

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

IMMERSION CORPORATION,
Patent Owner.

Case IPR2017-01369
Patent 7,336,260 B2

Before BRYAN F. MOORE, PATRICK R. SCANLON, and
MINN CHUNG, *Administrative Patent Judges*.

SCANLON, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
35 U.S.C. § 314 and 37 C.F.R. § 42.108

I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition (Paper 1, “Second Petition,” or “Second Pet.”) requesting an *inter partes* review of claims 3–9 of U.S. Patent No. 7,336,260 B2 (Ex. 1001, “the ’260 patent”). As discussed further below, the claims challenged in the Second Petition cover essentially the same scope as the claims Petitioner challenged in its prior petition filed in Case IPR2016-01884 (*Apple Inc. v. Immersion Corp.*, Case IPR2016-01884 (filed Sept. 30, 2016)¹ (Paper 3, “First Petition” or “First Pet.”)). Immersion Corporation (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”).

Institution of *inter partes* review is discretionary. *See* 35 U.S.C. § 314(a); 37 C.F.R. § 42.108(a). Under the circumstances of this case, for the reasons explained below, we exercise our discretion to not institute an *inter partes* review as to any of claims 3–9 of the ’260 patent.

II. BACKGROUND

A. Related Matters

The parties indicate that the ’260 patent is at issue in the following related cases: *Immersion Corp. v. Apple Inc.*, Nos. 1:16-cv-00077 and 1:16-cv-00325 (D. Del.); and *In the Matter of: Certain Mobile Electronic Devices Incorporating Haptics (Including Smartphones and Smartwatches) and Components Thereof*, ITC Investigation No. 337-TA-990 (USITC), which has been consolidated with *In the Matter of: Certain Mobile and Portable Electronic Devices Incorporating Haptics (Including Smartphones*

¹ An initial Petition (Paper 1) in Case IPR2016-01884 filed on September 23, 2016, was subsequently replaced by a Corrected Petition (Paper 3) filed on September 30, 2016.

and Laptops) and Components Thereof, ITC Investigation No. 337-TA-1004 (USITC). Second Pet. 1; Paper 5, 2.

The '260 patent is also the subject of an instituted trial proceeding in Case IPR2016-01884. *Apple Inc. v. Immersion Corp.*, Case IPR2016-01884 (PTAB Apr. 3, 2017) (Paper 11, "1884 Dec. on Inst.").

B. The '260 patent

The '260 patent, titled "Method and Apparatus for Providing Tactile Sensations," issued on February 26, 2008. Ex. 1001, (54), (45). The '260 patent describes a system and method for providing tactile sensations to input devices, including non-mechanical input devices, such as soft-keys displayed on a screen. *Id.* at Abstract, 2:66–3:4. In particular, the '260 patent describes different tactile sensations to users manipulating an input device such as a touchscreen, based in part on varying levels of pressure applied to the input device by the users. *Id.* at 5:38–57. Figure 2 of the '260 patent is reproduced below.

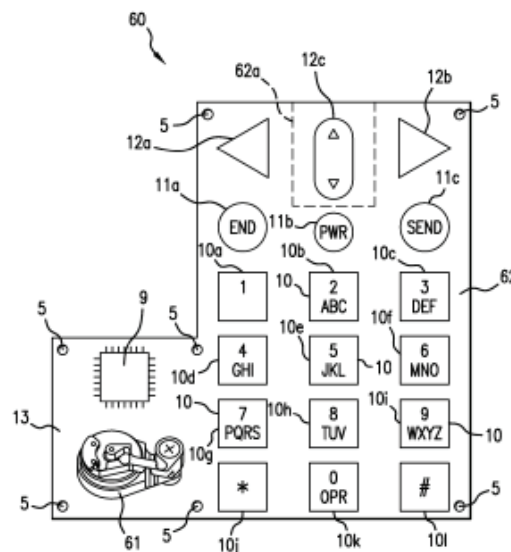


FIG. 2

Figure 2 depicts apparatus 60 with multiple input devices arranged as keys in a key pad for a telephone or mobile telephone, including twelve fixed or pre-assigned alphanumeric input buttons 10*a-l*, three pre-assigned function buttons 11*a-c*, and three assignable function buttons 12*a-c*. *Id.* at 5:39–47. Each of alphanumeric buttons 10 is capable of receiving multiple levels of pressure, such as button 10*i* capable of resolving five levels of increasingly greater pressure. *Id.* at 5:62–6:9. Pre-assigned function buttons 11 are capable of resolving three levels of increasingly greater pressure. *Id.* at 6:51–55. Actuator 61 is in communication with input devices and with controller 9 and is configured to provide vibrations of varying frequencies to the input devices in response to signals transmitted from the controller. *Id.* at 7:65–8:25.

