UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.

Petitioner

v.

SMITH INTERFACE TECHNOLOGIES, LLC

Patent Owner

IPR2024-01083
Patent 10,642,413

PATENT OWNER REQUEST FOR DIRECTOR REVIEW

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I. INTRODUCTION

The Final Written Decision (FWD) highlights a troubling pattern of generalized obviousness findings. As the Director noted for § 101, "Examiners and panels should not evaluate claims at such a high level of generality." *Ex Parte Desjardins*, Appeal No. 2024-000567 at 9 (PTAB 2025). The § 103 analysis requires the same analytical rigor.

Here, the FWD (1) found that the elements were known individually, *but not together as claimed*, and (2) found that a POSITA would have been motivated to combine the references in *one* arrangement *that does not meet the claims*. With individual elements in one hand, and a generic motivation in the other, the FWD found the claims to have been obvious. The FWD stayed at that level of abstraction, leaving unworkable gaps. Specifically, the FWD (1) found that the Ahn reference disclosed a first *feature* of the claimed "first menu," and the Hinkley reference disclosed a second *feature* of the claimed "first menu," (2) credited motivations for a combination of these references that would ***not*** include both claimed features, and (3) dismissed undisputed evidence and expert testimony that the combination with both required features "cannot be implemented."

For these reasons, the FWD is legally flawed in a way—generic obviousness findings that would not have led to the claims—that is ripe for the Director's guidance. The FWD should therefore be reversed.

II. OBVIOUSNESS REQUIRES A MOTIVATION TO COMBINE KNOWN ELEMENTS *AS ARRANGED IN THE CLAIMS*

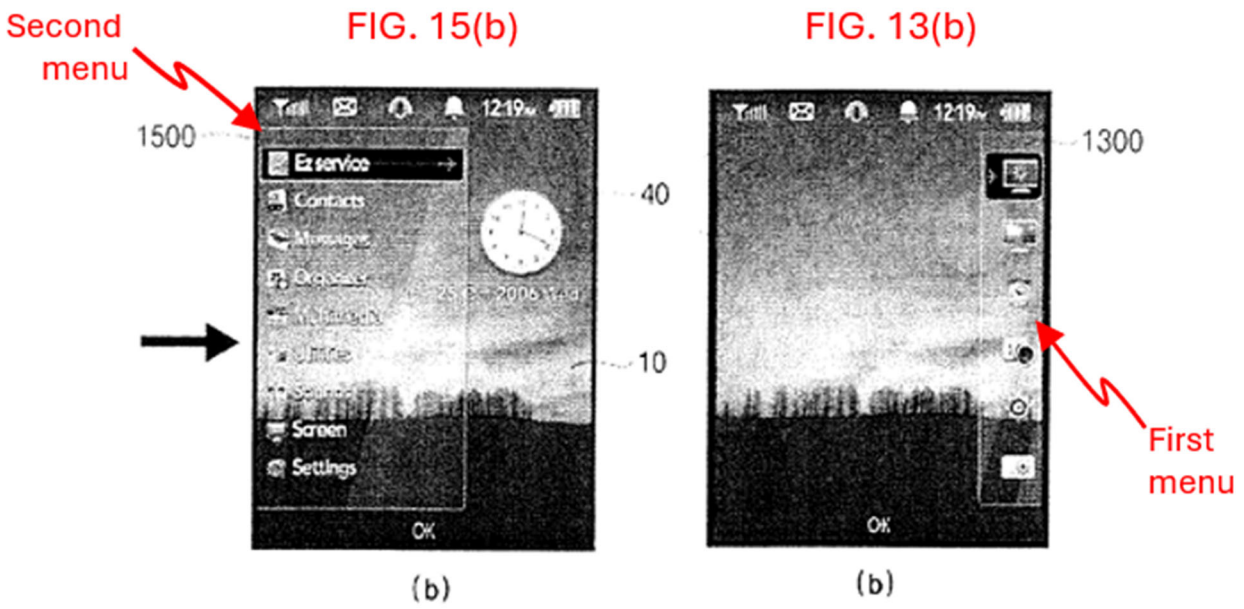
"[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006); *see also KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (quoting same). Critically, a claim is not obvious merely because its elements were individually known; there must have been "an apparent reason to combine [them] in the fashion claimed by the patent at issue." *KSR*, 550 U.S. at 418.

