

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS INC.,
Petitioner,

v.

PANTECH CORPORATION,
Patent Owner

Case: IPR2023-01268

U.S. Patent No. 9,575,631

PATENT OWNER PRELIMINARY RESPONSE

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	January 13, 2023 Declaration of Jamie B. Beaber (Confidential)
2002	Pantech Corp. v. LG Electronics Inc., Case No. 5:22-cv-00113 (E.D. Tex.), Dkt. 1 (Complaint).
2003	Pantech Corp. v. LG Electronics Inc., Case No. 5:22-cv-00113 (E.D. Tex.), Dkt. 15 (LGE SEALED Motion to Disqualify) (Confidential).
2004	Pantech Corp. v. LG Electronics Inc., Case No. 5:22-cv-00113 (E.D. Tex.), Dkt. 93 (Magistrate Order Regarding LGE's Motion for Disqualification) (Confidential).
2005	Pantech Corp. v. LG Electronics Inc., Case No. 5:22-cv-00113 (E.D. Tex.), Dkt. 160 (Order Regarding LGE's Motion for Disqualification) (Confidential).
2006	Pantech Corp. v. LG Electronics Inc., Case No. 5:22-cv-00113 (E.D. Tex.), Dkt. 102 (SEALED Defendants' Rule 72 Objections to the Order Regarding Disqualification) (Confidential).
2007	Pantech Corp. v. LG Electronics Inc., Case No. 5:22-cv-00113 (E.D. Tex.), Dkt. 103 (SEALED Pantech Objections to Order Denying DQ) (Confidential).
2008	Pantech Corp. v. LG Electronics Inc., Case No. 5:22-cv-00113 (E.D. Tex.), Dkt. 111 (SEALED Pantech Response to LGE Objections to Order Denying Disqualification) (Confidential).
2009	Pantech Corp. v. LG Electronics Inc., Case No. 5:22-cv-00113 (E.D. Tex.), Dkt. 113 (SEALED LGE's Opposition to Plaintiffs' Rule 72 Objections) (Confidential).
2010	(Reserved)

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2011	November 18, 2019 Declaration of Juseong Ryu (Confidential)
2012	ABA Formal Opinion #05-436
2013	3GPP TS 36.321
2014	Pantech Corp. v. LG Electronics Inc., Case No. 5:22-cv-00113 (E.D. Tex.), Dkt. 45 (Pantech’s Response to LGE’s Motion to Disqualify) (Confidential).
2015	Pantech Corp. v. LG Electronics Inc., Case No. 5:22-cv-00113 (E.D. Tex.), Dkt. 54 (SEALED Reply ISO Motion to Disqualify) (Confidential).
2016	Pantech Corp. v. LG Electronics Inc., Case No. 5:22-cv-00113 (E.D. Tex.), Dkt. 60 (SEALED Sur-reply ISO Response to Motion to Disqualify Mayer Brown) (Confidential).
2017	Claim Construction Order from <i>Pantech Corp. v. LG Electronics Inc.</i> , No. 5:22-cv-00113-RWS, Dkt. 215 (E.D. Tex. Oct. 23, 2023)
2018	Scheduling Order from <i>Pantech Corp. v. LG Electronics, Inc.</i> , No. 5:22-cv-00113-RWS, Dkt. 240 (E.D. Tex., Jan. 22, 2024)
2019	Invalidity Contentions from Pantech Corp. v. LG Electronics Inc., No. 5:22-cv-00113-RWS (E.D. Tex. April 13, 2023)
2020	U.S. Patent No. 7,123,945 (“Kokubo”)
2021	Prosecution History of U.S. Patent No. 9,250,957

I. INTRODUCTION

Patent Owner Pantech Corporation (“Patent Owner”) respectfully requests that the United States Patent and Trademark Office (“USPTO” or the “Office”) Patent Trial and Appeal Board (“PTAB” or the “Board”) deny institution of claims 1-10 (the “challenged claims”) of U.S. Patent No. 9,575,631 (“the ’631 Patent”).

First, the advanced stage of the co-pending District Court case *Pantech Corp. v. LG Electronics Inc.*, No. 5:22-cv-00113-RWS (E.D. Tex.) (“District Court Action”) means that *inter partes* review would be neither an efficient nor effective alternative to litigation, but rather merely introduce duplicative proceedings. Specifically, trial in the District Court Action is scheduled for September 2024, before even a reply would be due from Petitioner (late October 2024), and expert discovery—covering the same combinations of references asserted by this Petition—will conclude prior to any institution decision. Petitioner has not offered any *Sotera*-type stipulation to alleviate concerns of duplicative litigation, nor is a stay likely in the district court. Accordingly, as will be explained herein, there are strong grounds for discretionary denial of this Petition under 35 U.S.C. § 314(a).

Second, Petitioner fails to show a reasonable likelihood of prevailing because it has not shown that the cited references anticipate and/or render obvious claims 1-10. As explained herein, the prior art relied upon by Petitioner fails to teach or render

obvious key aspects of the invention of the '631 Patent. For Grounds 1-4, the cited prior art fails to teach at least a causal relationship between a command and a sequential display of icons as required by independent claim 1 (for Grounds 1-4), and in fact simply teaches the same sort of independent display present in the prior art considered by the Examiner and overcome during prosecution. For Grounds 5-7, the cited prior art does not teach a multitasking terminal in which applications run in the background, but rather merely a terminal with a “split screen” mode. The combinations of secondary references cited in the Petition do not overcome these deficiencies.

Accordingly, for at least these reasons, the Board should deny Petitioner's request to institute *inter partes* review.

II. BACKGROUND

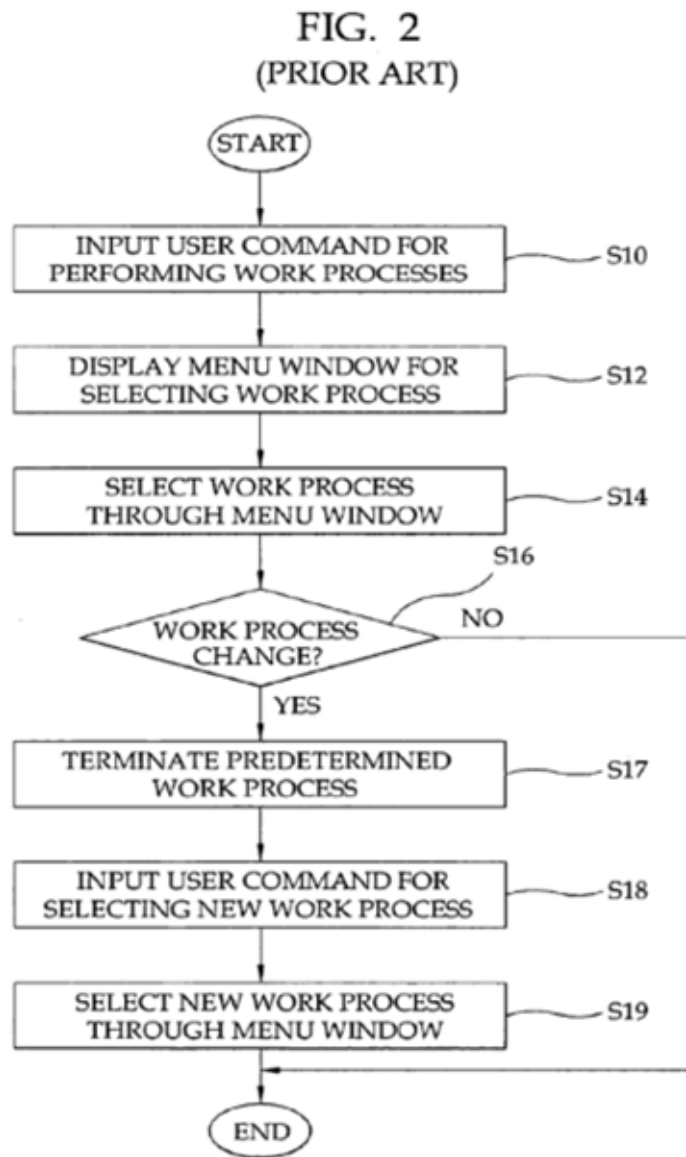
A. Overview of the '631 Patent

The '631 Patent is entitled “Method for Selecting and Controlling Second Work Process During First Work Process in Multitasking Mobile Terminal.” The application from which the '631 Patent was issued was filed on January 29, 2016, and claims priority to KR 10-2005-0073877, which was filed on August 11, 2005 and KR 10-2005-0102198 filed on October 28, 2005. The '631 Patent issued on February 21, 2017.

