

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner

v.

SMITH INTERFACE TECHNOLOGIES, LLC

Patent Owner

IPR2024-01089
Patent 10,671,212

PATENT OWNER SUR-REPLY

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PATENT OWNER'S EXHIBIT LIST

Exhibit	Shorthand	Description
2001	Surati	Declaration of Dr. Rajeev Surati, Ph.D.
2002	CV	CV of Dr. Rajeev Surati, Ph.D.
2003	Stay Order	October 2, 2024 Order Granting in Part Apple's Motion to Stay in <i>Smith Interface Technologies, LLC v. Apple Inc.</i> , 3-23-cv-01187, S.D. Cal. (DKT. No. 127).
2004	JCC	Excerpt of Joint Claim Construction Chart Exhibit A.
2005	Madiseti	Declaration of Dr. Vijay Madiseti
2006	Cockburn Deposition	Transcript of Andrew Cockburn March 25, 2025 Deposition
2007	'918 Provisional	U.S. Provisional Patent Application No. 61/581,918
2008	Madiseti CV	CV of Dr. Vijay Madiseti

I. INTRODUCTION

Petitioner's Reply fails to excuse any of the three independent flaws that doom the Petition's mapping of the Challenged Independent Claims. **First**, the Reply concedes that Petitioner may not just point to use of haptic feedback generally to demonstrate Limitations [1.c], [16.h], and [84.d], which recite providing haptic feedback "when" / "based on" "a second duration of the touch" occurs. And Petitioner identifies no disclosure in Hotelling disclosing providing haptic feedback "when" / "based on" that event. The Reply attempts to link a reference in Hotelling to "touch events" to "when" / "based on" "a second duration of the touch" occurs, but does so only by mischaracterizing Hotelling. With no actual disclosure in Hotelling, the Reply continues to argue that because *haptics are good*, providing haptic feedback in response to any event must be obvious.

Second, for Limitations [1.d], [16.i], and [84.e], the Reply fails to identify any portion of the Petition that explains why and how a POSITA would have read Hotelling's disclosure of "touch vocabulary associated with a music player" and applied that to the "main menu GUI" the Petition otherwise relies upon. The Reply points to the D.I.'s discussion of embodiments, but this missing the point. It is beyond dispute that Petitioner points disparate teachings in Hotelling that Hotelling does not teach or disclose combining. Absent explanation or why a POSITA would do what Hotelling does not do—and why a POSITA would choose to *ignore*

Hotelling's actual disclosures, which results in a *different* combination that does not meet the claims, the mapping fails.

Third, for both of these claim elements the Reply add additional evidence and altered and additional mappings not found in the Petition that cannot properly form the basis of a Final Written Decision.

Fourth, to bolster the holes in each of the Petition's five different mappings for Limitations [1.f], [16.k], and [84.g] identified in the POR, the Reply reads features into Martyn, including touch screen support, that are not consistent with Martyn's disclosure and were not raised in the Petition. These belated justifications to combine features across Hotelling, Martyn, and Cho are unsupported by the references themselves and rely either solely on expert testimony or on references not cited in the Petition.

II. PETITIONER CONFIRMS IT MUST SHOW ALL CONDITIONAL LIMITATIONS IN THE PRIOR ART

In IPR2024-01091 challenging a related patent, the Board requested the parties brief the issue of whether certain conditional limitations “were presented in the alternative such that not all of the limitations need to be satisfied in order to meet the claim.” IPR2024-01091, Paper 10, 2. Because the Challenged Claims in this IPR also include conditional limitations, PO provided the answer to that question in the POR, explaining that the claim language does not “relieve Petitioner from demonstrating the alleged prior art combination includes logic meeting each

Limitation such that each Limitation will be performed when presented with an instance of user input ‘where their preconditions apply.’” Paper 14 (POR), 13-17. In support, PO pointed to the claim language and specification disclosure “consistent with” that claim language. *Id.*

Petitioner acknowledges the relevant question and confirms it does not dispute PO’s position and accepts the burden of demonstrating that “[t]he Petition accounts for every limitation in exactly the fashion Patent Owner contends is required.” Reply, 1-2. But rather than stopping there, Petitioner falsely characterizes the POR as presenting a “convoluted construction” and then attacks a construction not proposed. *Id.* PO does not propose any construction beyond confirming all conditional limitations must be met. POR, 13-17. *Id.* Petitioner’s confirmation that “there is no ‘controversy’ on this issue here” of the mandatory nature of the conditional limitations resolves the issue. Reply, 1-2.

