

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

**PETITIONERS' AUTHORIZED RESPONSE TO
PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW
OF THE FINAL WRITTEN DECISION**

I. INTRODUCTION

This IPR involves two prior art references that each disclose a portable electronic device with two screens. The Board found that both references teach a first screen showing an image preview and a second screen that would be in one of two states: on or off. Final Written Decision, Paper 29, at 14, 22–25, 41–42, 47–49 (May 15, 2026) (“FWD”). These factual findings, supported by the disclosures of the references themselves and both parties’ experts’ testimony about how a POSITA would understand the references, were not disputed by Patent Owner (“PO”) before the Board and are not challenged in the Request for Director Review.

In an entirely unremarkable obviousness analysis, the Board found that it would have been obvious to a POSITA for the second screen, which could be either on or off, to be off. The Board found a POSITA would have been motivated to conserve battery power by turning off or disabling this unused second screen, another finding supported by both experts’ testimony and not challenged in the Request for Review. And, because it would have been obvious to a POSITA for the second screen to be off, the subject matter of the challenged independent claims as a whole was unpatentable (FWD, 25–26, 49–50).

In the face of this record, PO warns that the FWD will “undo[]” the “fundamental framework for AIA post-grant reviews.” Director Review Request (“Request”), 8. This hyperbole is detached from the record. Petitioners’ expert did

not “supply the missing claim limitation” at all and certainly did not do so based on “*ipse dixit*.” *See id.* Just as it did before the Board, and as the Board recognized (FWD, 25, 49), PO’s argument is knocking down a straw man: PO argues against an obviousness theory that the Petition did not present or need to present, ignoring the actual obviousness analysis of the Petition and FWD, which fully aligns with precedent, along with the unchallenged factual support for that analysis.

The Director Review Request shows no legal error or abuse of discretion and should be denied.

II. STANDARD FOR DIRECTOR REVIEW

Director Review of a FWD is available in limited circumstances and is not proper simply because a patent owner disagrees with the outcome of an *inter partes* review. “Director Review of a Board’s final decision ... shall be limited to decisions presenting (a) an abuse of discretion, (b) important issues of law or policy, (c) erroneous findings of material fact, or (d) erroneous conclusions of law.” U.S. PATENT & TRADEMARK OFFICE, DIRECTOR REVIEW PROCESS § II.B (2026), www.uspto.gov/patents/ptab/decisions/director-review-process.

III. THE BOARD CORRECTLY CONCLUDED THAT THE CHALLENGED CLAIMS ARE UNPATENTABLE

In a thorough 58-page opinion, the Board correctly concluded that Petitioners demonstrated by a preponderance of the evidence that claims 1–7, 10–13, 16, 17, 19, and 20 of U.S. Patent No. 8,836,842 (“the ’842 patent”) are unpatentable under 35

U.S.C. § 103. The Board relied on two single-reference obviousness grounds: Chin (US 2009/0190295 A1) and Whitehorn (US 2005/0078211 A1). FWD 57–58.

Claim 1, reproduced below, is representative for purposes of this Response. The central disputed limitation, and only limitation addressed in the Director Review Request, is the final clause, “wherein in each image capture mode a display on the first or second screen is different.”

1. A method, comprising:

providing a device having at least first and second screens;

receiving user interface input to execute an image capture function;

determining one or more of an image capture function configuration, a device orientation, and a device state; and

based on one or more of the image capture function configuration, the device orientation, and the device state, entering one of one or more image capture modes, *wherein in each image capture mode a display on the first or second screen is different.*