The '631 Patent generally “relates to a method for controlling a plurality of

work processes in a multitasking mobile terminal, and more particularly, to a method for selecting a second work process during a first work process and controlling a predetermined function of the selected second work process.” Ex. 1001 at 1:23-28.

At the time of the '631 Patent, conventional methods for multitasking in a mobile terminal meant that when a user wanted to change from one process to another, the previous process would be terminated, as shown below in Figure 2. *Id.* 1:61-64. As one example, a user had to terminate a text message creation process in order to control music or audio playback. *Id.* at 2:40-44. Upon returning to the text message creation, the user would be faced with the inconvenience of recreating any progress previously discarded or forced to seek out the incomplete message stored in a temporary mailbox. *Id.* at 2:44-51.



Id. at FIG. 2.

The '631 Patent solved this problem by providing a technique for controlling a predetermined function of a first work process in a multitasking mobile terminal that performs the first work process and the second work process, and by providing a technique for controlling a predetermined function of a second work process in a

multitasking mobile terminal that performs the first work process and the second work process. In one example, an icon is displayed, which corresponds to a first work process. If the icon is selected, then a screen for the first work process is displayed. *Id.* at 5:40-45. Multiple icons, including an icon corresponding to a second work process, are displayed when a command is received to sequentially display icons. The icon corresponding to the second work process can be selected and a corresponding screen is displayed. From this screen, a control menu can be activated for controlling the first work process and commands can be input for controlling the first work process. *Id.* at 5:50-58.

B. Relevant Patent Prosecution History

During prosecution of the '631 Patent, and as supported by the prosecution of related applications, the issued claims were extensively examined, and their patentability confirmed.

The principle office action prior to allowance of the '631 Patent occurred on May 19, 2016. In this office action, the Examiner (1) rejected the pending claims on the grounds of nonstatutory double patenting in view of the related U.S. Patent No. 9,122,518 (“the '518 Patent”) and U.S. Patent No. 9,250,957 (“the '957 Patent”) (Ex. 1002 at 107-109); and (2) rejected the pending claims under 35 U.S.C. § 103 based on several combinations of U.S. Patent No. 7,123,945 (“Kokubo”), U.S. Patent Pub.

No. 2015/0183017 (“Cain”), and U.S. Patent Pub. No. 2005/0229103 (“King”) (Ex. 1002 at 109-125).

In response, and following an Examiner interview, the Applicant submitted a terminal disclaimer regarding the ’518 Patent and the ’957 Patent (*see* Ex. 1002 at 157-158) and amended the claims. These claim amendments provided, at least in part, that “the displayed icon corresponds to the first work process,” “if the displayed icon corresponding to the first work process is selected, displaying a screen of the first work process,” and “in response to a first command for sequentially displaying icons, performing sequential display of icons such that an icon corresponding to the second work process is displayed.” Ex. 1002 at 165-170.

The Examiner, after entering a minor Examiner Amendment to remove “and is displayed together with at least a part of a screen image of the first work process in the display” and to add “in the display” at the end of the second limitation, confirmed the patentability of the claims. Ex. 1002 at 187-194. In particular, the Examiner emphasized that:

As per independent claims 1, 10 and 15, the primary reason for allowance is the inclusion of “displaying one icon in a designated portion of a display, wherein the displayed icon corresponds to the first work process; if the displayed icon corresponding to the first work process is selected, displaying a screen of the first work process in the display; in response to a first command for sequentially

displaying icons, performing sequential display of icons such that an icon corresponding to the second work process is displayed, wherein the icon corresponding to the second work process is displayed in the designated portion of the display” in conjunction with the rest of the limitations of the claim.

Ex. 1002, at 193. Leading to this Notice of Allowance, 24 references had been made of record and were considered by the Examiner, including U.S. Patent Pub. 2004/0117440 (“Hellyar”) and U.S. Patent Pub. 2006/0020904 (“Aaltonen”), which are now relied upon by Petitioner.

1. Examination of Related ’518 and ’957 Patents

Previously, the Office had examined the related ’518 and ’957 patents, and the prosecution histories of those patents inform the examination of the ’631 Patent. Indeed, these earlier patents were the subject of the terminal disclaimer requirement for the ’631 Patent, and the independent claims share many of the same elements, as shown by the following exemplary chart:

’631 Patent	’957 Patent	’518 Patent
1[.pre]. A method for controlling a predetermined function of a second work process during a first work process in a multitasking mobile terminal that performs the first work process and the second	1. A method for controlling a predetermined function of a second work process during a first work process in a multitasking mobile terminal that performs the first work process and the second	1. A method for controlling a predetermined function of a second work process during a first work process in a multitasking mobile terminal that performs the first work process and the second

'631 Patent	'957 Patent	'518 Patent
work process, the method comprising:	work process, the method comprising:	work process, the method comprising:
[1.a] displaying one icon in a designated portion of a display, wherein the displayed icon corresponds to the first work process;	while performing the first work process, displaying a screen of the first work process;	while performing the first work process,
[1.b] if the displayed icon corresponding to the first work process is selected, displaying a screen of the first work process in the display;	displaying an icon corresponding to the first work process, the displayed icon being displayed together with a screen image of the first work process in a display, wherein the icon corresponding to the first work process is displayed in a designated portion of the display;	displaying an icon corresponding to the first work process, the displayed icon being displayed together with a screen of the first work process in a display, wherein the icon corresponding to the first work process is displayed in a designated portion of the display, the displayed icon corresponding to the first work process not including an icon corresponding to the second work process;
[1.c] in response to a first command for sequentially displaying icons, performing sequential display of icons such that an icon corresponding to the second work process is displayed, wherein the icon corresponding to the second work process is displayed in the	in response to a first command for sequentially displaying icons, performing sequential display of icons such that the icon corresponding to the second work process is displayed, wherein the icon corresponding to the second work process is displayed in the	in response to a first command for sequentially displaying icons, performing sequential display of icons such that the icon corresponding to the second work process is displayed, wherein the icon corresponding to the second work process is displayed in the

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'631 Patent	'957 Patent	'518 Patent
designated portion of the display;	designated portion of the display replacing the icon corresponding to the first work process;	designated portion of the display replacing the icon corresponding to the first work process, and, in the designated portion of the display, the icon corresponding to the second work process is configured to be replaced with an icon corresponding to a third work process in response to another first command;
[1.d] in response to a second command for changing to the second work process, replacing the screen of the first work process with a screen of the second work process;	in response to a second command for selecting the icon corresponding to the second work process among the sequentially displayed icons, replacing the screen of the first work process with a screen of the second work process;	in response to a second command for selecting the icon corresponding to the second work process among the sequentially displayed icons, replacing the screen of the first work process with a screen of the second work process, wherein an icon to be displayed in the designated portion is replaced with an icon that is different from the icon corresponding to the second work process in response to the second command;
[1.e] controlling the multitasking of the second work process and the first work process;	controlling the multitasking of the second process and the first work process in response to the second	controlling the multitasking of the second process and the first work process in response to the second

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'631 Patent	'957 Patent	'518 Patent
	command;	command;
[1.f] in response to a third command for activating a control menu for controlling a predetermined function of the first work process, activating the control menu for controlling the predetermined function of the first work process; and	in response to a third command for activating a control menu for controlling a predetermined function of the first work process, activating the control menu for controlling the predetermined function of the first work process; and	in response to a third command for activating a pop-up for controlling a predetermined function of the first work process, activating pop-up for controlling the predetermined function of the first work process; and
[1.g] in response to a fourth command for controlling the predetermined function of the first work process through the activated control menu, controlling the predetermined function of the first work process through the activated control menu.	in response to a fourth command for controlling the predetermined function of the first work process through the activated control menu, controlling the predetermined function of the first work process through the activated control menu.	in response to a fourth command for controlling the predetermined function of the first work process through the activated pop-up, controlling the predetermined function of the first work process through the activated pop-up.

