

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner,

v.

SMITH INTERFACE TECHNOLOGIES, LLC
Patent Owner.

Case IPR2024-01088
Patent 10,656,758

AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST

TABLE OF CONTENTS

I.	Introduction.....	1
II.	The Law Rejects Smith’s Piecemeal Analysis: Obviousness Evaluates the Motivation to Combine Prior Art References as a Whole.....	1
III.	The Board’s Motivation Analysis Properly Addressed All Aspects of the Petition’s Combination	4
	A. Smith’s Attempt to Dissect the Martyn-Chaudhri Combination Into Disparate Parts Is Contrary to Law and the Petition	4
	B. The Board Made Evidence-Backed Findings on Motivation-to-Combine for the Entirety of the Chaudhri-Martyn Combination.....	6
	C. The Board Relied on Record Evidence Showing a Touch-and-Hold Gesture Was the Known “Analog” to Martyn’s Press-and-Hold.....	7
IV.	The Board Followed the Law and Rightly Rejected Smith’s “Unnecessary Problem” Argument as a Factual Matter	9
	A. As the Board Found, the Touch-and-Hold Gesture Was a Known Solution for Launching Sub-Menus Like Martyn’s, and Griffin’s Teachings Support Its Implementation in Chaudhri’s Device	9
	B. The Board Made a Sound Factual Finding That the Touch-and-Hold Gesture Aligns With Chaudhri’s Disclosure	10
	C. The Board Properly Framed the Petition’s Chaudhri-Martyn-Griffin Combination and Supporting Motivation Rationales	11
	D. As the Board Found, Griffin Teaches a Known Solution to a Known Problem That Supports the Chaudhri-Martyn Combination	12
V.	Conclusion	13

I. Introduction

Smith Interface Technologies (“Smith”) requests Director Review to relitigate a factual dispute that it lost on a fully developed record. Smith cannot disguise these factual grievances as putative legal errors, particularly when Smith itself repeatedly misstates and misapplies the law. Vacating the Board’s final decision via Director Review is an extraordinary remedy reserved for abuses of discretion and important policy questions or clear errors of law and fact.¹ Smith alleges none of the former and proves none of the latter. To the contrary, the Board firmly anchored its decision in the evidentiary record and faithfully applied longstanding precedent on obviousness. Smith’s request therefore should be denied.

II. The Law Rejects Smith’s Piecemeal Analysis: Obviousness Evaluates the Motivation to Combine Prior Art References as a Whole

“[T]he law has always evaluated the motivation to combine elements based on the combination of prior art *references* that together disclose all of the elements of the invention.” *GE v. Raytheon Techs. Corp.*, 983 F.3d 1334, 1352 (Fed. Cir. 2020) (original emphasis). Any attack on motivation-to-combine that “unduly dissects prior art references into collections of individual elements” cannot be

¹ Director Review process at §2.B. Retrieved from <https://www.uspto.gov/patents/ptab/decisions/director-review-process#RIDRP>.

sustained. *Id.* “This does not change when combining prior art references would require some alteration of the apparatuses disclosed in the prior art.” *Id.* Why? Because “a person of ordinary skill is also a person of ordinary creativity, not an automaton, so the fact that it would take some creativity to carry out the combination does not defeat a finding of obviousness.” *Id.* (cleaned up).

Smith’s claim that the Board’s decision adopts “modifications for which there is no motivation” fails under *Raytheon*. DR Req. 5. Smith first complains that the Board’s motivation-to-combine analysis should have “separate[d]” Martyn’s teaching of a contextual sub-menu from Martyn’s integrally related teaching of a press-and-hold user input to launch the menu. *Id.* 6–7. Next, Smith blames the Board for finding obviousness when the record shows that a skilled artisan would have implemented Martyn’s press-and-hold teaching with a touch screen device like Chaudhri’s via the analogous and ubiquitous touch-and-hold gesture on an application icon. *Id.* 8–9. Neither critique is cognizable. It is contrary to the law for Smith to “dissect[]” Martyn into individual elements, nor can Smith ignore that an artisan would have exercised “ordinary creativity” to integrate Martyn’s teachings with Chaudhri using known techniques. *Raytheon*, 983 F.3d at 1352.