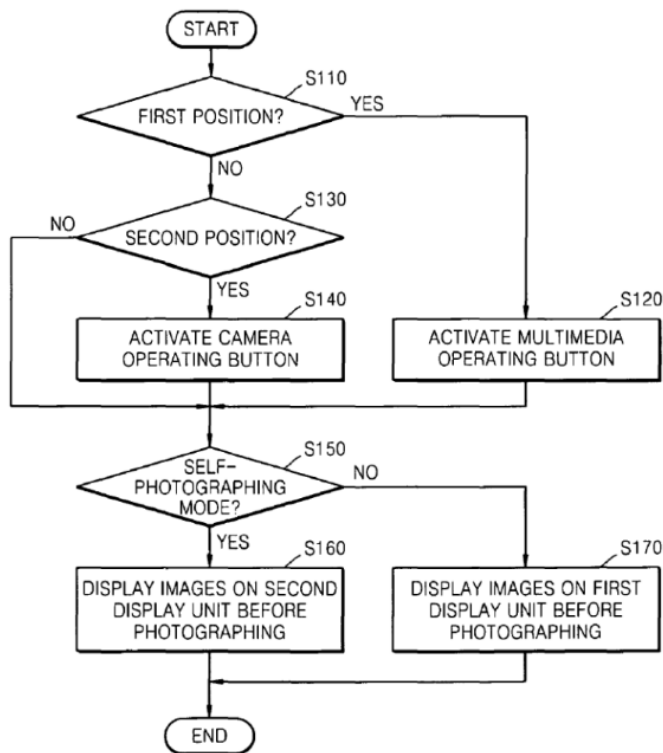
A. The Board’s Obviousness Finding Is Supported By Undisputed Facts, and The Board Did Not Rely on Expert Testimony to Supply a “Missing Limitation”

Contrary to PO’s assertions (*see* Request, 7–12), Petitioners and the Board did not rely on expert testimony to supply a “missing limitation.” PO’s Request for Review rests on a fundamental mischaracterization of Petitioners’ argument and the

Board’s analysis. PO frames Petitioners’ argument as modifying the Chin / Whitehorn devices by “turning off or disabling a screen that is not facing the user.” Request, 7–10. But the Petition never proposed a modification requiring the device to detect whether a screen is “facing a user” and then decide to turn it off on that basis. The Board recognized this, finding that “Patent Owner’s arguments are misplaced because the arguments focus on a modification to the teachings of [the prior art] not proposed by Petitioner.” FWD, 25 (discussing Chin); *see also* FWD, 49 (discussing Whitehorn). The Board rejected PO’s “facial recognition” straw man argument: “the proposed combination does not propose a complex modification involving facial recognition technology (e.g., detect the presence or absence of a user’s face).” FWD, 25.

Petitioners’ actual argument is far simpler. Chin and Whitehorn each explicitly disclose an electronic device that enters into one of two image capture modes; this is not disputed. Petition, 13, 65–66; PO Resp., 36, 38, 64. Chin also explicitly discloses that, in one mode (“self-photographing”), a preview image is shown on the *second* display unit, and in the other mode, a preview image is shown on the *first* display unit. Petition, 29–30; PO Resp., 36, 38. This is depicted in Figure 9 of Chin, reproduced below, at Steps S160 and S170, and the accompanying text of the specification, and is also not disputed. *See* Petition, 31 (citing Ex. 1004, Fig. 9, [0078]–[0079]). Whitehorn has a similar disclosure of the preview image

being displayed on different screens in the two different modes. *See* Petition, 58 (citing Ex. 1005, Fig. 6, [0016], [0021], [0026]).



Ex. 1004, Fig. 9.

Petitioners argued that, in light of the express disclosures in Chin and Whitehorn, it would have been obvious to a POSITA for both screens to not show the same preview image at the same time, thereby meeting the claim language (the “display on the first or second screen is different” in each image capture mode). Petition, 54–55, 82–83. That is, where Chin and Whitehorn disclose that screen one displays a preview, and do *not* disclose that screen two displays a preview, it would at least have been obvious to a POSITA for screen two to not display a preview (e.g., by being turned off or displaying nothing).

