

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC, SAMSUNG ELECTRONICS CO. LTD.,
AND SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

MULTIMODAL MEDIA LLC,
Patent Owner.

IPR2024-00064
Patent 10,552,030 B2

Before NEIL T. POWELL, ARTHUR M. PESLAK, and
SCOTT RAEVSKY, *Administrative Patent Judges*.

RAEVSKY, *Administrative Patent Judge*.

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

I. INTRODUCTION

Google LLC, Samsung Electronics Co. Ltd., and Samsung Electronics America, Inc. (collectively, “Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–14 of U.S. Patent No. 10,552,030 B2 (Ex. 1001, “the ’030 patent”). Pet. 1. Multimodal Media LLC (“Patent Owner”) filed a Preliminary Response (Paper 8, “Prelim. Resp.”).

Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless it is determined that there is a reasonable likelihood that the petitioner would prevail with respect to at least one of the claims challenged in the petition. After considering the parties’ arguments and evidence, and for the reasons set forth below, Petitioner demonstrates a reasonable likelihood of prevailing with respect to at least one of the challenged claims of the ’030 patent. Accordingly, we institute an *inter partes* review with respect to all challenged claims and grounds asserted in the Petition. 37 C.F.R. § 42.108(a) (2022).

Our factual findings and conclusions at this stage of the proceeding are based on the evidentiary record developed thus far. This is not a final decision as to patentability of the challenged claims.

II. BACKGROUND

A. Related Matters

The parties identify the following infringement lawsuits involving the ’030 patent: *Multimodal Media LLC v. Samsung Electronics Co. Ltd., et al.*, No. 2:22-cv-00462 (E.D. Tex.) and *Multimodal Media LLC v. TCL Technology Group Corporation et al.*, No. 2:22-cv-00463 (E.D. Tex.) (collectively, the “District Court litigation”). Pet. 2; Paper 6, 2.

B. Real Parties-in-Interest

Petitioner identifies itself as the real parties-in-interest (RPI). Pet. 2.
Patent Owner identifies itself as the sole RPI. Paper 6, 2.

C. The '030 patent

The '030 patent describes a system for recording media data in one or more communication modes based on gestures on a graphical user interface (GUI) of an electronic device. Ex. 1001, code (57). A gesture-based media recording application provided on the electronic device defines multiple interface regions on the GUI. *Id.* The application detects a gesture on an interface region and performs a recording of the media data. *Id.* The application detects another gesture on the same or another interface region and performs a second action. *Id.* The first and second actions can include triggering recording of the media data, switching from one communication mode to another, canceling recording, generating and displaying multiple options, or the like. *Id.*

Figure 3A, reproduced below, depicts example GUI 302:

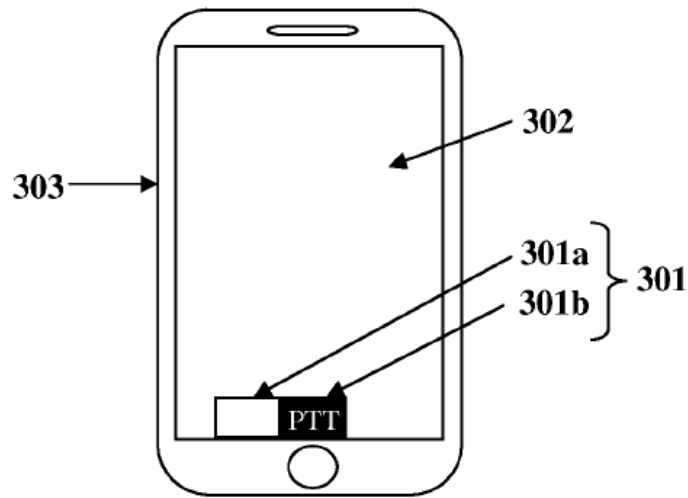


FIG. 3A

Id. at 10:48–49. Figure 3A depicts electronic device 303 having a touch sensitive display, which displays GUI 302. *Id.* at 10:48–52. Electronic device 303 is capable of recording and storing media data, such as audio data. *Id.* at 10:52–54. In the example shown, a push to talk (PTT) interface region 301b may be pressed and held to record audio data. *Id.* at 10:56–59. Interface region 301a is also shown, which has a new predefined function associated with it in response to a user pressing and holding PTT interface region 301b. *Id.* at 11:22–27.

