UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC and MOTOROLA MOBILITY LLC,

Petitioners,

v.

MULTIFOLD INTERNATIONAL INCORPORATED PTE. LTD.

Patent Owner

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

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PATENT OWNER'S PRELIMINARY SUR-REPLY

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Institution should be denied because Petitioners never allege any claim limitation is missing from PO's proof of prior invention, except for one limitation in claims 2 and 14.

Antedating Seo for claim 14 is unnecessary because the Petition failed to address obviousness of limitation 14[m]. This leaves dependent claim 2 as the only claim for which Petitioners identified a potentially disputed limitation for the swear-behind. Instituting trial for all 11 challenged claims based on arguments for a single dependent claim would be an inefficient use of the Board's resources.

I. PO CLEARLY MAPPED THE PROTOTYPES TO THE CHALLENGED CLAIMS

Petitioners' insinuations that PO's evidence is overbroad and not described with enough particularity (Reply, 1, 5) are incorrect. It is true, as Petitioners admit, that PO submitted "voluminous" evidence demonstrating that the Imerj prototypes were conceived and actually reduced to practice prior to Seo's filing date and that the prototypes performed the challenged claims. But most of the POPR's 83 exhibits corroborate discrete issues that are not contested by Petitioners, such as dates, testing, diligence, and the existence of physical prototypes. The functionality of the prototypes is primarily discussed in the corroborating declarations (EXS2001, 2002, 2003), design specifications (EXS2006, 2012, 2013), prototype videos (EXS2022, 2023), software project plan (EX2033) and emails (EX2034-2038). This universe (14 exhibits) is not so large as to force Petitioners "on a scavenger hunt." Reply, 1.

Further, the mapping of the corroborated evidence to each claim limitation is clear. For each limitation, the POPR provides a claim chart quoting the testimony of inventor Sirpal explaining why the prototypes perform the claimed limitation. POPR, 55-79. For each limitation in the claim chart, the POPR (and Sirpal) also identify substantial evidence that corroborates Sirpal's testimony. *Id.* The claim chart submitted in the POPR is clear and detailed. *Id.*

Nor are the declarations ambiguous. Each declaration explains in detail, citing design specifications, how the relevant gesture functionality (such as maximize/minimize, swiping and dragging, and parent/child windows) operated. EX2001 [Sirpal Decl.], ¶¶9-24; EX2002 [Cassar Decl.], ¶¶9-18; EX2003 [Becze Decl.], ¶¶6-12. Videos demonstrate how the prototypes maximized and minimized windows. EX2022, EX2023 [prototype video excerpts]. Sirpal describes, with supporting evidence, how this functionality maps to the claims. EX2001 [Sirpal Decl.], ¶¶49-70. Cassar provided non-inventor testimony corroborating how the prototypes performed the claimed functionality. EX2002 [Cassar Decl.], ¶¶63-77.

Rather than generically criticizing PO for providing too much evidence, Petitioners should have identified why specific claim limitations were allegedly not met by the prototypes discussed in the claim chart or why specific statements were allegedly not corroborated. *Roofr Inc. v. Eagle View Technologies, Inc.*, IPR2023-00437, Paper 14, 13 (PTAB August 1, 2023) (denying institution where "Petitioner

has provided neither argument nor evidence to outweigh [PO]'s showing" of prior conception and reduction to practice). The Board should deny institution because Petitioners have not rebutted PO's evidence.

II. THE PRELIMINARY REPLY DOES NOT REBUT PO'S OVERWHELMING EVIDENCE

Section I of the Preliminary Reply suggests that discrete pieces of evidence do not—by themselves—prove conception and reduction to practice. Reply, 1-5. These arguments ignore or mischaracterize substantial corroborating evidence without identifying any real factual dispute about the operation of prototypes in Jan. 2011 or their application to the claims.

For example, PO provided two video excerpts (EX2022, EX2023)[1] that corroborate Sirpal by showing Imerj prototypes in Jan. 2011 performing the claimed maximize and minimize functionality. Petitioners do not dispute that the videotaped prototypes practiced the claims. Instead, Petitioners suggest "there is insufficient evidence to find the videos authentic or to corroborate their date." Reply, 4. Petitioners confuse the issue. The video excerpts corroborate Sirpal's testimony that the relevant functionality was present in the prototypes no later than Jan. 2011. EX2001 [Sirpal Decl.], ¶¶33-34, 38, 52-69, 79-81.

[1] Sirpal mistakenly refers to the video clips as EX2023 and EX2024 rather than EX2022 and EX2023. EX2001, ¶¶79-80.

