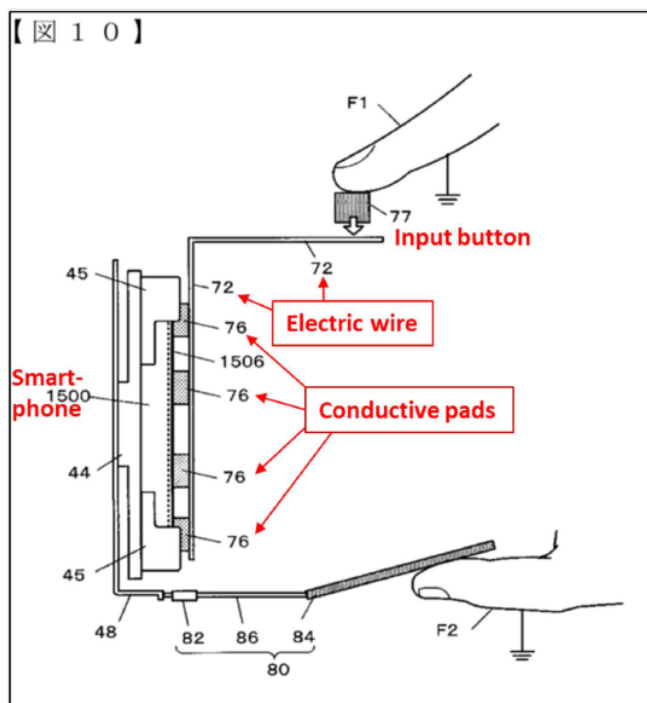
iii. Limitation 1[c]

Petitioner relies on both Kondo and Chu for the teaching of limitation 1[c]. Pet. 54–59. More specifically, Petitioner asserts that Kondo discloses “an input device on the exterior of the housing,” as shown in Petitioner’s

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annotated Figure 10, reproduced below. *Id.* at 58 (citing to Ex. 1003, Fig. 10).

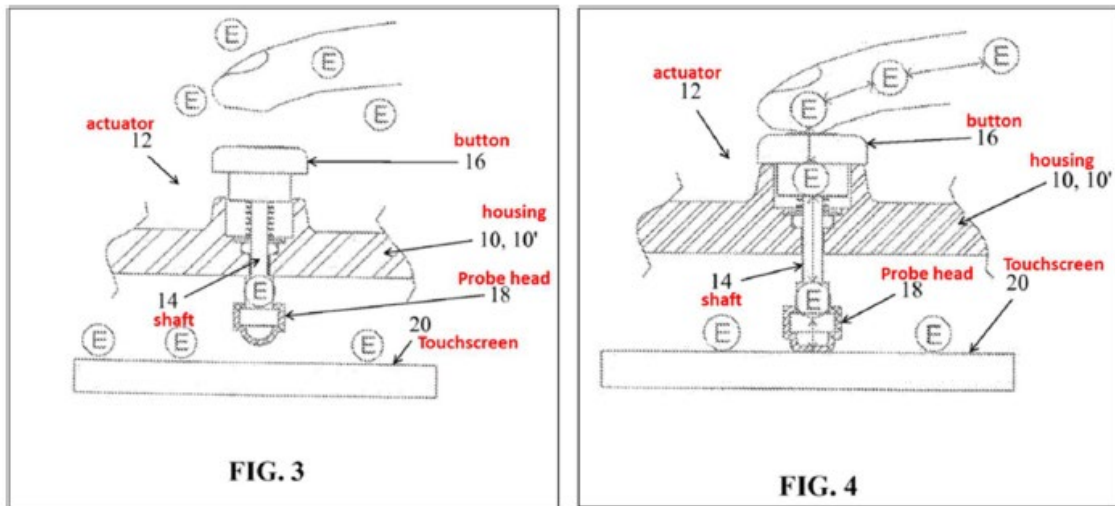


Petitioner’s annotated Figure 10 of Kondo, above, depicts a remote touch circuit of the device. Pet. 58; Ex. 1003 ¶ 20. Petitioner asserts that Kondo illustrates “that button 77 is accessible from the exterior of the housing and that this button moves in the interior from a first position to a second position through a cut out in the main body of the attachment, called the gripping part 9.” Pet. 59 (citing Ex. 1003, Fig. 7, ¶¶ 42, 43, 47, 48, 49, 52).