III. HOTELLING DOES NOT DISCLOSE OR SUGGEST TACTILE FEEDBACK “WHEN” / “BASED ON” “A SECOND DURATION OF THE TOUCH” (LIMITATIONS [1.C], [16.H], AND [84.D])

A. The Petition’s Proposed Combination Does Not Disclose or Suggest Providing Haptic Feedback Upon Detection of a Long Touch

The Petition relies exclusively on Hotelling as either disclosing or rendering obvious providing haptic feedback “when” / “based on” “a second duration of the touch” is met. Pet., 28-29. As explained in the POR, Hotelling *does* disclose use of haptic feedback, but *not* “when” / “based on” “a second duration of the touch” is

met. POR, 26-31. Rather, Hotelling discloses providing haptic feedback in response to specific events that are, indisputably, not “a second duration of touch,” as well as in conjunction with “an input event.” *Id.*, 28-30.

In Reply, Petitioner does not dispute that performing haptic feedback **not** “when” / “based on” “a second duration of the touch” is met does not meet the claims. *See* Reply, 3. And, Petitioner does not assert that Hotelling’s disclosure of haptic feedback in response to any specific event meets the claims. *Id.*, 3-6. Instead, Petitioner focuses solely on the reference to an “input event” and attempts to link that to “‘long’ touches on a virtual button” in “earlier disclosures” from Hotelling. *Id.*, 4 (citing EX1004, [0097], [0135], [0145]-[0151], Figures 26, 27A-E). The fatal flaw in this argument is that Petitioner’s assertion that Hotelling links long touches to “input events” that cause haptic feedback is not true. None of the cited portions of the “earlier disclosures” in Hotelling make any reference to the use of haptic feedback. *See* EX1004, [0097], [0135], [0145]-[0151], FIGs 26, 27A-E. Further, the one section that discusses “short” and “long” duration touches contains no reference to “input events” or “touch events” that would explain how this disclosure connects to the haptic feedback section of Hotelling in the way Petitioner claims. *See id.*, [0145]-[0151], FIGs. 26, 27A-E. To the contrary, this section suggests that no “action is performed” until after “the UI mode, the pressure of the touch, the number of touches, whether or not the touch is moving, the duration of the touch,

and the touch location” have already been determined and are used to identify the gesture. *Id.*, [0150], FIG. 26. At least several of these variables are not known until after the gesture completes, providing no indication that any intermediate action is performed, much less intermediate haptic feedback when a second duration is detected, as Petitioner proposes. Thus, to the extent Hotelling has *any* disclosure regarding the relation between exceeding a “second duration” during an ongoing touch and providing haptic feedback, Hotelling discloses to perform “no action” during an ongoing touch at the time the claim requires providing haptic feedback.

Having disposed of the inaccurate assertion of a link in Hotelling between detection of a “long” touch and providing haptic feedback, Petitioner is left only to argue *haptics are good* and therefore providing haptics at any time in response to any event should be obvious. *See* Reply, 4-7. Not only are most of these arguments new and improper as discussed below, they fail to identify some teaching or suggestion to combine the operation and the condition. POR, 28 (citing *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007)). This is insufficient to carry Petitioner’s burden. *See Johns Manville Corp. v. Knauf Insulation, Inc.* (IPR2018-00827, Paper 9) at 13-14; POR, 31-33.

