

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

SMITH INTERFACE TECHNOLOGIES, LLC,
Patent Owner.

IPR2024-01117
Patent 10,656,754 B1

Before NATHAN A. ENGELS, SHARON FENICK, and
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

FENICK, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

On June 28, 2024, Apple Inc. (“Petitioner”) filed a petition requesting an *inter partes* review of claims 2, 25, 27, 65, 66, 101, 104, 117, and 122 of U.S. Patent No. 10,656,754 B1 (Ex. 1001, “the ’754 patent”). Paper 2 (“Pet.”). With its Petition, Petitioner filed a Declaration of Dr. Loren Terveen (Ex. 1003) and a paper ranking the seven petitions filed by Petitioner for the ’754 patent (Paper 3; “Ranking Notice”). Smith Interface Technologies, LLC (“Patent Owner”) timely filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). With its Preliminary Response, Patent Owner filed a Declaration of Marc Davis, Ph.D. (Ex. 2001) and a response to Petitioner’s ranking (Paper 8; “Ranking Response”).

We may institute an *inter partes* review if the information presented in the Petition and the Preliminary Response shows that there is a reasonable likelihood that Petitioner would prevail with respect to at least one of the challenged claims. *See* 35 U.S.C. § 314. However, the Board has discretion to deny a petition even if a petitioner meets that threshold. *See, e.g., Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”). The Board’s Trial Practice Guide identifies considerations that may warrant exercise of this discretion. PTAB Consolidated Trial Practice Guide (Nov. 2019) (“Trial Practice Guide”),¹ 55–63.

For the reasons that follow, we exercise our discretion to deny institution of *inter partes* review.

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

I. BACKGROUND

A. *Related Matters*

The parties indicate that the '754 patent has been asserted in *Smith Interface Technologies, LLC v. Apple Inc.*, 3:23-cv-01187 (S.D. Cal.). Pet. 74; Paper 4 (Patent Owner Mandatory Notices), 1.

The '754 patent is the subject of various proceedings at the United States Patent and Trademark Office, all initiated by Petitioner. Specifically, on June 28, 2024, Petitioner filed this Petition as well as six other petitions in IPR2024-01086, IPR2024-01114, IPR2024-01115, IPR2024-01116, IPR2024-01118, and IPR2024-01119,² which each challenge claims in the '754 patent. Ranking Notice 1–2; *see infra* § II (addressing parallel petitions). In addition, on September 5, 2024, Petitioner filed an *ex parte* reexamination request for a different set of claims of the '754 patent (*see* Ex. 2004 (district court order in the related litigation), 3), and reexamination was ordered on November 14, 2024 (Reexamination Control No. 90/019,646).³

² In this Decision, we refer to these proceedings using the last four digits of the proceeding number. For example, we refer to IPR2024-01116 as the “1116 IPR” and its petition as the “1116 petition.”

³ Neither Petitioner nor Patent Owner identified this related matter to the Board in their mandatory notices, despite their obligation to do so. 37 C.F.R. §§ 42.8(a)(3), 42.8(b)(2).

B. The Petition's Asserted Grounds

Petitioner asserts the following grounds of unpatentability (Pet. 1):

Claim(s) Challenged	35 U.S.C. ⁴ §	Reference(s)/Basis
2, 27	103(a)	Ahn, ⁵ Chaudhri ⁶
25, 65, 66, 101, 104, 117, 122	103(a)	Ahn, Chaudhri, Hinkley ⁷

C. The '754 Patent

The '754 patent is titled “Devices and Methods for Navigating Between User Interfaces.” Ex. 1001, code (54). The application leading to this patent was filed on June 11, 2019, claiming priority to several applications, including a provisional application filed on August 5, 2011. *Id.* at codes (22), (60), (63).

The '754 patent includes a description of a method in which a signal is received in association with a touch interface of a device, and the user experience for the user of the device is altered utilizing the signal. Ex. 1001, 3:4–6, 14:31–53, 15:12–18, Fig. 3. The touch interface of a device may be combined with a display of the device, and thus may be a touch screen for the device. *Id.* at 14:57–65. The signal may include a pressure signal that is

⁴ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. §§ 102 and 103 effective March 16, 2013. We refer the pre-AIA version of the statute because the '754 patent claims priority to an application filed before that date; however, our findings and analysis would be the same under the current statute.

