

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA MOBILITY LLC and GOOGLE LLC,
Petitioners,

v.

MULTIFOLD INTERNATIONAL INC. PTE. LTD.,
Patent Owner.

Case IPR2025-00038
U.S. Patent No. 8,836,842

**PATENT OWNER REQUEST FOR DIRECTOR
REVIEW OF FINAL WRITTEN DECISION**

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I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.75(a), Multifold International Inc. Pte., Ltd. (“Patent Owner”) requests Director Review of the decision finding all challenged claims unpatentable in the *inter partes* review (“IPR”) of U.S. Patent No. 8,836,842 (the “’842 Patent”). *See* Paper 29 (“Decision” or “FWD”). Motorola Mobility LLC and Google LLC (“Petitioners”) challenged the ’842 Patent.

The Board’s decision rests on fundamental errors of law and an abuse of discretion. The Director should grant this request for Director Review and reverse the Board’s decision.

II. THE INVENTION

The ’842 Patent, which enjoys priority to September 2011, is directed to a foldable dual-screen mobile device having the capability of operating in multiple selectable modes including a camera mode. POR, 2-9. The ’842 Patent was the result of the development of an innovative foldable cellphone with two screens known as the “Imerj dual screen phone” that was the subject of an intensive research and development effort by Flextronics International, Inc. POR, 1.

An exemplary foldable dual screen mobile device is provided in Figure 1 of the ’842 Patent:

