

**IN UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

SAMSUNG ELECTRONICS CO., LTD. AND
SAMSUNG ELECTRONICS AMERICA, INC.

Petitioners,

v.

MAXELL, LTD.,
Patent Owner

Case: IPR2024-00828

U.S. Patent No. 8,982,086

**PATENT OWNER'S PRELIMINARY RESPONSE
TO PETITION FOR *INTER PARTES* REVIEW
OF U.S. PATENT NO. 8,982,086**

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PATENT OWNER'S EXHIBIT LIST

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I. INTRODUCTION

Patent Owner Maxell, Ltd. ("Patent Owner") respectfully requests that the Board deny institution because Petitioners Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (hereinafter "Petitioner" or "Samsung") have failed to demonstrate a reasonable likelihood of success on the grounds submitted in the Petition for challenging the patentability of claims 1, 2, 4-7, and 9-14 ("challenged claims") of U.S. Patent No. 8,982,086 ("the '086 Patent") (Ex. 1001).

First, the Board should exercise its discretion pursuant to 35 U.S.C. § 314(a) or 35 U.S.C. §325(d) and deny this petition. Application of the *Becton, Dickinson* factors weigh in favor of denying institution because most of the art relied on in the Petition was in fact considered or is cumulative to prior art considered during the '086 Patent prosecution, the '086 Patent reexamination, and related applications. Moreover, application of the *Fintiv* factors weigh in favor of denying institution. One of the purposes of IPRs is to be an "effective and efficient alternative" to litigation. *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16-17 (PTAB Sept. 6, 2017) (precedential). Here, instituting an IPR would not be an effective or efficient alternative to litigation, particularly given the stage of the co-pending District Court case *Maxell, Ltd. v. Samsung Electronics Co. Ltd. et al.*, No. Case No. 5:23-cv-00092 (E.D. Tex.) ("District Court Litigation") and the finite resources of the Board.

Second, Petitioner fails to show a reasonable likelihood of prevailing on any Ground because it has not shown that the cited references render obvious claims 1, 2, 4-7, and 9-14. None of the cited references alone or in combination disclose the arrangement of each element of claims 1, 2, 4-7, and 9-14. Specifically, all of Petitioner's grounds rely on Rogers, and Petitioner has not shown with reasonable certainty that Rogers discloses or renders obvious at least claim element 1[f].

Accordingly, the Board should decline to institute the Petition.

II. DISCRETIONARY FACTORS FAVOR DENIAL OF INSTITUTION

The Petition should be denied pursuant to the Director's discretion to deny institution of petitions. First, the Petition should be denied pursuant to 35 U.S.C. § 325(d) because the petition argues the "same or substantially the same art previously [] presented to the Office" and fails to demonstrate "that the Office erred in a manner material to the patentability of the challenged claims." *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, 8 (P.T.A.B. Feb. 3, 2020) (precedential); *see also Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, pp. 17-18 (PTAB Dec. 15, 2017) (Precedential). Second, the Petition should be denied pursuant to 35 U.S.C. § 314(a) and the factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020). The PTAB has the authority, where warranted, to exercise discretion to deny institution in view of the *Fintiv* factors particularly where, as here,

the merits of the challenge are neither compelling nor meritorious (*see infra*, Section III). *See* “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings With Parallel District Court Litigation,” issued June 21, 2022 (“Director’s Guidance”).

A. Application of 35 U.S.C. § 325(d) Weighs In Favor Of Denying Institution

The Petition should be denied pursuant to 35 U.S.C. § 325(d) because the petition argues the “same or substantially the same art previously [] presented to the Office” and fails to demonstrate “that the Office erred in a manner material to the patentability of the challenged claims.” *Advanced Bionics*, IPR2019-01469, Paper 6 at 8; *see also Becton, Dickinson*, IPR2017-01586, Paper 8 at 17-18. “Previously presented art includes art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent.” *Advanced Bionics*, IPR2019-01469 at 7-8. Further, the Board has construed “previously presented” in 35 U.S.C. § 325(d) to refer to art and arguments presented to the Office *prior to* the filing of the petition at issue. *Ironsource Ltd. v. Digital Turbine Inc.*, PGR2021- 00096, Paper 14 at 52 (PTAB Jan. 6, 2022). The Federal Circuit “has many times applied the prosecution history of one patent in a family to a related patent in the same family,” as such the parent reissue is relevant here as well. *See Microsoft Corp. v. Multi-Tech Sys., Inc.*,

357 F.3d 1340, 1345 (Fed. Cir. 2004); *Elkay Mfg. Co. v. Ebco Mfg. Co.*, 192 F.3d 973, 980 (Fed. Cir. 1999)).

Specifically, the '086 Patent not only was thoroughly examined by the Office during the original prosecution, but it also went through extensive reexamination proceedings. *See generally* Ex. 1004. Additionally, the '086 Patent's parent—U.S. Patent No. 8,654,093—went through extensive reissue proceedings. *See generally* Ex. 1005. Here, the IPR-asserted art is “the same or substantially the same” because two of the references, as admitted by Petitioner—Rogers and Rosenberg—were previously presented to and considered by the Office during reexamination of the '086 Patent. Ex. 1004 at 30-33; 77-79; 85-98; 158-162; 176-271. Rogers and Rosenberg were also considered during the parent reissue proceedings. *See* Ex. 1005 at 83; 573. Rogers is the main reference for all four grounds presented in the Petition. The remaining references—Rekimoto and Miyazawa—are cumulative of those previously presented to the Office, which meets the first part of the two-part framework from *Advanced Bionics*.

Under the second part, Petitioner argues that the examiner materially erred. Yet, Petitioner's argument is so cursory that, other than pointing to the arguments in its petition generally, Petitioner provides no argument about material error with respect to the previously considered references—Rogers and Rosenberg. Pet. at 80. *See Albany Int'l Corp. v. Kimberly-Clark Worldwide, Inc.*, PGR2021-00019, Paper

22, 8-9 (P.T.A.B. June 22, 2021) (denying institution because “[i]f a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute [] review.”).

1. The Same Or Substantially The Same Art Was Previously Presented To The Office

The overlap between the IPR-asserted references and those submitted during prior reexamination proceedings and prosecution of related applications meets the first part of the two-part *Advanced Bionics* framework, which considers the similarities and material differences between the two sets of art, the cumulative nature of the art, and the extent of the overlap between the arguments. *Becton, Dickinson*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph) (factors (a), (b), and (d)).

