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Paper 36
Entered: January 10, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

IMMERSION CORPORATION,
Patent Owner.

Case IPR2016-01381
Patent 8,773,356 B2

Before MICHAEL R. ZECHER, NEIL T. POWELL, and MINN CHUNG, *Administrative Patent Judges.*

POWELL, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
Inter Partes Review
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

A. *Background*

Apple Inc. ("Petitioner") filed a Petition requesting an *inter partes* review of claims 1–3, 5, 7, 9–13, 15, 17, 19–23, 25, and 26 of U.S. Patent No. 8,773,356 B2 (Ex. 1001, "the '356 patent"). Paper 1 ("Pet."). Patent Owner, Immersion Corporation, filed a Preliminary Response. Paper 6 ("Prelim. Resp."). In view of those submissions, we instituted an *inter partes* review of claims 1–3, 5, 7, 9–13, 15, 17, 19–23, 25, and 26. Paper 7 ("Institution Decision" or "Dec. on Inst."). Subsequently, Patent Owner filed a Patent Owner Response (Paper 13, "PO Resp."), and Petitioner filed a Reply (Paper 18, "Pet. Reply").

We have jurisdiction over this proceeding under 35 U.S.C. § 6(b). After considering the evidence and arguments of the parties, we determine that Petitioner has proven by a preponderance of the evidence that claims 1–3, 5, 7, 9–13, 15, 17, 19–23, 25, and 26 of the '356 patent are unpatentable. *See* 35 U.S.C. § 316(e). We issue this Final Written Decision pursuant to 35 U.S.C. § 318(a).

B. *Related Matters*

The parties note the following related cases: *Immersion Corp. v. Apple Inc.*, No. 1-16-cv-00077 (D. Del.); *In re: Certain Mobile Electronic Devices Incorporating Haptics (Including Smartphones and Smartwatches) and Components Thereof*, ITC Investigation No. 337-TA-990 (USITC), which has been consolidated with *In re: Certain Mobile and Portable Electronic Devices Incorporating Haptics (Including Smartphones and Laptops) and Components Thereof*, ITC Investigation No. 337-TA-1004 (USITC). *See* Pet. 1–2; *see* Paper 4, 2. Additionally, a petition requesting

an *inter partes* review of a certain subset of claims of the '356 patent was filed in Case IPR2016-00807. *See* Pet. 2; Paper 4, 2. In that case, we denied Petitioner's request to institute an *inter partes* review as to claims 1–3, 5, 7, 9–13, 15, 17, 19–23, 25 and 26 of the '356 patent as unpatentable under 35 U.S.C. §§ 102(e) and 103(a). *Amit Agarwal v. Immersion Corp.*, Case IPR2016-00807 (PTAB Sept. 19, 2016) (Paper 16).

C. *Instituted Grounds of Unpatentability*

We instituted a trial based on the following grounds of unpatentability (Dec. on Inst. 27):

References	Statutory Basis	Challenged Claim(s)
Rosenberg 737[1] and Rosenberg 281[2]	35 U.S.C. § 103(a)	1–3, 9–13, 19–23, 25, and 26
Rosenberg 737, Rosenberg 281, and Newton 2.0[3]	35 U.S.C. § 103(a)	5, 7, 15 and 17

Petitioner also relies on declarations from Patrick Baudisch, Ph.D. (Exs. 1002, 1025). Patent Owner relies on a Declaration from Nathan J. Delson, Ph.D. (Ex. 2005).

D. *The '356 Patent*

The '356 patent describes a system and method for providing tactile sensations to input devices, including non-mechanical input devices, such as

[1] U.S. Patent Application No. 09/487,737 (Ex. 1007).

[2] U.S. Patent Application No. 09/103,281 (Ex. 1013).

[3] *Newton 2.0 User Interface Guidelines*, ©1996 Apple Computer, Inc., ISBN 0-201-48838-8, First Printing, May 1996 (Ex. 1014).

soft-keys displayed on a screen. *See* Ex. 1001, Abstract; 3:10–15. Figure 5 of the '356 patent is reproduced below.

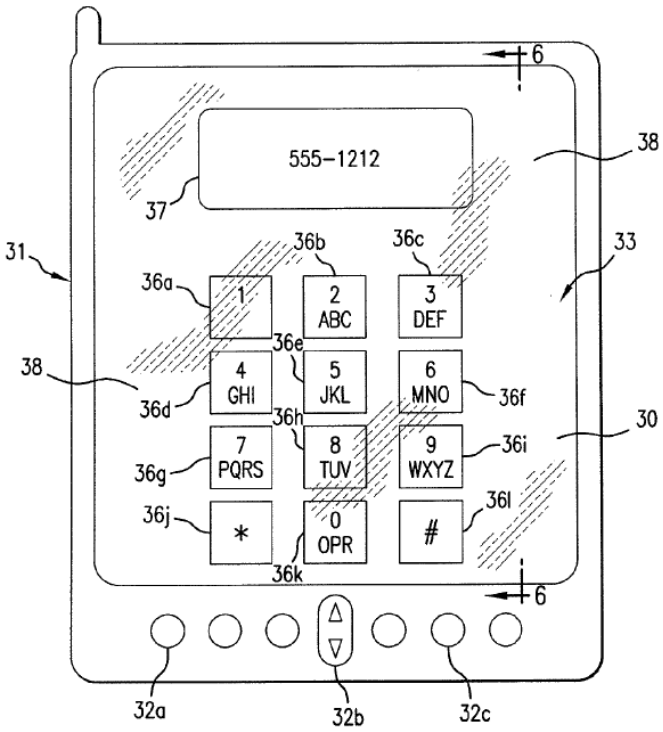

FIG.5

Figure 5 depicts Personal Digital Assistant (PDA) 31 having pressure-sensitive touchpad 30 as an input device. *Id.* at 11:11–13. As shown in Figure 5, display panel 33 of PDA 31 displays software-generated buttons or keys (e.g., soft-keys 36a–36i), which provide a graphical user interface for the PDA. *Id.* at 11:40–43. As a graphical object, each soft-key occupies a distinct location on the display panel. *Id.* at 11:44–45. In the embodiment depicted in Figure 5, the PDA can function as a mobile telephone, and the soft-keys are arranged as a telephone keypad to provide the same functionality as the mechanical keys on a conventional telephone keypad. *Id.* at 11:45–48. PDA 31 also includes an actuator that generates and

transmits tactile sensations to display panel 33 and touchpad 30. *Id.* at 11:22–39; Fig. 6.

When a soft-key is selected by touching touchpad 30 at an appropriate location on display panel 33, a controller determines the touched location on the display and identifies the soft-key corresponding to the touched location. Based on this information, the controller causes the actuator to provide a corresponding tactile sensation. *Id.* at 11:53–63. In addition, the pressure applied to a particular soft-key is detected by the controller or a separate pressure detector, such that the detected pressure can be used to distinguish different inputs for soft-keys that represent multiple inputs—e.g., 2, A, B, or C for soft-key 36b. *Id.* at 12:6–12; Fig. 5. For such keys, each specific input corresponds to a distinct amount of pressure applied to a particular soft-key. *Id.* at 12:6–8.

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