

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 No. 8,836,842

PATENT OWNER SUR-REPLY

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PATENT OWNER'S EXHIBIT LIST

Ex. No.	Description
Ex. 2001	Plaintiff Multifold International Incorporated Pte. Ltd.'s Proposed Counter-Constructions in Response to Defendants' Proposed Terms for Claim Construction
Ex. 2002	Expert declaration of Dr. Rajiv Surati
Ex. 2003	C.V. of Dr. Rajiv Surati
Ex. 2004	Challenged Claims
Ex. 2005	Joint Claim Construction Brief, Dkt. 103, May 15, 2025.
Ex. 2006	Designing a Dual-Screen Phone - The IMERJ Experience
Ex. 2007	U.S. Pat. No. 6,384,852 (Ye)
Ex. 2008	U.S. Pat. No. 8,977,293 (Rodriguez)
Ex. 2009	U.S. Pat. Pub. No. 2011/0043683 (Beach)
Ex. 2010	Reserved
Ex. 2011	Deposition Transcript of Dr. Jeffrey Rodriguez (Aug. 8, 2025)
Ex. 2012	U.S. Pat. No. 7,626,630 (Nishino)

I. INTRODUCTION

The Petitioners' Reply fails to resolve the defective arguments in the Petition, as explained further below.

II. CLAIM CONSTRUCTION

A. Limitation 1E for “Wherein in Each Image Capture Mode a Display on the First or Second Screen is Different”

Patent Owner provided extensive intrinsic evidence—including the claims, specification, and the prosecution history—that the limitation “*wherein in each image capture mode a display on the first or second screen is different*” means “a different display on the first screen between image capture modes or a different display on the second screen between image capture modes.” POR, 10-11, 25, 34. This means that at least one of the “*first and second screens*” must be different between the image capture modes. Patent Owner explained that “the limitation requires a first-screen-to-first-screen comparison or a second-screen-to-second-screen comparison.” POR, 13, 34.

Petitioners do not seriously dispute the construction. Reply, 1-3. Petitioners do not dispute the plain meaning of the claim language. See POR, 12-13 (claim language). Petitioners do not dispute that the embodiments in the '842 repeatedly and consistently characterizes image capture modes “as having different displays on the first screen between image capture modes or different displays on the second screen between image capture modes.” POR, 13-21. See Reply, 1-3.

B. “Associated With” and “Faces an Opposite Direction”

The Reply argues there must be special constructions for “*associated with*” and “*faces an opposite direction*.” Reply, 3-6. There is no need for special construction because the patentability challenge does not turn on the meaning of either term.

III. INDEPENDENT CLAIMS 1, 11, AND 16 ARE NOT ANTICIPATED BY CHIN (GROUND 1)

A. The Law of Anticipation Requires that a Reference Expressly or Inherently Discloses Each Claim Limitation, Not That the Claim Limitation Might Be “Envisaged.”

The Federal Circuit has held that “unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations *arranged or combined in the same way as recited in the claim*, it cannot be said to ... anticipate under 35 U.S.C. § 102.” *Net Moneyln v. Verisign, Inc.*, 545 F.3d 1359 at 1371 (Fed. Cir. 2008) (original italics). “[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).

Petitioners’ new anticipation argument, improperly presented for the first time on reply,¹ relies on *Kennametal, Inc. v. Ingersoll Cutting Tool Co.*, 780 F.3d 1376, 1381 (Fed. Cir. 2015)² for the proposition that anticipation can be found if a POSITA could “evisage” the limitation. Reply, 10-11. However, *Kennametal* is a corner case applying an “evisage” inquiry that does not apply here. In *Kennametal*, the reference expressly disclosed the claimed combination of materials as one of many disclosed combinations of materials. *Kennametal*, 780 F.3d at 1381-83 (claimed combination was one of “31 possible combinations” that were disclosed in the reference). The question was whether a POSITA would recognize the expressly disclosed claimed combination out of the numerous expressly disclosed combinations. *Kennametal* does not apply here.

¹ Petitioners’ new “envisage” theory of anticipation was not in its petition, and thus is waived and should not be considered. See PTAB Consolidated Trial Practice Guide (Nov. 2019), 73-74.

² *Kennametal* relied on a C.C.P.A. case from 1962 for the “envisage” test. 780 F.3d at 1381 (citing *In re Petering*, 49 C.C.P.A. 993, 301 F.2d 676, 681 (1962)).

The Federal Circuit has gone on to reject the “envisage” test where the issue is whether the reference is missing a claim limitation. In *UCB, Inc. v. Actavis Laboratories UT*, 65 F.4th 679, 688-689 (Fed. Cir. 2023), the Federal Circuit found that a district court erred in applying the *Kennametal* “envisage” test:

As we held in [*Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 851 F.3d 1270, 1274 \(Fed. Cir. 2017\)](#): *Kennametal* does not stand for the proposition that **a reference missing a limitation** can anticipate a claim if a skilled artisan viewing the reference would “at once envisage” the missing limitation. Rather, *Kennametal* addresses whether the disclosure of a limited number of combination possibilities discloses one of the possible combinations.

UCB, 65 F.4th at 689 (emph. added).

In this IPR, the issue is that the Chin reference is missing limitation 1E. POR, 33-44. Accordingly, the “envisage” test does not apply. Rather, Chin must expressly or inherently disclose limitation 1E. *King Pharm., Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1274 (Fed. Cir. 2010); *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987). *See Celeritas Techs. Ltd. v. Rockwell Int'l Corp.*, 150 F.3d 1354, 1360 (Fed. Cir. 1998) (original italics) (“[A]nticipation by inherent disclosure is appropriate only when the reference discloses prior art that must *necessarily* include the unstated limitation....”) (cite omitted).

B. Independent Claims 1, 11, and 16 Are Not Anticipated Because Chin Does Not Disclose Image Capture Modes “Wherein in Each Image Capture Mode a Display on the First or Second Screen is Different.”