Here, the Office previously considered both Rogers and Rosenberg, yet neither reference prevented issuance of similar claims. Indeed, during the reexamination proceedings Claims 1-4 were confirmed and Claims 5-15 were added, even after consideration of Rogers and Rosenberg. *See Clim-A-Tech Ind., Inc. v. William A. Ebert*, IPR2017-01863, Paper 13, at 18-19 (PTAB Feb. 12, 2018) (denying institution even though the ‘Examiner did not base a rejection’ on the reference asserted in the petition); *Biocon Pharma Ltd. v. Novartis Pharm. Corp.*,

IPR2020- 01263, Paper 12, 9 (PTAB Feb. 16, 2021) (holding that cited but unapplied references supported denying institution); *Sony Interactive Entm't LLC v. Terminal Reality, Inc.*, IPR2020-00711, Paper 15, at 11 (PTAB Oct. 13, 2020) (finding reference was previously considered by the PTO because it was listed in the Examiner's Notice of References Cited).

a. Rogers Was Considered During Reexamination And The Parent Reissue

Rogers—which anchors all of the petition's grounds—was considered during both the reexamination of the '086 Patent as well as during the reissue proceedings of the '086 Patent's parent application, U.S. Patent No. 8,654,093 (“parent reissue”). For example, during the parent reissue Rogers was considered by the Examiner. Ex. 1005 at 83. Rogers was also an exhibit to the reexamination proceedings, analyzed in the prosecution history of the reexamination through a supporting expert declaration submitted with the reexamination request, and considered by the Examiner in connection with the arguments made throughout the reexamination proceeding. Indeed, an entire paragraph was dedicated to Rogers in the reexamination:

36. Similarly, U.S. Patent No. 8,683,582 to Rogers (“*Rogers*”) (Ex. 1019) describes a method and system for entering a graphical passcode into a mobile device, such as a cellular telephone. *Rogers*, Abstract, 3:4-13, 3:60-64. *Rogers* teaches multiple parameters for entering the

passcode that collectively authenticate a user, such as pressure magnitude applied by a user to a touchscreen (i.e., the force with which the user presses the screen), the size of contact between a user's finger and the touch screen of the device, timing of entering the passcode information, speed, and coordinate (position) data (the location on the screen the user presses), recorded during an "initialization procedure." *Id.*, 1:5-40, 3:60-64, 7:56-67, 13:28-14:2. *Rogers* further teaches that upon entering the graphical passcode in the correct manner, a specified process is executed, such as unlocking the mobile device. 13:14-20.

Ex. 1004 at 197. Further, the fact that Petitioner uses *Rogers* as a primary reference here does not militate against discretionary denial because, not only was it actually considered during the reexamination, *Rogers* is merely cumulative to *Bayram*—the primary reference utilized during the reexamination. For example, like *Rogers* here, *Bayram* was used in combination with *Rosenberg* in the reexamination proceedings. Ex. 1004 at 153-162. The cumulativeness of the previously considered *Rogers* reference to *Bayram* can be seen by the description of *Bayram* in the reexamination proceedings where, like *Rogers*, *Bayram* purportedly discloses a touch-sensitive display for receiving user input to authenticate the user to a device. Ex. 1004 at 201-203. Indeed, in the reexamination proceedings, the third-party requestor's expert described to the Examiner the interrelatedness of *Bayram* and *Rogers* as these references purportedly related to Claim element 1[e]:

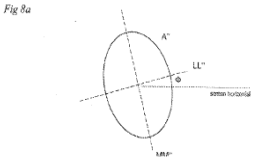
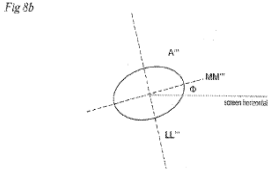
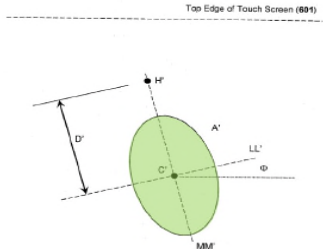
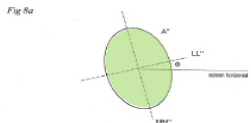
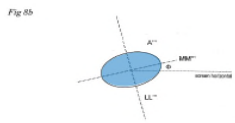
For instance, U.S. Patent No. 8,683,582 to Rogers ("*Rogers*") discloses "hardware used to implement the foregoing embodiments may be *processing elements* and memory elements configured to execute a set of instructions, wherein the set of instructions are for performing method steps corresponding to the above methods." *Rogers*, 13:21-25. *Rogers* further discloses "some steps or methods may be performed by circuitry that is specific to a given function." *Rogers*, 13:25-27. Thus, a POSITA would have been motivated by Rogers to use multiple processors (as taught by Bayram) for performing various application specific tasks (as also taught by Bayram). Further, as will be discussed in more detail below, Rosenberg (Ex. 1005) teaches processor 20 and a separate system controller 24, again showing that it was well-known and common to include a plurality of controllers within a single electronic device. *Rosenberg*, 0047.

Ex. 1004 at 234-235. Here, Petitioner repeats the arguments already considered in the reexamination by the Examiner and simply substitutes Rogers for Bayram, and essentially parrots the characterization of Rogers from the reexamination file history for the very same claim element, 1[e]. *Compare* Ex. 1004 at 234-235 with Pet. at 29-30. Indeed, as set forth further below in Section III.F, Rogers suffers from the same defects as Bayram. As aptly stated by the Examiner during reexamination: "The Examiner agree[s] that the combination did not have 2 registration modes, one for the finger tip and one for the finger pad, as Bayram has one registration mode for the signature." Ex. 1004 at 8.

