

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner,

v.

SMITH INTERFACE TECHNOLOGIES, LLC,  
Patent Owner.

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IPR2024-01115  
IPR2024-01116  
IPR2024-01119  
Patent 10,656,754 B1

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Before MIRIAM L. QUINN, BARBARA A. PARVIS, and  
SHARON FENICK, *Administrative Patent Judges*.

FENICK, *Administrative Patent Judge*.

ORDER

Conduct of the Proceeding

37 C.F.R. § 42.5

Consolidating Proceedings

35 U.S.C. § 315(d); 37 C.F.R. § 42.122(a)

Staying Reexamination

35 U.S.C. § 315(d); 37 C.F.R. §§ 42.122(a), 42.3(a)

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On February 19, 2025, we held a call with counsel for both parties to discuss the following issues: (A) the consolidation of these three proceedings, and (B) a potential stay of the co-pending *ex parte* reexamination of Patent 10,656,754 B1 (“the ’754 patent”). On February 21, 2025, we issued an order on the conduct of the proceedings in these proceedings, noting that we had suggested and the parties had agreed to consolidation, ordering that the parties meet and confer regarding proposed limits for papers in a consolidated proceeding, and respond by email. Paper 12 (“Feb. 2025 Order”), 2.<sup>1</sup> The parties did this, and Patent Owner responded reporting the parties’ agreement in an email on March 7, 2025. Ex. 3001 (“Agreement Email”).

Additionally, we authorized parties to submit briefing regarding whether to stay the *ex parte* reexamination proceeding, 90/019,646 (“the Reexamination”), filed regarding Patent 10,656,754 B1. Feb. 2025 Order, 3–4. Both submitted such briefs. Paper 14 (“PO Stay Br.”); Paper 15 (“Pet. Stay Br.”). Petitioner does not oppose a stay. Pet. Stay Br. Patent Owner opposes a stay. PO Stay. Br.

#### *A. Consolidation*

To secure the just, speedy, and inexpensive resolution of *these inter partes* reviews, and to administer the proceedings more efficiently, we

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<sup>1</sup> We refer herein, except as indicated, to papers and exhibits in IPR2024-01115. The same order and substantially identical briefing was filed in each proceeding.

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exercise our authority to consolidate the briefing and the oral hearing for the above-captioned proceedings. *See* 35 U.S.C. § 315(d); 37 C.F.R. §§ 42.1(b), 42.122(a). The briefing will be subject to the mutually-agreed limits proposed in the Agreement Email and shall be filed in each proceeding.

All exhibits are common to all proceedings. The consolidated papers may refer to the common exhibit number without a citation to a particular proceeding. The parties are encouraged to use the same exhibit numbers in each proceeding for any additional exhibits that are submitted. For any paper that is not common to multiple proceedings, the consolidated briefing may use a short citation that adequately identifies the proceeding in which the paper appears (e.g. “Petition-01115” or similar).

#### *B. Reexamination*

On September 5, 2024, Petitioner filed a request for *ex parte* reexamination of claims 2, 83, 85, 86, 101, 108–115, 118–120, 123–127, 130–132, 134, 136, 137, 142–148, 150–186, 188, 193, 195, 196, 198, 205–208, 217–221, 225, 230, and 232 of the ’754 patent. Ex. 2007, 2. On November 14, 2024, Petitioner’s request for reexamination was granted and assigned control number 90/019,646. Ex. 2006. An office action was issued on March 7, 2025. Ex. 2008.

Of the claims for which reexamination was requested, claims 2, 186, 208, 225, and 230 are also challenged in one or more of the instituted *inter partes* review proceedings. IPR2024-01115, Paper 2 (Petition), 1 (showing claim 2 as challenged); IPR2024-01116, Paper 2 (Petition), 1–2 (showing

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claims 2, 186, 225, and 230 as challenged); IPR2024-01119, Paper 2 (Petition, hereinafter “Petition-01119”), 1 (showing claims 2 and 208 as challenged). Claims 2 and 225 are independent. Ex. 1001, 95:35–49, 119:43–54)

The Board may enter an order staying a reexamination proceeding where good cause exists. 37 C.F.R. § 42.122(a); *see also* 35 U.S.C. § 315(d); 37 C.F.R. § 42.3(a). “[T]he Board ordinarily will stay a [reexamination] where good cause exists.” Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding, 84 Fed. Reg. 16654, 16656 (Apr. 22, 2019) (“Notice”). The Notice outlines factors the Board considers in AIA trials in deciding whether to stay a parallel reexamination involving the same patent. Notice, 16657.

