

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

SMITH INTERFACE TECHNOLOGIES, LLC,
Patent Owner.

IPR2024-01116
Patent 10,656,754 B1

**PATENT OWNER'S
OPPOSITION TO STAY OF
REEXAMINATION CONTROL NO. 90/019,646**

PATENT OWNER'S EXHIBIT LIST

Exhibit	Shorthand	Description
2001	Declaration	Declaration of Marc Davis, Ph.D.
2002	CV	CV of Marc Davis, Ph.D.
2003	JCC	Excerpt of Joint Claim Construction Chart Exhibit A.
2004	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).
2005	Ahn EP	European Publication App. No. EP08101835.0 to Hye Sang Ahn et al. ("Ahn EP")
2006	Reexam Order	November 14, 2024, Order Granting Request For Ex Parte Reexamination in Control No. 90/019,646
2007	EPR Request	September 5, 2024, REQUEST FOR <i>EX PARTE</i> REEXAMINATION OF U.S. PATENT NO. 10,656,754 UNDER 35 U.S.C. § 302 AND 37 C.F.R. § 1.510

I. SUMMARY

Smith Interface Technologies, LLC (“PO”) stipulates that it will not amend a claim, challenged in either the *ex parte* reexamination (the “EPR”) of U.S. Patent No 10,656,754 B1 (the “’754 Patent”) or the proceeding set to be consolidated from IPR2024-01115, IPR2024-0116, and IPR2024-01119 (the “IPR”), that is also challenged in the other of the EPR and the IPR or from which another claim challenged in the other of the EPR and the IPR depends while the IPR is pending and the EPR remains unstayed and co-pending (“PO’s Stipulation”). PO’s Stipulation, which concerns Factor 5 of the Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding, 84 Fed. Reg. 16,654, 16,656-57 (Apr. 22, 2019), together with Factors 2, 4, and 8, disfavors a stay of the EPR and, on balance, outweigh the Factor (1) that favors a stay. Factors 3 and 7 are negligible and Factor 6 is neutral. Therefore, a stay of the EPR should not be ordered.

II. ANALYSIS

Factor 1: Whether the claims challenged in the IPR are the same or depend directly or indirectly from claims at issue in the reexamination.

This factor favors a stay because at least some of the claims challenged in the IPR (*i.e.*, claims **2**, **165**, 187, 189, 191, 192, 197, 199-203, **208-216**, **225**, and **230**) are the same as or depend directly or indirectly from claims at issue in the EPR (*i.e.*,

claims **2, 165, 186, 208, 225, or 230**). The claims at issue in both are bolded.

***Factor 2:** Whether the same grounds of unpatentability or the same prior art are at issue in both the IPR and the reexamination.*

This factor weighs against a stay. The references in the IPR2024-0115 and IPR2024-0116 grounds (**Ahn** (US Pub. 2008/0207188) and **Chaudri '842** (US Pub. 2007/0150842)) are different from those forming the substantial new questions (“SNQs”) in the EPR (**Beaumier** (US Pub. 2011/0283236), **Chaudhri '359** (US Pub. 2009/0198359), **Wang** (US Pub. 2012/0206399), and **Shiplacoff** (US Pub. 2010/0095240)). And the EPR examiner stated: “[t]he prior art references of Beaumier, Chaudhri ‘359 and Wang are materially different references than presented in the seven IPR petitions.” Reexam Order at 16/19.

In IPR2024-01119, Shiplacoff is part of both the second ground (with Ahn and Chaudhri '842) and the third SNQ (with Beaumier, Chaudhri '359, and Wang), which challenge claim 208. But Shiplacoff is used in differing ways. *Compare* IPR2024-01119, Paper 2 at 34-40, 50-68 (at 38-39: using Shiplacoff’s “card metaphor” in the Ahn-Chaudri '842 touch screen mobile device, where “[t]he fundamental aspects of Ahn’s disclosure would remain intact,” because “Shiplacoff provides one example of implementation details that are lacking for a feature otherwise disclosed in Ahn”) *with* EPR Request at 308-333/356 (at 316/356: actually incorporating Shiplacoff’s card viewer in the Beaumier-Chaudhri '359-

Wang apparatus). This factor should disfavor a stay given (1) that difference, which pertains to only one of 88 total claims at issue in the EPR, and (2) the non-overlap of the other prior art at issue in the EPR and IPR. *Cf. Lab. Corp. of America Holdings v. Ravgen, Inc.*, IPR2021-0126, Paper 17 at 4-7 (PTAB Feb. 1, 2022).

