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Paper No. ____

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HP INC., DELL TECHNOLOGIES INC., DELL INC.,
ASUSTEK COMPUTER INC., and ASUS GLOBAL PTE. LTD.,
Petitioners,

v.

LITL LLC,
Patent Owner.

Case No. IPR2024-00404

Patent No. 8,624,844

PATENT OWNER'S RESPONSE

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2008	[No Author Listed], All-New Litl Webbook Debuts at 2010 CES. Cision. January 5, 2010. URL: https://www.prnewswire.com/newsreleases/all-new-litl-webbook-debuts-at-2010-ces-80716797.html [last accessed June 25, 2021]

Exhibit	Description
2009	David Pogue, Windows XP Home Edition: The Missing Manual, 2nd Edition
2010	David Pogue, Windows Vista: The Missing Manual, 1st edition, 2nd printing, published February 2007
2011	<i>Lenovo (United States) Inc. v. LiTL LLC</i> , IPR2021-00822, Paper 5 (July 28, 2021)
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2013	Merriam-Webster’s Collegiate Dictionary, Eleventh Edition, 2007
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2015	Webster’s New College Dictionary, Third Edition, 2008
2016	Microsoft Windows XP Tablet PC Edition, Tablet PC: An Overview, White Paper, June 2002
2017	Yardena Arar, Computerworld, Microsoft previews pen-based Windows XP variant at TechXNY, June 25, 2002
2018	Windows XP Tablet PC Edition: Product Information available at: https://download.microsoft.com/documents/australia/windows/Tablet_PC_ProductInfo.pdf
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2023	Bendre, Ritesh, “Neonode Airbar first impressions: This clever accessory adds touchscreen functionality to any non-touch laptop,” BGR India (July 25, 2017).
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2025	Saxena, Muskaan, “Touchscreen MacBooks could launch in the 'next few years' - but not before a significant iPad overhaul,” t-break Tech (June 3, 2024).
2026	Leung, Christopher, Handling Ambiguous User Input on Touchscreen Kiosks (June 2005)

I. INTRODUCTION

All of Petitioners' grounds rely on a combination including "Lane's computer running the XP Pro operating system as taught in Pogue" (Petition, 26) and rely on Lane's pen-based computing tablet that Petitioners allege describes a touchscreen. Petitioners rely on Lane's alleged touchscreen to meet the "navigation control" limitation recited by every Challenged Claim. But as Petitioners' expert admitted at deposition, there is no description in Pogue of operating system support for a touchscreen. Pogue never mentions touchscreens because the Windows XP Pro operating system described in Pogue did not support the operation of touchscreens. Lane's touchscreen would have been inoperative in all of Petitioners' combinations that include "Lane's computer running the XP Pro operating system as taught in Pogue." Petition, 26.

To establish obviousness, Petitioners needed to establish that a person of ordinary skill in the art ("POSA") would have combined Lane and Pogue in the manner alleged. But the Petition fails to explain why a POSA would have combined the Windows "XP Pro operating system as taught in Pogue" with Lane's computer when doing so would have rendered Lane's touchscreen inoperative. Petitioners' combinations that render Lane inoperative for its intended purpose fail to establish obviousness of any Challenged Claim.

To establish obviousness, Petitioners also needed to establish that a POSA would have reasonably expected success in combining Lane and Pogue in the manner alleged. But Petitioners fail to establish that a POSA would have reasonably expected Lane's touchscreen to be operable after Lane was modified to run "the XP Pro operating system as taught in Pogue" when Pogue never describes its operating system as supporting touchscreen operation. The Petition cites art disclosing touchscreens on computers running different *unidentified* operating systems. But POSAs would not have expected a touchscreen to be operable on Lane's computer "running the XP Pro operating system as taught in Pogue" simply because the touchscreen worked on Lane's computer when running a different operating system.

The Institution Decision preliminarily found that "[e]ven if Patent Owner is correct that Windows XP Pro did not include touchscreen support, that does not mean it would be beyond a skilled artisan's capability to *modify* Windows XP Pro or select a Windows XP version like the *Tablet PC Edition* that does include touchscreen support as well as the My Documents and My Pictures features on which Petitioner relies."¹ Paper 12, 16-17. Respectfully, that rationale cannot support a finding that Petitioners carried their burden for multiple reasons.

¹ All emphasis is added unless otherwise indicated.

First, Petitioners’ challenge must be evaluated based on the contents of the Petition, not upon what the Petitioners *could have* argued. *See SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018).

The Petition never alleged that a POSA would have modified “the XP Pro operating system as taught in Pogue” in any way and simply alleged that a POSA would have run it on Lane’s computer. Petition, 26. Thus, the Petition never even alleged that a POSA would have modified “the XP Pro operating system as taught in Pogue,” let alone *identify* any alleged modification that purportedly would have been made and submit *evidence* to establish a reason why a POSA would have made any such unidentified modification with a reasonable expectation of success.

Similarly, the Petition never argued that a POSA would have “select[ed] a Windows XP version like the Tablet PC Edition that does include touchscreen support.” Paper 12, 16-17. The operating system that the Petition alleged a POSA would have run on Lane’s computer is “the XP Pro operating system *as taught in Pogue*.” Petition, 26. By statute, Petitioners were limited to advancing grounds based “*only* on the basis of prior art consisting of patents or printed publications.” 35 U.S.C. § 311(b). And by rule the *Petition* was required (“must”) to identify “the patents or printed publications relied upon for each ground.” 37 C.F.R. § 42.104(b)(2). Any suggestion that Petitioners relied on a different version of

Windows XP that is not “the XP Pro operating system as taught in Pogue” is inconsistent with what the Petition argued. Petition, 26.

Second, the Petition could not have relied on a different version of Windows, a software update, or a driver that was not described by Pogue. The Petition’s grounds are based on Pogue, which is a book that Petitioners relied on as a printed publication. Petition, 16-17, 26 (relying on “the XP Pro operating system *as taught in Pogue*”). Any suggestion that Petitioners can rely on software that is not described in the “printed publication” relied on in the grounds fails because it violates the restrictions imposed by the patent statute and the rules on “content” the Petition must have. 35 U.S.C. § 311(b); 37 C.F.R. § 42.104(b)(2); *see also infra* § IV.D (citing cases where the Board rejects arguments from a petitioner based on features of a product that are not described in the prior art publication that is the basis of the grounds).

Third, Petitioners fail to establish that making Lane’s touchscreen work with “the XP Pro operating system as taught in Pogue” was something a POSA could have done without undue experimentation. Neither the Petition nor the expert declaration filed with it provided *any* explanation of how a POSA would have allegedly gone about trying to make Lane’s touchscreen work with “the XP Pro operating system as taught in Pogue.” At deposition, Petitioners’ expert alleged that a POSA would have used a driver. But Lane does not describe a driver and

does not describe any operating system that Lane runs that supports that (unidentified) driver. Lane provided no guidance whatsoever to a POSA about *how* to write a driver that would support Lane’s touchscreen and work with “the XP Pro operating system as taught in Pogue.” Patent Owner (LiTL)’s expert explains that this would have been far beyond the skill of a POSA under Petition’s own POSA definition. Petition, 7.

Petitioners allege that a POSA would have had “experience in the design and architecture of laptop computers and other portable electronic devices” and only “been *familiar* [with] ... designs of user interfaces employed and displayed by computer operating systems and their organization of content and functionality.” Petition, 7. Even if the POSA had a degree in computer science, Petitioners do not allege that the POSA had the coding experience necessary for the complicated task of writing a touchscreen driver for “the XP Pro operating system as taught in Pogue” when Microsoft provided no support in that operating system for a touchscreen. A POSA would not have reasonably expected to succeed if they had tried to make Lane’s touchscreen work after modifying Lane to run “the XP Pro operating system as taught in Pogue.” *Kinaxis v. Blue Yonder Grp.*, IPR2021-01205, Paper 16, 23 (Jan. 19, 2022) (no obviousness where the alleged modification was “*not within the level of skill of a POSA proposed by Petitioner*”).

To establish a prima facie case of obviousness, the Petition needed to submit evidence establishing both a reason to combine Lane and Pogue and a reasonable expectation of success in combining them in the manner alleged. The Petition failed to do so, which is something that cannot be remedied in reply. 2019 Trial Practice Guide at 74 (“‘Respond,’ in the context of 37 C.F.R. § 42.23(b), does not mean proceed in a new direction with a new approach as compared to the positions taken in a prior filing” and “*a reply or sur-reply that raises a new issue or belatedly presents evidence may not be considered.*”). Petitioners failed to carry their burden for any Challenged Claim. The Board should thus confirm the patentability of all Challenged Claims for that reason alone.

The Grounds also fail for claims 1, 3-4, 7-9, 18, and 22 because even if a POSA would have made the Petition’s combinations, they fail to disclose a navigation control that is disposed about, or is rotatable about, the longitudinal axis of the computer as recited in those claims.

II. THE ’844 PATENT

Before the LiTL Webbook, “home computers were essentially the same as office computers,” and home users “struggle[d] with complex interfaces designed in pre-web times.” EX2001, 1. LiTL worked for years to develop its Webbook. LiTL recruited leading user experience design (“UXD”) experts and worked closely with some of the world’s leading technology and UXD consultancies. *Id.*,

1-2. This design effort led to the filing of provisional application no. 61/041,365 on April 1, 2008, to which the '844 Patent claims priority. EX1001, 1.

The '844 Patent discloses and claims a portable computer configurable between a plurality of display modes (*e.g.*, “a closed mode, a laptop mode, an easel mode, a flat mode and a frame mode.”). EX1001, 2:19-22. The computer’s keyboard is not easily accessible to the user in some of these configurations. *See e.g., id.*, Figs. 4-6 and 26. To address that, LiTL developed a novel navigation control (scroll wheel 132) that is disposed about the longitudinal axis between the base and display components, so it is accessible to the user in all the computer’s various configurations. *See e.g., id.*, Figs. 4, 7B, and 15 (reproduced below).

“[T]he portable computer may include integrated ‘navigation’ hardware that allows a user to easily and comfortabl[y] control various features and functions of the portable computer, and to manipulate content displayed on the portable computer. For example, [] scroll wheel **132** [] allows a user to control, adjust and/or select various functionality of the portable computer [and] may be used to provide ‘hardware navigation’ through information, such as menus, icons, etc., displayed on the display screen **110**.” *Id.*, 10:54-64; *see also id.*, 11:5-10 (“navigation may be performed using [] scroll wheel **132**”). The user can rotate scroll wheel 132 relative to the base to control various functionality of the computer.

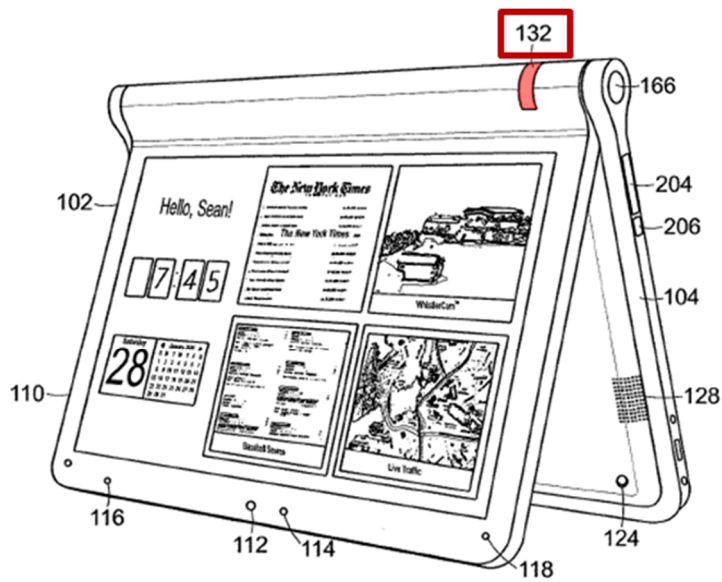


FIG. 4



FIG. 15

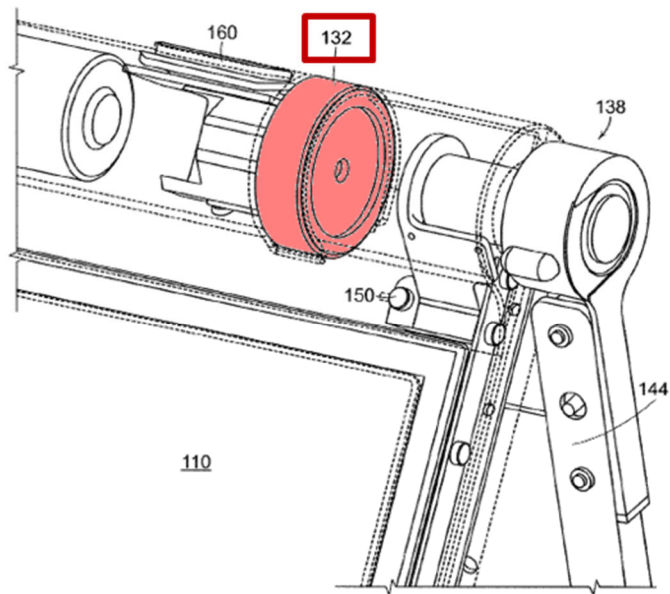


FIG. 7B

Id., Figs. 4, 7B, and 15 (annotated).

