Paper No. 23
Filed: April 3, 2020

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 IPR2019-00358
Patent No. 5,796,183

PATENT OWNER'S SUR-REPLY BRIEF

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I. INTRODUCTION

Apple accuses Nartron of "misrepresent[ing] the Federal Circuit's holding" in *Samsung Elecs. Co. v. UUSI, LLC*, 775 F. App'x 692 (Fed. Cir. 2019). Paper 19 ("Reply") at 1. Nartron did no such thing. Nartron stated that the Federal Circuit issued a "claim construction," Paper 16 ("POR") at 15-19, because the Federal Circuit characterized its own decision as a "claim construction." *Samsung,* 775 F. App'x at 697. Applying the Federal Circuit's construction, Apple has not established that any claim is unpatentable. Apple's Petition also fails for reasons unrelated to claim construction. Thus, the patentability of all challenged claims should be confirmed.

II. ARGUMENT

A. The Board Should Adopt the Federal Circuit's Construction

1. The Federal Circuit Issued an Express Claim Construction

The Federal Circuit's *Samsung* opinion states: ***"[b]ased on the proper claim construction***, we *vacate* and *remand* for the Board to consider whether … the combination could have been modified ***to 'provide' a frequency, selected from multiple possible frequencies, to the entire touch pad***)." *Id.* This statement expressly construed the "selectively providing" term to mean "providing a frequency, selected from multiple possible frequencies, to the entire touch pad."

Apple asserts that the Federal Circuit "d[id] not expressly construe" the "selectively providing" term. Reply, 3-5. Not so. The Federal Circuit found that the

Board implicitly construed the "selectively providing" limitation as requiring a microprocessor to provide "different frequencies ***to different rows***" of the touch pad. *Samsung*, 775 Fed. App'x at 697. According to the Federal Circuit, the Board's implicit construction erred because "selectively providing" does not require providing different frequencies to different rows; rather, it requires "that different frequencies be provided ***to the entire pad***." *Id.* This alone confirms that the Federal Circuit construed "selectively providing" to require selecting a frequency, from multiple frequencies, to provide to the entire touch pad.

Apple next asserts that the Federal Circuit's discussion of "select[ing] from multiple possible frequencies" was not a "claim construction," but merely a discussion of the "Gerpheide" reference. Reply, 3-4. This is incorrect. The Federal Circuit instructed the *Samsung* panel to decide, on remand, whether a POSITA would have had a reasonable expectation of success in modifying Ingraham/Caldwell/Gerpheide to "provide a frequency, selected from multiple possible frequencies." *Samsung*, 775 Fed. App'x at 697. The Federal Circuit would not have issued this instruction unless it determined that the claims require such a "selection." *BTG Int'l Ltd. v. Amneal Pharm. LLC,* 923 F.3d 1063, 1074 (Fed. Cir. 2019) ("reasonable expectation of success" must be viewed "under [the claim] construction.") Thus, the Federal Circuit's instruction confirms that it construed "selectively providing" to require selection from among multiple frequencies.

2. The Board Should Adopt the Federal Circuit's Construction

Apple points to the fact that the Federal Circuit designated its *Samsung* decision "nonprecedential." Reply, 2. But the Federal Circuit permits parties to cite non-precedential decisions. Fed. Cir R. 32.1(c). Lower tribunals routinely follow non-precedential Federal Circuit decisions. *See, e.g.*, *Permacel Kansas City, Inc. v. Soundwich, Inc.,* 2006 WL 1449979 at *3 (W.D. Mo. 2006); *General Protecht Group, Inc. v. Leviton Manufacturing Co.,* 2015 WL 4988635, *16 (D.N.M. 2015). Tribunals are particularly apt to follow non-precedential Federal Circuit ***claim construction*** decisions involving the same patents and claim terms at issue. *See, e.g.*, *Aspex Eyewear, Inc. v. Concepts In Optics, Inc.,* 211 F. App'x 955, 957 (Fed. Cir. 2007); *Burke, Inc. v. Bruno Indep. Living Aids, Inc.,* 183 F.3d 1334, 1338 (Fed. Cir. 1999). And, this Board has repeatedly noted that it may rely on, and adopt, the Federal Circuit's non-precedential decisions. *Ex Parte Colin Rule*, No. APPEAL 2017-009307, 2018 WL 3004509, at *4 (P.T.A.B. May 25, 2018); *Ex Parte Takayuki Sano*, No. APPEAL 2017-002144, 2018 WL 388953, at *3 (P.T.A.B. Jan. 10, 2018).

The *Samsung* panel issued an opinion construing the ***exact same*** claim term, in the same patent at issue before the Board. Accordingly, "[i]t would ... be reckless, to say the least, for [the Board] to rule in a manner inconsistent with an unpublished opinion of a panel of [its] reviewing court." *Permacel*, 2006 WL 1449979 at *3. The Federal Circuit's clear, well-reasoned, and correct construction should be followed.

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