NOTE: This disposition is nonprecedential.

United States Court of Appeals for the Federal Circuit

APPLE INC.,
Appellant

v.

UUSI, LLC, DBA NARTRON,
Cross-Appellant

KATHERINE K. VIDAL, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE,
Intervenor

2021-1035, 2021-1036, 2021-1057, 2021-1058

Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2019-00358, IPR2019-00359.

Decided: April 25, 2023

LAUREN ANN DEGNAN, Fish & Richardson P.C., Washington, DC, argued for appellant. Also represented by CHRISTOPHER DRYER; NITIKA GUPTA FIORELLA, Wilmington, DE.

LAWRENCE MILTON HADLEY, Glaser Weil Fink Howard Avchen & Shapiro LLP, Los Angeles, CA, argued for cross-appellant. Also represented by STEPHEN UNDERWOOD.

BENJAMIN T. HICKMAN, Office of the Solicitor, United States Patent and Trademark Office, Alexandria, VA, for intervenor. Also represented by MARY L. KELLY, THOMAS W. KRAUSE, FARHEENA YASMEEN RASHEED.

Before DYK, BRYSON, and PROST, *Circuit Judges*.

PROST, *Circuit Judge*.

Apple Inc. ("Apple") filed two petitions for inter partes review of various claims of U.S. Patent No. 5,796,183 ("the '183 patent"), which UUSI, LLC, d/b/a Nartron ("Nartron") owns. The Patent Trial and Appeal Board ("Board") determined that some claims were shown to be unpatentable while others weren't. *Apple, Inc. v. UUSI, LLC*, IPR2019-00358, Paper 26, 2020 WL 4546916, at *44 (P.T.A.B. Aug. 4, 2020) ("*Final Written Decision*"); *Apple, Inc. v. UUSI, LLC*, IPR2019-00359, Paper 27, 2020 WL 4542561, at *37 (P.T.A.B. Aug. 4, 2020).[1] Apple appeals, and Nartron cross-appeals. We affirm as to both the appeal and cross-appeal.

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[1] Because the issues on appeal are common to both underlying final written decisions and the outcomes do not depend on any differences in the record, the remainder of this opinion cites only the Petition and Final Written Decision in the '358 proceeding for simplicity.

BACKGROUND

I

The '183 patent relates to capacitive responsive electronic switching circuits. Claims 37, 94, and 97 are representative for purposes of this appeal.

Claim 37 recites:

> 37. A capacitive responsive electronic switching circuit for a controlled device comprising:
>
> an oscillator providing a periodic output signal having a predefined frequency, wherein *an oscillator voltage is greater than a supply voltage*;
>
> a microcontroller using the periodic output signal from the oscillator, the microcontroller *selectively providing signal output frequencies* to *a closely spaced array* of input touch terminals of a keypad, the input touch terminals comprising first and second input touch terminals;
>
> the first and second touch terminals defining areas for an operator to provide an input by proximity and touch; and
>
> a detector circuit coupled to said oscillator for receiving said periodic output signal from said oscillator, and coupled to said first and second touch terminals . . . .

'183 patent claim 37 (emphasis added); J.A. 233.

Claim 94 recites:

> 94. A capacitive responsive electronic switching circuit for a controlled keypad device comprising:
>
> an oscillator providing a periodic output signal having a predefined frequency; [and]

> a microcontroller using the periodic output signal from the oscillator . . ., and wherein *a peak voltage of the signal output frequencies is greater than a supply voltage* . . . .

'183 patent claim 94 (emphasis added); J.A. 238.

> Claim 97 recites:
>
> 97. The capacitive responsive electronic switching circuit as defined in claim 94, wherein each signal output frequency selectively provided to each row of the closely spaced array . . . is selected from *a plurality of Hertz values*.

'183 patent claim 97 (emphasis added); J.A. 239.

II

Apple petitioned for inter partes review challenging, in relevant part, claims 28, 32, 36–39, 83–88, 90–94, 96–99, 101–09, and 115–16 as obvious. The Board determined that Apple proved claims 28, 32, 36, 83–85, 90–94, 96, 101–106, and 115–116 were obvious but failed to prove claims 37–39, 86–88, 97–99, and 107–09 were obvious. Apple appeals with respect to claims 37–39, 86–88, 97–99, and 107–09. Appellant's Br. 15–16. Nartron cross-appeals with respect to claims 83–85, 90–94, 96, and 101–106. Appellee's Br. 56–57, 74.[2] For simplicity, we discuss the issues on appeal and cross-appeal in terms of representative claims 37, 94, and 97.

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[2] Nartron appears to cross-appeal with respect to claims that the Board upheld. *See, e.g.*, Appellee's Br. 74 (asking for this court to determine that claims "83–88, 90–94, 96–99, and 101–104" were nonobvious). For claims on which Nartron prevailed, a cross-appeal is improper. We therefore do not consider Nartron's arguments with respect to such claims.

We have jurisdiction under 28 U.S.C. § 1295(a)(4)(A).

DISCUSSION

I

Apple's appeal challenges: (A) the Board's refusal to consider an argument that the combination of Chiu and Schwarzbach taught "an oscillator voltage . . . greater than a supply voltage" for claim 37; and (B) the Board's determination that Apple failed to prove a motivation to combine and reasonable expectation of success in combining Chiu, Schwarzbach, and Meadows for claim 97.[3] We review the Board's determination that Apple failed to raise an argument in its Petition for abuse of discretion. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016). We review the Board's motivation-to-combine and reasonable-expectation-of-success findings for substantial evidence, *id.* at 1366, which is "such relevant evidence as a reasonable mind might accept as adequate to support a conclusion," *Novartis AG v. Torrent Pharms. Ltd.*, 853 F.3d 1316, 1324 (Fed. Cir. 2017).

A

Apple, in relevant part, challenged claim 37 as obvious in view of Chiu and Schwarzbach. *See* J.A. 264. In its Final Written Decision, the Board determined that Apple's Petition argued *only* that Schwarzbach alone taught the limitation of claim 37 requiring "an oscillator voltage . . . greater than a supply voltage." *Final Written Decision*, 2020 WL 4546916, at *32–34. For the reasons outlined below, this reading of Apple's Petition was not an abuse of discretion, so we affirm the Board's determination that Apple failed to prove that claim 37 was unpatentable.

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[3] U.S. Patent No. 4,561,002 ("Chiu"); U.S. Patent No. 4,418,333 ("Schwarzbach"); U.S. Patent No. 4,922,061 ("Meadows").

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