Figure 4 of the '260 patent is reproduced below.

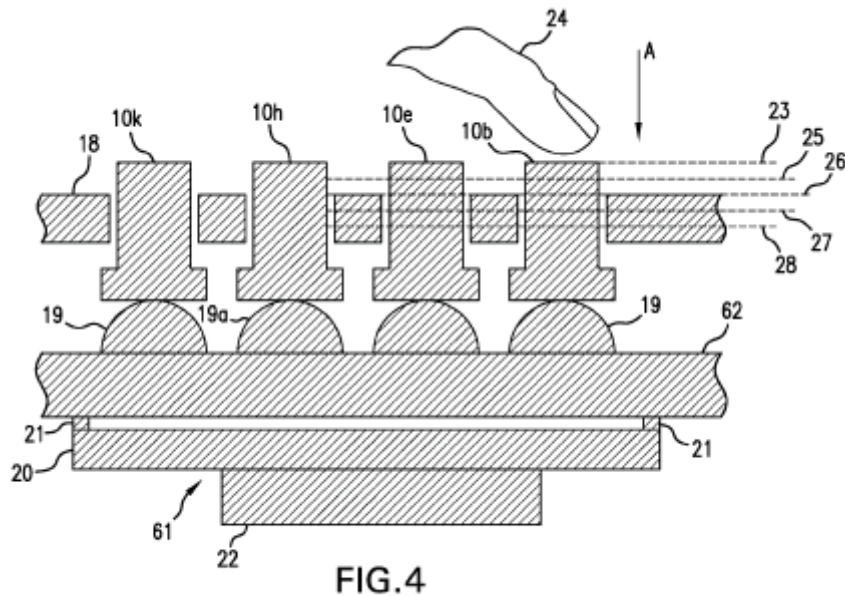


Figure 4 depicts alphanumeric input buttons or keys 10 in a mobile telephone, passing through case 18 of the telephone and contacting a

plurality of switches 19 that are in communication with controller 9 and disposed on printed circuit board (PCB) 62. *Id.* at 8:38–43. PCB 62 in turn is in communication with actuator 61, which is a piezo-electric actuator having metal diaphragm 20 in contact with piezo-ceramic element 22. *Id.* at 8:54–59.

Object 24, for example a user's finger, selects one or more of keys 10 by applying pressure in direction of arrow A, causing the selected key to progress through a plurality of positions such as rest position 23, second position 25, third position 26, fourth position 27, and fifth position 28, as greater pressure is applied to button 10. *Id.* at 8:65–9:5. Figure 3 of the '260 patent is reproduced below.

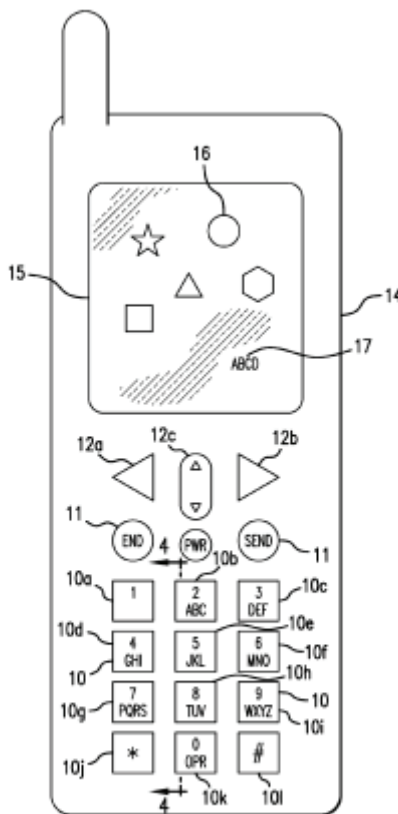


FIG. 3

Figure 3 depicts mobile telephone 14, with controller 9, actuator 61, and PCB 62 of apparatus 60 from Figure 2 encased in case 18. *Id.* at 8:26–30. Display screen 15 displays graphical objects 16 and alphanumeric information 17. *Id.* at 8:30–32. When a user presses the “9” key/button 10*i*, button 10*i* applies pressure to switch 19*a*, which transmits signals to controller 9. *Id.* at 9:19–30. Controller 9 then transmits a signal to actuator 61 which provides a vibration of a first pre-selected frequency to metal diaphragm 20, in turn causing PCB, switches 19, and button 10 to vibrate at that frequency. *Id.* at 9:30–44.