**b. Rosenberg Was Considered During Reexamination
And The Parent Reissue**

Rosenberg, a secondary reference for Grounds 1 and 2, was thoroughly considered during both the '086 Patent reexamination proceedings and the parent reissue proceedings. For example, during the parent reissue the Examiner noted that Rosenberg “performs different functions based on fingertip versus finger pad contact to a touch screen.” Ex. 1005 at 573. During reexamination of the '086 Patent, in which claims 1-4 were confirmed and claims 5-15 were added, Rosenberg was similarly used as a secondary reference by the third-party requestor. Ex. 1004 at 153-162; 257-271. Throughout the reexamination proceeding Rosenberg was thoroughly considered. *See, e.g.*, Ex. 1004 at 30-33; 77-79; 85-98; 158-162; 257-271. Indeed, Petitioner uses Rosenberg in substantially the same way as the third-party requestor used Rosenberg in the reexamination proceedings for Claim element 1[f] to fill in the gaps in Rogers and Bayram, respectively:

Patent No. 8,982,086
Patent Owner's Preliminary Response

Rosenberg in the '086 Patent Reexamination	Rosenberg in the Petition
<i>Request for Reexamination of U.S. Patent No. 8,982,086 B2</i> generally easily distinguishable for a given finger of a given user" due to differences in total area contacted, shape of contact, and orientation of contact (e.g., the orientation of the major axis of contact). <i>Id.</i> Rosenberg illustrates how contact area for a finger-pad touch may differ from a contact for a finger-tip touch and discusses the differences in size, shape, and orientation of the two types of touches:  Finger-Pad Touch  Finger-Tip Touch Rosenberg, FIGS. 8A-B, 0050. Rosenberg thus teaches that "each of the size, shape, and/or orientation of the detected finger contact area may be used alone or in combination by the routines of the present invention to distinguish between a tip-pointing interaction and a pad-pointing interaction." Rosenberg, 0050, 0053 (detailing the size, shape, and orientation "parameters" "derived from the finger contact sensor data" for distinguishing finger-pad/finger-point contact).	U.S. Patent No. 8,982,086 Petition for <i>Inter Partes</i> Review Rosenberg explicitly discloses identifying pad-pointing as opposed to tip-pointing "[b]ased upon the size and/or shape" of the contact area (shown as an ellipse A' in FIG. 6):  Fig. 6 EX1007, FIG. 6. Rosenberg provides an example in which pad-pointing is shown in FIG. 8A and tip-pointing is shown in FIG. 8B. EX1007, ¶50.  Fig 8a  Fig 8b The tip-pointing interaction (FIG. 8B) "is substantially smaller in size (both area and circumference), more eccentric in shape (i.e., less rounded), and is oriented such that the major axis MM'' is oriented closer to the reference screen horizontal." EX1007, ¶50. The pad-pointing contact (FIG. 8A) "is substantially larger in size (both area and circumference), is less eccentric in shape (i.e., more rounded), and is oriented such that the minor axis LL" is oriented closer to the reference screen horizontal." EX1007, ¶50. "Thus, each of the size, shape, and/or orientation of the detected finger contact area may be used alone or in combination by the routines of the present invention to distinguish between a tip-pointing interaction and a pad-pointing interaction." EX1007, ¶50; EX1003, ¶129.

Compare Ex. 1005 at 158-160 with Pet. at 36-38.

c. Miyazawa Is Cumulative To At Least Aguera-Arcas, Wang, and Bayram

Petitioner uses Miyazawa as a tertiary reference for Grounds 2 and 4 to support the contention that the Rogers-Rosenberg-Miyazawa combination discloses

gesture operations. Pet. at 47. As characterized by Petitioner's expert: "The information processing apparatus disclosed in Miyazawa recognizes various user **touch operations, or gestures**, based on the detection of positions on the touch panel touched with an instruction object." Ex. 1003, ¶79 (emphasis added). However, Miyazawa is merely cumulative to art that was previously considered during the reexamination proceedings and the parent reissue proceedings. For example, during the parent reissue, the Office explicitly noted that Aguera-Arcas (U.S. Patent Application No. 2012/0284297) and Wang (U.S. Patent Application No. 2012/0192100) teach unlocking a touch screen with a gesture and password:

XIV. PRIOR ART

Aguera-Arcas et al US PG PUB 2012/0284297 teaches unlocking a touch screen with a gesture and password in paragraph [0003].

Wang et al US PG PUB 2012/0192100 teaches unlocking a touch screen with a gesture and password in paragraph [0058].

See Ex. 1005 at 572. Petitioner's use of Miyazawa is cumulative to the Office's prior consideration of at least Aguera-Arcas and Wang.

Miyazawa is also cumulative to the art considered in the reexamination proceeding. For example, Wang, as in the parent reissue, was considered during the reexamination for its teaching of unlocking a touch screen with a gesture and

password. *See, e.g.*, Ex. 1004 at 194. Bayram was similarly used to show gesture input in the reexamination proceedings. *Id.* at 208. Thus, Miyazawa is cumulative to references such as Aguera-Arcas, Bayram, and Wang, already considered during both the parent reissue and the reexamination of the '086 Patent.

d. Rekimoto is Cumulative To At Least Rosenberg

Rekimoto is used as a secondary reference for Grounds 3 and 4. Petitioner contends that Rekimoto “discloses its fingertip and finger pad touches as a solution to provide ‘continuous and smooth operation,’ which was a problem with certain operations at the time, EX1010, 1:53-67, and a POSITA would have understood that this would have added a benefit to Roger’s device.” Pet. at 63. Petitioner also alleges that Rekimoto discloses a fingertip and finger pad distinction technique. *Id.* at 64. Petitioner merely substitutes Rekimoto in Ground 3 for the use of Rosenberg in Ground 1. Utilization of Rekimoto for these purposes is merely cumulative of art already considered by the Office during the reexamination proceedings as well as the parent reissue proceedings.

For example, during reexamination as discussed above Rosenberg was used and thoroughly examined for substantially the same reasons as Petitioner uses Rekimoto (and Rosenberg) in this proceeding. *See, e.g.*, Ex. 1004 at 30-33; 77-79; 85-98; 158-162; 257-271. During the parent reissue, the Office specifically highlighted art to which Rekimoto is cumulative, *e.g.*, Rosenberg (“performs

different functions based on fingertip versus finger pad contact to a touch screen.”). Ex. 1005 at 573. Petitioner's use of Rekimoto is merely cumulative to the Office's prior consideration of at least Rosenberg.

All told, Rosenberg and Rogers were previously fully considered by the Office, as admitted by Petitioner. Pet. at 80. The remaining two minor references—Miyazawa and Rekimoto—are merely cumulative to art already considered by the Office. As such, the same or substantially the same art was previously presented to and considered by the Office, meeting the first step of *Advanced Bionics*.

