Motorola Mobility LLC and Google LLC
v.
Multifold International Inc. Pte. Ltd.

Patent Owner Demonstratives

IPR 2025-00038
U.S. Patent No. 8,836,842
February 25, 2026

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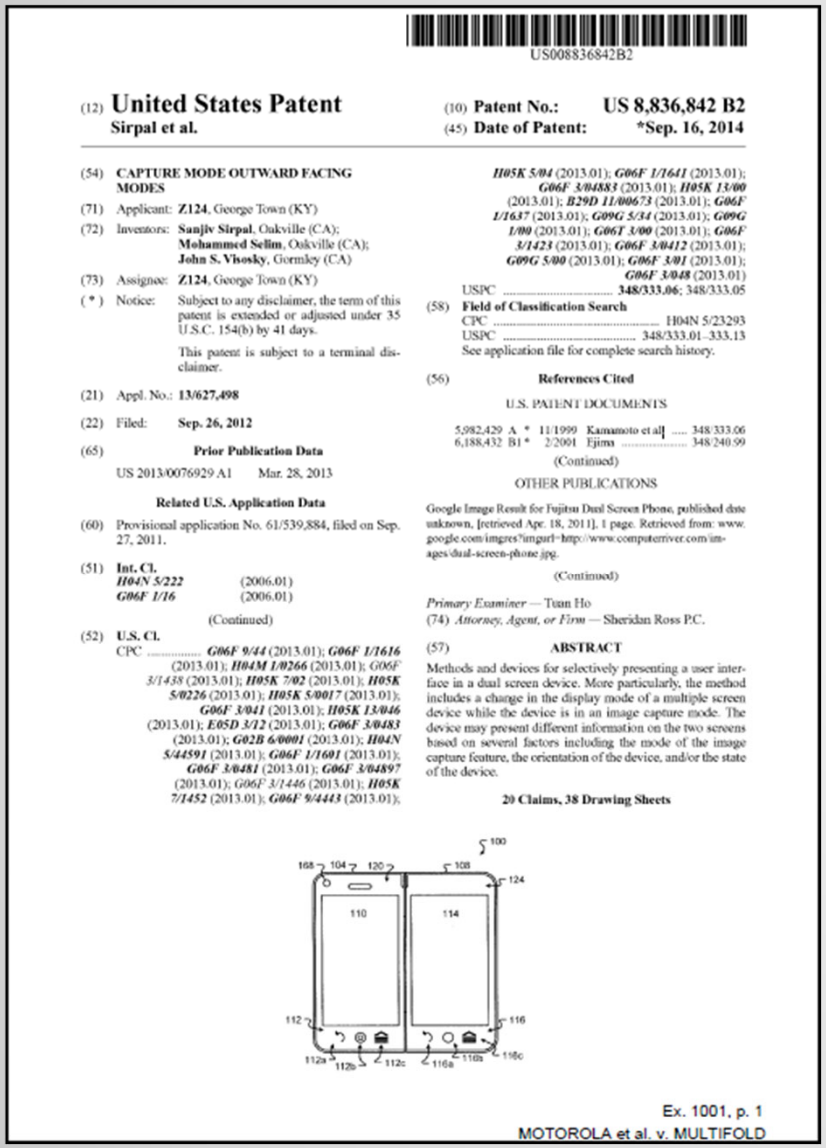
DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Background of ’842 Patent



US008836842B2

(12) **United States Patent**
Sirpal et al.

(10) **Patent No.: US 8,836,842 B2**
(45) **Date of Patent: *Sep. 16, 2014**

(54) **CAPTURE MODE OUTWARD FACING MODES**

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(73) Assignee: **Z124**, George Town (KY)

(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 41 days.

This patent is subject to a terminal disclaimer.

(21) Appl. No.: **13/627,498**

(22) Filed: **Sep. 26, 2012**

(65) **Prior Publication Data**

US 2013/0076929 A1 Mar. 28, 2013

Related U.S. Application Data

(60) Provisional application No. 61/539,884, filed on Sep. 27, 2011.

(51) **Int. Cl.**
H04N 5/222 (2006.01)
G06F 1/16 (2006.01)

(Continued)

(52) **U.S. Cl.**
CPC ***G06F 9/44*** (2013.01); ***G06F 1/1616*** (2013.01); ***H04M 1/0266*** (2013.01); *G06F 3/1438* (2013.01); ***H05K 7/02*** (2013.01); ***H05K 5/0226*** (2013.01); ***H05K 5/0017*** (2013.01); ***G06F 3/041*** (2013.01); ***H05K 13/046*** (2013.01); ***E05D 3/12*** (2013.01); ***G06F 3/0483*** (2013.01); ***G02B 6/0001*** (2013.01); ***H04N 5/44591*** (2013.01); ***G06F 1/1601*** (2013.01); ***G06F 3/0481*** (2013.01); ***G06F 3/04897*** (2013.01); *G06F 3/1446* (2013.01); ***H05K 7/1452*** (2013.01); ***G06F 9/4443*** (2013.01); ***H05K 5/04*** (2013.01); ***G06F 1/1641*** (2013.01); ***G06F 3/04883*** (2013.01); ***H05K 13/00*** (2013.01); ***B29D 11/00673*** (2013.01); ***G06F 1/1637*** (2013.01); ***G09G 5/34*** (2013.01); ***G09G 1/00*** (2013.01); ***G06T 3/00*** (2013.01); ***G06F 3/1423*** (2013.01); ***G06F 3/0412*** (2013.01); ***G09G 5/00*** (2013.01); ***G06F 3/01*** (2013.01); ***G06F 3/048*** (2013.01)
USPC **348/333.06**; 348/333.05

(58) **Field of Classification Search**
CPC H04N 5/23293
USPC 348/333.01–333.13
See application file for complete search history.

(56) **References Cited**

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(Continued)

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(57) **ABSTRACT**

Methods and devices for selectively presenting a user interface in a dual screen device. More particularly, the method includes a change in the display mode of a multiple screen device while the device is in an image capture mode. The device 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.

20 Claims, 38 Drawing Sheets

Ex. 1001, p. 1
MOTOROLA et al. v. MULTIFOLD

- **Issued: Sept. 16, 2014**
- **Priority date: Sept. 27, 2011**

Ex. 1001 (‘842 Patent).

Grounds

Claims [1], 2-7, [10], 11, 12-13, [16], 17, and 19-20

Ground 1: Cl. [1], 2-7, 10, [11], 12-13, [16], 17, and 19-20 under § 102 re Chin.

Ground 2: Cl. [1], 2-7, 10, [11], 12-13, [16], 17, and 19-20 under § 103 re Chin.

Ground 3: Cl. [1], 2-7, 10, and [11] under § 102 re Whitehorn.

Ground 4: Cl. [1], 2-7, 10, and [11] under § 103 re Whitehorn.

[bracket] = Independent claim

Pet, 6-7.

Definition of POSITA

Parties agree on the Definition of POSITA as of September 2011:

For purposes of this response, Patent Owner accepts the Petitioner's definition of the POSITA as having at least a bachelor's degree in electrical engineering, computer engineering, computer science, or a related field along with 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. See Pet., 16; Ex. 1003 (Rodriguez Decl.), ¶ 51. Surati Decl., ¶¶ 42-46.

POR, 25.

Claim 1

[1P] 1. *A method, comprising:*

[1A] *providing a device having at least first and second screens*;

[1B] *receiving user interface input to execute an image capture function*;

[1C] *determining one or more of an image capture function configuration, a device orientation, and a device state; and*

[1D] *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*,

[1E] *wherein in each image capture mode a display on the first or second screen is different*.

POR, 7.

Claim Construction – “Screen” & “Display”

Petitioner:

Proposed special construction of “screen” and “display.” Pet., 16-17.

Patent Owner:

No need for explicit construction of “screen” and “display” based on applied art. POR, 10.

Board:

Board was correct that no special construction required for “screen” or “display.” DI, 9.

Claim Construction – Limitation 11B

"a second screen, 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"

<u>Petitioner</u>:
Proposed construction of "Associated With" and "Faces an Opposite Direction" **Reply, 3-6.**

- **"Associated With": P&OM.** **Reply, 4.**
- **"Faces An Opposite Direction" means screens are facing one another.** **Reply, 5.**

<u>Patent Owner</u>:
No need for explicit construction based on patentability theory.

Sur-reply, 2.

Claim Construction – Limitation 1E

"Entering into one or more image capture modes, wherein in each image capture mode a display on the first or second screen is different" **POR., 10-11; Sur-reply, 1.**

<u>Patent Owner</u>: "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; Sur-reply, 1.**

"Put another way, this means that at least one of the "first and second screens" must be different between the image capture modes.

<u>Board</u>: "At this stage of the proceeding we need not explicitly construe . . . [limitation 1E]." **DI, 9.**

<u>Reply/Sur-reply</u>: Petitioner does not seem to dispute PO's construction. **Reply, 1-3; Sur-reply, 1.**

Claim Construction – Limitation 1E

"Entering into one or more image capture modes, wherein in each image capture mode a display on the first or second screen is different"

Language of Claim:

The claim language supports Patent Owner's construction because it provides for a device having a first screen and a second screen (limitation 1B) and entering one of one or more image capture modes wherein "*in each image capture mode a display on the first screen or second screen is different*." A POSITA would understand the limitation as providing that the "*display on the first screen or second screen*" for a first image capture mode is "*different*" from the "*display on the first screen or second screen*" for another image capture mode. In other words, the limitation requires a first-screen-to-first-screen comparison or a second-screen-to-second-screen comparison. In short, the same screen must present different displays between image capture modes. Surati Decl., ¶¶ 73-74.

POR, 12-13.

Claim Construction – Limitation 1E

Specification:

Consistently describes different image capture modes as having a different display on the first screen and/or a different display on the second screen.

1324. Based on the determined orientation, state, and image capture mode, the device **100** may enter an image capture mode that is presented to the user, in step **1328**.

At some time thereinafter, while remaining in the image capture mode, the device **100** may receive an orientation change. The orientation change can include a rotation of the device **100**, the device **100** moving from a closed state to an open state, or from an open state to a closed state. The rotation of the device **100** may be from portrait to landscape or from landscape to portrait, or the device **100** may be flipped such that the screens face different directions from their original configuration. When received, and based on the new orientation, the device **100** may present a new image capture mode by providing a different type of display for the image capture function **1100** **1110**. A least a portion of the first and/or second screen **110**, **114** change from the original display to the new display.

