UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC and MOTOROLA MOBILITY LLC,
Petitioner,

v.

MULTIFOLD INTERNATIONAL INCORPORATED PTE. LTD.,
Patent Owner.

Case IPR2025-00058
Patent No. 9,158,494

PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE

To antedate Seo (EX1005), Patent Owner ("PO") "must show either an earlier reduction to practice, or an earlier conception followed by a diligent reduction to practice." *Purdue Pharma L.P. v. Boehringer Ingelheim GmbH*, 237 F.3d 1359, 1365 (Fed. Cir. 2001). PO alleges both here, but its evidence is insufficient. *See, e.g.*, Paper 8 (Patent Owner Preliminary Response, "POPR"), 14-16.[1]

I. PO FAILS TO PROVIDE COMPETENT EVIDENCE SHOWING WHAT WAS REDUCED TO PRACTICE FOR ALL CLAIMS

PO's proffered arguments and evidence for reduction to practice generally consist of circular inferences that the EV-1, EV-2, and Smartpad devices had all the features described in the alleged conception documents because there is no evidence that the prototypes did not have those features. And instead of identifying supporting evidence purportedly showing conception and reduction to practice of each claim element with particularity, the POPR is littered with overbroad string cites sending Petitioner and the Board on a scavenger hunt through PO's 83 exhibits. *See, e.g.*, POPR, 55–79; *NRG Energy, Inc. et al. v. Midwest Energy Emissions Corp.*,

[1] Although PO failed to meet its burden for proving conception and reduction to practice for additional reasons, Petitioner focuses on a subset of the issues given the limited nature of this briefing without waiving any arguments. Petitioner reserves its right to present additional responses and evidence post-institution regarding PO's conception, reduction to practice, and diligence arguments.

IPR2020-00926, Paper 19 at 33 (Dec. 2, 2020) (granting institution while noting that "[i]t is [] unclear, without further explanation, what the documents purporting to show conception and reduction to practice actually demonstrate, and how they are related specifically to the limitations of the challenged claims.").

Notably missing from those 83 exhibits is any user manual, software development kit, developer guide, or other materials sufficient to prove that any specific claim feature was embodied in the EV-1, EV-2, or Smartpad. The documents reveal no more than generic statements about "gesture," "minimization," or "maximization," functionality without sufficient detail to map the documents to the claims. Thus, whatever functionality existed in the EV-1 or EV-2, there is no particularized showing of how those devices worked.

For instance, PO cites to an SSA Project Plan (EX2033), which shows merely that "Gestures" were 100% complete. *See* POPR, 38 (citing EX2033). PO points to lines in that spreadsheet allegedly showing the "Minimize Dual Display Application Transition Controller," "Maximize Dual Display Application Transition Controller" and "Integration with Parent / Child infrastructure" were 100% complete as of November 2010 (POPR, 38-39), but getting from that to reduction to practice requires two substantial inferences: (1) that the document actually reflects these features being implemented into the EV-1 or EV-2 device, and (2) that the features described are identical to those claimed. Ron Cassar, the document's author wrote

in his declaration only that "the gesture capability necessary to support the relevant gesture functionality (minimization and maximization and parent/child relationships) was complete," not that it was installed and working on an EV-1 or EV-2 device, or that it tracked the claim limitations.

PO also cites a December 1, 2010 email from Paul Reeves (EX2034) that is, as an initial matter, inadmissible hearsay because the document is being offered for its truth. POPR, 40. But the email merely refers to a purported understanding that "ParentChild **may** have been added to the framework." EX2034. PO provided no evidence of what ParentChild means as used by Mr. Reeves (i.e., whether it meets any claim elements), nor whether "may" means ParentChild actually has been added.

Similarly, PO cites EX2035, another inadmissible hearsay email, this time from Rod Schrock. POPR, 40-41. Mr. Schrock was allegedly demonstrating the EV-1 and EV-2 handsets, and PO contends that, despite the complete lack of documented evidence showing how the EV-1 and EV-2 actually worked, their mere demonstration somehow means they practice all the claims limitations. These types of deficiencies pervade all of PO's evidence on reduction to practice. They all require strained inferences. PO simply cannot meet its burden to show any device meets all the claim limitations and certainly has not put forward evidence justifying denying the institution of a proceeding to allow the record to be further developed.

In addition to the documents, PO included two video clips discussed below. *Infra* Section II.c (citing EX2023, EX2024). However, neither the videos nor the date of their creation is corroborated by anything other than inventor Sirpal's testimony and a screenshot of purported metadata (EX2025) from Sirpal himself. "In order to establish an actual reduction to practice, an inventor's testimony must be corroborated by independent evidence." *See Cooper v. Goldfarb*, 154 F.3d 1321, 1330 (Fed. Cir. 1998).[2] Thus, there is insufficient evidence to find the videos authentic or to corroborate their date. *See Microsoft Corp. v. Surfcast, Inc.*, IPR2013-00292, Paper 93 at 16-17 (finding inventor evidence cannot alone authenticate a document or corroborate an exhibit's date of origin).