Petitioner also asserts that Chu also discloses “an input device on the exterior of the housing.” Pet. 60 (citing Ex. 1004, Fig. 2). In further support, Petitioner asserts that Chu teaches an input device that is both accessible from the exterior of the housing, and is depressible, as illustrated in annotated Figures 3 and 4 from Chu reproduced below. *Id.* at 61–62 (citing Ex. 1004, Figs. 3, 4, ¶¶ 53–57).

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Petitioner's annotated Figures 3 and 4 of Chu, above, depict button 16 of actuator 12 that is accessible from the exterior of the housing. *See* Pet. 61.

Patent Owner presents no arguments specific to this limitation. On this preliminary record, we determine that sufficient evidence has been presented that Kondo and Chu teach limitation 1[c].

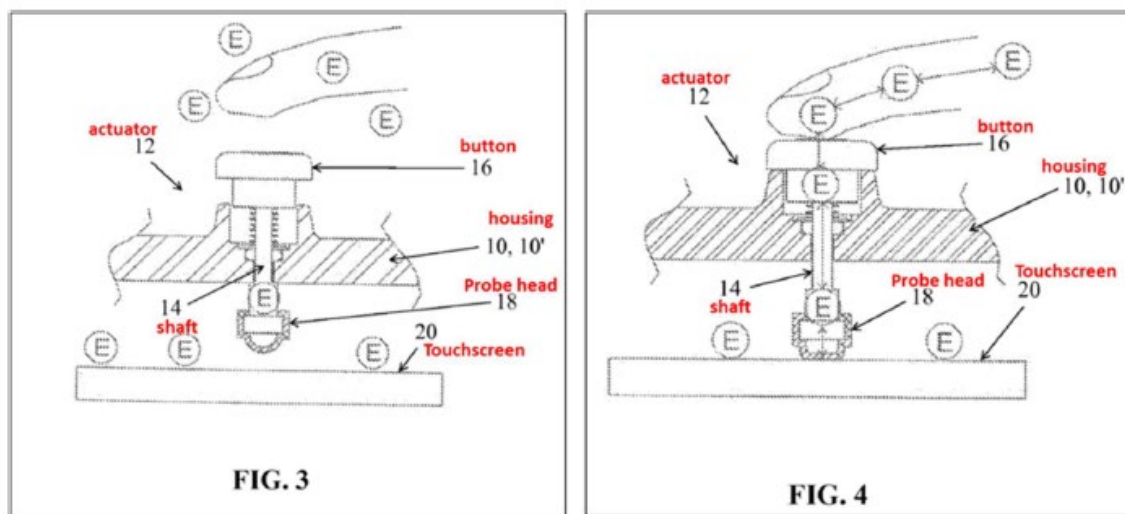
iv. Limitation 1[d]

Petitioner asserts that Chu teaches limitation 1[d]. *See* Pet. 62–67. In support, Petitioner asserts that Chu discloses an input device (button 16 of actuator 12) accessible from the exterior of the housing 10 with the claimed contact element (the contact element consisting of probe head 18 and probe pad 30). *Id.* at 62–63 (citing Ex. 1004, Figs. 3, 4). Petitioner asserts that the Chu contact element is “(1) is moveable in the interior of the housing between a first position (i.e., unactuated) to a second position (i.e., actuated); (2) is responsive to the input device (button 16) because it is coupled to the input device; and (3) generates a touch event on the touchscreen when in the second position (i.e., actuated).” *Id.* at 63 (citing Ex. 1004 ¶¶ 53–56).

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Petitioner illustrates these assertions in Petitioner's annotated Figures 3 and 4 from Chu, reproduced below. *Id.*



Petitioner's annotated Figures 3 and 4 of Chu, above, depict the contact of the probe pad's surface contacting touchscreen 20 of the smart phone when there is actuation to a second position. *See* Pet. 63–66 (citing Ex. 1004 ¶¶ 53–56).

Petitioner contends that Chu illustrates “the contact element (probe pad 30), which has a surface that is made of material capable of conducting electric charge to a touchscreen.” Pet. 65 (citing Ex. 1004, Fig. 5, ¶ 11). Petitioner asserts that Chu illustrates “the probe's pad's surface contacting the touchscreen 20 of the smartphone when the input device is actuated to the second position to create a detectable touch event,” as shown in annotated Chu Figure 4. *Id.* (citing Ex. 1004, Fig. 4, ¶ 41). Petitioner contends that Chu discloses that the “probe pad 30 is made of conductive material, such as metal or rubber with a conductive additive.” *Id.* at 66–67 (citing Ex. 1004 ¶ 11). Petitioner also contends that in Chu “[t]he press

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button, the shaft, the adaptor, and the probe head may be made of metal.”

