

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.,
Petitioner,

v.

IMMERSION CORPORATION,
Patent Owner.

Case IPR2023-00943
Patent 8,896,524

**PATENT OWNER'S PRELIMINARY RESPONSE
UNDER 35 U.S.C. §§ 311-19 AND 37 C.F.R. § 41.100, ET SEQ.**

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EXHIBIT LIST

Exhibit No.	Exhibit Description
2001	<i>Immersion Corp. v. Meta Platforms, Inc.</i> , 1-23-CV-00623-ADA, Claims Construction Order, Dkt# 91.
2002	Declaration of Dr. Geoffrey Abowd, Ph.D.
2003	Tierling Reference
2004	<i>Immersion Corp. v. Meta Platforms, Inc.</i> , 6:22-CV-00541-ADA, Scheduling Order, Dkt# 28
2005	<i>Immersion Corp. v. Meta Platforms, Inc.</i> , 6:22-CV-00541-ADA, Defendant Meta Platform, Inc.'s Motion to Transfer Venue to the Northern District of California (Redacted Version), Dkt# 27
2006	<i>Immersion Corp. v. Meta Platforms, Inc.</i> , 1-23-CV-00623-ADA, Amended Scheduling Order, Dkt# 97
2007	Meta Platform, Inc.'s Final Invalidity Contentions

I. INTRODUCTION

Petitioner challenges claims 1-2, 6-8, 11-14 (the “Challenged Claims”) of U.S. Pat. No. 8,896,524 (the “524 Patent”) with two obviousness Grounds, both relying on base references US Patent Application Publication No. 2008/0024459 (“Poupyrev”) and 2009/0322498 (“Yun”). As explained below, because these base references do not teach using the “context metadata . . . compris[ing] at least one of data indicating a functionality of the user interface element, or data indicating a history of the user interface element” as required by all Challenged Claims, neither Ground demonstrates unpatentability of the 524 Patent. *See* EX1001, 11:47-51. Notably, while the 524 Patent contains five separate examples of “context metadata,” the Challenged Claims expressly only cover two of those examples. The Petition, however, conflates the examples and relies on identifying features in the prior art as “context metadata” that are not recited in the Challenged Claims.

The 524 Patent is directed to providing richer and more realistic haptic effects to confirm command inputs made by users based on “context metadata.” “[I]n contrast to known haptic systems, where confirmation haptic effects for user interface elements are generally one confirmation type per element, embodiments of the invention can provide for multiple possible confirmation haptic events for a single user interface element, based on context metadata.” EX1001, 11:7-12. The 524 Patent teaches providing multiple possible confirmation haptic events for a

single GUI object, such as virtual push button or switch, where each event is customized based on some aspect of the same GUI object. *Id.*, 2:20-24. The particular aspect of the GUI object is communicated to the system via “context metadata.” *Id.* “Such context metadata can include data indicating one or more physical properties of the user interface element . . . data indicating the functionality of the user interface element . . . data indicating a history of interaction with the user interface element” *Id.*, 1:65-2:17. These are the two types of context metadata specifically required by the Challenged Claims. *E.g.*, EX1001, 11:7-12.

In contrast, Poupyrev is directed to determining when a user has made a gesture that is consistent with a command input and proposes different techniques for distinguishing between a user's intended command input and a casual brush of a GUI element. EX1003, ¶ 0068. Poupyrev provides different tactile feedbacks (e.g. haptic stimulations) for different events, but only teaches a single feedback when the user intends a command input. *Id.*, ¶ 0081. For example, when the user does not intend a command input yet places a finger on the GUI without actuating anything, the system provides one tactile feedback; when the user intentionally actuates a GUI element by applying the requisite pressure to the GUI, the system provided different tactile feedback. *Id.*; ¶¶ 82, 86. Additionally, Poupyrev does not teach or suggest the use of context metadata related to “functionality of the user interface element”

or “a history of interaction with the user interface element” as required by the Challenged Claims. *See* EX1001, 11:7-12.

Yun is directed to adding haptics to space constrained mobile terminals. EX1004, ¶0007. “In a limited display device such as a mobile communication terminal, there is a restriction in allocating sufficient space for a UI device (such as a display device or a keypad) of a mobile terminal without compromising mobility of a mobile terminal.” *Id.*, ¶0005. Yun proposes dividing the surface of an input mechanism of a mobile device into separate regions, each region producing a different haptic effect when touched. *Id.*, ¶0008.

Because neither of these references teach the generation of rich and complex haptic responses based on “context metadata . . . including data compris[ing] at least one of data indicating a functionality of the user interface element, or data indicating a history of the user interface element” as required by all Challenged Claims, the Petition fails to demonstrate at least one claim is unpatentable. The Board should deny institution.