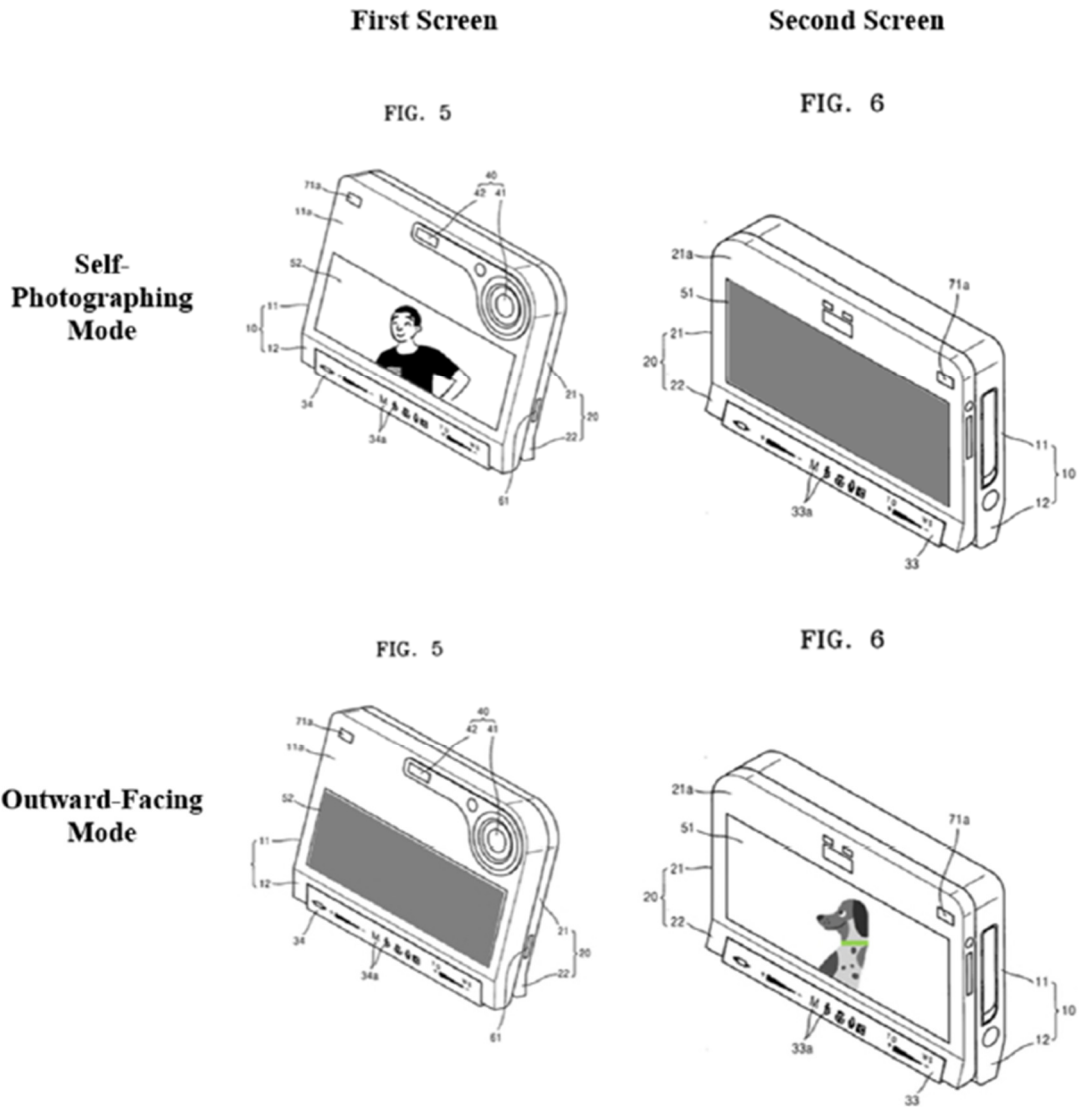
To anticipate, Chin must disclose image capture modes where there is “a different display on the first screen between image capture modes or a different display on the second screen between image capture modes.” POR, 10-11, 34. This requires a first-screen-to-first-screen comparison or a second-screen-to-second-screen comparison.

Petitioners argue that in Chin “both screen displays are different in each image capture mode.” Reply, 6 (Heading III.A.1). Petitioners focus on the self-photographing mode of Chin’s Figure 5 and the outward-facing mode of Figure 6. It is undisputed that Chin has a display 51 and a display 52. As Petitioners admit, in the self-photograph mode of Figure 5 display 52 presents a preview of the user, whereas Chin does not disclose what is presented by display 52 in the outward-facing mode of Figure 6. Reply, 7-8. Likewise, in the outward-facing mode of Figure 6, display 51 presents a preview of the subject of the photo, whereas Chin does not disclose what is presented by display 51 in the self-photograph mode of Figure 5. *Id.* See POR, 34-38, 41-44.

Petitioners’ confusing argument that “the image preview is *not* displayed in both screens in both modes” (Reply, 8) does not address the claim language.