A. Challenged Claims

The Petition challenged claims 1, 3, 4, 7-10, 13, 14, 16-18, and 22 of the '844 Patent (“Challenged Claims”), including independent claims 1, 10 and 18. Petition, 1. Claim 1 recites a portable computer having a base and display that are “rotatable with respect to one another about a longitudinal axis” and “a navigation control disposed at least partially within the base and *rotatable about the longitudinal axis*.” Claim 10 recites “a navigation control *accessible in each of the plurality of display modes*.” Both claims 1 and 10 require that the claimed navigation control be “*configured to permit a user to [control/manipulate]* at least one of operating parameters of the portable computer and the content displayed.” Claim 18 recites “a navigation control disposed at least partially *about the longitudinal axis*.” These limitations are supported in the '844 Patent specification by the scroll wheel 132 which is a navigation control that is disposed at least partially within the base, is disposed about the longitudinal axis, is rotatable relative to the base about the longitudinal axis, and is both accessible and functional in each of the display modes to manipulate operating parameters and the content displayed. *Id.*, 10:54-64, 11:5-10, Figs. 4, 7B, and 15; EX2021 (“Walker”) ¶39.

B. The Challenged Claims Cover LiTL’s Webbook

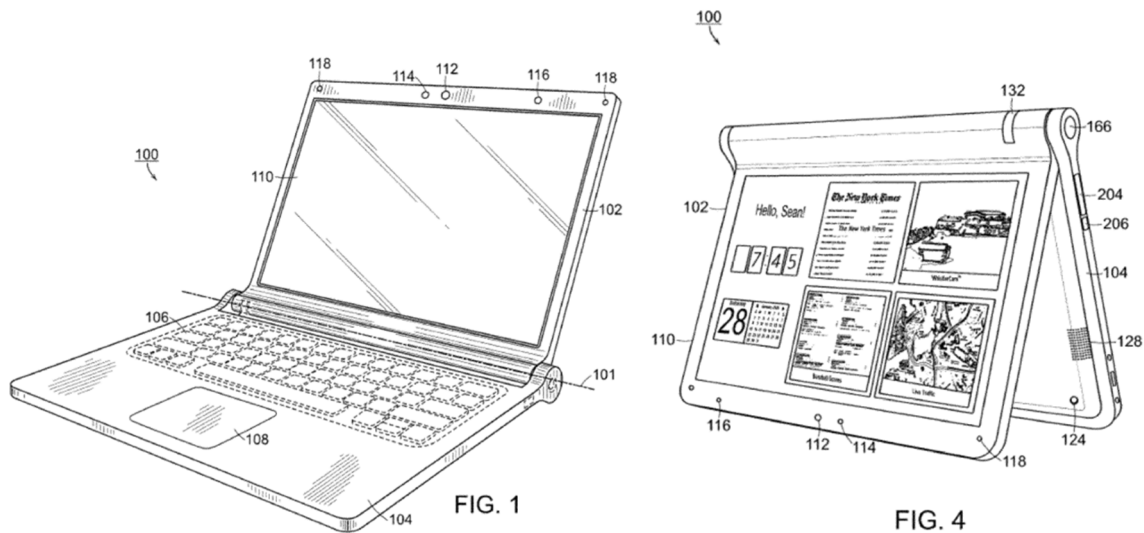
LiTL launched its Webbook in November 2009. EX2002, 1. The LiTL Webbook is nearly indistinguishable from the figures in the '844 Patent:

LiTL Webbook



EX2001, 1.

'844 Patent Figures 1 & 4

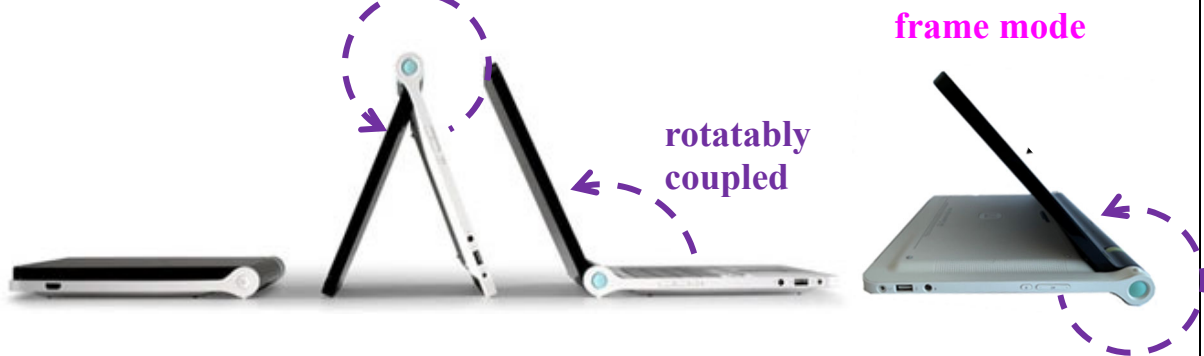


The Challenged Claims read on the LiTL Webbook. Walker ¶41. This is demonstrated below using claim 1 as an example and adopting the Petition's claim limitation labels:

[1pre] A portable computer configurable between a plurality of display modes including a **laptop mode** and an **easel mode** ... comprising:



[1b] a main display component **rotatably coupled** to the base ... about a **longitudinal axis** running along an interface between the main display component and the base ..., wherein



[1c] the **laptop mode** is configured to display ... a **first content mode** ...;

[1d] the **easel mode** is configured to display ... a **second content mode** ...; and

[1e] a **navigation control** ... rotatable about the longitudinal axis, ... configured to permit a user to control at least one of operating parameters of the portable computer and content displayed wherein the plurality of modes includes a **frame mode**....

See e.g., EX2003, 2; Petition, ix (claim labels); Walker ¶41. Independent claims 10 and 18 similarly read on the LiTL Webbook as well. Walker ¶41.

C. Claimed Aspects of LiTL’s Webbook Received Contemporaneous Praise

Industry publications lavished praise on aspects of the LiTL Webbook claimed by the ’844 Patent, including integrated navigation controls and the ability to convert between notebook and easel modes. For example, an August 2010 product review touted the LiTL Webbook’s “[p]atented *hinge to convert to easel mode*,” its “[b]uilt-in scroll wheel for easy navigation,” and its “[f]ull-sized keyboard.” EX2005, 4. An article covering the 2010 Consumer Electronics Show stated, “[t]he all new webbook boasts of a *highly innovative convertible design* that allows for the display to be flipped over and viewed as a standalone screen.” EX2004, 1. A November 2009 article stated, “[p]hysically, *it looks exciting*, toting a 12.1-inch display that can open past 180 degrees, allowing you to *prop it on a table like an overpowered LCD frame*.” EX2002, 2. A December 2009 ABC News report titled “Litl Webbook Re-Defines Computing” highlighted “two interesting display options that set it apart from traditional laptops” including one in which the “screen flips around into *easel mode* allowing the full 12-inch screen to display ... anything ... while hiding the keyboard.” EX2006, 2. Other 2009-2010 articles also recognized the innovative claimed features of the LiTL Webbook. EX2001, 1; EX2003, 1, 3; EX2007, 1-2; EX2008, 1.

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

For purposes of this Response only, LiTL does not challenge Petitioners’ POSA definition (Petition, 7) because the Petition fails to demonstrate unpatentability even under that definition.

IV. GROUND 1 FAILS

Ground 1 fails for two independent reasons for all Challenged Claims and for a third independent reason for claims 1, 3-4, 7-9, 18, and 22.

First, Ground 1 fails for all claims because the Petition failed to establish that a POSA would have made Petitioners’ Ground 1 combination which relies on “Lane’s computer running the XP Pro operating system as taught in Pogue.”

Petition, 26. Lane discloses pen-based computing, which Petitioners allege is a touchscreen. Petition, 29. But Pogue never breathes a word about the disclosed operating system supporting touchscreen operation. Pogue itself cautions against using Windows XP Pro as the operating system if the computer has incompatible hardware, and the Petition is bereft of any evidence that Lane’s touchscreen was compatible with Pogue’s Windows XP Pro. Indeed, as explained by LiTL’s expert, Dr. Martin Walker, a POSA would have known that running Pogue’s Windows XP Pro on a computer with a touchscreen would have rendered that touchscreen inoperative. Walker ¶¶57, 65. Petitioners fail to establish that POSAs would have been motivated to run Pogue’s Windows XP Pro operating system on

Lane's computer despite knowing that this would have rendered Lane's touchscreen inoperative, and thus fail to establish that a POSA would have combined Lane and Pogue. Ground 1 fails for this reason alone. *See infra* §IV.A.

Second, Ground 1 fails because the Petition failed to establish that POSAs would have had a reasonable expectation that running Pogue's Windows XP Pro with Lane's computer would have resulted in an operational touchscreen, as the Petition alleges. Petitioners cite Pogue, Lane, Shimano, and Kurtenbach as allegedly supporting an expectation of success, but Pogue never mentions the ability of its Windows XP Pro operating system to support the operation of a touchscreen. POSAs would not have expected Lane's touchscreen to be operational on "Lane's computer running the XP Pro operating system as taught in Pogue"—Ground 1's combination (Petition, 26)—even if the touchscreen worked when Lane's computer ran some different *unidentified* operating system. Petitioners' failure to establish that POSAs would have reasonably expected Lane's touchscreen to be operational when Lane's computer runs the XP Pro operating system as taught in Pogue is a second independent reason Ground 1 fails. *See infra* §IV.B.

Finally, Ground 1 additionally fails for independent claims 1 and 18 and their dependent claims because Lane does not disclose a navigation control that is

disposed about, or is rotatable about, the longitudinal axis of the computer as required by those claims. *See infra* §§IV.E-F.

A. The Petition Failed to Establish that POSAs Would Have Run the XP Pro Operating System Taught in Pogue on Lane’s Pen-Based Computer

The Petition’s alleged Ground 1 combination was “Lane’s computer running the [Windows] XP Pro operating system *as taught in Pogue*.” Petition, 26.

Lane discloses a “pen-based computing tablet.” EX1006, 3:13-14; *see also id.*, 8:18-19 (“a tablet for pen-based computing”), 10:20 (same). Petitioners argued that Lane’s pen-based input was a “touchscreen or equivalent.” Petition, 29. The Petition alleged that Lane’s “touchscreen and pen-based computing would be operable in all configurations of the computer 10.” *Id.*, 29, 48.

Pogue nowhere discloses support for a touchscreen. Walker ¶¶64.

Petitioners’ own expert admitted as much. EX2020, 42:18-21. LiTL’s expert, Dr. Martin Walker, explained that POSAs would not have made Petitioner’s combination that runs the XP Pro operating system as taught in Pogue on Lane’s computer because POSAs would have known that doing so would have rendered Lane’s pen-based computing inoperative. Walker ¶¶69-70.

The Federal Circuit has repeatedly made clear that a combination that renders the primary reference inoperable for its intended purpose is not one a POSA would have made. *See e.g., Trivasular v. Samuels*, 812 F.3d 1056, 1068

(Fed. Cir. 2016) (affirming the Board’s finding that a POSA would not have replaced barbs in a primary reference with gripping protuberances from a secondary reference because the modification “would *destroy the basic objective* of the barbs, which is to penetrate surrounding tissue”); *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984) (reversing the Board’s determination of obviousness where the modification to the primary reference that turned it upside down as needed to meet the claim would have *rendered the primary reference “inoperable for its intended purpose”*).

