

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

SMITH INTERFACE TECHNOLOGIES, LLC,
Patent Owner.

IPR2024-01091
Patent No. 10,936,114 B1

Before JEFFREY S. SMITH, BARBARA A. BENOIT, and
NATHAN A. ENGELS, *Administrative Patent Judges*.

BENOIT, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

Petitioner filed a Petition (Paper 2, “Pet.”), requesting *inter partes* review of claims 1, 27, 30, 32, 34, 59, 62, and 64 (“the challenged claims”) of U.S. Patent No. 10,936,114 B1 (Ex. 1001, “the ’114 patent”). Paper 2, “Pet.”). Patent Owner filed a Preliminary Response (Paper 6). After considering the Petition, the Patent Owner Preliminary Response, and the evidence cited therein, we determined that the information presented in the Petition established a reasonable likelihood that Petitioner would prevail in showing at least one of the challenged claims would be unpatentable. Paper 8 (“Dec.” or “Institution Decision”), 41–42. On January 14, 2025, we instituted *inter partes* review as to all challenged claims on all grounds asserted by Petitioner. Dec. 42.

In our Institution Decision, we identified as an issue for trial whether the “when” limitations recited in independent claim 1 were presented in the alternative such that not all of the limitations need to be satisfied in order to meet the claim. Dec. 25–27 (citing *Brown v. 3M*, 265 F.3d 1349, 1352–53 (Fed. Cir. 2001)); *Hytera Commc’ns Co. v. Motorola Solutions, Inc.*, 841 Fed. Appx. 210 (2021); *Applera Corp. v. Illumina, Inc.*, 375 Fed. Appx. 12, 21 (Fed. Cir. 2010); *Cybersettle, Inc. v. Nat’l Arbitration Forum, Inc.*, 243 Fed. Appx. 603, 607 (Fed. Cir. 2007); *Ex parte Schulhauser*, Appeal 2013-007847 (PTAB April 28, 2016) (precedential)). Independent claims 32, 34, and 64 recite similar conditional limitations. *See* Ex. 1001, 97:23–38 (claim 1), 107:52–108:3 (claim 32), 108:22–39 (claim 34), 118:50–119:5 (claim 64).

These issues may be dispositive as to these claims. In the particular circumstances of this case in which the plain language of these claims recites

mutually exclusive alternatives, we authorize each party to file claim construction briefing as set forth in this Order.

A. Independent Claim 1

Claim 1 is directed to an apparatus comprising generic elements including one or more processors and recites, among other limitations, stored instructions and “wherein the one or more processors execute the instructions to” perform certain actions. Ex. 1001, 97:13–20. The recited actions include “detect a gesture on the touch screen on the object” (limitation [1.e]) and performing various actions “when a [or ‘the’] magnitude of a duration of the gesture being detected” meets criteria relative to one of two thresholds (limitations [1.f, 1.g, and 1.i]).¹ Ex. 1001, 97:23–38; Dec. 4–5. The plain language of the claim² recites detecting a single gesture and, due to the antecedent basis in limitations [1.g and 1.i] that refer to the duration recited in limitation [1.e], takes action when the duration of the detected gesture meets the criterion recited in the conditional limitations [1.f, 1.g, and 1.i].

As we noted in the Institution Decision, the “when” limitations recited in claim 1 “appear to be written in the alternative such that not all of three recited ‘when’ conditions would be met in any scenario meeting the claim language.” Dec. 25 (discussing limitations [1.f–1.i]). As we observed, two

¹ For clarity, Petitioner’s identifiers are used. *See* Pet. v.

² Our discussion here is based on the plain language of the claims. Neither party has directed us to any portion of the written description of the challenged patent that describes an embodiment of claim 1 or otherwise describes the subject matter of claim 1. *See, e.g.* Dec. 24 (citing Prelim. Resp. 23–25); Pet. 3 (Brief description of challenged patent), 12–26 (claim 1).

of the three “when” limitations—limitations [1.f and 1.g]—present mutually exclusive conditions because the duration of the gesture cannot be both *less than* and *greater than* the specified threshold. Dec. 26. As such, only one of those two “when” conditions would be met and only the action recited in one of alternative limitations [1.f and 1.g] would be taken for any scenario that meets the claim language. Dec. 26. We also noted in the Institution Decision that dependent claim 9 informed the scope of claim 1 and identified a duration of the detected gesture for which only one of the three “when” limitations in claim 1 would be met—namely, the action recited in limitation [1.g] is performed but the actions recited in limitations [1.f] and [1.i] are not performed. On this basis, we did not agree with Patent Owner that trial should be denied because Petitioner had not identified the same gesture having three different durations. Dec. 27 (citing Prelim. Resp. 18–25).