Using the references’ own disclosures—not external evidence—Petitioners and their expert explained that “[b]ecause Chin [and Whitehorn] specif[y] that the preview is shown on one screen or the other, and not on both screens in both modes, it is at least suggested and would have been obvious to a POSITA that the display on each of the screens changes between modes. Indeed, *a POSITA would have understood that the screen not described as showing the preview would either be on or off.*” Petition, 55 (emphasis added). Far from being “missing,” the option to turn off an unused screen would have been apparent to a POSITA from Chin and Whitehorn’s express disclosures that one screen shows a preview and which screen that is depends on the device’s mode. Dr. Rodriguez’s testimony is tethered to the references’ disclosures: their flowcharts (Ex. 1004, Chin Fig. 9; Ex. 1005, Whitehorn Fig. 6) specify which screen displays the preview in each mode and Dr. Rodriguez explained that a POSITA reading those flowcharts would understand that the undescribed screen could be off. FWD, 24 (citing Ex. 1003 ¶ 257). PO’s own expert confirmed this, admitting that “[t]here’s nothing in Chin that discloses that the first display unit would display an image in the self-photographing mode” and that “it is a choice that could be made” for that screen to display nothing. Ex. 1015, 51:18–22, 52:6–11.

In view of this undisputed evidence, the Board had good reason to conclude that “a POSITA would have understood that the screen not described as showing the

preview would have one of two states: either on or off.” FWD, 24 (emphasis removed) (quoting Ex. 1003 ¶ 257); *see also* FWD, 48 (quoting Ex. 1003 ¶¶ 375–76). Indeed, the agreed-upon POSITA possesses “at least a bachelor’s degree in electrical engineering, computer engineering, computer science, or a related field plus at least two years of work or post-graduate experience in image capture, image processing, image display, user interfaces, or a related field.” FWD, 9–10; PO Resp. 25 (accepting this definition). An engineer with this background would know that a screen could be turned off.

The Board then looked to Petitioners’ expert testimony to provide a motivation to exercise the option of turning off the screen and a reasonable expectation of success in doing so. *See* FWD, 25, 49. The Board found that it was undisputed that “[i]n 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.” FWD, 24 (quoting Ex. 1003 ¶ 257); *see also* FWD, 48 (quoting Ex. 1003 ¶ 376). PO’s expert admitted that “[i]n 2011, around the time of the ’842 patent’s invention, the battery capacity of mobile devices was limited” and that “at least one reason why you might in some circumstances want to turn off a screen that’s not being viewed is to save battery life.” Ex. 1015, 85:12–16, 86:11–16. The Board correctly found that Petitioners provided sufficient evidence that “it would have been obvious to a person of ordinary skill in the art to modify [each

reference’s] teachings to turn off or disable the display screen not described as showing a preview (i.e. facing away from the user in each mode) in order to save power” and that a POSITA would have a reasonable expectation of success “because doing so would have been a simple modification (e.g., use of a power source switch for a display screen) well within the skill level of one with ordinary skill in the art.” FWD, 25 (discussing Chin); *see also* FWD, 49 (discussing Whitehorn).

These undisputed facts map directly onto the *Graham* framework for obviousness. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). A POSITA would have known how to turn off the unused screen in Chin and Whitehorn, would have been motivated to do so because turning off the screen would conserve limited battery power, and would have expected success because the modification is “well within the skill level of one with ordinary skill in the art.” FWD, 25–26, 49–50. PO does not challenge any of these factual findings.

B. The Board Correctly Applied Obviousness Caselaw

PO’s legal arguments all rest on its faulty premise that the Board needed to supply a “missing limitation,” which is incorrect, as explained above. In making this argument, PO insists that each and every claim limitation appear explicitly in a prior art patent or printed publication, with no role for a POSITA’s knowledge, creativity, or common sense. The Supreme Court and Federal Circuit have repeatedly rejected

this rigid framework. The Board committed no legal error and PO's caselaw does not prove otherwise.

1. Obviousness May Be Based on a Single Reference

“A claim can be unpatentable as obvious in light of a single prior art reference if it would have been obvious to modify that reference to arrive at the claimed invention.” FWD, 23 (citing *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324 (Fed. Cir. 2009)); *see also B/E Aerospace, Inc. v. C&D Zodiac, Inc.*, 962 F.3d 1373, 1379–81 (Fed. Cir. 2020). Courts need not demand a second reference to suggest a modification to a reference where “the background knowledge, creativity, and common sense of the person of ordinary skill” can supply the factual basis for the obviousness argument. *Perfect Web*, 587 F.3d at 1329 (citing *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418–21 (2007)).