Smith’s reliance on *InTouch* and *PersonalWeb* is misplaced. DR Req. 4–5. In the *InTouch* case, the Federal Circuit reversed a district court’s obviousness judgment because the patent challenger relied on expert testimony that “did not

articulate reasons why a person of ordinary skill in the art at the time of the invention would combine these references.” *InTouch Techs., Inc. v. VGo Communs., Inc.*, 751 F.3d 1327, 1351 (Fed. Cir. 2014). In *PersonalWeb*, the Federal Circuit vacated the Board’s obviousness finding because the motivation analysis implied “no more than that a skilled artisan, once presented with the two references, would have understood that they *could be* combined.” *PersonalWeb Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 993 (Fed. Cir. 2017) (original emphasis). That is not our case. Here, Smith openly concedes that the Board “credited motivations” for combining Chaudhri and Martyn. DR Req. 5; *see also id.* 7 (listing motivations). Smith simply disagrees with the reach of the Board’s adopted motivations, a factual dispute that *InTouch* and *PersonalWeb* do not govern.

Smith similarly flouts the law by trying to cabin the *Qualcomm* case the Board cited into a box that excludes “a finding of obviousness premised on a modification that only *creates* a new problem, without first generating some benefit.” DR Req. 5 (original emphasis). Setting aside that the Board explicitly found the Petition’s combination superior to Smith’s alternatives (*see infra*, §III.C), Smith’s rigid “benefit” requirement misstates the law. A modification need not yield “an ‘improvement’ in a categorical sense.” *Intel Corp. v. PACT XPP Schweiz AG*, 61 F.4th 1373, 1381 (Fed. Cir. 2023). The “expansive and flexible” motivation-to-combine framework simply requires “an apparent reason to combine the known

elements in the fashion claimed by the patent at issue.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 415, 418 (2007). While a benefit or improvement would certainly qualify as a reason to combine, it is also sufficient to show a “substitution of one element for another known in the field,” an “arrange[ment of] old elements with each performing the same function it had been known to perform,” “a finite number of identified, predictable solutions,” or even “common sense.” *Id.* at 416–17, 421–22.

Fundamentally, Smith’s request rests on a flawed understanding of the law that assumes it is proper to “dissect” references into individual elements, ignore well-reasoned motivations adopted by the Board, and replace *KSR*’s expansive and flexible motivation-to-combine framework with a rigid “benefit” requirement. Correctly read and properly applied, the caselaw fully supports the Board’s decision.

III. The Board’s Motivation Analysis Properly Addressed All Aspects of the Petition’s Combination

A. Smith’s Attempt to Dissect the Martyn-Chaudhri Combination Into Disparate Parts Is Contrary to Law and the Petition

Seeking to manufacture complexity, Smith slices the Chaudhri-Martyn Combination into “three different modifications.” DR Req. 6. The Board properly rejected this fractured view, opting instead to judge the integral combination in the Petition. FWD 18. The Petition explains that Chaudhri teaches a “user interface for a touch screen device” and Martyn teaches launching “a contextual shortcut sub-menu of common application functions in response to a press-and-hold user input.”

Pet. 15. As the Petition makes clear, incorporating Martyn’s sub-menu naturally brings along its trigger—the press-and-hold input. *Id.* 15–16. Moreover, because “the analog to Martyn’s press-and-hold input on a touch screen like Chaudhri’s is the well-known touch-and-hold gesture,” the “predictable result” of the combination is “a mobile device...that displays [Martyn’s] contextual sub-menu...in response to a touch-and-hold gesture applied to Chaudhri’s touch screen.” *Id.*

The law does not require a petitioner to “re-do the work already done in the prior art reference.” *Raytheon*, 983 F.3d at 1352; DR Req. 6. Martyn already discloses the press-and-hold input in tandem with the sub-menu. *See* Pet. 12–13 (citing EX1005 (Martyn) [0015]–[0018]); DR Req. 6. Thus, as the Board correctly found, the Petition provides sufficient motivation to use “both Martyn’s menu and its mechanism for calling the menu.” FWD 19.