II. BACKGROUND

A. Immersion Corporation's Pioneering Haptics Technology

Immersion Corporation is a publicly traded company, and since its founding 30 years ago, has been a market leader in tactile feedback technology for a multitude of markets including wearable devices, mobile ads and video, mobile devices,

medical applications, automotive interfaces, gaming and virtual reality. Started in 1993 by Louis Rosenberg, a pioneer in sensing interfaces and feedback technology, Immersion developed and commercialized haptic innovations beginning with its force feedback technology, allowing devices to provide tactile sensations and resistance to user interactions, such as force feedback in devices like joysticks. Immersion was one of the first companies to release haptic joysticks, computer mice and steering wheels for video games. This technology has been widely used in gaming controllers, medical simulators, and other applications to enhance realism and user engagement.

Throughout the mid- to late- 1990s Immersion continued to develop its haptic technologies, eventually developing VR interfaces for specific medical procedures. Using Immersion's technology to provide realistic feedback, these systems are used in medical schools around the world to train physicians in surgical procedures in a realistic and safe virtual environment.

Immersion also partners with manufacturers and systems integrators of actuator hardware. Through these partnerships, Immersion provides designs and guidance for the development of actuators that are required to implement advanced haptic features.

Immersion, over its 30-year history, has developed and licensed haptic products and IP across diverse applications, including gaming systems, medical

devices, automobiles, touchscreens, and mobile devices. Recently a primary focus has been developing and implementing advanced haptic effects, including effects optimized for use in virtual and augmented reality (“AR/VR”) systems. Immersion also has a long history of developing advanced software. For example, Immersion’s TouchSense® 3000 software includes a driver package designed to operate an actuator, a haptic API that programmers can use to create, launch, and modulate haptic effects, a library containing more than 100 pre-defined effects, and user interface support. Video game industry leaders, including Nintendo, have recognized the value of Immersion’s technology and partnered with Immersion. Immersion’s industry-defining technology is used in over three billion devices worldwide.

Immersion’s technology is used in more than 3 billion devices, including tablets, smartphones, wearables, gaming controllers, and automotive interfaces. The Institute of Electrical and Electronics Engineers (“IEEE”) has recognized Immersion in its annual IEEE Spectrum Patent Power scorecards, which evaluate the technology world’s most valuable patent portfolios by quantitative benchmarks. Immersion’s established and growing leadership in haptic technology is reflected by its consistent ranking in the top 20 in its industry segment.

Immersion’s technological advances in area of haptic has generated over 3500 issued patents world-wide. Immersion’s patents have been proven novel through

multiple challenges over the years. Immersion's patents have been proven novel through multiple challenges over the years. Immersion patents have been challenged in 37 IPRs¹ of which only 2 cases have resulted in determinations of unpatentability.

B. The 524 Patent

The 524 Patent is directed to devices capable of providing richer and more realistic tactile or haptic feedback as confirmation of a user's desired input to a device. EX1001, 1:10-38. "[I]n contrast to known haptic systems, where confirmation haptic effects for user interface elements are generally on confirmation type per element, embodiments of the invention can provide for multiple possible confirmation haptic events for a single user interface element, based on context metadata." *Id.*, 11:7-12. "The haptic confirmation system can generate multiple possible confirmation haptic events for a single user interface element where each confirmation haptic event is individually customized based on context metadata." *Id.*, 2:20-24.

The 524 Patent describes five different types of context metadata, although not all are recited by the Challenged Claims: (1) physical properties of the user

¹ 10 of these IPRs were denied institution, 14 of them were terminated prior to an institution decision in light of settlements, while 13 of them were instituted with 11 of those terminated prior to a final written decision in light of settlements.

interface, such as the size and shape of the user interface (“a small button can feel different (e.g. lighter) to a user than a big button”) (EX1001, 4:27-48); (2) functionality of the user interface such as “the inputting of a character within a field displayed within a touchscreen can generate a confirmation haptic effect that is different from a confirmation haptic effect that is generated when a word is input within the field” (*Id.*, 4:48-5:2); (3) history of use of the user interface element, such as typing speed (*Id.*, 5:3-31); (4) sensor input data such as a pressure produced by a user touching a user interface element (*Id.*, 5:32-59); and other context metadata can be any kind of data that is associated with a user interface element (*Id.* at 5:60-64). Specifically, the Challenged Claims require “context metadata . . . compris[ing] at least one of data indicating a functionality of the user interface element, or data indicating a history of the user interface element” as required by all Challenged Claims. *See* EX1001, 11:47-51.

