

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 IPR2025-00040
U.S. Patent No. 9,134,756

**PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW OF
THE FINAL WRITTEN DECISION**

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I. INTRODUCTION

Patent Owner Multifold International Inc. Pte. Ltd. (“Multifold”) respectfully requests Director review of an issue foundational to *inter partes* review: If a petitioner does **not** include or address a claim element in the petition, may PTAB judges institute and issue a final written decision of their own design by looking for evidence of that element’s invalidity elsewhere in the petition and prior art? The Supreme Court and Federal Circuit have repeatedly held “no.” *SAS Institute Inc. v. Iancu*, 584 U.S. 357, 365 (2018); *Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330, 1336 (Fed. Cir. 2020); *Netflix, Inc. v. DivX, LLC*, 84 F.4th 1371, 1378-79 (Fed. Cir. 2023); *M&K Holdings, Inc. v. Samsung Electronics Co., Ltd.*, 985 F.3d 1376, 1385 (Fed. Cir. 2021); *In re IPR Licensing, Inc.*, 942 F.3d 1363, 1369-70 (Fed. Cir. 2019); *MModal LLC v. Nuance Communications, Inc.*, 846 Fed.Appx. 900, 906 (Fed. Cir. 2021).

But here, after acknowledging in its final written decision that the Petition omitted a limitation of the independent claims, the panel took it upon themselves to look for evidence of that limitation. The behavior of the panel illustrates the problem of confirmation bias that can occur the panel that institutes the proceeding is the panel that renders the final written decision. Here, the panel would be effectively admitting that institution never should have occurred if its final written decision held that the Petition failed because it did not address a claim limitation.

Respectfully, the Director should grant review and affirm that the Board does not have discretion to invalidate claims where the petition did not address every limitation.

II. ARGUMENT

A. Google and Motorola's Petition did not address every limitation of independent claims 1 and 7

Claim 1 of U.S. Patent 9,134,756 (the "'756 Patent) recites:

1. A method of displaying a plurality of desktops and/or applications, each having at least one window, on a multi-display device, comprising:

[1] receiving, by a processor, a first input that represents an instruction to reveal one of a desktop or application on a first display of the multi-display device;

[2] selecting, by the processor, a first desktop or application to display on the first display;

[3] receiving, by the processor, a second input that represents an instruction to reveal one of a desktop or application on a second display of the multi-display device;

[4] selecting, by the processor, a second desktop or application to display on the second display;

[5] displaying, by the processor, the selected first and second desktops or applications on the first and second displays;

[6] receiving, by the processor, a third input that represents an instruction to maximize a selected one of the first or second desktops or applications

resulting in the selected one being displayed on both of the first and second displays; and

[7] displaying, by the processor, the selected one of the first or second desktops or applications in a maximized condition.

'756 Patent, claim 1.

The Petition, however, only addressed the first, second, third, fourth, sixth, and seventh steps of claim 1. Paper 15 (Patent Owner Response), 12-17; Paper 22 (Sur-Reply), 2-3. The Petition entirely omitted any identification of or reference to the *fifth* step: “displaying, by the processor, the selected first and second desktops or applications on the first and second displays.” Paper 15 (POR), 12-17.

This was no mere typo. *Id.* As Multifold pointed out in its papers and Petitioners do not dispute, it is readily verifiable that the words of the fifth step (“displaying, by the processor, the selected first and second desktops or applications on the first and second displays”) ***do not appear anywhere*** in the Petition. Paper 15 (POR), 14-15. As a result, the Petition never specified what evidence corresponds to this element – nor could it, as this element is never mentioned. In failing to tie any evidence from the prior art to this element, Petitioners’ claim 1 challenge violates both 35 U.S.C. § 312(a)(3), which requires petitioner to “identif[y] ***with particularity*** ... the evidence that supports the grounds for the challenge to each claim,” and 37 CFR § 42.104(b)(4), which

requires the Petition to “specify where *each element of the claim* is found in the prior art patents or printed publications relied upon.”