B. The Reply’s Citations to References Other than Hotelling Are New

Realizing the weakness of Hotelling’s teachings alone, Petitioner in its Reply points to new materials that purportedly evidence the self-serving, perennially-vague

“common knowledge and ordinary creativity of a POSITA.” Reply, 6-8. The Reply asserts that a POSITA would “supplement” Hotelling’s teachings with teachings from these other “third-party documents” to arrive at the claims. *Id.*, 6-7. However, these other documents are (1) either not directly cited, or not cited at all, in the Petition’s combination; and (2) lack an articulated motivation to combine. *Compare id.*, 6-8 with Pet., 26-29; *see also* EX1003, ¶¶126-130. Petitioner’s attempts at this late stage to transform the Petition’s Hotelling-Martyn combination so as to include references not cited in the Petition are improper and should be disregarded by the Board. *Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.*, 853 F.3d 1272, 1286-87 (Fed. Cir. 2017) (“Shifting arguments in this fashion is foreclosed by statute, [Federal Circuit] precedent, and Board guidelines”); *see also Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (“the expedited nature of IPRs bring with it an obligation for petitioners to make their case in their petition to institute”).

Most notably, neither the Petition nor Dr. Cockburn cited **any** portion of EX1010 in the original mapping for this limitation. *See* Pet., 26-29; EX1003, 126-130. In the Reply, Petitioner now argues that this document “confirm[s]” that Hotelling teaches tactile feedback as “how the user is informed that they have successfully executed a ‘long’ touch.” Reply, 5. This is an entirely new argument based on evidence not cited in the Petition. *See* Pet., 28. It should be disregarded

by the Board. *See Apple Inc. v. eWatch, Inc.*, IPR2015-00412, Paper 50, 44 (PTAB May 6, 2016) (“‘Respond,’ in the context of 37 C.F.R. § 42.23(b), does not mean embark in a new direction with a new approach as compared to the position originally taken in the Petition. Accepting such belatedly presented new arguments would be unjust to the Patent Owner and we decline to do so.”).

The same is true of the Reply’s argument that tactile feedback occurring “‘upon release’ of a virtual button” meets the claim language. Reply, 6. This argument was not raised in the Petition. Further, contrary to Petitioner’s assertion, PO does not concede that such functionality meets the claim language. Regardless, this argument was neither raised nor even hinted at in the Petition (*see* Pet., 26-29), and should be rejected for that reason alone. *Wasica*, 853 F.3d, 1286-87.

Additionally, the portion of EX1028 included inline in the Reply was not cited for this proposition in the Petition or Dr. Cockburn’s original declaration. *Compare* Reply, 7 with Pet., 26-29; EX1003, ¶¶126-130. The highlighted text is presented for the first time in the Reply, allegedly to rebut POR’s suggestion that “the record lacks any sign of ‘providing haptic feedback upon detection of a long touch.’” Reply, 7 (citing POR, 32). However, the POR was not an invitation for Petitioner to cite new portions of the dozens of exhibits included with but not cited in the Petition. *See eWatch*, IPR2015-00412, Paper 50, 44. The relevant question remains whether the **Petition** identified anywhere in the record that teaches haptics in response to a long

touch. *Wasica*, 853 F.3d, 1286-87. It did not. *See* POR, 32 (“Petitioner does not identify anywhere in the record beyond an identical conclusory statement from Dr. Cockburn.”).

C. The Reply’s New Arguments Are Also Insufficient

Even assuming the Reply’s new arguments are timely, they fail to carry Petitioner’s burden because they rely on hindsight to broadly interpret generic disclosure that tactile feedback and long touches were separately known and, therefore, a POSITA would have known to combine the two in precisely the way claimed. *KSR*, 550 U.S., 418 (“A patent composed of several elements is not proved obvious by merely demonstrating that each of its elements was, independently, known in the prior art.”); *see also Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570 (Fed. Cir. 1996) (“To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction—an illogical and inappropriate process by which to determine patentability.”). Such a combination is “fraught with hindsight bias. *See ActiveVideo Networks, Inc. v. Verizon Commc’ns, Inc.*, 694 F.3d 1312, 1327 (Fed. Cir. 2012).