System software maps the context metadata to one or more haptic parameters such as “magnitude, frequency, duration, amplitude (i.e. strength), waveform, or any other kind of quantifiable haptic parameter.” EX1001, 6:2-25. Additional mapping can take place to customize the haptic effect to the user’s desires. “As part of the customized mapping, the one or more haptic parameters can be modified based on one or more multipliers defined by the user. More specifically, a value for the one or more haptic parameters can be modified based on the one or more multipliers

defined by the user. The one or more multipliers defined by the user can be based on the one or more sliders that are part of a slider user interface.” EX1001, 6:53-59.

C. Prosecution History

The 524 Patent was filed on August 24, 2012, along with an invention disclosure statement identifying ten prior art references. EX1009, 1, 42. On April 10, 2014, the Examiner issued a non-final office action rejecting all claims as anticipated by Tierling, U.S. Patent Publication No. 2005/0134561 and obvious in light of Tierling and Keyson, U.S. Patent 6,046,726. On July 8, 2014, Applicants responded to the non-final office action by amending the claims to expressly include “wherein the context metadata comprises at least one of: data indicating functionality of the user interface element, or data indicating a history of the user interface element.” *Id.*, 82, 84. The applicant explained:

[w]hile Tierling describes that the effect mapper 306 can modify haptic instructions based on received physical characteristics of the haptic device 124, Tierling fails to disclose or suggest that the effect mapper 306 can modify the haptic instruction based on received data that either indicates a functionality of a user interface element of the haptic device, or indicates a history of a user interface element of the haptic device 123. Thus, Tierling fails to disclose or suggest that the haptic device 124 receives context metadata associated with a user interaction of the user interface element including data indicating the

functionality of the user interface element or data including a history of the user interface element

Id., 89-90. On August 5, 2014, the Examiner issued a Notice of Allowance for all claims in the application. *Id.*, 95-99. The 524 Patent issued on November 24, 2014.

III. PERSON OF ORDINARY SKILL IN THE ART (POSA)

Petitioner proposes the following for the level of ordinary skill in the art:

A person of ordinary skill in the art would have possessed a bachelor's degree in electrical engineering or computer science (or an equivalent degree), and two years of practical or industry experience in the field of human computer interaction, including implementation of computer-based systems and software for providing haptic feedback effects to a user. A person could also have qualified as an ordinarily skilled artisan with more formal education and less practical or industry experience, or vice versa.

Pet., 4 (internal citations omitted). Patent Owner finds this defined level adequate for purposes of this *Inter Partes* Review proceeding.

IV. CLAIM CONSTRUCTION

Patent Owner does not believe any specific claim terms require construction, and all terms should have their plain and ordinary meaning. Patent Owner does not believe any argument in this Preliminary Response requires any particular interpretation of a claim term. In the District Court case, Petitioner sought a construction of “context metadata” as “any data associated with an interaction with

the user interface element.” EX2001, 3 [Dk. No. 91 at 3]. However, the District Court declined to adopt that construction and instead adopted “plain and ordinary meaning.” *Id.* Immersion reserves the right to propose terms for construction if trial is instituted.

V. THE ASSERTED REFERENCES

A. Poupyrev

As discussed above, Poupyrev describes a system for determining when a user has made a gesture that is consistent with a command input and proposes different techniques for distinguishing between a user's intended command input and a casual brush of a GUI element. EX1003, 7:14-25. Poupyrev identifies two goals, both of which the reference describes as prior art: (1) “providing tactile notification when a user touches a user interface element on a touchscreen without executing functionality of the user interface element”; and (2) “providing tactile feedback notification to a user when the functionality of the user interface is executed.” EX1003, 1:47-52. According to Poupyrev, systems must be able to distinguish between touches intended by the user to actuate or execute a GUI element, e.g. press a button on a touch screen, or other casual touches not intended to execute a GUI element. EX2002, ¶31. Poupyrev describes this determination as based on “a) the current state of GUI object and b) the pressure value applied to the GUI object For example, if the GUI object is a graphical button, the GUI controller 112 can

calculate if there was enough pressure applied on the graphical button on the screen to change the state of the button from 'free' to 'pressed' or 'non-actuated' to 'actuated'." EX1003, 7:14-25. Poupyrev teaches providing tactile feedback when the user has activated a GUI element indicating the desire to execute a system function. *Id.*, 8:43-49.