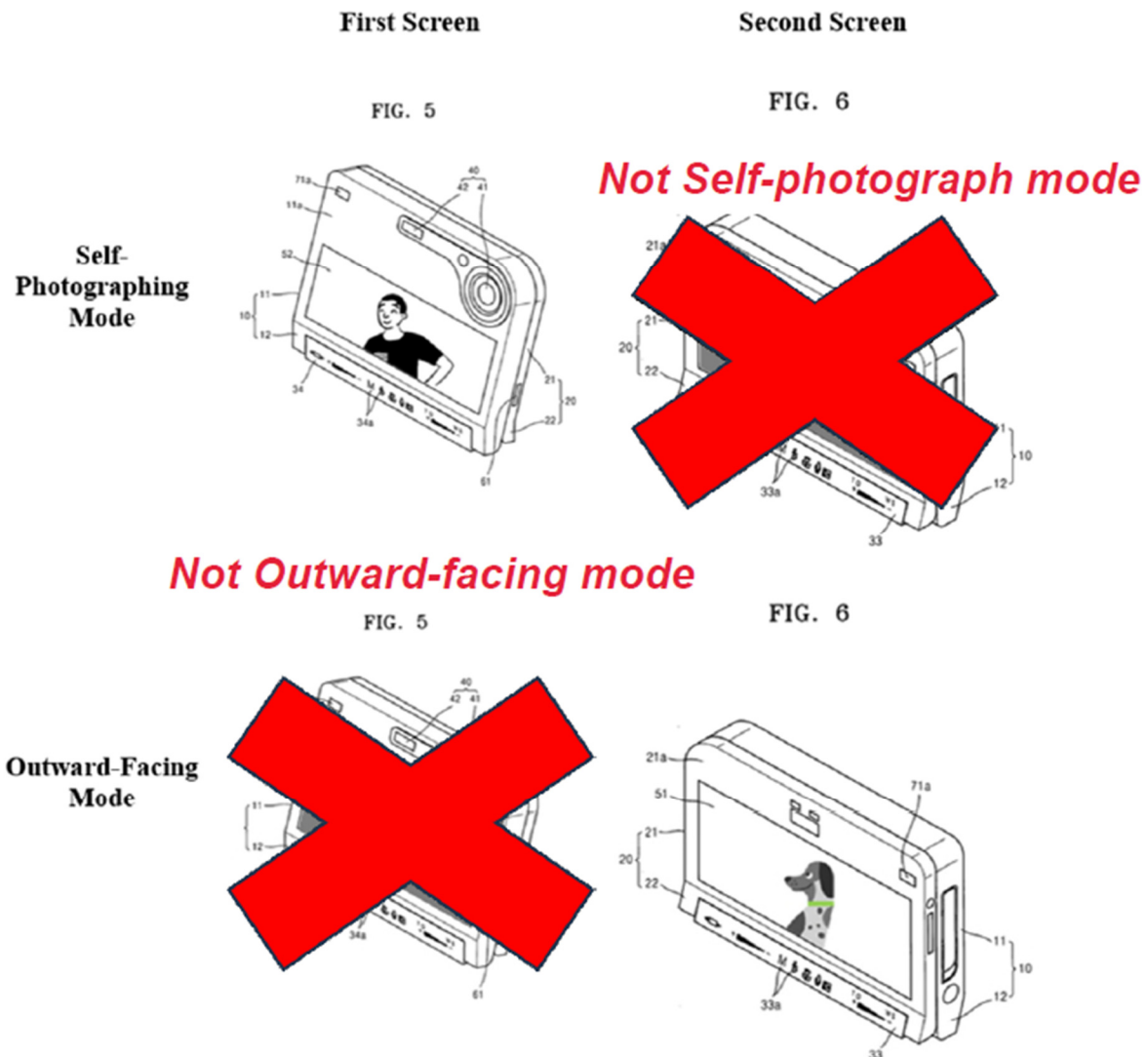
Petitioners do not engage the language of limitation 1E requiring that the **same screen** presents different displays between image capture modes. Reply, 9-10. Not once does Petitioner provide a first-screen-to-first-screen comparison (comparing display 52 in Fig. 5 to display 52 in Fig. 6) or second-screen-to-second screen comparison (comparing display 51 in Fig. 5 to display 51 in Fig. 6). Reply, 6-11. Therefore, Chin does not anticipate.

Petitioners provide a confusing diagram that only highlights their dilemma that Chin does not disclose limitation 1E:



Reply, 12.

The diagram is misleading because it mixes up the displays between the self-photographing mode of Figure 5 and the displays of the outward-facing mode of Figure 6, as illustrated below:



Petitioner Reply, 12 (annotated in red by Patent Owner).

Figure 6 on the upper right hand corner is a display from the outward-facing mode, not the self-photographing mode as the diagram suggests. Figure 5 in the lower left hand corner is a display from the self-photograph mode, not the outward-facing mode as the diagram suggests. Petitioners' diagram does not establish (or even try to establish) that display 51 in the self-photograph mode is different from

display 51 in the outwardly-facing mode, or that display 52 in the outwardly-facing mode is different from display 52 in the self-photograph mode.

Petitioners' diagram labels the "first screen" as display 52 and the "second screen" as display 51. Petitioners then assert that "the first screen does not display a preview in the self-photographing mode and does display a preview in the outward-facing mode." Reply, 13. The assertion is incorrect twice over. Chin discloses that display 52 presents a preview in self-photograph mode of Figure 5, and Chin does not disclose that display 52 presents a preview in the outwardly-facing mode of Figure 6. Chin makes no disclosure on what display 52 presents in the outwardly-facing mode of Figure 6. POR, 41.

Petitioners assert that the "the second screen [display 51] does not display a preview in the outward-facing mode and does display a preview in the self-photographing mode. Reply, 13. This assertion is incorrect, too. Chin discloses that display unit 51 presents a preview in the outwardly-facing mode of Figure 6. But Chin makes no disclosure on what display unit 51 displays in the self-photograph mode of Figure 5. POR, 41.

Thus, Chin does not expressly disclose limitation 1E.

The limitation is not disclosed inherently for two reasons. First, Petitioners made no inherency argument, and thus it is waived. POR, 41. Second, even if inherency was to be considered on the merits (it should not be), the limitation is not

inherently satisfied because a POSITA would understand that display unit 52 of Chin (alleged “first screen”) could display a preview in the outwardly-facing mode. POR, 41-43. Display unit 51 could display a preview in the self-photograph mode. *Id.* Patent Owner’s expert provides unrebutted sworn testimony on both points. Surati Decl., ¶¶ 160-162. See Reply, 6-15.