With respect to EX1010, the mere statement that “[c]ontinuous gestures” may be “performed in a single stroke” bears no relation to when or how *tactile feedback* should be provided. *See* Reply, 5-6 (citing EX1010, [0066], [0083]). Similarly, the

fact that “**actions** associated with gestures can be implemented at the same time as the gesture” does not refer to the use of tactile feedback, but rather refers to the device’s response to the gesture, such as “during a scrolling gesture, the screen moves with the finger motion.” EX1010, [0068], *see also* Reply, 6 (citing EX1010, [0068]). Petitioner cites Dr. Cockburn for the proposition that these cites confirm tactile feedback is “how the user is informed that they have successfully executed a ‘long’ touch,” but that statement—the key logical step explaining *when and why* tactile feedback should be used—is simply not supported by the generic disclosure above. Tellingly, Dr. Cockburn cites **nothing** to support his assertion that this is the case. *See* EX1062, ¶28. Thus, as was the case in the Petition, Petitioner reads generic disclosure with the benefit of hindsight to arrive at the claim language. *See* POR, 32. This is improper. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (“To prevent the use of hindsight based on the invention,” obviousness requires a show of “reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.”)

The new citations provided in support of the “common knowledge” of a POSITA are equally unavailing because they are, in essence, the same *haptics are good* argument that the Petition attempted to make based on Hotelling’s teachings alone. *Compare* Reply, 7 (“tactile feedback ‘is likely to help all button interactions

on touch-screens”) (emphasis in original) *with* Pet., 28 (“Hotelling further provides to the Combination, a teaching of outputting “tactile feedback” ... with a haptics mechanism”). As with the original *haptics are good* argument, this new evidence demonstrates “at best, that haptics generally has value, but says nothing about using haptics in response to a touch on a virtual button.” POR, 31.

IV. THE COMBINATION DOES NOT DISCLOSE OR SUGGEST DISPLAYING A MENU “WHEN” / “BASED ON” “A SECOND DURATION OF THE TOUCH” (LIMITATIONS [1.D], [16.I], AND [84.E])

A. The Petition Cobbles Together Disparate Teachings of Hotelling and Martyn Using Hindsight

As Petitioner explains in its Reply, the Petition must pull from (1) Hotelling’s main menu GUI, (2) Hotelling’s music player touch vocabulary, and (3) Martyn’s context menu to arrive at this limitation. *See* Reply, 8-9; *see also* Pet., 26-27, 30. Such a piecemeal combination strains credulity to begin with, but the primary problem with the Petition’s proposed combination is that the Petition does not explain why a POSITA would be motivated to combine bits and pieces of teachings from across Hotelling and Martyn to arrive at this limitation. POR, 34-37. Instead, the Petition assumes that a POSITA would take the GUI from Figure 18 of Hotelling, the gesture from Figure 27 of Hotelling, the App Snapshot menu from Martyn, and the gesture location (an app icon) from Martyn to miraculously arrive at the claim language. Pet., 26-27, 30. In doing so, Petitioner ignores (1) the differences between

Figure 18 and Figure 27 of Hotelling; and (2) that Martyn is not directed to touch screen devices. *See* POR, 37-40. Absent an articulated reason to combine these disparate disclosures in the face of contextual differences between each disclosure, the Petition's motivation can only be impermissible hindsight. POR, 35-37.

Petitioner's attempt to confuse the discussion as a legal debate over whether Figures 18 and 27A of Hotelling are different embodiments is a smoke screen. *See* Reply, 9-10. The question is whether Hotelling teaches a long press gesture on a main menu GUI, as proposed in the Petition. Pet., 27. As PO explained at length in the POR, it does not. POR, 37-47. Hotelling teaches a long press gesture on a music player GUI. *Id.* The Petition did not explain why a POSITA would combine Hotelling's music player touch vocabulary with its main menu GUI. *Id.* This is, and always has been, PO's argument. *Id.* Petitioner's citation to the D.I. is unhelpful because, as PO explained in the POR, the Board initially misunderstood PO's argument. POR, 36.