⁵ US 2008/0207188 A1, published August 28, 2008 (Ex. 1004).

⁶ US 2007/0150842 A1, published June 28, 2007 (Ex. 1005).

⁷ US 2011/0209093 A1, published August 25, 2011 (Ex. 1006).

indicative of a magnitude of pressure applied to a touch screen. *Id.* at 15:39–43.

The '754 patent describes that a user's touch may be analyzed to determine if it is a gesture based on touch event attributes. Ex. 1001, 56:32–38; Fig. 18. The '754 patent notes that “[s]ome gestures may be able to be identified solely from initial touch event attributes” while “[o]ther gestures may only be identified after the gesture has been performed for some period of time.” *Id.* at 56:53–56. A user may be given feedback, such as a display of a representation of the gesture, as a gesture is performed. *Id.* at 59:48–51. “Once the gesture has been identified, the corresponding operation is performed.” *Id.* at 57:9–10, Fig. 18. The association between gesture and operation may be context-dependent or context-independent. *Id.* at 59:28–29, 59:35–38, 59:41–44.

Gesture dynamics are aspects of a gesture that may vary without changing the identity of the gesture, such as contact point velocity, contact point acceleration, contact pressure velocity, contact pressure acceleration, time to complete gesture, or other aspects. Ex. 1001, 59:18–27. Gesture magnitude refers to the magnitude of gesture dynamics. *Id.* at 61:1–3. “For example, in one embodiment, the gesture magnitude of a swipe gesture may include the length of the swipe and/or the contact pressure exerted during the swipe.” *Id.* at 61:3–5.

An interface may include multiple layers, which may be physical layers or virtual display layers. Ex. 1001, 68:30–47. Virtual display layers may be given the appearance of depth through the use of 3D depth cues. *Id.* at 68:58–60. “[A] 3D depth cue refers to an effect, manipulation, transformation, animation or operation which gives a visual indication of a simulated depth.” *Id.* at 68:60–63. “[A] 3D depth cue may be a blur

operation, such that layers located at successively greater depths may appear blurrier than those closer to the user.” *Id.* at 68:63–66. “As an option, 3D depth cues may be used to indicate ‘moving’ through the display layers as the contact pressure is changed (i.e. magnifying and fading display layers as they are passed by, sharpening previously blurry display layers as they grow closer, etc.” *Id.* at 71:4–9.

D. Challenged Claims

In this Petition, Petitioner challenges claims 2, 25, 27, 65, 66, 101, 104, 117, and 122 of the ’754 patent. Of these, only claim 2 is independent. It recites:

- 2.[a] An apparatus, comprising:
 - at least one non-transitory memory;
 - a touch screen; and
 - one or more processors in communication with the at least one non-transitory memory, and the touch screen, wherein the one or more processors execute instructions in the at least one non-transitory memory, to cause the apparatus to:
 - [b] display an object and at least one other object;
 - [c] detect at least part of a gesture on the touch screen;
and
 - [d] during detection of at least a portion of the gesture before a completion thereof is detected, blur, based on a change in a magnitude of the gesture being detected on the touch screen, at least a portion of the at least one other object.

Ex. 1001, 95:35–49 (Petitioner’s reference designations added).

II. DISCRETIONARY DENIAL

Petitioner concurrently filed seven petitions challenging various claims of the '754 patent. *See* Ranking Notice 1–2. Patent Owner argues that we should exercise our discretion to deny all but two of them. Ranking Response 2.

Having considered the parties' arguments and the specific situation presented in these proceedings, we are persuaded to consider the merits of the top three ranked petitions and to discretionarily deny the other four. Because this Petition is ranked fifth (*see* Ranking Notice 1–2), we exercise our discretion to deny institution of this proceeding.