Petitioners engage in speculation on “[*what*] if the Chin device was displaying a preview on both screens in self-photographing mode.” Reply, 14. But Chin does not make that disclosure, and Petitioners make no citation to support such conjecture. Petitioners also speculate about what if the Chin device operated so that when “the device is in outward-facing mode, both screens would display a preview of an outward-facing image.” Reply, 14. Again, Chin makes no such disclosure.

Anticipation cannot be proved by “what if” conjecture. Anticipation cannot be established by “probabilities or possibilities,” and the fact a limitation “may result” from the reference is not enough. *In re Robertson*, 169 F.3d 743 (Fed. Cir. 1999). Here, Petitioners’ conjecture and speculation about how Chin might operate if it had a different disclosure does not establish anticipation.

C. Independent Claim 11 Is Not Anticipated Because Chin Does Not Disclose “A First Gesture Capture Region” and Chin Does Not Disclose “Controls Are Presented on a Second Screen” per Dependent Claim 10.

Petitioners' theory for limitation 11A of independent Claim 11 and for dependent Claim 10 is that Chin's first display unit 51 is disclosed as being implemented as a touch-screen display. Pet., 40-41; Reply, 15 (citing Chin, [0045], [0061]).

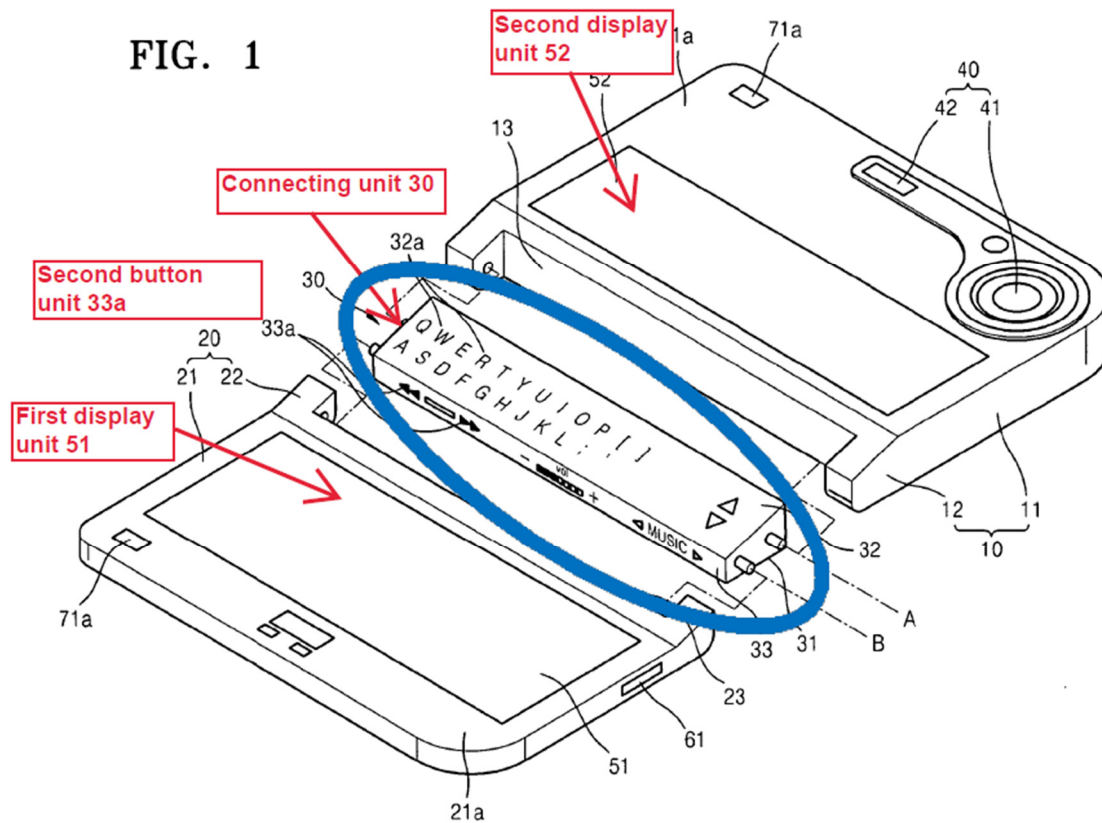
It is undisputed that in paragraph [0045] Chin discloses that "[t]he first display unit 51 may be a display apparatus such as a color liquid crystal display (LCD)." As for paragraph [0061], Chin discloses:

[0061] The **second button unit 33a** includes a **plurality of push-type buttons** (e.g., microswitches, snap domes, etc.) which may include a light-emitting diode (LED). As shown in FIG. 2, some of the buttons of button unit 33a may have a function of the camera operating button 33b and some may have a function of the multimedia operating button 33c. Accordingly, the **second button unit 33a** receives signals from the controlling unit 70 (relative to the sensor unit 71) so as to activate the camera operating button 33b or the multimedia operating button 33c. The structure of the **second button unit 33a** is not limited to the above structure, and may be embodied by using different components such as a **touch screen-type liquid crystal display**.

Chin, [0061] (emph. added).

Paragraph [0061] does not even mention first display unit 51. Instead, it addresses the form and function of second button unit 33a that is a button unit on the

connecting unit 33 (in **blue** below) that is between the first display 51 and the second display 52:



Chin, Fig. 1 (annotated). Plainly, connecting unit 30 is not part of first display 51.

Thus, Chin discloses that the button unit 33a on connecting unit 30 is implemented as a touch-screen LCD. Chin does not at paragraph [0061], or elsewhere, disclose that first display unit 51 is implemented as a touch-screen LCD. Thus, Petitioners' anticipation theory is without merit.

Petitioners argue on reply “that [the fact that] connecting unit 33 may be a touch screen LCD in some embodiments **does not prohibit** the first display unit 51

from also being a touch screen type LCD.” Reply, 15 (emph. added). “Does not prohibit” is not express disclosure and does not meet the standard for anticipation.

Petitioners make the same defective argument for limitation 11A of independent Claim 11 and dependent Claim 10. Accordingly, dependent Claim 10 and independent Claim 11 are patentable over Chin.