Petitioners’ error likewise infected their challenged to claim 7. Paper 15 (POR), 16-17. The third element of claim 7 is analogous to the fifth step of claim 1 and reads: “instructions configured to respond to the first and second predetermined inputs with outputs that cause the first desktop or application to be displayed on the first display and cause the second desktop or application to be displayed on the second display.” ’756 Patent, claim 7. But the Petition merely cited to the first through fourth steps of claim 1, rather than the missing fifth step, as evidence for this element. Paper 15 (POR), 16-17 (*citing* Paper 1 (Pet.), 39). Thus, the Petition did not tie evidence from the prior art to this element as required by 35 U.S.C. § 312(a)(3) and 37 CFR § 42.104(b)(4).

The Petition’s failure to identify the fifth step of claim 1 and where it was found in the prior art should have been fatal.

B. The Board does not have discretion to identify missing limitations on Petitioners’ behalf

Petitioners do not contest that their Petition does not identify the “displaying, by the processor, the selected first and second desktops or applications on the first and second displays” limitation. Paper 22 (Sur-Reply), 2. As a result,

they cannot dispute that they did not identify where this element was found in the prior art. The Final Written Decision concedes as much:

Petitioner represents that *the omission* was due to “an obvious typographical error” when the claim language was “copied and pasted” into the Petition... Paper 29 (FWD), 13-14, 21-22 (“The omission of the displaying element text in the Petition sub-heading for limitation 1[B] is an obvious “copy and paste” error...”).

Under *SAS*, 584 U.S. 357 and *Koninklijke Philips*, 948 F.3d 1130, the Board should have stopped there. Once Patent Owner established that the Petition completely failed to address an element of the claims, the Board should have found that the Petition failed to meet the requirements of 35 U.S.C. §312(a)(3) and 37 C.F.R. §42.104(b)(4) to identify “where each element of the claim is found in the prior art patents or printed publications relied upon.” Paper 15 (POR), 12-17.

Because Petitioners omitted an element of claim 1 from their Petition, Petitioners have not met their burden to address every claim element and claim 1 (and claim 7) cannot be invalidated. Paper 15 (POR), 12-17.

But that is not what the FWD did. After dismissing the Petition’s failure to address step five of claim 1 as “an obvious typo,” the Board took it upon itself to look through the Petition for evidence of step five, even though step five was missing from the Petition. Paper 29 (FWD), 14-15. But the Petition never specified what evidence corresponds to the fifth step of claim 1 – nor could it, as the fifth

step is never mentioned – so the FWD instead cites to Petitioners’ discussion of the third and fourth steps of claim 1 and, even more egregiously, to the “Prior Art Overview” section of the Petition for evidence of the fifth step of claim 1. Paper 29 (FWD), 14-17 (*citing* Pet. 13-14 (“Prior Art Overview” section) and Pet. 27-30 (section addressing the third (“receiving, by the processor, a second input that represents an instruction to reveal one of a desktop or application on a second display of the multi-display device” and fourth (“selecting, by the processor, a second desktop or application to display on the second display”) steps of claim 1). The FWD never addresses fact that the Petition never tied any of the Board’s “evidence” to the fifth step of claim 1, never mind that a “Prior Art Overview” section certainly does not identify with particularity any element of a challenged claim. If this FWD is not reversed, future petitioners could simply structure their petitions as one long “Prior Art Overview” section, conclude the section with “the prior art invalidates the claims,” and cite this decision as precedent.