A. Framework

“[I]n most situations,” one petition is sufficient to challenge a patent’s claims, and additional “petitions filed against the same patent at or about the same time . . . may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns.” Trial Practice Guide 59. There are, however, situations where more than one petition is necessary. *Id.* For example, a patent owner may have “asserted a large number of claims in litigation.” *Id.* “In such cases two petitions by a petitioner may be needed, although this should be rare.” *Id.* “Further, based on prior experience, the Board finds it unlikely that circumstances will arise where three or more petitions by a petitioner with respect to a particular patent will be appropriate.” *Id.*

“To aid the Board in determining whether more than one petition is necessary,” the Trial Practice Guide authorizes a petitioner to file a paper that ranks the petitions, identifies their differences, and explains “why the Board should exercise its discretion to institute additional petitions if it

identifies one petition that satisfies petitioner’s burden under 35 U.S.C. § 314(a).” Trial Practice Guide 59–60; *see* Ranking Notice. The Trial Practice Guide authorizes a patent owner to file a response to the petitioner’s paper. Trial Practice Guide 60–61; *see* Ranking Response. “The Board will consider the parties’ submissions in determining whether to exercise its discretion to institute *inter partes* review under 35 U.S.C. § 314(a).” Trial Practice Guide 61.

B. The Parallel Petitions

Petitioner submitted a Ranking Notice that ranks its petitions and identifies the claims challenged by each petition.⁸ *See* Ranking Notice 1–2. All seven petitions challenge independent claim 2, and four of the petitions challenge dependent claim 27; however, no other claims are challenged in more than one petition. As for the substance of the petitions, all contend that the challenged claims would have been obvious over a combination of Ahn and Chaudhri (alone or with one or two additional references). In addition, there are no grounds presented that are not based on a combination of Ahn and Chaudhri.

The following table identifies Petitioner’s ranking and the claims challenged by each petition. In addition, the rightmost column identifies the number of unique claims challenged by each additional petition.⁹

⁸ Petitioner’s Ranking Notice includes several typographical errors in the listing of challenged claims (Ranking Notice 1–2), but we have corrected these errors in the table provided in this section.

⁹ Specifically, although claims 2 and 27 are challenged in multiple petitions, these claims are only counted for the 1119 and 1116 petitions, respectively.

Rank	Petition	Challenged Claims	Unique Claims
1	IPR2024-01119	1, 2, 208–216	11
2	IPR2024-01116	2, 27, 186, 187, 189, 191, 192, 197, 199–204, 225, 230	15
3	IPR2024-01115	2, 27, 37, 58, 60–64, 67–79, 223	21
4	IPR2024-01114	2, 27–30, 32–36, 38, 40, 42–44, 46, 47, 52, 54, 57, 59	19
5	IPR2024-01117	2, 25, 27, 65, 66, 101, 104, 117, 122	7
6	IPR2024-01118	2, 80–83, 88, 90, 94, 95, 97–100	12
7	IPR2024-01086	2, 8, 10, 16, 24, 26, 224	6

C. Parties' Arguments

Petitioner contends that the seven petitions are necessary in order to address all 91 challenged claims.¹⁰ Ranking Notice 1. Petitioner states that the patent includes 365 claims in total, and that Patent Owner is asserting 166 claims in the co-pending district court litigation. *Id.* at 2. Petitioner submits that its petitions are each directed to different claims and rely on “only one single ground,” i.e., a combination of Ahn and Chaudhri. *Id.* at 1.

In addition, Petitioner argues that seven petitions are required because “the nature and relationship of the Challenged Claims demand significant overlap across the petitions.” Ranking Notice 2. Specifically, the ’754 patent includes only three independent claims (claims 1, 2, and 225), and nearly all challenged claims depend from claim 2. *See id.* at 3. As a result, Petitioner was required to repeat its contentions for claim 2 in each petition

¹⁰ Petitioner states that it challenges “99” claims (Ranking Notice 1 (emphasis omitted)); however, the petitions collectively challenge only 91 unique claims. We have corrected this error as well.

before addressing the other challenged claims. *Id.* Petitioner contends the sections common to the petitions (which analyze claim 2; summarize the '754 patent, Ahn, and Chaudhri; identify the level of ordinary skill in the art; evaluate claim construction; and address other potential sources of discretionary denial) “require[] approximately **8,350** words,” leaving Petitioner “only about 5,650 words per petition with which to present any invalidity arguments specifically directed to any Challenged Claims.” *Id.* According to Petitioner, this limited-word-count problem is further compounded by the fact that most of the challenged claims include multiple dependencies and many claims include features recited in other claims. *Id.* at 4–5; *see also id.* at 2 (characterizing the claims as “verbose”).

