

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.

Petitioner

v.

SMITH INTERFACE TECHNOLOGIES, LLC

Patent Owner

IPR2024-01088
Patent 10,656,758

PATENT OWNER REQUEST FOR DIRECTOR REVIEW

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I. INTRODUCTION

Respectfully, the Final Written Decision (“FWD”) is legally flawed and should be reversed. The FWD legally erred in ways that raise an important policy issue, namely ensuring that the Board faithfully requires Petitioners to articulate a rationale that—without using the claims as roadmap—would have led a POSITA to combine all elements as arranged in the claims. The Petition reaches the *claimed* trigger for “displaying one or more action objects” only through three stages of modification, each time: (1) offering no motivation to make the modification at that stage and (2) then declaring the result of that very modification inadequate as a pretext for reaching the next stage. At each stage, the FWD excuses or ignores the signs of improper hindsight that case law mandates avoiding—no articulated motivation, and admitted downsides of the proposed modification with no benefit.

The credited ground combined three references: Chaudhri, Martyn, and Griffin. In a First Stage, the FWD relied on Martyn for two modifications to Chaudhri: (1) adding Martyn’s contextual sub-menu, and (2) adopting one of Martyn’s actions to access, or call, that sub-menu: a press-and-hold on a navigation button. But the Petition did not offer any motivation or rationale for selecting the press-and-hold. Instead, the Petition and FWD bundled the two modifications yet relied only on the sub-menu motivations to justify using a press-and-hold on a navigation button for that purpose. The FWD thus legally erred by relying on a

rationale that—on its face—offers no motivation for modifying Chaudhri to use a press-and-hold on a navigation button to call the sub-menu.

Even assuming adopting a press-and-hold on a navigation button was justified, that should have been the end of the modifications because a press-and-hold on a navigation button could be successfully implemented in Chaudhri. But that would not meet the claims, which require “detecting the first single-finger touch input *at a location ... that corresponds to a first application icon.*” Using only the claims as a guide, the Petition then moved on to a Second Stage, in which Petitioner converted Martyn’s press-and-hold *on a navigation button* to a purported touch screen “analog” of a touch-and-hold *on an application icon*. Again, the Petition and FWD failed to identify any motivation for this Second Stage modification.

The pattern continued. Petitioner acknowledged that the Second Stage modification does *not* result in a usable device. Rather, it *unnecessarily* creates a “problem” because Chaudhri already uses a touch-and-hold gesture on an application icon for a different purpose. Rather than seek to avoid it, the Petition used this “problem” (of Petitioner’s own making) as a pretext to, in a Third Stage, add a third reference—Griffin—for further modifications. The FWD dismissed that issue as solely one of whether introducing a *secondary* problem teaches away. But that framing erroneously neglected PO’s primary argument that the modification, without any motivation, yielded *only* an avoidable problem with *no* benefit.

Rightly reluctant to fully endorse Petitioner’s logic of relying on its self-created conflict to reach Griffin, the FWD instead found that a POSITA would have looked to Griffin to understand how Chaudhri distinguished between types of gestures. But that rings hollow. There was no need to distinguish between two touch-and-hold gestures at the same location, but for the original sin of modifying Chaudhri—without motivation—to use a touch-and-hold gesture on an application icon—already in use for another purpose—to call the sub-menu.

The FWD legally erred by relying on an incomplete rationale that would *not* have led a POSITA to the purported combination and ignoring the lack of any rationales and admitted flaws at each stage of modifications, which are the hallmarks of hindsight. The Final Written Decision should therefore be reversed.

II. OBVIOUSNESS DEMANDS A RATIONALE THAT—WITHOUT THE CLAIMS THEMSELVES—WOULD HAVE LED A POSITA 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). The Supreme Court in *Graham* provided the framework: “the scope and content of the prior art are ... determined; differences between the prior art and the claims at issue are ... ascertained; and the level of ordinary skill in

the pertinent art resolved” so that, “[a]gainst this background, the obviousness or nonobviousness of the subject matter is determined.” *KSR*, 550 U.S. at 399 (quoting *Graham v. John Deere of Kan. City*, 383 U.S. 1, 17-18 (1966)).

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. The Federal Circuit has repeatedly emphasized the need for an articulated rationale that would have led to combining claimed elements *arranged as required by the claims*. See, e.g., *InTouch Techs. Inc. v. VGo Comms.*, 751 F.3d 1327 (Fed. Cir. 2014) (reversing a jury verdict of obviousness). In *InTouch*, the Federal Circuit faulted expert testimony that “opined that all the references were like separate pieces of a simple jigsaw puzzle, [but] did not explain what reason or motivation one of ordinary skill in the art ... would have had to place those pieces together.” *Id.* at 1349. This “was nothing more than impermissible hindsight” because it “failed to provide the glue to combine those references [with all elements as in the claims].” *Id.* at 1348.