Factor 3: Whether concurrent parallel Office proceeding will duplicate efforts within the Office.

There are very few common claims. Of the 88 claims at issue in the EPR, 87 are not challenged in IPR2024-01115; 83 are not challenged in IPR2024-01116; and 86 are not challenged in IPR2024-01119. Of the 23 claims challenged in IPR2024-01115, 22 are not at issue in the EPR; of the 16 claims challenged in IPR2024-01116, 12 are not at issue in the EPR; and of the 12 claims challenged in IPR2024-01119, nine are not at issue in the EPR. The EPR patentability assessments involve different prior art (with the exception of Shiplacoff) and arguments from the IPR grounds. *See* Factor 2 analysis, *infra*. So, none of the SNQs will necessarily be resolved or even simplified based on the resolution of any IPR ground. Even the resolution of the IPR ground involving Shiplacoff will not necessarily resolve the EPR SNQ involving Shiplacoff because other, differing references are at issue in the combinations. None of the institution decisions construe a term that is also construed in the EPR. And no Office Action has issued in the EPR, so the issues that will be in dispute in the EPR are unknown. At worst, this factor is negligible or neutral. *See*

Cisco Systems, Inc. v. Orckit Corp., IPR2023-00554, Paper 27 at 4 (PTAB Feb. 27, 2024) (finding this factor “negligible” where EPR and IPR were both at the early stages (no Office Action yet), and it was possible, though “largely speculative,” that there could be issues (like claim construction) relevant to both cases despite differing grounds against more overlapping claims than are present here).

Factor 4: Whether the reexamination could result in inconsistent results between proceedings.

This factor weighs against a stay because the resolution of any IPR ground will not necessarily resolve or even simplify the resolution of an EPR SNQ. *See* Factor 3 analysis, *infra*. A finding that a claim common to both the IPR and the EPR is unpatentable over one set of prior art references but not another is not inconsistent. And, at this point, it would be speculation to find that the EPR will need to address the construction of any term at issue in the IPR.

Factor 5: Whether amending the claim scope in one proceeding would affect the claim scope in another proceeding.

This factor weighs against a stay based on PO’s Stipulation.

Factor 6: The respective timeline and stage of each proceeding.

The IPR will be concluded by February 13, 2026, while the EPR’s conclusion is not knowable. This factor is therefore neutral. *See TikTok, Inc. v. Cellspin Soft, Inc.*, IPR2024-00770, Paper 13 at 4 (PTAB Nov. 5, 2024).

Factor 7: The statutory deadlines of the respective proceedings.

The IPR must be completed within one year (absent extension under 35 U.S.C. § 316(a)(11)) while the EPR has no statutory deadline (35 U.S.C. § 305). Even so, this factor should be negligible since very few claims overlap and PO's Stipulation should avoid any inconsistent results between proceedings.

Factor 8: Whether a decision in one proceeding would likely simplify issues in the concurrent parallel Office proceeding or render it moot.

This factor weighs against a stay. Even if one or more of the claims common to both is invalidated, there are many more uncommon claims in each proceeding that would still have to be addressed, and assessing the unpatentability of those claims will not have been simplified or mooted by the other. For example, regardless of whether claim 2 is invalidated or upheld in the IPR, the patentability of the claims depending therefrom in the EPR would still have to be addressed in the EPR (assuming an Office Action issues), which will require assessing the validity of those claims over different prior-art combinations.

Dated: March 7, 2025

Respectfully submitted,

/Eagle H. Robinson/

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Lead Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on March 7, 2025, complete copies of this Patent Owner's Opposition to Stay of Reexamination Control No. 90/019,646 and EX2006-2007 were served via email (by consent), as follows:

IPR50095-0166IP4@fr.com

/Eagle H. Robinson/
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