

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.,
Petitioner,

v.

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

Case IPR2019-00359
Patent 5,796,183

Before BRYAN F. MOORE, MINN CHUNG, and
NORMAN H. BEAMER, *Administrative Patent Judges*.

BEAMER, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining Some Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

In this *inter partes* review, instituted pursuant to 35 U.S.C. § 314, Apple Inc. (“Petitioner” or “Apple”) challenges the patentability of claims 27, 28, 32, 36, 83–88, and 90–93 (the “challenged claims”) of U.S. Patent No. 5,796,183 (Ex. 1001, “the ’183 patent”), owned by UUSI, LLC d/b/a Nartron (“Patent Owner”). This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed below, we determine Petitioner has shown by a preponderance of the evidence that claims 28, 32, 36, 83–85, and 90–93 of the ’183 patent are unpatentable, but has not proven by a preponderance of the evidence that claims 86–88 of the ’183 patent are unpatentable.

II. BACKGROUND

A. *Procedural History*

On November 29, 2018, Petitioner filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of the challenged claims. Patent Owner filed a Preliminary Response (Paper 8, “Prelim. Resp.”) on May 6, 2019.

On August 5, 2019, applying the standard set forth in 35 U.S.C. § 314(a), which requires demonstration of a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim, we instituted an *inter partes* review of the challenged claims. Paper 12 (“Inst. Dec.”). In the Institution Decision, we determined Petitioner demonstrated a reasonable likelihood that it would prevail as to at least one challenged claim, and we instituted trial on all claims and all grounds in the Petition. Inst. Dec. 63–64.

After institution, Patent Owner filed a Patent Owner Response (Paper 16, “PO Resp.”), Petitioner filed a Reply to Patent Owner Response

(Paper 19, “Reply”), and Patent Owner filed a Sur-reply (Paper 23, “Sur-reply”). An oral hearing was held on May 7, 2020, and a copy of the hearing transcript has been entered into the record. Paper 25 (“Hearing Tr.”).

B. Related Matters

According to Petitioner, the ’183 patent is the subject of the following district court litigation: *UUSI, LLC v. Apple Inc.*, No. 3-18-cv-04637 (N.D. Cal.); and *UUSI, LLC v. Apple Inc.*, No. 2:17-cv-13798 (E.D. Mich.), which has been transferred to the Northern District of California. Pet. 81. Patent Owner indicates that the ’183 patent is also the subject of *UUSI, LLC v. Samsung Electronics Co.*, No. 1:15-cv-00146 (W.D. Mich.). Paper 3, 2.

The ’183 patent has been subject to two reexaminations: Ex Parte Reexamination Control No. 90/012,439 (“the ’439 Reexamination Proceeding” or “the ’439 Reexamination”), certificate (“Reexam. Cert. C1”) issued April 29, 2013 (Ex. 1006, 1); and Ex Parte Reexamination Control No. 90/013,106 (“the ’106 Reexamination Proceeding” or “the ’106 Reexamination”), certificate (“Reexam. Cert. C2”) issued June 27, 2014 (Ex. 1007, 24). The challenged claims were amended or added during the reexaminations. Ex. 1006, 2–3; Ex. 1007, 27–28.

The ’183 patent is the subject of an earlier-filed *inter partes* review proceeding, *Samsung Electronics Co. v. UUSI, LLC*, Case IPR2016-00908 (“Samsung IPR”). Pet. 71; Paper 3, 1. On June 18, 2019, the Federal Circuit vacated the final written decision in the Samsung IPR, in which the Board determined that Samsung had not demonstrated unpatentability of any claims, and remanded to the Board for further proceedings. *Samsung Elecs.*

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Co. v. UUSI, LLC, 775 F. App'x 692, 697 (Fed. Cir. 2019) (“Samsung Appeal Opinion”).

Petitioner has also filed five other petitions challenging claims of the '183 patent under various grounds in IPR2019-00355, IPR2019-00356, IPR2019-00357, IPR2019-00358, and IPR2019-00360. Paper 3, 1. We denied institution of review in IPR2019-00355, IPR2019-00356, IPR2019-00357, and IPR2019-00360. IPR2019-00355, Paper 14; IPR2019-00356, Paper 14; IPR2019-00357, Paper 12; IPR2019-00360, Paper 12. We instituted trial in IPR2019-00358 on August 5, 2019. IPR2019-00358, Paper 12.

C. *The '183 Patent*

The '183 patent, titled “Capacitive Responsive Electronic Switching Circuit,” was filed January 31, 1996, and issued August 18, 1998. Ex. 1001, codes (22), (45), (54). The '183 patent has expired. Prelim. Resp. 17.

The '183 patent relates to a “capacitive responsive electronic switching circuit used to make possible a ‘zero force’ manual electronic switch.” Ex. 1001, 1:6–9. According to the '183 patent, zero force touch switches have no moving parts and no contact surfaces that directly switch loads. *Id.* at 2:40–41. Instead, such switches detect an operator’s touch and use solid state electronics to switch loads or activate mechanical relays. *Id.* at 2:42–44. “A common solution used to achieve a zero force touch switch has been to make use of the capacitance of the human operator.” *Id.* at 3:12–14. As background, the '183 patent describes three methods used by capacitive touch switches to detect an operator’s touch, one of which relies on the change in capacitive coupling between a touch terminal and ground. *Id.* at 3:13–15, 3:44–46. In this method, “[t]he touch of an operator then

provides a capacitive short to ground via the operator's own body capacitance." *Id.* at 3:52–55. Figure 8, reproduced below, is an example that makes use of this method.

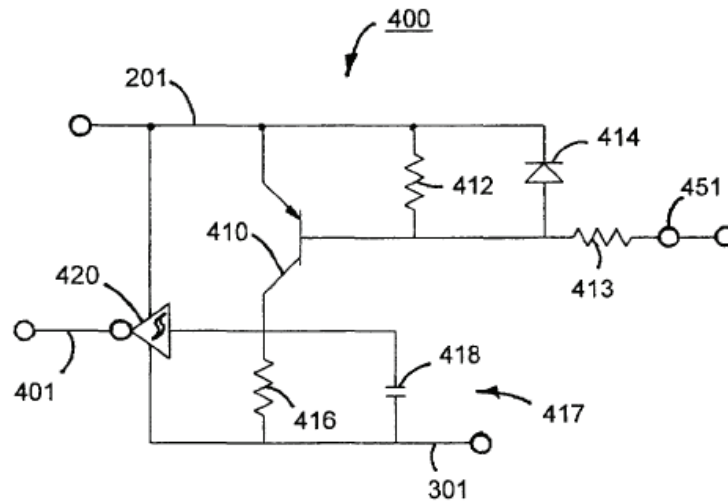


Fig. 8

Figure 8 depicts a “touch circuit” in which, when a pad (not shown) is touched to create a short to ground via terminal 451, transistor 410 turns on and connects a high frequency input at 201 to resistor/capacitor circuit 416/418, thus triggering Schmitt Trigger 420 to provide control output 401. *Id.* at 14:47–52, 15:17–47. Significantly, the operator of a capacitive touch switch using this method need not come in conductive contact with the touch terminal. *Id.* at 3:57–59. Rather, the operator needs only to come into close proximity of the switch. *Id.*

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