Figure 3B shows an example new predefined function associated with interface region 301a:

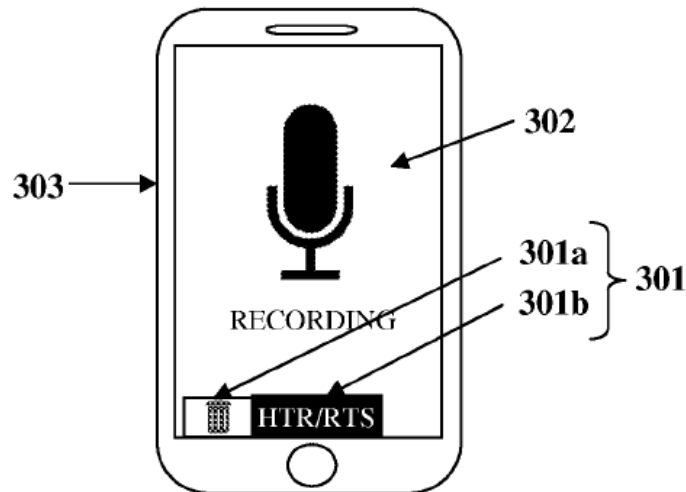


FIG. 3B

Id. at 11:24–27. In the example of Figure 3B, the predefined function associated with interface region 301a is to cancel and delete the current audio data that is being recorded. *Id.* at 11:27–30. The user can slide his or her finger from interface region 301b to interface region 301a and release the finger to execute the predefined cancel and delete function. *Id.* at 11:37–49.

D. Challenged Claims

Claim 1, below, is illustrative of the challenged claims. Petitioner's claim element labels are included for ease of reference.

1. [pre] A computer implemented method for recording media data, comprising:

[A] providing a gesture based media recording application executable by at least one processor configured to manage a graphical user

interface of an electronic device for said recording of media data in one or more recording modes on said electronic device;

[B] defining one or more interface regions on said graphical user interface of said electronic device by said gesture based media recording application;

[C] detecting a first gesture from among multiple gestures on a first of said defined interface regions, by said gesture based media recording application, wherein said first gesture is a press and hold gesture;

[D] starting said recording of media data in a push to talk (PTT) recording mode, by said gesture based media recording application, on said detection of said first gesture on said first of said defined interface regions;

[E] dynamically changing, by said gesture based media recording application, functions associated with said one or more defined interface regions based on said detected first gesture on said one of said defined interface regions; and

[F(i)] detecting a second gesture from among said multiple gestures, by said gesture based media recording application, wherein said second gesture is a slide and hold gesture, or a swipe and hold gesture from said first of said defined interface regions to a second of said defined interface regions proximate to said first of said defined interface regions, and

[F(ii)] wherein said recording of said media data continues uninterrupted during and after performance of said second gesture.

Ex. 1001, 22:63–23:27; *see* Pet. 17–31.

E. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability (Pet. 4–5):

Claim(s) Challenged	35 U.S.C. §¹	Reference(s)/Basis
1, 3–8, 10–14	103	Lee’041 ²
1, 3–8, 10–14	103	Lee’041, Ohashi ³
2, 9	103	Lee’041, Ohashi, Lee’804, ⁴ D’Souza ⁵

Petitioner also relies on the declaration of Dr. Benjamin B. Bederson (Ex. 1002). Patent Owner does not rely on declaration testimony at this stage.

III. ANALYSIS

A. Discretion under 35 U.S.C. § 314(a)

Patent Owner argues that we should exercise discretion under § 314(a) to deny institution in light of the District Court litigation. Prelim. Resp. 12–20.

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. §§ 102, 103 effective March 16, 2013. The ’949 patent claims priority to an application filed before March 16, 2013, so we preliminarily determine that the pre-AIA versions of §§ 102, 103 apply. Ex. 1001, code (60).

² U.S. Patent No. 8,812,041 B2 to Lee, issued Aug. 19, 2014 (Ex. 1014).

³ U.S. Publication No. 2012/0229410 A1 to Ohashi, published Sept. 13, 2012 (Ex. 1017).

⁴ U.S. Patent No. 8,948,804 B2 to Lee, issued Feb. 3, 2015 (Ex. 1015).