Petitioners and their expert entirely ignored the question of whether the operating system described in Pogue supported a touchscreen. Thus, Petitioners cited no evidence establishing that POSAs would have been motivated to make Petitioners’ combination of “Lane’s computer running the XP Pro operating system as taught in Pogue” (Petition, 26) knowing it would have rendered Lane’s touchscreen inoperative. Having failed to establish with evidence that a POSA would have made the Lane-Pogue combination that Ground 1 relies on—“Lane’s computer running the XP Pro operating system as taught in Pogue” (Petition, 26)—Ground 1 fails.

1. Pogue Does Not Describe Windows XP Pro as Supporting Touchscreens

Pogue never describes the Windows XP Pro operating system as supporting a touchscreen. Walker ¶61. Pogue explains that “*drivers* ... [are] controlling

software required by every hardware component of a PC.” EX1007 (“Pogue”), 23 (emphasis original).² Drivers are required for the computer’s “mouse, keyboard, screen, CD-ROM drive, scanner, digital camera, palmtop.” *Id.* “***Without the correct driver software, the corresponding piece of equipment doesn’t work at all***.” *Id.*; Walker ¶61. A POSA understood that a touchscreen is a type of “hardware component” “equipment” that Pogue says “doesn’t work all” “without the correct driver software.” Pogue, 23; Walker ¶61.

“Windows XP [came] with drivers for over 12,000 components.” Pogue, 23. Pogue does not disclose that a touchscreen driver was among them. Walker ¶62. For example, Pogue discloses a mouse as among the hardware components Windows XP Pro provided a driver for. Pogue, 23, 296 (“mouse, or its driver”); Walker ¶62. Pogue discloses how to use the mouse to manipulate operating parameters and the content displayed, to cut and copy content displayed, and to change the sharing and security settings of a folder. Pogue, 19; Walker ¶62. Pogue discloses a keyboard as another hardware component that Windows XP Pro provided a driver for. Pogue, 23; Walker ¶62. Pogue discloses how to use the keyboard to manipulate operating parameters and the content displayed and to cut and copy displayed content. Pogue, 21 (“You can use the keyboard for

² Citations throughout this paper refer to applied, not native, page numbers.

everything” such as “how you might print two copies of a document without using the mouse.”), 171; Walker ¶62.

In stark contrast to other hardware components like a mouse and keyboard, Pogue never mentions a touchscreen. Walker ¶62. Petitioners’ expert admitted this. EX2020, 42:18-21 (“Q. Pogue doesn’t use the word touch screen; is that right? A. I don’t recall Pogue using the word touch screen.”).

POSAs would not have understood Pogue to describe its operating system as supporting a touchscreen. Walker ¶64. A POSA would have understood that Pogue does not describe that its drivers for the mouse and touchpad would have supported a touchscreen. For a mouse and touchpad (which is different than a touchscreen), “the movement of the input pointer corresponds to the *relative* movements of the user’s finger” on the touchpad or the relative movement of the mouse. EX1020, ¶[0009]; Walker ¶64. In contrast, “[w]hen using a touch screen, a user makes a selection on the display screen by pointing *directly* to GUI objects on the screen (usually with a stylus or finger).” EX1020, ¶[0009]; Walker ¶64. Pogue says the Windows XP Pro operating system was capable of tracking the *relative* movements from the input of a mouse. Walker ¶64; Pogue, 38 (“[a]s you move your mouse pointer...”), 44 (“keeping the mouse still”), 218 (“dragging the mouse”), 283 (“Moving the mouse is the best way to get rid of a screen saver. A mouse click ... could trigger an action you didn’t intend.”). Indeed, Pogue

discloses the ability to change the ratio of the movement of the mouse to the movement of the pointer. Walker ¶64; Pogue, 295 (“you can set things up so that moving the mouse one *millimeter* moves the pointer one full *inch*—or vice versa”). Pogue never discloses that Windows XP Pro supported a driver to interpret inputs of user gestures on a touchscreen. Walker ¶64.

Any functionality of the Windows XP Pro **product** that is not disclosed by Pogue cannot save Petitioners because the grounds are based on the disclosure in Pogue’s printed publication. *See infra* Section IV.D (citing authority). But even if the Board were to (improperly) consider features of the Windows XP Pro product, it would not save Ground 1 because the product described by Pogue did not include support for a touchscreen. Walker ¶65. As Dr. Walker explains, “Windows XP Pro never did include support for a touchscreen,” “there was never an update or patch that allowed Windows XP Pro to support the operation of a touchscreen” and “Microsoft never made a driver that allowed Windows XP Pro to support the operation of a touchscreen.” *Id.* Dr. Walker knows from personal experience that “running the Windows XP Pro operating system on a computer with a touchscreen would result in the touchscreen being non-functional.” *Id.*

In sum, Pogue never mentions a touchscreen, unlike other input devices like a mouse or keyboard, that were supported by the version of Windows XP Pro disclosed by Pogue. “[T]he version of Windows XP Pro **disclosed by Pogue**” that

runs on Lane's computer in Petitioners' Ground 1 combination (Petition, 26) did not support a touchscreen. Walker ¶66.

2. The Petition Failed to Establish that POSAs Would Have Combined Pogue's Operating System With Lane's Pen-Based Computer When Pogue's Operating System Did Not Support Lane's Pen-Based Computing

The Petition alleges POSAs would have run "the XP Pro operating system as taught in Pogue" on Lane's pen-based computer because Lane "does not specify an operating system" and "market forces" dictated the selection of Pogue's Windows XP Pro as "the most widely used operating system." Petition, 25-26. The Petition's analysis fails to address why POSAs would have used Pogue's Windows XP Pro as the operating system just because it was the most popular when Pogue cautions against using Windows XP Pro for computers with incompatible hardware like Lane's touchscreen. Pogue, 645-46 ("***Before you even buy a copy of Windows XP***, your first order of business should be to ***check your computer against the list of hardware requirements*** for Windows XP, as published by Microsoft" which includes a "***compatible*** pointing device.")).

Petitioners were well aware that simply pointing out that Windows XP Pro was popular was not enough and that Petitioner needed to show that it was suitable for use on Lane's computer. For example, it would have made ***no*** sense to load Windows XP if Lane had disclosed a Mac computer because a Windows operating system would not be compatible on a Mac computer. Walker ¶80. Petitioners

alleged that “[a] POSITA would have had a reasonable expectation of success in making this combination as Windows XP Pro was widely used and *explicitly specified minimum and recommended hardware requirements*. Pogue, 632. A POSITA would have been motivated to *configure Lane’s laptop to satisfy these requirements* because the ability to run Windows operating systems would have been viewed as necessary for commercial acceptance of such a portable computer.” Petition, 26.

Petitioners’ above-quoted reasonable expectation of success analysis was facially deficient because it only focused on whether Lane had the “requirements” to work with Pogue’s operating system but totally ignored whether the converse was true and whether Pogue’s operating system had the requirements necessary to allow Lane’s “pen-based computing tablet” to function as Lane intended. EX1006, 3:13-14; *see also id.*, 8:18-19 (“a tablet for pen-based computing”), 10:20 (same).

Petitioners argued that Lane’s pen-based input was a “touchscreen or equivalent.” Petition, 29. And the Petition alleged that in Ground 1’s Lane-Pogue combination, Lane’s “touchscreen and pen-based computing would be operable in all configurations of the computer 10.” Petition, 29, 48. The Petition overlooked that when choosing an operating system for Lane’s computer, POSAs would have chosen an operating system that supported the operation of Lane’s touchscreen. Walker ¶67.

POSAs would not have selected “the XP Pro operating system as taught in Pogue” as the operating system for Lane’s pen-based computer because, as explained in Section IV.A.1, *supra*, Pogue does not teach that the operating system it describes supported touchscreen operation and, in fact, it did not. *See also* Walker ¶69. If “the XP Pro operating system as taught in Pogue” had been run on Lane’s computer as Petitioners allege (Petition, 26), Lane’s pen-based input device would have been inoperative. Walker ¶69. POSAs would not have expected that running Pogue’s operating system on Lane’s computer would have successfully resulted in a computer with an operable touchscreen because Pogue never mentions a touchscreen as a supported input device despite explaining in detail how other input devices like a mouse and a keyboard interacted with the Windows XP Pro operating system. *Id.* (citing Pogue, 19, 21, 23, 38, 44, 140, 218, 283, 295). Petitioners’ expert admitted that Pogue never mentions a touchscreen. EX2020, 42:18-21.

Pogue cautions that “[b]efore you even buy a copy of Windows XP, your first order of business should be to check your computer against the list of hardware requirements for Windows XP, as published by Microsoft.” Pogue, 645-46. That list includes a computer with a “[k]eyboard and Microsoft mouse or compatible pointing device.” *Id.* Petitioners never even alleges that Lane’s touchscreen was a compatible pointing device, let alone cite evidence to support

such an allegation. Walker ¶70. Indeed, Lane’s touchscreen was not a pointing device compatible with Pogue’s operating system. *See* § IV.A.1, *supra*; Walker ¶70.

POSAs would not have selected “the XP Pro operating system as taught in Pogue” (Petition, 26) as the operating system for Lane’s pen-based computer because doing so would have rendered Lane’s pen-input device inoperative. *Trivasular*, 812 F.3d at 1068; *In re Gordon*, 733 F.2d at 902; Walker ¶70.

3. Petitioners Never Alleged that a POSA Would Have Modified Pogue’s Operating System to Support Lane’s Touchscreen or Chosen a Different Windows XP Version

The Institution Decision preliminarily found that “[e]ven if Patent Owner is correct that Windows XP Pro did not include touchscreen support, that does not mean it would be beyond a skilled artisan’s capability to *modify* Windows XP Pro or select a Windows XP version like the *Tablet PC Edition* that does include touchscreen support.” Paper 12, 16-17. Neither assertion can support a finding that Petitioners carried their burden because Petitioners did not make either argument. *See infra* § IV.C (citing authority that the Board must resolve the case based on the Petition’s arguments).

The Petition never alleged that a POSA would have *modified* “the XP Pro operating system as taught in Pogue” in any way and simply alleged that a POSA would have run it on Lane’s computer. Petition, 26. *Petitioners’ expert admitted*

he did not suggest any modifications. EX2020, 82:7-17 (“Q. In your declaration, you don’t state that there’s any modifications that would have been required to Pogue’s Windows XP Pro in order for it to support the operation of touch screens; right? A. Correct.”). The Petition never even alleged that a POSA would have modified “the XP Pro operating system as taught in Pogue,” let alone *identify* some alleged modification that purportedly would have been made and provide *evidence* establishing that a POSA would have made any such unidentified modification with a reasonable expectation of success. *Pers. WebTechs. v. Apple*, 848 F.3d 987, 994 (Fed. Cir. 2017) (“[A] *prerequisite* to adequately explaining and supporting a conclusion” of obviousness is “a clear, evidence-supported account of the contemplated workings of the combination.”).

The Petition also never argued that a POSA would have “select[ed] a Windows XP version like the Tablet PC Edition that does include touchscreen support.” Paper 12, 16-17. Petitioners were limited to advancing grounds based “*only* on the basis of prior art consisting of patents or printed publications.” 35 U.S.C. § 311(b). The *Petition* was required (“must”) to identify “the patents or printed publications relied upon for each ground.” 37 C.F.R. § 42.104(b)(2). The Petition relied on Pogue’s printed publication. Petition, 16-17. Petitioners did not rely on a different version of Windows XP than what Pogue describes. Petition, 26 (“the XP Pro operating system *as taught in Pogue*.”).

At deposition, Dr. Wolfe belatedly testified for the first time that “[t]he user or manufacturer would have provided a driver, just like they do for every other piece of hardware in the system.” EX2020, 82:7-17. But neither his declaration (EX1002) nor the Petition cited any evidence that any driver existed that would have allowed Lane’s touchscreen to operate if Lane’s computer ran “the XP Pro operating system *as taught in Pogue*.” Petition, 26. Petitioners cannot make their case by belatedly alleging that some unidentified driver existed—that is not described in any patent or printed publication or cited anywhere in the Petition—that a POSA allegedly would have used.