D. Independent Claim 16 and Dependent Claims 6, 7, 13, 17, and 19 Are Not Anticipated Because Chin Does Not Disclose An Image Capture Mode that is a “Full and Disabled Mode.”

Limitation 16E provides “*wherein the image capture mode is ... a full and disabled mode.*” Dependent Claims 13 and 17 recite the same language. Dependent Claim 6 recites “*wherein, in the image capture mode, the device **does not display an image on a first screen.***” Dependent Claim 7 recites “*wherein the **first screen is disabled and does not receive user input** while in the image capture mode.*” Claim 19 is similar to Claim 7 in that it provides that “*user input for the second screen is disabled.*”

Patent Owner previously explained that for independent Claim 16 and dependent Claims 6, 7, 13, 17, and 19, that (1) Chin does not expressly disclose an image capture mode with a screen being in a “disabled mode” (Claims 7, 13, 16, 17, and 19) (POR, 46, 49-50, 53); (2) Chin does not expressly disclose an image capture mode with a screen that “does not receive user input” (Claim 7) (POR, 49); and (3) Chin does not expressly disclose an image capture mode with a screen that “does not

display an image” (Claim 6) (POR, 46-48). There can be no anticipation because Chin does provide any express disclosure on what is presented on display unit 51 in the self-photographing mode of Figure 5 or what is presented on display unit 52 in the outwardly-facing mode of Figure 6.

For Claim 6, Petitioners’ reply relies on the same arguments it presents for limitation 1E. Reply, 16 (“This is wrong for the reasons explained at length in Section III.A above.”).

Petitioners do not rehabilitate the *ipse dixit* testimony of their expert (see POR, 47-48) who submits an unsupported opinion that “[a] POSITA would have understood that absent any indication to the contrary, ‘the device does not display an image on a first screen [display unit 52 in Figure 6].’” That unsupported testimony does not translate to an express disclosure by Chin. Reply, 16-17.

No evidence is provided on reply to support that testimony. Instead, Petitioners assert that the expert’s opinion is “the only rational reading of Chin.” Reply, 16-17. First, this “rational reading” argument does not establish that Chin expressly discloses the limitation. Second, Patent Owner already established that Chin could present a preview on display unit 52 (POR, 43), and thus Petitioners’ reinterpretation of Chin is not “the only rational reading.”

For Claim 7 (screen is disabled and does not receive user input), Petitioners make the same “rational reading” argument based on their expert’s improper *ipse*

dixit testimony (see POR, 49). Reply, 17. Petitioners' experts' unsupported opinion does not substitute for the lack of express disclosure in Chin. Further, the Petitioners' logic that because "Chin [does not] describe that screen as being enabled or receiving any user interface input," then the screen [display 52 in Figure 6] must be disabled and incapable of receiving user input, is fallacious. Reply, 17. There is no express disclosure of the screen being disabled and incapable of receiving user input, and it is not inherent because display unit 52 in Figure 6 could be presenting a preview. See POR, 43.

For limitation 16E of independent Claim 16 and Claims 13, 17, and 19, the Petitioners refer back to the same arguments as for Claims 6 and 7. Reply, 13. However, Chin does not expressly disclose the limitations of independent Claim 16 and Claims 13, 17, and 19 for the reasons set above for Claims 6-7 and the reasons set forth in Patent Owner's preliminary response. POR, 46, 50, 53.

E. Dependent Claims 2–7, 10, 12–13, 17, and 19–20

Each of dependent claims 2–7, 10, 12–13, 17, and 19–20 is patentable for at least the same reasons set forth for its independent claim. POR, 53.

IV. INDEPENDENT CLAIMS 1, 11, AND 16 ARE PATENTABLE OVER CHIN (GROUND 2)

A. Independent Claims 1, 11, and 16 Are Patentable Because Chin Does Not Teach or Suggest Image Capture Modes “Wherein in Each Image Capture Mode a Display on the First or Second Screen is Different,” and Dependent Claims 6, 7, 13, and 19 Are Patentable Because Chin Does not Teach or Suggest Their Limitations.

The question of obviousness based on Chin is straightforward. Chin does not disclose what display 51 presents (or how it otherwise operates) in the self-photographing mode of Figure 5 or what display 52 presents (or how it otherwise operates) in the outward-facing mode of Figure 6. There is no express disclosure or inherent disclosure by Chin, as explained above in Section III.

Petitioners’ obviousness theory is that Chin would be modified as follows: “[A] POSITA would have been motivated to turn off or disable a screen that is not facing the user.” POR, 55. See Pet., 55; Rodriguez Decl., ¶ 258. Petitioners thus argue that missing limitation 1E can be satisfied by modifying or combining Chin with the feature of “turn[ing] off or disabl[ing] a screen that is not facing the user.” This is based entirely on Petitioners’ expert’s *ipse dixit* testimony. POR, 55-56 (citing Rodriguez Decl., ¶ 258). Neither the Petition, the Reply, nor Petitioners’ expert cites any evidence establishing that this feature was known in the art as of the September 2011 priority date of the ’842 Patent. See Reply, 18-23.

Petitioners' obviousness theory fails because they do not provide a single example of prior art having the feature of "turn[ing] off or disabl[ing] a screen that is not facing the user." See Reply, 18-23.

The burden is on Petitioners to establish that the feature to be combined was known in the art. That notwithstanding, Patent Owner provided multiple examples of prior art showing that it was **not known** to "turn off or disable a screen that is not facing the user." See POR, 55-56 (citing Aono, Lee, Kim, Kawasaki, Park, Beech, and the iPhone). Petitioners' own expert cited Aono, Lee, Kim, Kawasaki, and Park as representing the **state of the art** for multiple screen devices (see Rodriguez Decl., ¶¶ 61-66), yet Petitioners do not dispute that this alleged state of the art fails to disclose the feature of "turn[ing] off or disabl[ing] a screen that is not facing the user." POR, 55. See Reply, 18-23. Petitioners' expert admitted as much in deposition. Ex. 2011 (Dep. Trans. Rodriguez), 43:20-48:4. Through their silence on reply, Petitioners effectively admit that it was not known in the art to "turn off or disable a screen that is not facing the user."