⁵ U.S. Publication No. 2012/0014684 A1 to D’Souza, published Jan. 19, 2012 (Ex. 1018).

We consider the following factors when determining whether to deny institution under § 314(a) based on a parallel district court proceeding:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”). We also consider “several clarifications” made by the Director of the United States Patent and Trademark Office (“USPTO”). See USPTO Memorandum, Interim Procedure for Discretionary Denials in AIA Post Grant Proceedings with Parallel District Court Litigation, 2 (June 21, 2022) (“Director’s Memo”).⁶

Patent Owner argues that we should exercise discretion to deny institution for several reasons. There is no stay in the litigation, Patent Owner asserts. Prelim. Resp. 16–17. Patent Owner also argues that the trial in the District Court litigation is scheduled for October 28, 2024, more than seven months before the projected statutory deadline here. *Id.* at 15 (citing Ex. 2001). Patent Owner further asserts that the parties’ investment in the

⁶ Available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf.

District Court litigation weighs in favor of discretionary denial because “discovery is well under way” and because the parties have exchanged infringement and invalidity contentions, among other investments. *Id.* at 16. Patent Owner also asserts that the District Court litigation involves the same claims. *Id.* at 14. Further, Patent Owner asserts that the District Court litigation and the Petition involve substantially the same parties. *Id.* at 13–14.

The Director’s Memo provides that “[c]onsistent with *Sotera Wireless, Inc.*,^[7] the PTAB will not discretionarily deny institution in view of parallel district court litigation where a petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have reasonably been raised before the PTAB.” Director’s Memo 3. With our authorization, Petitioner has filed a stipulation which stipulates that “[i]f the PTAB institutes the pending IPR in IPR2024-00064 . . . , then Samsung will not pursue as to the challenged claims any ground raised or that could have been reasonably raised in the IPR in the . . . district court Case 2:22-cv-00462-JRG-RSP.” Ex. 1082, 1.⁸

We determine that the language of this stipulation sufficiently comports with the language of the Director’s Memo, consistent with *Sotera Wireless, Inc.* See Director’s Memo 3. We accordingly decline to

⁷ *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18–19 (PTAB Dec. 1, 2020) (precedential).

⁸ Exhibit 1082 refers to Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. as “Samsung.” Ex. 1082, 1. The stipulation in Exhibit 1082 does not include Google, which is not a party to the District Court litigation. See Pet. 52; Prelim. Resp. 14.

discretionarily deny institution in view of the related District Court litigation.⁹

B. Principles of Law

A claim is unpatentable as obvious if “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). We resolve the question of obviousness based on underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the prior art and the claims; (3) the level of skill in the art; and (4) when in evidence, objective indicia of nonobviousness. *See Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966).

We apply these principles to the Petition’s challenges.

C. Level of Ordinary Skill in the Art

We review the grounds of unpatentability in view of the understanding of a person of ordinary skill in the art at the time of the invention. *Graham*, 383 U.S. at 13, 17. Petitioner asserts that

A person of ordinary skill in the art at the relevant time (“POSITA”) would have had a bachelor’s degree in electrical engineering, computer science, computer engineering, or a related field, and two-three years of experience with multimedia and touch interface technologies, or the equivalent, with additional education substituting for experience and vice versa.

⁹ Patent Owner urges us not to accept a “late” *Sotera* stipulation. Prelim. Resp. 18–19. We disagree that Petitioner’s *Sotera* stipulation is late. It is within our discretion to permit Petitioner to file a stipulation prior to institution. *See NXP USA, Inc. v. Impinj, Inc.*, IPR2021-01566, Paper 13 (PTAB Sept. 7, 2022) (precedential).

Pet. 7 (citing Ex. 1002 ¶¶ 28–30).

Patent Owner agrees with Petitioner’s proposed level of skill in the art at this stage. Prelim. Resp. 3. We are persuaded, on the present record, that Petitioner’s proposal is consistent with the problems and solutions in the ’030 patent and prior art of record. We adopt Petitioner’s definition of the level of skill for the purposes of this Decision.

D. Claim Construction

In *inter partes* review, we construe a claim using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. 37 C.F.R. § 42.100(b).