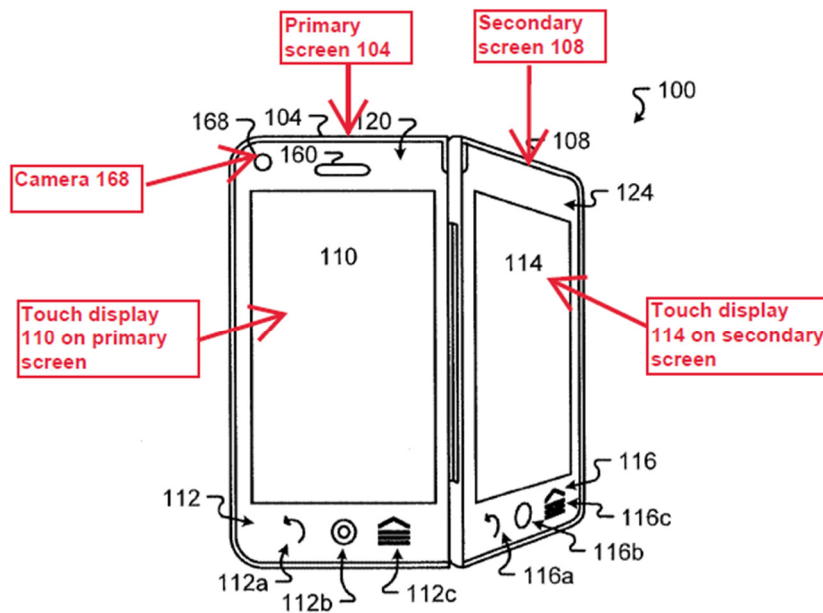


FIG. 1A

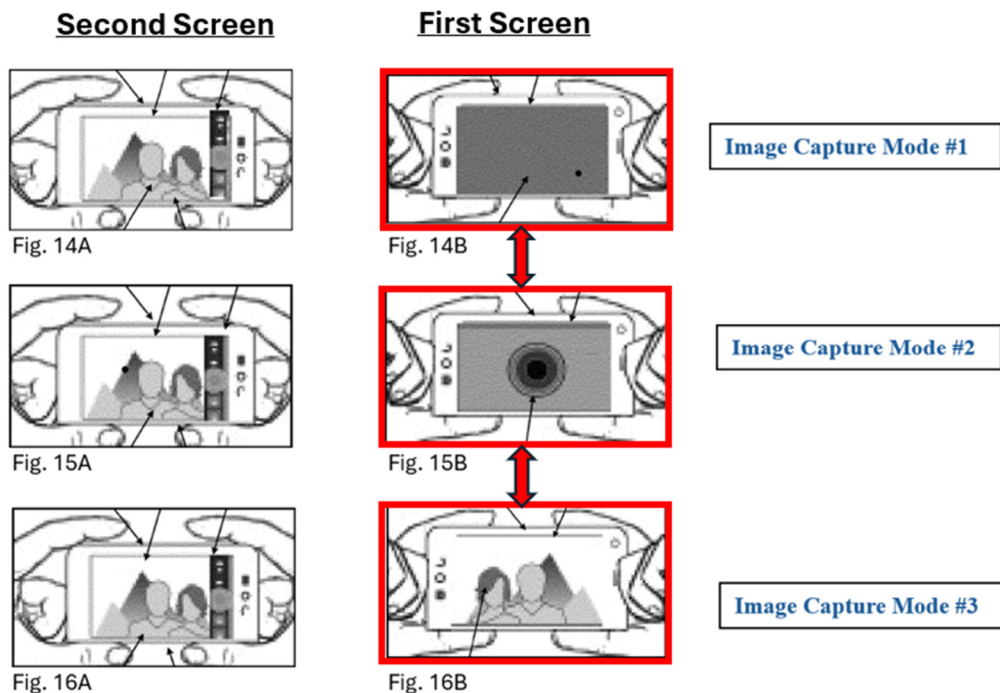
POR, 4.

The disclosed dual screen foldable could operate in different configurations, including (1) the screens being in portrait or landscape mode; (2) the device being in an unfolded open position (e.g., Figure 1) or a folded closed position (Fig. 3A); and (3) the device operating in a self-portrait camera mode (e.g., for taking so-called “selfies”) or an outward-facing camera mode (e.g., for taking a picture of a subject). POR, 4-5.

When in camera mode, the dual-screen foldable device can operate in different “image capture modes” that are set based on various parameters, such as the image capture function (self-portrait vs. outward-facing), device orientation (portrait vs. landscape), and the device state (open vs. closed). POR, 5. An “image

capture mode” defines what type of display is provided on the first screen and what type of display is provided on the second screen. The invention enables the device to provide image capture modes that are tailored to the multiple different configurations the device can take based on the different permutations of the above parameters. POR, 34-35.

For example, Figures 14A-16B of the '842 Patent describe three different image capture modes for the dual-screen device operating in the outward facing camera mode in landscape orientation:



POR, 16-17 (citing Figs. 14A-16B (annotated, excerpted), 33:38-34:8).

In image capture mode #1, the second screen (facing the user) provides a photo preview of the subject of the photo and the first screen (facing the subject) is

blank. In image capture mode #2, the first screen is different because it provides an image of a camera lens to indicate to the subject that a photo is being taken. In image capture mode #3, the first screen is different because it provides a preview to the subject of the photo being taken. POR, 16; '842 Patent, 3:38-34:8.

The disclosure of the various image capture modes image capture modes supports the claim limitation of “*enter[ing] ... one or more image capture modes, wherein in each image capture mode a display on the first screen or second screen is different.*” '842 Patent, Cl. 1. The limitation means that there is a different display on the first screen between image capture modes and/or a different display on the second screen between image capture modes. POR, 21. FWD, 8-9.

