

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC and MOTOROLA MOBILITY LLC,
Petitioners,

v.

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

Case IPR2025-00060
U.S. Patent No. 8,842,080

**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 pursuant to 37 CFR § 42.75(c) to correct the Board’s error in claim construction that is contrary to established and settled Federal Circuit precedent. Under a longstanding line of cases, the Federal Circuit has repeatedly held that “the word ‘comprising’ is ‘not a weasel word with which to abrogate claim limitations.’” *Dippin’ Dots, Inc. v. Mosey*, 476 F.3d 1337, 1343 (Fed. Cir. 2007); *In re Varma*, 816 F.3d 1352, 1362 (Fed. Cir. 2016); *Liberty Ammunition, Inc. v. US*, 835 F.3d 1388, 1399 (Fed. Cir. 2016); *David Netzer Consulting Engineer LLC v. Shell Oil Co.*, 824 F.3d 989, 998 (Fed. Cir. 2016); *Applera Corp. v. Illumina, Inc.*, 375 F. App’x 12, 27 (Fed. Cir. 2010); *Power Mosfet Tech. LLC v. Siemens, AG*, 378 F.3d 1396, 1409 (Fed. Cir. 2004).

But that is precisely what the Board did here. When construing a limitation specifying that the claims “comprise” an element, the Final Written Decision cited the word “comprise,” determined that the claims were not limited to that element, and then proceeded to read the element out of the claims. This is exactly what *Dippin’ Dots* commands the Board not to do: the word “comprise” permits other elements but ***requires*** the enumerated element to be present.

As the Federal Circuit previously admonished the Board, this error “is improper under the *Phillips* standard; indeed, it would be improper under any

standard.” *Raytheon Co. v. Sony Corp.*, 727 F. App’x 662, 681 (Fed. Cir. 2018).

The Board cannot be permitted to violate black letter rules of claim construction and read out claim limitations to match a claim with the prior art. Respectfully, Director review is warranted to correct this recurring error.

II. ARGUMENT

A. Multifold’s construction of “the icon indicates that the application is in a first state” and “wherein the first [state] comprise an open application state”

Claim 1 of U.S. Patent 8,842,080 (the “’080 Patent) recites:

1. A method for controlling a handheld computing device including one or more displays, comprising:

[1] displaying a first screen of an application in a first display condition;

[2] displaying an icon with the first screen of the application, wherein the icon indicates that the application is in a first state corresponding to the first display condition;

[3] receiving a gesture input at a gesture sensor;

[4] modifying the manner in which the application is displayed in response to the receiving step;

[5] changing the application to a second display condition; and

[6] morphing the icon to indicate that the application is in a second state corresponding to a second display condition the morphing comprising changing the shape and size of the icon;

wherein the first and the second states comprise an open application state.

'080 Patent, claim 1.

Because claim 1 specifies in step two that “the icon indicates that the application is in a first state” and specifies in the final “wherein” clause that “wherein the first and the second states comprise an open application state,” Multifold argued that the icon must indicate the application is in “an open application state.” Paper 11 (POR), 7-9; Paper 19 (Sur-reply), 1-4. This naturally follows from the claim language: “the icon indicates that the application is in a first state” and “the first state...comprise[s] an open application state.” *Id.* Because the icon must indicate the icon is in an “open application state,” the natural reading of “open application state” means that the icon indicates that “the application is open and being displayed in the corresponding display condition/status.” Paper 11 (POR), 7-9; Paper 19 (Sur-reply), 1-4.

Furthermore, because the first step of claim 1 specifies “an application” and the remaining steps of claim 1 specify “the application,” all the steps of claim 1 must be performed on the same application. Paper 11 (POR), 7-8; Paper 19 (Sur-reply), 1-4. Thus, the open application state must be a state of the same application consistently recited in claim 1. Paper 11 (POR), 7-9; Paper 19 (Sur-reply), 1-4.

B. The Board’s construction is contrary to a longstanding line of Federal Circuit cases prohibiting the Board from reading limitations out of a claim

Even though claim 1 explicitly states that “the icon indicates that the application is in a first state” and “the first state...comprise[s] an open application state,” the Final Written Decision determined that the icon need not indicate an open application state because the word “comprise” does not limit the first state to an open application state but permits other states:

Claim 1 also recites “wherein the first and second states comprise an open application state.” Given the usage of “comprise” in this clause, we determine that the possible first and second states must include an open application state but the states are not limited to an open application state.