If a user applies further pressure sufficient to cause button 10*i* to move from second level 25 to third level 26, switch 19*a* then transmits a second signal to controller 9, which transmits a second signal to actuator 61. *Id.* at 9:45–56. Actuator 61 provides a vibration of a second pre-selected frequency that is communicated through PCB 62 and switches 19 to button 10*i*. *Id.* at 9:56–64. Different signals are transmitted by switch 19*a* for each level of pressure 25, 26, 27, and 28. *Id.* at 10:1–3.

C. Illustrative Claim

Challenged claims 3–9 all depend directly or indirectly from independent claim 1. Ex. 1001, 20:54–22:16. Therefore, although claim 1 is not challenged individually in this proceeding, each challenged claim includes the limitations of claim 1. As such, claim 1 is illustrative of the challenged claims and is reproduced below.

1. A computer-readable medium having instructions, the instructions including instructions that cause a processor to:
 - detect a first pressure on a first input device;
 - provide a first tactile sensation to the first input device, the first tactile sensation based at least in part on the first pressure;

detect a second pressure on the first input device, the second pressure greater than the first pressure; and

provide a second tactile sensation to the first input device, the second tactile sensation based at least in part on the second pressure;

detect a third pressure on the first input device, the third pressure greater than the second pressure; and

provide a third tactile sensation to the first input device.

Id. at 20:33–46.

D. First Petition in IPR2016-01884

On September 30, 2016, Petitioner filed the First Petition in Case IPR2016-01884 requesting an *inter partes* review of claims 1 and 2 of the '260 patent. First Pet. 3, 74. In the First Petition, Petitioner asserted the following grounds of unpatentability (*id.* at 3).

Reference(s)	Basis	Claim(s) Challenged
Komata '849 ²	§ 103	1 and 2
Tang ³	§ 103	1 and 2
Tang and Synaptics ⁴	§ 103	2
JP725 ⁵	§ 103	1 and 2

² U.S. Patent Application Publication No. 2001/0008849 A1, published July 19, 2001 (Ex. 1005).

³ Hui Tang et al., *A Multi-Level Input System with Force-Sensitive Elements*, J. Human-Computer Studies, (2001) 54, 495–507.

⁴ *Synaptics TouchPad Interfacing Guide*, Document No. 510-000080-A, Rev. 2.5, (Jan. 22, 2001).

⁵ Japanese Unexamined Patent Application Publication No. 11-212725, published Aug. 6, 1999.

On April 3, 2017, based on the arguments and evidence presented in the First Petition, we instituted an *inter partes* review as to claims 1 and 2 of the '260 patent on the grounds that these claims are unpatentable under 35 U.S.C. § 103(a) as obvious over Komata '849 alone or JP725 alone. 1884 Dec. on Inst. at 36.

E. Asserted Grounds of Unpatentability in the Second Petition

On May 4, 2017, which was one month and one day after our Decision on Institution in Case IPR2016-01884 was entered, Petitioner filed its Second Petition in this case requesting an *inter partes* review of claims 3–9 of the '260 patent. In its Second Petition, Petitioner asserts the following grounds of unpatentability (Second Pet. 3).

Reference(s)	Basis	Claim(s) Challenged
Komata '036 ⁶	§ 103	3–9
Komata '036 and Komata '849	§ 103	6

III. ANALYSIS

A. Discretionary Non-Institution Under 35 U.S.C. § 314(a)

Patent Owner asserts that the Second Petition should be denied because (1) it would be inequitable to Patent Owner to allow Petitioner's second challenge to claims of essentially the same scope when Petitioner benefited from Patent Owner's Preliminary Response and the Board's Decision on Institution in Case IPR2016-01884, and (2) Petitioner was aware of the prior art references asserted in its Second Petition when filing its First Petition in Case IPR2016-01884. Prelim. Resp. 7–15 (citing *Akamai*

⁶ U.S. Patent Application Publication No. 2001/0009036 A1, published July 19, 2001 (Ex. 1004).

Technologies, Inc. v. Limelight Networks, Inc., Case IPR2017-00358 (PTAB May 2, 2017) (Paper 9)).