'842, 33:21-37.

POR, 14.

Claim Construction – Limitation 1E

Specification

Corresponding to 33:21-37 and 36:46-62, first image capture mode of Fig. 12 changes to second image capture mode of Fig. 20. The display on first screen has changed and the display on the second screen has changed.

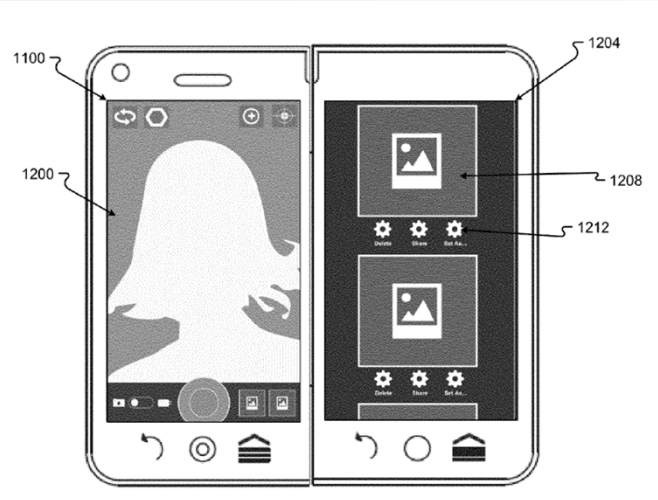


FIG. 12

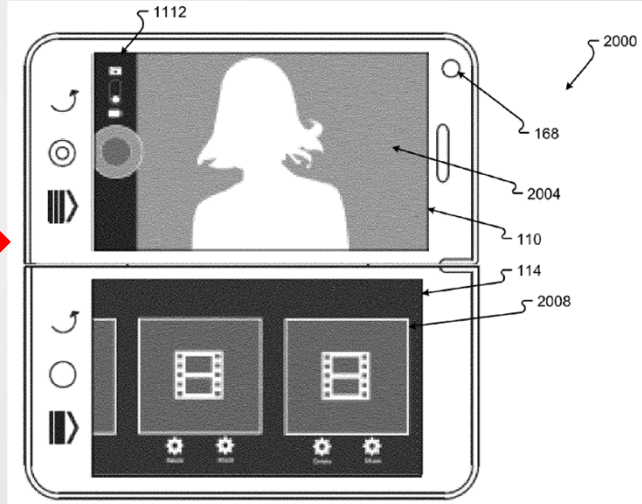


Fig. 20

Original "Image Capture Mode"

"New Image Capture Mode"

'842, Figs. 12, 20; POR, 14, 18-19.

Claim Construction – Limitation 1E

Specification

The image capture mode in Fig. 12 changes to a new image capture mode in Fig. 20 where the display on the first screen differs and the display on the second screen differs.

The image capturing function may be configured to be in a dual screen orientation capturing an inward facing image, as shown in FIG. **12**. Thus, the device **100** is in an open state and the first display **1200** is in a portrait orientation. With the rotation, the display can change to a landscape orientation **2000**, as shown in FIG. **20**. One or more portions of the display may change due to the rotation. For example, the preview image **1108**, shown in FIG. **12**, changes to a landscape orientation **2004**, shown in FIG. **20**.

Likewise, the film roll **1204**, shown in FIG. **12**, changes to a landscape orientation **2008**, shown in FIG. **20**. As the film roll **1204**, **2008** is navigable, the film roll **2008** may now move horizontally rather than vertically along the long axis of the screen **114**, thus the film roll **2008** changes movement from a vertical orientation to a horizontal orientation. Further, the images within the film roll **2008** may change from a portrait orientation to a landscape orientation.

’842, 36:46-62, Figs. 12, 20; POR 18-19.

Claim Construction – Limitation 1E

Specification

Figure 13 supports PO's construction by providing an image capture mode depending on (1) function configuration, (2) orientation, and (3) device state.

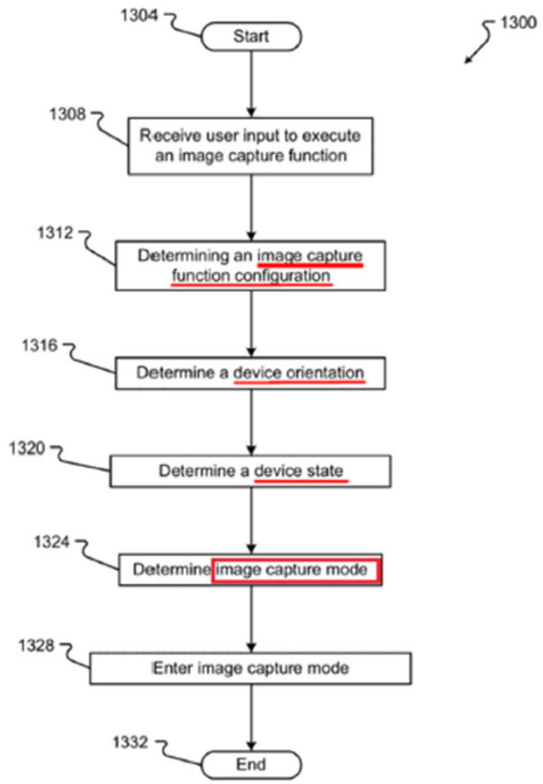


FIG. 13

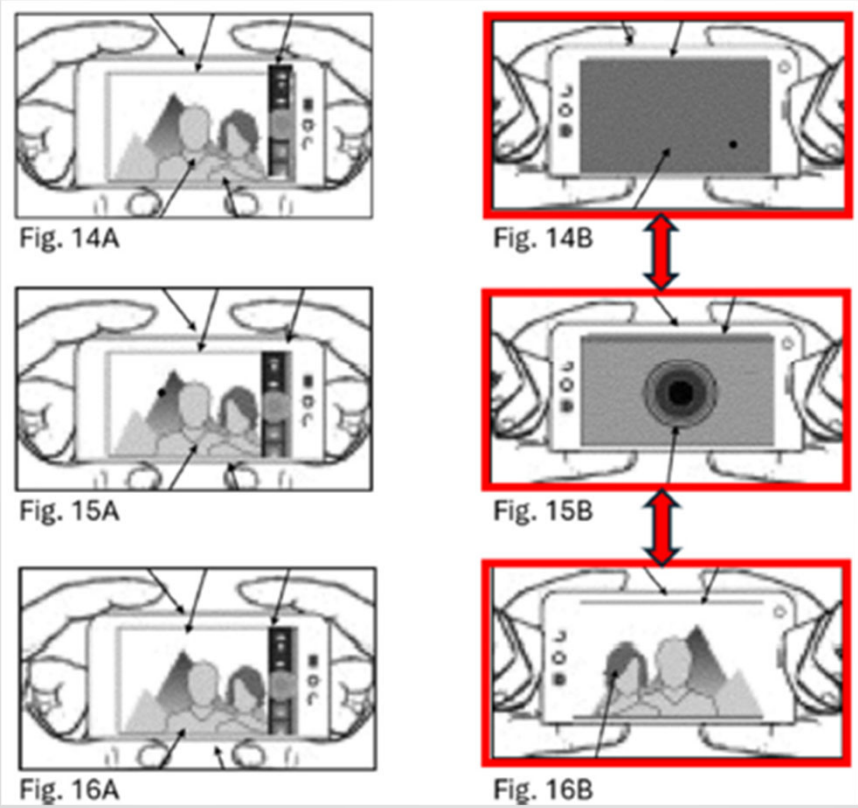
'842, 32:61-33:37; POR, 15.

Claim Construction – Limitation 1E

More Support from the Specification

The specification discloses three more examples of image capture modes in Figs. 14A-16B—here the first screen 110 differs.

Second Screen 114 **First Screen 110**



’842, 33:38-34:8; Figs. 14A-16B, POR, 16-17.

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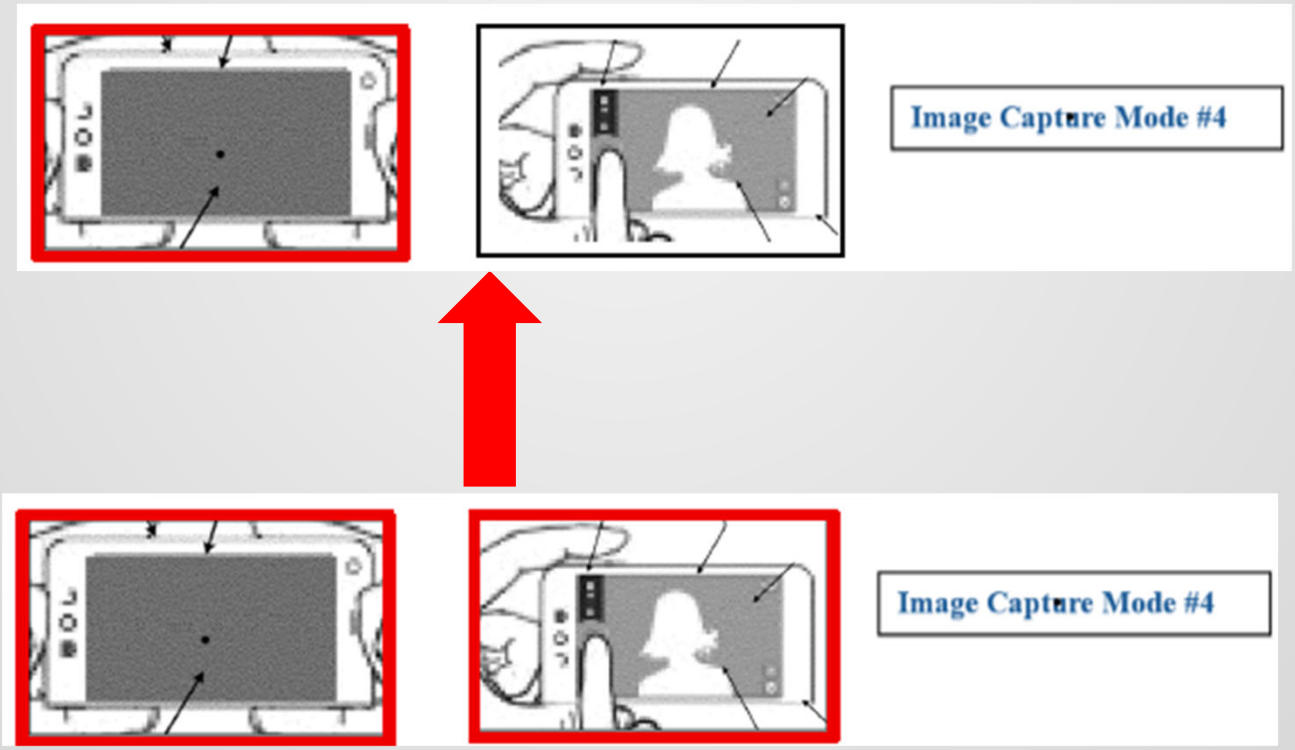
Claim Construction – Limitation 1E

More Support from the Specification

The specification discloses another example of an image capture mode in Fig. 18, where the second screen 114 is different (it is disabled). The first screen 110 is a photo preview (like Fig. 16B).