Id. at 67 (citing Ex. 1004 ¶¶ 14, 19, 49).

Patent Owner presents no arguments specific to this limitation. On this preliminary record, we determine that sufficient evidence has been presented that Chu teaches limitation 1[d].

v. Conclusion for Claim 1

For the reasons provided above, Petitioner has shown sufficiently that the combination of Kondo and Chu teach or suggest each limitation of independent claim 1 and sufficient reasoning with rational underpinning has been provided for the motivation to combine the references. We have considered Patent Owner’s arguments, including those related to objective indicia of nonobviousness, but we do not find that these arguments and evidence undermine Petitioner’s showing at this preliminary stage of the proceedings.

Accordingly, we are persuaded that Petitioner has demonstrated a reasonable likelihood that it will prevail in establishing that claim 1 would have been obvious over Kondo and Chu.

d. Claims 2–30

Petitioner provides evidence and argument that claims 2–30 are obvious over the combination of Kondo and Chu. Pet. 67–88. For independent claim 21, Petitioner relies upon argument and evidence provided under claim 1, and provides additional explanation of how Chu discloses an actuator moving from a first position to a second position, triggering a touch event when the probe pad contacts the touchscreen. Pet. 80 (citing Ex. 1004 Fig. 4, Fig. 5); *see also* Ex. 1004 ¶¶ 44–62.

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Furthermore, Petitioner asserts that Chu discloses a contact element (probe pad 30) is electro-mechanically coupled via a linkage element to touch button 16. *Id.* Petitioner contends that the claimed linkage element is comprised of biasing member 40 and shaft 14, with biasing member 40 providing a mechanical coupling, and shaft 14 providing both a mechanical and electrical coupling. *Id.* at 80–81 (citing Ex. 1004 ¶¶ 44–62). For independent claim 30, Petitioner relies upon the argument and evidence provide for claims 1 and 21, and additionally asserts that Chu discloses a linkage element comprised of a conductive lead that runs through at least a portion of the interior of the housing. *Id.* at 87–88. Petitioner argues that Chu’s shaft 14 conducts electricity when button 16 is pushed, which causes a touch event, and this touch event is the claimed conductive lead. *Id.* at 88 (citing Ex. 1004, Fig. 4, ¶¶ 41–62).

Patent Owner presents no additional arguments specifically directed to these claims. *See generally* Prelim. Resp.

For claim 27, which requires that “the linkage element is made from a flexible material,” Petitioner asserts that “Chu’s biasing member 40, part of the linkage element, is a spring. So, it is flexible.” Pet. 84. As Petitioner asserts, the biasing member is part of the linkage element. Claim 28 is directed to the apparatus of claim 21, “further comprising a memory material coupled to the linkage element, the memory material configured to bias the linkage element toward the first position.” *See id.* Petitioner contends that biasing member 40 is made of memory material, but also contends that biasing member 40 is part of the linkage element, which appears inconsistent with the language of the limitation which requires that the memory material

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be coupled to the linkage element. *Id.* at 80, 84. We welcome additional argument and evidence on these claims at trial. We have reviewed the evidence and arguments and find Petitioner’s evidence and argument on the obviousness of the remainder of the other claims, that is, claims 2–26, 29, and 30, is sufficient at this juncture.

IV. REAL PARTY-IN-INTEREST AND PRIVACY

Petitioner identifies itself as the only real party-in-interest (“RPI”). Pet. 2. Patent Owner argues that the Petition should be dismissed because Petitioner intentionally omitted an alleged RPI—Orora Packaging Solutions (“OPS”)—to gain a tactical advantage in this proceeding. Prelim. Resp. 3–17. In addition, Patent Owner argues that the Petition is time barred because it was filed more than one year after another alleged RPIs or privy—Unofficial Cardboard, Inc. (“UC”)—was sued for infringement of the ’001 patent. *Id.* at 17–21.

We disagree with Patent Owner’s arguments. We are persuaded that Petitioner correctly identifies itself as the only real party in interest in this proceeding (*see* Pet. 2), and we are persuaded that UC is not a privy of Petitioner. As a result, we do not deny institution due to these alleged real parties-in-interest or privy relationships.

