

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 5,796,183

Before BRYAN F. MOORE, MINN CHUNG, and
NORMAN H. BEAMER, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

On November 29, 2018, Apple Inc. (“Petitioner” or “Apple”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 37–39, 94, 96–99, 101–109, and 115–117 (the “challenged claims”) of U.S. Patent No. 5,796,183 (Ex. 1001, “the ’183 patent”). UUSI, LLC d/b/a Nartron (“Patent Owner”) filed a Preliminary Response (Paper 8, “Prelim. Resp.”) on May 6, 2019. Pursuant to a May 22, 2019 Order (Paper 9), the parties exchanged briefs further addressing the issue of discretionary denial of institution under 35 U.S.C. § 314(a) (Papers 10, 11).

Institution of an *inter partes* review is authorized by statute when “the 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); *see* 37 C.F.R. § 42.4. For the reasons discussed below, upon considering the Petition, Preliminary Response, and evidence of record, we determine that the information presented in the Petition establishes a reasonable likelihood that Petitioner would prevail in showing the unpatentability of at least one challenged claim. We thus institute an *inter partes* review of all challenged claims (37–39, 94, 96–99, 101–109, and 115–117) of the ’183 patent, based on all grounds raised in the Petition. *See SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018); U.S. Patent and Trademark Office, *Guidance on the impact of SAS on AIA trial proceedings* (Apr. 26, 2018), <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial> (“SAS Guidance”).

II. BACKGROUND

A. *Related Matters*

According to Petitioner, the '183 patent is the subject of the following district court litigation: *UUSI, LLC v. Apple Inc.*, No. 3-18-cv-04637 (N.D. Cal.); and *UUSI, LLC v. Apple Inc.*, No. 2:17-cv-13798 (E.D. Mich.), which has been transferred to the Northern District of California. Pet. 81. Patent Owner indicates that the '183 patent is also the subject of *UUSI, LLC v. Samsung Electronics Co.*, No. 1:15-cv-00146 (W.D. Mich.). Paper 3, 2.

The '183 patent has been subject to two reexaminations: Ex Parte Reexamination Control No. 90/012,439, certificate ("Reexam. Cert. C1") issued April 29, 2013 (Ex. 1006, 1); and Ex Parte Reexamination Control No. 90/013,106, certificate ("Reexam. Cert. C2") issued June 27, 2014 (Ex. 1007, 24). The challenged claims were amended or added during the reexaminations. Ex. 1006, 2–3; Ex. 1007, 27–28.

The '183 patent is the subject of an earlier-filed *inter partes* review proceeding, *Samsung Electronics Co. v. UUSI, LLC*, Case IPR2016-00908 ("Samsung IPR"). Pet. 81; Paper 3, 1. The Federal Circuit recently vacated the Final Written Decision in the Samsung IPR, in which the Board determined that Samsung had not demonstrated unpatentability of any claims, and remanded to the Board for further proceedings. *Samsung Elecs. Co. v. UUSI, LLC*, No. 2018-1310, 2019 WL 2511739, at *5 (Fed. Cir. June 18, 2019) ("Samsung Appeal Opinion").

Petitioner has also filed five other petitions challenging claims of the '183 patent under various grounds in IPR2019-00355, IPR2019-00356, IPR2019-00357, IPR2019-00359, and IPR2019-00360. Paper 3, 1. We

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denied institution of review in IPR2019-00355, IPR2019-00356, and IPR2019-00357. IPR2019-00355, Paper 14; IPR2019-00356, Paper 14; IPR2019-00357, Paper 12.

B. The '183 Patent

The '183 patent, titled “Capacitive Responsive Electronic Switching Circuit,” was filed January 31, 1996, and issued August 18, 1998. Ex. 1001, [22], [45], [54]. The '183 patent has expired. Prelim. Resp. 18.

The '183 patent relates to a “capacitive responsive electronic switching circuit used to make possible a ‘zero force’ manual electronic switch.” Ex. 1001, 1:6–9. According to the '183 patent, zero force touch switches have no moving parts and no contact surfaces that directly switch loads. *Id.* at 2:40–41. Instead, such switches detect an operator’s touch and use solid state electronics to switch loads or activate mechanical relays. *Id.* at 2:42–44. “A common solution used to achieve a zero force touch switch has been to make use of the capacitance of the human operator.” *Id.* at 3:12–14. As background, the '183 patent describes three methods used by capacitive touch switches to detect an operator’s touch, one of which relies on the change in capacitive coupling between a touch terminal and ground. *Id.* at 3:13–15, 3:44–46. In this method, “[t]he touch of an operator then provides a capacitive short to ground via the operator’s own body capacitance.” *Id.* at 3:52–55. Figure 8, reproduced below, is an example that makes use of this method.

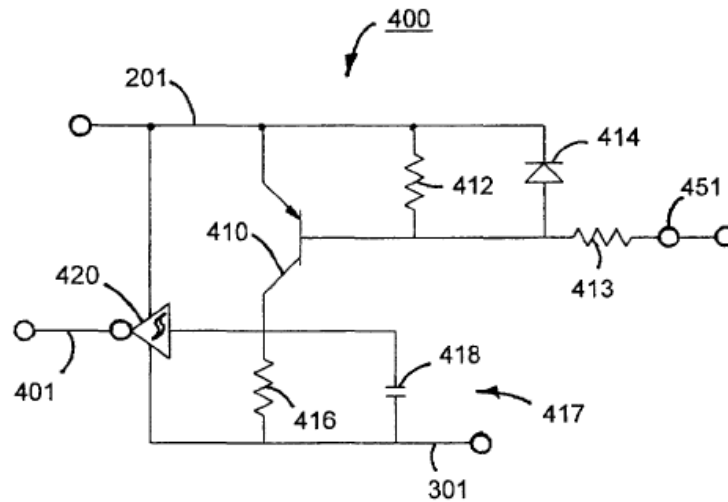


Fig. 8

Figure 8 depicts a “touch circuit” in which, when a pad (not shown) is touched to create a short to ground via terminal 451, transistor 410 turns on and connects a high frequency input at 201 to resistor/capacitor circuit 416/418, thus triggering Schmitt Trigger 420 to provide control output 401. *Id.* at 14:47–52, 15:17–47. Significantly, the operator of a capacitive touch switch using this method need not come in conductive contact with the touch terminal. *Id.* at 3:57–59. Rather, the operator needs only to come into close proximity of the switch. *Id.*

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