Second Screen 114 **First Screen 110**



’842, 34:40-63; Fig. 18; POR,.17-18.

Claim Construction – Limitation 1E

Summary of Specification

- **Repeatedly discloses different image capture modes where there is a different display on the first screen and/or a different display on the second screen, in response to differing parameters (image capture function, orientation, state).**

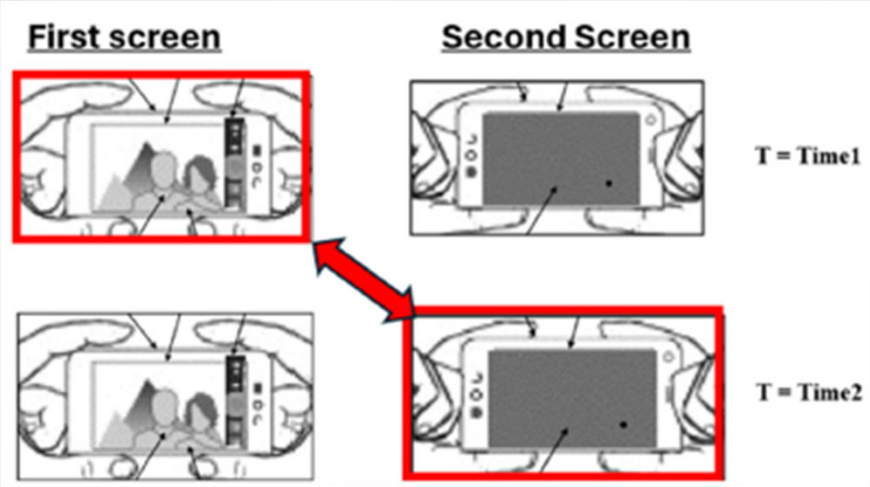
- **Supports construction: "a different display on the first screen between image capture modes or a different display on the second screen between image capture modes."**

POR,.20-21.

Claim Construction – Limitation 1E

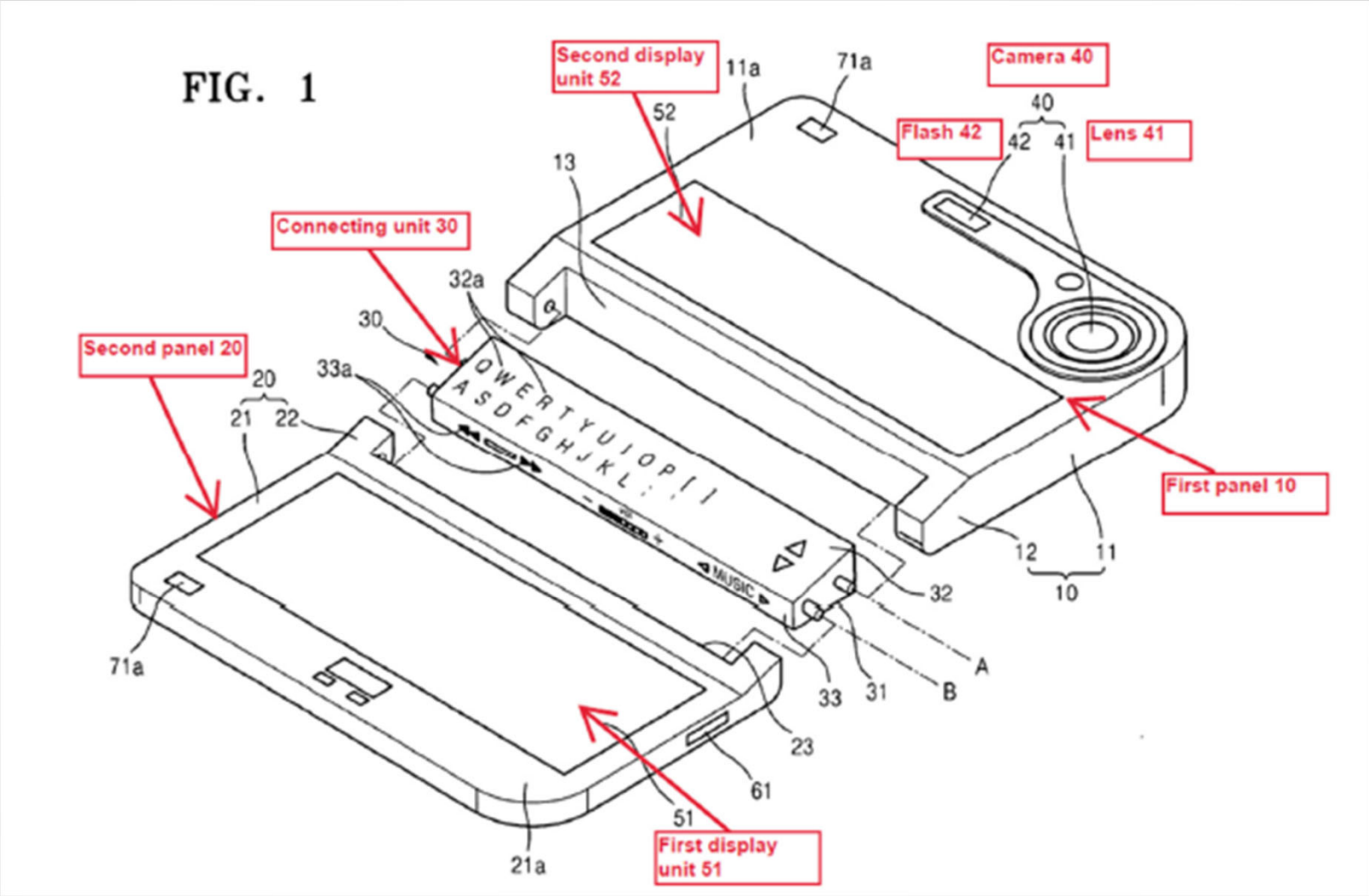
No Importation of Limitation into the Claim

- **Limitation 1E construed based on (1) P&OM confirmed by (2) repeated description in specification.**
- **DI based on POPR that addressed only Fig. 21 of specification. POR addresses six (6) different embodiments.**
- **Construction that would find different image capture modes based on comparing first-screen-to-second screen does not work:**



POR,.23-24.

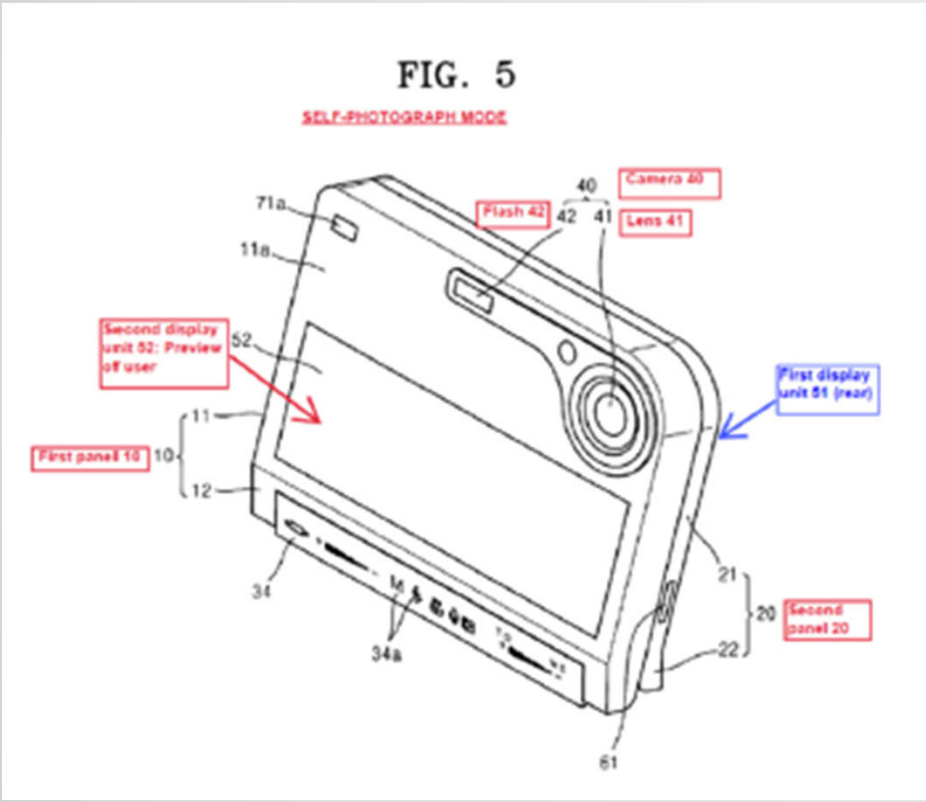
Chin – Fig. 1



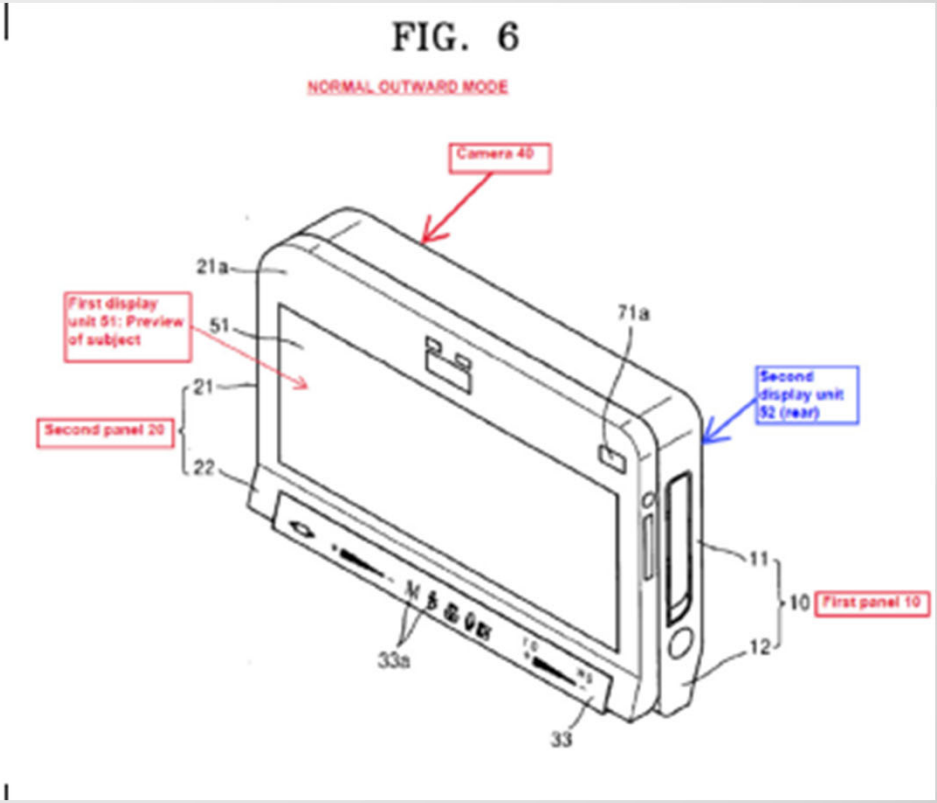
POR, 26-27, Chin, Fig. 1.