The Petition also did not err by relying on a skilled artisan’s understanding that the obvious way to implement Martyn’s press-and-hold on a touch screen device, like Chaudhri’s, was to use a touch-and-hold gesture on an application icon. DR Req. 6–7. Indeed, the Supreme Court took the very same approach in *KSR*, where the base reference (Asano) “disclosed an adjustable pedal with a fixed pivot” and a collection of supplemental prior art references taught “to place the sensor on a nonmoving part of the pedal structure.” *KSR*, 550 U.S. at 425. The Court then reasoned that a skilled artisan would have combined these teachings with an

understanding that “[t]he most obvious nonmoving point on the structure...is a pivot point..., thereby designing an adjustable electronic pedal covered by claim 4.” *Id.* Here, the Board similarly found that the touch-and-hold gesture was the most obvious way to implement Martyn’s teaching to use a press-and-hold input for launching the sub-menu. *See* FWD 18–20; *infra*, §III.C (discussing the evidence). Just as the artisan in *KSR* knew where to put the sensor, the artisan here knew how to adapt Martyn’s press-and-hold for a touch screen. *Id.*

B. The Board Made Evidence-Backed Findings on Motivation-to-Combine for the Entirety of the Chaudhri-Martyn Combination

The Board made explicit factual findings on every aspect of the Chaudhri-Martyn Combination. Smith wrongly claims that the Board only addressed Martyn’s sub-menu and nothing else. DR Req. 7. The Board credited Dr. Cockburn’s testimony that the motivation rationales in his declaration (and the Petition) apply “not to the [menu] in isolation, but instead to Martyn’s teachings as a whole regarding the [menu], including the press-and-hold user input.” EX1067 ¶20; *see also* FWD 19 (citing same). The Board also credited Dr. Cockburn’s testimony that a skilled artisan would have implemented Martyn’s teachings with Chaudhri using the ubiquitous touch-and-hold analog to Martyn’s press-and-hold. *See* FWD 19 (citing EX1003 ¶¶49–53, ¶63; EX1067 ¶¶16–22); *see also infra*, §III.C (discussing

the evidence). These findings were more than sufficient to establish a motivation-to-combine for the entirety of the Chaudhri-Martyn Combination.

C. The Board Relied on Record Evidence Showing a Touch-and-Hold Gesture Was the Known “Analog” to Martyn’s Press-and-Hold

The Board did not rely on a “bare assertion of analogousness of a touch screen touch-and-hold to Martyn’s press-and-hold on a navigation button.” DR Req. 8. Rather, the Board made this analogousness finding because it is “supported by record evidence.” FWD 19 (citing EX1003 ¶¶49–53, ¶63; EX1067 ¶¶16–22). And the record is extensive.

Far from merely repeating the Petition, Apple’s expert, Dr. Cockburn, provided an extensive and densely corroborated discussion on the longstanding use of duration-based hold gestures in touch screen devices. *See* EX1003 ¶¶49–53. Among “numerous prior art patent documents,” for example, Dr. Cockburn pointed to one of Apple’s prior art patent publications that “maps a ‘LONG’ single-finger touch with no movement (e.g., a touch-and-hold gesture) to the function of ‘bring[ing] up [a] context sensitive menu.’” EX1003 ¶¶52–53 (citing EX1031 Figures 27A-27B); *see also id.* (citing EX1024, 5:35–45 (a “long press” triggers “generation of a contextual pop up menu”); EX1025 [0183] (when a touch extends “for a predetermined period of time,” the device “may display on the touch screen [] a second level menu”)). Dr. Cockburn expanded this discussion in a supplemental

declaration that Smith chose not to contest, rebut, or explore through cross-examination. There, Dr. Cockburn identified even more evidence, including documentation that prior art Windows devices made a “short cut menu appear[]” when the user “touch[es] the screen” and executes a “hold.” EX1067 ¶19 (citing EX1071, p.1). He also referenced a prior art Android Developer’s guide equating “when the user either touches and holds the item (when in touch mode)” or “presses and holds the suitable ‘enter’ key.” *Id.*, ¶22 (citing EX1061, p.1).