B. The Reply's Argument that a POSITA Would Combine Hotelling's Main Menu GUI and Music Player Long Touch Gesture Based on "Commonplace" and "Conventional" Designs is New and Incorrect

Instead of pointing to disclosure within Hotelling itself to explain why Figures 18 and 27A are compatible, the Reply points to previously-uncited disclosure outside of Hotelling to support its new argument that a POSITA would combine Hotelling's main menu GUI and music player touch vocabulary because "a long touch gesture

on virtual buttons and icons to invoke menus and control options was not new in 2011; it was commonplace.” Reply, 10-11 (citing EX1024, EX1025, EX1037, EX1006). As a threshold matter, this argument fails for similar reasons to the *haptics is good* argument discussed above. See POR, 2, 31; KSR, 550 U.S., 418. Statements that the claimed functionality was “commonplace” or “conventional” are no substitute for disclosure from the references in the Petition’s proposed combination. See *ActiveVideo*, 694 F.3d, 1327 (“conclusory statement[s] that a [POSITA] would have known, based on the ‘modular’ nature of the claimed components, how to combine any of a number of references to achieve the claimed inventions ... is not sufficient and is fraught with hindsight bias.”). As the POR explains, the Petition does not adequately support its implicit combination of Hotelling’s main menu GUI and music player touch vocabulary. POR, 33-37. However, the Board need not reach the merits of Petitioner’s generic claims of conventionality because this argument was not raised in the Petition and is, therefore, untimely. *Wasica*, 853 F.3d, 1286-87.

The Reply also argues that “a POSITA would have known it was a common technique to assign the same input command to achieve substantially similar functionality across different operating systems and applications” to “promote[] usability.” Reply, 11. This argument was not raised in the Petition and should not be considered by the Board. *Wasica*, 853 F.3d, 1286-87. Indeed, the exhibit relied

on by Dr. Cockburn to make this argument was not filed with the Petition and was first cited by Petitioner in the Reply. *See* Reply, 11; Pet., iv-vi (List of Exhibits).

C. The Reply’s Argument that Martyn is Directed to Touch Screen Devices is Both New and Incorrect

Next, in an attempt to massage the obvious differences between the input features of Martyn, a non-touch screen reference, and Hotelling, a touch screen reference, Petitioner argues for the first time in the Reply that “Martyn’s disclosure is not limited to non-touch screen devices with only physical buttons.” Reply, 12. This argument was not raised in the Petition and Petitioner does not attempt to argue it was, citing no portion of the Petition in this section of the Reply. The Petition references Martyn only for its App Snapshot menu, with all touch screen gestures in the Petition’s proposed combination coming from Hotelling. *See* Pet., 29-30 (“The discussion at Element [1.c] shows that, *through Hotelling*, the Combination includes the notion of triggering the display of a ‘context sensitive menu’ in response to the second (‘long’) duration touch.”) (altered emphasis). For the Board to now treat Martyn as directed to a user interface design for touch screen devices and the source of the touch screen gesture in the Petition’s mapping would be “unjust to the Patent Owner.” *eWatch*, IPR2015-00412, Paper 50, 44.

Even assuming this argument is timely, Petitioner’s contention that Martyn describes user input functionality for use on a touch screen device is patently absurd. To support its contention, Petitioner points to a single sentence from Martyn that its

disclosure broadly applies to “any kind of mobile device with communications capabilities,” including “smart phones” and “PDAs.” Reply, 12 (citing EX1005, [0002]). This sentence is ambiguous, at best. Not all “smart phones” and “PDAs” at the time of Martyn’s invention were touch screen devices, even if some touch screen devices were known. Additionally, to read this sentence as referring to touch screen devices requires that the POSITA close their eyes to every other part of Martyn’s disclosure. *See e.g.*, EX1005, [0007] (“Some mobile telephones also offer limited shortcuts ... usually involve[ing] memorizing various **keyboard input sequences**”), [0009] (“According to a first aspect of the invention there is provided a computing device comprising a **display** screen”), [0016] (“At this point, the user may take **conventional navigations steps, such as scrolling, to move the highlight and using the available select function to navigate to the required highlighted application.**”), [0017] (“the App Snapshot may be ‘called’ ... by ... a press and hold of **the select function** when an application name is highlighted; or using **a right cursor key** on a highlighted application name.”), [0018] (“When an item is selected ... using **a conventional selection technique such as pressing a right cursor**”), FIGs. 1-3. Read within the full context of its disclosure, Martyn clearly refers to a non-touch screen device that supports “conventional navigation steps,” which refers to navigation using physical buttons. *See* EX1005, [0016], [0018].