Perfect Web, which was cited by the Board (FWD, 23) and summarily dismissed by PO as irrelevant (Request, 13), provides ample support for the Board's analysis. In *Perfect Web*, the Federal Circuit held that an obviousness analysis “may include recourse to logic, judgment, and common sense available to the person of ordinary skill that do not necessarily require explication in any reference or expert opinion.” 587 F.3d at 1329. Using this rule, the court affirmed the use of common sense to modify a prior art reference to supply a single missing step in a claimed method, emphasizing that the technology was simple, the level of ordinary skill was

modest, and the expert evidence—while “not necessary”—“fully support[ed] the district court’s conclusion.” *Id.* at 1330. The record in the present case is even stronger: the modification is not wholly “missing” because a screen being off is suggested in the reference itself, the modification of turning a screen off is extremely simple, and the modification is supported by unrebutted expert testimony. PO ignores the clear directive of *Perfect Web*, instead quibbling with the facts and incorrectly asserting that the case “does not ratify the ‘use of common sense to supply [a] missing limitation’ in the reference.” Request, 13 (alteration in original).

The Federal Circuit has also recently reaffirmed *Perfect Web*’s holding in *B/E Aerospace*. There, the court affirmed the Board’s invocation of common sense to modify a reference to supply a “second recess” limitation, finding the Board’s approach proper because (1) “the evidence shows that the technology of the claimed invention is simple” and (2) the Board relied on “detailed expert testimony.” *B/E Aerospace*, 962 F.3d at 1380 (holding that common sense must be “properly accompanied by reasoned analysis and evidentiary support”). Again, the same two conditions apply in this case: the technology—turning off a screen—is simple, and the Board relied on Dr. Rodriguez’s detailed, corroborated testimony. FWD, 23–26, 47–50.

2. PO Cites Inapposite Caselaw and Argues for a Rigid, Pre-KSR Test for Obviousness

In *KSR*, the Supreme Court reversed the Federal Circuit for employing a rigid “teaching, suggestion, or motivation” test, instead focusing on an “expansive and flexible” approach to obviousness. 550 U.S. at 415. The Court held that “[t]he obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents.” *Id.* at 419. Instead, one must look to “interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art.” *Id.* at 418. The Court admonished the Federal Circuit that a POSITA is “a person of ordinary creativity, not an automaton,” and “[r]igid preventative rules that deny factfinders recourse to common sense” are “neither necessary under our case law nor consistent with it.” *Id.* at 421.

PO’s caselaw arguments run directly counter to *KSR*’s directive. PO strings together purported factual comparisons between its cited cases and this IPR proceeding, but none of the cases suggest any legal error. At most, PO’s arguments amount to a disagreement with the Board’s weighing of the evidence—precisely the type of outcome-based complaint that Director Review is not designed to address.

Start with *TQ Delta, LLC v. Cisco Systems, Inc.*, 942 F.3d 1352 (Fed. Cir. 2019). PO cites *TQ Delta* for the proposition that “[t]he Federal Circuit has regularly rejected conclusory *ipse dixit* testimony of an expert that is not tethered to supporting evidence.” Request, 13. There, the Federal Circuit rejected the Board’s obviousness determination because the expert declaration “fail[ed] to provide any meaningful explanation for why one of ordinary skill in the art would be motivated to combine these references at the time of this invention.” *TQ Delta*, 942 F.3d at 1362 (emphasis removed and citation omitted). His testimony was “[u]ntethered to any supporting evidence,” citing no contemporaneous evidence and offering no factual basis. *Id.* Dr. Rodriguez’s testimony is nothing like that of *TQ Delta*. Dr. Rodriguez identifies specific motivating facts—such as limited battery capacity in 2011 and power savings from disabling an unused screen—and ties each to the disclosures of Chin and Whitehorn. Ex. 1003 ¶¶ 257–58, 375–76. PO’s own expert confirmed every one of these facts. Ex. 1015, 85:12–16, 86:11–16.