Ground 1’s combination was “Lane’s computer running the XP Pro operating system *as taught in Pogue*.” Petition, 26. Pogue did not disclose support for an operational touchscreen. Walker ¶69; EX2020, 42:18-21 (Petitioners’ expert admitted Pogue does not mention a touch screen). Petitioners cite no other evidence that would cause a POSA to see a disclosure of touchscreen support in Pogue. Walker ¶72. And it would be outside the scope of an IPR for Petitioners to rely on some unnamed product driver to fill the gap. *See infra* § IV.D (citing authority).

Ground 1 is based on running “the XP Pro operating system *as taught in Pogue*” on Lane’s computer. Petition, 26. Petitioners failed to show that POSAs would have picked Pogue’s operating system for Lane’s pen-based computing

given that it would have rendered Lane’s pen-based input inoperative. Walker ¶73; *Trivasular*, 812 F.3d at 1068; *In re Gordon*, 733 F.2d at 902. Petitioners chose the basis of their Grounds and must live with the consequences. That Petitioner *might have* chosen to argue some modification to Pogue’s operating system or *could have* alleged that a POSA would have selected a different operating system cannot save Ground 1. *See infra* § IV.C (citing authority).

4. The Petition’s Hindsight Combination that Renders Lane’s Touchscreen Inoperable Fails to Establish Obviousness

Petitioner’s hindsight combination that destroys Lane’s ability to support pen-based computing fails to establish obviousness. *See e.g., Henny Penny v. Frymaster*, 938 F.3d 1324, 1331-32 (Fed. Cir. 2019); *Medtronic v. Teleflex Innovations*, 69 F.4th 1341, 1349 (Fed. Cir. 2023) (affirming a Board decision rejecting obviousness arguments: “We did not hold, however, that a proposed modification’s destruction of a device’s primary purpose is always legally irrelevant to obviousness. Such a conclusion is equally at odds with common sense and gives in to the very hindsight bias the obviousness inquiry is designed to avoid. Indeed, we have held it was error for the Board to ignore evidence that a proposed modification would interfere with a reference’s stated purpose.”).

In *Henny Penny*, the Federal Circuit affirmed the Board’s finding that a petition failed to prove obviousness where the petitioner failed to establish a supportable “motivation to combine” the references. *Henny Penny*, 938 F.3d at

1331-32. The Board found a lack of motivation because the petition’s combination disadvantageously changed the primary reference in certain ways. *Id.* On appeal, the petitioner alleged that this was error. *Id.* The Court disagreed because the prior art “must be considered for all its teachings” and the benefits “*both lost and gained*” from the modification to the primary reference “should be weighed against each other.” *Id.*, (emphasis original) (quoting *Winner v. Wang*, 202 F.3d 1340, 1349 n.8 (Fed. Cir. 2000)). The Court found no error in the Board’s analysis and noted that a reasonable factfinder could have found that the tradeoffs from the modification “yield an unappetizing combination” that a POSA would not have been motivated to make. *Id.*

Here, Petitioners ignored Lane’s teachings that make clear that Petitioners’ combination was “unappetizing” because it destroyed functionality (pen-based computing) that Lane taught was desirable. Walker ¶69. In doing so, Petitioners failed to consider Lane “for all its teachings” and failed to weigh the benefits “*lost*” against those allegedly “*gained*” from Petitioners’ modification to Lane as the law requires to establish obviousness. *See Henny Penny*, 938 F.3d at 1331-32. In sum, Ground 1 fails because Petitioners failed to establish that POSAs would have run “the XP Pro operating system as taught in Pogue” (Petition, 26) on Lane’s computer in the first place.

B. The Petition Failed to Establish that POSAs Would Have Had a Reasonable Expectation that Lane's Touchscreen Would Be Operational If Lane's Computer Ran Pogue's Operating System

An independent reason why Ground 1 fails is that the Petition failed to establish that POSAs would have had a reasonable expectation that Lane's touchscreen would be operable if Lane's computer ran "the XP Pro operating system as taught in Pogue" as alleged in Ground 1's combination. Petition, 26.

The Petition alleged that Lane's "touchscreen and pen-based computing would be operable in all configurations of the computer 10." *Id.*, 29, 48. And the Petition relies on the touchscreen to meet a limitation in every Challenged Claim. *Id.*, 37 ("the touchscreen was active for user interactions in each of the plurality of display modes"), 48-49. But Petitioners fail to establish that a POSA would have reasonably expected that "the XP Pro operating system as taught in Pogue" would have supported operation of Lane's touchscreen or pen-based input as explained in Section IV.A.1, *supra*. Indeed, it was well-known that Windows XP Pro had no support for touchscreens so POSAs would not have expected that "the XP Pro operating system as taught in Pogue" running on Lane's computer would have resulted in the operable touchscreen that the Petition relies on in purporting to demonstrate obviousness of every Challenged Claim. Walker ¶78; § IV.A.1, *supra*.

It is black letter law that demonstrating obviousness required a showing of a reasonable expectation of success. *OSI Pharms., LLC v. Apotex Inc.*, 939 F.3d 1375, 1382 (Fed. Cir. 2019) (“An obviousness determination requires finding that a person of ordinary skill in the art would have been motivated to combine or modify the teachings in the prior art and would have had a reasonable expectation of success in doing so.”). But as explained in Section IV.A.2, *supra*, Petitioners’ arguments focused only on whether Lane’s computer could successfully run Pogue’s operation system and entirely ignored whether Pogue’s operating system could support Lane’s pen-based computing. Petition, 26. The ***Petition*** needed to state its grounds “with particularity” and “must” provide a “full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence.” 35 U.S.C. § 312; 37 C.F.R. §42.22. The Petition wholly failed to meet these requirements because it never explains how or why a POSA would have reasonably expected Lane’s pen-based input to operate after Lane was modified to run “the XP Pro operating system as taught in Pogue.” Petition, 26.

To the extent the Petition is read as implicitly arguing that because Lane’s touchscreen was operational when Lane ran some unidentified operating system, a POSA would have expected the touchscreen to be operational when Lane ran Pogue’s operating system, that assertion is unsupported and wrong. Petition, 25 (admitting the Lane “does not specify an operating system”); Walker ¶79. As Dr.

Walker explains, POSAs would have known that different operating systems can support different hardware. Walker ¶80. Just because some hardware works on a computer running one operating system does not mean POSAs would have reasonably expected it to work on a different computer running a different operating system. *Id.* Our own personal experience tells us this: Macs and Windows PC are not compatible. *Id.* One would not expect a Mac to be operative when attempting to run a Windows operating system. *Id.* The same is true for touchscreens. Even if Lane, Shimano, and Kurtenbach disclosed operable touchscreens as alleged in the Petition (at 29), that is in the context of those computers running some ***undisclosed operating system***. *Id.* ¶81. Just because the touchscreens worked when the computers ran some undisclosed operating system(s) did not mean that POSAs would have reasonably expected Lane's touchscreen to be operative when running Pogue's operating system, particularly when it was well-known to POSAs that the Windows XP operating system that Pogue describes did not in fact support touchscreen operation. *Id.*

Similarly, to the extent the Petition is read as implicitly suggesting that making Lane's touchscreens operational when used with Pogue's operating system would have been nothing but routine optimization for a POSA, that assertion would also be unsupported and wrong. This would have been well beyond the

capabilities of a POSA as defined by the Petition on the critical date in 2008. *Id.*

¶82; Petition, 7.

As of at least 2022, “[t]he MacOS operating system doesn’t provide any support for touchscreens.” EX2022, 2; EX2023, 1 (“macOS doesn’t support touchscreens”). POSAs knew that “*it’s not as simple as popping in a touchscreen onto the MacBook Pro and calling it a day.*” EX2024, 1. Rather, “to make such a *drastic change as switching to a touchscreen*, macOS would also need a massive update to accommodate the new functionality.” EX2025, 1. The record is clear that getting an operating system to allow the operation of a touchscreen was a massive undertaking even in 2022. It was certainly a massive undertaking in 2008 and well beyond the scope of routine optimization for a POSA. Walker ¶82. Indeed, POSAs understood that is why Microsoft needed to release an entirely new and different operating system when it sought to support the operation of touchscreens. *Id.* Getting a touchscreen to work on Pogue’s Windows XP Pro operating system was not as simple as downloading the correct driver. *Id.*

1. POSAs Would Have Known that Pogue’s Windows XP Pro Did Not Support Touchscreens

Pogue provides no basis for establishing a reasonable likelihood that running Pogue’s Windows XP Pro on Lane’s computer would have resulted in an operable touchscreen. Walker ¶83. Pogue was the only prior art reference that Petitioners cited to establish how Windows XP Pro operated. Petitioners’ expert admitted

this. EX2020, 21:9-13 (“Q. Pogue is the only reference that you cite as disclosing the features of Windows XP Pro; is that right? A. Yes. As disclosing the features that I rely on, that’s correct.”).

Petitioners cited no other evidence of how Windows XP Pro worked. Walker ¶83. And Pogue never mentions the ability to support the operation of touchscreens or pen-input devices. *Id.*; EX2020, 42:18-21 (Petitioners’ expert admitted this); § IV.A.1, *supra*.

Petitioners cite Pogue at 646 (native page 632) as allegedly supporting “a reasonable expectation of success.” Petition, 26. But on that page, Pogue merely provides a list of hardware requirements, including a “[k]eyboard and Microsoft mouse or *compatible* pointing device,” and never lists a touchscreen or pen-input device. Pogue, 645-46; Walker ¶84. A pen-input and touchscreen are different from a mouse or touchpad, as explained in Section IV.A.1, *supra*. For example, a mouse and touchpad track *relative* movement, whereas a touchscreen relies on the operating system being able to interpret *direct* inputs of user gestures. Walker ¶84; EX1020, ¶[0009]. Petitioners cite no evidence that Lane’s pen-input device was a compatible pointing device that Pogue describes as compatible with the Windows XP Pro operating system. Petition, 26; Walker ¶84.

As explained in Section IV.A.1, *supra*, touchscreens and pen-input devices were not compatible with Pogue’s Windows XP Pro and would not have been

operational on a computer running that operating system. *See also* Walker ¶85. If Pogue’s Windows XP Pro had supported touchscreens, POSAs would have expected Pogue to disclose such a capability because Pogue explained how a mouse and keyboard were supported. Walker ¶85. But Pogue never mentions touchscreens, unlike a mouse and keyboard. *See supra* § IV.A.1; Walker ¶85; EX2020, 21:9-13, 42:18-21. Pogue thus does not support a reasonable expectation that a touchscreen would have been operational on Lane’s computer when running Pogue’s Windows XP Pro.

2. POSAs Would Not Have Expected a Touchscreen to Be Operable on a Computer Running Windows XP Pro Simply Because It Was Operable on a Computer Running a Different Operating System

Petitioners cite Lane (EX1006), Shimano (EX1008), and Kurtenbach (EX1015) as allegedly establishing that Lane’s touchscreen would be “operable in all configurations of the computer 10, including the laptop, easel and frame modes” because there were known uses for touchscreens in all of these configurations. Petition, 28-29. Even *if* “the XP Pro operating system as taught in Pogue” (Petition, 26) supported Lane’s touchscreen then it would have been obvious to have the touchscreen operable in all configurations, that does not help Petitioners because none of the cited evidence supports that “the XP Pro operating system as taught in Pogue” would support Lane’s touchscreen in any configuration in the first place.

None of those references ever mention Windows XP Pro, let alone disclose that it provides support for touchscreen operation. Walker ¶86. Indeed, Petitioners’ expert admitted that Pogue was the only prior art reference he relied upon to establish the features of Windows XP Pro. EX2020, 21:9-13. Even if Lane, Shimano, or Kurtenbach disclosed operable pen-based computing or touchscreens, that did not mean POSAs would have had a reasonable expectation that Lane’s touchscreen would be operative on a computer running the *different* operating system described in Pogue that did not support touchscreen operation. Walker ¶¶87-88.