2. Petitioner Fails To Demonstrate A Material Error By The Office

Regarding part two, Petitioner's attempt to detail material error by the Office is cursory. Petitioner relies solely on its supposed meritorious arguments set forth in the Petition, but makes no effort to detail how the Examiner materially erred in the '086 Patent's thorough reexamination proceedings and the specific prior consideration of both Rogers and Rosenberg. Petitioner also argues that “whether Rosenberg discloses fingertip and finger pad touches was not formally addressed.” Pet. at 80. This is incorrect in light of the extensive review of Rosenberg during reexamination. See Section II.A.1.b above; Ex. 1005 at 158-160. In fact, Petitioner rehashes the same substantive arguments that were rejected during reexamination, merely substituting Rogers for Bayram. But, as set forth below, Rogers fails to

render the claims unpatentable for *very similar* reasons as Bayram failed to render the claims unpatentable.

As such, because Petitioner's lack of analysis is insufficient to meet the second part of the *Advanced Bionics* test, denial under §325(d) is appropriate. *Albany Int'l Corp.*, PGR2021-00019, Paper 22, 8-9 (denying institution because "[i]f a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute [] review.").

Since the first part of the *Advanced Bionics* framework is satisfied, and Petitioner failed to make a showing of material error for the second part, the Director should exercise discretion not to institute review. *See Advanced Bionics*, IPR2019-01469, Paper 6, 8; *Albany Int'l Corp.*, PGR2021-00019, Paper 22, 10-11.

B. Application of 35 U.S.C. § 314(a) Weighs in Favor of Denying Institution

The Petition should be also be denied pursuant to 35 U.S.C. § 314(a) because, as set forth below, not only are there significant flaws in Petitioner's analysis that fail the "compelling merits" standard, but the circumstances of the parallel District Court Litigation necessitate denial of the Petition under the Board's precedent. In the Petition, Petitioner does not argue that any *Fintiv* factor, other than factor 6, supports institution. Nor has Petitioner made a *Sotera* stipulation. Every factor

considered in relation to efficiency, fairness, and the merits supports denial. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 6 (P.T.A.B. Mar. 20, 2020) (precedential).

Accordingly, the Board should exercise its discretion under § 314(a) and deny the Petition because institution of this proceeding would not be consistent with the objective of the AIA to “provide an effective and efficient alternative to district court litigation.” *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, at 20 (P.T.A.B. Sept. 12, 2018) (*quoting Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, at 16–17 (P.T.A.B. Sept. 6, 2017) (precedential))

1. No Stay Of The Parallel District Court Litigation

There is no stay of the parallel District Court Litigation. Even if the Petition were instituted and Petitioner filed a motion to stay the District Court Litigation, prejudice, tactical disadvantage to Maxell, the late stage of the litigation, and the lack of potential simplification would weigh strongly against such a motion. *See Lennon Image Techs., LLC v. Macy's Retail Holdings, Inc.*, 2:13-CV-00235-JRG, 2014 WL 4652117, at *1 (E.D. Tex. Sept. 18, 2014). The statutory deadline for institution is not until after fact discovery closes. Ex. 2001; *see Intell. Ventures II v. FedEx Corp.*, No. 2:16-cv-00980-JRG, Dkt. 141 at 5 (E.D. Tex. Oct. 24, 2017) (“The Court agrees that the Parties have already invested substantial effort and resources during discovery and in preparing claim construction briefing. . . .These

circumstances weigh against staying this case.”)

2. Proximity Of The District Court's Trial Date

The proximity of the District Court Litigation's trial date to the Board's projected statutory deadline for a Final Written Decision strongly weighs in favor of discretionary denial. The parties' trial is scheduled for May 19, 2025. Ex. 2002 at 1 (First Amended Docket Control Order). Petitioner knew of this trial date four months prior to filing its Petition. *Id.* Pursuant to 35 U.S.C. §§ 314(b)(1) and 316(a)(11), the projected statutory deadline for a Final Written Decision of this Petition is November 12, 2025.¹ As the District Court's trial will be almost six months before the projected statutory deadline, this factor weighs strongly in favor of denying institution. *See Samsung Elecs. Am., Inc. v. Uniloc 2017 LLC*, IPR2019-01218, Paper 7, at 7-10 (P.T.A.B. Jan. 7, 2020) (denying institution where jury selection was scheduled for approximately six months before trial in the Board proceeding would conclude); *Next Caller Inc. v. TrustID, Inc.*, IPR2019-00961, -00962, Paper 10, at 8-16 (P.T.A.B. Oct. 16, 2019) (denying institution where trial was scheduled to conclude “several months,” before a final decision would be due); *Cisco Sys., Inc.*, IPR2020-00122, Paper 15 at 8 (“Because the trial date is substantially earlier than the projected

¹ The Statutory deadline for institution is November 12, 2024, “three months after receiving a preliminary response to the petition under section 313.” *See* 35 U.S.C. §314(b)(1).

statutory deadline for the Board's final decision, this factor weighs in favor of discretionary denial.").

The proximity of the trial favors denial of institution.

3. Significant Investment In The Parallel Proceeding

The parties' investment in the parallel proceeding weighs in favor of discretionary denial. In the District Court Litigation, the Court has already entered a Docket Control Order (Dkt. 45), Discovery Order (Dkt. 46), and Protective Order (Dkt. 47). The Court has also conducted a *Markman* Hearing. (Dkt. 84) Discovery is also well under way, and fact discovery will be complete on October 29, 2024, about two weeks before the Institution Decision in this proceeding. Ex. 2001.

The parties have already exchanged infringement contentions and invalidity contentions, completed claim construction briefing, and a trial date is set for May 19, 2025, which is only six months after a decision on Institution. Ex. 2001. Thus, the parties' and Court's substantial investment in this proceeding weighs in favor of denial of institution under this factor. *10X Genomics, Inc. v. President and Fellows of Harvard College*, IPR2023-01299, Paper 15, at 17-18 (P.T.A.B. March 7, 2024) (finding, under similar facts, that the parties have made a substantial investment in the parallel proceeding as of the time of the Institution Decision).

4. Petitioner Fails To Offer A *Sotera* Stipulation And There Is Significant Overlap Between Issues Raised In The Petition And In The District Court Litigation

The issues in this proceeding are substantially the same as in the District Court Litigation. Here, Samsung asserts that Claims 1, 2, 4-7, and 9-14 of the '086 Patent are unpatentable. Pet. at 1. These claims cover the asserted claims against Petitioner in the District Court Litigation. Ex. 2003. The prior art that Petitioner relies on in supporting its Petition is the same as the prior art at issue in the District Court Litigation. See Ex. 2004. In light of the Director's Guidance, Petitioner's failure to make a *Sotera* stipulation weighs against institution. "When a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition *or any grounds that could have reasonably been raised in the petition*, it mitigates concerns of potentially conflicting decisions and duplicative efforts between the district court and the PTAB. See *Sotera*, Paper 12 at 18- 19." Director's Guidance at 7 (emphasis added).

