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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/002,132	08/31/2012	7,461,353 B2	SV.95002132	1682

59860 7590 02/26/2025
LAW OFFICE OF R. ALAN BURNETT
4108 131ST AVE. SE
BELLEVUE, WA 98006

EXAMINER

BASEHOAR, ADAM L

ART UNIT	PAPER NUMBER
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3992

MAIL DATE	DELIVERY MODE
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02/26/2025

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,634	05/20/2011	7,461,353	SV.95000634	8853

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Apple Inc.
Appeal 2021-005530 Requester and Cross-Appellant

v.

Patent of Soft View LLC
Patent Owner and Appellant

AND

Motorola Mobility, LLC
Appeal 2022-000153 Requester and Cross-Appellant

v.

Patent of Soft View LLC
Patent Owner and Appellant

Appeals 2021-005530 and 2022-000153
Reexamination Control Nos. 95/000,634 and 95/002,132
Patent US 7,461,353 B2
Technology Center 3900

Before ALLEN R. MacDONALD, ERIC B. CHEN, and
BRIAN J. McNAMARA, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

STATEMENT OF THE CASE

We issue this decision on remand from the United States Court of Appeals for the Federal Circuit (*SoftView LLC v. Apple Inc.*, 108 F.4th 1366 (Fed. Cir. 2024)). In our April 2022 decisions, we reversed the Examiner's rejections and entered a new ground of rejection based on estoppel under 37 C.F.R. § 42.73(d). The Federal Circuit affirmed in part and vacated and remanded in part. *SoftView*, 108 F.4th at 1375.

PROCEDURAL BACKGROUND

PTAB Decisions (April 6, 2022)

In deciding an appeal of *Inter Partes* Reexamination No. 95/000,634 ('634 reexamination'), we concluded:¹

The Examiner erred in rejecting claims 2–28, 30–32, 34, 35, 37, 38, 41, 44–46, 50, 53–55, 60, 61, 69–83, 85–105, 107–111, 122–126, 128–135, 137, 140, 141, 144, 145, 147, 150–152, 154, 156–159, 161–177, 184–203, 205–209, 215, 216, 226–236, 238–242, 245–248, 251, 253, 254, 257, 259, 264–271, 274–277, 285–303, 305–310, and 318–321 as being unpatentable under 35 U.S.C. § 103.

The Examiner erred in making a final decision favorable to the patentability of claims 106, 182, 204, 282, 304, and 322.

We newly reject all claims subject to this reexamination based on 37 C.F.R. § 42.73(d) estoppel as not being patentably distinct from claims finally cancelled during an *inter partes* review of the patent which is the subject of this reexamination.

¹ The claims before the PTAB were those as further amended by the November 1, 2018 Written Comments to Action Closing Prosecution.

Appeals 2021-005530 and 2022-00153
Reexamination Control Nos. 95/000,634 and 95/002,132
Patent US 7,461,353 B2

Appeal 2021-005530, 86 (PTAB April 6, 2022).

Also, on April 6, 2022, in deciding an appeal of *Inter Partes* Reexamination Application No. 95/002,132 (“the ’132 reexamination”), we concluded:

The Examiner erred in rejecting claims 5, 6, 23–27, 60, 61, 70, 122, 137, 140, 141, 147, 156, 174–177, 216, 238–242, 248, 259, 274–277, 320, and 321 as being unpatentable under 35 U.S.C. § 103.

The Examiner erred in making a final decision favorable to the patentability of claim 322.

We newly reject all claims subject to this reexamination based on 37 C.F.R. § 42.73(d) estoppel as not being patentably distinct from claims finally cancelled during an *inter partes* review of the patent which is the subject of this reexamination.

Appeal 2021-000153, 15 (PTAB April 6, 2022).

Federal Circuit Opinion (July 26, 2024)

On July 26, 2024, the Federal Circuit affirmed our application of the estoppel provision of 37 C.F.R. § 42.73(d)(3)(i) to “new claims or amended claims, but not to previously issued claims.” *SoftView*, 108 F.4th at 1369. Specifically, the court held the following:

[W]e affirm the Board’s application of section 42.73(d)(3)(i) to the amended claims, but ***we vacate and remand*** for further consideration of the application of the regulation to issued claims 3, 6, 11, 18, 30–32, 35, 37–38, 41, 50, 53, 55, 69–70, 75, 87, 111, 128, 131, 133–34, 144–45, 147, 150–51, 154, 161, 165, 168–69, 171, 182, 184–87, 189–94, 196, 199, 203–04, 206–07, 209, 216, 253–54, 264, 267, 269, 282, 285–88, 290–94, 296, 303, 304–07, 310, and 318–22.

Id. at 1375–76 (emphasis added).

DISCUSSION

The Federal Circuit remanded as to the “issued” claims listed above. Four of the claims, however, were amended or added during reexamination. Specifically, in the ’634 reexamination, in a July 24, 2017 Amendment, Patent Owner amended claim 147 and added claims 320–322.

As to the claims listed as remanded in the Federal Circuit’s *SoftView* decision, we previously reversed the Examiner’s rejection of those claims and we do not enter a new ground of rejection here. Therefore, these cases are remanded to the Examiner.

CONCLUSION

Accordingly, it is

ORDERED that reexamination Application No. 95/000,634 is remanded to the Examiner.

ORDERED that reexamination Application No. 95/002,132 is remanded to the Examiner.

REMANDED

Appeals 2021-005530 and 2022-00153
Reexamination Control Nos. 95/000,634 and 95/002,132
Patent US 7,461,353 B2

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