Petitioner further belies the reality that Martyn's disclosure is not meant for a touch screen device by arguing elsewhere that "dismissing ... Martyn's App Snapshot[] in the context of a touch screen GUI was an evident design problem." Reply, 20. Yet, Martyn already discloses several ways that its App Snapshot may be dismissed. *See* EX1005, [0020]-[0023] ("The App Snapshot dropdown may be dismissed in the following ways:...") Why would there be an "evident design problem," unless the dismissal methods (and other input techniques) disclosed in Martyn were not meant for a touch screen GUI? Accordingly, Petitioner's belated contention that Martyn discloses input techniques for a touch screen should be rejected by the Board as both untimely and unfounded.

V. THE COMBINATION DOES NOT DISCLOSE OR SUGGEST "CHANG[ING] AT LEAST ONE ASPECT OF THE DISPLAY OF THE AT LEAST ONE MENU" "WHEN" / "BASED ON" "DETECT[ING]" "A SLIDE OR SWIPE GESTURE" (LIMITATION [1.F], [16.K], [84.G])

The Petition proposes five different alternative modifications in order to map these claim elements. But, again, the Petition offers not objective motivation to reach any of these modifications other than a hindsight goal to meet the claims. POR, 48-58. Nothing in the Reply alters this conclusion.

1. First Attempt: Martyn's highlighting to indicate the currently selected item

As explained above, Petitioner's contention that Martyn's "teachings extend to known touch screen devices" is both untimely and inaccurate. *See* Reply, 13. The

Reply's rebuttal of the POR based on this contention fails here for the same reasons as for the limitation discussed above. Petitioner was obligated to explain why Martyn's non-touch screen input features would be imported to a touch screen device. Both the Petition and the Reply failed to do so, and Petitioner's attempt to rely on Martyn's input features here and elsewhere fails as a result.

Alternatively, Petitioner argues that Martyn's highlighting to support "conventional navigation steps" would be imported into a touch screen implementation of Martyn's App Snapshot because it is a "common practice" to use highlighting on touch screen devices to assist in item selection. Reply, 15. This argument was not raised in the Petition and should be rejected on this ground alone. *Wasica*, 853 F.3d, 1286-87; *see* Pet., 34-35 (citing only to Hotelling and Martyn to support this argument). What is more, however, this argument also lacks support in Hotelling and Martyn. POR, 49-50. Petitioner does not dispute that "Martyn's highlight scrolling functionality is not strictly necessary on a touch screen." Reply, 15. Petitioner disputes only whether a POSITA would have adopted Martyn's highlight scrolling functionality, arguing that it was "common practice" on touch screen devices. *See id.* In support of its contention, Petitioner cites only unsupported testimony from Dr. Cockburn and "Apple's Newton MessagePad, a touch screen PDA from 1993," which allegedly included this functionality. *Id.* The mere availability or possibility of a similar feature is not a sufficient motivation to

overcome the undisputed fact that “highlight scrolling functionality is not strictly necessary on a touch screen.” *See id.* Petitioner’s first attempt to map this limitation fails by “merely demonstrating that each of its elements was, independently, known in the prior art.” *See KSR*, 550 U.S., 418; *see also* POR, 49-50.

2. *Second Attempt: Hotelling’s swipe gesture to “back out a folder” of a music player*

The Reply focuses on whether Martyn’s App Snapshot is hierarchical when implemented on Hotelling’s main menu GUI. Reply, 15-16. This sidesteps the real issue raised by the POR, which is that the Petition cites no objective disclosure from Hotelling or elsewhere that suggests folders and menus are considered “analogous” contexts in the art. POR, 50-51. Petitioner does not dispute that “Hotelling does not compare folders to menus.” *Id.*, 51. Petitioner does not dispute that “Hotelling does not compare ‘back[ing] out’ of a folder to dismissing a menu.” *Id.* Petitioner does not dispute that “Hotelling does not teach that the gestures disclosed in Figures 27A-E are applicable outside of the context of a music player GUI.” *Id.* As a result, Petitioner effectively concedes that the Petition relies solely on Dr. Cockburn’s testimony for the proposition that a POSITA would look through the 31 exemplary gestures in Figures 27A-E of Hotelling and settle on the specific one Petitioner contends renders this limitation obvious, while also ignoring the existing teachings of Martyn as to how the App Snapshot may be dismissed. *See* POR, 51; EX1004, FIGs. 27A-e; EX1005, [0020]-[0023]. By leaving this point undisputed, Petitioner

confirms that the Petition's mapping is the result of hindsight, as opposed to a reasoned analysis based on objective evidence from the references cited in the Petition. *See* POR, 51.