PO also set forth alleged reduction to practice evidence in the three declarations. *See generally* EX2001; EX2002; EX2003. But the striking similarity and repetitiveness across the declarations indicates that inventor Sirpal and the other two declarants prepared their declarations in concert. *Compare, e.g.*, EX2001 ¶¶27-32, *with* EX2002 ¶¶21-25, *and* EX2003 ¶¶13-15, 18, 20; *also compare, e.g.*, EX2001 ¶¶75-76, *with* EX2002 ¶50, *and* EX2003 ¶¶28-29. While declarations may provide independent corroboration under some circumstances, that is not warranted here, particularly at this preliminary stage without the benefit of robust cross-examination to aid the Board's factfinding, at least because the named inventor plainly

[2] Corroboration is required for both conception and reduction to practice.

collaborated with the other declarants in preparing testimony. *See IQE PLC v. Cornell Research Foundation Inc.*, IPR2024-00609, Paper 9 at 40-41 (Sep. 13, 2024) (granting institution because "Patent Owner's arguments [regarding conception/reduction to practice] raise disputed factual issues that are best resolved on a more fully developed record."). A better-developed record, including cross-examination of the inventor and other declarants would also assist the Board in parsing through the voluminous evidence and homing in on the disputed issues.

In sum, the evidence provided with the POPR is insufficient to determine exactly what features were in the EV-1 and EV-2 prototypes or when those devices were actually reduced to practice. Thus, PO has failed to carry its burden.

II. PO'S CHALLENGE TO INDEPENDENT CLAIM 14, AND DEPENDENT CLAIM 2, SUFFERS FROM ADDITIONAL EGREGIOUS ISSUES FURTHER COMPELLING INSTITUTION

In addition to the issues discussed above that implicate all challenged claims, PO's argument suffers from various other critical problems. Given the limited nature of this briefing, Petitioners focus below on a subset of the issues that are exemplary of the failures in PO's argument.

a. Challenged Claims 2 and 14 Require Gesture Capture Region(s) Included as Part of the Display, Where the Display Is Used to Display Output to a User

Claim 2 recites that "the first input from the user is received in a gesture capture region of the device, and **wherein the gesture capture region is included**

as part of at least one of the first and second displays of the device." EX1001, 51:48-51.[3] Independent claim 14 recites two gesture capture regions that are part of a first and second display, respectively. The first display includes "a gesture capture region, **wherein the gesture capture region is located within a second area of the first display**," Ex. 1001, 52:50-52, and the second display includes "a second gesture capture region, **wherein the second gesture capture region is located within a second area of the second display**," *id.*, 52:56-58.

The '494 patent specification explains that the term "display" means "a portion of one or more screens **used to display the output of a computer to a user**." EX1001, 4:22-23. Thus, in view of the '494 patent, the "gesture capture region" or "second gesture capture region" must be included/located as part of/within a first/second display that is a portion of a screen used to display the output of a computer to a user. *Id.*; *see also* Paper 1 ("Pet."), 19 n.8. PO did not dispute this meaning of a "display." *See generally* POPR.

b. PO Fails to Prove Conception of Claims 2 and 14

"Conception requires proof that the inventor formed in his mind 'a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice,' and that the idea be 'so clearly defined in the inventor's mind

[3] Emphasis added unless otherwise specified.

that only ordinary skill would be necessary to reduce the invention to practice, without extensive research or experimentation.'" *Purdue Pharma L.P.*, 237 F.3d at 1365 (Fed. Cir. 2001) (quoting *Burroughs Wellcome Co. v. Barr Labs., Inc.*, 40 F.3d 1223, 1228 (Fed. Cir. 1994)).

For conception, PO relies on declarations from one of its inventors (EX2001 [Sirpal Decl.]) along with two project team members (EX2002 [Cassar Decl.]; EX2003 [Becze Decl.]). POPR, 4, 17-18. PO additionally relies on three presentations for conception. POPR, 17-18 (citing EX2006 [UX Overview], EX2012 [Windowing Management], EX2013 [Browser Interaction Design]). But even a cursory review of this evidence confirms that no complete embodiment or idea is disclosed where a gesture capture region is included as part of a display used to display output of a computer to a user, as required by claims 2 and 14. Indeed, PO's own characterizations (and that of its declarants') of the figures in its presentations confirm that the gesture capture region envisioned was located **outside** (above) the first or second screen areas displaying output of a computer to a user.

Named inventor Sirpal explained that the claimed gesture capture region he conceived corresponds to "a gesture capture bar running across the top of both screens" of two devices: the "Imerj EV-1 and EV-2." EX2001 [Sirpal Decl.] ¶55. He contends that "[t]he gesture capture bar is included as part of at least one of the screens" and cites to, *inter alia*, his discussion of EX2006. EX2001 ¶55 (citing *id.*

¶11). But EX2006 unequivocally shows the gesture capture region is **above** the display, not **as part of** or **within** the display. *See* EX2001 ¶11; EX2006, 15, 30. The POPR confirms that PO contends the dashed area **above** the display area in the below figure corresponds to the gesture capture region. POPR, 19 ("a dual-screen handset with a gesture strip across the top of the device bounded by the dashed rectangle") (citing EX2006, 15); *see also* EX2006, 15, 30; EX2001 ¶11.