Poupyrev describes providing various pressure thresholds to distinguish between when a user is intending to actuate or active a GUI control, and when the touch is casual and not intended to actuate or active the control, such as dragging a finger across a touch screen. "The reason for providing this additional threshold or confirmation threshold is to avoid accidental activation of the GUI objects." EX1003, 12:38-40. Notably, Poupyrev only considers the user to intend to provide a command input when the user presses the GUI hard enough to reach this confirmation threshold. If the pressure does not reach this confirmation threshold, then the system does not consider the user's action to be a command input. *Id.*, 8:32-49.

Poupyrev explains these various pressure thresholds with reference to Fig. 11. Fig. 11 shows two pressure curves representing user interactions with the touch screen and GUI elements. Curve (a) represents a slow increase of pressure on the GUI object whereas Curve (b) is a faster increase. EX1003,12:29-53. Points 1 and 2 on Curve (a) do not result in a command input or activation, but rather a command

input is only recognized when the pressure reaches the confirmation pressure threshold at Point 3, at which point a tactile feedback is presented to the user to confirm the activation. *Id.* Other tactile feedbacks are associated with Points 1 and 2, but those points are not command inputs, and in fact if the user ceases pressing on the GUI object, no command input occurs for those two points. *Id.* Poupyrev recognized that when a user applies pressure quickly, having tactile feedback occurring at Points 1 and 2 would be “distracting or hamper the user interaction” and therefore the system only presents tactile feedback when the confirmation pressure threshold is exceeded, and a command input is signaled. *Id.*

B. Yun

As discussed above in the introduction, Yun is directed to deploying haptics within a device with space-constrained displays/touchscreens. EX1004, ¶¶ 0005, 0007. Yun provides a level or customization of the haptic effect by the user. *Id.*, ¶0007. Yun described dividing the screen into various regions, each region having its own haptic effect.

wherein the input mechanism has a surface that is divided into at least two separate regions, wherein the two separate regions provide a tactile sensation such that the first region provides a first tactile sensation and the section region provides a second tactile sensation, wherein a user in response to touching the first region and second region recognizes a difference in the first and the second tactile

sensations, wherein said difference in sensations allows a user to detect a change in the functionality of the mobile terminal or an output generated by the mobile terminal.

Id., ¶ 0008.

Yun also describes dividing UI objects into regions and having different haptic effects for each region of the UI object. *Id.*, ¶¶ 0009, 0011. The Petition refers to Fig. 36 (*id.*, ¶ 0110) that describes a number of GUI buttons representing menu items. Yun describes each menu item having its own unique haptic effect. *Id.*, ¶ 0110.

Referring to FIG 36, if a user touches or approaches and thus chooses one of the menu icons, the name of the chosen menu icon may be analyzed and a haptic effect corresponding to the name of the chosen menu icon may be generated. For example, if the user chooses a menu icon 'setting', haptic effect (such as vibration effects) respectively corresponding to alphabet letters 's', 'e', 't', 't', 'I', 'n', and 'g' may be sequentially output. Alternatively, the user may set a haptic effect for the word 'setting' in advance. In this case, the haptic effect corresponding to the word 'setting' may be generated."

Ex. 1004, ¶ 0109.

VI. POUPYREV IN COMBINATION WITH YUN DOES NOT TEACH, SUGGEST, DISCLOSE, OR RENDER OBVIOUS CLAIMS 1-2, 6-8, AND 11-14 OF THE 524 PATENT

Claims 1 and 11 require “context metadata comprises at least one of: data indicating a functionality of the user interface element, or data indicating a history of the user interface element.” All other claims depend from either claims 1 or 11 and because the Petition does not teach context metadata that either indicates a functionality or history of a user interface element as those are described in the 524 Patent, institution should be denied.

The 524 Patent describes five categories of “context metadata.” For example, in Fig. 2, shown below, the five categories of context metadata include “Physical Properties 211,” “Functionality 212,” “History 213,” “Sensor Input Data 214,” and “Other Context Metadata 215.”