Paper 27 (FWD), 13.

We are also not persuaded by Patent Owner’s antecedent basis argument because it is based on a misreading of the claim. In claim 1, the “icon” indicates the state of the application but, the final wherein clause makes clear that the first and second states each “comprise an open application state” and are not limited to an open application that is also being displayed.

Paper 27 (FWD), 14.

In doing so, the Board read out claim 1’s requirement that the icon indicate an open application state because the word “comprise” does not limit the first state to an open application state but permits the first state to include states other than an open application state. *Id.* at 12-14.

This logic has been rejected by a long line of Federal Circuit cases. In *Dippin' Dots*, the appellant argued that a claimed method “comprising” six steps could be extended to cover methods that did not include one of the six steps. The Federal Circuit flatly rejected this argument, stating:

“Comprising” appears at the beginning of the claim — “comprising the steps of” — and indicates here that an infringing process could practice other steps in addition to the ones mentioned. Those six enumerated steps ***must, however, all be practiced*** as recited in the claim for a process to infringe. The presumption raised by the term “comprising” does not reach into each of the six steps to render every word and phrase therein open-ended...

Dippin' Dots, 476 F.3d at 1343.

Here, correctly construed following *Dippin' Dots*, if the first state comprises states other than the open application state, that merely means that the icon must indicate every state – the open application state and any other states – not that the icon need not indicate an open application state. To find otherwise violates the holding of *Dippin' Dots*. *Id.* at 1343.

The Federal Circuit has consistently applied this holding for decades. In *In re Varma*, 816 F.3d at 1362, the Federal Circuit stated:

Although the transitional term “comprising” indicates that the claim is open-ended, the term does not render each limitation or phrase within the claim open-ended... “Comprising” means that the claim can be met by a system that contains features over and above those specifically required by the claim

element, but only if the system still satisfies the specific claim-element requirements...

In re Varma, 816 F.3d at 1362.

In *Liberty Ammunition*, in *David Netzer*, in *Applera*, each time a party has argued that the word “comprising” permits reading out an element because “comprising” permits additional unnamed elements, the Federal Circuit has rejected it. *Liberty Ammunition*, 835 F.3d at 1399; *David Netzer*, 824 F.3d at 998; *Applera Corp.*, 375 F. App’x at 27. As the Federal Circuit succinctly stated in *Power Mosfet*: “‘Comprising,’ while permitting additional elements not required by a claim, ***does not remove the limitations that are present.***” *Power Mosfet*, 378 F.3d at 1409. Indeed, in *Raytheon*, the Federal Circuit dedicated a section in an opinion otherwise affirming the Board to explain why the PTAB may not use the word “comprising” to read out a claim element. *Raytheon*, 727 F. App’x at 679-681. Such an interpretation “is improper under the *Phillips* standard; indeed, it would be improper under any standard.” *Id.* at 681. Based on these precedents, the only correct way to read claim 1 is that it encompasses icons that indicate an open application state and potentially other states, but does not encompass icons that do not indicate an open application state.

“[T]he word ‘comprising’ is ‘not a weasel word with which to abrogate claim limitations.’” *Dippin’ Dots*, 476 F.3d at 1343. Director Review is warranted.

C. Reversal is appropriate because Petitioners admitted that the prior art does not suggest Multifold's construction

The Board's invalidation of claim 1 is entirely based on its rejection of Multifold's construction: "Patent Owner's argument for this limitation relies on its proposed construction for open application state which we do not adopt." Paper 27 (FWD), 30-31. Given that Federal Circuit precedent renders the Board's construction untenable, that invalidation cannot stand.