Operating systems that did not support touchscreens were not unique to Pogue’s Windows XP Pro. *Id.* ¶89. For example, as of 2022, “[t]he MacOS operating system doesn’t provide any support for touchscreens.” EX2022, 2; EX2023, 1 (“macOS doesn’t support touchscreens”). Even if Lane, Shimano, and Kurtenbach disclosed touchscreens that were operable when their computer was running some undisclosed operating system, a POSA would understand that that does not mean they would be operable if the computer ran the different operating system described in Pogue. Walker ¶89. Thus, none of Lane, Shimano, or Kurtenbach supports that a POSA would have a reasonable expectation that Lane’s touchscreen would be operable if Lane’s computer were modified to run “the XP

Pro operating system as taught in Pogue” as in Ground 1’s combination. Petition, 26; Walker ¶90.

3. Dr. Wolfe’s Conclusory Opinion is Unsupported

Petitioners cite the testimony of their expert. Petition, 28-29. But Dr. Wolfe provides no credible evidence that a POSA would have reasonably expected Lane’s touchscreen to be operable if Lane’s computer were modified to run the XP Pro operating system as taught in Pogue. On cross-examination, Dr. Wolfe only identified paragraphs 101-103 of his declaration as relating to his reasonable expectation of success opinion for Ground 1. EX2020, 46:21-48:19, 49:23-50:10. Those three paragraphs parrot virtually word-for-word the Petition’s conclusory unsupported assertions. *Compare* Petition, 25-29, *with* EX1002, ¶¶101-103. Dr. Wolfe only cites the same portions of the same prior art references as the Petition does without any additional explanation. As explained in Section IV.B.1-2, *supra*, none of those references support a reasonable expectation that Lane’s touchscreen would be operable with Lane running Pogue’s Windows XP Pro. Walker ¶¶86-90.

Dr. Wolfe’s conclusory assertions that simply rehash the Petition’s arguments warrant no weight under the Board’s precedential *Xerox* decision. *Xerox v. Bytemark*, IPR2022-00624, Paper 9, 15 (Aug. 24, 2022) (precedential) (“[T]he cited declaration *testimony is conclusory and unsupported*, adds little to the conclusory assertion for which it is offered to support, and is *entitled to little*

weight.”) (citing 37 C.F.R. § 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight”)).

4. Making a Touchscreen Operate on a Computer Running Pogue’s Windows XP Pro Would Have Been Beyond a POSA’s Capabilities

To the extent the Petition is read as implying that POSAs could have easily made Lane’s touchscreen work on a computer running Pogue’s operating system that was not designed to support the touchscreen operation, the Petition cited no evidence to support that and it is simply incorrect. Walker ¶91. “[I]t’s *not as simple as popping in a touchscreen* onto [a computer running an operating system that does not support touchscreens] *and calling it a day.*” EX2024, 1; Walker ¶94. “[T]o make such a *drastic change as switching to a touchscreen,*” would “need a *massive* update to accommodate the new functionality.” EX2025, 1; Walker ¶94. Getting Lane’s touchscreen to work with Pogue’s Windows XP Pro would have been beyond the capabilities of a POSA as defined by Petitioners. Petition, 7; Walker ¶95.

a. Petitioners’ Definition of a POSA Does Not Include Necessary Experience to Write a Touchscreen Driver for Windows XP Pro Without Undue Experimentation

Petitioners define a POSA as having “a bachelor’s degree (or equivalent) in electrical engineering, computer engineering, computer science, or a comparable

subject and would have had two to three years of work experience in the *design and architecture of laptop computers* and other portable electronic devices.”

Petition, 7. Petitioners define an alternate POSA as one having an advanced degree in the same fields “and would have had one year of post-graduate research or work experience in the *design and architecture of laptop computers* and other portable electronic devices.” *Id.* Petitioners state that a POSA “would have been *familiar* [sic] the structural hardware aspects of laptop computers and other portable electronic devices as well as *designs of user interfaces* employed and displayed by computer operating systems and their organization of content and functionality.” *Id.*

Petitioners’ POSA thus had experience in hardware design and the design of user interfaces but no work experience or expertise involving coding device drivers or modifying an operating system. Walker ¶¶92-93. Given that lack of expertise and experience, Petitioners’ POSA had no experience or expertise in how to make a touchscreen operable on a computer running Pogue’s Windows XP Pro operating system that did not already support the operation of touch screens. *Id.*

b. Making Lane’s Touchscreen Operational When Running Pogue’s Windows XP Pro Would Have Been Beyond the Skill of a POSA

The Petition needed to explain the contemplated workings of its combination, including how the teachings of Lane and/or Pogue would have been

modified to make Lane’s touchscreen operable with Pogue’s operating system.

Pers. WebTechs, 848 F.3d at 994 (“[A] **prerequisite** to adequately explaining and supporting a conclusion” of obviousness is “a clear, evidence-supported account of the contemplated workings of the combination.”). The Petition’s failure to do so should end the matter, as it is not LiTL’s burden to imagine arguments the Petition could have advanced to refute them.

As Dr. Walker explains, to the extent Petitioners belatedly argues that a POSA would have created a touchscreen driver that translated the output of the touchscreen to emulate the output of a mouse that Pogue’s Windows XP Pro could interpret, or would have modified Pogue’s operating system itself to directly interpret the output of the touchscreen, neither would have been within the skill of a POSA to perform without undue experimentation. Walker ¶¶94-95; EX2024, 1 (“*it’s not as simple as popping in a touchscreen ... and calling it a day.*”); EX2025, 1 (“such a **drastic change** as **switching to a touchscreen**,” would “need a **massive** update to accommodate the new functionality”).

Both approaches would have required specific types of operating system coding experience and expertise (Walker ¶103) that Petitioners’ POSA lacked (Petition, 7). *Kinaxis*, IPR2021-01205, Paper 16, 23 (no obviousness where the alleged modification was “***not within the level of skill of a POSA proposed by Petitioner***”).

i. Making Lane’s Touchscreen Operational Would Have Been Challenging to a Person with Extensive Driver and Operating System Programming Experience

Making Lane’s touchscreen operable when running Pogue’s Windows XP Pro would have presented multiple layers of challenges, even for a person with extensive experience programming drivers and operating systems. Walker ¶¶96.

The problem a POSA would have faced is different in kind from the more routine situation where an operating system *supports* a certain type of input device like a keyboard and third-party keyboard manufacturers can write drivers to work with that operating system. *Id.* The reason is that in those circumstances, the provider of the operating system provides application programming interfaces (“APIs”) to third parties so that they write drivers to interface with the operating system for *supported* devices like a keyboard. *Id.* Windows XP Pro did not support a touchscreen so Microsoft provided no API to third-party touchscreen manufacturers to assist them in writing a driver that would work with Windows XP Pro. *Id.*

If Petitioners argue that a POSA would have used an API that Microsoft provided for a *different* type of supported device (e.g., for a mouse) and written a touchscreen driver to work with the API for that different device, that would have been beyond a POSA’s skill to perform without undue experimentation. *Id.* ¶¶105-09. This would have required translating the *direct* inputs of user gestures

associated with a touchscreen to a *relative* output signal that Pogue’s Windows XP Pro interprets from a mouse. *Id.* ¶100; EX1020, ¶[0009]. A touchscreen driver would first need to know where the location of the pointer currently is because Pogue’s Windows XP Pro would not output that information to a driver because a mouse does not require it. *Id.* ¶101. The touchscreen driver would need to have calibration functionality to take into account the dimensions and orientation of the touchscreen. *Id.* ¶102. But even by the mid-2000s, the ability to calibrate a touchscreen was far from trivial. *Id.* ¶100; EX2026, 26 (“Mice do not need to be calibrated.... On touchscreens, *miscalibration is a frequent and important problem*.... [T]hey consistently interpret input incorrectly, skewing it to one direction or another. Even slight miscalibrations can cause the users to unintentionally make undesired selections, which can be very aggravating.”). Even with a calibrated touchscreen, Pogue discloses that the sensitivity of the mouse input can be manually adjusted. Pogue, 295 (“you can set things up so that moving the mouse one *millimeter* moves the pointer one full *inch*—or vice versa”). A driver would need to coordinate its output with the manual sensitivity setting set in Pogue’s Windows XP Pro, otherwise the cursor would overshoot or undershoot the location being touched. Walker ¶102.

In addition to translating the direct inputs of the touchscreen to a relative output signal, a touchscreen driver would need to account for the lower precision

of a touchscreen over a mouse. *Id.* ¶97. A mouse can select an object as small as 1 pixel by 1 pixel, and Pogue’s Windows XP Pro is designed to take advantage of that precision. *Id.* But touchscreens and pen-based inputs have much lower precision. *Id.*; EX2026, 13 (as of 2005, “touchscreens [were] still notorious for their inaccuracy”), 25 (“This makes it difficult to select precise pixels on the screen, given the large error factor of the fingertip”). A driver, therefore, would need to somehow compensate for the lower precision of a touchscreen over a mouse input to successfully interact with Pogue’s Windows XP Pro operating system designed for mouse-like precision. Walker ¶97.

A touchscreen driver would also need to compensate for the ambiguity of a touch. *Id.* ¶¶98-99. When a user clicks a mouse, the operating system can register the click almost instantaneously because a click is unambiguously a click—it can mean nothing else. *Id.* ¶98. A finger or stylus touching a touchscreen, however, is ambiguous: it could be equated to a mouse click or it could be the beginning of a different gesture such as the user dragging the finger/stylus across the screen. *Id.* Touchscreen gestures include swiping, pinching and multi-touch actions. *Id.* To get a touchscreen or pen-based input to provide meaningful input for Windows XP Pro, a POSA would have needed to overcome the ambiguity of the user intention of first touching a touchscreen and how that should be presented as input to the operating system. *Id.* ¶99.

In sum, even for a person with *extensive* experience programming drivers, creating a driver to translate touchscreen input to input that Pogue's Windows XP Pro would recognize as mouse output would have been very challenging. *Id.* ¶¶96-102. Petitioners' POSA could not have done this without undue experimentation as discussed in Section IV.B.4.b.ii, *infra*.

And if Petitioners were to argue that a POSA would have modified Pogue's operating system directly to support a driver for Lane's touchscreen, that fails. First, this would have required reprogramming the operating system to address all the challenges just discussed based on differences between a touchscreen and a pointing device like a mouse and would have been beyond a POSA's abilities. But more fundamentally, Pogue's operating system is Windows XP Pro, relied upon for its popularity. *Petition*, 26. Microsoft does not make its Windows source code available for modification so Petitioner's POSA could not have simply modified Pogue's Windows XP Pro operating system. *Walker* ¶ 105.

ii. A POSA Could Not Have Made Lane's Touchscreen Operational Without Undue Experimentation

Petitioners' POSA lacked meaningful experience in coding device drivers and would have been unable to create a touchscreen driver that would have worked with Pogue's Windows XP Pro operating system that provides no API or other support for a touchscreen. *Walker* ¶103. Extensive experience coding drivers

would have been a prerequisite to developing a touchscreen driver that would have translated touchscreen input to input that Pogue's Windows XP Pro would recognize as mouse input output and Petitioners' POSA could not have done this without undue experimentation. *Id.* ¶¶96-103. Petitioners' POSA also did not have the experience or skill to modify Pogue's Windows XP Pro operating system directly to support a touchscreen and this would have required access to Microsoft's source code which Microsoft does not make publicly available. *Id.* ¶105. Without the requisite experience and expertise, Petitioners' POSA would not have had a reasonable expectation of success in getting Lane's touchscreen to work when Lane's computer runs Pogue's Windows XP Pro operating system. *Id.* ¶104.

An informative case is *Kinaxis v. Blue Yonder Grp.*, IPR2021-01205, Paper 16. There, the petition argued a combination of three references rendered the claimed bill of materials ("BOM") sourcing system obvious. *Id.*, 21. Petitioner's expert testified that "the combinations are within the skill of a POSA," but the "combinations require[d] modifications ... requiring computer science and programming knowledge." *Id.*, 22. The problem was that the level of skill defined by the petition did "not have computer science knowledge or computer programming ability." *Id.*, 9. The Board adopted the level of skill stated by the petition and then denied institution because the proposed combinations "each

require computer science and programming knowledge which is not within the level of skill of a POSA.” *Id.*, 23.