In the first office action related to the '518 Patent on August 31, 2010, the pending claims were rejected on the basis of 35 U.S.C. §§ 102 and 103 in view of Kokubo as well as U.S. patent 7,222,304 ("Beaton") and U.S. Patent Pub. 2006/0247851 ("Morris"). Ex. 1030 at 87-92. In response, Patent Owner argued that Kokubo failed to disclose "that icons are sequentially displayed in turn in response to a first command," but rather disclosed "that icons 10 are displayed on a sub-display unit 142 or a sub-display area (e.g., a display region (A) 122S) of a display

unit 122a.” Ex. 1030 at 109 (citing Kokubo at 12:55, 14:5-60 (Kokubo attached as Ex. 2020)).

On March 16, 2011, the Examiner issued the first Final Office Action: (1) rejecting claims 1 and 3 on the grounds of 35 U.S.C. § 103 as unpatentable over Kokubo and the “User’s Guide for Nokia 5110” (“Nokia”), Ex. 1030 at 139; and (2) rejecting claims 4-8 on the grounds of 35 U.S.C. § 103 as unpatentable over Kokubo, Nokia, and U.S. Patent Pub. 2002/0080186 (“Frederiksen”). *Id.* at 141. Notably, the Examiner acknowledged that “Kokubo does not teach wherein inputting a first command to sequentially highlight icons in turn is implemented as sequentially displaying icons in turn,” but rather discloses “simultaneously displays icons.” *Id.* at 140 (emphasis in original) (citing Kokubo at FIG. 13, display 142).

The Patent Owner’s reply highlighted the Examiner’s acknowledgment “that Kokubo does not teach at least ‘while performing the first work process, inputting a first command to sequentially display icons in turn corresponding to respective work process of the mobile terminal.” Ex. 1030 at 167 (emphasis in original). In response, the Examiner entered an Advisory Action rejecting Patent Owner’s request for reconsideration. *Id.* at 177. Then on June 13, 2011, the Patent Owner filed a reply with Request for Continued Examination and reasserted the Examiner’s concession regarding Kokubo. *Id.* at 187.

On October 22, 2012, the Examiner issued the second non-final Office Action: (1) rejecting claims 1 and 3 on the grounds of 35 U.S.C. § 103 as unpatentable over Kokubo and U.S. Patent Pub. No. 2003/0016251 (“Kondo”), Ex. 1030 at 199; and (2) rejecting claims 4-8 as unpatentable over Kokubo, Kondo, and Frederiksen. *Id.* at 201. In response, the Patent Owner filed a reply arguing that both Kokubo and Kondo failed to disclose that “sequentially displaying icons comprises ***displaying the icons corresponding to the active work processes*** in order of the work process performed.” *Id.* at 219 (emphasis in original).

On January 21, 2013, the Examiner issued a second Final Office Action: (1) rejecting claims 1 and 3 on the grounds of 35 U.S.C. § 102 as anticipated by Kokubo, Ex. 1030 at 229; and (2) rejecting claims 4-8 on the grounds of 35 U.S.C. § 103 as unpatentable over Kokubo and Frederiksen. *Id.* at 231. In response, the Patent Owner filed a reply on May 28, 2013, arguing that the Examiner had previously “conceded that Kokubo failed to disclose ‘while performing the first work process, inputting a first command for sequentially displaying icons in turn corresponding to respective work processes of the mobile terminal, wherein sequentially displaying icons comprises displaying the icons in order of the work process performed.’” *Id.* at 243-244 (emphasis removed). A few days later, the Examiner entered an Advisory Action

rejecting Patent Owner's request for reconsideration. *Id.* at 253. Then, Patent Owner filed a Request for Continued Examination. *Id.* at 256.

On July 10, 2013, the Examiner issued the third non-final Office Action: (1) withdrawing the January 21, 2013, rejection under 35 U.S.C. § 102; and (2) rejecting claims 1 and 3-8 on the grounds of 35 U.S.C. § 103 as unpatentable over Kokubo and U.S. Patent Pub. 2007/0003224 ("Krikorian"). Ex. 1030 at 269. In response, Patent Owner filed a reply arguing that both Kokubo and Krikorian failed to disclose "wherein the sequentially displayed icons are displayed brighter than the screen corresponding to the first work process." *Id.* at 293.

On December 4, 2013, the Examiner issued a third Final Office Action rejecting claims 1 and 3-8 on the grounds of 35 U.S.C. § 103 as unpatentable over Kokubo, Krikorian, and U.S. Patent Pub. 2004/0229200 ("McKeon"). Ex. 1030 at 301. In response, Patent Owner filed a reply on February 28, 2014 requesting reconsideration under the After-Final Consideration Pilot Program 2.0. *Id.* at 327. This request resulted in the entry of a detailed action rejecting Patent Owner's arguments and explaining that U.S. Patent Pub. 2006/0161847 and U.S. Patent Pub. 2003/0117440 ("Hellyar") (Ex. 1012) could "be used to reject the proposed amendment." Ex. 1030 at 342. A subsequent Request for Continued Examination and reply was filed by Patent Owner. *Id.* at 347, 351.

On September 23, 2014, the Examiner issued the fourth non-final Office Action rejecting claims 4-8, 10, and 11 on the grounds of 35 U.S.C. § 103 as unpatentable over Kokubo and Cain. Ex. 1030 at 374, 376. In response, Patent Owner filed a reply arguing that both Kokubo and Cain failed to disclose “in response to ***a first command*** for sequentially displaying icons, ***performing sequential display of icons such that the icon corresponding to the second work process is sequentially displayed***, wherein ***the icon corresponding to the second work process is displayed in a designated portion of the display***, and, ***in the designated portion, the icon corresponding to the second work process is configured to be replaced with an icon corresponding to a third work process in response to another first command.***” *Id.* at 418 (emphasis in original).

Finally, on April 22, 2015, the Examiner allowed claims 4-15 with an Examiner’s Amendment noting the following reasons for allowance:

As per independent claim 4, the primary reason for allowance is the inclusion of “while performing the first work process, displaying an icon corresponding to the first work process, the displayed icon being displayed together with a screen of the first work process in a display, wherein the icon corresponding to the first work process is displayed in a designated portion of the display, the displayed icon corresponding to the first work process not including an icon corresponding to the second work process; in response to a first

command for sequentially displaying icons, performing sequential display of icons such that the icon corresponding to the second work process is displayed, wherein the icon corresponding to the second work process is displayed in the designated portion of the display replacing the icon corresponding to the first work process, and, in the designated portion of the display, the icon corresponding to the second work process is configured to be replaced with an icon corresponding to a third work process in response to another first command, in response to a second command for selecting the icon corresponding to the second work process among the sequentially displayed icons, replacing the screen of the first work process with a screen of the second work process, wherein an icon to be displayed in the designated portion is replaced with an icon that is different from the icon corresponding to the second work process in response to the second command” in conjunction with the rest of the limitations of the claim.

Ex. 1030 at 442-443.

This reason for allowance was substantially similar to the reasons for allowance provided for the subsequent '957 Patent:

As per independent claim 1, the primary reason for allowance is the inclusion of “while performing the first work process, displaying a screen of the first work process; displaying an icon corresponding to the first work process, the displayed icon being displayed together with a screen image of the first work process in a display, wherein

the icon corresponding to the first work process is displayed in a designated portion of the display; in response to a first command for sequentially displaying icons, performing sequential display of icons such that the icon corresponding to the second work process is displayed, wherein the icon corresponding to the second work process is displayed in the designated portion of the display replacing the icon corresponding to the first work process; in response to a second command for selecting the icon corresponding to the second work process among the sequentially displayed icons, replacing the screen of the first work process with a screen of the second work process;” in conjunction with the rest of the limitations of the claim.

’957 Patent Prosecution History (Ex. 2021) at 74-75.