Petitioners try to skirt the problem by reframing their obviousness theory as: "[A] POSITA would understand Chin as disclosing two options: the screen can be either on or off." Reply, 18. That ignores the part of Petitioners' argument that the feature to be combined is "turn[ing] off or disabl[ing] a screen **that is not facing the user.**" And Petitioners' argument about motivation to combine (Reply, 19) skips the

prerequisite step of establishing that the feature to be combined was known in the art.

Accordingly, Petitioners' obviousness theory fails because it fails to demonstrate that the proposed feature of "turn[ing] off or disabl[ing] a screen that is not facing the user" was known in the art. The proposed combination/modification of Chin is thus missing limitation 1E and the other limitations involving a disabled screen, a screen not accepting user input, and a screen not displaying an image in the other claims.

Additionally, Petitioners provide no response to Patent Owner's point that they did not establish—or even address—a reasonable expectation of success for the proposed combination of Chin with the feature of "turn[ing] off or disabl[ing] a screen that is not facing the user." POR, 57. See Reply, 18-23 (no response). The failure to address a reasonable expectation of success is an additional basis for finding that Petitioners have not established that the claims are obvious over Chin.

As acknowledged in their Reply (see heading IV.A at 18), Petitioners' failed obviousness theory applies to limitations 1E, 11H, 16D, and 16E, as well as dependent claims Claims 6, 7, 13, and 19. Accordingly, independent Claims 1, 11, and 16 are patentable over Chin. Dependent Claims 6, 7, 13, and 19 (as well as all other dependent claims) are patentable over Chin.

B. Independent Claim 11 Is Patentable Because Chin Does Not Teach or Suggest Limitation 11A for “A First Gesture Capture Region” and Chin Does Not Teach or Suggest “Controls Are Presented on a Second Screen” per Dependent Claim 10.

Petitioners’ obviousness theory for limitation 11A (“*gesture capture region*”) and dependent Claim 10 (“*controls are presented on a second screen*”) is based on combining Chin’s first display unit 51 or second display unit 52 with the touch screen LCD implemented in Chin’s connecting device 30. POR, 58. Patent Owner explained that a POSITA would not make this modification because it is contrary to Chin’s design principle of separating the display and control functions. POR, 58.

Petitioners assert that “Multifold’s arguments about contradicting Chin’s ‘design principle’ are unfounded.” Reply, 24. However, Petitioners do not dispute that Chin’s design principle is to separate the display and control functions. See Reply, 23-24. And Petitioners do not dispute that in the proposed modification the display and control functions would be combined, not separated. Thus, Petitioners effectively concede that a POSITA would not make the proposed modification because it is contrary to Chin’s principle of design.

C. Dependent Claims 2–7, 10, 12–13, 17, and 19–20

Each of these dependent claims is patentable for at least the same reasons set forth for its independent claim. POR, 59.

V. INDEPENDENT CLAIMS 1, 11, AND 16 ARE NOT ANTICIPATED BY WHITEHORN (GROUND 3)

A. Independent Claims 1, 11, and 16 Are Not Anticipated Because Whitehorn Does Not Disclose Image Capture Modes “Wherein in Each Image Capture Mode a Display on the First or Second Screen is Different.”

The Petitioners did not argue inherency for any limitation of the claims challenged under Ground 3. Thus, the claims are anticipated only if Whitehorn expressly discloses each claim limitation.

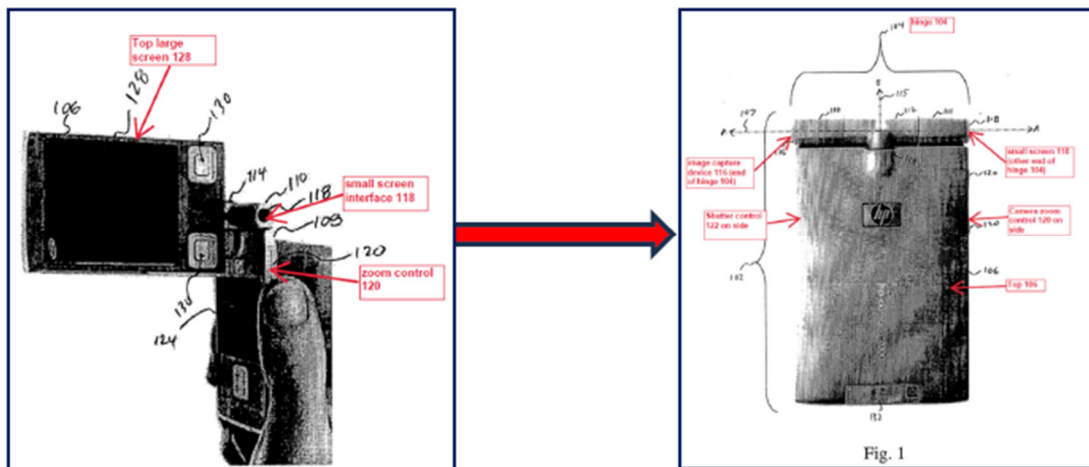
Limitation 1E requires that the device with a first screen and second screen presents image capture modes having “a different display on the first screen between image capture modes or a different display on the second screen between image capture modes.” This requires a first-screen-to-first-screen comparison and/or a second-screen-to-second-screen comparison. See Section II.A, III.B.

Petitioners rely on the first mode of Figures 1/3/4 in Whitehorn, where the device is closed, and the second mode in Figure 5, where the device is opened and large screen 128 is rotated about sub-hinge 114. POR, 61 (citing Pet., 66). Petitioners’ argument is that large screen 128 presents a display in the first mode that is different from large screen 128’s display in the second mode. *Id.*

However, while Whitehorn discloses that large screen 128 displays an image preview in the second mode, it does not disclose anything regarding what large screen 128 displays in the first mode. POR, 63-64. Whitehorn thus does not

expressly disclose limitation 1E. Petitioners did not make and therefore waived any theory of inherency. POR, 64-65.