But equally as important, Petitioners admitted during the proceeding that the prior art does not suggest Multifold's construction. Multifold put forth evidence that Petitioners' art (Ogawa) indicates the status of a display screen regardless of whether an application is open in that screen or not. Paper 11 (POR), 10-16; Paper 19 (Sur-reply), 4-8. And if there is no open application on Ogawa's screen, Ogawa still indicates an open screen even though the claims require the icon to indicate an open application (not screen) state. Paper 19 (Sur-reply), 5-6. As Multifold's Dr. Surati expert testified:

"[Ogawa] can't indicate that it's an open application because it's indicating the screen is active. The state of the application underneath it is not clearly that of an open application because it could be a desktop, it could be another application. It's not indicative of that particular application being open. It could be a desktop."

Ex.1016, 59:5-12. In other words, Ogawa's icon indicates that a screen is active, not that a particular application meeting the remaining elements of claim 1 (or claim 12)

is active. Paper 19 (Sur-reply), 5. And because Ogawa's screen does not require an active application and is not limited to a particular application, Dr. Surati further confirmed that just because Ogawa's access bar is colored to indicate an active screen does not mean that there is an active application in the part of the screen indicated by the access bar:

“[I]f you happen to see [Ogawa's] icon, it indicates that part of the screen is active, and there could be an open application on the screen, but there doesn't have to be... if I were to just tell you, oh, the -- if I just put your hands over your head and I said, oh, the left-hand side of the screen -- I mean, of that diagram 42 is lit up, is there an application that's open on that screen? ***You wouldn't know*** because you don't know if there's an application open on that part of the screen -- I mean, literally there as opposed to it's just the desktop. I think that's what I'm trying to say is that if you say -- if I make that statement, you don't know that there's an application there on that screen, A; and B, if it is, and that's active, it probably would indicate that it's open, but it's not necessarily an indication that there's an open application on that screen just because it's active.

Ex.1016, 61:2-62:3.

Petitioners admit that Multifold is correct in two ways. First, Petitioners acknowledge that Ogawa's icon only *sometimes* matches an open application. Paper 19 (Sur-reply), 6 (*citing* Paper 16 (Reply), 8, 10-16). But if an icon only sometimes matches an open application, it cannot correctly indicate the open application state. *Id.*

Second, Judge Jung asked Petitioners during oral argument whether there was a difference between indicating an active application (as in Ogawa) and indicating an open application state (as claimed), and Petitioners agreed that there was a difference:

JUDGE JUNG: And then we have Patent Owner's declarant saying that the icon is more directly tied to the screen rather than the program. And it seems like -- you know, I just did a quick reading of the deposition testimony you cited and the paragraph cited in Ogawa, but it does seem like it better supports Patent Owner's declarant. That icon is really directly tied to the active state of the screen, not a state of an application, but by implication, it may be an application, but -- So that's -- you know, presuming that's all true, then Patent Owner's declarant is better supported by Ogawa than your declarant.

JUDGE JUNG: I agree the figures look the same, but they're trying to show different things, right? In Ogawa, it's the screen that's being shown as being expanded or shrunk down, whereas in the '080, it's the application itself, which -- actually just as a prerequisite, do you agree there's a difference between application and the display that the application is on?

MR. AHMED: So the claim language says displaying a first screen of an application, right? In a first display. And so your question, Your Honor, just so I understand is, is there a difference between an application and a -- the screen on which the application is displayed? Is that --

JUDGE JUNG: Let me rephrase. The display of the application itself, that's distinguishable from -- like, from the desktop, the display of a desktop, correct?

MR. AHMED: Okay. I understand. Yep.

JUDGE JUNG: So is there -- those would be two distinct things, right? A window for the application and the desktop?

MR. AHMED: Yeah. So in the hypothetical you're describing, I would agree. Yeah.

Paper 26, 34:21-38:8.

In view of Petitioners' admission that there is a difference between indicating an open display or screen (as in Ogawa) versus indicating an open application (as claimed), and the evidence establishing that Ogawa teaches only the former but not the latter, the only possible conclusion is that Ogawa cannot suggest the claims if correctly construed. The Final Written Decision should thus be reversed.

III. CONCLUSION

The Board's claim construction is contrary to longstanding and established Federal Circuit precedent. Multifold respectfully requests that the Director grant review to correct the Board's error in claim construction.

Respectfully submitted,

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Date: May 22, 2026

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This paper contains 11 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 22, 2026

CERTIFICATE OF SERVICE

I hereby certify that on May 22, 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 Petitioners by electronic mail to the following addresses:

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