Thus, the relevant prosecution history of the ’631 Patent shows an extensive examination of the patentability of its claims in view of a wide range of prior art, with the Office identifying various reasons for patentability in view of this prior art.

C. Summary of Petitioner’s Proposed Grounds for Unpatentability

Petitioner contends that claims 1-10 would have been anticipated under pre-AIA 35 U.S.C. § 102, and would have been obvious under pre-AIA 35 U.S.C. § 103. The Petition raises seven grounds of alleged unpatentability based on eight references:

1. U.S. Patent No. 9,785,329 (“Paasonen”);
2. U.S. Patent Pub. 2004/0100479 (“Nakano”);

3. U.S. Patent Pub. 2006/0020904 (“Aaltonen”);
4. U.S. Patent Pub. 2005/0257169 (“Tu”);
5. U.S. Patent Pub. 2006/0197753 (“Hotelling”);
6. U.S. provisional application 60/658,777 (“Hotelling-Prov”);
7. U.S. Patent Pub. 2006/0026521 (“Hotelling-521”); and
8. U.S. Patent Pub. 2003/0117440 (“Hellyar”).

The specific grounds of alleged invalidity are based on shifting combinations of the eight references identified above, and are summarized as follows:

Ground	'631 Patent Claims	Type of Challenge	Primary Reference	Secondary Reference(s)
1	1-10	§ 102	Paasonen	
2	1-10	§ 103	Paasonen	Nakano
3	4 and 7	§ 103	Paasonen	Aaltonen
4	4 and 7	§ 103	Paasonen	Aaltonen and Nakano
5	1-4 and 7	§ 102	Hotelling	
6	1-4 and 6-10	§ 103	Hotelling	Hellyar
7	5 and 6	§ 103	Hotelling	Hellyar and Tu

D. The Relied-Upon References

The eight references relied upon by Petitioner to challenge the patentability of claims 1-10 of the '631 Patent are summarized as follows:

1. Paasonen (Ex. 1005)

U.S. Patent No. 9,785,329 (“Paasonen”) is entitled “Pocket Computer and Associated Methods” and was filed on May 23, 2005.

Paasonen is directed to “a pocket computer . . . having an apparatus housing and a user interface with a touch-sensitive display provided at a first side surface of said apparatus housing, at least one key for navigation among content shown on said display, and at least one key for performing zooming on content shown on said display.” Paasonen, Abstract.

Specifically, Paasonen discloses a “pocket computer” that enables a “efficiently and intuitively switch between running applications.” *Id.* at 4:23-25. This is accomplished through the use of “an application switcher panel” that allows a user to switch between “a plurality of launched applications, i.e., running applications.” *Id.* at 14:24-26. Where the active running application “has control over the application area.” *Id.* at 14:28.

However, Paasonen does not disclose at least sequentially displaying icons in response to a first command, and Petitioner fails to identify distinguishable commands, as required by the challenged claims.

2. Nakano (Ex. 1006)

U.S. Patent Pub. 2004/0100479 (“Nakano”) is entitled “Portable Information Terminal, Display Control Device, Display Control Method, and Computer

Readable Program Therefor” and was published on May 27, 2004. Nakano claims priority to Japanese Patent Application 2002-221746, filed on July 30, 2002.

Nakano is directed to “a display control device for performing display control of menu display, portable information terminal, and display control information and a display control method for allowing a computer to perform display control of menu display.” Nakano, at [0001].

Notably, Petitioner only relies on Nakano as a secondary reference for claims 1-10 and Nakano fails to provide any support or disclosure for its application in multitasking mobile terminals, as required by the challenged claims.

3. Aaltonen (Ex. 1007)

U.S. Patent Pub. 2006/0020904 (“Aaltonen”) is entitled “Stripe User Interface” and was published on January 26, 2006. Aaltonen incorporates by reference provisional application 60/586,855, filed on July 9, 2004.

Aaltonen is directed to “the field of graphical user interfaces.” Aaltonen, at [0003]. More specifically, it is directed to “a user interface for a mobile computing device,” *id.*, that “generally provides the availability of important information in a device in a single gesture.” *Id.* at [0050].

Notably, Petitioner only relies on Aaltonen as a secondary reference for dependent claims 4 and 7.

4. Tu (Ex. 1008)

U.S. Patent Pub. 2005/0257169 (“Tu”) is entitled “Control of Background Media When Foreground Graphical User Interface is Invoked” and was published on November 17, 2005. Tu incorporates by reference provisional application 60/570,343, filed on May 11, 2004.

Tu is directed to “systems and methods that provide control of multimedia contents displayed in the background when the foreground graphical user interface (GUI) is invoked.” Tu, at [0005].

Notably, Petitioner only relies on Tu as a secondary reference for dependent claims 5 and 6.

5. The Hotelling References

The Petition relies on three references (Hotelling, Hotelling-Prov, and Hotelling-521) as a single allegedly anticipatory reference for Ground 5, and as a single primary reference for Grounds 6-7. As discussed below in the context of the limitations of Ground 5, Petitioner makes a flawed assumption and fails to support the use of these references as prior art. Nevertheless, the Hotelling references are summarized as follows:

a. Hotelling (Ex. 1009)

U.S. Patent Pub. 2006/0197753 (“Hotelling”) is entitled “Multi-Functional Hand-Held Device” and was published on September 7, 2006. Hotelling

incorporates by reference provisional application 60/658,777 (“Hotelling-Prov”) (Ex. 1010), filed March 4, 2005, and U.S. Patent Pub. 2006/0026521 (Ex. 1011), filed on July 30, 2004.

Hotelling is directed to “a multi-functional hand-held device capable of configuring user inputs based on how the device is to be used.” Hotelling, Abstract. The disclosed multi-functional hand-held device “has at most only a few physical buttons, keys, or switches so that its display size can be substantially increased.” *Id.* The multi-functional hand-held device “incorporates a variety of input mechanisms, including touch sensitive screens, touch sensitive housings, display actuators, audio input, etc.” as well as “a user configurable GUI for each of the multiple functions of the devices.” *Id.*

b. Hotelling-Prov (Ex. 1010)

U.S. provisional application 60/658,777 (“Hotelling-Prov”) is entitled “Multi-Functional Hand-Held Device” and was filed on March 4, 2005. Hotelling-Prov incorporates by reference U.S. Patent Pub. 2006/0026521 (Ex. 1011), filed on July 30, 2004.

Hotelling-Prov is directed to “hand held electronic devices and more particularly, . . . to hand held electronic devices with touch sensing components.” Hotelling-Prov, at A-7.

Hotelling-Prov discloses “a multi-functional device capable of configuring user inputs based on how the device is to be used.” *Id.* at 7:3-4. Where “the term ‘multi-functional’ is used to define a device that has the capabilities of two or more devices in a single device.” *Id.* at 7:25-26. Notably, in discussing the operation of at least two functionalities simultaneously, Hotelling-Prov discloses “[i]n one embodiment, the device instead of activating one device, may also activate two devices (or more). In such cases, the software for both devices is activated and the display operates in a split screen mode where the screen is parsed into different sections, each section including the device GUI.” *Id.* at 20:12-15.

Hotelling-Prov is limited in its application to multitasking mobile terminals, however. Specifically, Hotelling-Prov discloses a dual mode that presents two full device GUIs side by side but does not limit the functionality of the first device GUI or the second device GUI to a predetermined function, as required by the challenged claims.

c. Hotelling-521 (Ex. 1011)

U.S. Patent Pub. 2006/0026521 (“Hotelling-521”) is entitled “Gestures for Touch Sensitive Input Devices” and was filed on July 30, 2004.

Hotelling-521 is directed to “[m]ethods and systems for processing touch inputs.” Hotelling-521, Abstract. More specifically, Hotelling-521 is directed to

“reading data from a multipoint sensing device such as a multipoint touch screen where the data pertains to touch input with respect to the multipoint sensing device, and identifying at least one multipoint gesture based on the data from the multipoint sensing device.” *Id.*

However, Hotelling-521 fails to disclose how it would be combined with Hotelling-Prov’s dual mode and Petitioner fails to identify the third command required by the challenged claims.