Likewise, in *PersonalWeb Techs., LLC v. Apple, Inc.*, the Federal Circuit held that “reasoning” that “say[s] no more than that a skilled artisan, once presented with the two references, would have understood that they *could* be combined” is “not enough”—there must be “a motivation to pick out those two references and combine them to arrive at the claimed invention.” 848 F.3d 987, 993-94 (Fed. Cir. 2017)

(citing *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015); *InTouch Techs., Inc.*, 805 F.3d at 1073).

Reversal is necessary here because the FWD relies on a similar error as in *InTouch* and *PersonalWeb*. Specifically, while the FWD credited motivations for *some* of the required modifications, its legal conclusion of obviousness relies on further modifications for which there is no motivation or rationale. Stated in *InTouch*'s terms, the Petition and FWD offer glue for just *some* of the puzzle pieces.

Further, the FWD identified *no* case law that supports obviousness based on a modification, without motivation, that solves *no* problem while admittedly *creating* a new problem—and common sense dictates otherwise. *See* FWD, 22 (citing *Intel Corp. v. Qualcomm Inc.*, 21 F.4th 784, 799 (Fed. Cir. 2021). In *Qualcomm*, the “problem of their own making” was a *second* problem created by a first modification that solved a *first* problem of seeking to “improve energy efficiency by turning off a portion Der’s circuit.” *Qualcomm*, 21 F.4th at 796-97. Thus, while it may be permissible to adopt a modification that successfully solves a first problem even where it “triggered a known [second] problem,” there is no apparent precedent for a finding of obviousness premised on a modification that only *creates* a new problem, without first generating some benefit.

III. THE BOARD ERRED BY FAILING TO REQUIRE MOTIVATIONS THAT WOULD HAVE LED TO *ALL* OF NEEDED MODIFICATIONS

A. The Petition and FWD Relied On Martyn For Three Separate Modifications of Chaudri

The Petition contended it would have been obvious “to integrate Martyn’s ... [1] contextual shortcut sub-menu in the form of a “summary window” of common application functions (an “App Snapshot”) [2] in response to a press-and-hold user input with Chaudhri’s disclosure of a touch screen mobile device with a user interface for displaying and reorganizing a menu of selectable application icons.” Pet., 16 (citing EX1003, ¶¶63-69); FWD, 17-18. This single sentence requires three different modifications: (a) adding Martyn’s context menu to Chaudhri, (b) adopting but not actually adding Martyn’s press-and-hold *on a navigation button* to Chaudhri and (c) abandoning Martyn’s press-and-hold *on a navigation button* and, instead, using a purported touch screen “analog” of a touch-and-hold *on an application icon*. See, e.g., POR, 31-32.

Martyn discloses at least six methods of calling its contextual sub-menu. POR, 22-23 (citing EX1005, [0016]-[0017]). The Petition, without explanation, selects one of those six methods: “a press and hold of the select function when an application name is highlighted.” Pet., 16-17. But the Petition did not proceed to add that functionality to Chaudhri. Instead, the Petition proposed adding a *touch-and-hold on an application icon* to Chaudhri with the only explanation being that

“the analog to Martyn’s press-and-hold input on a touch screen like Chaudhri’s is the well-known touch-and-hold gesture.” Pet., 16 (citing EX1003, ¶¶63, 49-53).

But the record is clear that Chaudhri discloses click wheels, virtual and physical, so a trigger for the sub-menu could have been added using Martyn’s actual gesture (*press*-and-hold) on Chaudhri’s existing click wheel. EX1004, [0093]; POR, 45; FWD, 19-20. Thus, calling the sub-menu with a *touch*-and-hold on an application icon in the combination requires: *first*, illogically severing the call link between Martyn’s press-and-hold on a button and Martyn’s contextual sub-menu and, *second*, unnecessarily modifying Chaudhri to add a second function to its pre-existing touch-and-hold (even though Chaudhri’s click wheel was the more-logical, available option).