Petitioner construes the terms “interface regions,” “gesture,” “interface definition module,” “detection module,” and “action management module.” Pet. 8–10. Patent Owner agrees with some of these constructions and asserts that resolution of others are unnecessary at this stage. Prelim. Resp. 4–6. Because none of these terms are in dispute, none of these terms or any other terms require construction at this stage. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))). The parties are free to present any proposed construction of any claim term in subsequent briefing.

E. Asserted Obviousness over Lee'041

Petitioner contends that claims 1, 3–8, and 10–14 would have been obvious over Lee'041. Pet. 17–38.

1. *Overview of Lee'041*

Lee'041 describes a tap-to-end feature for unlocking a virtual slide-to-lock lock feature on a display screen of a communication device running a push-to-talk (PTT) application. Ex. 1014, code (57). The tap-to-end can be implemented by simply tapping the display screen or by contacting the display screen on the communication device running the PTT application for a predetermined period of time. *Id.*

Figure 2B of Lee'041 is shown below:

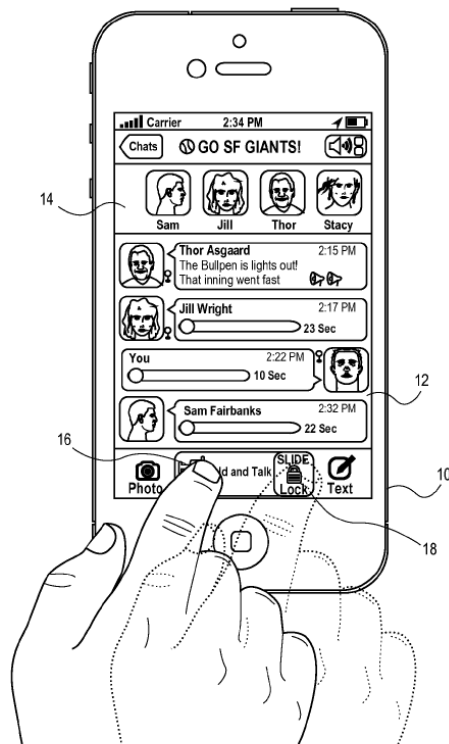


FIG. 2B

As shown in Figure 2B above, slide-to-lock feature 18 appears when hold to talk region 16 is contacted by a user. *Id.* at 3:33–35. When a sliding motion is detected on touch-sensitive display screen 12, it signifies selection of slide-to-lock feature 18. *Id.* at 3:40–42. As a result, the text displayed in region 16 changes from “Hold to Talk” to “Slide-to-Lock,” as illustrated in Figure 2C below:

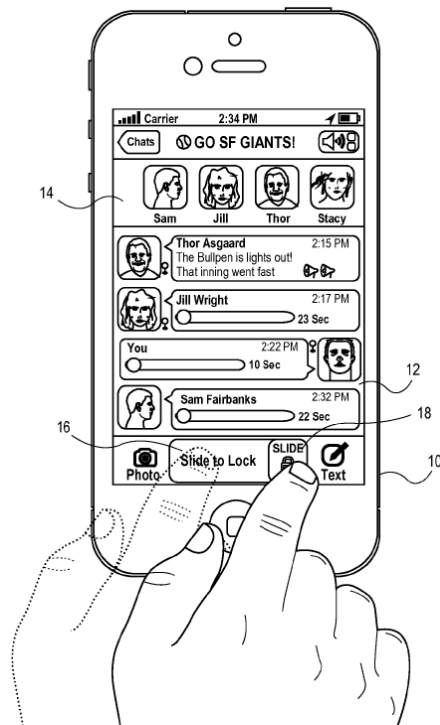


FIG. 2C

Id. at 3:42–44. Figure 2C above depicts the text “Slide to Lock” in region 16. *Id.* When slide-to-lock feature 18 is activated, it results in a PTT locking function so that the user no longer needs to select or hold region 16 and/or 18 while creating a message. *Id.* at 3:45–48.

2. Independent Claim 1

a. Undisputed limitations

Petitioner asserts that Lee’041 discloses the preamble and all the limitations of claim 1. Pet. 17–32. Petitioner identifies where Lee’041 teaches these limitations, supporting this showing with testimony from Dr. Bederson. *See id.* Apart from limitation [E], “dynamically changing, by said gesture based media recording application, functions associated with said one or more defined interface regions based on said detected first gesture on said one of said defined interface regions,” Patent Owner does not dispute Petitioner’s showing. *See* Prelim. Resp. 6–11.