Given that the Petition is directed toward the same claims, same grounds, same arguments, and significantly overlapping evidence at issue in the District Court Litigation, and since Petitioner has not sought to mitigate any of these concerns, this factor favors denial of institution.

5. The Parallel District Court Litigation And The Petition Involve The Same Parties

As noted in Patent Owner's Mandatory Notice, there exists a parallel District Court Litigation between the same parties regarding the same subject patent (the '086 Patent). See Paper 5. Petitioner is a party to the District Court Litigation. Accordingly, this factor weighs in favor of discretionary denial.

6. Other Factors Favor Discretionary Denial

Petitioner does not present a strong case on the merits, let alone a "compelling meritorious challenge," further supporting denial of institution. See *infra* Section III.F. Petitioner also does not identify any other factors which weigh against discretionary denial. Pet. at 79-80.

Thus, when viewing the factors together, the Petition should be denied in the Director's discretion under 35 U.S.C. § 314(a).

C. The Board Should Reject Any Late *Sotera* Stipulation

Petitioner has not made a *Sotera*-style stipulation that "if IPR is instituted, [Petitioner] will not pursue in the District Court Litigation any ground raised or that could have been reasonably raised in an IPR" in its Petition, which weighs further in favor of discretionarily denying institution. See *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, 13-14 (P.T.A.B. Dec. 1, 2020) (designated Dec. 17, 2020). The Board should not accept any late *Sotera* stipulation after this Patent Owner Preliminary Response. Petitioner has known about the related District Court

Litigation since Patent Owner filed a Complaint asserting infringement of the '086 Patent on September 7, 2023, over seven months before this Petition. The Court set the trial date seven months ago. Ex. 2002. Any withholding of the *Sotera* stipulation in its Petition is gamesmanship and prejudicial to Patent Owner in this proceeding, and is inconsistent with 37 C.F.R. § 42.1(b)'s mandate to "secure the just, speedy, and inexpensive resolution of every proceeding."

Both the Board and the Director are clear that Petitioners cannot wait until after the Board renders its Institution Decision to address the issue of *Fintiv* and to submit a *Sotera* stipulation. *NXP USA, Inc. v Impinj, Inc.*, IPR2021-01556, Paper 12, 5-6 (P.T.A.B. Aug. 25, 2022); *see also id.*, IPR2021-01556, Paper 13, 3-4 (P.T.A.B. Sept. 7, 2022) (the Director finding "that the Board correctly determined that a stipulation, offered by a petitioner for the first time after a decision denying institution, is not a proper basis for granting rehearing of the decision on institution;" "[p]ermitting a petitioner to wait and see if the Board denies institution under *Fintiv*, and then offer such a stipulation for the first time on rehearing, frustrates these goals [of avoiding conflicting decisions] and would open the door to gamesmanship;" "the only appropriate time for a petitioner to offer a stipulation related to the *Fintiv* factor 4 analysis is prior to the Board's decision of whether to institute review.") (emphasis added).

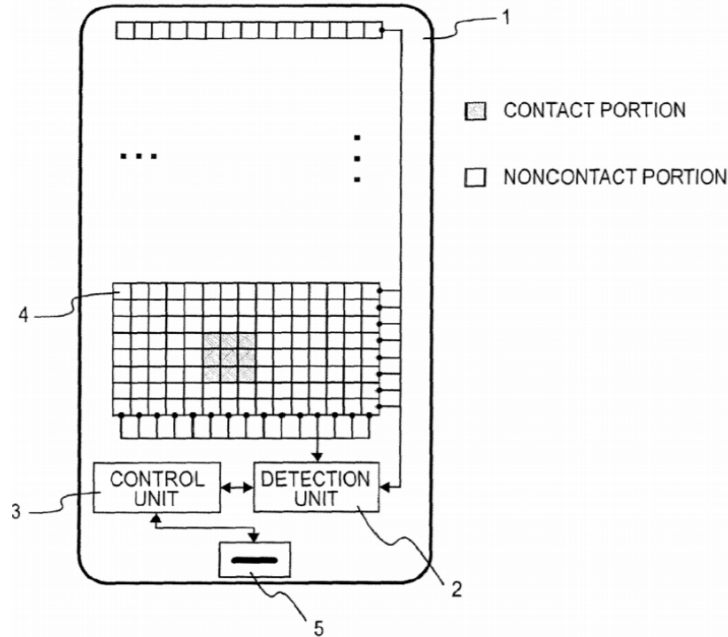
III. THE PETITION DOES NOT SHOW A REASONABLE LIKELIHOOD OF PREVAILING WITH RESPECT TO ANY CHALLENGED CLAIM

While application of §325(d) and the *Fintiv* factors weigh in favor of denial of institution, institution should also be denied because, for the reasons more fully set forth below, the petition fails to show a reasonable likelihood of prevailing with respect to any challenged claim.

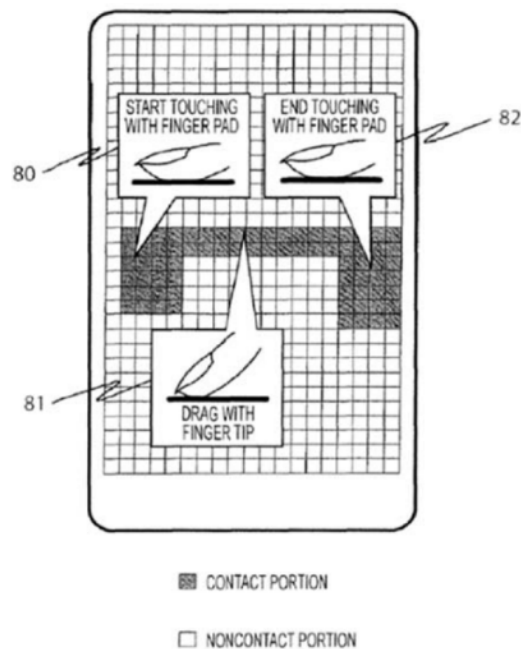
A. U.S Patent No. 8,982,086

The '086 Patent is entitled "Information Processing Apparatus." It was filed on January 14, 2014 and issued on March 17, 2015 to inventor Masaaki Yamada. The patent claims priority to U.S. Patent Application No. 13/366,983 and Japanese patent application JP 2011- 025576, filed February 9, 2011.