A. Applicable Law

A petitioner must “identif[y] all real parties in interest” in an *inter partes* review petition (37 C.F.R. § 312(a)(2)), and the petition must be filed no more than one year after “the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent” (35 U.S.C. § 315(b)).

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A petitioner’s identification of RPIs “should be accepted unless and until” a patent owner “produce[s] *some* evidence that tends to show that a particular third party should be named a real party in interest.” *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1243–44 (Fed. Cir. 2018). “A mere assertion that a third party is an unnamed real party in interest, without any support for that assertion, is insufficient to put the issue into dispute.” *Id.* Once the patent owner has sufficiently raised the issue, the “petitioner bears the burden of persuasion to demonstrate that its petitions are not time-barred under § 315(b) based on a complaint served on a real party in interest more than a year earlier.” *Id.* at 1242.

Determining whether a non-party is a “real party in interest” or “privity” is a highly fact-dependent inquiry that takes into consideration how courts have viewed these terms. Trial Practice Guide⁴ 13 (citing *Taylor v. Sturgell*, 553 U.S. 880, 895 (2008); Charles Alan Wright, Arthur R. Miller & Edward H. Cooper, Federal Practice & Procedure §§ 4449, 4451). This inquiry demands a flexible approach that takes into account both equitable and practical considerations, with an eye toward determining whether the non-party is a clear beneficiary that has a preexisting, established relationship with the petitioner. *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1351 (Fed. Cir. 2018) (“*AIT*”). Privity “is an equitable rule that takes into account the practical situation, and should extend to parties to transactions and other activities relating to the property in question.” *Id.* at 1349 (quotation and emphasis omitted). But the mere

⁴ Consolidated PTAB Trial Practice Guide (Nov. 2019), *available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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existence of some relationship between a petitioner and another entity is not sufficient—that relationship must be related to the lawsuit and be sufficiently close that it can be fairly said the petitioner had a full and fair opportunity to litigate the validity of the patent in that lawsuit. *See WesternGeco LLC v. ION Geophysical Corp.*, 889 F.3d 1308, 1319 (Fed. Cir. 2018). As the Federal Circuit explains,

the inquiry has a dual-focus on preventing the petitioner from now lodging a successive attack for which it already had a first bite, thus, protecting the defending party from an unwarranted second attack, while also ensuring that the petitioner is not unfairly limited in its ability to lodge its challenges if it has not had a full and fair opportunity to do so already.

Uniloc 2017 LLC v. Facebook Inc., 989 F.3d 1018, 1028 (Fed. Cir. 2021); *see also AIT*, 897 F.3d at 1349–50. Depending upon the circumstances, a number of factors may be relevant to the RPI or privity analysis, and relevant considerations include:

(1) an agreement to be bound; (2) pre-existing substantive legal relationships between the person to be bound and a party to the judgment (e.g., “preceding and succeeding owners of property”); (3) adequate representation by someone with the same interests who was a party (e.g., “class actions” and “suits brought by trustees, guardians, and other fiduciaries”); (4) assumption of control over the litigation in which the judgment was rendered; (5) where the nonparty to an earlier litigation acts as a proxy for the named party to relitigate the same issues; and (6) a special statutory scheme expressly foreclosing successive litigation by nonlitigants.

WesternGeco, 889 F.3d at 1319 (citing *Taylor*, 553 U.S. at 894–95).

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B. Orora Packaging Solutions (“OPS”)

According to Patent Owner, OPS is an RPI (Prelim. Resp. 3–15), and Petitioner intentionally failed to identify it in order to gain a tactical advantage in this proceeding (*id.* at 15–17). Specifically, Patent Owner contends that Petitioner omitted OPS “to prevent the Board from conducting a proper analysis of the *Fintiv* factors based on OPS’s much more advanced proceeding with a trial date in May of 2024.” *Id.* at 15 (referencing *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”)).

We determine that we need not address whether OPS is an unnamed RPI in this proceeding. As the Board explained in *SharkNinja*, it “better serves the interest of cost and efficiency” when the Board does not engage in the “extensive analysis” required to determine whether a party is an unnamed RPI if the result of that analysis has no material impact on the proceeding. *SharkNinja v. iRobot Corp.*, IPR2020-00734, Paper 11 at 19–20 (PTAB Oct. 6, 2020) (precedential). Here, it is undisputed that Petitioner could have named OPS as an RPI in its Petition without triggering a statutory bar or estoppel under 35 U.S.C. § 315.