It is "not … enough" for the Board to find all elements of the claims in the cited references; the Board also "ha[s] to find that a [POSITA] would have been motivated to combine the prior art in the way claimed by the ['413] patent claims at issue and had a reasonable expectation of success in doing so." *Pers. Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 991. (Fed. Cir. 2017); *InTouch Techs. Inc. v. VGo Comms.*, 751 F.3d 1327 (Fed. Cir. 2014) (emphasizing the need for an articulated rationale that would have led to combining claimed elements *arranged as required by the claims*). This requires an explanation showing "how the combination of the … references was supposed to work." *Pers. Web Techs.,* 848 F.3d at 994 (an "evidence-supported account of the contemplated workings of the combination is a prerequisite to adequately explaining and supporting a conclusion that a relevant skilled artisan would have been motivated to make the combination").

Reversal is necessary here because the FWD fails to make the "prerequisite" findings to support Petitioner's purported motivation to combine. Specifically, while the FWD found all elements of the claims to be individually disclosed, separately, in Ahn and Hinckley, the FWD's explanation for why a POSITA would have been motivated to combine these references supports only a combination that does not include all claimed features. On the other hand, the combination that would have been required to actually include all claimed features, was shown by undisputed evidence to have been technically unworkable, which is diametrically opposed to any reasonable expectation of success.

III. THE FWD ERRONEOUSLY RELIES ON A MOTIVATION TO MODIFY AHN'S SECOND MENU AS EVIDENCE THAT A POSITA WOULD HAVE MODIFIED AHN'S DISTINCT FIRST MENU

Claims 1 and 101 recite two menus: "a first menu" and "a second menu." The FWD found that "the Petition maps the claimed first menu … to Ahn's [right] menu list 1300 of figure 13(b) and maps the claimed second menu … to [Ahn's left] menu list 1500 of figure 15(b)." FWD, 66-67 (Analyzing claim 101, which incorporated the mapping from claim 1); Pet., 35-36, 58-60, 77-79; EX1004, FIGs, 13(b), 15(b) (inset below).

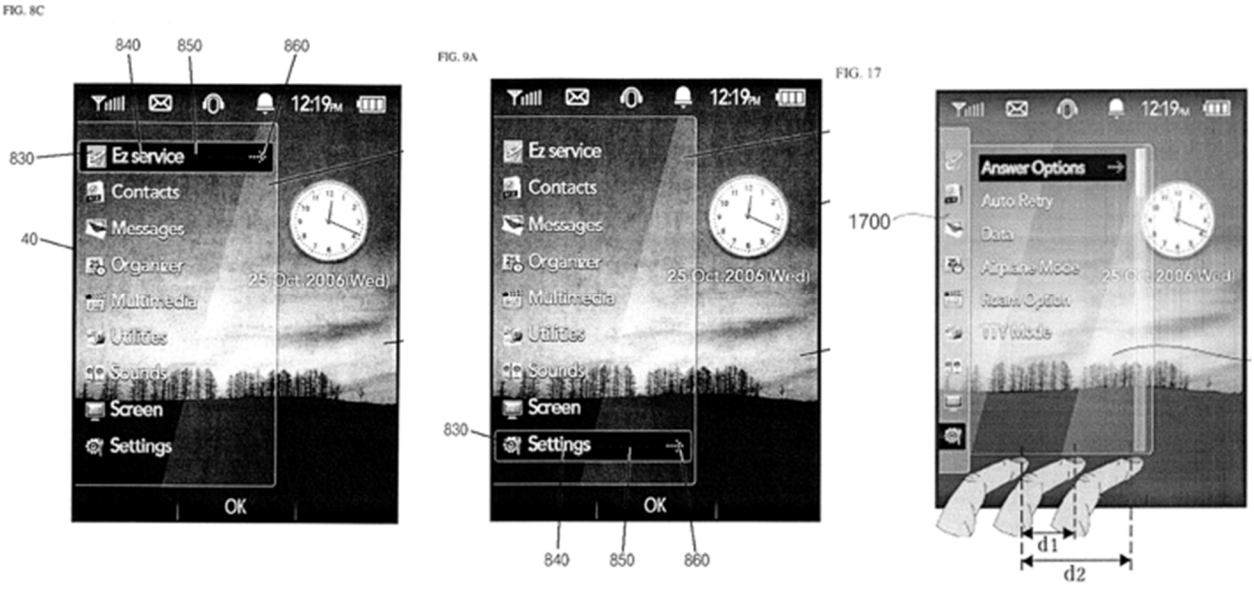


The claims require the ***first menu*** to: (1) "slid[e] in" and "blur[]" a GUI (Limitations [1.d.i-ii]) and (2) include "first menu item[(s)]" that perform two operations "in response to the first duration of contact" surpassing/not surpassing a threshold (Limitations [1.e.i-iii]). Thus, Petitioner's combination must establish Ahn's ***right*** menu 420[1]/1300 meets both the sliding/blurring operations of Limitations [1.d.i-ii] and the threshold operations of Limitations [1.e.i-iii].

