UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

SMITH INTERFACE TECHNOLOGIES, LLC,
Patent Owner.

Case IPR2024-01116
Patent 10,656,754

PETITIONER'S BRIEF IN SUPPORT OF BOARD'S REQUEST FOR COMMENT REGARDING STAYING REEXAMINATION

TABLE OF CONTENTS

I. Introduction 1

II. There Are Overlapping Claims and Prior Art Between the Proceedings 1

III. The Overlap Between Proceedings Will Likely Lead to Duplicate Efforts and Could Result in Inconsistent Results Between Proceedings 3

IV. The Respective Stages and Statutory Deadlines Between the EPRx and IPRs Favor a Stay 4

V. Conclusion 5

I. Introduction

Apple submits this brief in response to the Panel's invitation for comment regarding a potential stay of the co-pending *ex parte* reexamination of U.S. Patent No 10,656,754 designated Control No. 90/019,646 (hereinafter "the EPRx"). Apple does not oppose a stay of the EPRx because a stay would benefit the efficient administration of the Office and integrity of the patent system. There are overlapping issues between the instituted IPRs (IPR2024-01115, IPR2024-01116 and IPR2024-01119) and the EPRx that likely will result in duplication of efforts and could result in inconsistent findings of fact and law between the proceedings absent a stay. Further, the EPRx is at an early stage such that a stay is likely to reduce the risk of duplication or waste of resources in the EPRx—a risk that only increases as the EPRx progresses. Based on these circumstances, it would be prudent and efficient to stay the EPRx pending the conclusion of the instituted IPRs.

II. There Are Overlapping Claims and Prior Art Between the Proceedings

Independent claims 2 and 225, as well as dependent claims 186 and 208, are at issue in both the instituted IPRs and the granted EPRx. Furthermore, all other claims at issue in the granted EPRx depend from either independent claim 2 or 225. Therefore, conclusions reached by the Board about the scope of independent claim 2 or 225 in the IPRs will directly or indirectly impact determinations related to all of the claims at issue in the EPRx.

For example, each of independent claims 2 and 225 recite the term "blur." EX1001, cls. 2, 225. Each of dependent claims 124-127, 142, 152, 162, 165, 186, 195, 198, 206, 208, 218, and 221 at issue in the EPRx also recite the term "blur." The Petition explained that a POSITA would have understood the term "blur" to mean "make or become unclear or less distinct." Petition at 32-33. In its preliminary response, Patent Owner explains that "Patent Owner does not agree with Petitioner's proposed interpretation of blurring," and "reserves the right to address Petitioner's interpretation if IPR is instituted." POPR at 18, n. 3. Accordingly, at least the construction of the term "blur" is at issue in both the IPRs and the EPRx.

Similarly, a number of prior art references are shared between the IPRs and the EPRx. For example, U.S. Pub. No. 2010/0095240 to Shiplacoff is a prior art reference used in combinations that form grounds in each of IPR2024-01119 and the granted EPRx. Additionally, overlapping teachings from each of the following references is cited in both the IPRs and the EPRx:

- U.S. Appl. Pub. No. 2008/0207188 to Hye Sang Ahn *et al.* ("Ahn");
- U.S. Appl. Pub. No. 2007/0150842 to Imran Chaudhri *et al.* ("Chaudhri '842");
- Robert Kosara *et al.*, "Semantic Depth of Field," IEEE Symposium on Information Visualization 2001, pp. 97-104 (2001);
- U.S. Appl. Pub. No. 2011/0209093 to Kenneth P. Hinckley and Koji Yatani ("Hinkley"); and
- Certified translation of JP Published Patent Application No. 2002-55750 ("Hisatomi"), published February 20, 2002.

The teachings from these references are utilized in both proceedings to establish the knowledge of a POSITA and demonstrate how a POSITA would understand the prior art references that form the basis of the grounds. Accordingly, interpretation of at least these numerous overlapping references will be at issue in both the IPRs and the EPRx.

III. The Overlap Between Proceedings Will Likely Lead to Duplicate Efforts and Could Result in Inconsistent Results Between Proceedings

Because all claims at issue in the granted EPRx depend from independent claims 2 and 225 and these independent claims are also at issue in the instituted IPRs, there is a reasonable likelihood that concurrent conduct of the granted EPRx and the instituted IPRs would lead to duplicate efforts and could result in inconsistent results between proceedings. For example, as noted above in Section II, *supra*, "Patent Owner does not agree with Petitioner's proposed interpretation of blurring," which is recited in both independent claims and numerous dependent claims at issue in the granted EPRx. POPR at 18, n. 3. Under the reasonable assumption that Patent Owner will contest the meaning of this term in the granted EPRx and the instituted IPRs, both the CRU Examiner and the Board will need to adjudicate the meaning of the term "blurring," which would not only duplicate the effort of construing the claim language but could also lead to inconsistent results. Because Apple is no longer able to participate in the EPRx and therefore cannot appeal conclusions

reached by the CRU Examiner, the Board may not have an opportunity to reverse an inconsistent conclusion regarding the term "blurring." For example, if the Board maintains the preliminary construction of the term "blurring" it adopted in its Institution Decision (*see* ID at 9) in finding that the claims at issue in the IPRs are unpatentable but the CRU Examiner adopts Patent Owner's contrary construction in finding the claims at issue in the EPRx not unpatentable, Apple will not be able to appeal the CRU Examiner's decision and the Board will not have an opportunity to align the CRU Examiner's decision with the Board's.

A similar possibility for duplication and inconsistency exists with respect to the scope of the prior art shared between the granted EPRx and the instituted IPRs. Both the CRU Examiner and the Board will be called upon to interpret the teachings and scope of the Shiplacoff reference. Further, the overlapping teachings cited in the various references listed in Section III, *supra*, are largely relied upon to corroborate the understanding of a POSITA, which will be at issue in both the granted EPRx and the instituted IPRs. Concurrent interpretation of these various references by both the Board and the CRU Examiner is both inefficient and may lead to inconsistent outcomes without a clear path for correction.

IV. The Respective Stages and Statutory Deadlines Between the EPRx and IPRs Favor a Stay

With institution of the IPRs on February 13, 2025, the Board is statutorily required to issue a final determination within 1 year. 35 U.S.C. § 316(a)(11). At

most, this deadline may be extended by six months. *Id.* On the other hand, the only statutory deadline imposed on the EPRx—the requirement under 35 U.S.C. § 303(a) that the Director issue a determination whether the EPRx request raises a substantial new question of patentability—has been satisfied. Accordingly, a stay would violate no statutory deadlines.

Further, the EPRx is at an early enough stage to avoid the inefficiencies described in Section III, *supra*. Specifically, the Examiner issued an order granting the EPRx on November 14, 2024. However, the Examiner has not yet issued an Office Action interpreting the claims or prior art, nor has Patent Owner filed a response arguing against those interpretations. Now is the time, early in both proceedings, at which a stay of the EPRx would best avoid any duplication of effort or inconsistencies with respect to the IPR. Furthermore, the EPRx would be simplified by the Board adjudicating the numerous overlapping issues between the two proceedings.

V. Conclusion

Apple does not oppose a stay of the EPRx because a stay would benefit the efficient administration of the Office and integrity of the patent system. Without a stay, there is a reasonable likelihood of duplication of efforts between the EPRx and the IPRs, and inconsistent outcomes between the two proceedings without a clear path to address those inconsistencies.

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on March 7, 2025, a complete and entire copy of this Petitioner's Brief in Support of Staying Reexamination was provided by email to Patent Owner by serving the email correspondence addresses of record as follows:

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