B. The Petition and FWD Relied On Motivations Applicable Only to the First Martyn Modification to Support All Three Modifications

The Petition listed four separate reasons a POSITA would have been motivated *to add Martyn’s contextual sub-menu into Chaudhri*. Pet., 16-19; FWD, 17-18. First, adding a sub-menu was ubiquitous in computer GUIs. *Id.*, 16. Second, adding a sub-menu improves usability. *Id.*, 17. Third, Martyn discloses advantages of its sub-menu. *Id.*, 17-18. Fourth, Chaudhri suggests sub-menus. *Id.*, 18.

C. The Petition and FWD Are Devoid Of Any Motivation or Rationale That Would Have Led To A Touch-and-Hold On an Icon

None of Petitioner's motivations for adding Martyn's sub-menu to Chaudhri address any differences among Martyn's calling methods, let alone an advantage for the one plucked by Petitioner: "a press and hold of the Select function when an application name is highlighted." Even worse, the further change from press-and-hold on a navigation button to touch-and-hold on an application icon ignored available combinations within the explicit disclosures of Chaudhri and Martyn that would have avoided the admitted problem altogether. Chaudhri already had a click wheel that could have directly implemented Martyn's original press-and-hold gesture, leaving no need for the further change. Looking past those options, without explanation, the Petition simply mentions in passing that "the analog to Martyn's press-and-hold input on a touch screen like Chaudhri's is the well-known touch-and-hold gesture." Pet., 16 (citing EX1003, ¶¶63, 49-53). Petitioner's expert merely parroted the same sentence, noted that touch-and-hold gestures were known, and repeated, without support, that "a touch-and-hold gesture on a touch screen *is analogous to* a press and hold of a physical button." EX1003, ¶63, fn.3 (emphasis added). The lack of support for that assertion should have deprived it of weight. Consolidated Trial Practice Guide at 35, 40 (PTAB Nov. 2019). Yet the FWD credited this bare assertion of analogousness of a touch screen touch-and-hold to Martyn's press-and-hold on a navigation button. FWD, 19.

Importantly, the assertion of analogousness tacitly concedes that Martyn’s “press and hold of a physical button” is *not the same as* “a touch-and hold gesture on a touch screen.” As such, not only did the Petition fail to offer any rationale or motivation for using Martyn’s press-and-hold of a button to call the combination’s added sub-menu, the Petition also failed to offer any rationale or motivation to *shift* from that press-and-hold on a navigation key *to* a touch-and-hold on an application icon for that function. Nor did the FWD offer anything else to support a *motivation* for using Chaudhri’s already-assigned touch-and-hold gesture to also call the sub-menu. FWD, 19 (pointing only to general analogousness). That deficiency should have been the end of Petitioner’s contention that the Chaudhri-Martyn combination would use a touch-and-hold to call the sub-menu. *InTouch*, 751 F.3d at 1348-49.

IV. THE BOARD ERRED BY IMPROPERLY FRAMING AND DISMISSING THE FACT THAT THE COMBINATION CREATED A PROBLEM WITHOUT ANY CORRESPONDING BENEFIT

Despite the lack of rationale or motivation for further modifying Chaudhri to call Martyn’s sub-menu with a touch-and-hold gesture, the FWD pressed on. This despite the fact that Chaudhri already used a touch-and-hold for a different purpose, meaning this modification created a problem without any corresponding benefit. And despite the fact that Chaudhri also disclosed a click wheel that is plainly more analogous to Martyn’s navigation button, meaning the problem was unnecessary.

A. The Lack of Motivation to Use a Touch-and-Hold Gesture for the Sub-Menu Is Glaring Because It Creates an Unnecessary Problem

The Petition conceded that assigning “a touch-and-hold” on an application icon “to trigger” Martyn’s App Snapshot creates a “*problem* of distinguishing between the different gesture commands” because it *conflicts* with Chaudhri’s existing assignment of the “touch-and-hold” on an application icon “to transition into the reconfiguration mode.” Pet., 21. The Reply did not dispute this “problem.” Reply, 15-23. To the contrary, Petitioner’s creation of this problem was a self-serving, hindsight-driven pretext to further modify the combination with Griffin’s differentiation of gestures based on duration. Pet., 20-21.

As noted above, Martyn used a press-and-hold gesture on a navigation button to call its sub-menu. Pet., 16-17; EX1005, [0016]-[0017]; EX1003, ¶63, fn.3. Chaudhri already discloses using such a click wheel to “navigate among and interact with ... icons” by “press[ing] down on ... the click wheel.” POR, 45-46 (quoting EX1004, [0093]; citing EX2005, ¶¶130-131). Thus, Martyn’s sub-menu and its *original* press-and-hold on a navigation button could be added to Chaudhri without adding a second, conflicting function (calling the sub-menu) to Chaudhri’s existing touch-and-hold gesture. POR, 45-46 (citing EX2005, ¶131). Indeed, Martyn also offered “[o]ther selection processes”—recognized by Petitioner’s expert—that also would have avoided the conflict. Thus, the problem of Petitioner’s theory was entirely avoidable. POR, 46.