We further note that, based on the breadth of the plain language recited in claim 1, only the condition in limitation [1.f] would be met in some instances by the duration of a detected gesture and, as a result, only the action recited in limitation [1.f] would be performed (and not actions required by limitations [1.g and 1.i]). This is because the plain language of claim 1, which does not identify a relationship between the first and second magnitude thresholds, seems to encompass instances in which a first magnitude threshold is *greater than* the second magnitude threshold and instances in which a first magnitude threshold is *less than* the second magnitude threshold.³ In such an instance, only limitation [1.f] of the three

³ This understanding is in contrast to dependent claims 8 and 9, which each show an instance in which the first magnitude threshold is *less than* the

“when” limitations would be performed. This is because limitation [1.f] is *met* because the duration of the gesture is *less than* the first magnitude threshold, limitation [1.g] is *not* met because the duration of the gesture is *not greater than* the first magnitude threshold, and limitation [1.i] is *not* met because the duration of the gesture is *less than* the first magnitude threshold and the second magnitude threshold is *less than* the first magnitude threshold, so necessarily the duration of the gesture is *less than* the second magnitude threshold.

The plain language of the claims, on the underdeveloped record on this issue developed before institution of trial, appears to encompass at least alternatives such that (1) only the action in one of limitations [1.f or 1.g] occurs due to the mutually exclusive conditions recited, (2) instances where only the action recited in limitation [1.g] occurs (as required by the conditions recited in claims 8 or 9), and (3) instances where only the action recited in limitation [1.f] occurs (as described above).

In its authorized briefing, each party may wish to address the following as well as the legal basis for its position:

express claim construction of the claim term “gesture”;

express claim construction of the claim term “a magnitude of a duration of the gesture”;

whether conditional limitations [1.f, 1.g. and 1.i] could be met by a single detected gesture;

second magnitude threshold. *See, e.g.*, Ex. 1001, 98:12–15 (requiring the duration of the gesture “to be greater than the first magnitude threshold and less than the second magnitude threshold”).

whether conditional limitations [1.f, 1.g, and 1.i] present alternatives such that no magnitude of the duration of a single detected gesture could meet all three limitations;

whether conditional limitations [1.f, 1.g, and 1.i] could be met by different gestures in which each gesture has a different duration that satisfies different alternatives; and

whether or not all of conditional limitations [1.f, 1.g, and 1.i] need to be met in order to satisfy the claim and, if not all, which ones need to be met.⁴

Each party should identify specific portions of the specification and any relevant prosecution history in evidence in support of its claim construction positions. *See, e.g., Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (indicating the specification is “the single best guide to the meaning of a” claim term); *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (“In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.”).

B. Independent Claims 32, 34, and 64

Independent claims 32, 34, and 64 recite similar (but not the same) conditional limitations to those recited in claim 1. *See* Ex. 1001, 97:23–38

⁴ *See, e.g., Brown v. 3M*, 265 F.3d 1349, 1352–53 (Fed. Cir. 2001)); *Lincoln Nat’l Life Ins. Co. v. Transamerica Life Ins. Co.*, 609 F.3d 1364, 1366, 1370 (Fed. Cir. 2010); *Ex parte Schulhauser*, Appeal 2013-007847 (PTAB April 28, 2016) (precedential)); *see also Hytera Commc’ns Co. v. Motorola Solutions, Inc.*, 841 Fed. Appx. 210 (2021); *Applera Corp. v. Illumina, Inc.*, 375 Fed. Appx. 12, 21 (Fed. Cir. 2010); *Cybersettle, Inc. v. Nat’l Arbitration Forum, Inc.*, 243 Fed. Appx. 603, 607 (Fed. Cir. 2007).

(claim 1), 107:52–108:3 (claim 32), 108:22–39 (claim 34), 118:50–119:5 (claim 64). For example, claim 32 recites “detect at least one component of a gesture” in limitation [32.e]; “when a first component of the gesture is detected where a magnitude of a duration of the gesture being detected” in limitation [32.f]; “when a second component of the gesture is detected where the magnitude of the duration of the gesture being detected” in limitation [32.g]; and “when a third component of the gesture is detected where the magnitude of the duration of the gesture” in limitation [32.i].⁵ Ex. 1001, 107:50–108:3.