3. Third Attempt: Cho's scrolling

Petitioner does not dispute that the *only* examples in Martyn are “exemplary ‘implementation[s]’ where the items in the App Snapshot are ‘limited,’” which obviates the need for scrolling functionality within the App Snapshot. *See* Reply, 16; *see also* EX1005, FIGs. 2-3; POR, 52-55. Instead, the Reply accuses the POR of being “shortsighted” because it only addresses the examples disclosed in Martyn, and not those imagined by the Petitioner based on other references not cited in Martyn or the relevant section of the Petition. *Compare* Reply, 16-17 (citing EX1022) *with* Pet., 38. In reality, Martyn contains no teaching that “users will sometimes ‘add[so] many items’ that the menu ‘becomes too long to fit on the screen.’” Reply, 16 (citing EX1022). This is a belated justification manufactured by Petitioner to account for gaps in the Petition's mapping. It should be rejected as both untimely and unsupported by Martyn, Hotelling, and Cho for the reasons already described in the POR. *Wasica*, 853 F.3d, 1286-87; POR, 52-55.

4. Fourth Attempt: Cho's window re-sizing

Again, as with Petitioner's third attempt to map this limitation, the Reply sidesteps the primary issue identified in the POR: *why* would a POSITA have

combined Cho's window re-sizing with Martyn's App Snapshot, especially when Martyn discloses only a quick-access, summary App Snapshot with limited options? *See* POR, 56. Rather than grapple with this deficiency in the Petition, the Reply simply points out new prior art examples of window re-sizing, without providing any reason it would be useful to or resolve a problem in the Hotelling-Martyn App Snapshot. *See* Reply, 18-19. These new examples are insufficient for precisely the same reasons already discussed in the POR. *See* POR, 56-57 (citing *Virtek Vision Int'l ULC v. Assembly Guidance Sys., Inc.*, 97 F.4th 882, 888 (Fed. Cir. 2024)).

Additionally, Petitioner's arguments that Hotelling and Martyn teach window resizing are new arguments raised for the first time in the Reply that should not be considered. *Wasica*, 853 F.3d, 1286-87; *see* Reply, 19 (citing EX1010, [0085]), 20 (citing EX1005, [0017]). Further, Petitioner takes the POR's characterization of Martyn out of context. *See* Reply, 20. Martyn discloses one embodiment of the App Snapshot that includes 3 options (EX1005, FIG. 2) and another, "longer" embodiment of the App Snapshot that include 5 options (EX1005, FIG. 3). EX1005, [0017]; *see* POR, 54. PO does not concede that these separate configurations of Martyn's App Snapshot disclose **dynamic** window re-sizing in response to a gesture, as the Reply suggests and the claim requires. Reply, 20. They are alternative configurations with no disclosed runtime function to switch between the two configurations. EX1005, [0017], FIGs. 2-3.

5. Fifth Attempt: Cho's information window dismissal

PO does not concede that the Petition has made the appropriate showing, nor that this case is analogous to *Intel*. In *Intel*, both references cited by the patent challenger sought to address “the same cache-coherency issue” in “multiprocessor systems.” *Intel Corp. v. PACT XPP Schweiz AG*, 61 F.4th 1373, 1380 (Fed. Cir. 2023). Here, by contrast, Martyn addresses menu dismissal inputs on a ***non-touch screen*** device, while Cho addresses menu dismissal inputs on a ***touch screen*** device. See Section IV.C (explaining that Martyn is directed to non-touch screen devices); Pet., 11 (“Cho describes ... gestures on a touch screen for interacting with various types of ‘information windows’”). These are not the “same” problems, as was the case in *Intel*, and, therefore, do not fit the *Intel* mold. See *Intel*, 61 F.4th, 1380-81. Instead, as explained in the POR, “[w]ithout ‘the glue to combine these references,’ what remains is the tempting notion—tainted by hindsight—that this specific combination of prior art elements is obvious because similar elements are so combined in the Challenged Claims.” POR, 58 (citing *InTouch Techs., Inc. v. VGO Commc’ns, Inc.*, 751 F.3d 1327, 1348-49 (Fed. Cir. 2014)).