Further, there is substantial evidence corroborating the fact that the video was created in early Jan. 2011. Sirpal testifies that the video was created on Jan. 4, 2011. EX2001 [Sirpal Decl.], ¶79. The video metadata shows the video was created on Jan. 4, 2011. EX2025 [screenshot of video metadata]. An email from Sirpal forwarding a link to the video on Jan. 5, 2011 further corroborates this testimony. EX2024 [email chain forwarding video from Sirpal to Nivedita Ojha]. And the non-inventor declarations of Cassar and Becze (each also supported by corroborating evidence) corroborate Sirpal's testimony that the claimed gesture functionality was functional in prototypes by Jan. 2011. EX2002 [Cassar Decl.], ¶¶20, 24-25, 30-45; EX2003 [Becze Decl.], ¶¶15-17, 21-25. Without explaining why this corroborated evidence is not trustworthy, Petitioners' suggestion fails.

Petitioners essentially concede that Sirpal's testimony is corroborated by complaining about "the striking similarity and repetitiveness across the declarations." Reply, 4. Petitioners identify nothing in the testimony or corroborating evidence cited therein that is allegedly incorrect or inconsistent. Petitioners identify no authority that business partners like Cassar and Becze should not work with each other or their former colleague Sirpal to confirm their recollections. To the contrary, the Board has held declarations submitted by brothers-in-law credible and entitled to weight despite the declarations' similarity.

Shenzhen Buxiang Network Technology Co., LTD. v. Sun Pleasure Co. Limited, IPR2021-00080, Paper 43, 42-43 (PTAB April 11, 2022).

Petitioners' other arguments fail. Petitioners argue that the emails at EX2034 [email from Kurdziel copying Cassar] and EX2035 [email from Schrock copying Cassar] are hearsay. Reply, 3. But these exhibits are not offered for the truth of any matter asserted therein; they are used to corroborate (and refresh) the independent recollection of Cassar that the claimed functionality was working for its intended purpose before Feb. 10, 2011. EX2002 [Cassar Decl.], ¶¶30-35.

Petitioners contend PO did not disclose "any user manual, software development kit, developer guide, or other materials" to show the claim features embodied in the prototypes. Reply, 2. Petitioners are incorrect. PO disclosed design specifications from 2010 authored by Sirpal and his team that explain in detail how the gesture functionality operated in the prototypes. EX2006 [UX Foundation Overview], 15 (showing Imerj form factor), 30-31 (explaining the gesture strip and application shuffling), 32-33 (discussing the application manager), 34-36 (explaining how minimizing and maximizing are performed); 45-49 (discussing dual screen application design on dual screen email, dual screen phone dialer, and dual screen messaging applications), 75 (calendar app), 84 (camera app); 94-104 (calendar application); 105-112 (messaging application); 113-131 (browser application); EX2012 [Windowing Management Interaction

Design Specification], 4 (introducing operations such as moving an application to the other screen, maximizing a dual-screen capable application to two screens, and minimizing one to a single-screen), 8 (explaining gestures such as the "Drag" gesture which "[m]oves applications from one screen to another" and/or "[m]aximizes and minimizes dual-screen capable applications"), 9-19 (defining standard rules for maximizing and minimizing dual-screen applications), 20 (defining rules for when the child page remains displayed upon minimization); and EX2013 [Browser Interaction Design Specification], 34 (defining browser operation), 44 (specifying that the "Web Browser" view remains visible on minimization gestures, unless there is a modal on the "Control Page" on the left).

Sirpal, Cassar and Becze each explain how these design specifications disclose the claimed functionality, including, maximize, minimize, moving applications between screens, and displaying parent-child windows. EX2001 [Sirpal Decl.], ¶¶9-24; EX2002 [Cassar Decl.], ¶¶9-18; EX2003 [Becze Decl.], ¶¶6-12. Sirpal, Cassar, and Becze also explain that the design specifications specified the gesture functionality implemented on the prototypes. *See, e.g.*, EX2001 [Sirpal Decl.], ¶24 ("I was responsible ... for ensuring that the product being developed met the requirements laid out in the specifications."); EX2002 [Cassar Decl.], ¶10 ("I directed implementation of the gesture functionality in the Imerj software based on specifications provided by Sanjiv [Sirpal]. … Sanjiv and

his team provided specifications and helped ensure that the software met the specified functionality."); EX2003 [Becze Decl.], ¶6 ("Sanjiv provided the specifications for the gesture functionality and helped ensure that the smartphone met the specified gesture functionality. My team and I developed hardware prototypes based on the designs provided by Sanjiv."). Thus, the design specifications disclose how the prototypes operated.