III. THE IPR TRIAL

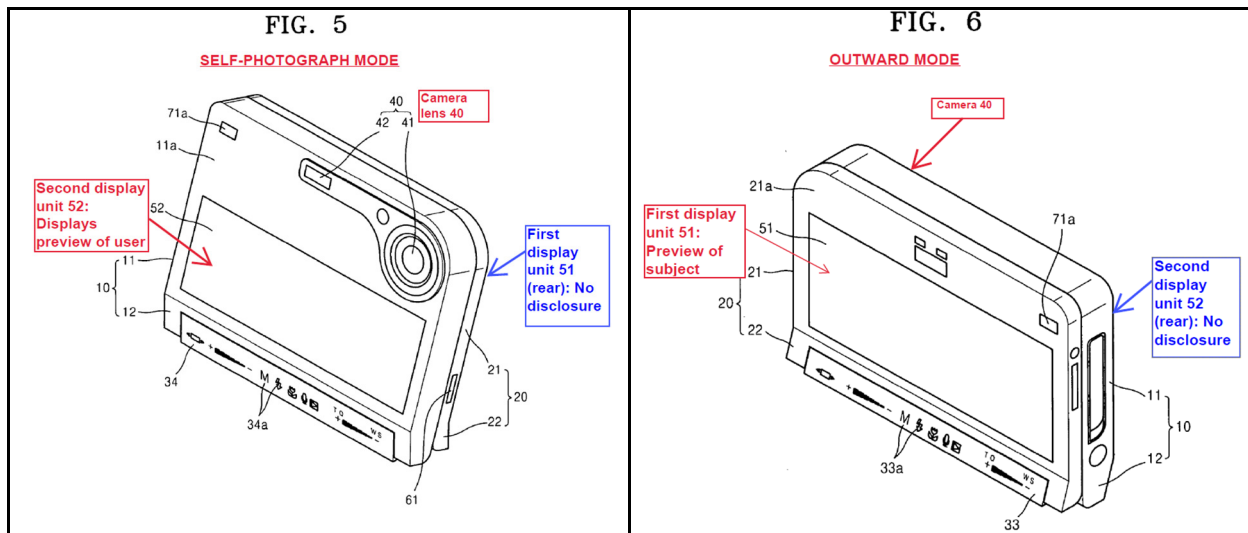
The patentability of challenged independent Claims 1, 11, and 16 turned on whether the prior art disclosed the limitation of the dual-screen device “*entering ... one or more image capture modes, wherein in each image capture mode a display on the first screen or second screen is different.*” (limitation 1(E) of Claim 1).

Petitioners presented four grounds based on just two references, Chin (Ex. 1004) and Whitehorn (Ex. 1005): (1) Ground 1: Claims anticipated by Chin; (2) Ground 2: Claims obvious based on Chin; (3) Ground 3: Claims anticipated by

Whitehorn; and (4) Ground 4: Claims obvious based on Whitehorn. Pet., 6-7.

In its Decision, the Board agreed with Patent Owner that Chin does not anticipate because it fails to disclose that the first screen provided a different display between configurations or that the second screen provided a different display between configurations, and therefore it did not meet the limitation 1(E) for “*entering ... one or more image capture modes, wherein in each image capture mode a display on the first screen or second screen is different.*” FWD, 20.

The Petitioners had argued that Chin disclosed a first image capture mode that was the self-photographing mode of Figure 5. In that mode, Chin discloses that the display unit 52 facing the user provides a preview of the user (e.g., for a selfie), but Chin is silent as to what, if anything, is displayed on the opposing display unit 51, as illustrated below. Petitioners argued that Chin disclosed a second capture mode that was the outward-facing mode of Figure 6. In that mode, Chin discloses that display unit 51 facing the user displays a preview of the subject of the photo, but Chin is silent as to what, if anything, is displayed by the opposing display unit 52 (as noted below in blue on the right hand side). POR, 35-38, 41-44.



POR, 28, 35-38, 41-44.

Accordingly, Chin did not meet limitation 1(E) because it did not disclose that the display on screen 51 was different between Figure 5 and Figure 6 or that the display on screen 52 was different between Figure 5 and Figure 6. The Board explained:

As explained above, Chin's disclosure is silent regarding what is or is not displayed on first display 51 when images are displayed on second display 52 in self-photographing mode, and similarly silent regarding what is or is not displayed on second display 52 when images are displayed on first display 51 in outward-facing mode. ... For the forgoing reasons and based on the entire record developed during trial, the preponderance of the evidence does not support Petitioner's showing that Chin discloses "wherein in each image capture mode a display on the first or second screen is different." Accordingly ..., the preponderance of the evidence does not support Petitioner's showing

that Chin anticipates claim 1.
FWD, 20.