We determine, on this record, that Lee’041 discloses the preamble (whether or not limiting) and all the limitations of claim 1, except that we specifically address limitation [E] in the next section. *See LG Elecs., Inc. v. Conversant Wireless Licensing S.A.R.L.*, 759 F. App’x 917, 925 (Fed. Cir. 2019) (nonprecedential) (“The Board is ‘not required to address undisputed matters’ or arguments about limitations with which it was never presented.”) (quoting *In re NuVasive, Inc.*, 841 F.3d 966, 974 (Fed. Cir. 2016)).

b. *1[E] dynamically changing, by said gesture based media recording application, functions associated with said one or more defined interface regions based on said detected first gesture on said one of said defined interface regions*

Petitioner contends that Lee’041 discloses limitation 1[E]. Pet. 27–28. Petitioner reproduces the following annotated versions of Lee’041’s Figures 2A and 2B:

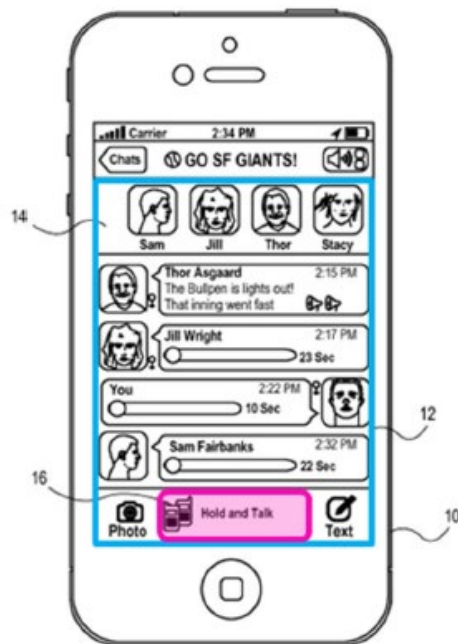


FIG. 2A

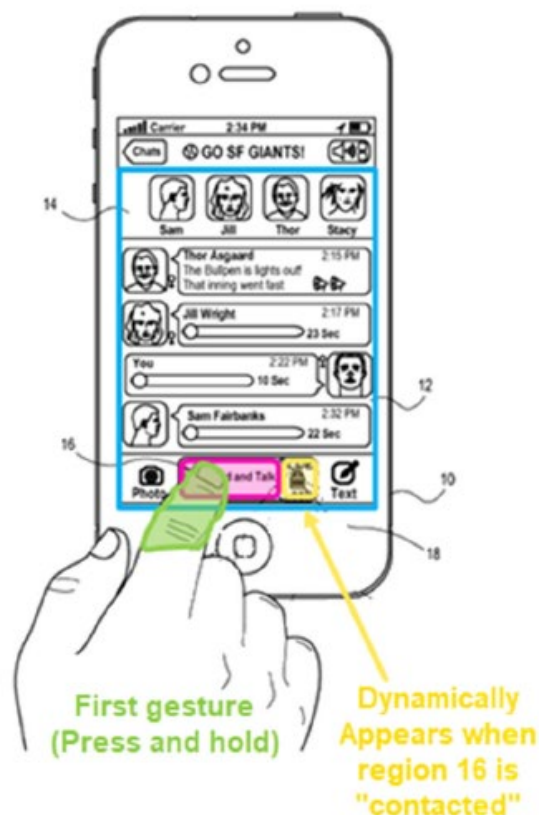
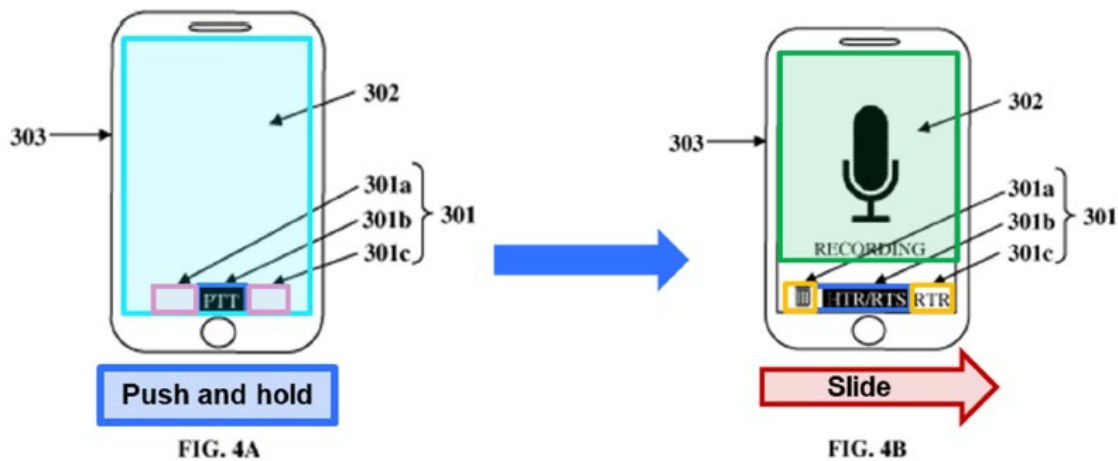