It is undisputed that Ahn's menu does not disclose the threshold operations of Limitations [1.e.i-iii]; Petitioner, instead, relies on Hinckley's radial menu. Pet., 46-55. It is also undisputed that the functionality of Ahn's ***right*** menu 420/1300 "cannot

[1] Ahn provides two reference numbers (420, 1300) to describe an identical right menu. EX1004, FIGs. 4B, 13(b).

be implemented by a radial menu." EX2006, ¶¶115-117; POR, 43; Sur-reply, 16. The FWD tacitly recognized that "some icons [of Ahn's menus] would not benefit from a radial menu"—presumably the icons of Ahn's ***right*** menu—but found that a POSITA would have been motivated to include a radial menu because the POSITA "would have recognized that ***other icons*** would benefit," such as the icons shown in "figure 8C" and "figure 17" that are found in Ahn's ***left menu*** 820/1500 FWD, 28-29; EX1004, FIG. 8C, 9A, 17 (inset below).



The FWD articulated only a motivation to incorporate a radial menu into Ahn's ***left menu***—mapped to the claimed "second menu." But that does not explain why a POSITA would have been motivated modify Ahn's ***right menu***, especially because undisputed evidence shows that Ahn's right and left menus are materially different. The FWD therefore erroneously premised its motivation analysis on a combination that does not meet the claims. *See* FWD, 26-32 (discussing only Ahn's left menu).

A. Petitioner Must Modify Ahn's Right Menu to Add a Radial Menu

To meet the "blurring" features described in Limitations [1.d.i-ii], Petitioner relies on Ahn's right menu opening to blur the "clock widget" in Ahn's standby screen. Pet., 40-45. The only menu that is asserted to perform "blurring" the GUI—as required by Limitations [1.d.i-ii]—is Ahn's right menu 420/1300, shown in FIGs. 4B and 13(b). Pet., 35-42, FWD, 34, EX2005, 111:3-14 (Petitioner's expert conceding Ahn's left menu does not blur the GUI); EX2006, ¶¶114, 139-140; EX1004, FIGs. 3A-3E, 6B, 7B-7C, 9A-9B, and 17 (depicted top, bottom, and left menus being opened without 'blurring' the clock). Thus, only Ahn's right menu 420/1300 can be the "first menu" of Limitation [1.d.i].

Petitioner does not allege that Ahn discloses the threshold operations (Limitations [1.e.i-iii]) of the claimed "first menu," instead relying on the radial menu of Hinckley for disclosing this feature. Pet., 46-55. Thus, to meet both requirements of the claimed "first menu," Petitioner must show a POSITA would have been motivated to modify Ahn's right menu 420/1300 to incorporate Hinckley's radial menu. POR, 41-42; Limitations [1.d.i] ("first menu" includes "first menu items"), [1.e.i-iii] (describing functionality of the "first menu items").

B. It Is Undisputed That the Functionality of Ahn's Right Menu Could Not Have Been Implemented as a Radial Menu

The Petition contends that "the implementation and operation of the bezel menus and radial menus[] would have been a simple substitution of one known element for another to obtain predictable results." Pet., 26.

As explained in the POR, "a POSITA would have understood that the functionality described for Ahn's sub-menus 420a-420f cannot be implemented by a radial menu." EX2006, ¶115; POR, 43. The selection of Ahn's sub-menus 420a-420f displays a corresponding "window"—"brightness setting window 510," "standby screen setting window 520," and "alarm setting window 540." EX1004, ¶¶[0053]-[0057], FIGs. 5A-5D. Each of the described windows[2] include functionality that could not have been implemented as a radial menu. EX2006, ¶¶115-117 (identifying "binary toggles" and "numerical inputs" of window 540, "scrolling icons" and "number of options" of window 520, and "slider bar" of window 510 as being incompatible with radial menus), POR, 41-45. Thus, a POSITA would have understood that Hinkley's radial menu was ***not*** a "simple substitution" for Ahn's right menu 420/1300. EX2006, ¶¶72-73, 103, 117; POR, 36-37.