Institution of *inter partes* review is discretionary. *See* 35 U.S.C. § 314(a) (authorizing institution of an *inter partes* review under particular circumstances, but not requiring institution under any circumstances); 37 C.F.R. § 42.108(a) (stating “the Board *may* authorize the review to proceed”) (emphasis added); *Harmonic Inc. v. Avid Tech, Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (explaining that under § 314(a), “the PTO is permitted, but never compelled, to institute an IPR proceeding”). When determining whether to exercise our discretion under § 314(a), we consider the following non-exhaustive factors:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition;
4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite resources of the Board; and
7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha, Case IPR2016-01357, slip op. 15–16 (PTAB Sept. 6, 2017) (Paper 19) (precedential)⁷ (hereinafter, “*General Plastic*”) (citing *NVIDIA Corp. v. Samsung Elec. Co.*, IPR2016-00134, slip op. 6–7 (PTAB May 4, 2016) (Paper 9)).

A central issue addressed by the *General Plastic* factors is balancing the equities between a petitioner and a patent owner when information is available from prior Board proceedings for a subsequent proceeding. *General Plastic*, slip op. at 15–19. Accordingly, we use the non-exhaustive *General Plastic* factors as a framework for assessing, under the specific circumstances of this case, the equities of allowing the Second Petition filed by the same Petitioner that challenges claims of the same patent having essentially the same scope as the claims challenged in the First Petition to proceed to trial. We address each of these factors in turn, but note that not all the factors need to weigh against institution for us to exercise our discretion under § 314(a).

Factor 1: Whether Petitioner Previously Filed a Petition Directed to the Same Claims of the Same Patent

As discussed above, Petitioner’s First Petition challenged claims 1 and 2 of the ’260 patent. First Pet. 3. The Second Petition additionally challenges dependent claims 3–9, which depend directly or indirectly from claim 1. Second Pet. 3. Challenges to these dependent claims must necessarily invoke a challenge to independent claim 1. As noted above, independent claim 1 was challenged in the First Petition. Thus, on the whole, the Second Petition overwhelmingly challenges claims covering

⁷ *General Plastic* was designated precedential on October 18, 2017.

essentially the same scope as the claims challenged in the First Petition filed in Case IPR2016-01884. Apart from asserting that it was attempting to conserve the resources of the Board and the parties (Second Pet. 3–4)—the effect of which is now diminished by the actual filing of the Second Petition—Petitioner does not explain adequately why it could not have addressed dependent claims 3–9 in the First Petition. Accordingly, this factor weighs against institution.

Factor 2: Whether Petitioner Knew of the Prior Art Asserted in the Second Petition When It Filed the First Petition

As discussed above, the Second Petition relies on two references: Komata '036 and Komata '849. Second Pet. 2. Petitioner knew of Komata '849 when it filed the First Petition because, as discussed above, the First Petition asserted grounds involving Komata '849.

Patent Owner argues that Petitioner also knew of Komata '036 at the time of its filing of the First Petition because Petitioner, on September 14, 2016, “served on Patent Owner in the co-pending ITC litigation separate invalidity claim charts for the '260 patent based on both Komata 036 and Komata 849.” Prelim. Resp. 10 (citing Exs. 2104, 2015). Patent Owner further asserts that these claim charts were attached to and identified in an interrogatory response dated and served September 14, 2016. *Id.* (citing Ex. 2103, 6, 8, 39, 41). Sufficient evidence shows that Petitioner served a detailed invalidity claim chart based on Komata '036 in the related ITC investigation on September 14, 2016. Exs. 2103, 2104. Thus, the record

indicates that Petitioner knew of Komata '036 when it filed the First Petition on September 30, 2016.⁸

Because Petitioner knew of or should have known of both of the references asserted in its Second Petition when it filed its First Petition, this factor weighs against institution.

Factor 3: Whether Petitioner Had Patent Owner's Preliminary Response and the Board's Institution Decision on the First Petition When Petitioner Filed the Second Petition

Patent Owner filed its Preliminary Response to the First Petition on January 4, 2017. *See* Case IPR2016-01884, Paper 7. We issued our Decision on Institution addressing the First Petition on April 3, 2017. 1884 Dec. on Inst. at 1. Hence, when Petitioner filed the Second Petition on May 4, 2017 (*see* Second Pet. 62), Petitioner had both Patent Owner's Preliminary Response to the First Petition and the Board's Decision on whether to institute review addressing the First Petition. Consequently, this factor weighs against institution.

