UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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APPLE INC.,
Petitioner,

v.

FIRSTFACE CO., LTD.,
Patent Owner.

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IPR2019-00613,
IPR2019-01011[1]
Patent 9,633,373 B2

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

HAAPALA, *Administrative Patent Judge*.

DECISION
Final Written Decision
Determining Some Challenged Claims Unpatentable
35 U.S.C. § 318(a)

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[1] Case IPR2019-01011 was consolidated with IPR2019-00613.
Accordingly, we issue a consolidated Final Written Decision, and all
citations are to IPR2019-00613 unless otherwise indicated.

Apple Inc. ("Petitioner") filed a Petition pursuant to 35 U.S.C.

§§ 311–319 to institute an *inter partes* review of claims 1, 2, 4–6, and 11–14

of U.S. Patent No. 9,633,373 B2 ("the '373 patent"). Paper 2 ("Pet.").

Petitioner later filed a Petition in IPR2019-01011 to institute an *inter partes*

review of claims 10 and 18 of the '373 patent. IPR2019-01011, Paper 1

("1011 Pet."). Firstface Co., Ltd. ("Patent Owner") filed a Preliminary

Response in IPR2019-00613 (Paper 8) and waived the filing of a preliminary

response in IPR2019-01011 (IPR2019-01011, Paper 7). Applying the

standard set forth in 35 U.S.C. § 314(a), we granted Petitioner's requests and

instituted an *inter partes* review of all challenged claims based on all

grounds presented in both Petitions. Paper 10 ("Dec."); Paper 14 ("1011

Dec.").[2] We further consolidated both proceedings and ordered all further

filings in the consolidated proceeding to be made in IPR2019-00613. 1011

Dec. 23.

During the trial, Patent Owner timely filed a Response (Paper 16,

"PO Resp."), to which Petitioner timely filed a Reply (Paper 18, "Reply").

Patent Owner further submitted a Sur-Reply (Paper 21, "Sur-Reply") to

Petitioner's Reply. An oral hearing was held on May 5, 2020, and a copy of

the transcript was entered into the record. Paper 26 ("Tr.").

We have jurisdiction under 35 U.S.C. § 6. This Decision is a Final

Written Decision under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73 as to the

patentability of the claims on which we instituted trial. For the reasons that

follow, we determine that Petitioner has shown by a preponderance of the

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[2] Although we granted Petitioner's motions to seal certain exhibits filed with
its Petitions (Paper 9; IPR2019-01011, Paper 8), we do not refer to any
sealed material in either Decision Granting Institution or in this Decision.

evidence that claims 1, 2, 4–6, and 10 are unpatentable. Petitioner has not shown by a preponderance of the evidence that claims 11–14 and 18 are unpatentable.

I. BACKGROUND

A. The '373 Patent (Ex. 1001)

The '373 patent describes a method and mobile communication terminal for performing a specific function when a mobile communication terminal is activated. Ex. 1001, 1:16–18. Figure 1 of the '373 patent is reproduced below.
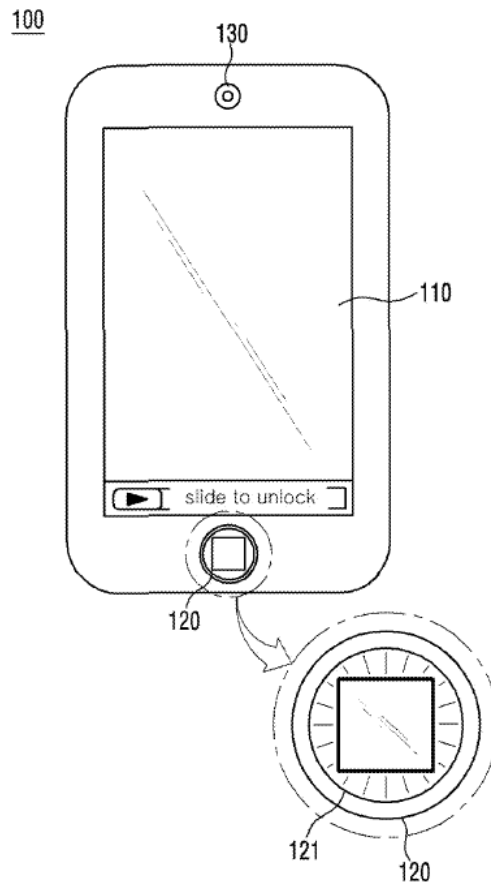
FIG. 1

Figure 1 illustrates an external appearance of mobile communication terminal 100. *Id.* at 3:42–44. Mobile communication terminal 100 includes display unit 110 and activation button 120. *Id.* at 3:45–47. Display unit 110 displays various information regarding operation states of mobile communication terminal 100. *Id.* at 3:64–66. Activation button 120 switches mobile communication terminal 100 from an inactive state (in which the terminal is communicable but the display screen is turned off) to an active state (in which the display screen is turned on). *Id.* at 3:21–23, 3:32–37, 4:22–24.

If the user presses activation button 120 when mobile communication terminal 100 is in the inactive state, mobile communication terminal 100 performs a predetermined operation in addition to switching to the active state. *Id.* at 4:36–40. Example operations that can be performed include camera activation, user authentication (e.g., fingerprint recognition), and operation of a music player. *See id.* at 5:51–63, 7:18–8:20, 10:1–8.

The user can set the operation to be performed when the activation button is pressed. *Id.* at 4:51–53. Different operations can be set to be performed according to the number of presses or a press time of activation button 120; for example, a first operation can be performed if activation button 120 is pressed for a short time and a second operation can be set to be performed if activation button 120 is pressed for a long time. *See id.* at 4:57–5:2.

B. *Illustrative Claim*

Claims 1 and 11 are independent claims. Claim 1 is illustrative of the subject matter at issue:[3]

> 1. A mobile communication terminal comprising:
>
> a touch screen display;
>
> a camera;
>
> a power button configured to turn on and off the terminal by pressing; and
>
> an activation button separate from the power button and located outside the touch screen display, the activation button configured for pressing to turn on the touch screen display and to initiate one or more additional functions of the terminal,
>
> wherein the terminal has a first function and a second function to perform in response to user input via the activation button and is configured to provide user settings for configuring at least one of the first and second functions such that at least one of the first and second functions is set to be performed in addition to turning on the touch screen display upon pressing of the activation button while the touch screen display is turned off, wherein the first and second functions are different from each other and selected from the group consisting of fingerprint authentication, activating the camera, playing music and a hands-free function,
>
> wherein upon one-time pressing of the activation button while the touch screen display is turned off, the terminal is configured to turn on the touch screen display and further perform at least one of the first and second functions in addition to turning on the touch screen display such that:
>
>> a lock screen is displayed on the touch screen display upon turning on the touch screen display in

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[3] Claims 1 and 11 were corrected in a certificate of correction dated June 27, 2017. Ex. 1001.

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