FIG. 2B

Id. at 27. Petitioner describes these figures as follows: “when the Hold-and-Talk region 16 (Fig. 2A (pink)) is pressed and held by the user’s finger (Fig. 2B (green)) (first gesture), a ‘Slide-to-Lock’ feature 18 dynamically appears on the display screen (yellow) *where a part of region 16 was previously.*”

Id. (citing Ex. 1014, 3:33–36) (emphasis added). Petitioner further asserts that a POSITA would have understood that Lee’041’s PTT application includes an interface definition module, which is a “software component” that performs the functionality of limitation 1[E] “because the text displayed on the GUI changes from a predefined ‘Hold-and-Talk’ function to a ‘Slide-to-Lock’ function for interface region 16 based on detection of a user’s finger.” *Id.* at 28 (citing Ex. 1002 ¶¶ 68–72, 112–113).

Petitioner also notes that Lee'041's functionality is similar to that disclosed in the '030 patent. *Id.* at 27–28 (citing Ex. 1001, 12:22–34, Figs. 4A–4B). For comparison, Petitioner reproduces the following annotated versions of Figures 4A and 4B of the '030 patent:



Id. at 28. Figures 4A and 4B illustrate three interface regions 301 on GUI 302 of electronic device 303. Ex. 1001, 11:59–61. Petitioner asserts that when a press and hold gesture is detected (in Figure 4A), the application “associates new predefined functions to” interface regions 301a, 301b, 301c, such as interface region 301b (in Figure 4B) for “hold to record (HTR)/release to stop (RTS).” *Id.*

After consideration of Patent Owner's arguments, which we address below, we agree with Petitioner that Lee'041 discloses limitation 1[E].

Patent Owner argues that Petitioner fails to show that the functions of the interface regions in Lee'041 are dynamically changed in response to a first gesture. Prelim. Resp. 6. Lee'041's dynamically appearing interface region does not disclose “*dynamically changing functions associated with said one or more defined interface regions,*” Patent Owner asserts, “because the function associated with each of the defined regions remains static.” *Id.*

at 8. That is, Patent Owner argues, Lee’041’s Slide-to-Lock feature 18 appears in Figure 2B when Hold to Talk region 16 is contacted, but “region 16 is always associated with the function ‘Hold to Talk’ and region 18 is always associated with the function ‘Slide to Lock.’” *Id.* (citing Ex. 1014, 3:33–35).¹⁰

At this stage, we disagree with Patent Owner. As we understand Lee’041, the defined interface regions do not remain static, as Patent Owner argues. Rather, we agree with Petitioner at this stage that Slide-to-Lock feature 18 dynamically appears on the display “where a part of region 16 was previously.” Pet. 27. As can be seen from Figures 2A and 2B of Lee’041, reproduced above, Hold to Talk region 16 covers a bottom portion of the screen (shown with Petitioner’s pink annotation). When Hold to Talk region 16 in Figure 2A is pressed and held by the user’s finger, Slide-to-Lock feature 18 appears (in Figure 2B) in a part of the same area of the screen as Hold to Talk 16 region was displayed. *See* Ex. 1014, 3:33–36; Figs. 2A–2B. Comparing these two figures, the region 16 for Hold to Talk in Figure 2A shrinks in size in Figure 2B to accommodate Slide-to-Lock feature 18. Thus, Patent Owner’s assertion that “the function associated with each of the defined regions remains static” overlooks that the function of part of the Hold to Talk region 16 is changed to be a Slide-to-Lock feature 18. *See* Prelim. Resp. 8.