6. Hellyar (Ex. 1012)

U.S. Patent Pub. 2003/0117440 (“Hellyar”) is entitled “Method and System for Switching Between Multiple Computer Applications” and was published on June 26, 2003.

Hellyar is directed to “a computer system that allows users to navigate quickly through multiple applications.” Hellyar, Abstract. “Broadly, the invention monitors for user input indicative of a desire to navigate between open applications windows.” *Id.* at [0024].

Notably, Petitioner only relies on Hellyar as a secondary reference for claims 1-10 and as explained above in Section II.B, the Examiner considered Hellyar during the prosecution of the ’518 Patent. Ex. 1030 at 342.

III. CLAIM CONSTRUCTION

On October 23, 2023, in the co-pending District Court litigation, Magistrate Judge J. Boone Baxter issued a Claim Construction Memorandum and Order. In his order, Judge Baxter construed the following claim terms of the '631 Patent:¹

Term / Claim in Which it Appears	Court's Construction
"control menu" (Claims 1 and 3)	Plain and ordinary meaning
"predetermined function" (Claims 1 and 2)	"a function among those selected in advance"
"sequentially displaying icons" / "performing sequential display of icons"	Plain and ordinary meaning

¹ Petitioner objected to the Magistrate's construction of the claim terms "sequentially displaying icons" / "performing sequential display of icons" and "displaying one icon in a designated portion of a display." *Pantech Corp. v. LG Electronics, Inc.*, No. 5:22-cv-00113-RWS-JBB, Dkt. 218 at 1-4 (E.D. Tex., Nov. 6, 2023). However, this objection was overruled Judge Robert W. Schroeder III. *Pantech Corp. v. LG Electronics, Inc.*, No. 5:22-cv-00113-RWS-JBB, Dkt. 226 at 1 (E.D. Tex., Dec. 1, 2023). Neither party challenged any other construction (including the construction of "predetermined function"), making these remaining constructions largely unappealable. See Fed. R. Civ. P. 72(a).

Claims 1 and 8)	
“displaying one icon in a designated portion of a display” (Claim 1)	Plain and ordinary meaning

Pantech Corp. v. LG Electronics, Inc., No. 5:22-cv-00113-RWS-JBB, Dkt. 215 at 25-26 (E.D. Tex., Oct. 23, 2023) (attached as Ex. 2017).

Petitioner did not identify any claim terms for construction, and does not acknowledge the District Court’s construction for “predetermined function.” Rather, Petitioner merely applies the plain and ordinary meaning for each term. *See* Petition at 13-14.

IV. LEGAL STANDARDS FOR INVALIDITY

Under 35 U.S.C. § 102(a) (pre-AIA),² an issued patent is invalid if “the invention [therein] was . . . described in a printed publication . . . before the invention thereof by the applicant.” This statute “embodies the concept of novelty—if a device or process has been previously invented (and disclosed to the public), then it is not new, and therefore the claimed invention is ‘anticipated’ by the prior invention.” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008). To anticipate,

² The pre-American Invents Act (“AIA”) statute controls here because the ’631 Patent is entitled to an effective filing date prior to the AIA’s implementation.

“the prior art reference . . . must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’” *Id.* (citing *Connell v. Sears Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)).

A claim is also not patentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious to a person of ordinary skill in the art at the time of the invention. 35 U.S.C. § 103(a) (pre-AIA). Obviousness requires assessing (1) the “level of ordinary skill in the pertinent art,” (2) the “scope and content of the prior art,” (3) the “differences between the prior art and the claims at issue,” and (4) “secondary considerations” of non-obviousness such as “commercial success, long felt but unsolved needs, failure of others, etc.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966)).

It is the petitioner’s burden to prove unpatentability, *E.I DuPont de Nemours & Co. v. Synvina C.V.*, 904 F.3d 996, 1007 (Fed. Cir. 2018), and “to demonstrate both ‘that a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so.’” *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367-68 (Fed. Cir. 2016)

(quotations and citations omitted). However, a petitioner must first show that all of the claimed elements are disclosed in the prior art. *See Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1164 (Fed. Cir. 2006) (considering motivation to combine and reasonable expectation of success only “if all the elements of an invention are found in a combination of prior art references”).

V. DISCRETIONARY FACTORS FAVOR DENIAL OF INSTITUTION UNDER 35 U.S.C. § 314(a)

The Petition should be denied pursuant to the Director’s discretion to deny institution of petitions. Specifically, the Petition should be denied pursuant to 35 U.S.C. § 314(a) according to the factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020). The PTAB has the authority, where warranted, to exercise discretion to deny institution in view of the *Fintiv* factors particularly where, as here, the merits of the challenge are neither compelling nor meritorious (*see infra*, Section VI). *See* “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings With Parallel District Court Litigation,” issued June 21, 2022 (“Director’s Guidance”); *see also, Harmonic Inc. v. Avid Tech.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016); *see also Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016); 37 C.F.R. § 42.108(a).

Guidance from the Director states that the purpose of discretionary denial is to “limit unnecessary and counterproductive litigation costs” and avoid

gamesmanship. *See* Director’s Guidance at 1. This guidance has also clarified the application of the so-called *Fintiv* factors to circumstances such as these, where there is a co-pending District Court Action.³ *Id.*

For the Grounds presented in this Petition, instituting an IPR would not be an effective or efficient alternative to litigation because, most notably, the co-pending District Court Action (1) involves the same primary prior art references and substantially the same secondary prior art references that LGE relies on here, and (2) will be complete well before a final written decision in this proceeding. Furthermore, LGE is asking the Board to consider seven asserted grounds of invalidity in this IPR Petition. This is well beyond the normal limits of an IPR petition and thus puts an increased burden on the Board to complete review of such a voluminous Petition within the statutory timeframe.

Thus, the Petition would be neither an “effective [nor] efficient alternative” to the ongoing litigation, and would not be an efficient use of Board resources. *See Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16-17 (PTAB Sept. 6, 2017) (precedential). Indeed, when considered within a

³ Here, the co-pending District Court Action is *Pantech Corp. v. LG Electronics Inc.*, No. 5:22-cv-00113-RWS (E.D. Tex.).

thorough analysis of the *Fintiv* factors, any slim (if any) merits of this petition fail to weigh in favor of institution. Rather, the merits of LGE’s invalidity challenge are best addressed in the District Court Action, and therefore, the Board should exercise its discretion to deny institution.

1. The Court Has Not Stayed the District Court Action

Regarding the first *Fintiv* factor (“whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted”), a stay has not been granted in the District Court Action, and Petitioner has not filed a motion to stay in view of this Petition. And while Petitioner has made the bare statement that it “intends to seek a stay” if this IPR is granted (*see* Petition at 12), there is no evidence that Petitioner’s not-yet-made request would be granted even if made—and Petitioner has offered absolutely none.

While the Board “will not attempt to predict” how the district court will proceed in the absence of specific evidence (*Sand Revolution II, LLC v. Continental Intermodal Group-Trucking LLC*, IPR 2019-01393, Paper 24 at 7 (PTAB June 16, 2020) (informative)), it bears mentioning that the evidence indicates that a stay will not be granted. First, even if this IPR is instituted, the projected final written decision will not occur until April, 2025—approximately seven months after the scheduled

trial date in the District Court Action.⁴ In similar circumstances, this district court routinely denies motions to stay. The District Court’s decision in *Maxell Ltd. v. Apple Inc.*, No. 5:19-CV-00036-RWS, 2020 U.S. Dist. LEXIS 257531, at *7-9 (E.D. Tex. April 27, 2020), explained that a stay should not be granted because the case was filed “more than a year ago” (as would be true with this litigation) and because trial is scheduled for six months after the order (the September trial date would be even closer to any decision on institution). *See also Kirsch Research and Development LLC v. DuPont de Nemours, Inc.*, Dkt. 269, No. 5-20-cv-00057-RWS (E.D. Tex. July 7, 2021) (similar analysis following *Maxell* and noting the advanced stage of litigation). Second, the District Court has already denied a different request by Petitioner to stay the litigation (for reasons unrelated to any *inter partes* review), stating that a stay “would unjustly delay the progress of the case and harm Pantech’s interests in timely resolution.” *See Pantech Corp. v. LG Electronics Inc.*, No. 5:22-cv-00113-RWS, Dkt. 131 at 1 (E.D. Tex., July 19, 2023). The Court has thus demonstrated its intent to proceed to trial in a timely manner. As such, there has been

⁴ Jury trial is scheduled for September 23, 2024. *See Pantech Corp. v. LG Electronics, Inc.*, No. 5:22-cv-00113-RWS, Dkt. 240 at 2 (E.D. Tex., Jan. 22, 2024) (scheduling order attached as Exhibit 2018).

no suggestion that the trial would not occur as currently scheduled in September 2024.