VI. THE DEPENDENT CLAIMS ARE PATENTABLY DISTINCT, BUT THE PETITION’S MAPPINGS ARE NOT (LIMITATIONS 14, 15, 61-64)

A. Claim 14

Hotelling’s incorporated-by-reference disclosure that “continuous gestures” may be “performed in a single stroke” does not come close to supporting the claim that the Petition’s proposed set of gestures may be continuous. Petitioner appears to interpret this disclosure to teach that *any* gesture may be “continuous,” which is clearly overbroad. *See* Reply, 21 (citing EX1010, [0066]). What Petitioner does not explain is *why* a POSITA would implement the Petition’s proposed set of gestures in a “continuous” manner, or *how* a POSITA would implement any of the Petition’s various Limitation [1.f] mappings as a “continuous” gesture with the original touch. *See* Pet., 43-45; Reply, 21. As such, Petitioner’s argument is essentially that a POSITA would “just figure it out” because Hotelling teaches that some gestures can be continuous. This is not sufficient analysis. *ActiveVideo*, 694 F.3d, 1327. Thus, the Reply does not resolve the Petition’s lack of reasoned analysis identified in the POR. POR, 59-61.

B. Claim 15, 61-64

Each of these claims recite more specific ways that the at least one aspect of the display of the at least one menu may be changed, as claimed in Limitations [1.f], [16.k], and [84.g]. Pet., 45, 49-52. For each of these claims except for Claim 61,

the Petition relies exclusively on a subset its five theories for Limitations [1.f], [16.k], and [84.g]. Pet., 45, 49-52. (For Claim 61, the Petition includes an additional theory that the POR addresses and the Reply does not defend. Pet., 50-51; POR, 62-63; Reply, 22.) Thus, a failure of that subset of theories, while not fatal to the independent claims unless all five fail, would be fatal to that dependent claim.

VII. PETITIONER’S ATTACKS ON DR. MADISETTI ARE WITHOUT MERIT

The Reply spends nearly six pages attacking Dr. Madisetti *without linking any of those criticisms to any portion of Dr. Madisetti’s actual opinions on why Petitioner fails to meet its burden*. Reply, 22-27. Petitioner faults Dr. Madisetti for not having studied every single word of Hotelling, but cites no portion of Hotelling that should have altered Dr. Madisetti’s analysis. *Id.* Petitioner also omits the full context of Dr. Madisetti’s testimony and that he explained “I offered a rebuttal to the petition and a rebuttal to Dr. Cockburn’s opinions and the basis” and it was not “the purpose of my declaration” to “do any independent evaluation of Hotelling in its entirety.” EX1059, 16-22. This role is different than his prior role in which he was an expert for a petitioner in another matter. Petitioner also faults Dr. Madisetti for not reviewing a document Hotelling incorporates by reference, EX1010, but omits that that the Petition does not cite EX1010 for any claim addressed in Dr. Madisetti’s declaration.

VIII. CONCLUSION

For the foregoing reasons, the Petition should be denied in its entirety.

Dated: September 5, 2025

Respectfully submitted,

/Eagle H. Robinson/

Eagle H. Robinson

Reg. No. 61,361

Lead Counsel for Patent Owner

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(a)(i), the undersigned certifies that this Paper—exclusive of the table of contents, table of authorities, certificate of service, and this certificate of word count—includes 5,364 words. The undersigned relies upon the word count generated by Microsoft Word.

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

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on September 5, 2025, a complete copy of the Patent Owner Sur-Reply was served on Petitioner via email (by consent), at the following email address(s):

IPR50095-0169IP1@fr.com

/Eagle H. Robinson/

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