Petitioners argue that in the first mode large screen 128 is “not visible” and therefore “does not display an image.” Reply, 25. However, as explained by Patent Owner’s expert, Dr. Surati, a POSITA would understand that the top large screen 128 could continue to display the preview after the device changes from the second mode (Fig. 5) to the first mode (Fig. 1). POR, 63-64. Surati Decl., ¶¶ 218-220. Thus, the display of large screen interface 128 would not differ between modes.



POR, 64. It is black letter law that Petitioner’s inference that large screen 128 displays nothing in the first mode must “necessarily be present” in the reference. *Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 1380 (Fed. Cir. 2002); *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268-1269 (Fed. Cir. 1991). Dr. Surati provided an explanation supported by evidence that Petitioners’ inference is not

inherent in Whitehorn. This explanation by Patent Owner's expert goes un rebutted. See Reply, 25-27 (no response).

Petitioners generic statement that "the display of information on the screens is different" (Reply, 25) does not address the claim language, which requires a showing that Whitehorn expressly discloses that the **same screen** provides a different display between modes. Petitioners refer to "Whitehorn's express disclosures" but provide no citation for the assertion that "Whitehorn's top large screen interface does not display an image in the first mode." See Reply, 27.

Limitations 1E, 11G, and 16D are not disclosed in Whitehorn. Accordingly, Whitehorn does not anticipate independent Claims 1, 11, and 16.

B. Independent Claim 11 Is Not Anticipated Because Whitehorn Does Not Disclose "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."

Limitation 11B requires "*wherein 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.*"

The Petitioners' argument fails because it contradicts itself. It relies on Whitehorn's first image capture mode (Fig. 1) or second handheld mode (Fig. 6, step 610) for "*the second screen faces an opposite direction from the first screen when*

the device is closed,” but then it relies on the second image capture mode (Fig. 5) for “*image capture lens is associated with the second screen.*” POR, 67.

Petitioners’ reply asserts that the device does not need to be in a particular image capture mode. Reply, 28. But the limitation requires that the “*device is closed,*” and Petitioners’ theory relies on the second image capture mode where the device is open. Whitehorn, Fig. 5.

C. Dependent Claims 4 Is Not Anticipated Because Whitehorn Does Not Disclose “Wherein the Device Is In a Landscape or Portrait Orientation.”

The theory in the Petition is based on Figure 3 of Whitehorn. Petitioners’ argument is that in Figure 3 the circular image capture lens 116 at one end of the hinge discloses “*the device is in a landscape or portrait orientation.*” POR, 67-68; Pet., 73 (“Whitehorn discloses a device used in a portrait orientation (i.e., where the width is less than the height), as illustrated in Figure 3.”).

Figure 3 of Whitehorn is depicted below:

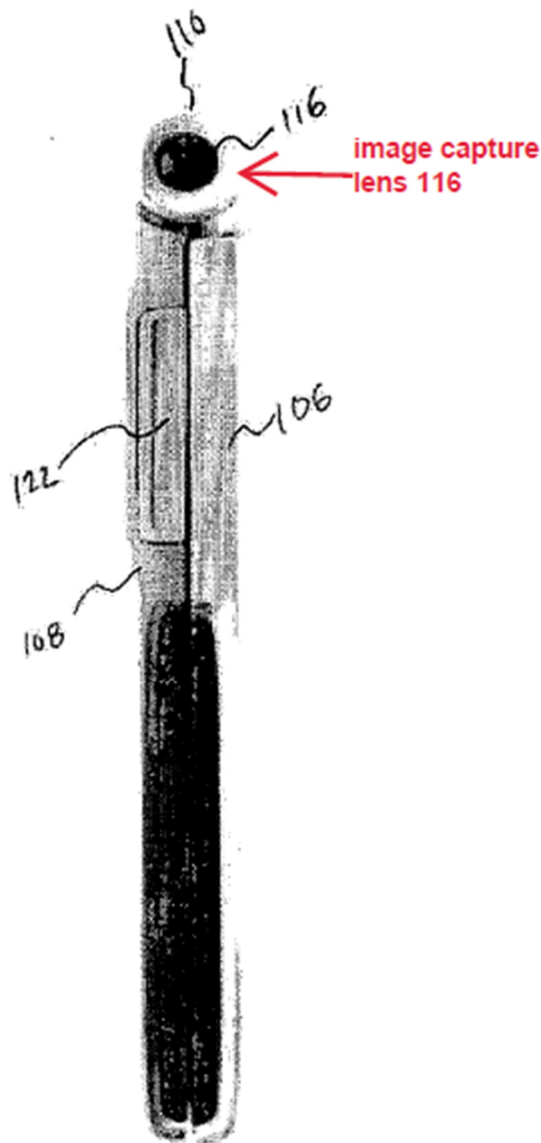


Fig. 3

Whitehorn, Fig. 3 (annotated), [0022].

There are multiple problems with Petitioners' theory. First, the image capture device 116 of Figure 3 is a **lens**, not a "display" as required by the definition in the

specification of the '842 Patent, discussed further below. See Whitehorn, [0022]. Thus, the image capture device of Figure 3 does not disclose a **display** that is in a landscape or portrait mode per Claim 4.

Second, Petitioners attempt to present on reply an argument based on Figure 4 (instead of Figure 3) and its circular small screen 118, but that new theory is waived. *Compare* Reply, 28 (“in relation to Whitehorn Figure 4 ...) *with* Pet., 73 (“Whitehorn discloses [the limitation] as illustrated in Figure 3.”).