Here, the Petition defined a POSA as having experience with computer hardware architecture and user interface design, but without experience coding device drivers. Petition, 7; Walker ¶¶93. While Petitioners’ POSA could have had a computer science degree (Petition, 7), unlike the POSA defined by the petition in *Kinaxis*, that factual difference does not matter. What matters is that Petitioners’ POSA did not have the experience and expertise that would have been required to have had a reasonable expectation of making the combination that Petitioners allege. Walker ¶¶95, 103-04.

As it was Petitioners’ “burden to establish a reasonable expectation of success,” and they have “presented no theory other than that the combination was simple,” the patentability of the claims should be upheld. *Juniper Networks, Inc. v. Correct Transmission, LLC*, No. 2023-1046, 2024 WL 3517862, at *6 (Fed. Cir. July 24, 2024) (affirming Board’s finding of nonobviousness where the petition provided scant evidence that a POSA would have had the technical capability to expect the combination to be successful); *KSR Intl Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) (“using the technique is obvious ***unless its actual application is beyond his or her skill***”); *Samsung Elecs. Co. v. Elm 3DS Innovations, LLC*, 925 F.3d 1373, 1381 (Fed. Cir. 2019) (affirming Board’s finding of nonobviousness

“[g]iven the complexity involved in integrated circuit fabrication”); *MobileMedia Ideas LLC v. Apple Inc.*, 780 F.3d 1159, 1167-68 (Fed. Cir. 2015) (“[I]ntegrating the Lucent microprocessor to control the camera of the Kyocera mobile phone in the manner required by the asserted claims would be *beyond the technical ability of a skilled artisan.*”).

C. Petitioners Bore the Burden to Prove Their Case in the Manner Advanced in the Petition

Petitioners’ challenge must be evaluated based on the contents of the Petition *in the manner advanced*, not upon what the Petitioners *could have* argued. *SAS*, 138 S. Ct. at 1356 (The Board does not “enjoy[] a license to depart from the petition and institute a different inter partes review of [its] own design.”). The contentions *in the Petition* “define the scope of the litigation all the way from institution through to conclusion.” *Id.*, 1357. The Board must “base its decision on arguments that were advanced by a party” and has no power to “raise, address, and decide unpatentability theories never presented by the petitioner.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016); *see also Nautilus Hyosung v. Diebold*, IPR2016-00580, Paper 15, 7 (Jan. 31, 2017) (“[t]he Board must base its analysis on the arguments and evidence presented in the petition and not upon what the petitioner *could have* argued,” even where Petitioner based arguments on a combination of features not required by challenged claims); *Samsung Elecs.*, 925 F.3d at 1383 (“We will not fault the

Board for analyzing Petitioners’ obviousness grounds in the way presented in the Petition.”).

Here, *the Petition* argued that POSAs would have run the Windows “XP Pro operating system *as taught in Pogue*” on Lane’s pen-based computer, despite offering no evidence that Pogue’s operating system would have supported the operation of Lane’s touchscreen. Petition, 26. Establishing obviousness requires establishing a reason to combine and an expectation of success. *OSI Pharms.*, 939 F.3d at 1382. Petitioners established neither. Petitioners failed to establish that POSAs would have run Pogue’s operating system on Lane’s pen-based computer when doing so would have rendered Lane’s pen-based input inoperative. *See supra* § IV.A. And Petitioners failed to establish a reasonable expectation of success in making Lane’s touchscreen operable when Lane’s computer runs Pogue’s operation system because doing so without undue experimentation was beyond the skill of the Petition’s POSA. *See supra* § IV.B.

The Institution Decision stated that “[e]ven if Patent Owner is correct that Windows XP Pro did not include touchscreen support, that does not mean it would be beyond a skilled artisan’s capacity to *modify* Windows XP Pro or *select a Windows XP version like the Tablet PC Edition* that does include touchscreen support.” Paper 12 at 16-17. But the Petition did not make those allegations. The Petition did not argue that POSAs would have *modified* Pogue’s operating system

in any way. And the Petition did not combine Lane with a different “Windows XP version” and instead combined Lane with “the XP Pro operating system as taught in Pogue.” Petition, 26. The law requires that Petitioners prove their case in the manner advanced in the Petition, not based upon what the Petitioners *could have* argued. *SAS*, 138 S. Ct. at 1356.

LiTL agrees that the test for obviousness is not whether Pogue’s operating system can be “bodily incorporated” into Lane’s computer. Paper 12, 16. But Petitioners were required to explain the “contemplated workings” of their Lane-Pogue combination and that combination “run[s] the XP Pro operating system as taught in Pogue” on Lane’s computer and purportedly has Lane’s touchscreen “operable in all configurations” to meet the claimed limitations. Petition, 26, 29, 44, 48; *Pers. WebTechs*, 848 F.3d at 994. The combination *as proposed in the Petition* simply would not have worked. See § IV.A-B, *supra*.

D. Petitioners Cannot Rely on Software Products in an IPR

A “petitioner in an inter partes review” may “only” request to cancel claims “on the basis of prior art consisting of patents or printed publications.” 35 U.S.C. § 311(b). The Grounds are based on Pogue’s printed publication (Petition, 16-18) – not the Windows XP Pro product. Reliance on products, like software and drivers, is not permitted in an IPR. *Capsugel Belg. v. Innercap Techs.*, IPR2013-00331, Paper 9, 14-15 (Dec. 9, 2013) (institution declined where “the prior art upon which

[petitioner] relies is not the NIH product information submitted as Exhibit 1003, but rather the Midol product itself,” which “cannot be the basis of a ground for review”).

In an IPR, evidence other than prior-art patents and printed publications may play a “supporting role[]” in an obviousness analysis, e.g., as “indicating the level of ordinary skill in the art, what certain terms would mean to one with ordinary skill in the art, and how one with ordinary skill in the art would have under-stood [sic] a prior art disclosure.” *Yeda Research & Dev. Co. v. Mylan Pharm. Inc.*, 906 F.3d 1031, 1041 (Fed. Cir. 2018).

However, Petitioners may not rely on a physical product to establish unpatentability, such as making a showing that a certain claim limitation is met. *See DaVincia v. Enco Sys.*, IPR2020-00690, Paper 9, 2020 WL 5551710, at *12-13 (Sept. 16, 2020) (institution denied where Petitioner relied on a webpage describing software to show that it teaches a claim limitation—“Petitioner presents testimony that a webpage describing the CPC-700 software existed on a website.... Petitioner uses the CPC-700 webpage to show how the product worked.... Petitioner does not rely on the CPC-700 software to play a supporting role in the obviousness analysis... [r]ather, Petitioner ***relies on that product*** to show that the prior art teaches claim 1’s ‘selecting’ limitation.”); *see also Salpetre v. ARP Mfg.*, IPR2019-01382, Paper 13 (Dec. 27, 2019) (institution denied under § 311(b) where

Petitioner relies on “devices” described in a “Manual,” a “Video,” an “Operation Guide,” “Protocols,” “website screenshots,” as the basis for its challenges—“*Even if* several of the claimed features are present in this commercial embodiment... Petitioner may only rely on prior art patents and printed publications.”).

No evidence Petitioners can submit in Reply can remedy the failure of Pogue to describe an operating system that supported Lane’s touchscreen.

E. Ground 1 Fails for Claims 1, 3-4, and 7-9 for the Additional Reason That Lane Does Not Disclose a Navigation Control that is Rotatable About the Computer’s Longitudinal Axis Independently from the Computer’s Base

Ground 1 fails for independent claim 1 and the dependent claims challenged in Ground 1 (dependent claims 3-4 and 7-9) because Lane does not disclose a navigation control that is *rotatable about* the longitudinal axis of the computer independently from the computer’s base as required by those claims.

1. The ’844 Patent Describes a Novel Navigation Control Disposed About the Computer’s Longitudinal Axis So It Is Accessible in All the Computer’s Display Modes

The ’844 Patent’s computer can be placed by the user into different physical configurations (“display modes”), including laptop (Fig. 1), easel (Figs. 4), frame (Fig. 26) and flat (Fig. 27) modes. Walker ¶47.

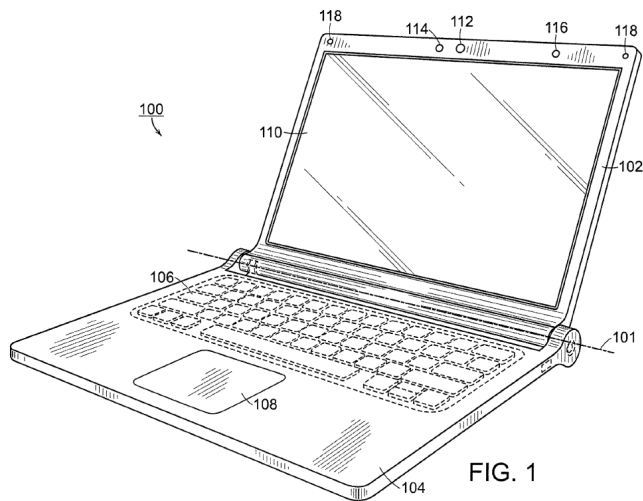


FIG. 1

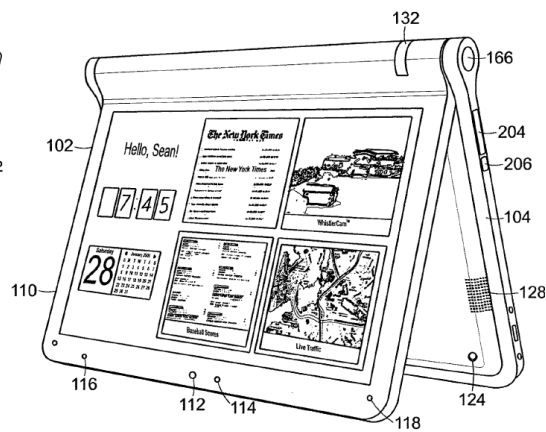


FIG. 4

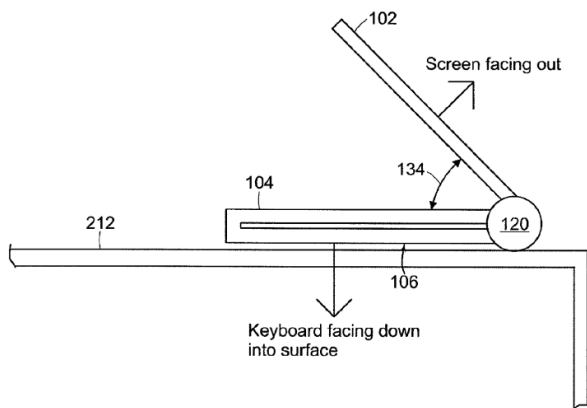


FIG. 26

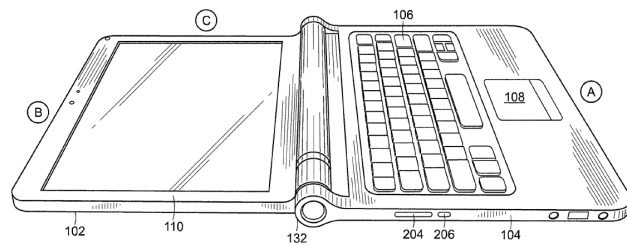


FIG. 27

EX1001, Figs. 1, 4, 26, and 27.

The computer's keyboard is not easily accessible in some of these configurations. *See e.g., id.*, Figs. 4-6 and 26; Walker ¶48. To address that, LiTL developed a novel navigation control (scroll wheel 132) disposed about the longitudinal axis between the base and display components, so it is accessible to the user in all the computer's configurations. *See e.g., id.*, Figs. 4, 7B and 15 (reproduced below). "[T]he portable computer may include integrated 'navigation' hardware that allows a user to easily and comfortabl[y] control various features

and functions of the portable computer, and to manipulate content displayed on the portable computer. For example, [] scroll wheel **132** [] allows a user to control, adjust and/or select various functionality of the portable computer [and] may be used to provide ‘hardware navigation’ through information, such as menus, icons, etc., displayed on the display screen **110**.” *Id.*, 10:54-64; *see also id.*, 11:5-10 (“navigation may be performed using [] scroll wheel **132**”). The user can rotate scroll wheel 132 relative to the base to control various computer functionality.

Walker ¶48.