Chin – Figs. 5-6

Self-Photograph Mode



Outward-Facing Photograph Mode



POR, 27-28, Chin, Figs. 5-6.

Whitehorn – Fig. 2

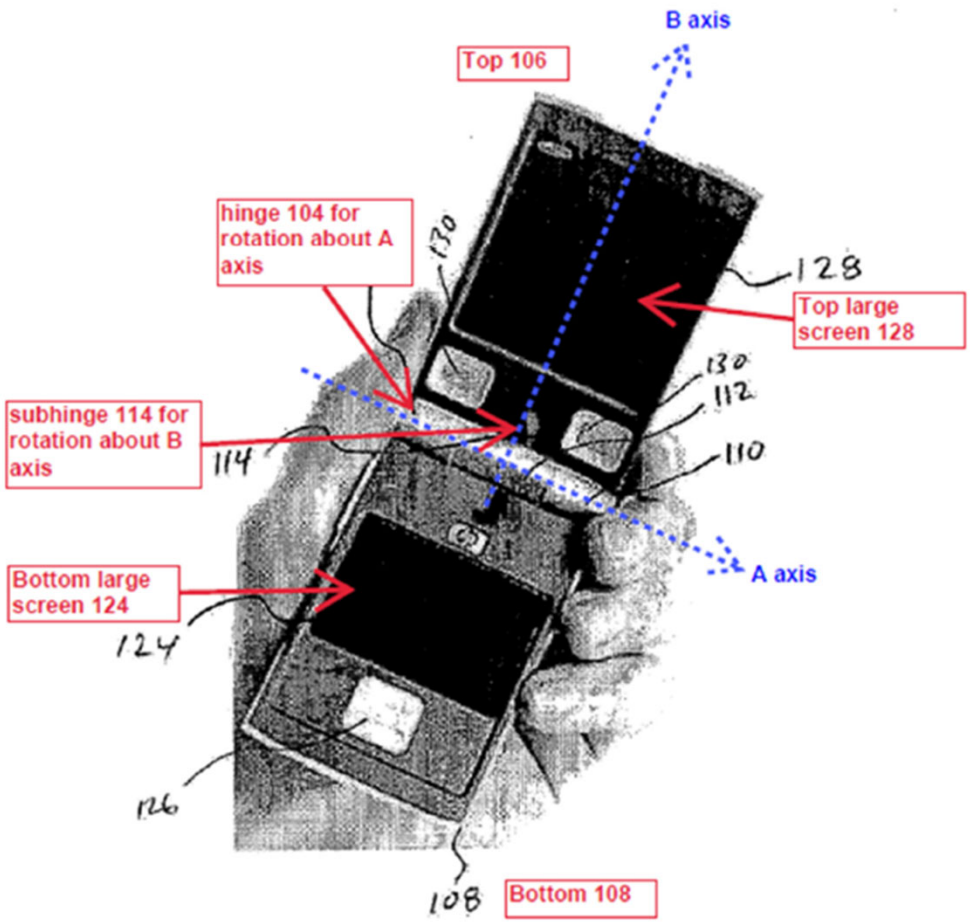


Fig. 2

POR, 29-30, Whitehorn, Fig. 3.

Whitehorn – Fig. 1

First Image Capture Mode

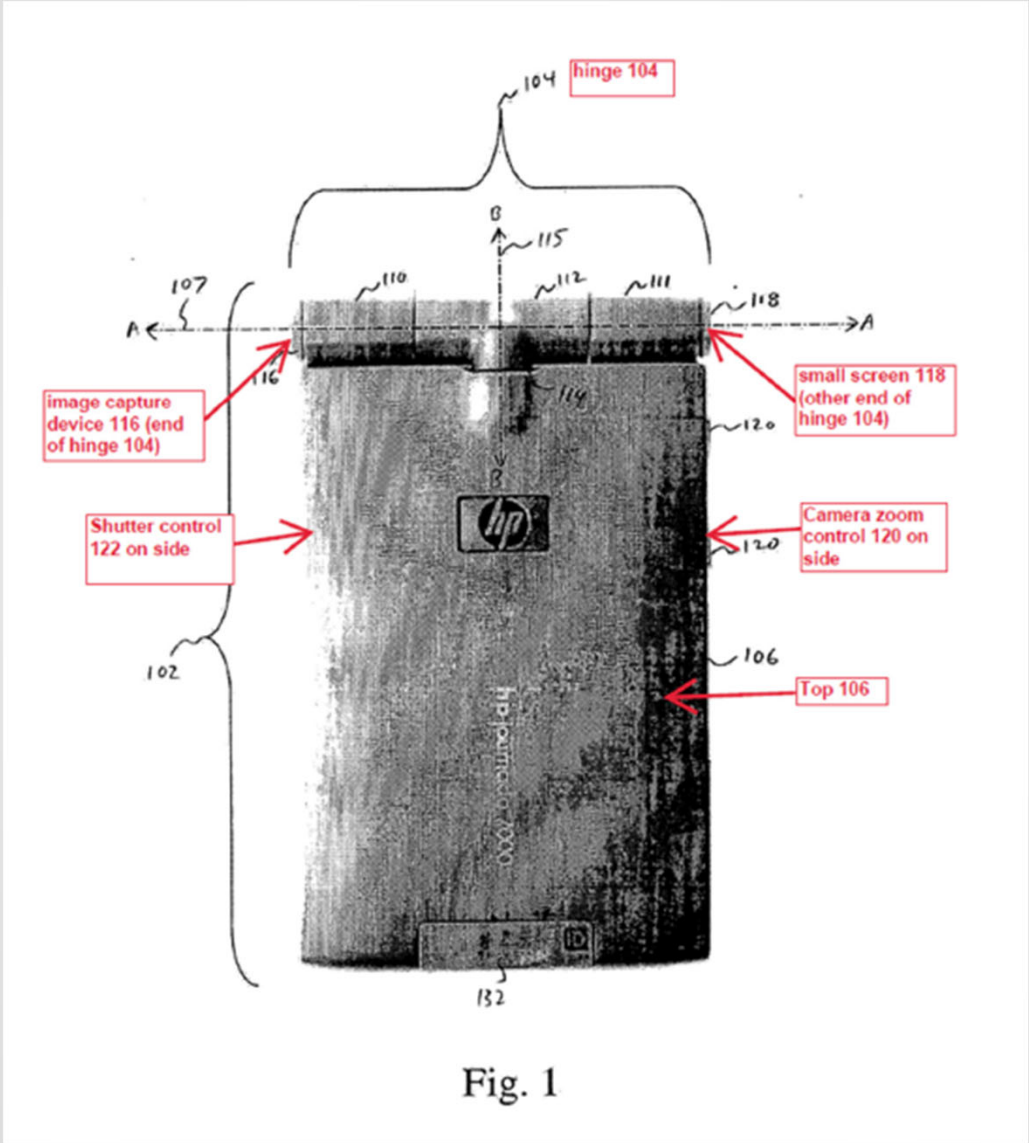
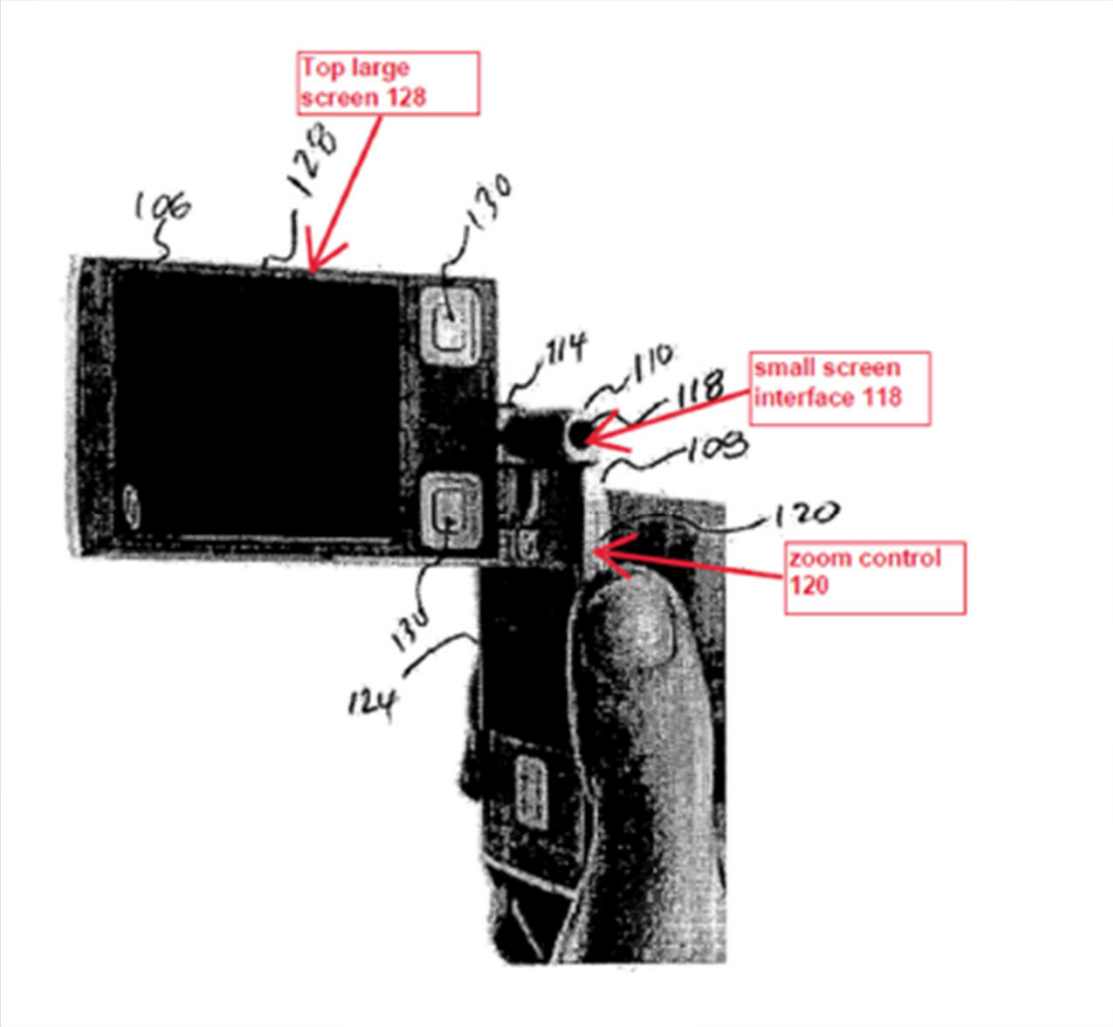