The '086 Patent discloses a "portable terminal" to enable various operations including tapping, dragging, flicking, pinching, and unlocking based on different types of input provided to the touch interface of the portable terminal. Ex. 1001, 3:39-49. For example, as shown in Figure 2, the touch panel in the portable terminal "includes a group of sensors or a sensor" and "when the user's finger contacts with the touch panel, capacitance of the sensor 4 changes and the sensor 4 outputs a signal according to the change." *Id.*, 3:17-20.



Ex. 1001, Fig. 2. Embodiments of the '086 Patent describe both the location and type of touch input being used by the portable terminal to allow for enhanced security and an improved user experience. As shown below in Figure 8 of the '086 Patent, the device is able to distinguish inputs entered by different regions of the finger (*e.g.*, end or pad):



Ex. 1001, Fig. 8. The portable terminal distinguishes between input methods provided by different regions of the finger. For example, a fingertip input has “an area of contact ... between the finger of the user and the touch panel 1 [that] is small,” whereas finger pad input “is characterized in that the contact range of the finger and the touch panel 1 is wider than that of the finger tip input.” *Id.*, 3:3-12. Further, a plurality of operations can be assigned to sequences of finger input methods:

DIGIT		1	2	3	4	OPERATION
PASSWORD		0	5	2	8	—
INPUT METHOD	1	FINGER TIP	FINGER PAD	FINGER PAD	FINGER PAD	WAITING SCREEN
	2	FINGER TIP	FINGER TIP	FINGER TIP	FINGER TIP	MAIL CREATING SCREEN
	3	FINGER PAD	FINGER TIP	FINGER PAD	FINGER TIP	APPLICATION STARTING

Id., Fig. 12B. “For example, in the case shown in FIG. 12B, three types of input methods are registered for one password and a specific operation is assigned for each

of them: input method 1 is for displaying a normal standby screen, input method 2 is for displaying a mail creating screen, and input method 3 is for starting an application.” Ex. 1001, 7:42-44. Using a group of capacitive sensors to distinguish between types of input entered by a user's finger enables the portable terminal to execute a variety of operations that are associated with different types of inputs. *Id.*, 7:42-44.

An example of such inputs includes an “enhanced security function that incorporates a four-digit password and a difference in the contact range” with respect to the capacitive sensors in the portable terminal being touched by different portions of the user's finger. *Id.*, 6:16-35. The portable terminals “can thus handle user's highly confidential information” and the “burden[] on the user for memorization can thus be alleviated.” *Id.*, 7:50-60.

B. '086 Patent Family Prosecution History

U.S. Application No. 14/154,993 was filed on January 14, 2014 and issued as the '086 Patent on March 17, 2015. The '086 Patent claims priority to Japanese Patent Application No. 2011-025576, filed on February 9, 2011. The '086 Patent is a continuation of U.S. Patent No. 8,654,093 (“'093 Patent”).

As detailed above, the '086 Patent was thoroughly reexamined by the PTO as Reexamination Request No. 90/014,638, which resulted in a Reexamination Certificate issued on September 28, 2021. Ex. 1004 at 3-4. All original claims were

confirmed and claims 5-15 were added during reexamination.

The '093 Patent was subject to reissue proceedings. *See* Ex. 1005. Contrary to Petitioner's characterization of those proceedings, there is adequate written support for information relating to a fingerprint. The specification includes over a **hundred** references to a user's finger and of identifying an input from the finger using "a group of sensors or a sensor whose capacitance varies upon contact with the user's finger." *See* Ex. 1001, 3:30-32; *see also id.* at Figs. 3, 4A, 4B, 8, 10A, 10B, and 11A. The specification does not state anywhere that this finger is used without fingerprints, or that the disclosed examples of identification information of "letters, figures, and symbols" cannot include fingerprints. Indeed, the specification discloses using capacitive sensors to detect touch, and there is no disclosure in the specification that these capacitive sensors are detecting the user's touch **without** detecting "information about a user's fingerprint."

C. Person Of Ordinary Skill In The Art

For purposes of this preliminary response only, Patent Owner agrees with Petitioner's definition of a POSITA.

D. Petitioner's References

The Petition raises four grounds of alleged obviousness based on the following four references. U.S. Patent No. 8,683,582 ("Rogers") (Ex. 1006), U.S. Patent Publication No. 2007/0097096 ("Rosenberg") (Ex. 1007), U.S. Patent No.

8,477,115 ("Rekimoto") (Ex. 1010), and U.S. Patent No. 8,633,909 ("Miyazawa") (Ex. 1008).

Ground	'086 Patent Claim(s)	Type of Challenge	Primary Reference	Secondary Reference(s)
1	1, 2, 4-7	§ 103	Rogers	Rosenberg
2	9-14	§ 103	Rogers	(1) Rosenberg (2) Miyazawa
3	1, 2, 4-7	§ 103	Rogers	Rekimoto
4	9-14	§ 103	Rogers	(1) Rekimoto (2) Miyazawa

1. Rogers (Ex. 1006)

Rogers, titled "Method and System for Graphical Passcode Security," issued on March 25, 2014 based on a June 16, 2008 filing date. Rogers describes a method and system for electronic access security that uses touches and movements on a touch sensitive surface to determine graphical passcode that are used in a manner similar to passwords. Graphical passcodes comprise various combinations of swipes, taps or drags on a touchscreen surface as defined by a user. A user's selected graphical passcode is stored in memory for comparison to subsequent entries of graphical passcode in order to authenticate the users. An envelope may be generated to define a range of acceptable pressure, speed, coordinate positions or other parameters, as a function of time or position, required for passcode authentication. The envelope may be stored in a computer memory and is used to authenticate a user by determine whether an entered graphical passcode falls within the envelope. Ex.

1006, Abstract.

2. Rosenberg (Ex. 1005)

Rosenberg, titled “Bimodal User Interface Paradigm for Touch Screen Devices,” is a U.S. Patent Application published on May 3, 2007 based on a January 23, 2007 filing. Rosenberg discloses a touch screen device that provides bi-modal user interaction. The touch screen device includes (a) a touch screen interface, (b) a detector to detect an area of finger interaction with the touch screen surface, and (c) a processor. The processor determines, based on at least one of a size, a shape, and an orientation of the detected area of finger interaction, whether a current finger interaction is of one of: a finger-tip interaction type and a finger-pad interaction type. The processor also selects and implements, based on a determined interaction type, one of two different targeting modes, including a first targeting mode selected and implemented in response to a determined finger-tip interaction type and a second targeting mode selected and implemented in response to a determined finger-pad interaction type. In a preferred embodiment, the first targeting mode is direct-targeting mode and the second targeting mode is an offset-targeting mode. Ex. 1005, Abstract.