As such, the evidence indicates that a stay will not be granted in the future even if Petitioner requests one, and this *Fintiv* factor weighs in favor of denial.

2. The Trial Date in the District Court Action Precedes the Projected Final Written Decision Date

Regarding the second *Fintiv* factor (“the proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision”), the projected final written decision date is April, 2025, well after the scheduled September 23, 2024 trial date in the District Court Action. In fact, the trial date is even before any reply would be due from Petitioner (late October, 2024) and prior to the final oral hearing, should *inter partes* review be granted.

While Petitioner correctly states that the median time to trial in the Eastern District of Texas “varies between 19 and 24 months” (see Petition at 12, citing Ex. 1028), 24 months after the filing date is September 2, 2024. That is **before** the currently-scheduled trial date (meaning the current schedule is already longer than the average). Petitioner’s alternative citation to privately gathered statistics from *Docket Navigator* indicating a median time to trial of 26 both exceeds the guidance from the USPTO Director of what statistics will be considered (see Memo from Katherine K. Vidal at 9 n. 12 (June 21, 2022)) and also does not meaningfully change

the analysis—November 11, 2024 (the date using these statistics) would still be many months before the projected statutory deadline for a final written decision. Regardless, the statistics about averages are irrelevant here because a trial date has been set and there has been no indication that it would move in any significant way beyond the currently scheduled date.

Accordingly, this *Fintiv* factor also weighs in favor of denial.

3. The Parties Have Invested Substantial Efforts in Litigating the Grounds Presented in this Petition in the District Court Action

Regarding the third *Fintiv* factor (“investment in the parallel proceeding by the court and the parties”), the parties have significantly invested in the District Court Action. For example, the parties have served and responded to discovery including making large document productions, engaged in early motion briefing, a hearing on a motion to dismiss (with related briefing and a denied motion for reconsideration), engaged in full claim construction briefing and depositions of experts relating to claim construction, and received a claim construction order. Fact discovery has concluded.

Most notably, expert reports on invalidity are due to be served on February 21, 2024, with expert discovery on validity concluding by April 10, 2024—expert discovery will therefore be complete by the time of any institution decision. *See*

Exhibit 2018 at 3. As addressed below in the context of the fourth *Fintiv* factor, the grounds of invalidity disputed by the parties in the District Court Action are the same as Petitioner presents here. Thus, the parties have already (or shortly will have) invested many of the same resources into the District Court Action that Petitioner seeks to bring into this dispute. Institution would be a waste of party and judicial resources, precisely what discretionary denial seeks to avoid. *See* Memo from Katherine K. Vidal at 1 (June 21, 2022).

This *Fintiv* factor also weighs in favor of denial.

4. The District Court Action will Consider the Same Grounds as Presented in this Petition

Regarding the fourth *Fintiv* factor (“overlap between issues raised in the petition and in the parallel proceeding”), each of the seven grounds of alleged invalidity asserted in this Petition are already being litigated in the District Court Action.

Specifically, each of Paasonen, Nakano, Aaltonen, Tu, the Hotelling references, and Hellyar (*i.e.*, each alleged prior art reference at issue in this Petition) is being asserted as a basis of invalidity in the District Court Action. Exhibit 2019 (LGE’s Invalidity Contentions) at 115-128. Indeed, Petitioner relies on all of the combinations presented in this Petition in the District Court as well. *Id.* at 116-118.

Moreover, Petitioner has not offered any *Sotera*-type stipulation or made any

effort to avoid duplicative proceedings.

Given that the Petition is directed toward the same claims, same grounds, same arguments, same references, and significantly overlapping evidence at issue in the parallel District Court Action, and since Petitioner has not sought to mitigate any of these concerns through a *Sotera* stipulation, this *Fintiv* factor favors denial of institution.

5. The Parties are the Same in the District Court Action

Regarding the fifth *Fintiv* factor (“whether the petitioner and the defendant in the parallel proceeding are the same party”), LG Electronics Inc. is both Petitioner here and a defendant in the District Court Action. The Petition acknowledges this. See Petition at 12. This *Fintiv* factor thus also weighs in favor of denial.

6. Other Circumstances Also Weigh in Favor of Discretionary Denial

Regarding the sixth *Fintiv* factor (“other circumstances that impact the Board's exercise of discretion, including the merits”), while petitioner avers that “[t]he merits of this Petition are compelling as shown herein” (see Petition at 13), as set forth below in Section VI, the weakness of the proposed grounds weighs strongly in favor of denial of institution.

But even if there are some merits to Petitioner’s shotgun, seven-ground challenge (and there are not), “[w]here the information presented at the institution

stage is merely sufficient to meet the statutory institution threshold [a reasonable likelihood of success], the PTAB has the authority, where warranted, to exercise discretion to deny institution in view of the other *Fintiv* factors.” Memo from Katherine K. Vidal at 4 (June 21, 2022). Petitioner has certainly failed to meet the higher threshold of a “compelling” unpatentability challenge.

Furthermore, the sheer number of grounds asserted, seven, increases substantially the duplicative litigation sought by Petitioner. Asking both the USPTO and the district court to independently consider seven asserted grounds of invalidity, on the basis of eight references, without any *Sotera* stipulation, surpasses any reasonable threshold of “counterproductive litigation costs” limited by the Director’s guidance on discretionary denial (not to mention gamesmanship).

In addition, institution should be denied because of the excessive number of grounds presented in this petition that also lack particularity. The efficient administration of the Office, the integrity of the patent system, and the Board’s ability to timely complete the requested review, and the undue burden that the number of prior art combinations asserted in the Petition places upon the Board and Patent Owner support denial of institution. “[W]here a petition contains voluminous or excessive grounds, Office guidance indicates ‘[t]he panel will evaluate the challenges and determine whether, in the interests of efficient administration of the

Office and integrity of the patent system (*see* 35 U.S.C. § 316(b)), the entire petition should be denied under 35 U.S.C. § 314(a).’” *Energysource Minerals LLC v. Terralitim LLC*, IPR2019-00607, Paper 10, at 11 (PTAB May 4, 2020) (*quoting* SAS Q&As, Part D, Effect of SAS on future challenges that could be denied for statutory reasons (June 5, 2018)).

Here, the Petition challenges ten claims, based on eight references, across seven grounds. The petition in the informative *Adaptics* decision, by contrast, asserted a similarly large number (ten) of prior art references against nine patent claims but using only five grounds. *Adaptics Ltd. v. Perfect Co.*, IPR2018-01596, Paper 20, at 2, 6 (PTAB Mar. 6, 2019) (informative) (“Adaptics”). In *Adaptics*, the various combinations of prior art references represented an “unduly burdensome” number of challenges. *Adaptics*, Paper 20 at 9, 13, 14, 19. Here, Petitioner asserts at least seven prior art combinations. Accordingly, the Board should exercise its discretion under 35 U.S.C. § 314(a) and deny the Petition.

Therefore, for several reasons, the sixth *Fintiv* factor also weighs against institution.

* * *

As described above, every single one of the six *Fintiv* factors weighs against institution of this Petition. The USPTO should exercise its discretion not to institute

an *inter partes* review in view of the advanced stage of the District Court Action considering substantially the same grounds, as well as the other considerations described herein.

