

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA MOBILITY LLC and GOOGLE LLC,
Petitioners,

v.

MULTIFOLD INTERNATIONAL INCORPORATED PTE. LTD.,
Patent Owner.

Case IPR2025-00038

U.S. Patent 8,836,842

PATENT OWNER'S PRELIMINARY RESPONSE

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PATENT OWNER'S EXHIBIT LIST	
2001	Plaintiff Multifold International Incorporated Pte. Ltd.'s Proposed Counter-Constructions in Response to Defendants' Proposed Terms for Claim Construction

I. INTRODUCTION

Challenged claims 1-7, 10-13, 16-17, and 19-20 of U.S. Patent 8,836,842 (the “’842 Patent”) are directed to an improved image capture interface for a dual screen device. The device has multiple image capture modes, and in each image capture mode the display of information on either the first or second screen is different than the display of information by that screen in the other image capture modes. This is distinct from the prior art, which does not teach either the first or second screen displaying different information in each image capture mode. Therefore, institution must be denied.

II. BACKGROUND

A. The ’842 Patent

The ’842 Patent is titled “Capture Mode Outward Facing Modes” and is directed to “[m]ethods and devices for selectively presenting a user interface in a dual screen device.” Ex.1001, abstract. “The device may present different information on the two screens based on several factors including the mode of the image capture feature...” *Id.*

Fig. 1A shows an exemplary dual screen image capture device:

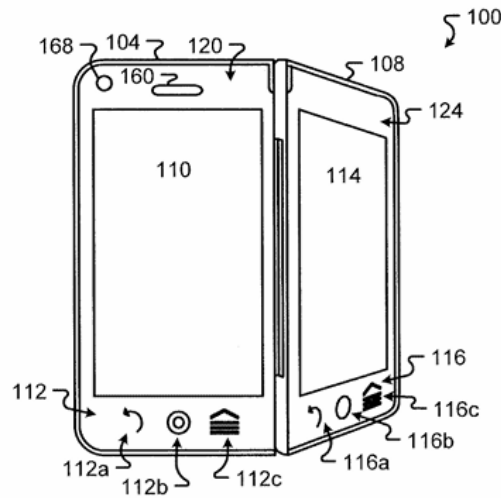


FIG. 1A

Ex.1001, Fig. 1A. The '842 Patent further describes the information displayed on the two screens during various image capture modes in col. 36 ln. 37-45:

A first display 1200 may be presented for the image capture function 1100, in step 2112, as described hereinbefore in FIGS. 13 through 19. After presenting the first display 1200 for the image capture function 1100, the device 100 may receive a rotation of the device 100, in step 2116. In response to the rotation of the device 100, the device 100 may present a second display 2000 for the image capture function 1100 that is different from the first display 1200, in step 2120.

Ex.1001, 36:37-45. These steps are further illustrated in Fig. 21:

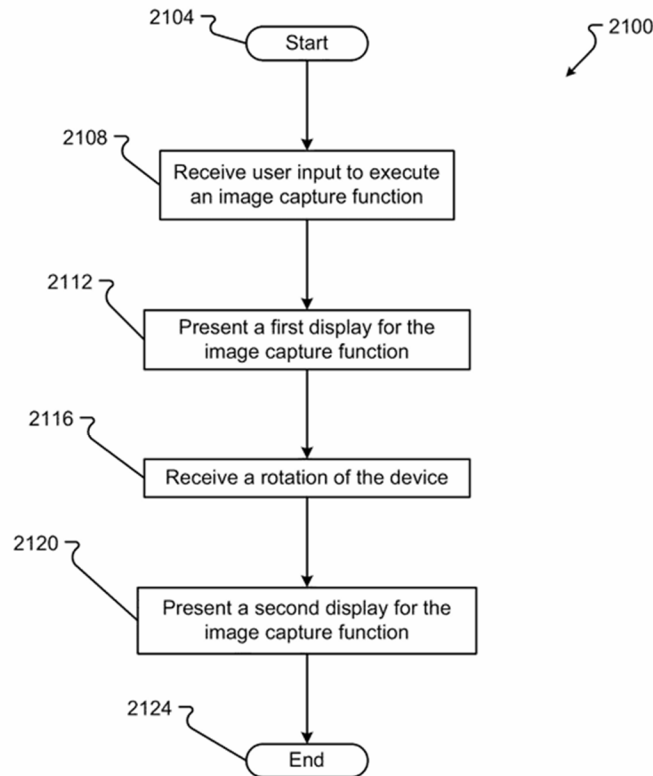


FIG. 21

Ex.1001, Fig. 21. At step 2112, the device presents a first manner of displaying the image capture function. *Id.* Fig. 12 shows an exemplary first manner of displaying the image capture function:

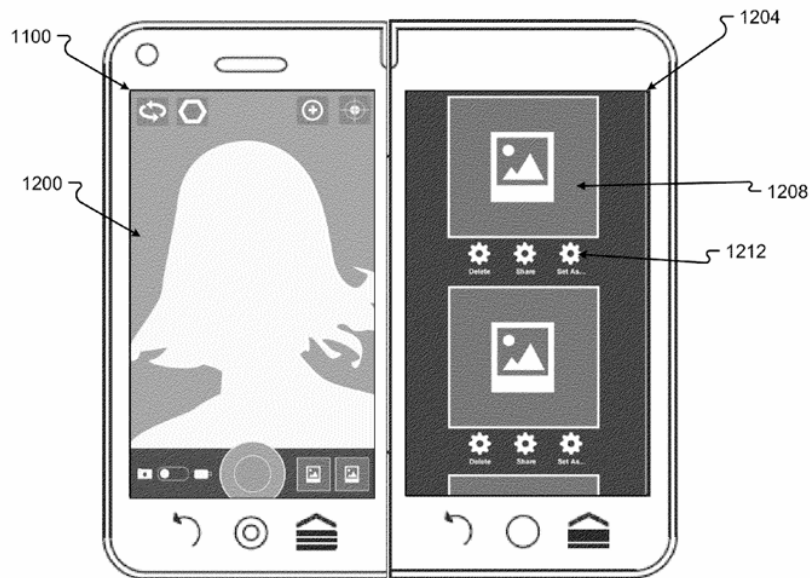


FIG. 12

Ex.1001, Fig. 12 (showing the device in a first image capture mode). The user may change the image capture mode at step 2116, and at step 2120 the device therefore presents a second manner of displaying the image capture function. Fig. 20 shows an exemplary second manner of displaying the image capture function:

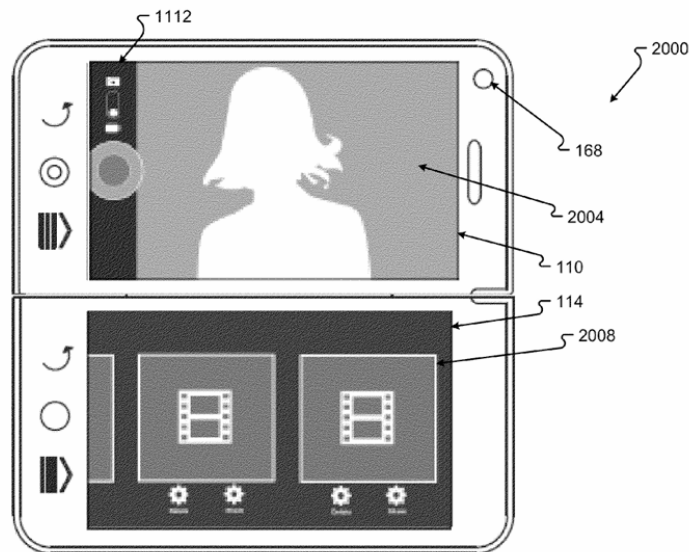


Fig. 20

Ex.1001, Fig. 20 (showing the device in a second image capture mode). As can be seen in Figs. 12 and 20 and further described in col. 36 ln. 37-45, the device in the first image capture mode presents a first display 1200 that is different than a second display 2000 presented by the device in the second image capture mode. Notably, first display 1200 and second display 2000 are presented on the same left screen of the device but are different between the first image capture mode and second image capture mode.

B. The Alleged Prior Art

The Petition asserts the following four grounds of invalidity:

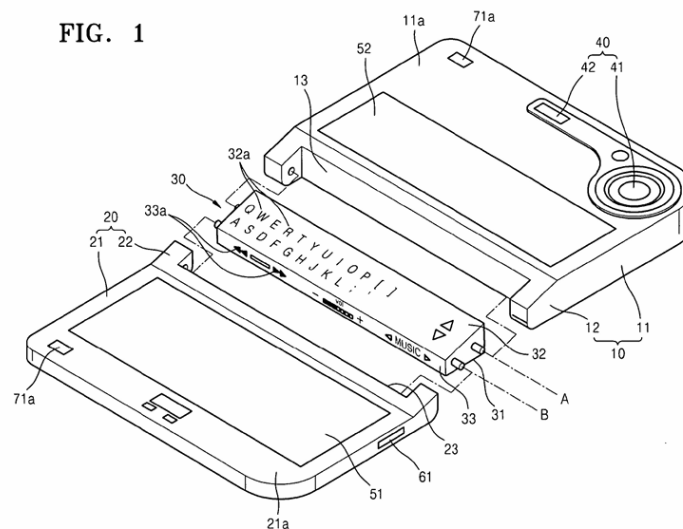
- Anticipation of claims 1-7, 10-13, 16-17, and 19-20 by U.S. Pub.

2009/0190295 (“Chin”)

- Obviousness of claims 1-7, 10-13, 16-17, and 19-20 in view of Chin
- Anticipation of claims 1-7 and 11 by U.S. Pub. 2005/0078211 (“Whitehorn”)
- Obviousness of claims 1-7 and 11 in view of Whitehorn

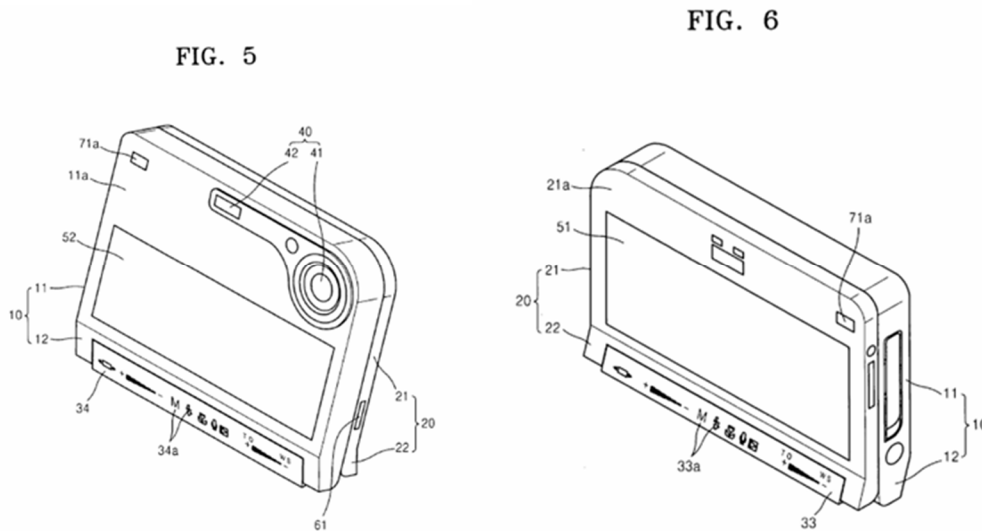
1. Chin

Chin is a patent application titled “Portable Information Terminal” and discloses a portable information terminal comprising two flat boards connected by a hinge as shown in Fig. 1:



Ex.1004, Fig. 1. The first flat board 11 comprises a camera 40 and a second display unit 52. Ex.1004, [0044]-[0045]. The second flat board unit 21 comprises a first display unit 51. *Id.*

Chin's terminal may be oriented in two positions, and the second position is shown by Figs. 5 and 6:



Ex.1004, Figs. 5 and 6. Notably, Chin only discloses that the first display unit 51 provides a preview when the device is not in self-photographing mode and the second display unit 52 provides a preview when the device is in self-photographing mode. Ex.1004, [0078]-[0079]. Chin does not disclose what the first display unit displays in self-photographing mode, or what the second display unit displays when not in self-photographing mode.

2. Whitehorn

Whitehorn is a patent application titled “Handheld Device with Integral Axial Camera” and describes a handheld device with an integrated axial camera to

permit “a first large screen interface to rotate about a first hinge axis with respect to a second large screen interface.” Ex.1005, abstract.

Figure 5 shows the rotation of Whitehorn’s device:

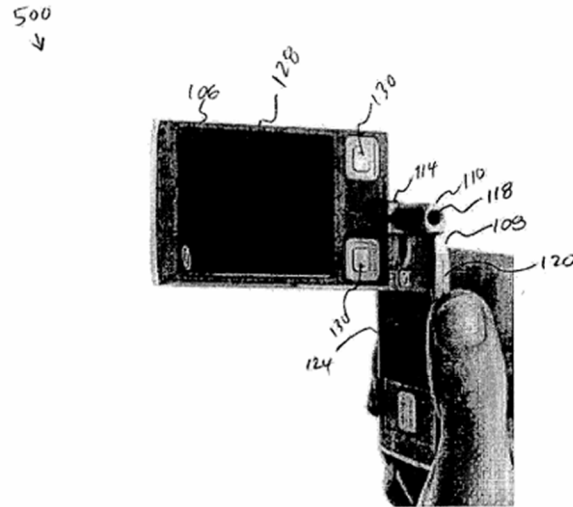


Fig. 5

Ex.1005, Fig. 5. The device has two large screen interfaces – top large screen interface 128 and bottom large screen interface 124 – and a small screen interface 118. Ex.1005, [0022]-[0023]. The small screen interface 118 displays images captured by the image capture device 116. *Id.*, [0023], [0027]. Alternatively, top large screen interface 128 may also display images captured by the image capture device 116 if it “would be more convenient [viewing the images on large screen interface 128] than viewing them on the small screen interface 118.” *Id.*, [0029].

III. CLAIM CONSTRUCTION

The Petition provides constructions for two terms in the '842 patent: “screen” and “display.” Pet., 16-17. The Petition argues that the “’842 patent expressly defines the term ‘screen’ [as referring] to a physical structure that includes one or more hardware components that provide the device with the ability to render a user interface and/or receive user input.” Pet., 15 (*citing* Ex.1001, 2:63-65). The Petition argues that the “’842 patent also expressly defines ‘display’ [as referring] to a portion of one or more screens used to display the output of a computer to a user.” Pet., 16 (*citing* Ex.1001, 3:28-29).

For the purposes of this preliminary response, Patent Owner’s arguments do not turn on the construction of either term. Therefore, it is unnecessary at this preliminary stage for the Board to construe either “screen” or “display.” *Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’”).

However, for the reasons discussed below, the term “wherein in each image capture mode a display on the first or second screen is different” should be construed to require a different display on the first screen between image capture modes or a different display on the second screen between image capture modes, in

accordance with that term's plain and ordinary meaning. As such, none of the prior art suggests "wherein in each image capture mode a display on the first or second screen is different."

For the purposes of this preliminary response, Patent Owner interprets all other terms under their plain and ordinary meaning as understood by a POSITA. Patent Owner reserves the right to expressly construe other terms of the '842 Patent should the Board institute review.

A. "Wherein in each image capture mode a display on the first or second screen is different"

In the District Court litigation, while the parties agreed the term need not be briefed during Markman proceedings, Defendants identified the construction of the term "wherein in each image capture mode a display on the first or second screen is different" as "in each of the device's image capture modes, the contents presented on the first screen or second screen are different." Ex.2001, 4. Patent Owner identified a competing construction for this term as "the type of display on one or both of the screens is different between different image capture modes." *Id.*

For the purposes of institution, the Board need not determine if either of these two constructions is correct because both constructions recognize that the claim term requires a different display on the first screen between image capture modes or a different display on the second screen between image capture modes.

Realtime Data, 912 F.3d at 1375. Petitioners' construction proposes that the contents presented on the first screen are different in each of the device's image capture modes or the contents presented on the second screen are different in each of the device's image capture modes. Thus, this construction requires a different display on the first screen between image capture modes or a different display on second screen between image capture modes. Likewise, Patent Owner's construction proposes that the type of display on one or both screens is different between different image capture modes. This construction also requires a different display on the first screen between image capture modes or a different display on second screen between image capture modes.

The intrinsic evidence further supports this understanding. Specifically, col. 36 ln. 37-45 teaches that the claimed differences are, for example, between a first display 1200 presented in a first image capture mode and a second display 2000 presented in a second image capture mode:

A first display 1200 may be presented for the image capture function 1100, in step 2112, as described hereinbefore in FIGS. 13 through 19. After presenting the first display 1200 for the image capture function 1100, the device 100 may receive a rotation of the device 100, in step 2116. In response to the rotation of the device 100, the device 100 may present a second display 2000 for the image capture function 1100 that is different from the first display 1200, in step 2120.

Ex.1001, 36:37-45. This is confirmed by the steps shown in Fig. 21:

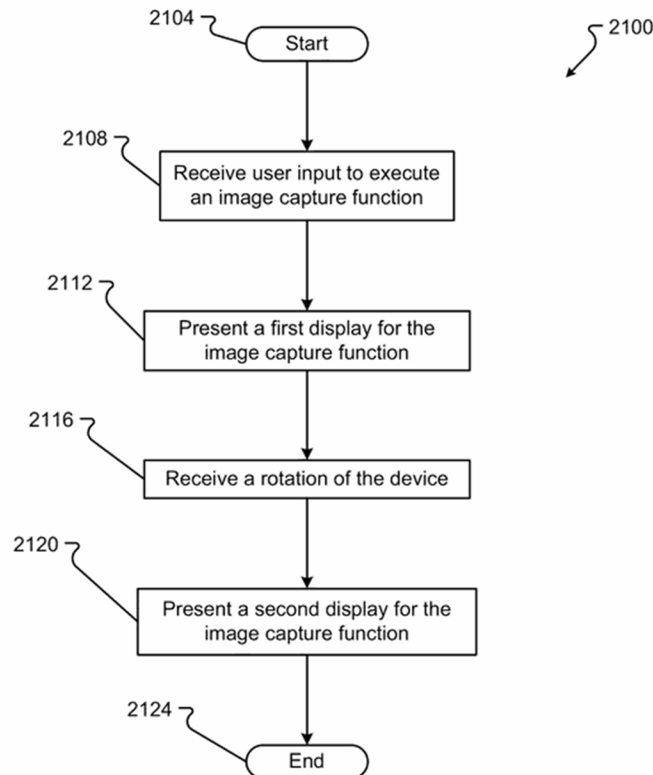


FIG. 21

Ex.1001, Fig. 21. The device first presents a first manner of displaying the image capture function (with first display 1200) in step 2112. The user changes the image capture mode in step 2116, and the device then presents a second manner of displaying the image capture function (with second display 2000) in step 2120. *Id.* Fig. 12 shows first display 1200:

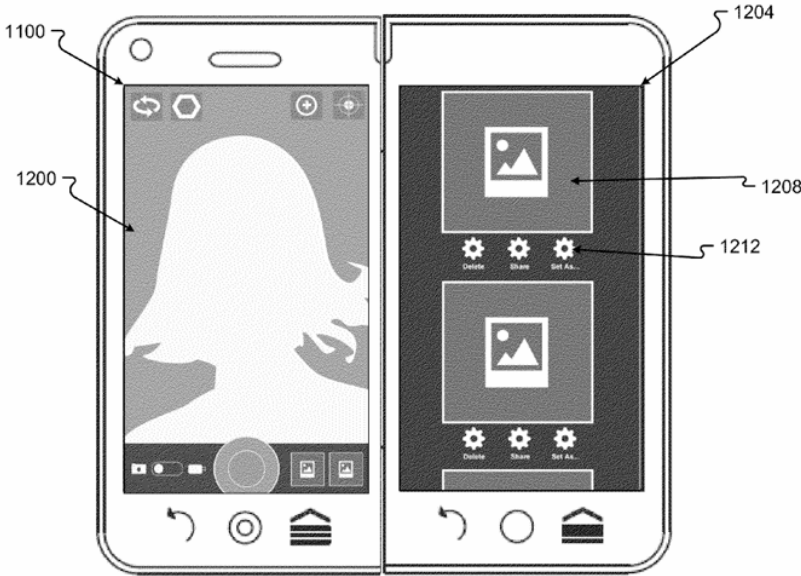


FIG. 12

Ex.1001, Fig. 12. And Fig. 20 shows second display 2000:

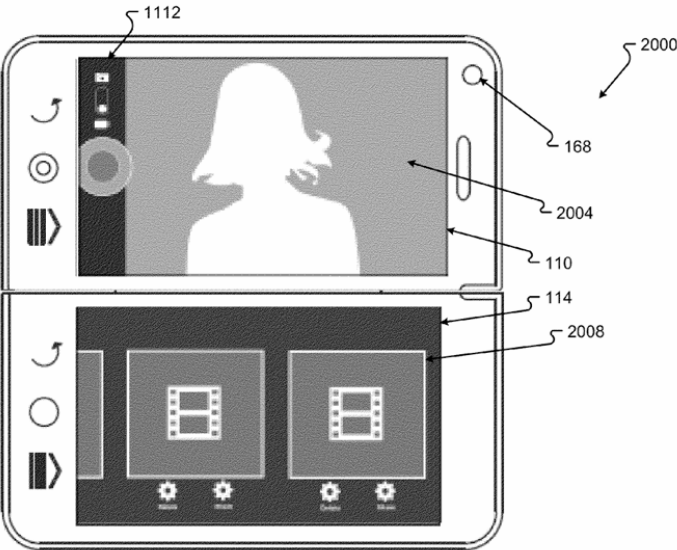


Fig. 20

Ex.1001, Fig. 20. Figs. 12 and 20 confirm that, as evidenced by first display 1200 and second display 2000, the displays presented on the same left screen of the device are different between the first image capture mode and second image capture mode.

Thus, the intrinsic evidence is consistent with the parties' constructions and the term's plain and ordinary meaning requiring a different display on the first screen between image capture modes or a different display on the second screen between image capture modes.

IV. PERSON OF ORDINARY SKILL

The Petition submits that a “person of ordinary skill in the art at the time of the alleged invention of the '842 patent (“POSITA”) would have had at least a bachelor's degree in electrical engineering, computer engineering, computer science, or a related field plus at least two years of work or post-graduate experience in image capture, image processing, image display, user interfaces, or a related field. Additional education could offset a lesser amount of experience and vice versa.” Pet., 16. Patent Owner applies this definition of a POSITA for the purposes of this preliminary response but expressly reserves the right to urge a different definition of a POSITA and support such definition with evidence including expert testimony.

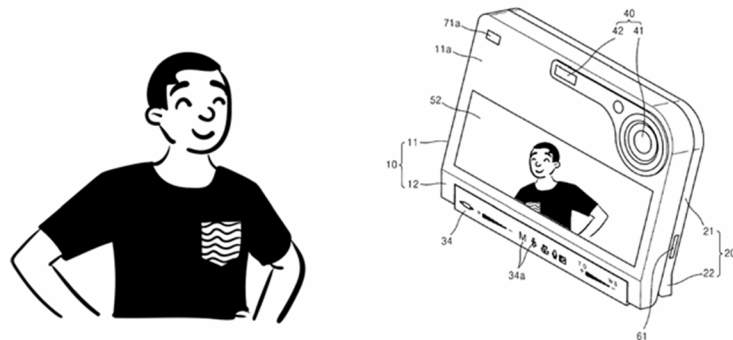
V. CLAIMS 1-7, 10-13, 16-17, and 19-20 ARE NOT ANTICIPATED BY OR OBVIOUS IN VIEW OF PETITIONERS' PRIOR ART

A. Neither Chin nor Whitehorn suggests “wherein in each image capture mode a display on the first or second screen is different”

Independent claims 1, 11, and 16 each require “wherein in each image capture mode a display on the first or second screen is different.” As discussed in Section III.A above, both parties’ proposed constructions in the District Court litigation recognize that this term requires a different display on the first screen between image capture modes or a different display on second screen between image capture modes, which is consistent with the term’s plain and ordinary meaning. As such, the Petition has not shown that either Chin or Whitehorn suggests this term.

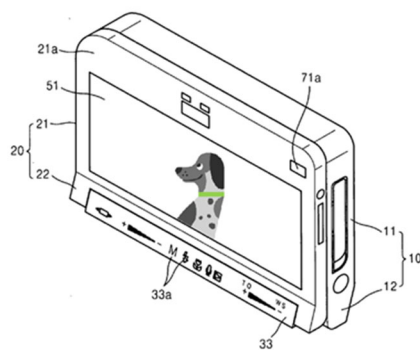
First, the Petition alleges that Chin teaches this element because “Chin teaches two image capture modes: the ‘self-photographing mode’ and the mode designed to take an outward-facing image” and “which screen displays the preview or images changes between the two modes.” Pet., 29-30. Specifically, the Petition identifies Chin’s Fig. 5 showing the preview image displayed on screen 52 in the “Self-Photographing” Mode and Chin’s Fig. 6 showing the preview image displayed on screen 51 in the “Outward-Facing” Mode (the photo subject and displayed screen are annotations made by Petitioners to Chin’s original figures):

FIG. 5



"Self-Photographing" Mode

FIG. 6



"Outward-Facing" Mode

Pet., 32-33. But these Figures do not address the claimed requirement because they do not demonstrate that the *same* screen presents different displays between different image capture modes. The Petition is wholly missing any evidence of what screen 52 displays in the "Outward-Facing" Mode that could confirm the display is different than in the "Self-Photographing" Mode shown in Fig. 5. Nor does the Petition present any evidence of what screen 51 displays in the "Self-

Photographing” Mode that could confirm the display is different than in the “Outward-Facing” Mode shown in Fig. 6. Indeed, Chin only discloses what the first display 51 displays when not in self-photographing mode and what the second display 52 displays when in self-photographing mode – Chin provides no disclosure of what each display displays in both modes necessary to establish that the same screen presents different displays in different image capture modes. Ex.1004, [0078]-[0079]. But without such evidence, the Petition has not demonstrated that the same screen presents different displays in different image capture modes, and thus the Petition has not demonstrated that “in each image capture mode a display on the first or second screen is different.”

Second, the Petition alleges that Whitehorn teaches this element because “Whitehorn teaches a first and second image capture mode” and, depending on the mode, “the device displays information on the small screen interface 118” in one mode or the device displays information on the top large screen interface 128 in another mode. But this theory again does not demonstrate that the *same* screen presents different displays in different image capture modes. The Petition has not alleged – much less shown – that small screen interface 118 presents different displays between the two modes. Rather, Whitehorn discloses that the purpose of small screen interface 118 is to display images captured by image capture device

116 (Ex.1005, [0022]), so it would always present the image captured by device 116 and never present a different image regardless of the image capture mode. Likewise, the Petition has not presented any evidence that large screen interface 128 presents different displays between the two modes. Whitehorn merely teaches that large screen interfaces 124 and 128 may display images captured by image capture device 116 if the user prefers viewing them through interfaces 124 or 128. Ex.1005, [0027] (“Users may prefer this mode out of convenience or due to bright lighting conditions which would otherwise obscure images displayed on one of the large screen interfaces 124 and 128.”), [0029] (“Users may prefer this mode when viewing images on the top large screen interface 128 would be more convenient than viewing them on the small screen interface 118.”). Again, these screens would always present the image captured by device 116 and never present a different image regardless of the image capture mode. Recognizing the difficulties in their theory, Petitioners also argue that large screen interface 128 may be turned off in one mode. Pet., 66 (“[T]he top large screen interface is not visible and does not display an image”). But turning off a screen does not show that “in each image capture mode a display on the first or second screen is different” in that it does not demonstrate that the same screen displays different information or images in different image capture modes. Even under Petitioners’ District Court construction,

the contents on a screen must be different in each of the device's image capture modes. And if a screen is off, that screen has no contents – nothing can be displayed. Thus, Petitioners' argument does not even satisfy their own District Court construction for this term.

Accordingly, the Petition fails to demonstrate that either Chin or Whitehorn suggests a different display on the first screen between image capture modes or a different display on second screen between image capture modes. Thus, the Petition fails to demonstrate that “wherein in each image capture mode a display on the first or second screen is different.”.

VI. CONCLUSION

For the foregoing reasons, the Board should deny institution.

Date: February 28, 2025

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This Patent Owner's Preliminary Response ("POPR") consists of 2710 words, excluding table of contents, table of authorities, certificate of service, this certificate, or table of exhibits. The POPR complies with the type-volume limitation of 14,000 words as mandated in 37 C.F.R. § 42.24. In preparing this certificate, counsel has relied on the word count of the word-processing system used to prepare the paper (Microsoft Word).

Dated: February 28, 2025

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that, pursuant to 37 CFR § 42.6(e), a true and correct copy of the foregoing **PATENT OWNER'S PRELIMINARY RESPONSE** have been served electronically via email on counsel of record for

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