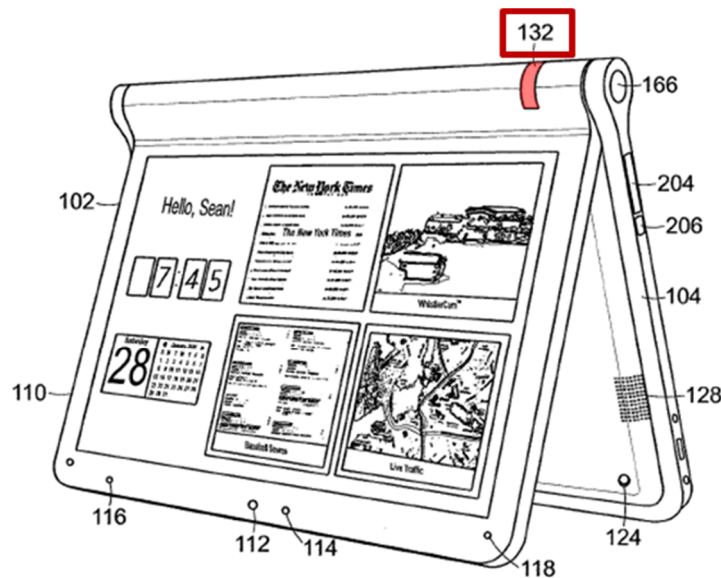


FIG. 4



FIG. 15

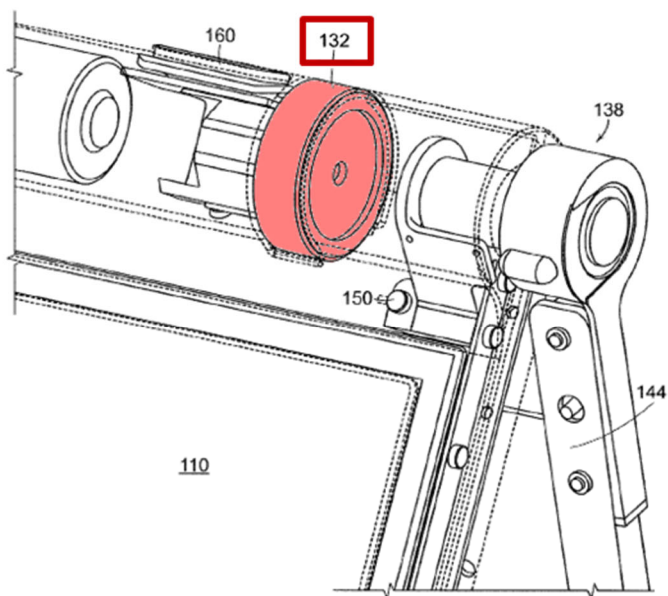


FIG. 7B

Id., Figs. 4, 7B, and 15 (annotated); Walker ¶48.

2. Claim 1 Requires a Navigation Control that Is Rotatable About the Longitudinal Axis Independently from the Base

Claim 1 requires a navigation control that is rotatable about the computer's longitudinal axis independently from the computer's base. Walker ¶¶44-45. Specifically, claim 1 recites a "portable computer configurable between a plurality of display modes ... comprising: a base ...; a main display component rotatably coupled to the base such that the main display component and the base are rotatable with respect to one another about a longitudinal axis running along an interface between the main display component and the base ...; ... and a navigation control disposed at least partially within the base and rotatable about the longitudinal axis." EX1001, 17:9-51. Claim 1 thus requires, in relevant part, (1) a

display component, (2) a **base *rotatably coupled to the display*** component about a longitudinal axis, and (3) a **navigation control** that is both at least partially **disposed within the base and rotatable about the longitudinal axis.** Walker ¶43.

Based on the claim's plain language, the navigation control must be independently rotatable about the longitudinal axis, separate and apart from the base's ability to rotate about the longitudinal axis. *Id.* ¶44. This is because the claim requires that the base be rotatable about the longitudinal axis and that the navigation control be partially disposed within the base. *Id.* A navigation control that is disposed within the base is necessarily rotatable about the longitudinal axis, because the claim already requires the base to be rotatable about the longitudinal axis. *Id.* But the claim also requires that the navigation control itself be rotatable about the longitudinal axis. *Id.*

This additional limitation further requires that the navigation control be rotatable about the longitudinal axis independently from the base's ability to rotate about the longitudinal axis. *Id.* ¶45. In other words, if the claim did not require the navigation control be rotatable about the longitudinal axis independently from the base, then the added requirement that the navigation control be rotatable about the longitudinal axis, in addition to the requirement that it be at least partially disposed within the base, would be superfluous, redundant, and have no meaning. *Id.* That is not the proper construction of claim 1. "It is highly disfavored to construe terms

in a way that renders them void, meaningless, or superfluous.” *Wasica Fin. v. Cont’l Auto. Sys.*, 853 F.3d 1272, 1288 n.10 (Fed. Cir. 2017); *Bicon v. Straumann*, 441 F.3d 945, 950-51 (Fed. Cir. 2006) (refusing to construe claim terms in a way that made other limitations meaningless).

This interpretation of the added requirement that the navigation control be both partially disposed within the base ***and*** rotatable about the longitudinal axis is consistent with the specification, which is the best, usually dispositive, evidence of how claims are to be construed. *Philips v. AWH*, 415 F.3d 1303, 1315 (Fed. Cir. 2005); *Vitronics v. Conceptronic*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). As detailed in Section IV.E.1, *supra*, the ’844 Patent specification discloses a navigation control (scroll wheel 132) disposed within the base and rotatable relative to the base about the longitudinal axis independently from the base’s ability to rotate about the longitudinal axis. Walker ¶¶46-49. Construing “disposed at least partially within the base ***and rotatable*** about the longitudinal axis” in claim 1 to require that the navigation control be rotatable independently from the base’s ability to rotate about that axis is consistent with the specification and gives meaning to every limitation in the claim.

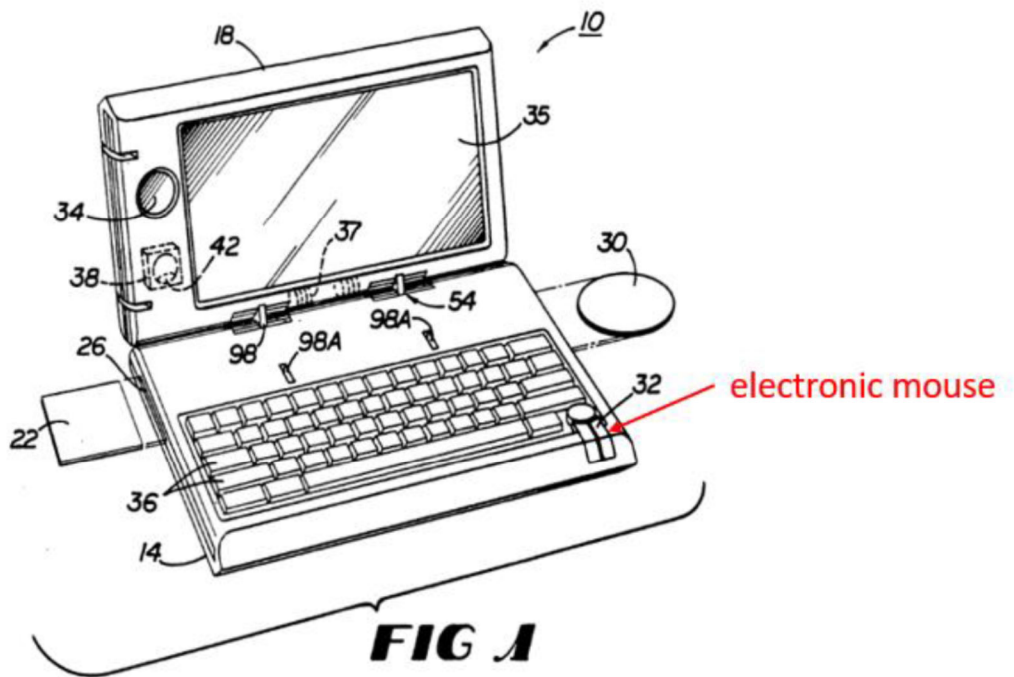
The Petition offers no contrary claim construction. The Petition at Section III.F.4 has a claim construction section for “‘navigation control’ (claims 1, 10, 18).” Petition, 11. That claim construction section only addresses the “navigation

control” language common to claims 1, 10 and 18 and does not address any of the language that differs among the navigation control clauses in those claims. *Id.*

This claim construction section only addresses what types of components could be a navigation control and says nothing about claim 1’s “rotatable about the longitudinal axis” requirement. *Id.*

3. Lane’s Electronic Mouse Is Not Rotatable About the Longitudinal Axis as Claimed

Lane’s electronic mouse is the only navigation control the Petition alleges as meeting claim 1’s navigation control. Petition, 45-48. Petitioners annotated Lane Fig. 1 (reproduced below) to identify the electronic mouse 32. Petitioners allege that Lane’s mouse includes a “pressure pad used to move the cursor” and “two buttons which a POSITA would have recognized as the left and right buttons for the electronic mouse 32 by which the user can right click or left click.” *Id.*, 45-46.



Id., 45 (reproducing and annotating Fig 1 of the '844 Patent).

But Lane's mouse 32 is not "rotatable" as required by claim 1. Walker ¶110. As shown above, Lane's mouse 32 is disposed fully within the base and has no ability to rotate about the longitudinal axis independently from the base as required by claim 1. *Id.* ¶111.

Indeed, the Petition never even alleges that Lane's mouse 32 is rotatable about the longitudinal axis. *Id.* ¶112; Petition, 45-48. The closest the Petition gets is when it states, "the electronic mouse 32 is part of the base and is therefore **disposed about** the longitudinal axis defined by axis of rotation 58 as are all portions of the base that are spaced apart from the longitudinal axis/axis of rotation 58." Petition, 48. But the petition never argues that a navigation control that is

“disposed about” the longitudinal axis must therefore be rotatable about that axis too. Dr. Wolfe’s declaration does not cure the Petition’s failure because it is *verbatim* the same as the Petition—Dr. Wolfe never opines that the Lane’s mouse 32 is rotatable about the longitudinal axis either. EX1002, ¶¶120-123.

In sum, Lane’s mouse 32 is not “rotatable about the longitudinal axis” as required by claim 1 and the Petition offers no argument or evidence to the contrary. Ground 1 for claims 1, 3, 4, and 7-9 thus fail for this additional reason.

F. Ground 1 Fails for Claims 18 and 22 Because Lane Does Not Disclose a Navigation Control Disposed About the Computer’s Longitudinal Axis

Ground 1 fails for claims 18 and 22 because Lane does not disclose a navigation control *disposed about* the longitudinal axis of the computer as required by those claims.

1. Claim 1’s Requirement that the Navigation Control be “Disposed About” the Longitudinal Axis Means Disposed Around the Longitudinal Axis

Claim 18 requires a navigation control disposed at least partially around the longitudinal axis running along an interface between the display component and the base. Walker ¶51. Specifically, claim 18 is directed to a “portable computer configurable between a plurality of display modes ... comprising: a base ...; a main display component...; a hinge assembly ... configured to rotatably couple the main display component to the base, the hinge assembly defining a longitudinal

axis running along an interface between the display component and the base...; ... and a navigation control disposed at least partially about the longitudinal axis.” EX1001, 19:32-20:30. Claim 18 thus requires (1) a longitudinal axis running along an interface between the display component and the base and (2) a navigation control disposed at least partially about the longitudinal axis. Walker ¶51.

Based on claim 18’s plain language, the navigation control must be disposed at least partially around (e.g., at least partially surrounding) the longitudinal axis. *Id.* ¶52. The ’844 Patent does not define what it means for a component to be disposed about an axis, but the plain meaning of “about” in this context means “around.” *Id.* ¶53 (citing EX2013 (defining “about” to mean “1: in a circle around: on every side of: AROUND”); EX2014 (defining “about” to mean “All around; on every side”); EX2015 (same)). Thus, construing “disposed at least partially about the longitudinal axis” to require that the navigation control be disposed at least partially around or surrounding the longitudinal axis is consistent with the ordinary meaning of “about.” Walker ¶53; *Hill-Rom Servs. v. Stryker*, 755 F.3d 1367, 1375 (Fed. Cir. 2014) (construing term “consistent with . . . the plain and ordinary meaning” of the term); *Masimo v. Sotera Wireless*, No. 2022-1415, 2023 WL 6307959, at *2-3 (Fed. Cir. 2023) (upholding Board construction consistent with the “plain meaning” of the claim terms).