Fig. 1

POR, 31-32, Whitehorn, Fig. 1.

Whitehorn – Fig. 5

Second Image Capture Mode



POR, 32-33, Whitehorn, Fig. 5.

Ground 1: Anticipation by Chin

<u>Chin fails to disclose limitation 1E</u>

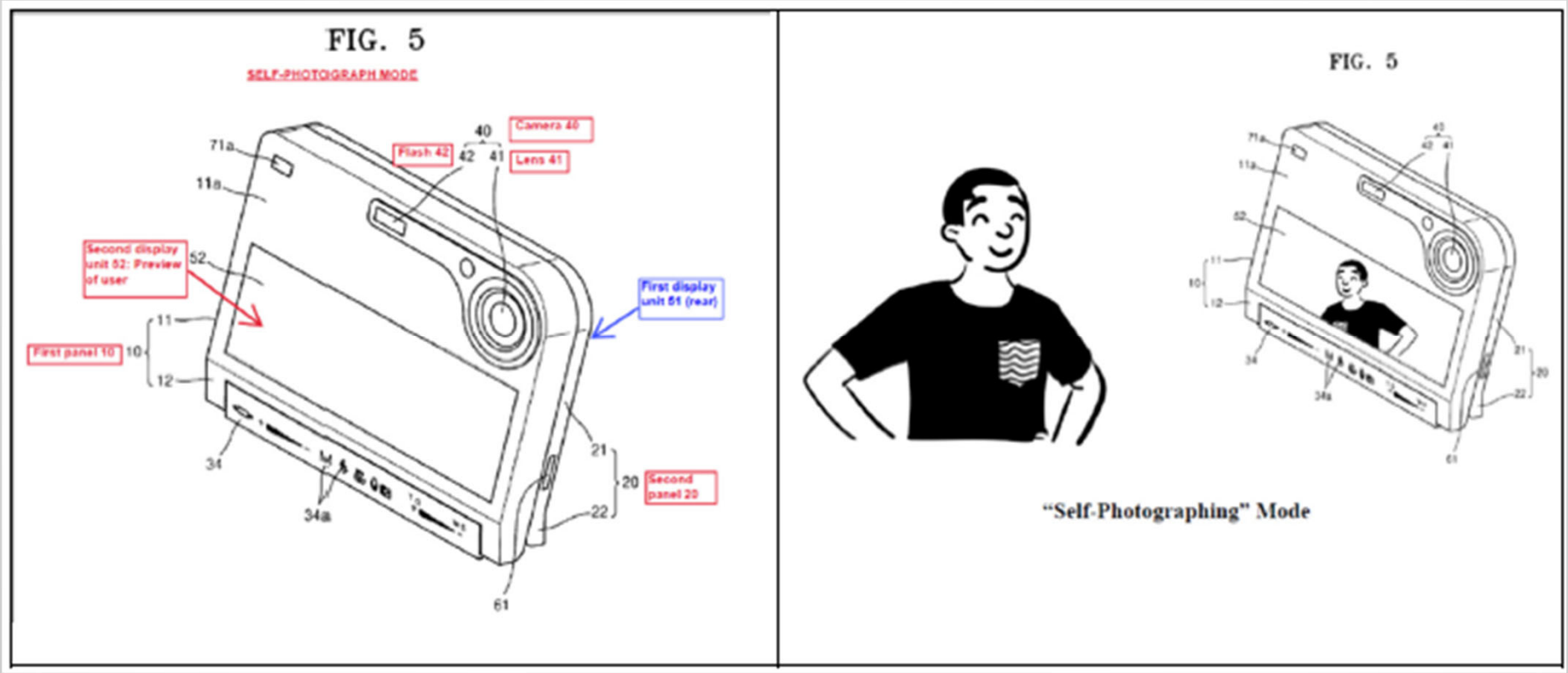
"entering one or more image capture modes"
"wherein in each image capture mode a display on the first or second screen is different."

POR, 33-44.

Ground 1: Anticipation by Chin

<u>Pet.</u>: First Image Capture Mode is Chin's Self-Photograph mode of Fig. 5

<u>PO</u>: Agree that Chin displays a photo preview on second screen 52.

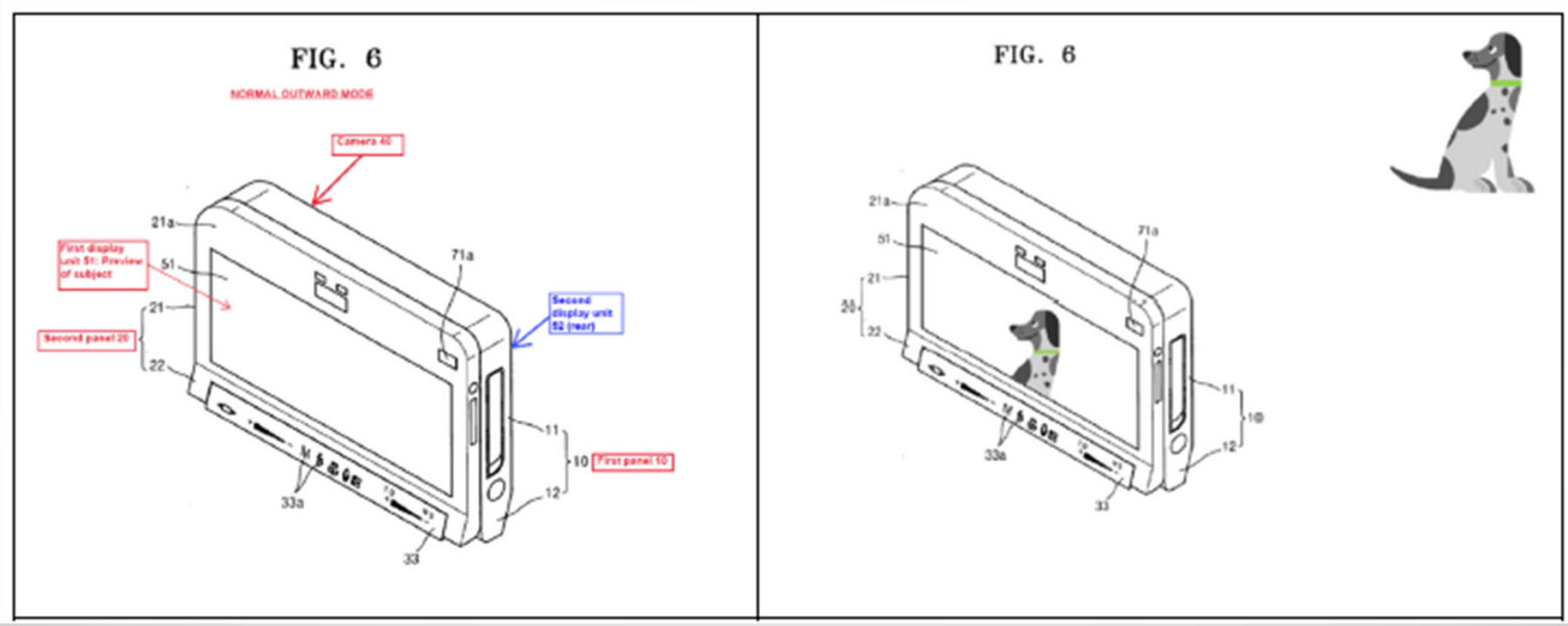


POR, 35-37, Chin, Fig. 5.

Ground 1: Anticipation by Chin

<u>Pet.</u>: Second Image Capture mode is Chin's Outward-Facing Photograph mode of Fig. 6.

<u>Patent Owner</u>: Agree that Chin displays a photo preview on first screen 51.



POR, 37-38, Chin, Fig. 6.

Ground 1: Anticipation by Chin

No anticipation by Chin because no showing that the display on the same screen differs between the Self-Photograph mode of Fig. 5 and the Outwardly-Facing Photograph mode of Fig. 6.

- **Petition appears to compare second display unit 52 in Fig. 5 to first display unit 51 in Fig. 6. See Pet., 30.**
- **But the proper claim construction is that either (1) first display unit 51 in Fig. 5 differs from first display unit 51 in Fig. 6, or (2) that second display unit 52 in Fig. 5 differs from second display unit 52 in Fig. 6.**
- **Chin does not anticipate because it does not disclose the display on first display unit 51 in Fig. 5 or the display on second display unit 52 in Fig. 6.**
- **The undisclosed displays could be photo previews and thus they would not differ from their counterpart display between Fig. 5 and Fig. 6.**

POR, 39-42.