Patent Owner responds that the Board should discretionarily deny all but two of these petitions. Ranking Response 2, 5. Patent Owner quotes the Trial Practice Guide and argues that, “[w]hile this may be one of the ‘rare’ situations that requires ‘two petitions,’ this is not such an ‘unlikely ... circumstance[]’ that three petitions are appropriate, let alone the seven petitions asserted here.” *Id.* at 2 (alterations in original). Patent Owner observes that “Petitioner challenges an average of just 13 claims per petition,” and Patent Owner represents that “Petitioner only challenges just over half (87) of the[] 166 claims” asserted in litigation. *Id.*; *cf.* Ex. 2004, 3 (district court stating that the petitions “challenge[] the validity of 85 of the 166 asserted claims (including all independent claims)”), 9 (stating that the petitions do not challenge 81 of the asserted claims).

In addition, Patent Owner argues that Petitioner fails to show that there are material differences between the petitions. Ranking Response 3–5. Specifically, Patent Owner contends that “Petitioner admits that each petition includes over 8,000 words of identical text that ‘cover no actual

Challenged Claim,”” and “[n]othing in the petitions shows that Petitioner attempted to organize or consolidate its arguments to efficiently challenge the claims.” *Id.* at 3. According to Patent Owner, Petitioner’s contentions “could have been distilled into only a few petitions.” *Id.* In support, Patent Owner submits that Petitioner removed nearly 1,000 words from the common sections of at least one petition (*id.* at 3–4), and that the petitions include other “inefficiencies,” such as challenging claim 27 and its dependent claims in different petitions, repeating the same sentences within different portions of the same petition, and repeating large swaths of argument between petitions (*id.* at 4–5). According to Patent Owner, “Petitioner’s failure to organize and draft its arguments in a succinct manner is not a reason to institute additional petitions.” *Id.* at 3.

D. Analysis

As a starting point, we agree with the parties that more than one petition is warranted given the number of claims at issue. *See* Trial Practice Guide 59 (identifying situations where “two petitions . . . may be needed”). Patent Owner has asserted 166 claims in the co-pending district court litigation, and Petitioner challenges 91 unique claims in these petitions. *See* Ranking Notice 2; Ranking Response 2. Also, the vast majority of the challenged claims are asserted in litigation. *See* Ranking Response 2; Ex. 2004, 3. As a result, we agree that this is the type of “rare” situation where multiple parallel petitions are necessary.

We do not agree, however, that seven petitions are justified.¹¹ Petitioner's primary argument is that seven petitions were required because the common sections needed to be repeated in each petition, which left few words for arguments directed to new claims (given word count limits). *See* Ranking Notice 2–3. But this argument is premised on an assumption that these common sections “require[d] approximately **8,350** words” (*id.* at 3), and Petitioner has not persuasively shown that so many words were actually required for these sections. Petitioner includes no explanation or justification of the length of the sections, but instead, it simply assumes that the words used were required. Having reviewed the analysis in those sections, we do not agree. In other words, although we agree that the common sections needed to be repeated in each petition (and that this reduced the number of words available for other analysis), we are not persuaded that the common sections required approximately 8,350 words. A petitioner is certainly entitled to allocate its words as it sees fit, and we typically have no reason to evaluate those strategic decisions; however, we agree with Patent Owner (*see* Ranking Response 3) that Petitioner cannot justify a large number of petitions by claiming that it needed additional words for its analysis (given the Board's word count limits) unless Petitioner's analysis was concise.