VI. THE PETITION DOES NOT SHOW A REASONABLE LIKELIHOOD OF PREVAILING WITH RESPECT TO ANY CHALLENGED CLAIM

The Petition should be denied because it does not establish a reasonable likelihood of prevailing on any of the asserted grounds against any of the challenged claims.

A. Ground 1: Petitioner Fails to Establish that Claims 1-10 are Anticipated by Paasonen

As explained below, Petitioner has not shown a likelihood of prevailing with respect to Ground 1 because Paasonen (the only reference relied upon) does not teach each and every element of claims 1-10. Specifically, for the reasons described below, Paasonen fails to teach at least claim element [1.c]. As claims 2-10 each depend upon at least independent claim 1, Petitioner cannot show that Paasonen anticipates any of claims 1-10.

Limitation [1.c] recites “in response to a first command for sequentially displaying icons, performing sequential display of icons such that an icon corresponding to the second work process is displayed, wherein the icon corresponding to the second work process is displayed in the designated portion of the display.” As explained below, Petitioner fails to demonstrate that Paasonen

discloses limitation [1.c], because Paasonen does not disclose performing sequential display of icons *in response to a first command*, as the claim language requires.

The display of icons in Paasonen (whether sequential or not) is always present. According to Petitioner’s argument and annotations, the display of icons occurs in an “application switcher panel” (in purple) which shows an “audio player” icon (in blue and with a red box):

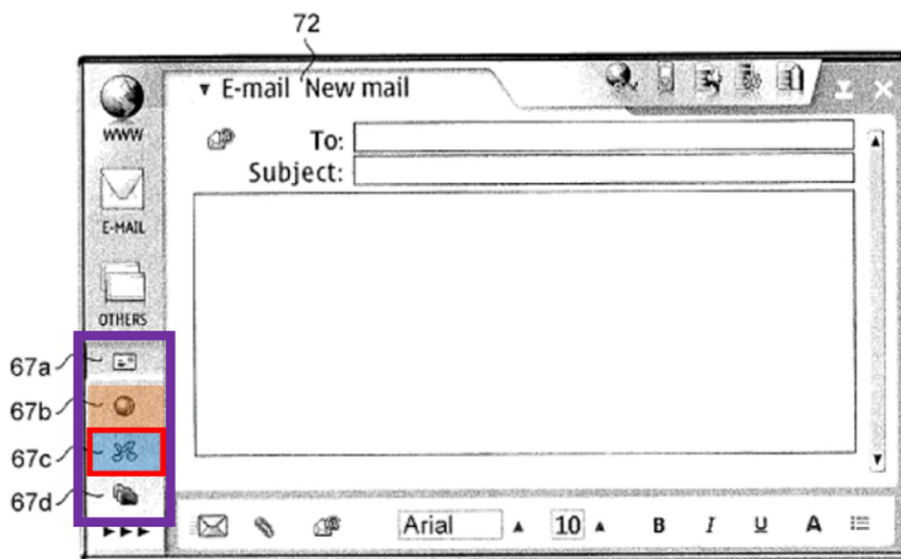


Fig 12

Paasonen, FIG. 12 (annotated by Petitioner).

But this “application switcher panel” is present regardless of whether a “command to launch a different application, such as a ‘bookmark manager’” (the alleged “first command for sequentially displaying icons” according to Petitioner) is executed. See Paasonen at 14:30-37. Therefore, any display of icons that occurs in

Paasonen is not “in response to a first command for sequentially displaying icons.”

Petitioner’s arguments do not overcome this deficiency. Rather, the Petition seems to avoid the issue, and merely states that:

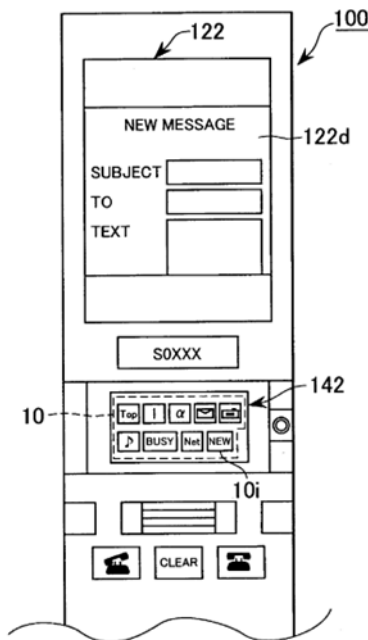
Paasonen discloses in response to a first command for sequentially displaying icons (*e.g.*, command to launch a different application, such as a “bookmark manager”), **performing sequential display of icons such that an icon corresponding to the second work process is displayed** (*e.g.*, “order of the icons” is “updated accordingly” when switching “from a currently active application to another one” by “shifting” icons “one vertical position downwards”)

Pet. at 23 (emphasis in original). In other words, according to Petitioner, the “order of the icons” is “updated” when the relevant command is executed – but this is not what the claim language requires. The claim language requires that the device “perform[es] [a] sequential display of icons” in response to the first command, not simply that the device reorders the icons. In Paasonen, the display of icons is already occurring at the time that any command is entered (*see* Paasonen at 14:30-37), not in response to the command.

A strikingly similar argument was already considered by the Examiner, and overcome, during the prosecution of the related ’518 Patent, which informs this dispute. Specifically, during the prosecution of the ’518 Patent, the Examiner

rejected the pending claims as being anticipated by Kokubo. Ex. 1030 at 87-89. In response, the Patent Owner amended the independent claims to recite “while performing the first work process, inputting a first command to sequentially display icons in turn corresponding to respective work processes of the mobile terminal.” *Id.* at 105-106. As explained by the patent owner, Kokubo failed to disclose “that icons are sequentially displayed in turn ***in response*** to a first command.” *Id.* at 109 (emphasis added). In the following Office Action, the Examiner acknowledged that “Kokubo does not teach wherein inputting a first command to sequentially highlight icons in turn is implemented as sequentially displaying icons in turn,” but rather “Kokubo simultaneously displays icons.” *Id.* at 140 (emphasis in original, citing Kokubo at FIG. 13, display 142).

FIG.13



Kokubo at FIG 13. Thus, there is a clear difference, as was recognized by the Examiner, between a display of icons that is “simultaneous” with the command at issue (as is the case with Paasonen and Kokubo), and a display of icons that is “in response to” the command at issue (as claimed). Petitioner merely reargues a teaching that was already found to be distinct by the Office.

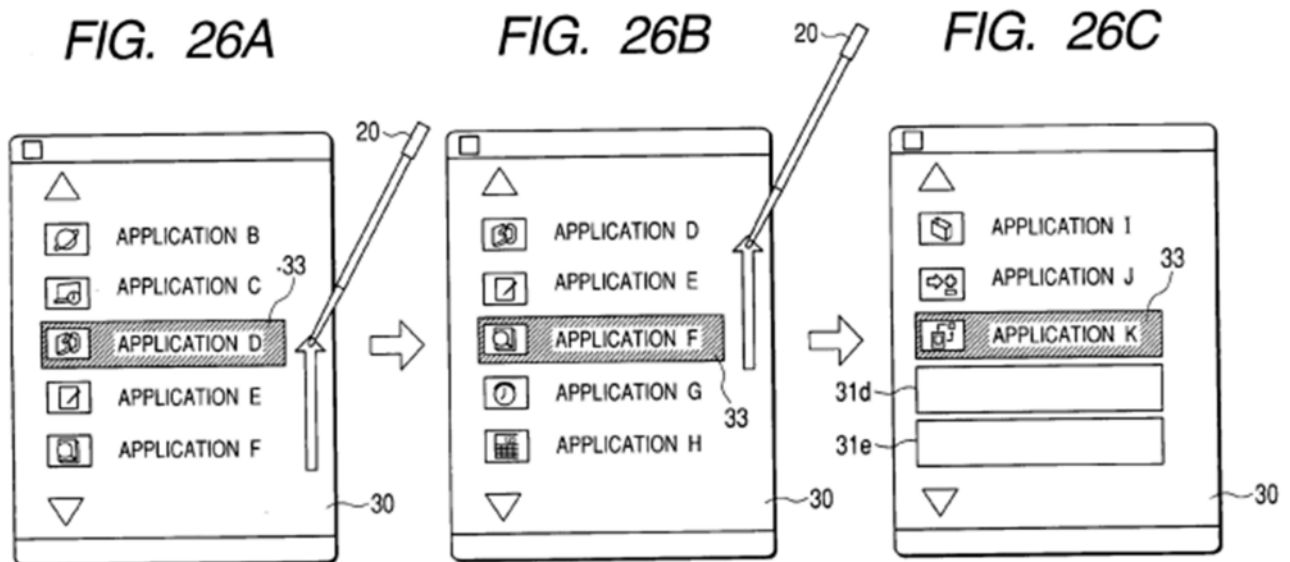
Accordingly, Petitioner has not demonstrated that Paasonen discloses limitation [1.c].