[2] Ahn does not describe or depict windows related to bell sound setting menu 420d, initial value setting menu 420e, or camera menu 420f.

Neither Petitioner nor its expert disputed the incompatibility between Ahn's right menu 420/1300 and Hinckley's radial menus. *See* Reply, 11-20, EX1023 ¶¶26-33. Instead, Petitioner attempted to characterize that technical incompatibility as premised on a "bodily incorporation" argument, which is legally incorrect. *Id.* The FWD did not credit that "bodily incorporation" characterization, instead seeming to tacitly concede "some icons would not benefit from a radial menu." FWD, 29-30 (citing POR, 42-51); POR, 42-45 (describing incompatibility of radial menus with Ahn's right menu). While the FWD found icons 830/1714 in Ahn's left menu 820/1700—the ***second menu***—would have benefited from a radial menu (FWD, 29-30), the FWD makes no finding that Ahn's right menu 420/1300 would have benefited from adding a radial menu, much less that doing so was even possible. *See generally* FWD; POR, 46; EX2006, ¶118 ("Ahn's left side menus 1700 and 1710 cannot meet the requirements for the claimed first menu and, therefore, are irrelevant to … the operations of "the one or more first menu items" of the first menu.").

Accordingly, there is no evidence or argument that Ahn's right menu 420/1300—the ***first menu***—would have benefited from a radial menu and it is undisputed that Ahn's right menu 420/1300 "cannot be implemented by a radial menu." EX2006, ¶¶115-117, POR, 41-45, Sur-reply, 15-17. Thus, the FWD's finding that Ahn's left menu 820/1700 would benefit from a radial menu (FWD, 28-30) fails to support any combination that might have met the claimed features. *Id.*

C. The FWD's Analysis of Ahn's Second Menu Or Hinckley's Bezel Menu/Gestures Does Not Explain Why a POSITA Would Have Modified Ahn's Right Menu

Petitioner provides two "independent reasons" to support its Hinckley modification: "[f]irst" that "the techniques described in Hinkley with respect to its bezel menus would have been equally beneficial in the context of Ahn's side menus" (Pet., 24) and "[s]econd" that "the implementation and operation of the bezel menus and radial menus[] would have been a simple substitution of one known element for another to obtain predictable results" (*id.*, 26). The only explicit discussion of Hinckley's "radial menu" in Petitioner's motivations is in relation the debunked "simple substitution" theory. *See supra*, III.B. Further, as explained below, the FWD's findings regarding the 'first' independent reason offer no basis to support the notion that a POSITA would have modified Ahn's right menu 420/1300 to incorporate Hinckley's radial menu as is required to arrive at the claimed features.

To start, the FWD's finding radial menus would benefit icons in Ahn's ***left*** menu 820/1700—"such as icons that display ***sub-menus*** when selected" (e.g., icon 830 of FIG. 8C) (FWD, 29))"—does not provide a reason as to why a POSITA would have modified Ahn's ***right*** menu 420/1300, which is a distinct menu that performs different functions. Sur-Reply, 31. Unlike Ahn's left menu 820/1700 which opens up another "***sub-menu*** 870" or "second menu list 1710" with further cascade menus (EX1004, ¶¶[0082], [0111]), Ahn's right menu 420/1300 opens up a UI "***window***"

for the user to interact with (EX1004, ¶¶[0053]-[0057]). *Compare* EX1004 FIGs. 5A-5D (displaying windows) *with* FIGs. 9B, 17 (displaying sub-menus). Ahn's right menu 420/1300 is configured "for the user to easily enter a menu in which the user frequently uses" (EX1004, ¶[0051]) and its icons "perform[] different functions" than the icons of left menu 820/1700. Sur-Reply, 31. Thus, the FWD's finding of benefits for "icons that display ***sub-menus*** when selected" (FWD, 29)) cannot explain why a POSITA would modify the icons 420a-420f of Ahn's right menu 420/1300 that perform a different function of displaying "windows"—***not*** sub-menus—when selected. For the same reason, the FWD's finding that a POSITA "would have replaced an icon of Ahn that performs the single function of revealing another menu with Hinckley's icon 1712 including radial menu icon 1714" (FWD, 29) is irrelevant to the icons of Ahn's right menu 420/1300 that reveal UI windows—not "another menu." *Compare* EX1004, ¶[0082] (revealing menu 870 in FIG. 9B) *with id.*, at ¶[0057] (revealing alarm setting window 540 in FIG. 5D).