The other reference in this IPR, Whitehorn, suffered the same deficiency in that it described two image capture modes but failed to disclose that one of the screens provided a different display between the two image capture modes to meet limitation 1(E). POR, 61-66. The Board thus agreed that Whitehorn, like Chin, was missing limitation 1(E). FWD, 45-46.

Accordingly, the anticipation grounds based on Chin (Ground 1) and Whitehorn (Ground 3) each failed because those references were missing limitation 1(E) for the dual-screen device “*entering ... one or more image capture modes, wherein in each image capture mode a display on the first screen or second screen is different.*” FWD, 20, 45-46.

Petitioners’ obviousness ground based on Chin (Ground 2) and the obviousness ground based on Whitehorn (Ground 4) had to address the aforementioned missing limitation.

IV. THE BOARD ERRED IN PERMITTING PETITIONERS’ EXPERT TO SUPPLY A MISSING CLAIM LIMITATION THAT WAS NOT FOUND IN ANY PRIOR ART OF RECORD.

As discussed above in Section III, Chin fails to disclose or suggest the limitation of “*entering ... one or more image capture modes, wherein in each image capture mode a display on the first screen or second screen is different*”

found in the independent claims.¹ To supply the missing limitation, Petitioners proposed that a POSITA would modify the Chin device to incorporate the feature of the dual-screen device “turning off or disabling” a display screen when it is “not facing a user.” Pet., 55. However, there was no showing that such a feature was known in the prior art other than Petitioners’ expert’s *ipse dixit* assertion that was untethered to **any** supporting evidence. The Board’s decision finding the missing limitation based on the expert’s unsupported assertion that the feature was known in the art was an error of law and abuse of discretion.

The fundamental framework for AIA post-grant reviews—that the challenged claim must be shown unpatentable based on the **prior art**—will be undone if experts can supply claim limitations without any evidentiary support.

¹ Whitehorn has the very same deficiency. Petitioners proposed modifying Whitehorn by the same feature proposed for Chin. The Board recognized that the analysis is the same for the two obviousness grounds. FWD, 46-49.

A. The Board Erred By Allowing The Missing Limitation To Be Supplied by Petitioners’ Expert Declaration’s *Ipse Dixit* Assertion of an Alleged Prior Art Feature Untethered to Any Supporting Evidence.

For Chin, Petitioners argued that the missing limitation could be supplied by modifying the Chin device with the feature of the dual-screen device “turn[ing] off or disabl[ing] a screen that is not facing the user” in order to save battery power. Ex. 1003 (Rodriguez Decl.), ¶ 258; Pet., 55 (“[A] POSITA would have been motivated to turn off or disable a screen that is not facing the user.”). However, Petitioners’ expert did not cite *any evidence* supporting the assertion that the feature of turning off/disabling a screen not facing a user was known in the art in September 2011. Rodriguez Decl.), ¶ 258 (no evidence cited).

Indeed, the expert’s declaration includes a background section that cites five separate prior art references that allegedly represent the state of the art of dual-screen devices in 2011—Aono (Ex. 1006), Lee (Ex. 1009), Kim (Ex. 1010), Kawaski (Ex. 1011), and Park (Ex. 1012). POR, 55 (citing Rodriguez Decl., ¶¶ 62-66)). But none of these references disclosed the alleged prior art feature used to modify Chin, and, indeed, the expert did not cite any of them to support his assertion that the feature was known in the prior art. Rodriguez Decl., ¶ 258 (no citation of evidence). POR, 55-56; Sur-reply, 17. The expert admitted in deposition that these references did not teach the feature he asserted was known in the art. Ex.