PO's other evidence repeatedly confirms that the gesture capture region allegedly conceived is outside, not part of or within, a display because the area of the screen that presents information to the user is separate from the gesture capture region in the dashed box above. *See, e.g.*, EX2002 ¶¶11-13, EX2003 ¶¶7-9; EX2012, 8-23 (describing "off-screen gestures"). Indeed, the UX Overview expressly states, "[t]he Dual Screen Handset provides a capacitive strip across the top of the dual screens." EX2006, 15. The UX Overview includes several images of a dual-screen app design, but none of them present any idea or embodiment of a gesture strip that is included as part of or located within the first/second displays. *See, e.g.*, *id.*, 45-49, 52-55, 67-76, 79-88, 92-104, 106-112, 119-120.

Similarly, the portions of the Windowing Management presentation (EX2012) cited by Sirpal as showing his alleged conception relate exclusively to "off-screen" gesture inputs. EX2001 ¶54 (citing EX2012, 8-23). The cited pages of the Windowing Management presentation illustrate drag and flick gestures.

EX2012, 8-23. But it defines those gestures as "[o]ff-screen" gestures. EX2012, 6; *see id.*, 8-23 (illustrating "off-screen gestures . . . supported").

Finally, none of the cited portions of the Browser-Interaction Design presentation concern gestures or a gesture capture region. POPR 29-31 (citing EX2013, 33, 34, 44.).

Because the evidence presented with the POPR shows only a gesture capture region outside a display, PO fails to demonstrate that the subject matter of claims 2 and 14 was conceived before the critical date.

c. PO Fails to Prove Actual Reduction to Practice of Claims 2 and 14 Prior to Seo's Priority Date

For proof of actual reduction to practice, "an inventor must establish that he 'actually prepared the composition and knew it would work.'" *Purdue Pharma L.P.*, 237 F.3d at 1365–66 (quoting *Estee Lauder Inc. v. L'Oreal, S.A.,* 129 F.3d 588, 592 (Fed. Cir. 1997)).

PO alleges that its prototypes EV-1 and EV-2 and a Smartpad tablet demonstrate actual reduction to practice prior to Seo's February 10, 2011, filing date. POPR, 32-35. PO fails to prove actual reduction to practice for claims 2 and 14 for reasons similar to those discussed above with respect to its conception evidence. For example, PO's own annotation of the gesture capture region in EV-1 and EV-2 readily demonstrate that the gesture capture region is not part of or included within a first or second display. *See* POPR, 36-37 (annotating "gesture strip" of alleged

EV-1 above display), 45-46 (same annotations for alleged EV-2). Likewise, PO's videos of the Smartpad tablet operation show a user inputting gestures above the display. EX2023; EX2024. Thus, the "gesture capture strip" in both the EV-1 and EV-2 prototypes and the Smartpad tablet is **above**, and **not included/located as part of/within a first/second display**. *See also supra* Section I. PO essentially admits as much as its alleged explanation for the EV-1 and EV-2 prototypes containing the limitation of claim 2 is premised on "[t]he gesture capture bar is included as part of at least one of the **screens.**" POPR, 57-58. The claims say "display," not "screen." In the '494 patent, a screen can include a display and a separate input region, but a display is only the area "used to display the output of a computer to a user." EX1001, 3:57-62, 4:22-23. Thus, the gesture capture region being part of a "screen," as alleged by PO, is not sufficient to meet claims 2 and 14 because no evidence shows that it is part of an area used to display the output to a user.

Accordingly, PO fails to show that any "display" of an EV-1, EV-2, or Smartpad has a gesture capture region and thus did not prove actual reduction to practice for at least claims 2 and 14.

III. CONCLUSION

The Board should institute the IPR at least due to PO's above-noted failures to prove conception and diligent reduction to practice of any embodiment encompassing the challenged claims before Seo's priority date. Seo is prior art.

Respectfully submitted,

Dated: April 7, 2025

By:/Naveen Modi/
Naveen Modi (Reg. No. 46,224)
Counsel for Petitioner Google
Designated Lead Counsel for Petitioners

CERTIFICATE OF SERVICE

I hereby certify that on April 7, 2025, I caused a true and correct copy of the foregoing Petitioner's Reply to Patent Owner's Preliminary Response to be served electronically on counsel for Patent Owner at the following addresses:

jim@carmichaelip.com
schreiner@carmichaelip.com
mitch@carmichaelip.com
stevemcbride@carmichaelip.com
chris@carmichaelip.com
MultifoldIPRs@carmichaelip.com

Respectfully submitted,

By: /Naveen Modi/
Naveen Modi (Reg. No. 46,224)
Counsel for Petitioner