The FWD also credits four benefits associated with Petitioner's 'first' motivation, which also fail to explain why a POSITA would have implemented a radial menu into Ahn's right menu 420/1300. FWD, 26-28. Only two of the cited reasons relate to radial menus: (a) conservation of screen real estate without

"permanently manifesting"[3] the menu and (d) providing different gestural modes (FWD, 26-27). At best, this explains why a POSITA would implement a radial menu generally; but fails to explain why a POSITA would have implemented this radial menu into Ahn's ***right menu***, the only place it might have met the claimed features, despite destroying the functionality of Ahn's right menu 420/1300. EX2006, ¶¶114-118. Further, "differentiat[ing] bezel gestures from other similar gestures" (i.e., swipe gestures) is irrelevant to modifying Ahn's right menu to include a radial menu that responds to a tap/tap-and-hold. FWD, 26; *see POR*, 40-41. And the fact that Ahn and Hickley each "display[] a menu on a touch screen" is so generic as to be meaningless—*i.e.*, is legally deficient. *Johns Manville Corp. v. Knauf Insulation, Inc.*, IPR2018-00827, Paper 9 at 10 (Informative) (October 16, 2018) ("Mere compatibility of the references is likewise not sufficient" to "establish that one of ordinary skill would have had reason to combine its teachings with other prior art ***in the manner set forth in the claim***.").

The FWD's citation to *Qualcomm* only underscores its erroneous conclusion. FWD, 30 (citing *Intel Corp. v. Qualcomm Inc.*, 21 F.4th 784, 800 (Fed. Cir. 2021)). While noting it is only necessary to show that a combination be a *suitable* option,

[3] Ahn's menus are also not "permanently" displayed on the screen (EX1004, ¶¶[0053]-[0057], FIGs. 3A-8A)

the FWD fails to find or support that the combination needed for *all* claimed features—incorporating a radial menu ***into Ahn's right menu***—would have been suitable. Instead, the FWD focused on radial menus in the abstract and whether a radial menu could be used in Ahn's mobile device at all. FWD, 30-31 ((1) emphasizing generic "benefits of a radial menu over a linear menu" and noting that the evidence "weighs advantages and disadvantages of a pie menu," (2) finding "a [POSITA] would have implemented Hinckley's radial menu in a mobile telephone," finding "a [POSITA] would have used Hinckley's radial menu in Ahn's mobile device," and finding a POSITA had reason to "implement[] Hinckley's radial menu in Ahn's mobile device"). But the claim does not recite merely a mobile device with a radial menu, but a "first menu" that operates in the specific manner of Limitations [1.d.i]-[1.e.iii]. And the sole combination that might include all claimed features is, undisputedly, ***unsuitable***. EX2006, ¶115 ("the functionality described for Ahn's sub-menus 420a-420f cannot be implemented by a radial menu").