¹¹ A petitioner is not entitled to an unlimited number of petitions (*see* Trial Practice Guide 59–61); instead, we determine whether the circumstances justify additional petitions (*see id.* at 59–60). This approach conforms with the rationale behind imposing a word count limit on petitions. *See id.* at 39 (discussing the reasons for establishing word count limits and urging parties to present “concise, well-organized, easy-to-follow arguments supported by readily identifiable evidence of record.”).

As a consequence, we reviewed the content of the common sections—i.e., the analysis of claim 2, the summary of the '754 patent and prior art, the articulation of the level of skill in the art and claim construction, and the other preliminary comments—and we are not persuaded that they are sufficiently concise to support Petitioner's argument. Claim 2 is only fifteen lines long, and its technology is relatively simple, yet Petitioner's analysis of this claim stretches for seventeen pages. *See* Pet. 23–40. Petitioner provides no general information about the technology and submits that no claims need to be construed (*id.* at 7), yet Petitioner provides a five-page summary of the '754 patent and its prosecution history (*see id.* at 2–6). Also, Petitioner provides an eleven-page summary of Ahn and Chaudhri (*see id.* at 7–18), despite the fact that neither reference is particularly long. Indeed, as Patent Owner notes, Petitioner was able to remove nearly 1,000 words from these common sections in at least one of the petitions. *See* Ranking Response 3–4. Because Petitioner's analysis in the common sections does not appear to be concise, we are not persuaded that Petitioner's use of approximately 8,350 words in those sections justifies the large number of petitions.

Petitioner also argues that seven petitions were required to address all of the claims given their “nature and relationship” (Ranking Notice 2), but this argument is largely premised on the unpersuasive assumption that Petitioner needed to repeat 8,350 words for independent claim 2 and other preliminary matters. Petitioner argues that use of the remaining word count

was complicated by the claims’ “multiple dependencies”¹² and tendency to “mix and match terms to create different combinations” (*id.*), but Petitioner also does not persuasively show that it organized the challenged claims efficiently in view of these constraints. For example, Petitioner argues that the analysis of claim 27 is repeated in four petitions¹³ because forty-four of the challenged claims depend from claim 27 (*see* Ranking Notice 4); however, as Patent Owner notes (*see* Ranking Response 4), one of these four petitions (i.e., the 1116 petition) does not challenge *any* of claim 27’s dependent claims. Petitioner also argues that ten challenged claims depend from claim 186, and similar subject matter is recited in “other claims” challenged in other petitions (*see* Ranking Notice 4); however, Petitioner does not explain why those other claims were not included in the petition challenging claim 186 (*see* Ranking Response 4–5).

Nevertheless, we are persuaded that this group of cases is somewhat extraordinary and, consequently, that more than two petitions are justified. Petitioner challenges 91 claims, and the vast majority of these claims are asserted in litigation. Separating the claims into different petitions is complicated by the ’754 patent’s unusual claiming structure (which includes several layers of dependencies) and by the presence of substantially similar

¹² The vast majority of challenged claims depend directly from dependent claims 27, 83, 101, 186, or 208, which each depend directly from independent claim 2. Also, there are about a dozen challenged claims with an additional layer of dependency (i.e., the claim depends from a claim that depends from a claim that depends from an independent claim), and one claim (claim 59) adds a fourth layer of dependency.

¹³ Although Petitioner asserts that the analysis of this claim is repeated in “five petitions” (Ranking Notice 4), this claim only appears in the 1116, 1115, 1114, and 1117 petitions. We have corrected this typographical error.

limitations in different claims. However, the challenged claims do not appear to be excessively long or technologically complex. As a result, having reviewed the specific circumstances, we are persuaded that institution of three of the seven petitions is appropriate.

Accordingly, we are persuaded to exercise our discretion to deny all but the top three ranked petitions. Because Petitioner ranks this Petition fifth (Ranking Notice 1–2), we discretionarily deny institution of this proceeding.

III. CONCLUSION

In the specific factual circumstances of this case, we exercise our discretion to deny institution.

IV. ORDER

It is ORDERED that the Petition is denied and no *inter partes* review is instituted.

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