UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,
Petitioner,

v.

IMMERSION CORPORATION,
Patent Owner.

———————

Case IPR2017-00897
Patent 8,773,356 B2

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

POWELL, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314(a) and 37 C.F.R. § 42.108

I. INTRODUCTION

A. *Background*

Apple Inc. ("Petitioner") filed a Petition (Paper 1, "Second Petition," or "Second Pet.") requesting an *inter partes* review of claims 1–26 of U.S. Patent No. 8,773,356 B2 (Ex. 1101, "the '356 patent"). As discussed further below, the Second Petition challenges most of the same claims of the '356 patent that Petitioner challenged in its prior Petition filed in Case IPR2016-01381. Patent Owner, Immersion Corporation, filed a Corrected Preliminary Response. Paper 10 ("Prelim. Resp.").

Institution of *inter partes* review is discretionary. *See* 35 U.S.C. § 314(a); 37 C.F.R. § 42.108(a). Under the circumstances of this case, and for the reasons explained below, we exercise our discretion to not institute *inter partes* review on any of claims 1–26 of the '356 patent.

B. *Related Matters*

According to the parties, the '356 patent is the subject of the following proceedings: (1) *Immersion Corp. v. Apple Inc.*, No. 1:16-cv-00077 (D. Del.); and (2) *In the Matter of: Certain Mobile Electronic Devices Incorporating Haptics (Including Smartphones and Smartwatches) and Components Thereof*, No. 337-TA-990 (USITC), which has been consolidated with *In the Matter of: Certain Mobile and Portable Electronic Devices Incorporating Haptics (Including Smartphones and Laptops) and Components Thereof*, No. 337-TA-1004 (USITC) ("related ITC proceeding"). Second Pet. 1; Paper 4, 2. The '356 patent is also the subject of an instituted trial proceeding in Case IPR2016-01381. *Apple Inc. v. Immersion Corp.*, Case IPR2016-01381 (PTAB Jan. 11, 2017) (Paper 7) ("1381 Dec. on Inst.").

C. The Asserted Grounds of Unpatentability

Petitioner contends that claims 1–26 of the '356 patent are

unpatentable based on the following grounds:

Reference(s)	Statutory Basis	Challenged Claims
Fukumoto[1]	35 U.S.C. § 103(a)	1–3, 5, 9–13, 15, 18–23, 25, and 26
Fukumoto and Roysden[2]	35 U.S.C. § 103(a)	8 and 18
Tsuji[3]	35 U.S.C. § 103(a)	1–7, 9–17, and 19–26

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

soft-keys displayed on a screen. *See* Ex. 1101, Abstract; 3:10–15. Figure 5

of the '356 patent is reproduced below.

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[1] International Patent Application No. WO 02/12991 A1, Pub. Feb. 14, 2002 (Exs. 1107, 1108 (English translation)).

[2] U.S. Patent No. 5,575,576, iss. Nov. 19, 1996 (Ex. 1115).

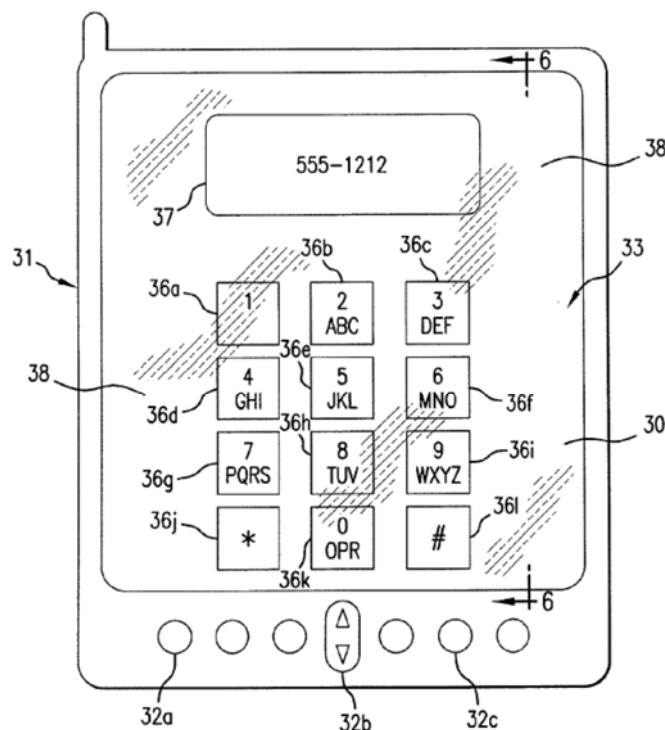[3] Japanese Published Application No. H11-212725, pub. Aug. 6, 1999 (Exs. 1110, 1111 (English translation)).

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 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. *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 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 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.

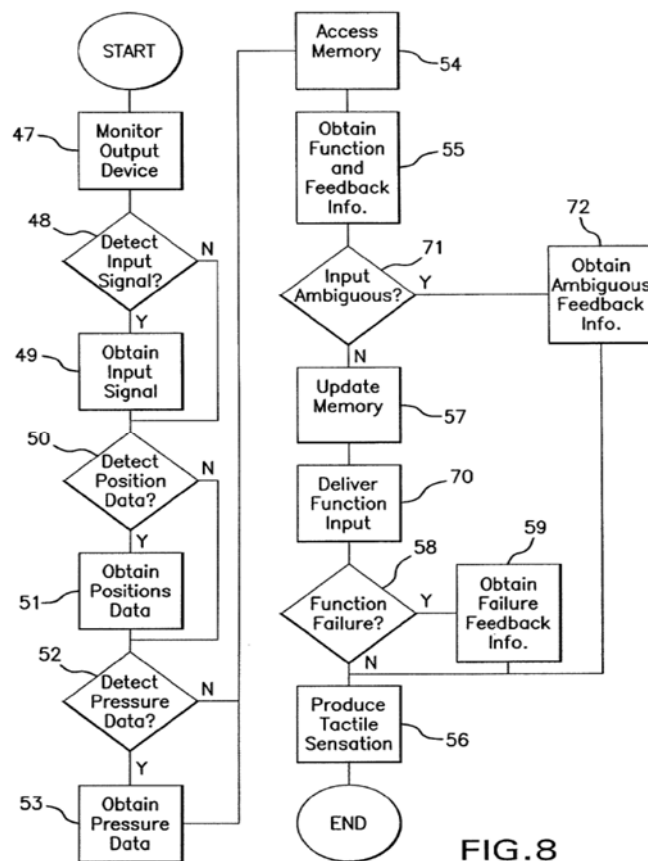Figure 8 of the '356 patent is reproduced below.

FIG.8

DOCKET ALARM

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