Paper No. 8
Filed: May 6, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.
Petitioner

v.

UUSI, LLC dba NARTRON
Patent Owner

Case IPR2019-00360
Patent No. 5,796,183

PATENT OWNER'S PRELIMINARY RESPONSE

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I. INTRODUCTION

U.S. Patent No. 5,796,183 ("'183 Patent") addresses the problem of unintended actuation in densely-spaced, capacitive responsive electronic switching circuit arrays on touch-operated devices. Ex 1001, 3:64-4:3. This is Apple's last of six separate petitions for *Inter Partes* Review ("IPR") challenging the '183 patent on obviousness grounds. In this IPR, Apple challenges two independent claims (40 and 61) and a number dependent claims on three grounds: (i) Chiu in combination with Schwarzbach (claims 40, 45, 47-48, 61-64, and 66); (ii) Chiu and Schwarzbach in combination with Meadows (claims 41-43 and 67-69); and, (iii) Chiu and Schwarzbach in combination with Ingraham '548 (claim 65).

The '183 Patent has been reexamined twice. More recently, all of the challenged claims were the subject of a recently-concluded IPR in which the Board, after institution, found insufficient evidence to support Petitioner Samsung's obviousness grounds.[1]

This new IPR challenge, filed on the heels of the last, should not be instituted. Apple never tries to explain why it needed to file six follow-on IPR petitions with grounds of rejection that overlap both one another and those presented in the Samsung IPR. Nor does Apple satisfactorily account for its delay

[1] The Board denied institution as to claims 37-39.

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in launching these six new IPRs. These failures become yet more egregious in the context of this IPR where, of the four references relied upon, two were known to Apple for years and one was cited during original prosecution of the '183 Patent. For these reasons alone, the Board should exercise its discretion to not institute this successive Petition. But even aside from Apple's duplicative challenges, the IPR should not be instituted because Apple fails to show that the asserted references contain all limitations of the challenged claims, and fails to show that a skilled artisan would have combined the references to make the challenged claims of the '183 patent.

First, Apple proposes a construction of one phrase used in each challenged claim—"providing signal output frequencies"—that is legally wrong and conflicts with how the Board used the phrase in the prior Samsung IPR. Under the legally correct construction—the same construction already used by the Board in the Samsung IPR—none of the asserted references in the proposed combinations contains the limitation in which the phrase appears.

Second, Apple's contention that both Chiu and Schwarzbach disclose an "oscillator" providing an output signal with a "predefined frequency" that activates touch terminals in an array, as required in all challenged claims, lacks support in the references. Chiu does not disclose an oscillator, much less an oscillator that provides a predefined frequency. While Schwarzbach discloses an oscillator as

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