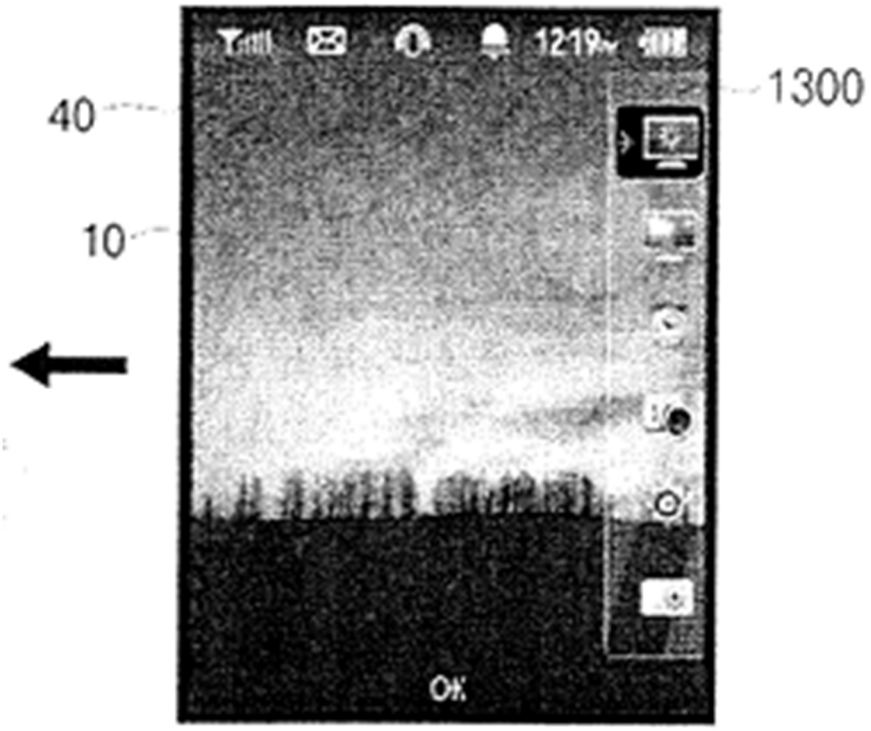
"Petitioner merely identifies Hinckley's radial menu and concludes it obvious to implement into Ahn, supplying only generic reasons for the combination without explaining how or why a POSITA would have done so" *in a way that meets the claims*. Sur-Reply, 22. The FWD followed suit, providing only a generic analysis of radial menus—divorced any combination that meets the claims—that relies solely on purported benefits of other combinations that do not include all claimed features.

D. The FWD's Sole Analysis of Ahn's Right Menu Highlights Its Deficiencies

In analyzing Limitation [101d], the FWD disagreed "that the Petition does not explain why a radial menu icon would have been included in menu list 1300 for the reasons given in our analysis of the reasons to combine the teachings of Ahn and Hinckley above."[4] FWD, 66. The FWD reiterates that "other icons" would benefit from radial menus "such as the icons that display sub-menus when selected, such as the ***settings icon*** of figure 13(b)." *Id.* (no citations). This single sentence represents the entirety of the FWD's analysis on the implementation of a radial menu in Ahn's right menu 420/1300. *See generally* FWD. However, this finding is an unevidenced assertion that is contradicted by Ahn and was never advanced in the record.

To start, the term "settings icon" does not appear in any paper of record. It appears the FWD is relying on the "value setting menu 420e" illustrated by the gear icon in Ahn's FIG. 13(b) (inset below). *See* EX1004, ¶[0051], FIG. 4B.

[4] As explained in Sections III.B-C, the Board provides no such reasoning "above." Outside of listing PO's arguments, the Board's analysis for combining Ahn and Hinckley fail to ever mention menu "1300," menu "420," or any other reference to Ahn's right menu. FWD, 21-32



However, Ahn explains that the icons 420a-420e opens a UI "window" when they are selected, not sub-menus. EX1004, ¶¶[0052]-[0057]; *supra* §III.C. Thus, Ahn ***directly contradicts*** the FWD's assertion that "the settings icon of figure 13(b)" would "display sub-menus when selected." FWD, 67.

Neither Petitioner nor Petitioner's expert ever discuss the "value setting menu 420e" (or any "setting" icon). *See generally* Pet., Reply, EX1003, EX1023. Nor does Petitioner or Petitioner's expert assert that selection of the "value setting menu 420e" displays a "sub-menu[]" as the FWD asserts (FWD, 67). *See generally* Pet., Reply, EX1003, EX1023. Accordingly, the FWD assertion that value setting menu 420e would benefit from a radial menu lacks any evidentiary report and is contrary

to the record. *See* EX2006, ¶115 ("a POSITA would have understood that the functionality described for Ahn's sub-menus 420a-420f cannot be implemented by a radial menu.").

IV. CONCLUSION

The FWD legally erred by providing an overgeneralized finding of obviousness that failed to articulate any motivation to combine the prior art in the way claimed by the '413 patent claims with a reasonable expectation of success. At best, the FWD finds that a POSITA would have been motivated to combine the references in a manner *that does not meet the claims*. For these reasons, the Final Written Decision should be reversed.

Dated: February 25, 2026

Respectfully submitted,

/Eagle H. Robinson/

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Reg. No. 61,361

Lead Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on February 25, 2026, a complete copy of this PATENT OWNER REQUEST FOR DIRECTOR REVIEW was served on Petitioner via email (by consent), at the following email address(s):

IPR50095-0163IP1@fr.com

/Eagle H. Robinson/
Eagle H. Robinson, Reg. No. 61,361