Similarly, Petitioners incorrectly argue that there is a "complete lack of documented evidence showing how the EV-1 and EV-2 actually worked" (Reply, 3). As discussed above, PO provided video excerpts of a functional prototype performing gesture functionality, as well as design specifications explaining how the claimed gesture functionality operates. EXS2006 [UX Foundation Overview]; 2012 [Windowing Management Interaction Design Specification]; 2013 [Browser Interaction Design Specification], 2022 [maximization video excerpt], 2023 [minimization video excerpt]. The POPR maps this evidence in detail to each claim limitation. POPR, 55-79.

Petitioners do not dispute that the gesture functionality software was "100% complete as of November 2010" as testified by Cassar and corroborated by his software Project Plan. Reply, 2. *See* POPR, 38-39; EX2002 [Cassar Decl.], ¶¶36-39; EX2033 [project plan listing software progress]. Instead, Petitioners argue "getting from [100% complete gesture software] 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." Reply, 2.

These are not inferences. The corroborating declarations, supported by corroborating exhibits (including video), independently confirm that the software described in EX2033 [software project plan] existed and operated in prototypes in the claimed manner prior to Feb. 10, 2011. EX2001 [Sirpal Decl.], ¶¶32-38, 79-82; EX2002 [Cassar Decl.], ¶¶20, 24-25, 30-35; 40-45; EX2003 [Becze Decl.], ¶¶15-17, 21-25. Again, Petitioners ignore corroborating testimony and evidence in favor of untethered wishful thinking.

Petitioners argue that institution and discovery are necessary to "assist the Board in parsing through the voluminous evidence and homing in on the disputed issues." Reply, 5. This argument highlights that (1) "voluminous evidence" corroborates Sirpal and (2) the Reply failed to identify "disputed issues" to home in on. Institution and discovery would not narrow anything. Instead, it would increase the time and expense of this IPR for no reason, now that PO has proven its swear-behind and Petitioners did not rebut it.

Sirpal's reduction to practice testimony is corroborated by two non-inventor declarants, videos, and documents. And Petitioners nowhere dispute PO's ***alternate*** argument and evidence that reduction to practice with continued

diligence occurred by Feb. 22, 2011. POPR, 50-55. Either is sufficient to antedate Seo.

Moreover, when requesting leave to file its preliminary reply, Petitioners knew that named co-inventor Mo Selim, now employed by Petitioners, worked on Imerj 2010-2011. EX3001, 1. Despite this, Petitioners did not seek to provide any testimony or evidence from Mr. Selim. EX3001, 2. If PO's reduction to practice evidence were incorrect, one would have expected Petitioners to provide or identify rebuttal evidence from its employee Mr. Selim. Petitioners proffered none.

III. CLAIMS 2 AND 14

The only alleged factual dispute Petitioners identify is whether the prototype's gesture capture region is part of the claimed "display." Reply, 5-10. This relates to one limitation in claims 2 and 14. EX1001 ['100 Patent], cls. 2, 14.

No swear-behind is necessary for claim 14 because the Petition failed to address obviousness of claim limitation 14[m] ("in response to a first input … discontinue the presentation of the [parent] page of the application."). Pet., 71; POPR, 79-80. The Petition only cites back to its discussion of limitation 1[d]. *Id.* But limitation 14[m] requires minimizing a ***parent*** page, EX1001, cl. 14, whereas limitation 1[d] requires minimizing a ***child*** page. POPR, 79-80; EX1001 ['100 Patent], cl. 1. The Petition nowhere discusses minimizing a parent page and therefore does not address limitation 14[m]. Pet. 29-31.

That leaves claim 2 as the only claim with a disputed swear-behind limitation. Thus, even if the prototypes hypothetically did not practice claims 2 and 14, Petitioners would at best be reasonably likely to prevail on only one of eleven challenged claims. The Board routinely denies institution under similar circumstances. *Par-Kan Company, LLC v. Unverferth Manufacturing Company*, IPR2024-01427, Paper 10, 15 (PTAB March 19, 2025) (denying institution based on swear-behind antedating 10 of 11 challenged claims because "instituting a trial with respect to all eleven claims based on evidence and arguments direct to [a single dependent claim] is not an efficient use of the Board's time and resources."). *Deeper UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7, 2 (PTAB Jan. 19, 2019) (denying institution where reasonable likelihood of prevailing on only 2 of 23 claims). The Board should deny institution.

IV. CONCLUSION

The Board should deny institution because the challenged claims were invented prior to Seo's filing.

Date: April 16, 2025

Respectfully submitted,

/Stephen McBride/

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that, pursuant to 37 CFR § 42.6(e), a true and correct copy of the foregoing **PATENT OWNER'S PRELIMINARY SUR-REPLY** have been served electronically via email on counsel of record for Petitioners:

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Dated: April 16, 2025

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