This decision contravenes numerous Supreme Court and Federal Circuit precedents, starting with *SAS*, 584 U.S. 357. *SAS* unequivocally states that the PTAB does not “enjoy[] a license to depart from the petition and institute a different *inter partes* review of [its] own design.” *Id.* at 365. Once Petitioners omitted the fifth step of claim 1 from their Petition, the Board does not have license to depart from the Petition and manufacture arguments not found in the

Petition. If the Petition does not tie evidence to a limitation, the Board may not look for evidence of that limitation. *Id.*

Multiple subsequent Federal Circuit decisions confirm that the Board has no discretion to create arguments not made in the Petition by relying on evidence that the Petition did not tie to the limitation at issue. As the Federal Circuit stated in *Koninklijke Philips*, 948 F.3d at 1336, “it is the petition, not the Board's ‘discretion,’ that defines the metes and bounds of an *inter partes* review.” If the Petition omits a limitation, the Board must confirm the claims. *Id.* In *Koninklijke Philips*, the Federal Circuit refused to permit the Board to exercise discretion to create an argument even though the evidence was presented in the petition. *Id.* at 1336. In *Netflix*, the Federal Circuit affirmed the Board’s refusal to consider the petitioner’s argument because, even though the evidence was presented in a block quote, “nothing in [the quote] signals to a reader that” the quote was equated to the limitation at issue. *Netflix*, 84 F.4th at 1378. The same must apply here – the Petition did nothing to tie the missing fifth claim step to any evidence. A petition must address every element – and this Petition’s failure to do so is fatal. *MModal*, 846 Fed.Appx. at 906 (“A petitioner generally must provide in the petition an understandable explanation of the element-by-element specifics of the unpatentability challenges, including the particular portions of prior art supporting those challenges.”). The Board may not entertain arguments not made in the

petition. *M&K Holdings, Inc.*, 985 F.3d at 1385 (Fed. Cir. 2021); *In re IPR Licensing*, 942 F.3d at 1369-70.

The Board’s determination that the omission was “an obvious typo” cannot change the result. In *Apple Inc. v. MPH Techs. Oy*, No. 2021 1355, 2021-1356, 2022 WL 4103286 (Fed. Cir. Sep. 8, 2022), the Federal Circuit upheld the confirmation of a claim where the Petitioner failed to address a limitation of a claim. Although that petitioner also argued that it was “an obvious typo,” the Federal Circuit rejected that argument because “where a petitioner did not address all of a claim’s limitations in its petition,” the petitioner fails to meet its burden under 35 U.S.C. §312(a)(3) and the claim may not be invalidated on arguments not in the Petition. *Id.* at *16-17. And more recently in *DK Crown Holdings, Inc. v. AG 18, LLC*, No. 2024-2078 (Fed. Cir. May 6, 2026), the Federal Circuit again confirmed that the Board may not analyze a missing claim or limitation – even though the petitioner characterized it as a “clerical error.” *Id.* at *4-6. The law is clear – there is no “obvious typo” exception to 35 U.S.C. §312(a)(3), nor do PTAB judges have the authority to create one.

The decision in this IPR has the hallmarks of confirmation bias: the Board instituted based on a facially deficient petition that completely failed to address a claim limitation, and the Board was not willing to admit that oversight in its final written decision.

III. CONCLUSION

It should not be controversial to require petitioners – and PTAB judges – to follow the law. 35 U.S.C. § 312(a)(3) explicitly requires petitions to “identif[y] *with particularity* ... the evidence that supports the grounds for the challenge to each claim.” Likewise, PTO regulations require the Petition to “specify where *each element of the claim* is found in the prior art patents or printed publications relied upon.” 37 CFR § 42.104(b)(4).

This Petition did not identify every element of independent claims 1 and 7. The Board does not have discretion to do so on Petitioners’ behalf. Multifold respectfully requests that the Director grant review and affirm that the Board may not invalidate claims where the petition did not address every limitation.

Respectfully submitted,

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Date: May 20, 2026

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This paper contains 9 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,

/Minghui Yang/

Date: May 20, 2026

CERTIFICATE OF SERVICE

I hereby certify that on May 20, 2026, I caused a true and correct copy of the foregoing **PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW OF THE FINAL WRITTEN DECISION** to be served on the following counsel of record for Petitioner by electronic mail to the following addresses:

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