Patent Owner argues that the RPI determination would materially impact the proceeding by impacting the *Fintiv* analysis (Prelim. Resp. 2, 15), but we disagree. *Fintiv* is not an issue in this proceeding.⁵ Patent Owner does not argue that we should exercise discretion to deny the Petition based

⁵ In a *Fintiv* analysis, the Board typically considers six factors to determine whether to discretionarily deny institution in view of the status of one or more parallel, co-pending litigations.

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on the *Fintiv* factors, and any such argument would have been unavailing in any event. A litigation in California with Petitioner named as a party was stayed on May 10, 2023 (Ex. 1016), and a Texas litigation with OPS named as a party was stayed on July 11, 2023 in view of a settlement between the parties before being terminated (*see* Paper 11 n.7).⁶ In short, as of the time of this Decision, the litigation in Texas is terminated, and the litigation in California is stayed. Even if RPIs were involved in both of these litigations, we would not exercise discretion to deny institution of the Petition based on *Fintiv*.

Patent Owner asserts that “the *Fintiv* analysis would have been highly relevant in this proceeding” (Prelim. Resp. 16), but it provides (and we discern) no support for such a contention. Patent Owner argues that we should not consider the *current* status of the litigations because they are “irrelevant to [Petitioner’s] conduct *at the time it filed its Petition*” (Prelim. Resp. 17; *see* Prelim. Sur-reply 3), but this argument is also unavailing. While a petitioner’s deceptive conduct when filing a petition could be relevant even if the issue is later made moot, that is not the case here. Under these circumstances, we disagree with Patent Owner’s assertion that Petitioner intentionally sought to deceive the Board regarding OPS.⁷

⁶ The litigation in Texas refers to *DDC Technology, LLC v. Orora Packaging Solutions*, No. 3:22-cv-01263 (N.D. Tex.), and the litigation in California refers to *DDC Technology LLC v. Google LLC*, 3:23-cv-01160 (N.D. Cal.).

⁷ Petitioner requests that the Board strike certain exhibits as inadmissible under Federal Rule of Evidence 408 and in violation of a mediation

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C. Unofficial Cardboard, Inc. (“UC”)

Patent Owner submits that the Petition is time barred under 35 U.S.C. § 315(b) because Patent Owner asserted the ’001 patent in the *UC* Litigation⁸ and UC is an RPI or privy of Petitioner. Prelim. Resp. 17–21. We disagree.

On this record, there is essentially no evidence that UC is an RPI or privy of Petitioner. There is no evidence that UC exercised any control over Petitioner’s decision to file the Petition (or over the arguments included therein), and there is no indication that UC had any authority to do so. The record does not suggest that UC provided any funding for this *inter partes* review. Nothing in the record suggests that Petitioner is acting as an agent or proxy of UC to challenge the ’001 patent, or that the Petition was filed at UC’s behest. Rather, the evidence indicates that Petitioner, through its own counsel, filed the Petition seeking to assert its own interests wholly independently of UC. Moreover, we discern no basis for inferring that Petitioner had an opportunity to litigate the validity of the ’001 patent in the *UC* Lawsuit. There is no evidence that Petitioner exercised any control over the defense of the *UC* Litigation (or had any authority to do so), and there is no evidence that Petitioner had any involvement in—or even knowledge of—the *UC* Litigation. On these points, Patent Owner does not argue otherwise.

agreement. *See* Prelim. Reply 5–6. We have not considered this evidence, so we deny, without prejudice, this request as moot.

⁸ *DDC Technology, LLC v. Unofficial Cardboard, Inc.*, No. 1:21-cv-05596 (N.D. Ill.) (filed Oct. 21, 2021; terminated Jan. 24, 2022).

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Instead, Patent Owner argues that UC is an RPI or privy because there was a business relationship between Petitioner and UC that related to a product accused in the *UC* Litigation. *See* Prelim. Resp. 17–21; Prelim. Sur-reply 4–5. Although Patent Owner never provides a legal analysis supporting its position (*see id.*), Patent Owner presumably relies on an alleged pre-existing, substantive legal relationship between Petitioner and UC. However, evidence simply shows that: (1) UC was a member of the Works With Google Cardboard (WWGC) program (*see* Ex. 2027, 8), and (2) UC sold WWGC-compliant VR viewers that were accused in the *UC* Lawsuit (*see* Ex. 2029 § 7.1; Ex. 2030, 2).⁹