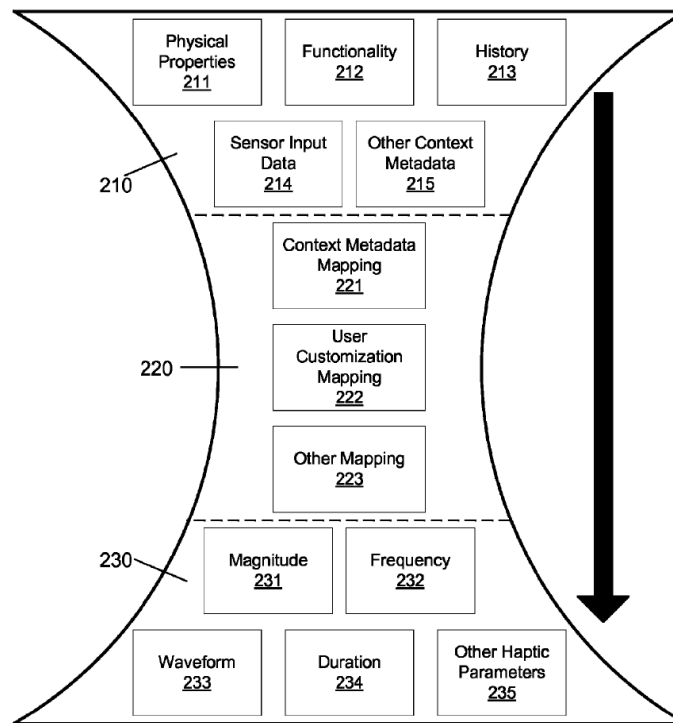


Fig. 2

The claims of the 524 Patent expressly cover “Functionality 212” and “History” metadata types. *See* EX1001, 11:48-51, 12:40-43; EX2002, ¶39. The 524 Patent describes functionality of a user interface element as either related to the type of user interaction with element, such as inputting a character as opposed to a word, or the function the element or object performs when it has been actuated by the user:

The functionality can be functionality associated with either the user interface element or the interaction with the user interface element. For example, the functionality of inputting a character or a word within the user interface element. As another example, the functionality can be the creation of a text or an email message that can be initiated by the user interface element upon interaction with

the user interface element. Thus, the functionality of the user interface element can be used to determine a confirmation haptic effect that is generated. For example, the inputting of a character within a field displayed within a touchscreen can generate a confirmation haptic effect that is different from a confirmation haptic effect that is generated when a word is input within the field. As another example, the pressing of a button displayed within a touchscreen in order to create a text message can cause a confirmation haptic effect to be generated. However, the same pressing of the button displayed within the touchscreen to create an email message can cause a different confirmation haptic effect to be generated.

EX1001, 4:49-5:2.

The 524 Patent describes the history of a user interface elements as relating to specific user interactions with the element in order to tailor the haptic response to avoid unwanted interactions with other haptic responses.

The history can be history associated with one or more previous interactions with the user interface element. For example, the history of a user interface element (such as a keyboard or a button displayed within a touchscreen) can be a typing speed (i.e., a speed at which a user either types on a keyboard or touches a button displayed within the touchscreen). As an example, a confirmation haptic effect that feels desirable at a slow typing speed may feel undesirable at a fast typing speed. One reason for this may be because an actuator that

generates the confirmation haptic effect may not be capable of generating cascading confirmation haptic effects at a certain speed because the duration of each confirmation haptic effect may be longer than the duration between each keystroke. Because of this, the confirmation haptic effects can blend into each other, and generate a “mushy” haptic experience. Another reason for this may be that a magnitude of the initial confirmation haptic effect may be so strong that it overpowers one or more weaker confirmation haptic effects that are subsequently generated. Thus, the typing speed can be used to automatically scale a magnitude, duration, or other parameter of a confirmation haptic effect to avoid having a plurality of confirmation haptic effects blend into each other or cause other undesirable results. The typing speed can be determined after a plurality of interactions with the user interface element. Thus, the modification of the confirmation haptic effect can occur as soon as soon as a change in typing speed is identified (i.e., after the plurality of interactions).”

EX1001, 5:3-31.

Importantly, the “context metadata” limitation including these two types of data was expressly added by amendment to overcome prior art, specifically the Tierling reference, during prosecution. EX1009, 82, 87. Like Poupyrev and Yun, Tierling disclosed an “effect mapper 306 [that] can modify haptic instructions based on received *physical characteristics* of the haptic device 124.” EX1009, 89-90 (emphasis added). However, “Tierling fails to disclose or suggest that the effect

mapper 306 can modify haptic instructions based on received data that indicates a functionality of a user interface element of the haptic device 124 or indicates a history of a user interface element of the haptic device 124.” *Id.* The Examiner allowed the application on the basis of this amendment. *Id.*, 99.