We discuss each of those factors below.

*1. Whether the claims challenged in the IPRs are the same as or depend directly or indirectly from claims at issue in the Reexamination*

Petitioner argues all claims challenged in the Reexamination depend from independent claims challenged in the Reexamination and in these *inter partes* proceedings (claims 2 and 225). Pet. Stay Br., 1.

Patent Owner agrees that this factor favors a stay. PO Stay Br., 1–2.

We concur; this factor favors a stay.

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2. *Whether the same grounds of unpatentability or the same prior art are at issue in both the IPRs and the Reexamination*

There is no dispute that the two proceedings raise different grounds of unpatentability. Patent Owner points out that neither Ahn<sup>2</sup> nor Chaudhri-842,<sup>3</sup> both of which are relied upon for the grounds in the *inter partes* proceedings, is used in the substantial new questions in the reexamination request, as acknowledged by the Examiner.<sup>4</sup> PO Stay Br., 2–3; Ex. 2007, 15; Ex. 2006, 15–17.

Petitioner argues that Shiplacoff<sup>5</sup> is at issue in IPR2024-01119 and in the Reexamination. Pet. Stay Br. 2. Petitioner additionally asserts that overlapping teachings from certain references, including Ahn and Chaudhri-842, are used in the reexamination. *Id.*

We determine that the prior art at issue in the *inter partes* review proceedings and that used in the Reexamination overlaps to a small extent, but is substantially distinct. While Petitioner is correct that Ahn and Chaudhri-842 are cited in the reexamination request, the citations are not used in the analysis of the independent claims. *See, e.g.*, Ex. 2007, vii–viii

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<sup>2</sup> US 2008/0207188 A1, published August 28, 2008 (Ex. 1004).

<sup>3</sup> US 2007/0150842 A1, published June 28, 2007 (Ex. 1005).

<sup>4</sup> Chaudhri-359 (US 2009/0198359 A1, published August 6, 2009), a reference different from Chaudhri-842, is denominated “Chaudhri” and used to assert a substantial new question of patentability in the request for *ex parte* reexamination. Ex. 2007, vii.

<sup>5</sup> US 2010/0095240 A1, published Apr. 15, 2010 (Ex. 1013).

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(showing Ahn as Appendix and Chaudhri-842 as Appendix H), 32–46 (analysis of claim 2, not citing either Ahn or Chaudhri-842), 55–57 (using Chaudhri-842 to support analysis of claim 109), 167–170 (using Ahn to support analysis of claim 162), 231–233 (analysis of claim 225).

Shiplacoff, however, appears to be used in a similar manner in IPR2024-01119 as in the Reexamination, with respect to claim 208. The IPR2024-01119 petition describes Shiplacoff as teaching a gesture that switches from a full screen mode to a second mode displaying a menu. Petition-01119, 50–68. Similar teachings from Shiplacoff are used in the reexamination request. Ex. 2007, 305–323. We note that Claims 1 and 208–216 are the claims challenged using a combination including Shiplacoff in IPR2024-01119, and of these claims only 208 is challenged in the Reexamination. Petition-01119, 1; Ex. 2007, 5.

Because substantially different prior art and different grounds are at issue in these *inter partes* review proceedings than in the Reexamination, this factor weighs against a stay.

*3. Whether simultaneously conducting the Reexamination and IPRs will duplicate efforts within the Office*

Petitioner argues that “Because all claims at issue in the [Reexamination] 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 [Reexamination] and the instituted IPRs would lead to duplicate efforts and could result in inconsistent results between proceedings.” Pet. Stay Br. 3–4. Petitioner

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argues, for example, that a claim interpretation of “blurring” may be at issue in each case. *Id.*, *see id.* at 2.

Patent Owner describes the lack of overlap in dependent claims challenged. PO Stay Br. 3. Patent Owner contends that few of the claims challenged in the Reexamination are at issue in the *inter partes* reviews and vice versa. *Id.* Patent Owner argues that “at worst” the factor is negligible or neutral because it is not clear which issues will overlap. *Id.* at 3–4.

After an evaluation of the proceedings, we agree with Petitioner that it appears at least some issues will overlap in these proceedings, and that it is significant that each independent claim challenged in the Reexamination is at issue in the *inter partes* proceedings. Allowing both proceedings to proceed concurrently would involve a duplication of efforts.