This relationship between Petitioner and UC did not put them in privity. The WWGC program was created by Petitioner to identify VR viewers that were compatible with Petitioner’s VR ecosystem. *See* Ex. 2031, 2–4 (identifying requirements for viewers); Prelim. Reply 7. Petitioner’s WWGC “Manufacturer’s Guide” states that a VR viewer “typical[ly]” has an enclosure, lenses, and “exactly one input” (without specifying the type of input), and the document neither provides nor requires

⁹ Patent Owner also argues that Petitioner provided “manufacturing instructions and CAD design files” to UC, but there is no evidence in this record to support these assertions. Prelim. Resp. 19. Although Patent Owner cites to its complaints in the Texas litigation (*see* Ex. 2003 ¶¶ 41–65; Ex. 2004 ¶¶ 41–65), the fact that it made similar allegations in a different forum does not show that its allegations are true. *Cf. Icon Health & Fitness, Inc. v. Strava, Inc.*, 849 F.3d 1034, 1043 (Fed. Cir. 2017) (“Attorney argument is not evidence.”). But even if Petitioner provided a reference design to UC and other WWGC members, the mere disclosure of this information (with no obligation to use it or compensate Petitioner for it) does not create a privity relationship.

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a particular design. Ex. 2031, 1–4. A manufacturer could apply to be a WWGC member by completing a form and sending two samples of each of its viewers to Petitioner for evaluation (*see id.* at 7, 19), and it appears that no payment or licensing agreement was required to participate. There is no evidence that WWGC members were obligated to indemnify Petitioner for patent infringement allegations,¹⁰ and Petitioner affirmatively disclaimed any obligation to indemnify WWGC members for the members’ viewers (*see id.* at 7). This evidence shows that the relationship between Petitioner and UC falls far short of what is required to put them in privity vis-à-vis the ’001 patent. *See, e.g., Taylor*, 553 U.S. at 894 (identifying “preceding and succeeding owners of property . . . and assignee and assignor” as exemplary qualifying relationships); *Ventex Co. Ltd. v. Columbia Sportswear N. Am., Inc.*, IPR2017-00651, Paper 152 at 7–8, 12–13 (PTAB Jan. 24, 2019) (precedential) (finding non-party to be an RPI and in privity where the petitioner had an opportunity to control the non-party’s litigation, an obligation to indemnify the non-party, and an exclusive agreement with the non-party to manufacture the allegedly infringing products).

In addition, Patent Owner argues that Petitioner [REDACTED]
[REDACTED]
[REDACTED] and Patent Owner cites an email from Petitioner’s counsel in support. Prelim. Resp. 20–21 (citing Ex. 2035, 2). We disagree with Patent

¹⁰ DODOcase Inc. (Patent Owner’s predecessor-in-interest for this patent family) was also a WWGC member (*see* Ex. 2027, 8), so Patent Owner would presumably have evidence of any such obligations.

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Owner's characterization of this email.¹¹ It includes no express reference to UC (*see* Ex. 2035), and we cannot infer a reference to UC, as it was sent five years before the UC Litigation was filed (*see id.* at 1–2; Ex. 2028).

Moreover, in the email, [REDACTED]

[REDACTED]. Ex. 2035, 1–2. This does not indicate that all WWGC members are RPIs or privies of Petitioner; rather, it simply indicates that [REDACTED]

[REDACTED]. Patent Owner fails to sufficiently explain its apparent assertion that, as a result of this [REDACTED], all WWGC members are RPIs or privies of Petitioner. *See* Prelim. Resp. 20–21.

Accordingly, on this record, we determine that UC is not an RPI or privy of Petitioner.

V. CONCLUSION

For the foregoing reasons, we have determined that there is a reasonable likelihood that the Petitioner would prevail with respect to at least one of the claims challenged in the Petition. In addition, we determine that it is not appropriate to deny institution due to allegedly unnamed real

¹¹ Petitioner argues that the [REDACTED] in this email are inadmissible under Federal Rule of Evidence 408. *See* Prelim. Reply 8. At this time, we decline to address this objection because Petitioner prevails even considering the cited evidence.

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parties-in-interest or privies. We therefore institute trial as to all challenged claims on all grounds stated in the Petition.

VI. ORDER

Upon consideration of the record before us, it is:

ORDERED that *inter partes* review of claims 1–30 of the '001 patent is instituted on all grounds in the Petition;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; the trial will commence on the entry date of this decision; and

FURTHER ORDERED that the parties shall jointly email a proposed redacted version of this paper no later than 14 days from the entry of this Decision to Trials@uspto.gov.

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