Such a construction is also consistent with the '844 Patent specification, which discloses a navigation control (scroll wheel 132) surrounding the longitudinal axis so it is rotatable relative to the base and accessible to the user even in configurations where the keyboard is inaccessible. EX1001, Figs. 4, 7B, and 26, 3:50-52 (“a scroll wheel accessible in each of the plurality of display modes”); Walker ¶54. As shown in Fig. 7B annotated below, scroll wheel 132 is “disposed about the longitudinal axis” because it is disposed in the location of the longitudinal axis and indeed around that axis. Walker ¶54.

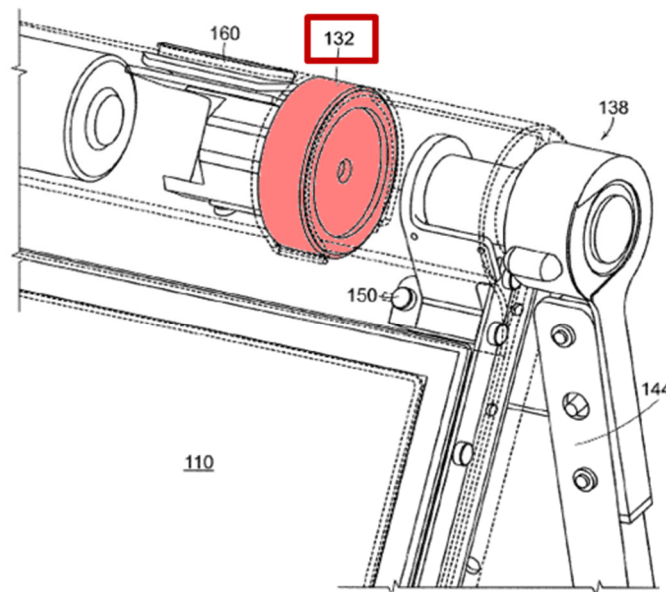


FIG. 7B

EX1001, Fig. 7B (annotated); Walker ¶54.

The Petition offers no contrary claim construction. The Petition at Section III.F.4 has a claim construction section for “‘navigation control’ (claims 1, 10, 18).” Petition, 11. That claim construction section only addresses what types of

components could be a navigation control and says nothing about claim 1's "rotatable about the longitudinal axis" requirement. *Id.* And Petitioner's expert admitted at his deposition that he did not offer an opinion for the term "disposed about." EX2020, 87:22-25 ("Q. *You don't provide an opinion on the term disposed, at least partially about the longitudinal axis; is that right?* A. **Correct.**"). Dr. Walker's opinions on this term are the only evidence of how a POSA would understand "disposed about."

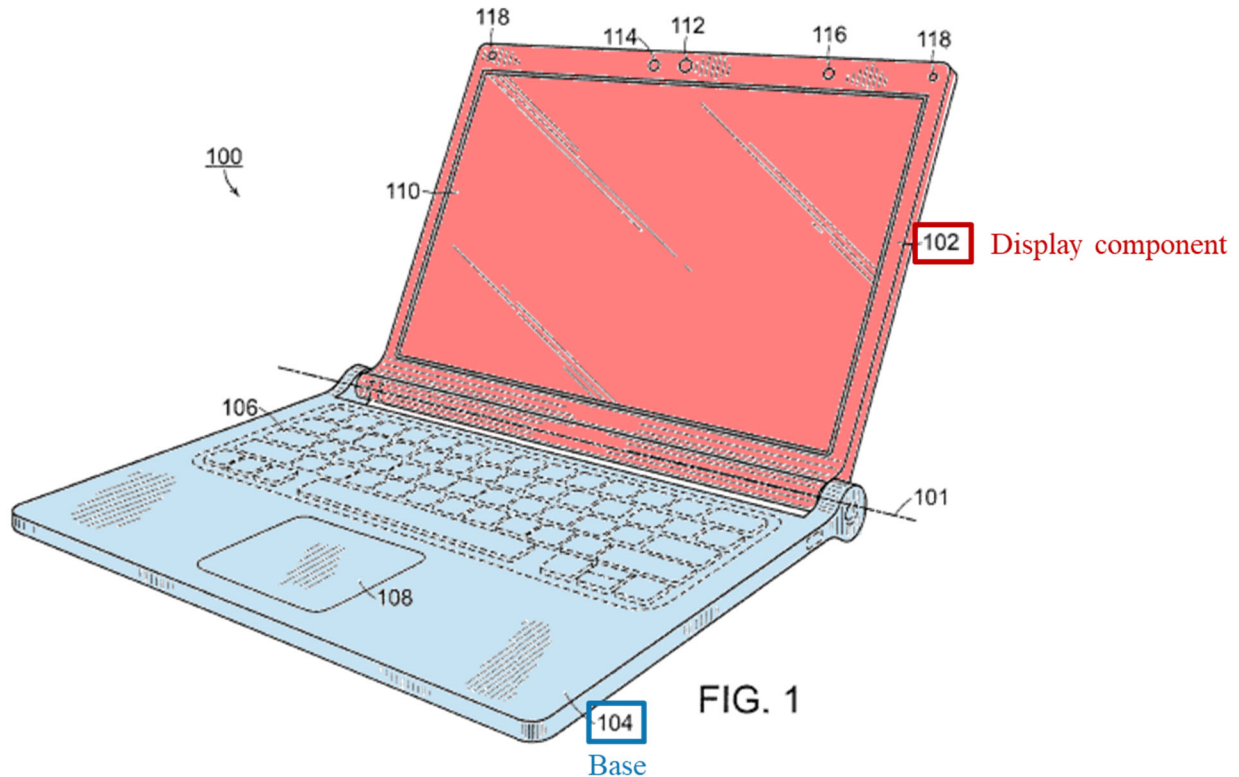
2. Neither Lane's Electronic Mouse Nor Its Touchscreen Are Disposed At Least Partially Around the Longitudinal Axis as Claimed

The Petition asserts that both Lane's electronic mouse and its touchscreen are disposed about the longitudinal axis despite neither of those components surrounding the longitudinal axis, even partially, as claimed. Petition, 48-49. The Petition argues that those components are "disposed about" the longitudinal axis because "the electronic mouse 32 is *part of the base*" and "the touchscreen/display 35 is *part of the main display component* which in its entirety is disposed and rotatable about the longitudinal axis." *Id.* The Petition offers no evidence-based reason why a navigation control that is entirely within the base or display also meets the separate claim requirement that the navigation control be at least partially disposed about the longitudinal axis as claimed. *Id.* Petitioners' implicit construction is unsupported and wrong. Walker ¶115.

The Petition was required to (“must”) explain “how” the “disposed at least partially **about** the longitudinal axis” “is to be construed.” 37 C.F.R. § 42.104(b)(3). Petitioners provide no explanation of why their implied construction is correct and cite no credible evidence. For example, the Petition cites no dictionary definitions or any portion of the specification in support of their claim construction argument. The Petition cites the Wolfe declaration (Petition, 48-49 (citing EX1002 ¶¶ 123, 126)), but Dr. Wolfe admitted he offered no opinion on the proper interpretation of this claim term. EX2020, 87:22-25 (“Q. *You don’t provide an opinion on the term disposed, at least partially about the longitudinal axis; is that right?* A. **Correct.**”). Petitioners cannot meet their burden by failing to explain how the “disposed at least partially **about** the longitudinal axis” term is to be construed, by ignoring the specification, and by submitting no evidence supporting their conclusory assertion.

The Petition’s construction is also wrong. Construing the requirement that the navigation control be “disposed at least partially about the longitudinal axis” to require nothing more than that it be “part of the base” or “part of the main display component” (Petition, 48-49) would give no meaning to “disposed at least partially about the longitudinal axis” and render that language superfluous. Walker ¶116. Claim 18 requires both a base and a main display component, and every other

component of the computer disclosed by the '844 Patent is part of the base or the main display component. EX1001, Fig. 1 (annotated below); Walker ¶116.



A construction such as Petitioner's that renders a term superfluous is not the proper construction. *Wasica*, 853 F.3d at 1288 n.10; *Bicon*, 441 F.3d at 950-51.

In sum, neither Lane's mouse nor its touchscreen is "disposed at least partially about the longitudinal axis" as required by claim 18 and the Petition offers no evidence-based argument to the contrary. Ground 1 for claims 18 and 22 fail for this additional reason.

V. GROUNDS 2-6 ALL INHERIT GROUND 1'S FAILINGS

Grounds 2-6 fall with Ground 1.

A. Ground 2

Ground 2 is based on a combination Lane, Pogue and Hotelling (EX1020) that is added to further support that Lane's touchscreen would be "active in all physical configurations/display modes." Petition, 57. Ground 2 relies on Ground 1's Lane-Pogue combination that runs Pogue's Windows XP Pro operating system on Lane's computer. Petition, 56-58; Walker ¶119. Petitioners' expert confirmed this. EX2020, 68:9-23 ("Q. So *for Ground 2, is the combination still Lane's computer running Pogue's Windows XP Pro?* A. *It is.*").

Ground 2 thus inherits Ground 1's failure to establish that a POSA would have run Pogue's operating system on Lane's pen-based computer and had a reasonable expectation of success that Lane's touchscreen would work. *See supra* §§ IV.A-B; Walker ¶120. And Ground 2 fails to show that the Lane-Pogue-Hotelling combination would have a navigation control that is rotatable about the longitudinal axis as required by claim 1 or is disposed at least partially about the longitudinal axis as required by claim 18 for the same reasons Ground 1 fails. *See supra* §§ IV.D-E; Walker ¶120.

B. Ground 3

Ground 3 adds Segawa to the Lane-Pogue combination to meet additional limitations in dependent claim 17. Petition, 58-60. Ground 3 relies entirely on Ground 1 to meet the limitations of independent claim 10. *Id.* Petitioners' expert admitted he only relied on Segawa for disclosing the "use of a navigation control"

and relied on Ground 1's Lane-Pogue combination to meet the navigation control limitation in Ground 3. EX2020, 84:24-85:5. Ground 3 therefore fails for the same reasons Ground 1 fails. *See supra* § IV; Walker ¶121.

C. Grounds 4-5

Grounds 4-5 swap Lane's hinge with a single axis hinge, but otherwise rely entirely on Ground 1's Lane-Pogue computer (Ground 4) or Ground 2's Lane-Pogue-Hotelling computer (Ground 5) to meet the claims. Petition, 61-63.

Petitioners' expert admitted he only relied on Ground 1's Lane-Pogue combination to disclose a navigation control in Grounds 4-5. EX2020, 85:9-21. Grounds 4-5 inherit the fatal flaws in Grounds 1-2, respectively, and fail for the same reasons. *See supra* §§ IV.A-E, V.A; Walker ¶122.

D. Ground 6

Ground 6 adds Segawa to Ground 4's Lane-Pogue-MIT computer to meet additional limitations in dependent claim 17. Petition, 64. Ground 6 relies entirely on Ground 1 (by way of Ground 4) to meet the limitations of independent claim 10. *Id.* Petitioners' expert admitted he only relied on Ground 1's Lane-Pogue combination to disclose a navigation control in Ground 6. EX2020, 85:22-86:1. Ground 6 fails for the same reasons Ground 1 fails. *See supra* §§ IV.A-E; Walker ¶123.

VI. CONCLUSION

As detailed above, the Board should confirm the patentability of all challenged claims.

Respectfully submitted,
LiTL LLC

Date: September 3, 2024

/Jason W. Balich/

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24, the undersigned certifies that the foregoing **PATENT OWNER'S RESPONSE** contains 13,480 words excluding; a table of contents, a table of authorities, Mandatory Notices under § 42.8, a certificate of service or word count, or appendix of exhibits or claim listing. Patent Owner has relied on the word count feature of the word processing system used to create this paper in making this certification.

Date: September 3, 2024

/Dara Del Rosario/
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Paralegal
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CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (e)(4)

I certify that on September 3, 2024, I will cause a copy of the foregoing document, including any exhibits filed therewith, to be served via electronic mail, as previously consented to by Petitioner, upon the following:

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