B. Ground 2: Petitioner Fails to Establish that Claims 1-10 are Obvious Over Paasonen in View of Nakano

Ground 2 differs from Ground 1 only in that Nakano is used for claim limitations [1.c], [8], and [9]. However, Nakano fails to cure the deficiencies of

Paasonen with respect to at least claim limitation [1.c], and therefore does not render obvious any of claims 1-10 of the '631 Patent.

For just one example, Petitioner fails to demonstrate that Nakano discloses displaying “an icon corresponding to the second work process” “in response to a first command,” as required by the claim language. While Nakano discloses “the concept of scrolling through menu display entities,” Nakano, [0303], Petitioner does not identify where or when an icon corresponding to the second work process is sequentially displayed in response to a first command—in fact, it is not. Nakano does not disclose the display of icons:



Nakano, FIGs. 26A, 26B, 26C. Rather, as can be easily seen, Nakano simply discloses scrolling through a menu of options in a set screen; its applicability to

Paasonen is minimal, and the specific proposed combination required to arrive at the claimed invention is far from obvious.

For these reasons, Paasonen in view of Nakano does not teach each and every element of Claims 1-10.

C. Grounds 3 and 4: Petitioner Fails to Establish that Claims 4 and 7 are Obvious Over Paasonen in View of Aaltonen or Aaltonen and Nakano

Grounds 3 and 4 relate only to dependent claims 4 and 7. For the reasons described above with regard to Grounds 1 and 2, Paasonen alone or in view of Nakano does not teach each and every limitation of independent claim 1, and accordingly Grounds 3 and 4 must fail for at least the same reasons.

D. Ground 5: Petitioner Fails to Establish that Claims 1-4 and 7 are Anticipated by Hotelling

Petitioner has not shown a likelihood of prevailing with respect to Ground 5 because Hotelling (the only reference relied upon) does not teach each and every element of Claims 1-4 and 7. Specifically, for the reasons described below, Hotelling (or at least Hotelling-Prov, which is the reference that allegedly predates the ‘631 Patent) fails to teach at least claim element [1.f]. As claims 2-10 each depend upon at least independent claim 1, Petitioner cannot show that Hotelling anticipates any of claims 1-10.

Limitation [1.f] recites “in response to a third command for activating a

control menu for controlling a predetermined function of the first work process, activating the control menu for controlling the predetermined function of the first work process.” Petitioner incorrectly asserts that Hotelling “discloses this element three ways” (*see* Pet. at 59-64), but each alleged teaching fails to meet the claim requirements, and in fact, Hotelling does not teach the activation of a control menu for controlling the predetermined function of the first work process.

Petitioner’s first proposal is that Hotelling’s alleged disclosure of “touching the ‘music player’ and ‘Cell Phone’ buttons simultaneously to enter a ‘split screen’ mode with a ‘music player’ GUI that includes ‘play/pause’ buttons to control music player functionality” means that Hotelling has disclosed a control menu.” Pet. at 60 (citing Hotelling-Prov 8:29-9:2, 15:1-15, 16:32-17:5, 20:9-21). This argument is incorrect because the alleged split screen mode (*i.e.*, dual mode) is not a control menu for controlling the predetermined function. Rather, the alleged split screen mode simply presents two full device GUIs side by side: a “first device GUI” and a “second device GUI” in a “reduced” form “to accommodate the [limited] space” but does not limit the functionality of the first device GUI or the second device GUI to

a predetermined function. Hotelling-Prov, 20:16-19;⁵ *see also* Ex. 2017 at 25 (explaining that a “predetermined function” is “a function among those selected in advance”). Furthermore, Hotelling-Prov discloses no figures for “split screen mode,” and there is no disclosure (as Petitioner argues) that the “virtual controls” will correspond to an application not being displayed (*see* Pet. at 60 n. 14)—Hotelling-Prov merely specifies that “controls in the control region 154” are “used to control whatever is being shown in the standard region 152.” Ex. 1010 at 17:3-6 (further noting that “[i]n some cases, the control region 154 may even change in accordance with the needs *of each displayed window* for the particular device.”) (emphasis added). There is nothing in Hotelling that a control menu controls a background application.

Petitioner’s second proposal is that the disclosures of Hotelling-521 (which is incorporated into Hotelling-Prov) “discloses touching the screen of the device to display ‘floating controls’ with preset ‘music listening control buttons’ including ‘play’ and ‘pause’ buttons for controlling the predetermined music play functions;

⁵ While Petitioner also cites to Hotelling for certain disclosures, these disclosures are found nowhere in Hotelling-Prov and thus not entitled to a priority date predating the ’631 Patent.

these ‘floating controls’ are a control menu.” Pet. at 60 (citing Hotelling-521, [0111]-[0113]). This argument is also flawed because it provides no support for how Hotelling-521 would be combined with Hotelling-Prov’s dual mode (which is otherwise the basis for Petitioner’s invalidity theory used for other claim elements). Moreover, even “virtual controls” (*i.e.*, the “floating controls”) are only disclosed as controlling the application otherwise on the screen. *See* Hotelling-Prov. at 17-7-9. Merely pointing to features in Hotelling-521 is insufficient. *See Hayward Indus., Inc. v. Pentair Water Pool & Spa, Inc.*, 814 F. App’x 592, 597 (Fed. Cir. 2020) (explaining that while a prior art reference “does not need to include an ‘express discussion of the actual combination to anticipate,’” it must at least “teach that the disclosed elements may be combined such that one of skill in the art could implement the combination” (citation omitted)). Moreover, the claim requires the activation of a control menu “in response to a third command,” and Petitioner fails to identify any third command in Hotelling-521 (or Hotelling-Prov).

Petitioner’s third and final proposal is that that “**Hotelling-521** discloses using a gesture to ‘invoke [a] virtual control knob’ to control ‘volume’ for a ‘currently playing’ ‘song,’ which is a ‘volume’ control menu.” Pet. at 60 (citing Hotelling-521, [0086]); *see* Hotelling-521, FIG. 6A. Again, Petitioner fails to provide support for how Hotelling-521 would be combined with Hotelling-Prov’s dual mode and fails

to identify the required third command.

As each of Petitioner's three theories fail, Petitioner has not demonstrated that Hotelling-Prov discloses limitation [1.f].

E. Grounds 6 and 7: Petitioner Fails to Establish that Claims 1-4 and 6-10 are Obvious Over Hotelling in View of Hellyar or Hellyar and Tu

Grounds 6 and 7 differ from Ground 5 only in that Hellyar and Tu are used for certain claim limitations, but not for claim element [1.f]. Accordingly, for the reasons that Ground 5 fails with respect to claim limitation [1.f] (and therefore all dependent claims), Grounds 6 and 7 fail as well.

VII. CONCLUSION

For at least the foregoing reasons, the Board should deny institution.

Case IPR2023-01268
Patent No. 9,575,631
Patent Owner Preliminary Response

Dated: January 29, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 29th day of January, 2024, a copy of the attached **PATENT OWNER PRELIMINARY RESPONSE** was served by electronic mail to the attorneys of record, at the following addresses:

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CERTIFICATION PURSUANT TO 37 C.F.R. § 42.24(d)

Pursuant 37 CFR 42.24(d), the undersigned certifies that this Preliminary Response complies with the type-volume limitation of 37 CFR §42.24(a). The word count application of the word processing program used to prepare this Preliminary Response indicates that the Preliminary Response contains 9,678 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

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