In contrast, the Petition cites examples against the Challenged Claims that the 524 Patent describes as “Physical Properties” or “Sensor Input Data” but not the claimed “Functionality” or “History” metadata types. EX2002, ¶39. The Petition relies on Poupyrev’s disclosure of position and amount of pressure: “The ‘**context metadata**’ in Poupyrev takes the form of data about the user’s interaction with the GUI object, which includes at least information about (1) the *position* on the screen where the interaction is occurring, and (2) the *amount* of pressure applied by the user.” Pet., 19. Similarly, for “data indicating a history of the user interface element” Petitioner cites “the prior touch positions and pressure values associated with the GUI object.” Pet., 23. Neither of these citations to Poupyrev disclose “context metadata” that includes “Functionality” or “History” as those are described in the 524 Patent. EX2002, ¶¶38-40. The applicants amended the claims to add this language to distinguish from Tierling, which specifically matches Poupyrev’s disclosure of physical attributes like position and pressure: “The sensor **126** of the interface device **120** is configured to sense input from a user of the interface device **120**. For example, the sensor **126** can be used to sense manipulation or

movement of a physical object, such as a manipulation of the interface device **120**. The sensor **126** can also be used to sense other forms of user input, such as pressure, speed, acceleration, torque, light, or other measurable quantities.” EX2003, ¶ 0043 (Tierling). Moreover, the specification clearly categorizes touch pressure as a sensor input, not “History” or “Functionality.” EX1001, 5:32-59; EX2002, ¶39. Position would also not be “History” or “Functionality,” but rather would be “Physical” or “Other.” *Id.*, 4:27-48, 5:60-64; EX2002, ¶39. Therefore, nothing in Poupyrev teaches the “Functionality” or “History” context metadata of the Challenged Claims. EX2002, ¶¶38-40.

Yun does not teach or disclose the “Functionality” or “History” categories of context metadata required by the Challenged Claims. Petitioner argues that to the extent Poupyrev does not disclose “data indicating a functionality of the user interface element,” Yun teaches this type of metadata through its disclosure of providing a haptic effect based on the textual name of the GUI element, such as the name “settings” on a settings button. Pet., 24, 26. “Yun therefore discloses that, when a user chooses a menu icon, the mobile terminal uses the textual name of the menu icon to determine the appropriate haptic effect.” Pet., 26.

Yun’s disclosure of using the title of the button to produce a haptic effect does not reflect the “functionality” of the button as described in the 524 specification. EX2002, ¶¶41-44. The 524 patent explains that “the functionality can be the creation

of a text or an email message that can be initiated by the user interface element upon interaction with the user interface element.” EX1001, 4:55-58. First, Yun’s description of having a sequence of haptic responses corresponding to the title of the “settings” button does not indicate the underlying “functionality” of the button, such as whether it is for email, or text. *Id.* “Settings” does not correspond to a functionality, but rather an arbitrary title or name, and instead of causing a particular function to occur likely presents the user with an additional set of buttons or menu items. *Id.* As such, Yun’s disclosure of using the title of a “settings” button does not teach data indicating functionality of a user interface element as described in the specification. EX2002, ¶43.

Secondly, the 524 Patent describes changing the haptic response associated with the same GUI object depending upon the context, using “context metadata.” “As another example, the pressing of a button displayed within a touchscreen in order to create a text message can cause a confirmation haptic effect to be generated. However, the same pressing of the button displayed within the touchscreen to create an email message can cause a different confirmation haptic effect to be generated.” EX1001, 4:49-5:2. In the first context, the button corresponds to text message, but in the second context the same button corresponds to email. In contrast, Yun discloses assigning different haptics to different buttons. EX2002, ¶¶ 41-44. That is not the same as having different buttons with different names use different haptic

responses. *Id.* Thus, the specification refers to functionality as what a single user interface element such as a single button is doing in different contexts, and the context metadata can indicate it is used for text in one instance, and email in another instance or context. *Id.* The Board should deny institution of Ground 1.

VII. POUPYREV IN COMBINATION WITH YUN, BRAUN OR ROSENBERG DOES NOT TEACH, SUGGEST, DISCLOSE, OR RENDER OBVIOUS CLAIMS 2-4 AND 12 OF THE 524 PATENT

Ground 2 combines Poupyrev with Yun, Braun, or Rosenberg to address dependent claims 2-4 and 12 that additionally require “modifying the one or more haptic parameters based on user input.” All of these claims depend from claims 1 or 11, and as described above, the combination of Poupyrev and Yun do not render those claims obvious. As such, dependent claims 2-4 and 12 are also not obvious for the same reasons as those articulated in Ground 1. Therefore, the Board should deny institution of Ground 2.

VIII. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION UNDER 35 U.S.C. §§ 314(A)

As explained above, Petitioner fails to set forth evidence establishing even a reasonable likelihood that it will prevail, much less that such evidence is “compelling” under the Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation, PTO Director’s Memorandum (June 21, 2022) (“Interim Guidance”). As Director Vidal recently

clarified, “the compelling merits standard is a higher standard than the standard for institution set by statute,” and is met only “if it is highly likely that the petitioner would prevail with respect to at least one challenged claim.” *Commscope Technologies LLC, v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23, 3-4 (PTAB Feb. 27, 2023). Moreover, a compelling merits inquiry is not a substitute for a full *Fintiv* analysis. *Id.*, 4. Here, the merits of the Petition are not compelling. As discussed above in §§ VI and VII, Grounds 1 and 2 suffer from several deficiencies fatal to the merits of Petitioner arguments, including, for example, both base reference’s failure to disclose or teach a “context metadata compris[ing] at least one of: data indicating a functionality of the user interface element, or data indicating a history of the user interface element.” Ground 2 is directed to additional limitations found in certain dependent claims and relies on success of Ground 1.