As another example, independent claim 34 is directed to a method performed “at an apparatus including a watch” with certain elements. Ex. 1001, 108:14–19. The steps of the method include “detecting a gesture” in limitation [34.f] and conditional limitations “based on a [or ‘the’] magnitude of a duration of the gesture detected” in limitations [34.g, 34.h, and 34.j].⁶ Ex. 1001, 108:22–38.

In yet another example, independent claim 64, like independent claim 34, is directed to a method performed “at an apparatus including a watch.” Ex. 1001, 118:42–43. The steps of the method include “detecting at least one component of a gesture” in limitation [64.f] and conditional limitations [64.g, 64.h, and 64.j].⁷ Ex. 1001, 118:50–119:5. More specifically, claim 64 recites “in response to a first component of the gesture being detected where a magnitude of a duration of the gesture being detected” in limitation [64.g]; “in response to a second component of the

⁵ For clarity, Petitioner’s identifiers are used. *See* Pet. vii–viii.

⁶ For clarity, Petitioner’s identifiers are used. *See* Pet. viii.

⁷ For clarity, Petitioner’s identifiers are used. *See* Pet. x–xi.

gesture being detected where the magnitude of the duration of the gesture being detected” in limitation [64.h]; and “in response to a third component of the gesture being detected where the magnitude of the duration of the gesture being detected” in limitation [64.j]. Ex. 1001, 118:50–119:5.

Each party should address whether its analysis regarding claim 1 would reach a different result when applied to independent claims 32, 34, and 64. Because different claim terms are presumed to have different meanings, the parties should address each independent claim with particularity. *See, e.g., CAE Screenplates Inc. v. Heinrich Fiedler GmbH & Co. KG*, 224 F.3d 1308, 1317 (Fed.Cir.2000) (“In the absence of any evidence to the contrary, we must presume that the use of these different terms in the claims connotes different meanings.”). The parties may wish to additionally propose an express construction for the claim term “component of the gesture being detected.” Additionally, because the statutory class of a claim is important in determining patentability, the parties should address the statutory class as relevant to the legal basis supporting the party’s position. *See, e.g., IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377, 1384 (Fed. Cir. 2005) (indicating “the statutory class of invention is important in determining patentability and infringement”).

C. Authorized Claim Construction Briefing

Patent Owner is authorized, but not required, to submit claim construction briefing addressing the detect and conditional limitations recited in independent claims 1, 32, 34, and 64. Ex. 1001, 97:23–38 (claim 1), 107:50–108:3 (claim 32), 108:22–39 (claim 34), 118:50–119:5

(claim 64). Patent Owner's briefing shall be **limited to fifteen (15) pages and filed no later than DUE DATE 1**. *See* Paper 9 (Scheduling Order).

Petitioner is authorized, but not required, to submit claim construction briefing addressing the conditional limitations recited in independent claims 1, 32, 34, and 64, including responding to Patent Owner's arguments. Petitioner's briefing shall be **limited to fifteen (15) pages and filed no later than DUE DATE 2**. *See* Paper 9.

Patent Owner is authorized, but not required, to submit reply claim construction briefing in response to Petitioner's claim construction briefing. Patent Owner's briefing shall be **limited to seven (7) pages and filed no later than DUE DATE 3**. *See* Paper 9

The authorized briefing shall be limited to issues of claim construction and the legal basis for determining patentability of independent claims 1, 32, 34, and 64 in view of the conditional limitations recited in the claims. Arguments regarding the asserted prior art should not be made in the authorized claim construction briefing but be presented in the Patent Owner's Response, Petitioner's Reply, and Patent Owner's Sur-reply.

The parties may stipulate to changes in the due dates for the claim construction briefing as long as the briefing is completed no later than DUE DATE 3 for Patent Owner's sur-reply.

Patent Owner and Petitioner are invited to contact the Board to arrange for a telephone conference if the parties wish to discuss this additional briefing opportunity, including proposing a different manner for the parties to address the legal issues raised by claims 1, 32, 34, and 64.

It is SO ORDERED.

IPR2024-01091
Patent 10,936,114 B1

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