¹⁰ Patent Owner refers to region 16 as “Hold to Talk” region 16, whereas Petitioner refers to this region as “Hold-and-Talk” region 16. *See* Pet. 27; Prelim. Resp. 8. Following the parties’ lead, we use these terms interchangeably in this decision.

Patent Owner further faults Petitioner for “compar[ing] the prior art to the disclosure in the [’030 patent] specification rather than the claim.” *Id.* at 6, 8–10. Patent Owner asserts that it is error to compare the prior to the specification rather than the challenged claims. *Id.* at 9. Also, Patent Owner asserts that Petitioner is using an embodiment to interpret the phrase “dynamically changing” without proffering a claim construction, which Patent Owner asserts is a failure of the petition requirements. *Id.* at 9–10 (citing 37 C.F.R. § 42.104(b)(3), (4)). Patent Owner further asserts that Petitioner misinterprets the ’030 patent specification because in Figure 4A, the defined interface regions “were blank (or PTT for the middle region), and after detection of the first gesture, new functions are associated with each.” *Id.* at 10.

We do not read the Petition to be arguing unpatentability by comparing Lee’041 to the specification instead of claim 1. Rather, we read the Petition to be arguing that Lee’041’s disclosure is similar to a disclosed embodiment that is encompassed by claim 1. *See* Pet. 27–28. We agree with Petitioner that Figures 4A and 4B of the ’030 patent are indeed similar to the functionality shown in Figures 2A and 2B of Lee’041. *See id.* In particular, one of the interface regions 301b in Figure 4A has a certain functionality (PTT) that has changed to a new functionality in Figure 4B (HTR/RTS). *See* Ex. 1001, 12:22–34. Lee’041 Figures 2A and 2B show a dynamic change of functionality for region 16 in a similar way. To the extent Patent Owner believes that claim 1 claims a different embodiment than is shown in Figures 4A and 4B, we invite Patent Owner to explain why at trial.

Regardless, we do not need to rely on Petitioner's comparison of the '030 patent specification with Lee'041 because for reasons we explain above, we are persuaded at this stage that Lee'041 discloses limitation 1[E]. We also find Patent Owner's argument that Petitioner failed to construe the claims as required by 37 C.F.R. § 42.104(b)(3), (4) unavailing because Petitioner proposes several claim constructions and asserts that all other terms should be given their plain and ordinary meaning. Pet. 8–10.

On this record, then, Lee'041 discloses limitation 1[E].

c. Summary as to Claim 1

Based on the preliminary record before us, Petitioner has shown a reasonable likelihood that claim 1 would have been obvious over Lee'041.

3. Independent Claim 8

Petitioner contends that independent claim 8 would have been obvious over Lee'041 for similar reasons as claim 1. Pet. 17–32. Patent Owner relies on the same arguments for claim 8 as it does for claim 1. Prelim. Resp. 10–11. On this record, for similar reasons as set forth above, we determine that Petitioner has shown a reasonable likelihood that claim 8 would have been obvious over Lee'041.

4. Dependent Claims 3–7 and 10–14

Petitioner contends that dependent claims 3–7 and 10–14 would have been obvious over Lee'041. Pet. 32–38. Patent Owner does not specifically contest these claims at this stage. We leave for trial the issue of whether Petitioner establishes that Lee'041 would have rendered obvious claims 3–7 and 10–14.

F. Remaining Challenges

Petitioner contends that claims 1–14 would have been obvious over various additional combinations of references. Pet. 39–51. Other than stating that these challenges fail for the same reason as Petitioner’s Lee’041 challenge, Patent Owner does not specifically contest these challenges at this stage. Prelim. Resp. 11. We leave for trial the issue of whether Petitioner establishes the unpatentability of claims 1–14 over the remaining challenges.

IV. CONCLUSION

At this stage of the proceeding, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing on its challenges as to at least one challenged claim. At this preliminary stage, we have not made a final determination as to the patentability of the challenged claims or any underlying factual and legal issues.

V. ORDER

It is, therefore,

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of all challenged claims of the ’030 patent is instituted with respect to all grounds of unpatentability set forth in the Petition; and

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

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Patent 10,552,030 B2

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