

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner

v.

UUSI, LLC d/b/a NARTRON,
Patent Owner.

Case IPR2016-00908
Patent No. 5,796,183

**PATENT OWNER'S RESPONSE TO PETITIONER'S
PAPER NO. 47 REGARDING PATENT OWNER'S
STATEMENTS IN IPR2019-00358**

The issue on remand is not whether a POSITA would have expected success in *generically* “modifying the Ingraham I-Caldwell combination” to “provide multiple frequencies to a touch pad.” Paper 47 at 1. It is whether a POSITA would have expected success in making the *specific* Caldwell-Ingraham I-Gerpheide combination asserted by Samsung. *See Samsung Elecs. Co. v. UUSI, LLC*, 775 F. App'x 692, 697 (Fed. Cir. 2019); *see also* Paper 2 at 28 (asserting that a POSITA “would have been motivated to incorporate interference negating functionality *similar to that described by Gerpheide* in the . . . Ingraham I-Caldwell system”) (emphasis added). Neither Gerpheide, Ingraham I nor Caldwell is at issue in IPR2019-00358. Rather, in that IPR, Apple is asserting entirely different references, including “Chiu” and “Schwarzbach.” Ex. 1019 at 1-3. Since Ingraham I, Caldwell and Gerpheide are not at issue in IPR2019-00358, Nartron could not possibly have “admitted,” in that IPR, that a POSITA would have had a reasonable expectation of success in combining those references. Nartron simply made no such admission.

To the contrary, Nartron’s statements in IPR2019-00358 relate solely to the adequacy of the *written description* of the ‘183 patent. Ex. 1019 at 19-28. Those statements have no bearing on whether, *without the benefit* of the ‘183 patent’s disclosure, a POSITA would have had a reasonable expectation of success in combining Caldwell, Ingraham I and Gerpheide, to arrive at the claimed invention.

Thus, Nartron’s statements in IPR2019-00358 are irrelevant to this remand.

Respectfully submitted,

Dated: December 17, 2019

By: /s/ Stephen Underwood
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on the date indicated below, a complete and entire copy of the foregoing PATENT OWNER'S RESPONSE TO PETITIONER'S PAPER NO. 47 REGARDING PATENT OWNER'S STATEMENTS IN IPR2019-00358 was served by email on the following counsel of record in this matter:

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