Factor 4: The Elapsed Time between When Petitioner Had Patent Owner's Preliminary Response and the Board's Institution Decision on the First Petition and When Petitioner Filed the Second Petition

The delay between when Petitioner had Patent Owner's Preliminary Response to the First Petition, as well as the Board's Decision on Institution addressing the First Petition, and when Petitioner filed the Second Petition left Petitioner with sufficient time to take advantage of Patent Owner's and the Board's responses to the First Petition. When Petitioner filed its Second

⁸ The record also indicates that Petitioner knew of Komata '036 on September 23, 2016, when it filed the initial Petition that was replaced by the First Petition.

Petition on May 4, 2017, Petitioner had Patent Owner's Preliminary Response to the First Petition for three months, and our Decision on Institution addressing the First Petition for slightly over one month. Thus, Petitioner not only had the relevant materials from Patent Owner and the Board when it filed its Second Petition, but had ample time to take advantage of those materials in crafting its arguments in the Second Petition. As a result, this factor weighs against institution.

Factor 5: Whether Petitioner Has Provided Adequate Explanation

The fifth *General Plastic* factor is “whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent.” *General Plastic*, slip op. at 9, 16. A closely related factor often considered when determining whether to exercise our discretion under § 314(a) is “whether the petitioner provides adequate explanation why we should permit another attack on the same claims of the same patent.” *Akamai*, slip op. at 9; *Xactware Sols., Inc. v. Eagle View Techs., Inc.*, Case IPR2017-00034, slip op. at 7–8 (PTAB Apr. 13, 2017) (Paper 9).

Petitioner addresses our discretion to deny institution only briefly. Petitioner asserts that the Second Petition addresses additional claims based on a different primary reference. Second Pet. 3. Petitioner also cites a previous Board decision in Case IPR2016-00448 and states that Petitioner has not “‘overwhelmed Patent Owner with an unreasonable number of challenges of patentability’ because this is only the second petition that Petitioner has filed regarding the ’260 patent.” *Id.* Petitioner also asserts that the Second Petition challenges additional claims because the additional claims are asserted in the related district court proceedings, but were not

asserted in the related ITC investigation. *Id.* at 4. Petitioner states that it omitted challenges of the additional claims from the prior Petition in order to conserve the resources of the Board and the parties. *Id.*

These explanations, without more, do not justify permitting Petitioner to wait to file its Second Petition until after it has had the advantage of seeing our Decision on Institution addressing the First Petition. Petitioner's stated reason for filing two separate petitions, i.e., to conserve resources of the Board and the parties, does not explain why Petitioner could not have filed the petitions at the same time and simultaneously challenged all of the claims asserted in the related ITC and district court proceedings. As the First and Second Petitions indicate, Petitioner knew of both the ITC and the district court proceedings when the First Petition was filed. *See* First Pet. 1, Second Pet. 1.

Furthermore, as discussed above, the claims challenged in Petitioner's Second Petition cover essentially the same scope as the claims challenged in its First Petition. Hence, contrary to Petitioner's contention, the resources of both the Board and the parties would have been saved if the challenges to these claims were raised at the same time. Consequently, this factor also weighs against institution.

Factors 6 and 7: Board Considerations

The sixth and seventh *General Plastic* factors consider “the finite resources of the Board” and “the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.” *General Plastic*, slip op. at 9–10, 16.

We conclude that these factors are not implicated under the circumstances of this case, and, therefore, do not weigh for or against exercising our discretion.

Weighing the Factors for Discretionary Non-Institution under § 314(a)

We view Petitioner's strategy in this particular case as burdensome to Patent Owner and the Board. Additionally, Petitioner has not provided a persuasive explanation of why its challenges raised in the Second Petition should be allowed. Petitioner does not even attempt to explain why it could not have raised the challenges in the Second Petition simultaneously with the challenges raised in the First Petition. And we find Petitioner's explanation of why it chose to delay filing the Second Petition unpersuasive. We do not take lightly denying a petition on grounds unrelated to its substantive patentability challenges. Nor do we hold that multiple petitions against claims of the same patent that cover essentially the same scope are never permitted. Here, however, weighing the relevant factors under the circumstances of this case, which, as we explain above, all favor exercising our discretion not to institute, we view the prejudice to Patent Owner to be greater than that to Petitioner. We, therefore, decline to institute *inter partes* review under 35 U.S.C. § 314(a).

B. Conclusion

For all of the reasons discussed above, we exercise our discretion under 35 U.S.C. § 314(a) and 37 C.F.R. § 42.108(a) not to institute review in this proceeding with respect to claims 3–9 of the '260 patent.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied* as to all challenged claims of the '260 patent, and no trial is instituted.

IPR2017-01369
Patent 7,336,260 B2

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