

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

IMMERSION CORPORATION,
Patent Owner

Case IPR2016-01777
Patent 8,749,507

**PETITIONER'S REQUEST FOR REHEARING
PURSUANT TO 37 C.F.R. § 42.71(d)**

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Patent Trial and Appeal Board
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I. INTRODUCTION

Pursuant to 37 CFR §42.71, Apple Inc. (“Petitioner”) respectfully requests rehearing of the Decision Denying Institution of *Inter Partes* Review issued on March 23, 2017 (Paper 7, “Decision”) denying authorization of *inter partes* review of claims 1-5, 9-12, and 14-17 of U.S. Patent No. 8,749,507 (the “’507 patent”) based upon Ground 1, obviousness in light of Toda in view of Shahoian. The basis for this denial was Toda’s alleged failure to disclose or render obvious the limitation “determining a press if: the pressure is greater than a pressure threshold, the change in pressure is greater than a change in pressure threshold, and a first interval has elapsed.”

Petitioner respectfully submits that the Board misapprehended the meaning of this limitation and the disclosure of Toda.

II. LEGAL STANDARDS

A. The Standard of Review for Rehearing

“A party dissatisfied with a decision may file a request for rehearing.” 37 C.F.R. § 42.71(d). Such a request must “identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” *Id.* Rehearing requests are reviewed for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion is found when “the decision is based on an erroneous interpretation of

the law, on factual findings that are not supported by substantial evidence, or represents an unreasonable judgment in weighing relevant factors.” *Gose v. United States Postal Service*, 451 F.3d 831, 836 (Fed. Cir. 2006) (citation omitted); *Illumina, Inc. v. Trs. of Columbia Univ.*, IPR2013-00011, Paper 44 at 2 (PTAB May 10, 2013) (citing *PPG Indus. Inc. v. Celanese Polymer Specialties Co. Inc.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988)).

B. The Standard For Instituting An *Inter Partes* Review

An *inter partes* review may be instituted only if “information presented in the petition ... and any response ... shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). When a trial is instituted, the Board narrows issues “by authorizing the trial to proceed only on the challenged claims for which the threshold standards for the proceeding have been met.” Trial Practice Guide, 77 Fed. Reg. 48756, 48757 (August 14, 2012).

III. CLAIM CONSTRUCTION

A. The Board misapprehended the “determining a press ...” limitation to require that the first two criteria be maintained for the duration of the interval of the third criteria.

Independent claims 1, 9, and 14 each recite, “determining a press if: the pressure is greater than a pressure threshold, the change in pressure is greater than a change in pressure threshold, and a first interval has elapsed.” Ex. 1001 at claims

1, 9, and 14. This limitation recites three criteria used to determine a press: (1) the pressure is greater than a pressure threshold; (2) the change in pressure is greater than a change in pressure threshold; and (3) a first interval has elapsed. *Id.* The Board found that “the first two conditions must be maintained for the duration of the first interval.” Decision at 5; *see also id.* at 14-15 (“the other two conditions—*i.e.*, the pressure exceeds the pressure threshold, and the change in pressure is greater than the change threshold—must be maintained for the duration of the first interval before a press is determined”). Notably, neither party, not even the Patent Owner, has ever asked for such a narrow construction—not in this proceeding governed by the broadest reasonable interpretation standard, and not in the ongoing ITC proceeding governed by the *Phillips* standard. While this fact is not dispositive, it suggests that an error in claim construction may have been made. As demonstrated below, Apple respectfully submits that the Board did misapprehend the broadest reasonable interpretation of this limitation.

“[T]he claim construction inquiry ... begins and ends in all cases with the actual words of the claim.” *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1248 (Fed. Cir. 1998). The '507 patent claims recite using three independent criteria, listed above, to determine whether a press has occurred. Importantly, the actual words of the claims do not specify that the first two criteria must both be maintained for the entire duration of the first interval. For example,

the actual words of the claims do not recite, “the pressure is greater than a pressure threshold while a first interval has elapsed.” The Board apparently did not find otherwise because it did not tie its construction to the actual words of the claim. Decision at 5. The Board’s interpretation therefore improperly rewrites the claims. *Rembrandt Data Techs. LP v. AOL, LLC*, 641 F.3d 1331, 1339 (Fed. Cir. 2011).

Nor does the specification disclose an embodiment that requires the first two claimed criteria to be maintained for the duration of the claimed first interval to determine a press. The Board’s Decision denying institution states that the embodiment of Figure 3 requires that the first two conditions must be maintained for the duration of the first interval. Decision at 4-5. However, the embodiment of Figure 3 includes no such requirement.

For example, in Figure 3, the system can start the tick count in step 316 (indicating the beginning of the interval), follow the “YES” branch of step 320 to step 322, branch “NO” in step 322 (indicating that the change in pressure is not greater than the change in pressure threshold), loop back to step 302, follow the “YES” branch to step 314, follow the “YES” branch to step 320, follow the “YES” branch to step 322, follow the “YES” branch to step 324 (indicating that the change in pressure is now greater than the change in pressure threshold), and follow the “YES” branch of step 324 (indicating that the first interval has elapsed) to state 326, indicating that a press has occurred. Ex. 1001 at Fig. 3. In this

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