Patent Owner acknowledges that the recent Interim Guidance notes that a petition should not ordinarily be denied in accordance with the *Fintiv* factors where (as here) Petitioner has offered a *Sotera* stipulation “that if the IPR is instituted, the Petitioner will not pursue in the District Court Litigation any ground raised or that could have been reasonably raised in an IPR for the challenged patent.” Pet., 4. But this Petition otherwise merits denial under a holistic analysis of the *Fintiv* factors due to the advanced stage of the parallel District Court proceedings and the duplication of the invalidity grounds asserted therein. *See Apple Inc. v. Fintiv, Inc.*,

IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) at 2-3; *see also Cisco Sys., Inc. v. Oyster Optics, LLC*, IPR2021-00238, Paper 10 (Jun. 1, 2021) (Panel exercising discretion to deny institution after holistic analysis of *Fintiv* factors). Indeed, prior to the Interim Guidance, the Board did not find a *Sotera* stipulation proffered under similar circumstances to overcome trial dates scheduled significantly before the due date of the Final Written Decision. *Cisco Sys., Inc. v. Estech Sys., Inc.*, IPR2021-00329, Paper 13 (July 6, 2021) at 13 (*Sotera* stipulation insufficient to overcome a time gap of 11 months between the Eastern District of Texas trial date and the Final Written Decision, a 7 month gap between the Western District of Texas trial date and the Final Written Decision, and where claim construction and fact and expert discovery had already completed prior to the Institution Decision date). Additionally, in this case because Petitioner's *Sotera* declaration is conditional, and the district court case is so far along, the declaration will not result in significant savings of resources because expert discovery will be over by the time an institution decision is rendered, meaning Patent Owner will be required to fully rebut in the district court case the same art Petitioner raises here.

A. Whether the Court Granted a Stay or Evidence Exists That One May Be Granted if a Proceeding Is Instituted

The first *Fintiv* factor addresses the likelihood of a stay if this proceeding is

instituted. Here, the District Court in the Western District of Texas has not considered a motion to stay, and therefore, this factor is neutral at best. *Cisco Sys., Inc. v. Oyster Optics, LLC*, IPR2021-00238, Paper 10 at 11. It should, however, be noted that the Federal Circuit has denied multiple petitions for *mandamus* relief on the grounds that the District Court had not abused its discretion in denying motions to stay pending *inter partes* review or post-grant review. See *In re Sand Revolution LLC*, 823 F. App'x 983, 984 (Fed. Cir. 2020); *In re Vulcan Indus. Holdings, LLC*, 830 F. App'x 318 (Fed. Cir. 2020).

B. Proximity of the Court's Trial Date to the Board's Projected Deadline for a Final Written Decision

In the parallel Western District of Texas litigation, the Court has already ordered a trial date of February 20, 2024 (EX2002, 4; EX2006, 2), approximately 10 months before the expected Final Written Decision date in December 2024. This gap is significant given that by the time a Final Written Decision is likely to issue in this proceeding, the District Court trial will have concluded almost a year earlier, addressing both infringement and validity of the 524 Patent. Notably, the Board's institution decision will come only two months prior to the scheduled trial date.

Also, the Interim Guidance notes "the PTAB will consider the median time from filing to disposition of the civil trial for the district in which the parallel litigation resides." Interim Procedure for Discretionary Denials in AIA Post-Grant

Proceedings with Parallel District Court Litigation, PTO Director's Memorandum (June 21, 2022) at 3. The parallel litigation in the Western District of Texas was filed on May 26, 2022, and the median time to trial in that district is 28.2 months²; therefore, under the median time-to-trial statistics, the putative trial date is in October 2024, which is still two months before the Final Written Decision in this proceeding. This factor should weigh in favor of denial.

Further, Petitioner's tacit agreement for the parallel litigation to proceed in the Western District of Texas cannot be overlooked. EX2003, 1, fn1, 15. Although Petitioner unsuccessfully moved for transfer of venue to the Northern District of California, it also moved in the alternative for transfer to the Austin Division in the Western District of Texas. *Id.* Now that the case is in the Austin Division due in part to its own admission, Petitioner has knowingly committed to a District Court for which the trial date is considerably earlier than the Final Written Decision date. Thus, Petitioner should be held to its admissions and resulting time gap between the District Court trial date and the Final Written Decision date.