PO’s citation of *iRobot Corp. v. SharkNinja Operating LLC*, 2024 WL 3687981 (Fed. Cir. Aug. 7, 2024), is equally inapposite. There, the Board properly disregarded expert testimony that was “only conclusory with inadequate supporting evidence.” *iRobot*, 2024 WL 3687981, at *5. The expert in *iRobot* recited claim elements and source code files but never explained what a POSITA would have understood from those files. *Id.* Here, Dr. Rodriguez explains *why* a POSITA would

make the modification, grounding each assertion with the reference’s disclosures and the contemporaneous technical landscape. The Board credited that testimony as evidence of a POSITA’s “knowledge, creativity, and common sense.” FWD, 24, 48.

Next, PO attempts to distinguish *Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330 (Fed. Cir. 2020) by pointing out that the expert there cited a corroborating prior art reference and demanding that Petitioners’ expert must have done the same. Request, 11. But *Koninklijke* imposed no requirement that experts must cite a corroborating prior art reference. And the Federal Circuit’s recent decision in *Shockwave Medical Inc. v. Cardiovascular Systems, Inc.*, 142 F.4th 1371 (Fed. Cir. 2025), confirms the point: “general background knowledge”—in that case applicant admitted prior art—can be used in an IPR for “furnishing a motivation to combine, or supplying a missing claim limitation.” *Shockwave*, 142 F.4th at 1378–79 (citations omitted). PO’s demand for a separate corroborating reference finds no support in the caselaw.

3. The USPTO Memo Does Not Show Legal Error

PO invokes the Director’s “Enforcement and Non-Waiver of 37 C.F.R. § 42.104(b)(4)” memorandum of July 31, 2025 (“Memo,” available at https://www.uspto.gov/sites/default/files/documents/aapa_memo_final__signed.pdf). Request, 12. But this memo does not show any error by the Board or change the outcome in this case.

First, the Memo does not apply. By its express terms, it governs only petitions “filed on or after September 1, 2025.” Memo, 3. The Petition in this case was filed in October 2024—nearly a year before the Memo’s effective date. PO does not explain why a prospective policy should retroactively govern this proceeding, and there is no basis for applying it here. Not only that, but retroactively applying a prospective policy change, particularly without notice to Petitioners, would violate the Administrative Procedure Act. *See Bowen v. Georgetown Univ. Hosp.*, 488 U.S. 204, 208 (1988) (retroactive agency rules only permissible when expressly authorized by statute); *c.f.* 5 U.S.C. § 551(4) (defining “rule” as having “future effect”).

Second, even if the Memo applied, Petitioners satisfy its terms. The Memo prohibits using general knowledge to “supply a missing claim limitation” but expressly permits general knowledge “to support a motivation to combine or to demonstrate the knowledge of a person having ordinary skill in the art.” Memo, 1. That is exactly how the Board used the expert testimony here: (1) to demonstrate what a POSITA would understand from Chin’s and Whitehorn’s own disclosures—namely, that the non-preview screen would be either on or off—and (2) to establish motivation to turn it off (saving battery power). FWD, 24–26, 48–50. Both uses are undisputed and squarely within the limits of the Memo.

Third, the Memo itself acknowledges *Shockwave's* holding that general background knowledge may supply a claim limitation when the patent owner does not argue the limitation was novel. Memo, 3 n.2 (citing *Shockwave*, 142 F.4th at 1380). PO has never argued that turning off a screen was a novel feature of the '842 patent—and for good reason, given that both experts agree it was known.

IV. **CONCLUSION**

Because PO failed to show that the FWD contained an abuse of discretion, important issues of law or policy, erroneous findings of material fact, or erroneous conclusions of law, its Request for Director Review should be denied.

Dated: June 23, 2026

By: */T. Vann Pearce, Jr./*

T. Vann Pearce, Jr. (Reg. No. 58,945)

Counsel for Petitioner Motorola Mobility LLC

CERTIFICATE OF SERVICE

The undersigned hereby confirms that the foregoing paper was caused to be served on June 23, 2026 via electronic mail, upon the following attorneys of record for the Patent Owner:

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/s/ Courtney Hsieh

Courtney Hsieh, Paralegal