2011 (Dep. Trans. Rodriguez), 43:20-48:4. Petitioners' expert also did not provide any evidence that he had personal knowledge that the alleged feature was known in the art in 2011. See Rodriguez Decl., ¶ 258.

After Patent Owner raised this deficiency in its POR, Petitioners' expert could have submitted a supplemental reply paper citing prior art establishing that the feature was known in the art in September 2011. But he did not. Likewise, Petitioners themselves did not submit on reply any evidence showing that the feature was known in the art.

Petitioners' and their expert's silence on reply was an admission that it was not known in the art to "turn off or disable a screen that is not facing the user" in a dual-screen device in 2011. The Petitioners failed to establish that the feature used to modify the Chin reference was known in the art, and, accordingly, the obviousness theory should have been rejected by the Board.

B. The Board Committed Legal Error by Disregarding Federal Circuit Law that an Expert Can Supply a Missing Limitation Only If Corroborated by Evidence Establishing the Feature was Known in the Art as of the Priority Date.

The Federal Circuit has held that, in certain circumstances, an expert can supply a missing claim limitation if it is established as being known in the art as of the priority date. For example, in *Koninklijke Philips N.V. v. Google LLC*, the Federal Circuit held that it was permissible for a limitation missing from the SMIL

1.0 reference to be satisfied by an expert declaration establishing that the feature of “pipelining” was known in the art as corroborated by the prior art Hua reference. 948 F.3d 1330, 1336-37 (Fed. Cir. 2020) (expert declaration citing to Hua for feature of pipelining); *Google Inc. v. Koninklijke Philips N.V.*, IPR2017-00447, Petition, Paper 2 at 43 (PTAB Dec. 9, 2016) (citing expert declaration that a POSITA would have modified SMIL 1.0 with the well-known feature of pipelining as shown by Hua).

In contrast to *Koninklijke*, Petitioners’ expert did not establish that the feature of turning off/disabling a screen not facing the user was known in the art as of the 2011 priority date. The expert did not cite any prior art or any other evidence showing that the feature was known. See Rodriguez Decl., ¶ 258 (no citation of evidence). Accordingly, the expert’s *ipse dixit* testimony cannot supply the missing claim limitation.

The Federal Circuit’s recent *Shockwave* decision does not alter the result. In *Shockwave*, the Court held that applicant admitted prior art (“AAPA”) could be used to supply a missing claim limitation. *Shockwave Med. Inc., v. Cardiovascular Sys., Inc.*, 142 F.4th 1371, 1378 (Fed. Cir. 2025). In *Shockwave*, the feature used to modify the main reference was indisputably known in the prior art—because it was

AAPA. In this IPR, the feature proposed to modify the Chin reference is not prior art and thus may not be used to fill the missing claim limitation.

C. The Board Erred in Asserting that 37 C.F.R. § 42.104(b)(4) Does Not Require Each Claim Limitation to Be Found in the Prior Art.

The Board defends its decision on this basis: “We also do not agree with Patent Owner’s suggestion that 37 C.F.R. § 42.104(b)(4) requires each and every limitation to be explicitly taught in the prior art.” FWD, 23. By its words, Rule 42.104(b)(4) requires that the petition “specify where each element of the claim is found in the prior art [patents or printed publications relied upon].”

Prior to the Director’s “Enforcement and Non-Waiver of 37 C.F.R. § 42.104(b)(4)” memorandum of July 31, 2025, the Board did not always rigorously enforce the requirement that each claim element must be found in the prior art patents or printed publications of the ground. But there is no doubt that it has *always been the case* that each element of the claim must be established as being found in the *prior art*. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) (“differences between the *prior art* and the claims at issue are to be ascertained”). *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 404 (2007) (required showing of combining or modifying “the *prior art* teachings”). 35 U.S.C. §§ 102, 311(b). The Board’s position that each element of the claim need not be shown to exist in the prior art is a clear error of law.