Furthermore, the specification of the '842 Patent defines portrait orientation as “the shorter dimension of **the display** is oriented **substantially horizontal** in the portrait mode while the longer dimension of **the display** is oriented **substantially vertical**.” '842 Patent, 3:53-56. The specification also states that portrait orientation and landscape orientation are defined in relation to a “**rectangular display**.” '842 Patent, 3:41-53.

The Reply disputes that these definitions are based on the screen dimensions (Reply, 29), but that is belied by the reference to “the display” in the definition in the specification. Further, the term “display” is defined in terms of a “screen” in the patent. '842 Patent, 3:28-30. The Reply also argues that Claim 4 refers to the “device” in a portrait mode, not a display in a portrait mode. Reply, 29-30. However, a POSITA would readily recognize that Claim 4 is referring to a device with a

display in the portrait (or landscape) mode, particularly in view of the definitional language in the '842 Patent.

Petitioners argue that Figure 3's circular image capture lens 116 is in a portrait mode. Reply, 28. See Pet., 73. But a POSITA would readily understand that circular lens is not a "rectangular display" as required by the definition in the '781 Patent.

Second, a POSITA would readily understand that the circular lens of Figure 3 does not disclose a "display [that] is oriented **substantially horizontal**" on a shorter dimension, nor does it disclose "display is oriented **substantially vertical**" on a longer dimension.

Petitioners' newly-presented (but waived) theory that the circular small screen 118 in Figure 4 discloses Claim 4 fails. A POSITA would readily understand that circular screen 118 is not a "rectangular display," nor does this circular display have dimensions that are "substantially vertical" and "substantially horizontal" per the definition in the specification. See Surati Decl., ¶¶ 235-237.

Accordingly, Claim 4 is not anticipated by Whitehorn.

D. Dependent Claims 6-7 Are Not Anticipated Because Whitehorn Does Not Disclose "Wherein ... The Device Does Not Display An Image on a First Screen" And "The First Screen Is Disabled And Does not Receive User Interface Input."

Petitioners' theory for Claim 6 ("*the device does not display an image on a first screen*") and Claim 7 ("*the first screen is disabled and does not receive user*

interface input”) is based on the same arguments made for limitation 1E. However, for the same reasons set forth above in Section V.A, Whitehorn does not disclose that large screen 128 displays no image when the device is in the first image capture mode (Claim 6) or that large screen 128 is disabled and does not accept user input in the first image capture mode (Claim 7). See POR, 69-71.

The Reply also does nothing to cure its expert’s improper *ipsi dixit* speculation testimony (see POR, 70, addressing Rodriguez Decl., ¶¶ 321-323), nor does it respond to the testimonial evidence provided by Patent Owner’s expert, Dr. Surati, on Claims 6-7. See Reply, 30 (not addressing Surati Decl. cited by POR at 69-71).

E. Dependent Claims 2-7 Are Not Anticipated By Whitehorn

Claims 2-7 are not anticipated for the reasons set forth in Section V.A. See Reply, 30.

VI. INDEPENDENT CLAIMS 1, 11, AND 16 ARE PATENTABLE OVER WHITEHORN (GROUND 4)

A. Independent Claims 1, 11, and 16 Are Patentable Because Whitehorn Does Not Teach or Suggest Image Capture Modes “Wherein in Each Image Capture Mode a Display on the First or Second Screen is Different.”

Like its obviousness theory for Chin, Petitioners’ obviousness argument for Whitehorn is based on the premise that a POSITA “would have been motivated to turn off or disable a screen **that is not facing the user.**” See Rodriguez Decl., ¶ 376. As with Chin, Petitioners and its expert provide no evidence that the feature of

“turn[ing] off or disabl[ing] a screen that is not facing the user” was known in the art as of the priority date of September 2011. POR, 73 (Petitioners’ expert testimony is *ipse dixit* unsupported by any evidence).

Petitioners’ expert admits that he does not assert that any of the five references he characterized as defining the state of the art (Aono, Lee, Kim, Kawasaki, Park) disclose the feature of “turn[ing] off or disabl[ing] a screen that is not facing the user.” Ex. 2011 (Dep. Trans. Rodriguez), 43:20-48:4; Rodriguez Decl., ¶¶ 61-66. Thus, Petitioners’ proposed modification/combination of Whitehorn is not viable because it is based on a feature not found in the art as of the priority date. In short, the combination is missing the feature needed for it to allegedly meet the claim limitation. See POR, 73-74.

Although the burden is on Petitioners to prove that the feature was known in the art as of the priority date, Patent Owner affirmatively demonstrated that it was not found in any of Aono, Lee, Kim, Kawasaki, Park, Beach, and the 2011 iPhone. POR, 73-74 (citing Surati Decl., ¶¶ 251-252).

Furthermore, Petitioners made no demonstration of a reasonable expectation of success (POR, 74), a defect that is not disputed or remedied on reply. See Reply, 30-31.

On reply, Petitioners provide arguments on motivation to combine (Reply, 30-31), but that bypasses the requirement of showing that the feature to be combined was known in the art.

B. Dependent Claims 6 and 7 Are Patentable Because Whitehorn Does Not Teach or Suggest “Wherein ... The Device Does Not Display An Image on a First Screen” Or “The First Screen Is Disabled And Does Not Receive User Interface Input.”

Dependent Claims 6 and 7 are patentable for the same reasons as independent Claim 1 in Section VI.A. Petitioners’ arguments are based on the feature of “turn[ing] off or disabl[ing] a screen that is not facing the user” that is not found in the prior art.

VII. CONCLUSION

For the foregoing reasons, the Challenged Claims should be confirmed as patentable.

Respectfully submitted,

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Date: January 8, 2026

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This Patent Owner Sur-Reply (“Sur-Reply”) consists of 5,578 words, excluding table of contents, table of authorities, certificate of service, this certificate, or table of exhibits. The Sur-Reply complies with the type-volume limitation of 5,600 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).

Respectfully submitted,

/Stephen T. Schreiner/

Date: January 8, 2026

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the following document was served by electronic service, by agreement between the parties, on the date below:

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