3. Miyazawa (Ex. 1008)

Miyazawa, titled “Information Processing Apparatus, Input Operation Determination Method, and Input Operation Determination Program,” issued on

January 21, 2014 based on a filing date of December 29, 2010. Miyazawa discloses an information processing apparatus that includes: a touch detection unit detecting touch of an instruction object on an operation surface; a proximity detection unit detecting proximity of the instruction object to the operation surface; and a control unit determining whether the touch of the instruction object is a predetermined input operation based on the detection result, which is obtained by the touch detection unit when the touch detection unit detects the touch of the instruction object, and at least one of the detection results, which are obtained by the proximity detection unit before and after the touch of the instruction object. Ex. 1008. Abstract.

4. Rekimoto (Ex. 1010)

Rekimoto, titled “Input Device, Information Processing Apparatus, Information Processing Method, and Program,” issued on July 2, 2013 based on a filing date of June 7, 2006. Rekimoto discloses an input device that includes: a contact detector configured to detect at least a size of contact area by detecting a physical contact with a control input section; a pressure detector configured to detect a pressure applied by the physical contact; and a controller configured to output signals in response to detection outputs from the contact detector and the pressure detector. The controller outputs a first signal carrying a value which varies in response to the pressure detected under a state of contact in which a contact detection result indicates that the detected contact area is equal to or smaller than a

predetermined contact area, and outputs a second signal carrying a value which varies in response to the pressure detected under a state of contact in which the contact detection result indicates that the detected contact area is greater than the predetermined contact area. Ex. 1009, Abstract.

E. Claim Construction

It is Petitioner's burden to propose a construction and then explain how the construed claim is unpatentable under that proposed construction. See 37 C.F.R. § 42.104(b)(4). As Patent Owner explains herein, the Petition fails to meet this burden. Given the multiple reasons why the Petition should not be instituted, including 35 U.S.C. § 325(d) and 35 U.S.C. § 314, and to minimize the disputes that the Board needs to address at this preliminary stage, for the purposes of this Preliminary Response only, Patent Owner simply applies Petitioner's own constructions to show how the Petitioner has not met its burden under 37 CFR § 42.104(b)(4).

Patent Owner, however, reserves all rights to dispute Petitioner's proposed construction with the support of expert testimony to the extent the Board decides to institute review of this Petition. Any statements made herein with respect to the lack of a claim element in a prior art reference are under Petitioner's proposed constructions and should not be construed as an admission on behalf of Patent Owner that such construction is proper under the *Phillips* standard.

F. Grounds 1-4 Fail Because Neither Rogers and Rosenberg Nor Rogers and Rekimoto Render Obvious Claim Element 1[f]

Petitioner contends that Rogers or the Rogers-Rosenberg (Ground 1)/Rogers-Rekimoto (Ground 3) combination renders element 1[f] obvious.² Claim element 1[f] recites a registering mode where “in said registering mode, there are provided a first registering mode for inputting input information by a pad of the finger, and a second registering mode for inputting input information by an end of the finger, and said second information relating to the identification of the user is produced upon basis of the input information, which is inputted at least in the first or second mode.” But Rogers or the Rogers-Rosenberg combination does not disclose two registering modes. While Rogers, for example, discusses “large fingertip” and a small stylus tip to provide input during the “training session,” these inputs are not treated as or disclose two separate registering modes as claim element 1[f] requires. Rogers discloses a “training session,” not multiple modes or multiple training sessions. In contrast, claim element 1[f] requires multiple registration modes.

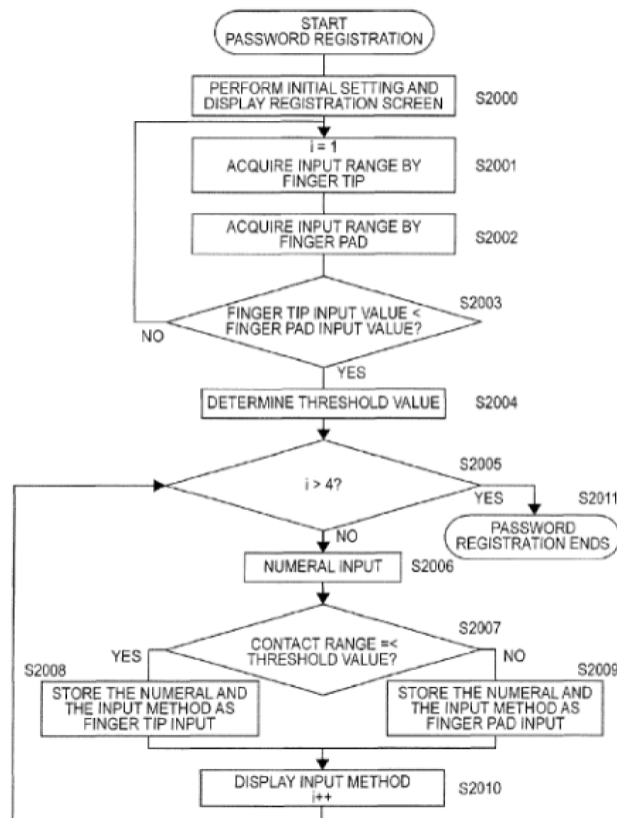
First, Rogers does not prompt the user for registering touches in two separate

² For both Grounds 1 and 3, Petitioners contend that Rogers alone renders obvious claim element 1[f]. Petitioner's addition of Rosenberg (Ground 1) and Rekimoto (Ground 3) does not save Rogers's failure to disclose two registering modes, as Petitioner does not contend that Rosenberg or Rekimoto discloses registering modes.

modes. At most, Rogers allows for a “large fingertip” and a small stylus tip because Rogers allows for fingertip/stylus size and shape information, but allowing for these size and shape scalar values (*i.e.*, real numbers) from fingertip/stylus touch areas is not the same thing (from either the user's or system's point of view) as multiple modes for registering a finger pad and finer end, like the '086 Patent discloses and claim element 1[f] requires.

