Trials@uspto.gov
571-272-7822

Paper 11
Entered: August 5, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC., SAMSUNG ELECTRONICS CO., LTD., and SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

FIRSTFACE CO., LTD.,
Patent Owner.

Case IPR2019-00611
Patent 8,831,557 B2

Before JUSTIN T. ARBES, MELISSA A. HAAPALA, and RUSSELL E. CASS, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

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

I. INTRODUCTION

Apple Inc., Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. (collectively, "Petitioner") filed a Petition (Paper 3, "Pet.") requesting *inter partes* review of claims 1, 8, 9, and 15 of U.S. Patent No. 8,831,557 B2 (Ex. 1001, "the '557 patent") pursuant to 35 U.S.C. § 311(a). Patent Owner Firstface Co., Ltd. filed a Preliminary Response (Paper 9, "Prelim. Resp.") pursuant to 35 U.S.C. § 313. Pursuant to 35 U.S.C. § 314(a), the Director may not authorize an *inter partes* review unless the information in the petition and preliminary 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." For the reasons that follow, we do not institute an *inter partes* review in this proceeding.[1]

II. BACKGROUND

A. Related Proceedings

The parties indicate that the '557 patent is the subject of the following district court cases: *Firstface Co., Ltd. v. Samsung Elecs. Co., Ltd.*, Case No. 3-18-cv-02243 (N.D. Cal.), and *Firstface Co., Ltd. v. Apple Inc.*, Case No. 3-18-cv-02245 (N.D. Cal.). *See* Pet. 3; Paper 5, 2. Petitioner filed a second petition challenging claims 1, 8, 9, and 15 of the '557 patent in Case IPR2019-00612. Pet. 4. The grounds of unpatentability in the second petition are the same as those asserted in this proceeding, but are "premised on the possibility that the Board may use a [different] construction of the

[1] Although we granted Petitioner's motion to seal certain exhibits filed with the Petition (Paper 10), we do not refer to any sealed material in this Decision.

term 'simultaneously.'" *Id.* In a concurrently entered Decision, we institute an *inter partes* review in Case IPR2019-00612. Apple Inc. also filed petitions for *inter partes* review of two patents related to the '557 patent in Cases IPR2019-00613 and IPR2019-00614. *Id.*

B. The '557 Patent

The '557 patent discloses a mobile communication terminal with "an activation button configured to switch from an inactive state . . . to an active state," where "a predetermined operation is performed simultaneously with switching to the active state by pressing the activation button." Ex. 1001, Abstract. According to the '557 patent, adding functionality to a mobile communication terminal, to be performed when the terminal is in an active state, typically required adding an "interface or button for performing the function." *Id.* at col. 1, ll. 34–40. At the same time, terminal users often perform the actions of "habitually taking out and activating the terminal[] on the move or in a standby state while carrying the terminal[]." *Id.* at col. 1, ll. 45–48. The '557 patent seeks to take advantage of that habitual use by "connecting various operations to the activation button provided in a terminal" and performing a predetermined function whenever the user presses the activation button. *Id.* at col. 1, ll. 52–56.

Figure 1 of the ’557 patent is reproduced below.

FIG. 1

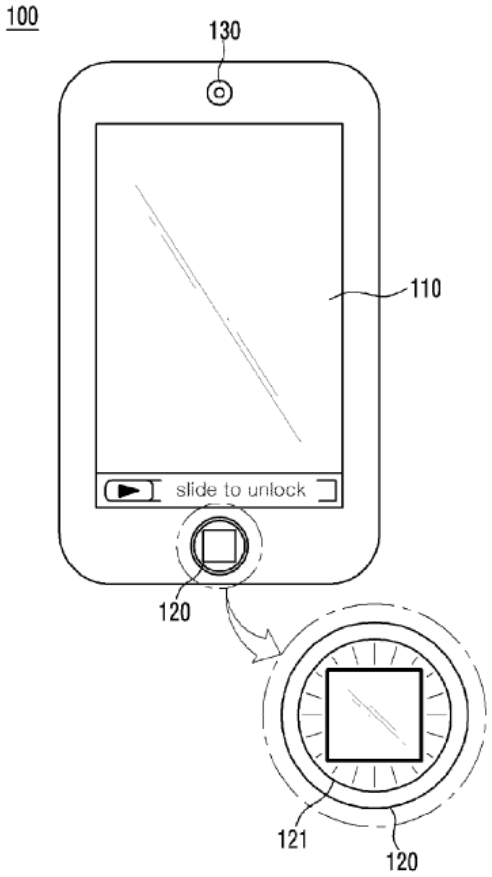

Figure 1 depicts mobile communication terminal 100 comprising camera 130, display unit 110, activation button 120, and sub-display unit 121. *Id.* at col. 3, ll. 51–55, col. 5, ll. 7–9. “[D]isplay unit 110 displays various information regarding operation states of the mobile communication terminal 100, and also displays an interface for a user’s input if the mobile communication terminal 100 drives a touch screen.” *Id.* at col. 4, ll. 3–6. When the user presses activation button 120, mobile communication terminal 100 switches from the inactive state (in which the terminal is communicable but the display screen is turned off) to the active state (in which the display screen is turned on). *Id.* at col. 3, ll. 28–46, col. 4,

ll. 27–35. Figure 1 above, for example, "illustrates a state in which a lock screen is displayed on the display unit 110 after pressing the activation button 120 when the mobile communication terminal 100 is in the inactive state." *Id.* at col. 4, ll. 32–35. If the user presses activation button 120 when mobile communication terminal 100 is in the inactive state, mobile communication terminal 100 may perform a "predetermined operation" (set in advance by the user) "simultaneously with switching to the active state." *Id.* at col. 2, ll. 1–17, col. 4, ll. 40–50. Mobile communication terminal 100 also may perform different operations depending on either the number of presses or the press time of activation button 120. *Id.* at col. 4, l. 50–col. 5, l. 6.

The '557 patent describes a number of operations that can be performed when activation button 120 is pressed. *Id.* at col. 5, ll. 44–49. For example, a "user authentication process can be performed for security by pressing the activation button 120." *Id.* at col. 7, ll. 4–7. When in the inactive state, mobile communication terminal 100 "senses whether or not the user has pressed the activation button" and, if so, performs a "user identification function." *Id.* at col. 7, ll. 14–19. User identification unit 420 of mobile communication terminal 100 may use camera activation element 421, iris detection element 422, and user identification element 423 to sense and recognize the iris of a user's eye. *Id.* at col. 7, ll. 20–50. The '557 patent explains that "other authentication methods, for example, an authentication key matching method, a password matching method, a face recognition method, a fingerprint recognition method, and the like, can be used" instead of the iris recognition method. *Id.* at col. 8, ll. 3–8.

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.