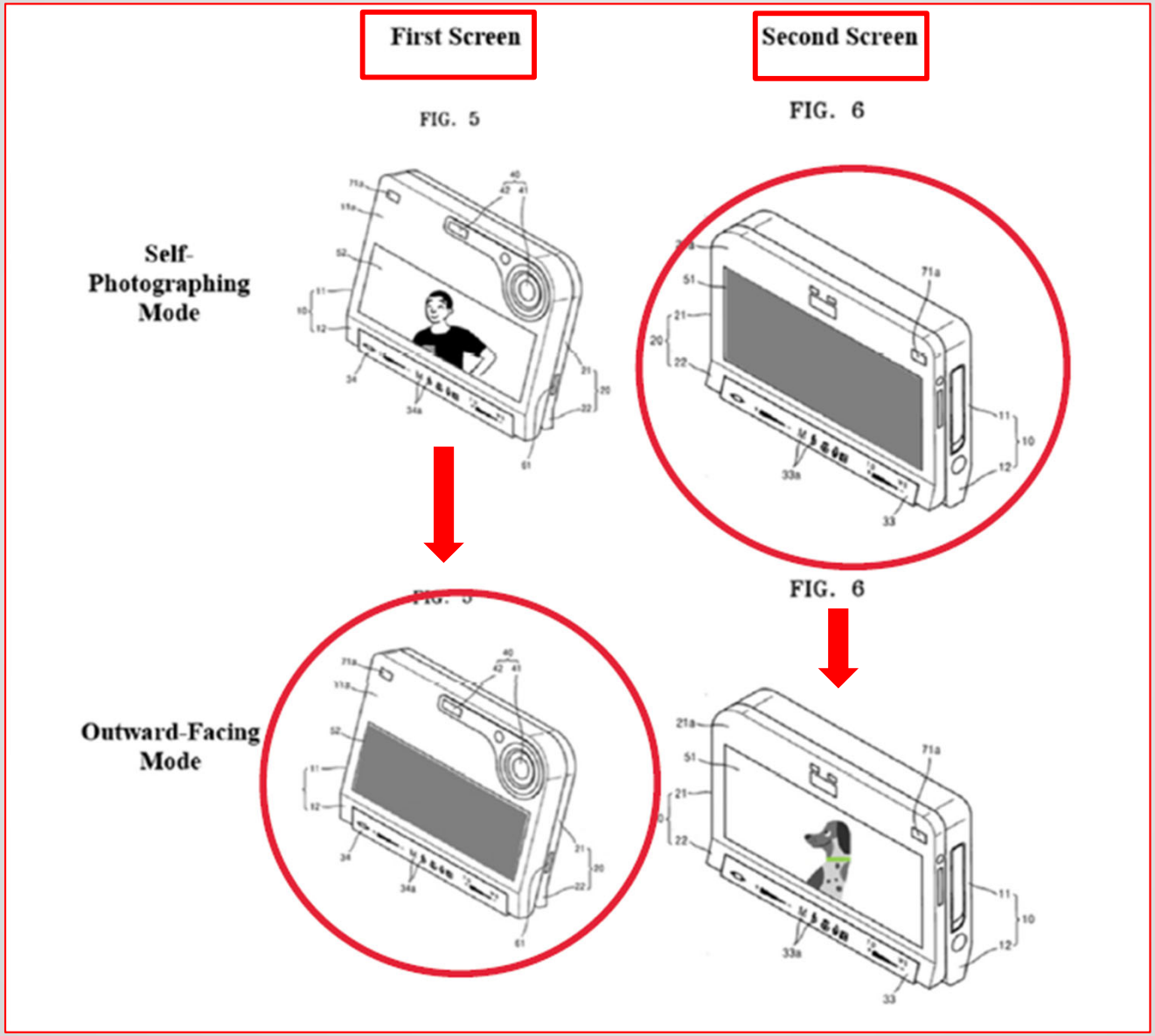
Ground 1: Anticipation by Chin

Petition made no inherency argument for limitation 1E for Chin.

- **Any inherency argument is waived because it was entirely foreseeable.**
- **Inherency argument fails because first display unit 51 in Fig. 5 could present a photo preview. Thus, not inherent that first display unit 51 in Fig. 5 differs from first display unit 51 in Fig. 6, which provides a photo preview.**
- **The same is true for second display unit 52 of Fig. 6, which could display a photo preview like second display unit 52 of Fig. 5, which provides a photo preview.**

POR, 41-43.

Ground 1: Anticipation by Chin



Reply, 12; Sur-reply, 5-9.

Ground 1: Anticipation by Chin

Petitioner's New Theories on Reply Should Be Deemed Waived:

1. **Fig. 9 of Chin shows that limitation 1E is met.** Pet., 8-9.

   PO Response: Fig. 9 does not disclose what first display 51 is in Self-Photo mode (see S150, S160), nor what second display 52 is in Outward-Facing mode (see S170).

2. **A POSITA would "envisage" Chin as meeting limitation 1E (citing *Kennametal v. Ingersoll Cutting Tool*, 780 F.3d 1376 (Fed. Cir. 2015))**

   Reply, 10-11.

   PO Response: Case law (e.g., *Net MoneyIn*) requires that limitation be expressly or inherently disclosed in reference.

   ***Kennametal*'s "envisage" test does not apply because there the claimed combination was disclosed. The only question was whether a POSITA would recognize it among the many disclosed combinations.**

   Sur-reply, 3-4.

Ground 1: Anticipation by Chin

Petitioner's Speculation on Reply is without merit:

<u>Petitioner</u>: "A self-photographing preview is a different display from an outward-facing preview." Reply, 13.

<u>PO Response</u>: If Chin disclosed second display 52 of Fig. 5 as providing a photo preview, that would not be a different display that second display in 52 in Fig. 6 which provides a photo preview.

<u>Petitioner</u>: "[What] if the Chin device was displaying a preview on both screens in self-photographing mode." Reply, 14.

<u>PO Response</u>: Chin does not make that disclosure. Chin does not disclose what both screens are displaying in the Self-Photo mode or the Outwardly-Facing mode. Sur-reply, 10.

Ground 1: Anticipation by Chin

<u>Chin fails to disclose limitation 11A and Claim 10</u>

11A: "*a first screen, the first screen including an image capture region*"

Cl. 10: "*controls are presented on a second screen.*"

POR, 45; Sur-reply, 10-13.

Ground 1: Anticipation by Chin

Pet.: Chin's first display unit 51 is disclosed in [0061] as being implemented as a touch-screen display. Pet., 40-41.

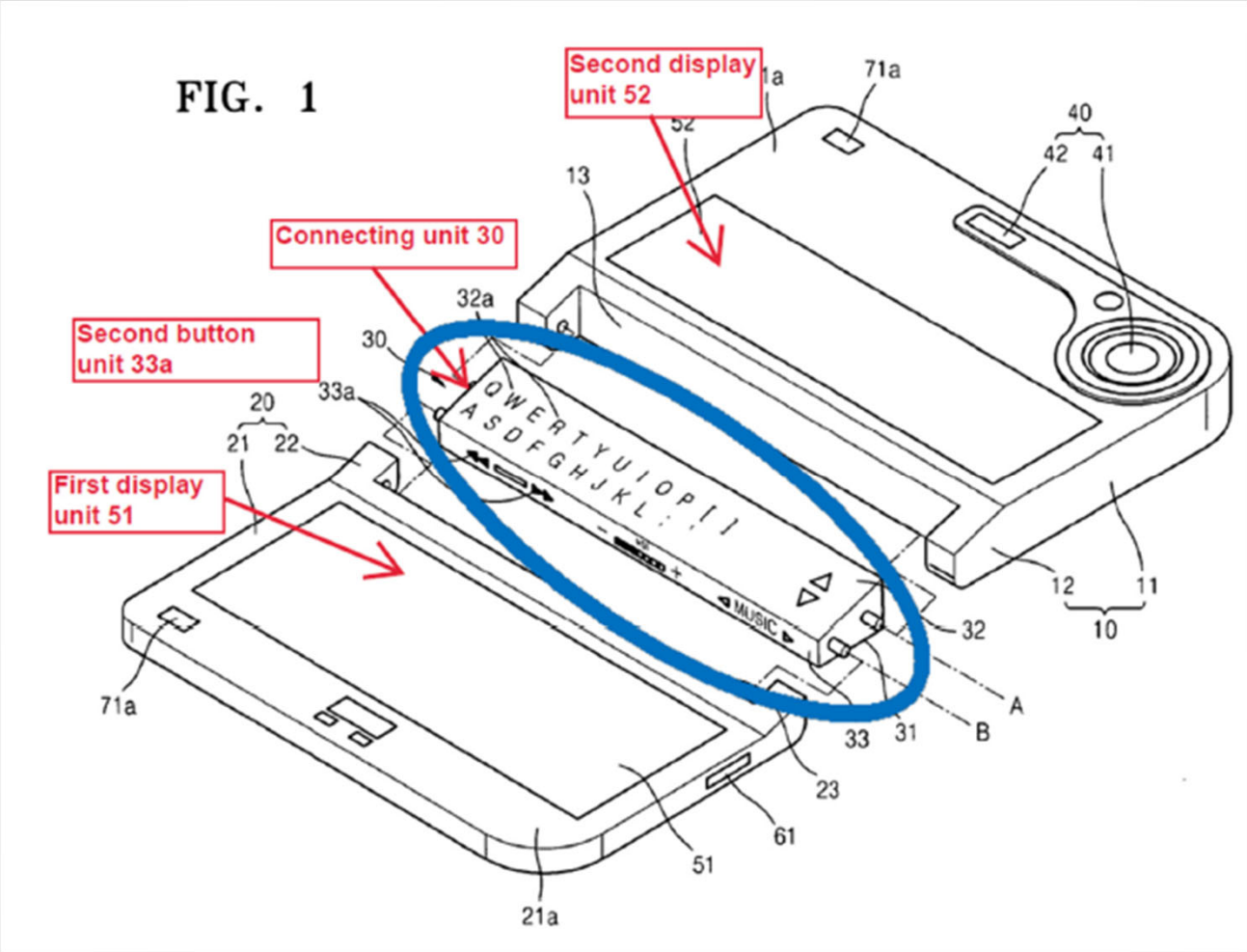
PO Response: Chin discloses that a button unit 33a on connecting unit 30 can be a touch-screen display, not that first display unit 51 can be a touch-screen display. POR, 45; Sur-reply, 10-13.

[0061] The second button unit **33***a* 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 **33***a* may have a function of the camera operating button **33***b* and some may have a function of the multimedia operating button **33***c*. Accordingly, the second button unit **33***a* receives signals from the controlling unit **70** (relative to the sensor unit **71**) so as to activate the camera operating button **33***b* or the multimedia operating button **33***c*. The structure of the second button unit **33***a* 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, Fig. 1, [0061].