The Board also did not “ignore[] available combinations within the explicit disclosures of Chaudhri and Martyn.” DR Req. 8. The Board explicitly evaluated all of the “alternate implementations” that Smith proposed and found that none were compelling. FWD 19. As to the “click wheel” that Smith advocates, the Board found as a factual matter that it is relegated to “only one paragraph of Chaudhri,” while the remainder of Chaudhri’s disclosure focuses on duration-based touch contact gestures with application icons. FWD 20 (citing, *inter alia*, EX1004 (Chaudhri) [0217] (“the device detects a contact 5008 with the solitaire application icon 5002-4”); EX1067 ¶32). The Board also expressly rejected Smith’s argument that a skilled artisan would have opted to include small circular badges (“target areas”) for launching Martyn’s contextual sub-menu. FWD 20. The Board agreed with Dr. Cockburn that this approach would have yielded a cramped and “problematic” user interface. *Id.* (citing EX1067 ¶¶28–29).

At bottom, Smith identifies no legitimate deficiency in the Board’s factual findings. Smith simply disagrees with how the Board weighed the evidence and now demands a do-over. But merely quibbling with the Board’s fact-finding is hardly the kind of clear error that warrants the extraordinary relief of Director Review.

IV. The Board Followed the Law and Rightly Rejected Smith’s “Unnecessary Problem” Argument as a Factual Matter

A. As the Board Found, the Touch-and-Hold Gesture Was a Known Solution for Launching Sub-Menus Like Martyn’s, and Griffin’s Teachings Support Its Implementation in Chaudhri’s Device

Smith’s “[l]ack of [m]otivation” argument relies on a fabricated concession. DR Req. 10. Nowhere does the Petition “concede[]” that using a touch-and-hold to launch Martyn’s sub-menu “*conflicts* with Chaudhri’s existing assignment of the ‘touch-and-hold’ on an application icon.” *Id.* (original emphasis). The Petition instead explains, and the Board agreed, that the Chaudhri-Martyn Combination would have prompted an artisan to seek “a solution to the problem of distinguishing between the different gesture commands.” Pet. 21; *see also* FWD 22–23. The Board also agreed with the Petition that this routine design problem is resolved by Griffin’s teaching to “evaluate a duration parameter of the user’s touch against certain predetermined criteria.” *Id.*

The Board credited Dr. Cockburn’s testimony dispelling Smith’s illusory “conflict.” An artisan would have simply implemented distinct time thresholds. *See*

EX1003 ¶¶75–77; EX1067 ¶25; FWD 22–23. The touch-and-hold to call Martyn’s sub-menu would trigger at a duration greater than Chaudhri’s tap (500 milliseconds) but less than the longer hold to initiate Chaudhri’s “reconfiguration” mode (2 seconds). EX1003 ¶77. “[U]sing two touch-and-hold gestures of different durations on the same application icon does not create a conflict.” EX1067 ¶31.

Beyond rejecting Smith’s contrived “conflict” theory, the Board also made specific factual findings detailing *why* an artisan would have favored the Petition’s touch-and-hold solution over Smith’s inferior alternatives. The Board again embraced Dr. Cockburn’s testimony that “a simple touch-and-hold gesture [is] more aligned with Chaudhri,” “easier and more efficient” than Smith’s alternatives, and “was a well-known and often preferred manner for interfacing with the kind of mobile devices disclosed in Chaudhri.” EX1067 ¶33; *see also* FWD 20.

B. The Board Made a Sound Factual Finding That the Touch-and-Hold Gesture Aligns With Chaudhri’s Disclosure

The Board firmly grounded its adoption of the Chaudhri-Martyn Combination in the record, identifying and crediting extensive evidence supporting the integration of Martyn’s contextual sub-menu alongside the touch-and-hold gesture used to launch it. FWD 18–20. To attack this sound fact-finding, Smith must resort to a distorted view of the record. Not once, but twice, Smith misstates Chaudhri’s disclosure and the Board’s analysis of Chaudhri.

