

Case IPR2019-00614  
U.S. Patent No. 9,779,419

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

APPLE INC.,

Petitioner,

v.

FIRSTFACE CO., LTD.,

Patent Owner.

---

Case IPR2019-00614  
Case IPR2019-01012  
U.S. Patent No. 9,779,419

---

**PATENT OWNER'S SUR-REPLY TO PETITION**

## TABLE OF CONTENTS

I.	Introduction.....	1
II.	Ground 1: The Combination of Griffin, Davis, and iOS Does Not Render Obvious the Challenged Claims .....	1
	A. The Combination of Griffin and iOS Fails to Disclose an Activation Button Separate from a Power Button.....	2
	B. The Combination of Griffin and Davis Fails to Disclose Turning on the Display and Performing a Fingerprint Authentication Function in Response to a One-Time Pressing of the Activation Button.....	4
	1. The Challenged Claims require performance, not just initiation, of a fingerprint authentication function in response to a one-time pressing of the activation button. ....	5
	2. The combination of Griffin and Davis fails to disclose performing a fingerprint authentication function in response to a one-time pressing of the activation button. ....	8
	C. A POSITA Would Not Have Been Motivated to Combine Griffin, Davis, and iOS.....	11
III.	Ground 2: The Combination of Goertz, Davis, and iOS Does Not Render Obvious the Challenged Claims.....	13
	A. The Combination of Goertz and iOS Fails to Disclose an Activation Button Separate from a Power Button.....	14
	B. The Combination of Goertz and Davis Fails to Disclose Turning On the Display and Performing a Fingerprint Authentication In Response to a One-Time Pressing of the Activation Button. ....	16
	C. A POSITA Would Not Have Been Motivated to Combine Goertz, Davis, and iOS.....	17
IV.	Conclusion .....	19

## TABLE OF AUTHORITIES

### Cases:

<i>Graham v. John Deere Co. of Kan. City</i> , 383 U.S. 1 (1966).....	9
<i>In re Gordon</i> , 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).....	12
<i>In re Merck &amp; Co.</i> , 800 F.2d 1091 (Fed. Cir. 1986) .....	9, 10
<i>In re Mouttet</i> , 686 F.3d 1322 (Fed. Cir. 2012) .....	9
<i>Intamin Ltd. v. