

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA MOBILITY LLC and GOOGLE LLC,
Petitioner,

v.

MULTIFOLD INTERNATIONAL INCORPORATED PTE. LTD.,
Patent Owner.

IPR2025-00038
Patent 8,836,842 B2

Before KRISTEN L. DROESCH, ARTHUR M. PESLAK, and
BRIAN P. MURPHY, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Motorola Mobility LLC and Google LLC (collectively, “Petitioner”) filed a petition (Paper 1, “Pet” or “Petition”) requesting *inter partes* review of claims 1–7, 10–13, 16, 17, 19, and 20 of U.S. Patent No. 8,836,842 B2 (Ex. 1001, “’842 Patent”). Petitioner filed a Declaration of Jeffrey J. Rodriguez, Ph.D., with its Petition. Ex. 1003. Multifold International Incorporated Pte. Ltd. (“Patent Owner”) timely filed a preliminary response. Paper 7 (“Prelim. Resp.” or “Preliminary Response”).

We have authority to determine whether to institute review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). An *inter partes* review may not be instituted unless it is determined that “the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a).

For the reasons provided below, we determine, based on the record before us, there is a reasonable likelihood Petitioner would prevail in showing at least one of the challenged claims is unpatentable.

B. Real Parties In-Interest

Petitioner indicates that the real parties-in-interest are Motorola Mobility LLC and Google LLC. *See* Pet. 3. Patent Owner indicates that Multifold International Incorporated Pte. Ltd. is the real party in-interest. *See* Paper 5, 1.

C. Related Matters

The parties indicate that the ’842 Patent is or was the subject of the following: *Multifold International Incorporated Pte. Ltd. v. Motorola Mobility LLC*, No. 1:23-CV-1173 (D. Del.);

Multifold International Incorporated Pte. Ltd. v. Google LLC, No. 1:23-CV-01323 (D. Del.); and

Multifold International Incorporated Pte. Ltd. v. Samsung Electronics Co., Ltd. et al., 2:21-cv-00371 (E.D. Tex.). See Pet. 3–4; Paper 5, 1.

D. The '842 Patent (Ex. 1001)

The '842 Patent is directed to “[m]ethods and devices for selectively presenting a user interface in a dual screen device,” that “include[] a change in the display mode . . . while the device is in an image capture mode” and “may present different information on the two screens based on several factors including the mode of the image capture feature, the orientation of the device, and/or the state of the device.” Ex. 1001, code (57); see *id.* at 1:45–2:3.

Figure 1A of the '842 Patent is reproduced below.

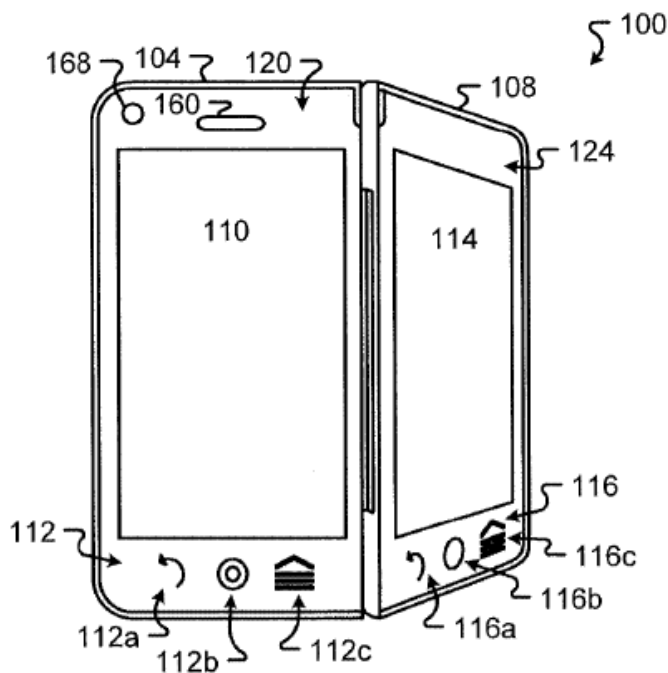


Figure 1A illustrates multi-screen device 100 including primary screen 104 with touch sensitive display 110, configurable area 112 for specific inputs, and gesture capture area 120, and secondary screen 108 with a touch sensitive display 114,

configurable area 116 for specific inputs, and gesture capture area 124. *See* Ex. 1001, 5:18–19, 7:17–56. Touch sensitive displays 110 and 114 display information to the user, but gesture capture areas 120 and 124 are not capable of rendering displayed images. *See id.* at 7:26–30, 7:60–67. Screens 104 and 108 are connected together with a hinge and “device 100 may have different functionalities depending on the relative positions of screens 104 and 108.” *Id.* at 8:1–11. Device 100 also includes camera 168 and two position sensors (not shown) used to determine the relative positions of screens 104, 108. *Id.* at 8:65–9:2.

Figure 13 of the '842 Patent is reproduced below.

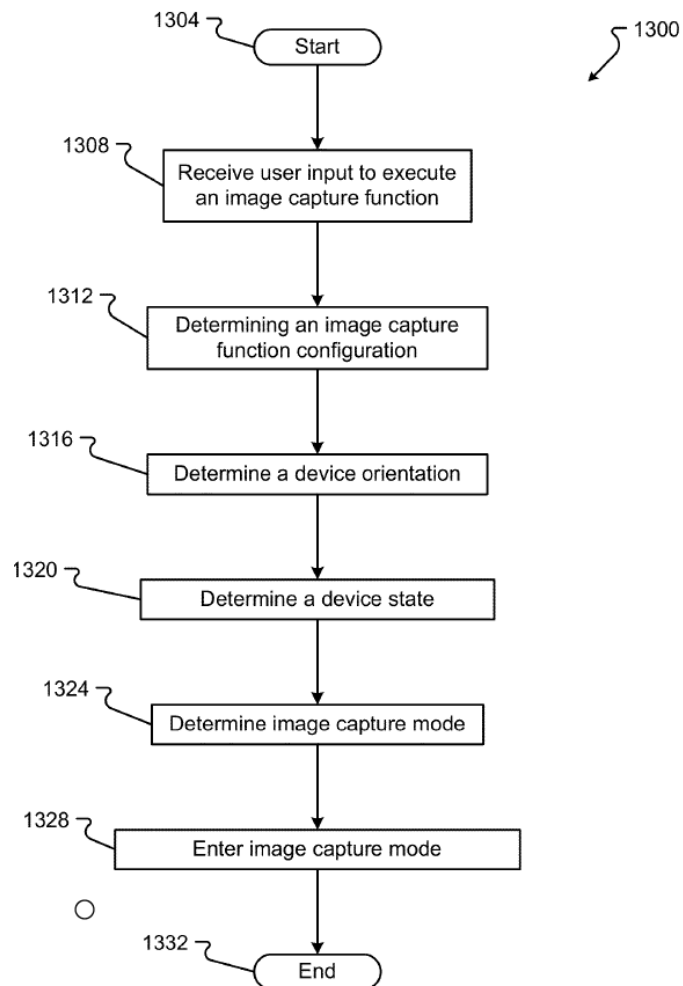


Figure 13 is a flowchart of method 1300 for providing an image capture function. *See* Ex. 1001, 6:39–40, 32:61–33:6. Method 1300 begins at step 1304, followed by step 1308 in which multi-screen device 100 receives an input from a user requesting execution of an image capture function. *See id.* at 33:7–15. Device 100 determines an image capture function configuration based on the device state and display mode in step 1312. *See id.* at 33:15–17. Device 100 determines a device orientation in step 1316, a device state in step 1312, and an image capture mode in step 1324. *See id.* at 33:17–20. Based on the determined orientation, state, and image capture mode, device 100 enters the image capture mode in step 1328. *See id.* at 33:20–22.

Figures 15 and 15B of the '842 Patent are reproduced below.

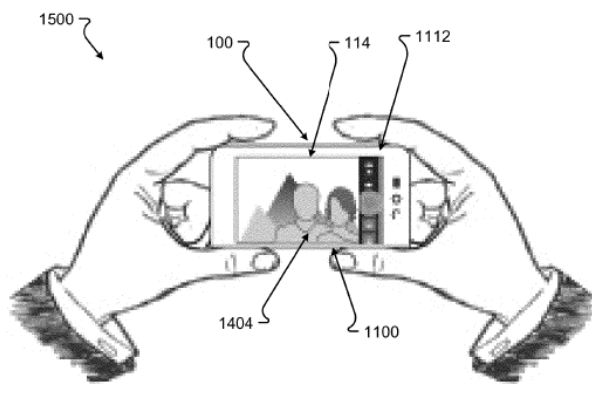


Fig. 15A

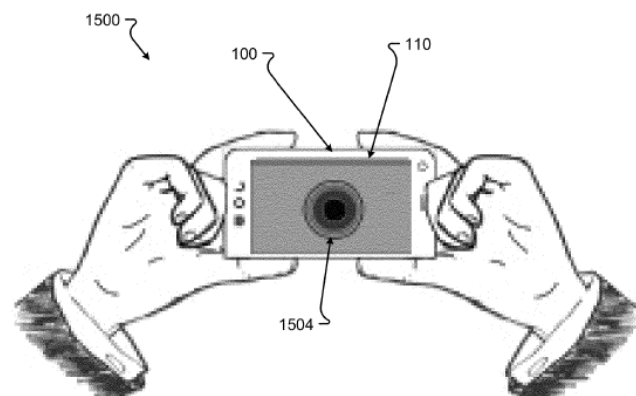


Fig. 15B

Figures 15A and 15B illustrate exemplary user interfaces for an image capture function. *See* Ex. 1001, 6:45–48. Device 100 is in a closed state and landscape orientation, second screen 114 facing the user shows preview 1404 of the scene in front of the user, and image 1504 that looks like a camera lens is displayed on first screen 110. *See id.* at 33:38–42, 33:45–46; 33:54–59. “Thus, the party in the scene to be captured is presented with a visual indicia that indicates a picture or image is being taken.” *Id.* at 33:59–61.

E. Illustrative Claim

Claims 1, 11, and 16 are independent, and claims 2–7, 10, 12, 13, 17, 19, and 20 depend directly or indirectly therefrom. *See* Ex. 1001, 39:26–41:5.

Claim 1 is illustrative and reproduced below:

1. A method, comprising:
 - providing a device having at least first and second screens;
 - receiving user interface input to execute an image capture function;
 - determining one or more of an image capture function configuration, a device orientation, and a device state; and
 - based on one or more of the image capture function configuration, the device orientation, and the device state, entering one of one or more image capture modes, wherein in each image capture mode a display on the first or second screen is different.

Ex. 1001, 39:26–37.

F. Asserted Challenges to Patentability and Asserted Prior Art

Petitioner challenges claims 1–7, 10–13, 16, 17, 19, and 20 on the following grounds of unpatentability (Pet. 6–7):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–7, 10–13, 16, 17, 19, and 20	102 ¹	Chin ²
1–7, 10–13, 16, 17, 19, and 20	103	Chin
1–7, 11	102	Whitehorn ³
1–7, 11	103	Whitehorn

¹ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. §§ 102 and 103 effective March 16, 2013. Because the '842 Patent claims an effective filing date prior to the effective date of the applicable AIA amendment, we refer to the pre-AIA version of §§ 102 and 103.

² US 2009/0190295 A1, published July 30, 2009 (Ex. 1004).

³ US 2005/0078211 A1, published Apr. 14, 2005 (Ex. 1005).

II. ANALYSIS

A. Claim Construction

In an *inter partes* review proceeding, the Board applies the same claim construction standard as that applied in federal courts in a civil action under 35 U.S.C. § 282(b), which is generally referred to as the *Phillips* standard. *See* 37 C.F.R. § 42.100(b); *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). Under the *Phillips* standard, “words of a claim ‘are generally given their ordinary and customary meaning.’” *Phillips* 415 F.3d at 1312.

Petitioner points out the express definitions for the terms “screen” and “display” set forth in the ’842 Patent. *See* Pet. 16–17 (citing Ex. 1001, 2:63–65, 3:28–29; Ex. 1003 ¶¶ 55–56). Patent Owner asserts that “it is unnecessary at this preliminary stage for the Board to construe either ‘screen’ or ‘display.’” Prelim. Resp. 9 (citing *Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019)).

Independent claims 1, 11, and 16 each recite “wherein in each image capture mode a display on the first or second screen is different.” Ex. 1001, 39:36–37, 40:9–11, 40:53–55. Patent Owner contends that this claim phrase “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.” Prelim. Resp. 9–10. Patent Owner points out that Defendants in the related district court proceedings identified the construction as “in each of the device’s image capture modes, the contents presented on the first screen or second screen are different,” and Patent

Owner identified the construction as “the type of display on one or both of the screens is different between different image capture modes.” *Id.* at 10 (citing Ex. 2001, 4). According to Patent Owner, “[f]or 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.” *Id.* at 10–11 (citing *Realtime*, 912 F.3d at 1375). Patent Owner asserts that the intrinsic evidence supports the parties understanding. *See id.* at 11–14 (reproducing Ex. 1001, Figs. 12, 20, 21; citing Ex. 1001, 36:37–45).

We do not adopt Patent Owner’s proposed construction. The disputed claim language merely requires that the display on the first or second screen is different in each image capture mode. Consistent with the claim language, the ’842 Patent discloses numerous examples of image capture modes in which a display on the first or second screen is different. *See e.g.*, Ex. 1001, Figs. 12, 14A–14B, 15A–B, 16A–B, 20. Patent Owner’s construction is narrower than the claim language and incorrectly adds a requirement for a different display on the first screen between image capture modes or a different display on the second screen between image capture modes. *See also* Prelim. Resp. 16–17 (arguing that the claim requires the same screen to present different displays in different image capture modes). Patent Owner’s citations to the ’842 Patent are directed to an embodiment disclosing a preview image 1108 on first display 1200 that is in the portrait orientation in Figure 12 that, upon rotation of device 100,

changes to preview image 1108 in landscape orientation 2004. *See* Ex. 1001, 35:65–36:2, 36:32–37:6; Figs. 12, 20, 21. Although claims are interpreted in light of the specification, it is improper to read an extraneous limitation into a claim from the specification. *See e.g., Commark Comm’s Inc. v. Harris Corp.*, 156 F.2d 1182, 1186 (Fed. Cir. 1998); *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.3d 1430, 1433 (Fed. Cir. 1988). An extraneous limitation is “a limitation read into a claim from the specification wholly apart from any need to interpret what the patentee meant by particular words or phrases in the claim.” *E.I. du Pont de Nemours*, 849 F.2d at 1433.

As demonstrated in the analysis below, at this stage of the proceeding, we need not explicitly construe “screen,” display,” “wherein in each image capture mode a display on the first or second screen is different,” or any other claim term or phrase. *See, e.g., Realtime*, 912 F.3d at 1375.

B. Level of Ordinary Skill in the Art

Petitioner asserts that

[a] person of ordinary skill in the art . . . (‘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.

Pet. 16. Petitioner also offers that “[a]dditional education could offset a lesser amount of experience and vice versa.” *Id.* Patent Owner does not dispute Petitioner’s proposed definition of a person of ordinary skill in the art for the purpose of institution. *See* Prelim. Resp. 14.

For the purpose of institution, we adopt Petitioner’s definition of a person of ordinary skill in the art because it is consistent with the level of skill reflected by the ’842 Patent Specification and the asserted prior art.

C. Principles of Law

“Under 35 U.S.C. § 102 a claim is anticipated ‘if each and every limitation is found either expressly or inherently in a single prior art reference.’” *King Pharm., Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1274 (Fed. Cir. 2010) (quoting *Celeritas Techs. Ltd. v. Rockwell Int’l Corp.*, 150 F.3d 1354, 1360 (Fed. Cir. 1998)).

“Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” *Therasense, Inc. v. Becton, Dickinson & Co.*, 593 F.3d 1325, 1332 (Fed. Cir. 2010) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)).

A claim is unpatentable under 35 U.S.C. § 103 if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) if in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).⁴

⁴ At this stage, the parties do not present evidence or arguments related to secondary considerations.

D. Challenges to Claims 1–7, 10–13, 16, 17, 19, and 20 Based on Chin

1. Overview of Chin (Ex. 1004)

Chin is directed to a “portable information terminal including a first panel, a second panel and a connecting unit having a button unit.” Ex. 1004 ¶ 13. “The first and second panels are rotatably connected to the connecting unit for movement between first and second folded orientations or states.” *Id.*

Figure 1 of Chin is reproduced below.

FIG. 1

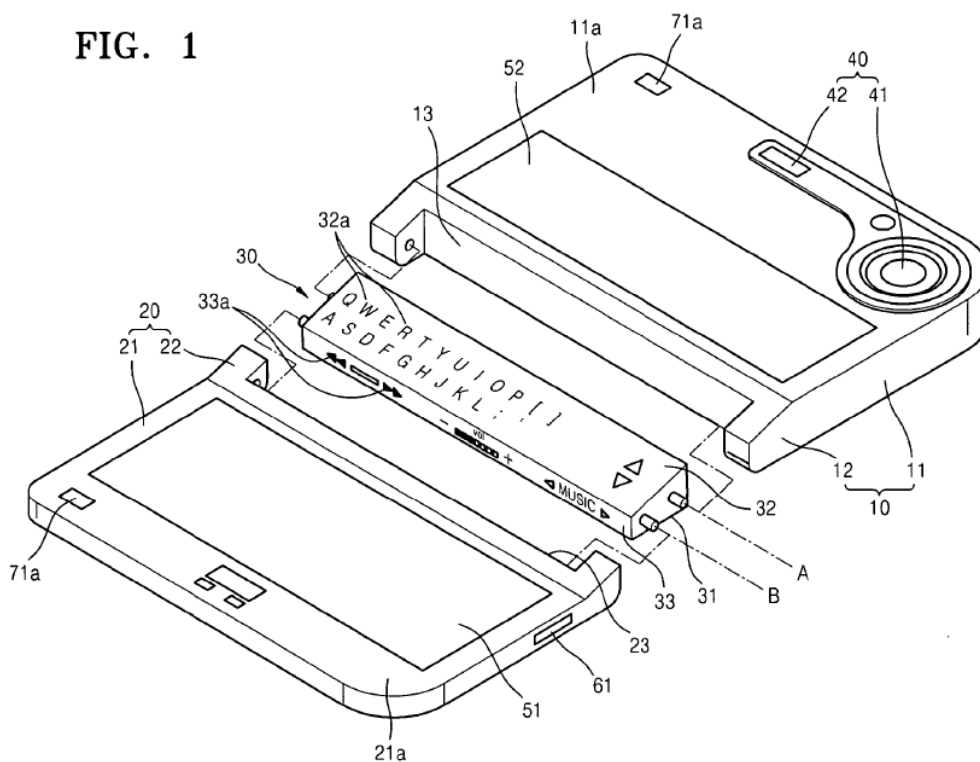


Figure 1 is a partially exploded perspective view of a portable information terminal. See Ex. 1004 ¶¶ 28, 40. The portable information terminal includes first panel 10, second panel 20 rotatably/hingedly connected to connecting unit 30. See *id.* ¶ 41. First panel 10 includes flat board unit 11, second display 52, and digital camera 40 on first generally planar surface 11a of flat board unit 11. See *id.* ¶¶ 42, 44, 45. Second panel 20 includes second flat board unit 21 and first display unit 51 configured on first generally planar surface 21a of second flat board unit 21. See

id. ¶¶ 42, 45. Sensor unit 71 including sensors 71 are employed “for detecting positions of the first panel 10 and the second panel 20,” such as “when the portable information terminal is in a second folded closed state or orientation.” *Id.* ¶ 50. Chin also discloses a controlling unit that detects positions of the panels through the sensor unit “so as to control (e.g., enable or disable)” the button units, digital camera, and display units of the portable information terminal. *See id.* ¶ 54.

Figure 9 of Chin is reproduced below.

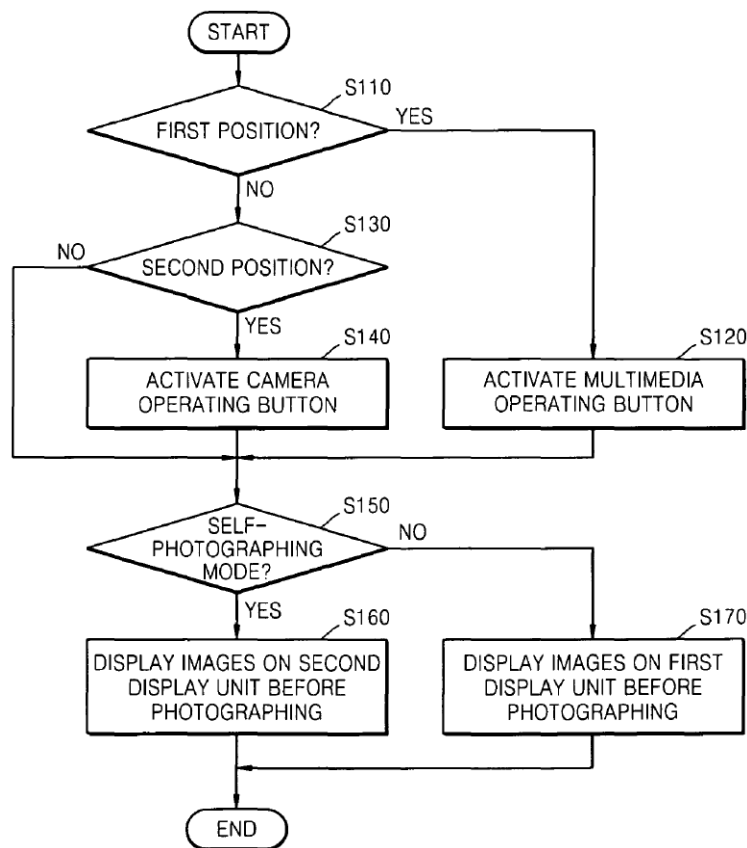


Figure 9 depicts a flowchart of a method for controlling the portable information terminal. *See Ex. 1004* ¶¶ 36, 74. A controlling unit of the portable information terminal in step S110 determines whether the first and second panels are in the first position based on a result from sensor unit 71, and if the terminal is in the first position, it activates the multimedia operating button in step S120. *See id.* ¶¶ 75, 76. If, in step S110, the controlling unit determines that first and second

panels are not in the first position, then the controlling unit determines whether the first and second panels are in a second position in step S130. *See id.* ¶ 76. If the first and second panels are in the second position in step S130, the camera activating button is activated in step S140. *See id.* In step S150, the controlling unit determines whether the portable information terminal is set or being used in a self-photographing mode, and, if yes, preview images are displayed on the second display unit in step S160. *See id.* ¶¶ 77, 78. If the controlling unit determines in step S150 that the self-photographing mode is not selected or being used, preview images are displayed on the first display unit in step S170. *See id.* ¶ 79.

2. Analysis of Claim 1

For the reasons that follow, we are persuaded Petitioner establishes sufficiently that Chin discloses, teaches, or suggests all of the limitations of claim 1.

Petitioner contends that, if the preamble is limiting, Chin discloses “[a] method” based on Chin’s disclosure of controlling the portable information terminal device of Figure 9. *See* Pet. 17–18 (reproducing Ex. 1004, Fig. 9; citing Ex. 1004 ¶¶ 36, 74–79). Petitioner asserts that Chin discloses “providing a device having at least first and second screens” based on Chin’s disclosure of a portable information terminal having two hingedly connected panels 10, 20 for moving between first and second folded states, where panels 10, 20 further include one or more display units 51, 52 and digital camera 40. *See* Pet. 18–20 (reproducing Ex. 1004, Fig. 1 (with annotations added); citing Ex. 1003 ¶¶ 96–100; Ex. 1004 ¶¶ 3, 22, 24–27, 45, 46, 61). Petitioner contends that Chin discloses “receiving user interface input to execute an image capture function” based on Chin’s disclosure of the portable information terminal having digital camera 40 that a user can operate by using a camera operating button. *See* Pet. 20–21 (reproducing

Ex. 1004, Figs. 1 (with Petitioner’s annotations added), 2 (with Petitioner’s annotations added); citing Ex. 1003 ¶¶ 101–107; Ex. 1004 ¶¶ 44, 48, 52, 53).

Petitioner asserts that Chin discloses “determining one or more of an image capture function configuration, . . . and a device state” based on Chin’s disclosures of determining whether or not the device is configured to be used in self-photographing mode, and determining the physical configuration and positions of the first and second panels 10, 20 (i.e., folded in a first or second position). *See* Pet. 21–27 (reproducing Ex. 1004, Fig. 3 (with Petitioner’s added annotations), Fig. 5 (with Petitioner’s added annotations), Fig. 9 (with Petitioner’s added annotations); citing Ex. 1003 ¶¶ 108–121; Ex. 1004 ¶¶ 30, 32, 36, 50, 54, 75–77, 79). Petitioner contends that Chin discloses “based on one or more of the image capture function configuration, . . . and the device state, entering one of one or more image capture modes” based on Chin’s disclosure of the device entering the self-photographing mode based on the image capture configuration that is manually entered by a user or automatically entered when the device state is closed in a second position and entering a second image capture mode where the portable information terminal displays images on first display unit 51 before an outward-facing photograph is taken. *See* Pet. 27–29 (citing Ex. 1003 ¶¶ 122–129; Ex. 1004 ¶¶ 30, 32, 50, 54, 56, 62, 75–77, 79, Figs. 3, 5, 9), citing Pet. 33–34).

Patent Owner does not address Petitioner’s showing for the preamble and the foregoing limitations of claim 1. *See generally* Prelim. Resp. In any event, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). At this stage of the proceeding, we determine Petitioner shows sufficiently for the purpose of institution that the preamble and foregoing limitations of claim 1 are satisfied by the teachings of Chin.

Petitioner further asserts that Chin discloses “wherein in each image capture mode a display on the first or second screen is different” based on Chin’s disclosure of the self-photographing mode and the mode designed to take an outward-facing image. Pet. 29–33 (reproducing Ex. 1004, Fig. 5 (with Petitioner’s added annotations), Fig. 6 (with Petitioner’s added annotations), Fig. 9 (with Petitioner’s added annotations); citing Ex. 1003 ¶¶ 130–135; Ex. 1004 ¶¶ 68, 78, 79). According to Petitioner, “*both* the first and second screens have different displays in the two image capture modes, because which screen displays the preview or images changes between the two modes.” Pet. 30 (citing Ex. 1003 ¶¶ 134, 135); *see id.* at 55 (similar argument, citing Ex. 1004 ¶¶ 78, 79, Fig. 9).

Petitioner further asserts that “wherein in each image capture mode a display on the first or second screen is different” “would have been obvious to a POSITA in view of Chin.” According to Petitioner,

Because Chin specifies that the preview is shown on one screen or the other, and not on both screens in both modes, it is at least suggested and would have been obvious to a POSITA that the display on each of the screens changes between modes. Indeed, a POSITA would have understood that the screen not described as showing the preview would either be on or off. . . . And a POSITA would have been motivated to turn off (disable) that other screen, as the screen would not be facing the user and doing so would save power and avoid inadvertent inputs on the other touch screen during the image capture process. . . . Turning off power to one screen in a multi-screen device was a known design option and well within the ability of a POSITA.

Pet. 55 (citing Ex. 1003 ¶¶ 257, 258).

In the Preliminary Response, Patent Owner contends that Chin does not disclose or teach this limitation because Chin’s Figures annotated by Petitioner “do not demonstrate that the *same* screen presents different displays between different image capture modes.” Prelim. Resp. 16 (reproducing Petitioner’s annotated Figures 5 and 6 of Chin); *see also id.* at 16–17 (similar arguments). As explained

above in Section II.A. addressing claim construction, we do not adopt Patent Owner's proposed claim construction for "wherein in each image capture mode a display on the first or second screen is different." Therefore, we do not agree with Patent Owner's arguments that Chin must demonstrate that the same screen presents different displays between different capture modes. As explained above in Section II.A., the claim language merely requires that the display on the first or second screen is different in each image capture mode.

For the purpose of institution, Petitioner sufficiently shows that Chin discloses "wherein in each image capture mode a display on the first or second screen is different" based on Chin's disclosure that, in the self-photographing mode, the preview images are displayed on second display 52, and when not in the self-photographing mode, the preview images are displayed on first display 51. *See* Pet. 29–33. Moreover, for the purpose of institution and based on Petitioner's cited support to Chin, and Dr. Rodriguez's testimony (Ex. 1003), we are persuaded Petitioner sets forth sufficient articulated reasoning with rational underpinning to support the conclusion that this limitation would have been obvious to one of ordinary skill in the art in view of the teachings of Chin for the purpose of saving power or avoiding inadvertent inputs by disabling or turning off the display that is not displaying the preview. *See* Pet. 55; *KSR*, 550 U.S. at 418.

For the purpose of institution and based on the record before us, Petitioner establishes sufficiently that the subject matter of claim 1 is anticipated by Chin and/or would have been obvious over Chin. Accordingly, there is a reasonable likelihood Petitioner would prevail in showing that claim 1 is unpatentable under 35 U.S.C. §§ 102 and 103.

3. Analysis of Independent Claims 11 and 16

Independent claim 11 is directed to a device that recites a processor that is operable to perform steps similar to the method steps recited in claim 1. *Compare* Ex. 1001, 39:60–40:11, *with* Ex. 1001, 39:26–37. Claim 11, however, includes the following additional limitations specific to the claimed device: “the first screen including a first gesture capture region,” “the second screen faces an opposite direction from the first screen when the device is closed, and wherein an image capture lens is associated with the second screen; a memory; a processor in communication with the memory, the first screen, and the second screen . . .” Ex. 1001, 39:60–40.

Independent claim 16 is directed to a non-transitory computer readable medium having stored computer executable instructions to perform steps similar to the method steps recited in claim 1. *Compare* Ex. 1001, 40:32–55, *with* Ex. 1001, 39:26–37. Similar to claim 11, claim 16 includes the following additional limitations: “wherein the device is in a closed state, wherein in the closed state the first and second screens face opposite direction” and “wherein an image capture lens is associated with the second screen.” *See* Ex. 1001, 40:42–44, 40:47–48. Claim 16 also includes additional limitations not included in claim 11: “wherein the image capture function is configured to capture an outward facing image, wherein the device is in a landscape orientation” and “wherein the image capture mode is one of a full and disabled mode, a full and static mode, or a full and live mode.” *See* Ex. 1001, 40:44–46, 40:53–55.

For the reasons that follow, including the reasons explained above in Section II.D.2., addressing claim 1, we are persuaded that Petitioner establishes sufficiently that Chin discloses, suggests, or renders obvious all of the limitations of independent claims 11 and 16.

Petitioner contends that, if the preamble of claim 11 is limiting, Chin discloses “[a] device,” based on Chin’s disclosure of a portable information terminal having two hingedly connected panels 10, 20 for moving between first and second folded states. *See* Pet. 40 (citing Ex. 1004 ¶ 3). Petitioner asserts that Chin discloses “a first screen . . . including a first gesture capture region,” as recited in claim 11, based on Chin’s disclosures of first display unit 51 that can be a liquid crystal display (LCD) apparatus, LCDs may be of a touch-screen type, and button unit may be embodied as a touch-screen type LCD. *See* Pet. 40–42 (reproducing Ex. 1004, Fig. 1 (with Petitioner’s added annotations); citing Ex. 1003 ¶¶ 170–174; Ex. 1004 ¶¶ 45, 61); *see also* Pet 53–54 (arguments addressing obviousness of using touch screen to execute image capture function, citing Ex. 1003 ¶¶ 251, 252, 254, 255; Ex. 1004 ¶ 61; Ex. 1006 ¶ 235; Ex. 1009, 5:15–30; Ex. 1010 ¶¶ 68, 69). Petitioner asserts that Chin discloses “a memory; a processor in communication with the memory, the first screen, and the second screen,” as recited in claim 11, based on Chin’s disclosure of controlling unit 70 which may be embodied as a semiconductor chip including controlling software, or a circuit board including the semiconductor chip and which sends/receives signals with other device components and controls device operations, and which communicates with first and second display units 51, 52. *See* Pet. 43–45 (reproducing Ex. 1004, Fig. 2 (with Petitioner’s added annotations); citing Ex. 1003 ¶¶ 171–193; citing Ex. 1004 ¶¶ 52–55, 60–61, 67, 75); *see also* Pet. 56–57 (arguments addressing obviousness of the portable information terminal having a memory and a processor, citing Ex. 1003 ¶¶ 262–270; Ex. 1004 ¶¶ 3–5; Ex. 1006 ¶¶ 281, 285–287, 385–415, Fig. 50; Ex. 1010 ¶¶ 30, 43, 44, Ex. 1011 ¶ 82; Ex. 1012 ¶¶ 67, 68, 125, Fig. 1; Ex. 1013 ¶¶ 25, 26, 34, 117).

Petitioner contends that, if the preamble of claim 16 is limiting, Chin discloses a “non-transitory computer readable medium having stored thereon computer readable instructions” based on Chin’s disclosure of controlling unit 70 which may be embodied as a semiconductor chip including controlling software, or a circuit board including the semiconductor chip and which sends/receives signals with other device components and controls device operations. *See* Pet. 49 (citing Ex. 1003 ¶¶ 229, 230; Pet. 43–45). Petitioner contends that that Chin discloses “a second screen . . . faces an opposite direction from the first screen when the device is closed, and wherein an image capture lens is associated with the second screen,” as recited in claim 11 and similarly recited in claim 16, based on Chin’s disclosure of second display unit 52 and image capture lens 41 of digital camera associated with the second display unit 52, and disclosure that when the device is rotated into a closed position, the first display unit 51 faces an opposite direction from second display unit 52. *See* Pet. 42, 43 (reproducing Ex. 1004, Fig. 1 (with Petitioner’s added annotations), Fig. 5 (with Petitioner’s added annotations); citing Ex. 1003 ¶¶ 175–177; Ex. 1004 ¶¶ 32, 56, 63, 65, Fig 6); *see also* Pet. 50 (addressing claim 16, citing Pet. 18–21, 42–43).

Petitioner asserts that Chin discloses “wherein the device is in a closed state” and “wherein the image capture function is configured to capture an outward facing image, wherein the device is in a landscape orientation,” as recited in claim 16, based on Chin’s disclosure of the portable information terminal being in a closed state, in a landscape orientation, and the digital camera being configured to capture images in a mode in which the self-photographing mode is not selected so as to capture an outward facing image and display preview images on first display 51. *See* Pet. 33–37 (reproducing Ex. 1004, Fig. 6 (with Petitioner’s added annotations), citing Ex. 1003 ¶¶ 136–153; Ex. 1004 ¶¶ 50, 62, 77–79, Fig. 5;

Pet. 17–34), 50 (citing Pet. 33–37); *see also* Pet. 55–56 (arguments addressing obviousness of “configured to capture an outward-facing image,” citing Ex. 1003 ¶ 261; Ex. 1004 ¶ 41; Pet. 17–33, 39–40, 48). Petitioner asserts that Chin discloses, teaches, or suggests “wherein the image capture mode is one of a full and disabled mode, a full and static mode, or a full and live mode,” as recited in claim 16, based on Chin’s disclosure that in the outward facing image capture mode, the device displays preview images on first display 51 and does not describe enabling second display 52 or displaying an image on second display 52 and, thus, second display 52 is disabled. *See* Pet. 38–39 (citing Ex. 1003 ¶¶ 159–164; Ex. 1004 ¶¶ 77, 79), 48 (citing Ex. 1004 ¶ 79; Pet. 38–39), 51 (citing Pet. 48).

Patent Owner does not separately address Petitioner’s showing for the preambles and the forgoing limitations of claims 11 and 16. *See generally* Prelim. Resp. Nevertheless, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378. Patent Owner’s arguments address the common disputed limitation of claims 1, 11, and 16. *See* Prelim. Resp. 15–17. For the same reasons as those explained above in Section II.D.2. addressing claim 1, we do not agree with Patent Owner’s arguments with respect to claims 11 and 16.

For the purpose of institution and based on the record before us, Petitioner establishes sufficiently that the subject matter of independent claims 11 and 16 are anticipated by Chin and/or would have been obvious over Chin. Accordingly, there is a reasonable likelihood Petitioner would prevail in showing that independent claims 11 and 16 are unpatentable under 35 U.S.C. §§ 102 and 103.

4. Analysis of Dependent Claims 2–7, 10, 12, 13, 17, 19, and 20

Claims 2–7, 10, 12, 13, 17, 19, and 20 depend respectively from claims 1, 11, and 16. We have reviewed Petitioner’s contentions and cited supporting

evidence addressing how Chin discloses, teaches, or suggests each of the limitations recited in dependent claims 2–7, 10, 12, 13, 17, 19, and 20. *See* Pet. 33–40, 47–48, 51–57.

Patent Owner does not substantively address the limitations of dependent claims 2–7, 10, 12, 13, 17, 19, and 20 apart from its arguments addressing claims 1, 11, and 16. *See* Prelim. Resp. 15–19.

For the purpose of institution and based on the record before us, including the reasons explained immediately above addressing claims 1, 11, and 16, Petitioner establishes sufficiently that the subject matter of dependent claims 2–7, 10, 12, 13, 17, 19, and 20 are anticipated by Chin and/or would have been obvious over Chin. Accordingly, there is a reasonable likelihood Petitioner would prevail in showing that claims 2–7, 10, 12, 13, 17, 19, and 20 are unpatentable under 35 U.S.C. §§ 102 and 103.

E. Challenges to Claims 1–7 and 11 Based on Whitehorn

As set forth in the detailed analysis in Section II.D., we determine Petitioner demonstrates a reasonable likelihood of prevailing in showing claims 1–7, 10–13, 16, 17, 19, and 20 are unpatentable under 35 U.S.C. §§ 102 and 103 over Chin. *See* 35 U.S.C. § 314; 37 C.F.R. § 42.4(a). Accordingly, we institute *inter partes* review of all of the challenged claims on all of the grounds articulated in the Petition, including the patentability challenges to claims 1–7 and 11 based on Whitehorn. *See* 37 C.F.R. § 42.108(a); *SAS Inst. Inc. v. Iancu*, 584 U.S. 357 (2018)

III. CONCLUSION

For the foregoing reasons, we determine there is a reasonable likelihood that Petitioner would prevail in showing at least one of the challenged claims of the '842 Patent is unpatentable.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–7, 10–13, 16, 17, 19, and 20 of the '842 Patent is instituted with respect to all grounds set forth in the Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of the '842 Patent shall commence on the entry date of this Order, and notice is hereby given of the institution of a trial.

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PETITIONER:

Timothy Pearce
Christopher Higgins
Naveen Modi
Joseph Palys
Daniel Zeilberger
Quadeer Ahmed
David Valente
ORRICK, HERRINGTON & SUTCLIFFE LLP
tvpptabdocket@orrick.com
0chptabdocket@orrick.com
naveenmodi@paulhastings.com
josephpalys@paulhastings.com
danielzeilberger@paulhastings.com
quadeerahmed@paulhastings.com
davidvalente@paulhastings.com

PATENT OWNER:

James Carmichael
Stephen Schreiner
Minghui Yang
Stephen McBride
Christopher Abidin
CARMICHAEL IP, PLLC
jim@carmichaelip.com
schreiner@carmichaelip.com
mitch@carmichaelip.com
stevemcbride@carmichaelip.com
chris@carmichaelip.com