First, Smith falsely claims that Chaudhri discusses the “click wheel” concept “in detail.” DR Req. 11. In reality, and as the Board observed, Chaudhri’s click wheel discussion is fleeting, spanning just 1 out of 384 paragraphs—less than 0.5% of the total disclosure. EX1004 [0093]; FWD 20. Second, the Board did not overlook that Chaudhri mentions a “virtual” click wheel or “*assum[e]* that a click wheel would not use touch-screen gestures.” DR Req. 11 (internal quotes omitted). Smith simply misreads the Board’s decision, which determines that “the use of touch-based gestures *such as those discussed extensively with respect to the Chaudhri device* would have been ‘far more aligned’ with Chaudhri’s disclosure as a whole than the use of a click wheel.” FWD 20 (quoting EX1067 (Cockburn Supp. Dec.) ¶¶32–33). The touch-based gestures that Chaudhri “discussed extensively” involve a user contacting targeted application icons for a predetermined amount of time—e.g., taps and holds. EX1004 [0174], [0217], [0220], [0283], [0346]; *see also* FWD 20 (citing same).

C. The Board Properly Framed the Petition’s Chaudhri-Martyn-Griffin Combination and Supporting Motivation Rationales

The Board squarely rejected Smith’s claim that “assign[ing] a second function to the touch-and-hold gesture on an application icon had *no advantages*.” *See* DR Req. 12. As discussed, the Board credited Dr. Cockburn’s testimony that the touch-and-hold was not only a known solution, but a superior one to the alternatives Smith

conjured. FWD 18–20. And the Board explicitly performed the legal analysis Smith claims is absent, finding that the “advantages of the combination of Chaudhri and Martyn outweigh the disadvantages, especially as those disadvantages can be addressed via teachings from Chaudhri regarding triggering different functionalities based on the characteristics of a user’s touch screen contact, along with additional information regarding use of different gestures from Griffin.” FWD 22. Nothing more was required.

D. As the Board Found, Griffin Teaches a Known Solution to a Known Problem That Supports the Chaudhri-Martyn Combination

Smith’s final complaint merely recycles its fabricated “conflict” theory, arguing that the Petition used an unnecessary problem as a “pretext” to add Griffin’s teachings. DR Req. 12–13. The Board correctly rejected this narrative as “not compelling.” FWD 23. Griffin was not introduced solely to address a “self-induced” problem with the combination of Chaudhri and Martyn. *Id.* Rather, a skilled artisan would have initially consulted Griffin “to provide detail regarding the distinction between the tap and touch-and-hold gestures described in Chaudhri on its own.” *Id.* With Griffin already in hand, the artisan would have naturally relied on its teachings to “complement[] the functionalities of the Chaudhri/Martyn combination.” *Id.*

V. Conclusion

The Board's decision correctly applied *KSR*'s "expansive and flexible" obviousness framework. At every turn, the Board anchored its conclusions in the evidentiary record, expressly crediting expert testimony that supported the Petition's motivation to combine Chaudhri, Martyn, and Griffin into a cohesive, advantageous, and superior user interface. By contrast, Smith's request for Director Review relies on fabricated concessions, mischaracterizations of the record, and a piecemeal approach to obviousness that Federal Circuit caselaw forbids. Having failed to persuade the Board, Smith should not be permitted a do-over before the Director.

Respectfully submitted,

Dated: February 24, 2026

/Kenneth Wayne Darby Jr./

W. Karl Renner, Reg. No. 41,265

Kenneth W. Darby Jr., Reg. No. 65,068

Joseph W. Bauer, Reg. No. 81,218

Fish & Richardson P.C.

60 South Sixth Street

Minneapolis, MN 55402

T: 202-783-5070

F: 877-769-7945

Counsel for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4)(iii), the undersigned certifies that on February 24, 2026, a complete and entire copy of this Authorized Response to Director Review Request was provided via email to the Patent Owner by serving the email correspondence addresses of record as follows:

Norton Rose Fulbright US LLP
Daniel S. Leventhal
daniel.leventhal@nortonrosefulbright.com
Eagle H. Robinson
eagle.robinson@nortonrosefulbright.com
Chad Wallis
chad.wallis@nortonrosefulbright.com

/Crena Pacheco/
Crena Pacheco
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
pacheco@fr.com