**B. The FWD Erred By Crediting Petitioner's Expert's
Reinterpretation of Chaudhri Over Chaudhri's Explicit Disclosure**

Chaudhri discusses, in detail, a click wheel that could be physical *or virtual*. POR, 45-46 (citing EX1004, [0093]). Nonetheless, the FWD dismissed this existing option based on the notion that touch-screen gestures were “far more aligned” with Chaudhri as a whole. FWD, 19-20. That is factually and legally erroneous for at least two reasons. First, the FWD brushes aside Chaudhri's own explicit disclosure of that click wheel, which flies in the face of the Board's duty to faithfully determine “the scope and content of the prior art.” *KSR*, 550 U.S. 399 (citation omitted). Second, the FWD's *assumption* that a click wheel would not use “touch-screen gestures” further neglects Chaudhri's explicit teaching that such click wheels can be *virtual*—*i.e.*, operated via “touch-screen gestures.” POR, 45-46 (quoting EX1004, [0093]) (“physical or *virtual* wheel”). Thus, even assuming “touch-screen gestures” are “more aligned” with Chaudhri, that would not support the idea that a touch-and-hold is more of a touch-screen gesture than a *press*-and-hold on a *virtual* click wheel. The FWD therefore legally erred by neglecting Chaudhri's explicit disclosure, and baselessly concluded that a click wheel would not use “touch-screen gestures.” Moreover, the FWD's dismissal of the *functional* alternatives due to purported drawbacks stands in contrast to the FWD's acceptance of the Petition's proposed use of a touch-and-hold on an application icon that was *non-functional* because it conflicted with Chaudhri's existing functionality.

C. The FWD Further Erred By Framing the Problem As a Mere Secondary Drawback Accompanying a Primary Benefit

As explained above, modifying Chaudhri to assign a second function to the touch-and-hold gesture on an application icon had *no advantages*. See also POR, 42-44. Doing so breaks the device. As such, the only result of that modification was to create a *disadvantage*, meaning there was no “simultaneous” advantage. The FWD therefore legally erred by framing that unnecessary problem as one of “simultaneous advantages and disadvantages.” FWD, 22 (citing *Qualcomm*, 21 F.4th at 799). To the contrary, the Board should have first looked to whether the Petition offered a motivation or benefit of using the touch-and-hold gesture on an application icon in Chaudhri (it did not) and, only if that threshold showing had been met, consider weighing disadvantages. But the Petition failed to identify *any* advantage or motivation for that modification to Chaudhri, and *Qualcomm* therefore offers no support for disregarding its solely disadvantageous result.

D. The Petition’s Hindsight Is Laid Bare By Its Use of the Unnecessary Problem as a Pretext for Adding Griffin

The Petition conceded that assigning “a touch-and-hold” on an application icon “to trigger” Martyn’s App Snapshot creates a “*problem* of distinguishing between the different gesture commands” because it *conflicts* with Chaudhri’s existing assignment of the “touch-and-hold” on an application icon “to transition into the reconfiguration mode.” Pet., 21 (emphasis added). As explained above,

that problem was unnecessary. Petitioner created it anyway; not for any benefit that would have motivated a POSITA to do so, but to justify further modifying Chaudhri-Martyn with Griffin's approach to differentiating gestures of different duration. Pet., 20-21. The FWD dismissed this concern because "Petitioner describes the use of Griffin for its disclosure not just to distinguish between two long-duration gestures, but also to provide detail regarding the distinction between the tap and touch-and-hold gestures described in Chaudhri on its own and used in the asserted combination of art." FWD, 23 (citations omitted). Even if correct, a generic reason to consult Griffin offers no reason to import its teachings about "distinguishing between two long-duration gestures." Yet neither the Petition nor the FWD articulate any "glue" for that necessary "puzzle piece" from Griffin. *InTouch*, 751 F.3d at 1348-49.

V. CONCLUSION

The FWD legally erred by finding obviousness without a motivation or rationale that would have led a POSITA to the claims. For these reasons, the FWD should be reversed.

Dated: February 13, 2026

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on February 13, 2026, complete copies of this PATENT OWNER REQUEST FOR DIRECTOR REVIEW was served on Petitioner via email (by consent), at the following email address(s):

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