We find that this factor favors a stay.

4. *Whether the Reexamination could result in inconsistent results between proceedings*

Patent Owner argues that “[a] finding that a claim common to both the IPR[s] and the [Reexamination] is unpatentable over one set of prior art references but not another is not inconsistent.” PO Stay Br. 3. Patent Owner reiterates that it is not known at this point the extent of overlapping issues. *Id.*

Petitioner’s arguments as to this factor are the same as those made for factor 3, discussed above. Pet. Stay Br. 3–4.

For the reasons discussed with respect to factor 3, we find that this factor favors a stay.

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

Patent Owner stipulates that it will not amend a claim challenged in the Reexamination or the *inter partes* review proceedings if we do not stay. PO Stay Br. 1. In light of this stipulation, Patent Owner argues that this factor weighs against a stay. Petitioner does not address this factor.

Because the stipulation removes one possible area of inconsistency and inefficiency, this factor weighs against a stay.

*6. The respective timeline and stage of each proceeding*

These proceedings are subject to a statutory deadline that requires a final decision within one year of institution, absent a good cause extension. 35 U.S.C. § 316(a)(11). The deadline is February 13, 2026.

The Reexamination is required to be “conducted with special dispatch,” but is not subject to a specific deadline. 35 U.S.C. § 305. The CRU issued a first action in the Reexamination on March 7, 2025.

Patent Owner argues this factor is neutral, since there is no deadline for the Reexamination to conclude. PO Stay Br. 4. Petitioner argues that it would be efficient, to avoid duplication of effort, to stay the Reexamination. Pet. Stay Br. 5.

We find this factor to weigh slightly in favor of a stay.

*7. The statutory deadlines of the respective proceedings*

As discussed above, only the *inter partes* proceedings are subject to a statutory deadline. Patent Owner argues that this factor “should be

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negligible.” PO Stay Br. 5. Petitioner notes that “a stay would violate no statutory deadlines.”

We find this factor to be neutral.

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

Patent Owner argues that this factor weighs against a stay because many dependent claims would remain to be addressed in the Reexamination even if the independent claims were found unpatentable in the *inter partes* proceedings. PO Stay Br. 5. Petitioner argues that the Reexamination would be simplified if we were to adjudicate overlapping issues. Pet. Stay Br. 5.

We determine that a final determination in these *inter partes* review proceedings regarding the patentability of the independent claims of the ’754 patent and regarding claim 208 (with respect to the teachings of Shiplacoff) could resolve or simplify certain issues in the Reexamination, but many issues would remain and be unaffected by any determinations in these proceedings.

This factor weighs against a stay.

9. *Conclusion*

Factors 1, 3, 4, and 6 weigh in favor of a stay, factors 2, 5, and 8 weigh against a stay, and factor 7 is neutral. After considering all the factors, for the foregoing reasons, we find good cause exists for staying the Reexamination pending resolution of these *inter partes* review proceedings.

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*See* Notice at 16656 (“Good cause for staying a case may exist if, for example, an ongoing AIA proceeding, which is subject to statutory deadlines, is addressing the same or overlapping claims of a patent at issue in a parallel Office proceeding.”).

We note for the parties that the Notice specifies considerations for lifting a stay, both generally (Notice, 16657) and specifically with respect to an *ex parte* reexamination (Notice, 16658). Should a party wish to move for the lifting of a stay, it should request authorization to so move and a phone conference with the Board.

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Accordingly, it is:

ORDERED that, pursuant to 35 U.S.C. § 315(d), IPR2024-01115, IPR2024-01116, and IPR2024-01119 are consolidated for the purposes of briefing and oral hearing, and all further filings in the consolidated proceeding shall be made identically in each case;

FURTHER ORDERED that the parties' agreed-upon word and page limits for briefing, as found in Exhibit 3001, shall be applicable for briefing;

FURTHER ORDERED that, pursuant to 35 U.S.C. § 315(d), Reexamination Control No. 90/019,646 is stayed pending the termination or completion of IPR2024-01115, IPR2024-01116, and IPR2024-01119; and

FURTHER ORDERED that this stay tolls all time periods for filing further papers in Reexamination Control No. 90/019,646, and, absent specific authorization, no further papers shall be filed in the reexamination while this stay remains in place; and

FURTHER ORDERED that, when the stay is lifted, a paper will be sent resetting the time periods for responding to any outstanding papers in Reexamination Control No. 90/019,646.

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