Ground 1: Anticipation by Chin

<u>PO Response</u>: Button unit 33a on <u>connecting unit 30</u>, not display unit 51, can be a touch-screen display. POR, 45; Sur-reply, 10-13.



Chin, Fig. 1.

Ground 1: Anticipation by Chin

Chin fails to disclose limitation 16E and Dependent Claims 6, 7, 13, 17, and 19

16E, Cl. 13, 17: "***wherein the image capture mode is one of a full and disabled mode . . .***"

Cl. 6: "***the device does not display an image on a first screen***"

Cl. 7: "***wherein the first screen is disabled and does not receive a user input***"

Cl. 19: "***user input for the second screen is disabled***"

POR, 46-50, 53;; Sur-reply, 13-15.

Ground 1: Anticipation by Chin

<u>Petitioner</u>: Chin discloses a "full and disabled mode" based on second display unit 52 in the Outward-Facing mode of Chin Fig. 6.
Pet., 48 (citing Chin, [0079])

<u>PO Response</u>: Chin provides no disclosure of what type of display is provided for second display unit 52 in Outward-Facing mode of Fig. 6.

[0079] When the self-photographing mode is not selected, the portable information terminal in step **S170** displays images on a first display unit before a photograph is taken, so that the first display unit can perform a preview function.

Ground 1: Anticipation by Chin

Patent Owner: Petitioner relies on its expert's *ipse dixit* testimony not tied to any supporting evidence that if Chin does not describe what type of display is provided on the first screen, then is expressly discloses that the first screen:

(1) "is not displaying and image"
(2) "is disabled," and
(3) "does not receive user interface input." POR, 45-46 (citing Rodriguez Decl., par. 161-164.

Petitioner Response on Reply: No response. No supplemental declaration. No supplemental evidence. See Reply, 16-17; Sur-reply, 14.

Conclusion:
(1) There is no evidentiary support that Chin discloses limitation 16E or Claims 6, 7, 13, 17, and 19.

(2) Petitioner's expert's unsupported opinion does not substitute for the lack of express disclosure in Chin.

Ground 1: Remaining Dependent Claims

Dependent Claims 2-7, 10, 12-13, 17, and 19-20 are not anticipated by Chin for same reasons as independent claims. **See POR, 53.**

Ground 2: Obviousness based on Chin

<u>Chin fails to teach or suggest limitation 1E</u>:

"entering one or more image capture modes"
"wherein in each image capture mode a display on the first or second screen is different."

POR, 54-58.

Ground 2: Obviousness based on Chin

Petitioner's Opening Argument

Pet.: Chin "specif[ies] that the preview is shown on one screen or the other, and not on both screens." Pet., 55.

PO Response: Petitioner is still comparing different screens (i.e., Chin discloses photo preview on second display 52 in Fig. 5 compared to photo preview on first display 51 in Fig. 6).

Limitation 1E requires a showing that the same screen is different between the two different image capture modes. POR, 54.

Ground 2: Obviousness based on Chin

Petitioner's Core Argument

Pet.: "[A] POSITA would have been motivated to turn off or disable a screen that is not facing the user" to save power Pet., 55; Rodriguez Decl., ¶ 258.

PO Response:

(1) The proposal is to modify or combine Chin with the feature of "turning off or disabling a screen that is not facing the user." POR, 55-58.

(2) Neither Petitioner or its expert establishes that it was common knowledge in the art (in 2011) to turn off or disable a screen when it is not facing a user.

(3) Petitioner's expert provides *ipse dixit* testimony unsupported by evidence. Not a single reference is provided in support.

Ground 2: Obviousness based on Chin

Petitioner's Core Argument

"[A] POSITA would have been motivated to turn off or disable a screen that is not facing the user" to save power. Pet., 55; Rodriguez Decl., ¶ 258.

258. And, among those two options, a POSITA in or around 2011 would have been motivated to turn off or disable a screen that is not facing the user because doing so would save power. In or around 2011, battery capacity was limited and turning off power to one screen in a multi-screen device was a known design option and well within the ability of a POSITA. And this would have made intuitive sense

No evidentiary basis for feature of "turning off or disabling a screen that is not facing the user."

Ground 2: Obviousness based on Chin

Petitioner's Core Argument

"[A] POSITA would have been motivated to turn off or disable a screen that is not facing the user" to save power. Pet., 55; Rodriguez Decl., ¶ 258.

- **Petitioner's expert cited five references defining the state of the art for multi-screen devices: (1) Aono (Ex. 1006), (2) Lee (Ex. 1009), (3) Kim (Ex. 1010), (4) Kawaski (Ex. 1011), and (5) Park (Ex. 1012).** POR, 55 (citing Rodriguez Decl., ¶¶ 62-66).

- **None of these references disclose "turning off or disabling a screen that is not facing the user."**

- **Petitioner's expert did not dispute that his cited references do not disclose feature of turning off/disabling a screen not facing a user.** POR, 55 (citing Ex. 2011 (Dep. Trans. Rodriguez), 43:20-48:4.

- **PO's expert Dr. Surati gave unrebutted testimony that the feature at issue was not common knowledge in the art in 2011.** POR, 55; Ex. 2002, Surati Decl. ¶¶ 194-197.

Ground 2: Obviousness based on Chin

Petitioner's Core Argument

"[A] POSITA would have been motivated to turn off or disable a screen that is not facing the user" to save power. Pet., 55; Rodriguez Decl., ¶ 258.

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.

Sur-reply, 16.

Ground 2: Obviousness based on Chin

Petitioner's Reframed Argument

"[A] POSITA would understand Chin as disclosing two options: the screen can be either on or off." Reply, 18.

PO Response:

(1) Petitioner's proposed combination is still to modify Chin with the feature of "turn[ing] off or disabl[ing] a screen that is not facing the user."

(2) False premise: Chin does not disclose display units 51/52 being turned off.

(3) Petitioner's burden to establish feature is common knowledge. PO's expert has provided affirmative evidence it was not common knowledge.

(4) Petitioner also does not establish a reasonable likelihood of success.

Sur-reply, 16-18.

Ground 2: Other Claims

Independent Claims 11, 16 and Dependent Claims

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.

Sur-reply, 18.

Ground 3: Anticipation by Whitehorn

<u>Whitehorn fails to disclose limitation 1E</u>:

"entering one or more image capture modes"
"wherein in each image capture mode a display on the first or second screen is different."

POR, 60-66; Sur-reply, 20-22. .

Ground 3: Anticipation by Whitehorn

<u>Pet.</u>: Relies on First Capture mode of Figs. 1/3/4 and Second Capture mode of Fig. 5.

<u>First Capture Mode</u>

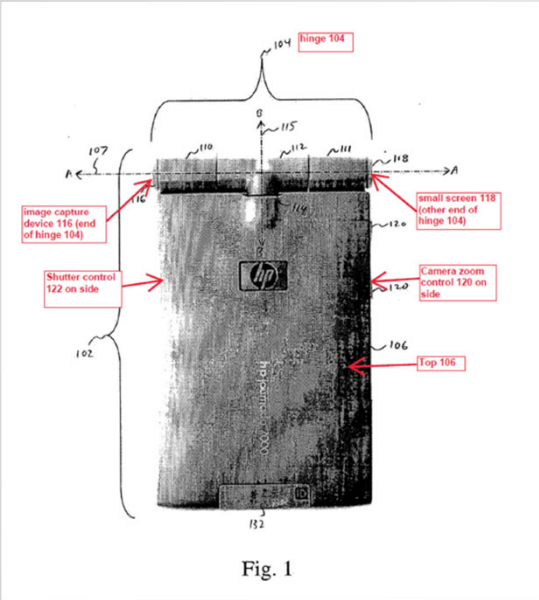


Fig. 1

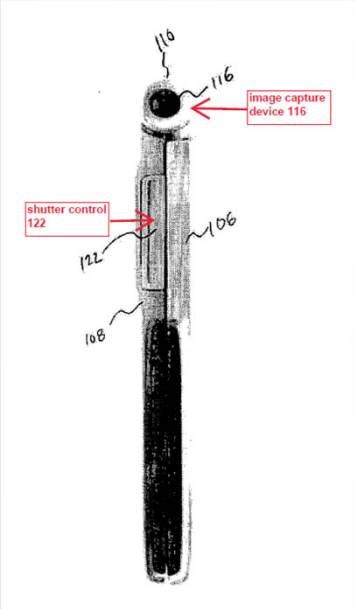


Fig. 3

<u>Second Capture Mode</u>

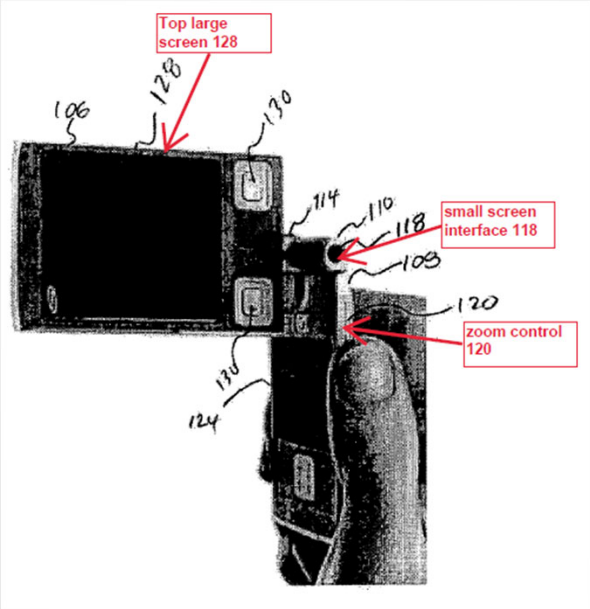


Fig. 5

POR, 60-66; Sur-reply, 20-22. .

Ground 3: Anticipation by Whitehorn

Pet.: "In each of these two image capture modes, a display on at least the top large screen interface 128 (the 'first screen' or 'second screen') is different." Pet., 66.

PO Response: Whitehorn does not disclose that large screen 128 in First Capture mode (e.g., Fig. 1) is different from large screen 128 in Second Capture mode (e.g., Fig. 5).

Whitehorn discloses that large screen 128 provides a preview in Fig. 5, but Whitehorn provides no disclosure on how large screen 128 operates in Fig. 1.

For First Capture mode, Whitehorn discloses in [0027] that small screen 118 provides a preview but does not disclose what large screen 128 displays or how it operates.