Second, in the '086 Patent, the algorithms themselves regard finger pads and ends (tips) as modes. This is further support of the existence and operation of two registering modes in the '086 Patent. But in Rogers, no such algorithmic treatment of these modes is provided, so Petitioner's silence on this point is unsurprising. In the '086 Patent, for example, Figure 9 discusses the two modes in steps S2001 – S2004, and S2007 – S2009:

FIG. 9



Ex. 1001, Fig. 9, 6:28-51. Rogers neither depicts algorithms that illustrate two registering modes nor contains any explanation regarding the two registering modes claimed in the '086 Patent.

Third, in the '086 Patent, there are separate user interfaces for registering touches regarding different portions of the finger. See Figures 10A and 10B displaying different UIs during registering:

FIG. 10A

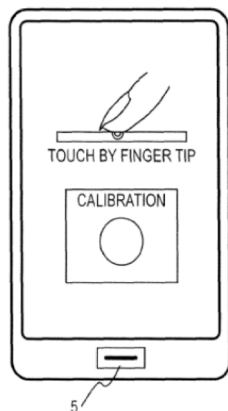
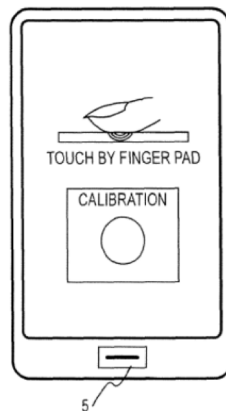


FIG. 10B



Ex. 1001, Figs. 10A and 10B; *see also* Ex. 1004 at 28, ¶65 (Expert Declaration of Jacob Wobbrock in Response to April 20, 2021 Non-Final Office Action). No registration user interfaces with different UIs exist in Rogers where different portions of the finger are registered.

Petitioner contends that Rogers discloses allowing the touch surface to “discriminate between a large fingertip and a small stylus tip.” Pet. at 31 (citing Ex. 1006, 7:56-62). Petitioner further contends that “Rogers further discloses two registration modes because the ‘training session’ for developing the thresholds, ranges or envelopes, for the measured parameters such as line thickness, involves repeated entry of the passcode to create thresholds for distinguishing between the different measured parameters, such as line thickness or contact area, for the touch inputs that make up the desired passcodes.” Pet. at 33 (citing Ex. 1006, 8:42-67). Petitioner’s characterization of Rogers is off the mark. For example, Rogers never

once uses the term “threshold.” Rather, Rogers is primarily focused on parameter envelopes, which are acceptable value ranges for touch parameters. These value ranges are also not the two claimed registering modes, but are scalar quantities that provide a range around a central (*i.e.*, mean, median, etc.) scalar quantity. Furthermore,

A POSITA would understand that the concept of a mode is a setting S such that the same action A has different results or effects based on the current value of S . Put differently, when S equals mode M_1 , then action A leads to result B_1 . But when S equals mode M_2 , then same action A leads to result B_2 . For example, with caps lock “off”, the action of hitting the “W” key is to produce a lower-case “w”. But with caps lock “on”, the same action of hitting the “W” key is to produce an upper-case “W”. The same action A produces different results (B_1, B_2) because of the current mode setting S .

Ex. 1004 at 29 (Decl. of Jacob Wobbrock, ¶68). In the '086 Patent,

touching the screen, the action A , registers values for a fingertip (Figure 10A) in one registering mode M_1 . The same action A , touching the screen, registers values for a finger pad (Figure 10B) in another registering mode M_2 . So, in Figures 10A and 10B, the two registering modes have the same action resulting in different outcomes, namely the values registered for finger tips and pads, respectively.

Id. (Decl. of Jacob Wobbrock, ¶69).

In Rogers, by contrast, there is only one mode in which the user touches the

screen to calibrate (the “initializing/training’ mode”) where at least one area is recorded. The user might touch repeatedly to create an envelope, or range, of touch area values. But there are not two registering modes. *See, e.g.*, Ex. 1006, 7:7-16, 7:65-67.

Petitioner attempts to obfuscate what is truly missing in Rogers—no two registering modes—with some misdirection, focusing on the lack of an explicit mention of a finger pad and finger tip in Rogers and utilizing Rosenberg (for Ground 1) and Rekimoto (for Ground 3), but Rosenberg and Rekimoto cannot make up for (nor does Petitioner argue) Rogers’s lack of two registering modes. Pet. at 36 (“To the extent PO argues that Rogers does not fully disclose limitation [1f] because Rogers does not explicitly recite the use of ‘finger pad’ and ‘finger tip’ inputs, Rogers in view of Rosenberg renders this limitation obvious.”); Pet. at 68 (“To the extent PO argues that Rogers does not fully disclose limitation [1f] because Rogers does not explicitly recite the use of ‘finger pad’ and ‘finger tip’ inputs, Rogers in view of Rekimoto renders this limitation obvious.”).

As such, Petitioner has not shown sufficient evidence that Rogers and Rosenberg or Rogers and Rekimoto renders obvious the two registering modes of element 1[f] of the ’086 Patent.

Claims 2, and 4-7 all depend on Claim 1, which Petitioner has not shown to be unpatentable. Therefore, Petitioner has also failed to show that Claims 2, and 4-

7 are unpatentable and thus Grounds 1 and 3 fail entirely.

Grounds 2 and 4 challenge Claims 9-14, all of which depend on Claim 1, which Petitioner has not shown to be unpatentable. Therefore, Petitioner has also failed to show that Claims 9-14 are unpatentable and thus Grounds 2 and 4 fail entirely.

IV. CONCLUSION

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

Dated: August 12, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 12th day of August, 2024, a copy of the attached PATENT OWNER PRELIMINARY RESPONSE TO PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 8,982,086, together with all exhibits was served by electronic mail to the attorneys of record, at the following addresses:

James Heintz
Jim.Heintz@us.dlapiper.com

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With a courtesy copy by electronic mail to:

dla-samsung-maxell@us.dlapiper.com

Respectfully submitted,

Date: August 12, 2024

By: /Robert G Pluta Reg No 50970/
Robert G. Pluta (Reg. No. 50,970)

Counsel for Maxell, Ltd.

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

Pursuant 37 CFR 42.24(d), the undersigned certifies that this Preliminary Response and complies with the type-volume limitation of 37 CFR §42.24(a). The word count application of the word processing program used to prepare this Preliminary Response indicates that the Preliminary Response contains 7,144 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

Respectfully submitted,

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