The Board's citation to *Perfect Web Techs. Inc. v. InfoUSA, Inc.*, 587 F.3d 1324 (Fed. Cir. 2009) is off the mark. FWD, 23. *Perfect Web* holds that the motivation to repeat three *prior art* steps A-C in a method could be supplied by common sense. The case does not ratify the "use of common sense to supply [a] missing limitation" in the reference, as the Board asserts. FWD, 23. In *Perfect Web*, the question was whether a POSITA would have been motivated to repeat prior art steps A-C. *Id.* The modification was made using known prior art, not a feature that is not found in the prior art like this IPR.

D. It Was Legal Error and An Abuse of Discretion to Apply an Expert Assertion Untethered to Facts to Supply a Missing Claim Limitation.

The general rule is that expert testimony not disclosing underlying facts or data is entitled to no weight. 37 C.F.R. § 42.65(a); Fed. R. Evid. 702(b). Proper application of this rule is particularly important when expert testimony is being offered to supply a claim limitation missing from the patents or printed publications of the IPR ground. It was an abuse of discretion for the Board to adopt Petitioners' expert's assertion of a missing claim limitation when no supporting evidence was provided that the feature was known as of the priority date in 2011.

The Federal Circuit has regularly rejected conclusory *ipse dixit* testimony of an expert that is not tethered to supporting evidence. *TQ Delta, LLC v Cisco*

Systems, Inc., 942 F.3d 1352, 1362 (Fed. Cir. 2019) (rejecting “Dr. Tellado’s *ipse dixit* declaration” that was “[u]ntethered to any supporting evidence”) (cite omitted). More recently, the Federal Circuit held that an expert’s *ipse dixit* testimony asserting that a reference disclosed missing claim elements was properly disregarded because it “is only conclusory with inadequate supporting evidence.” *iRobot Corp. v. SharkNinja Operating LLC*, 2024 WL 3687981, at *5 (Fed. Cir. Aug. 7, 2024).

Here, the Board disputes that Petitioners’ expert’s testimony “amounts to *ipse dixit*.” FWD, 23-34. The Board quotes several of the expert’s assertions, but the relevant paragraphs of the expert’s declaration have no citation to a reference or even citation to personal knowledge. See Rodriguez Decl., ¶¶ 258 (no evidence cited for alleged prior art feature of “turn[ing] off or disab[ling] a screen that is not facing the user ... to save power”). That is the quintessential *ipse dixit*—the expert is making an assertion that is untethered to any supporting evidence. *TQ Delta*, 942 F.3d at 1362 (expert assertion is *ipse dixit* because it is “[u]ntethered to any supporting evidence”).

The decision in *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 12, at *6 (Director Aug. 24, 2022) (precedential) is particularly on point. In *Xerox*, the Terrell reference did not teach the limitation of a server configured to “store in a

data record associated with the user account a data value indicating the fraudulent activity.” The Director rejected the Petitioner’s attempt to use the expert to supply the missing claim limitation because “the cited declaration testimony is conclusory and unsupported.” *Id.* That is precisely the case in the present IPR. The Board committed an error of law and abused its discretion in applying the expert’s unsupported statement to supply the missing claim limitation necessary to find the claims unpatentable.

V. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests Director Review of the Board’s decision and a determination that the FWD should be reversed.

Respectfully submitted,

/Stephen T. Schreiner/
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Date: June 15, 2026

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This paper contains 15 pages, excluding table of contents, table of authorities, certificate of service, this certificate, or table of exhibits. This paper complies with the type-volume limitation of 15 pages as mandated in 37 C.F.R. § 42.24(a)(1)(v).

Respectfully submitted,

/Stephen T. Schreiner/

Date: June 15, 2026

CERTIFICATE OF SERVICE

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

**PATENT OWNER REQUEST FOR DIRECTOR REVIEW
OF FINAL WRITTEN DECISION**

The names and address of the parties being served are as follows:

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