C. Investment in the Parallel Proceeding by the Court and the Parties

²https://www.uscourts.gov/sites/default/files/data_tables/fcms_na_distprofile0331.2023.pdf

The third *Fintiv* factor addresses the District Court's and parties' investments into the parallel proceeding. Here, the parties have already invested in a great deal of time and effort in the District Court such that Institution would be very inefficient. The parties have already served final invalidity and infringement contentions over five months ago (EX2002, 3) and completed claim construction two months ago (EX2004). Fact discovery in the parallel litigation will be complete on October 6, 2023—approximately two months before the Institution Decision in this proceeding. EX2006, 1.

In fact, Petitioner has already served thousands of pages of invalidity contentions including the same references that are asserted in this IPR, as well as similar references with cumulative subject matter. EX2005. And by December 1, 2023—before the expected date for the Institution Decision, the parties will have served expert invalidity and rebuttal reports and conducted expert depositions concerning prior art, including the references used herein. EX2006, 1. Therefore, given the impending deadlines in the parallel litigation and the progress that has already accrued and will continue to accrue in that litigation before the date of the Institution Decision, this factor also weighs in favor of denial.

D. Overlap Between the Issues Raised in the Petition and the

Parallel Proceeding

The fourth *Fintiv* factor, which addresses the overlap between the issues raised in the Petition and the parallel proceeding, should also weigh in favor of denial. In the parallel litigation, Petitioner has attacked the validity of the challenged claims in view of the same prior art addressed in the Petition. *See, e.g.*, EX2005, 34-35 (Final Invalidation Contentions asserting similar art against the asserted claims of the '524 patent).

Petitioner's offer to reduce its invalidity assertions based on the outcome of the Board's institution decision rings hollow, because Petitioner has sought two bites at the invalidity apple and is offering to discard one of its attempts only where the other shows promise. This violates the fundamental tenet of *inter partes* reviews, which is that a litigant cannot simply hedge its bets on the forum in which to pursue invalidity until it can better weigh its chances, but instead should make a concerted decision regarding where it wishes to litigate its invalidity challenges, and then honor that decision. *See* 77 Fed. Reg. 48680-01 (Aug. 14, 2012) (IPRs are intended "to create a timely, cost-effective **alternative** to litigation") (emphasis added). And as explained above, by the time an institution decision is rendered in this *inter partes* review, expert discovery will be complete and Patent Owner's expert will have rebutted Petitioner's invalidity arguments based on the same references used here. This factor weighs in favor of denial.

E. Whether the Petitioner and the Defendant in the Parallel Proceeding are the Same Party

The fifth *Fintiv* factors addresses whether the Petitioner and the defendant in the parallel proceeding are the same party. Petitioner admits that it is the defendant in the parallel litigation. Pet., 1. As a result, this factor weighs in favor of denial. *Cisco Sys., Inc. v. Oyster Optics, LLC*, IPR2021-00238, Paper 10 at 16-17.

F. Other Circumstances That Impact the Board's Exercise of Discretion, Including the Merits

Finally, the sixth *Fintiv* factor addresses other circumstances that impact the Board's exercise of discretion. As explained above, Patent Owner raises procedural and substantive reasons why the Petition should be denied on the merits and has demonstrated those merits are far from "compelling." These reasons also serve as factors relevant to discretionary denial under this sixth *Fintiv* factor.

IX. CONCLUSION

Petitioner has not established a reasonable likelihood that it will prevail on Grounds 1 and 2 to establish unpatentability of the challenged claims of the '524 Patent, and therefore the Board should deny institution of *inter partes* review of the '524 Patent.

Patent Owner's Preliminary Response
IPR2023-00943 (U.S. Patent No. 8,896,524)

Respectfully Submitted,

Dated: September 8, 2023

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CERTIFICATION UNDER 37 C.F.R. § 42.24(d)

Under the provisions of 37 C.F.R. § 42.24(d), the undersigned hereby certifies that the word count for all portions of the foregoing Patent Owner's Preliminary Response totals 6,283 words per Microsoft Word, which complies with the requirement of 14,000 words allowed under 37 C.F.R. § 42.24(d).

Dated: September 8, 2023

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CERTIFICATE OF SERVICE

As authorized by Patent Owner's Mandatory Notice, I hereby certify that on September 8, 2023, a copy of this document has been served in its entirety by electronic mail on Petitioner's lead and backup counsel.

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