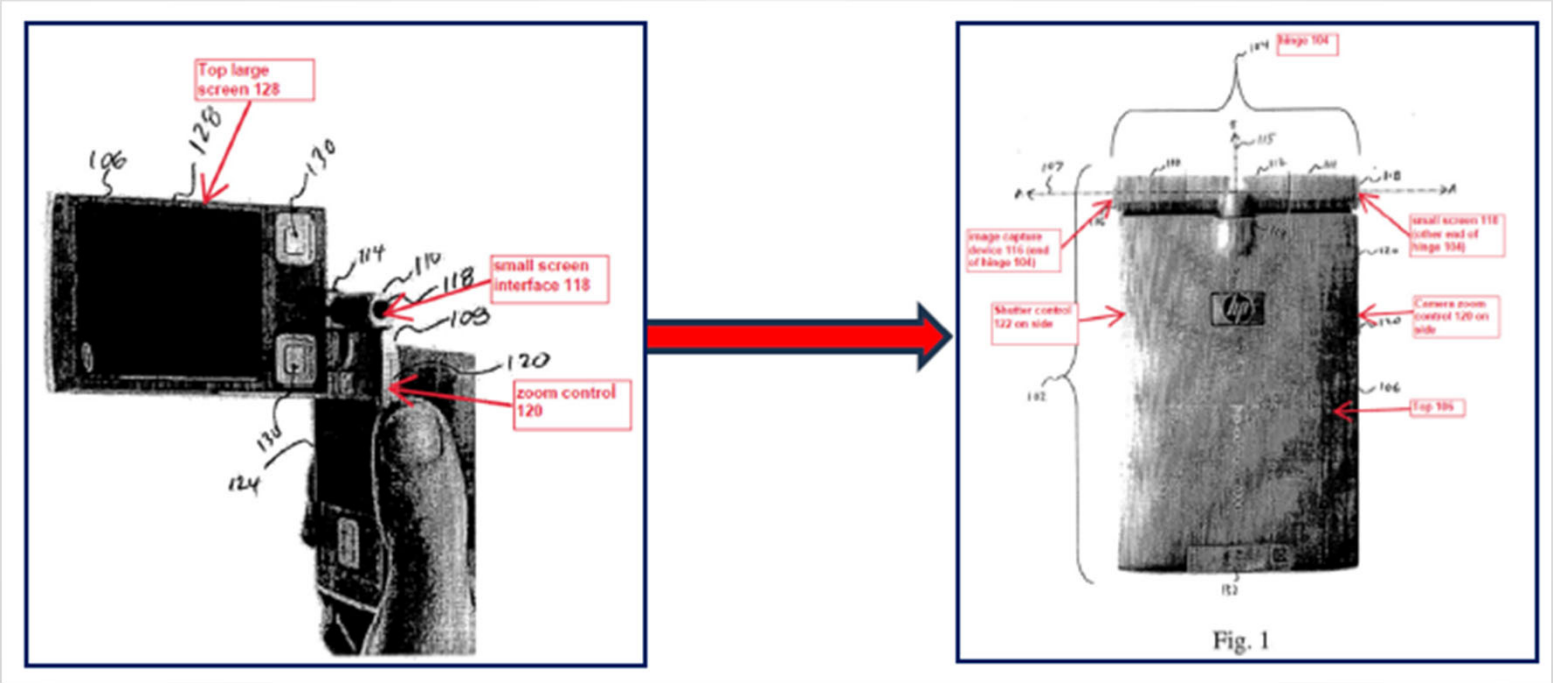
Fact that large screen 128 is folded in Fig. 1 mode does not translate to a disclosure that it does not display an image or that it is turned off or disabled. See Surati Decl., ¶ 218.

POR, 60-66; Sur-reply, 20-22. .

Ground 3: Anticipation by Whitehorn

<u>PO Response</u>: Whitehorn could provide preview image in Fig. 5 mode and upon folding into Fig. 1 mode could continue to provide a preview image.

Whitehorn does not expressly disclose that top large screen 128 does not display an image in first capture mode, as alleged.



POR, 63-64; Surati Decl., ¶ 218.Sur-reply, 20-22. .

Ground 3: Anticipation by Whitehorn

PO Response: The Petition makes no inherency argument, thus it is waived.
POR, 64-65, Sur-reply, 20.

Petitioner's argument that large screen 128 is "not visible" in the First Capture mode (Fig. 1) does not mean it "does not display an image." **Reply, 25; Sur-reply, 21.**

PO's expert Dr. Surati's evidence that large screen 128 could continue to display a preview when changed from the Fig. 5 configuration to the Fig. 1 configuration is not rebutted. **See Reply, 25-27 (no response); Sur-reply, 21-22.**

Thus, Claim 1 is not anticipated because limitation 1E is not disclosed by Whitehorn. Claim 11 is not anticipated because similar limitation 11H is not disclosed.

POR, 63-64; Surati Decl., ¶ 218.Sur-reply, 20-22. .

Ground 3: Anticipation by Whitehorn

<u>Whitehorn fails to disclose limitation 11B</u>:

"wherein the second screen faces an opposite direction from the first screen when the device is closed."

POR, 66-67; Sur-reply, 22-23.

Ground 3: Anticipation by Whitehorn

Pet.: Argues that bottom large screen 124 is "*first screen*" and top large screen 128 is "*second screen.*

Argues that "*wherein the second screen* [top large screen 128] *faces an opposite direction from the first screen* [bottom large screen 128] *when the device is closed"* met by First Image Capture mode of Fig. 1 or Second Handheld mode of Fig. 6, step 610. POR, 67 (citing Pet., 76-77).

PO Response:

(1) In First Image Capture mode of Fig. 1, the bottom screen 124 and the top screen 128 are folded onto each other, so that they are facing each other, not "*fac[ing] an opposite direction*" per limitation 11B.

(2) In the Second Handheld mode of Fig. 6, step 610, the top and bottom screens are "*fac[ing] in opposite direction,*" but device is not operating in an "*image capture mode."* Rather, it is operating as a "handheld tablet computer." See [0030].

POR, 66-67; Sur-reply, 20-22. .

Ground 3: Anticipation by Whitehorn

<u>Whitehorn fails to disclose Claim 4</u>:

"wherein the device is in a landscape or portrait orientation."

POR, 67-69; Sur-reply, 23-26.

Ground 3: Anticipation by Whitehorn

Pet.: Theory #1: Argues in Petition that circular image capture lens 116 in Fig. 3 discloses "*the device is in a . . . portrait orientation.*" Pet., 73.

Theory #2: New argument on Reply that circular small screen 118 in Fig. 4 discloses the "*the device is in a . . . portrait orientation.*" Reply, 28.

PO Response:

(1) Theory #1 (Fig. 3) defective because image capture lens 116 is a camera lens, not a display screen per Claim 4.

(2) Theory #1 (Fig. 3) defective because portrait orientation means "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." Also, defined in relation to "rectangular display." '842 Patent, 3:41-53.

(3) Theory #1 (Fig. 3): Portrait mode defined based on the display, not the device housing. Circular lens 116 (alleged "display") is not a "rectangular display."

POR, 66-67; Sur-reply, 20-22. .

Ground 3: Anticipation by Whitehorn

Pet.: Theory #2: New argument in Reply that circular small screen 118 in Fig. 4 discloses the "*the device is in a . . . portrait orientation.*" Reply, 28.

PO Response:

(1) Theory #2 on reply based on circular small screen 118 in Fig. 4 is waived because is entirely new theory re Pet theory based on lens 116 of Fig. 3.

(2) Theory #2 (Fig. 4) defective because circular small screen 118 is not a "rectangular display."

(3) Theory #2 (Fig. 4) defective because circular small screen 118 does not have a "substantially vertical" dimension that is longer than a "substantially horizontal" dimension. Rather, small screen 118 is circular.

POR, 66-67; Sur-reply, 20-22. .

Ground 3: Anticipation by Whitehorn

<u>Whitehorn fails to disclose Claims 6-7</u>:

Claim 6 *("the device does not display an image on a first screen")*

Claim 7 ("*the first screen is disabled and does not receive user interface input*")

POR, 69-71; Sur-reply, 26-27.

Ground 3: Anticipation by Whitehorn

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).

Sur-reply, 26-27.

Ground 4: Obviousness based on Whitehorn

<u>Whitehorn does not teach or suggest limitation 1E</u>:

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

POR, 71-74; Sur-reply, 27-29.

Ground 4: Obviousness based on Whitehorn

Pet's Core Argument is same as for obviousness re Chin. PO's response is the same.

Pet.: "[A] POSITA would have been motivated to turn off or disable a screen that is not facing the user" to save power. Pet., 83; Rodriguez Decl., ¶ 376.

PO Response:

(1) Proposal is to modify or combine Whitehorn with the feature of "turning off or disabling a screen that is not facing the user." POR, 72-73.

(2) Petitioner and its expert fail to establish it was common knowledge in the art to turn off or disable a screen when it is not facing a user. POR, 73; Sur-reply, 27-28.

(3) Petitioner's expert provides *ipse dixit* testimony unsupported by evidence. Not a single reference is provided in support. Sur-reply, 27-28.

(4) PO's expert provided affirmative evidence that the feature was not common knowledge in the art. Surati Decl., ¶¶ 251-252.

POR, 71-74; Sur-reply, 27-29.

Ground 4: Obviousness based on Whitehorn

<u>Whitehorn fails to teach or suggest Claims 6-7</u>:

Claim 6 *("the device does not display an image on a first screen")*

Claim 7 ("*the first screen is disabled and does not receive user interface input*")

POR, 69-71; Sur-reply, 26-27.

Ground 4: Obviousness based on Whitehorn

Second, Claims 6-7 provide for the first screen "*not display[ing] an image*" and the first screen being "*disabled and [] not receiv[ing] user input*," respectively. For these claims, Petitioners rely on the same argument provided for limitation 1E of independent Claim 1. See Pet., 83. However, the claimed features are not obvious for the reasons set forth above for limitation 1E in Section X.A above. Surati Decl., ¶ 255. As explained in detail there, there is no evidence that it was common knowledge in the art to "turn off or disable a screen that is not facing the user," as alleged. Further, a POSITA would not have reason to make such a modification to Whitehorn. Finally, Petitioners do not address, let alone establish, a reasonable expectation of success for the proposed modification.

POR, 75.

Questions

Further Questions?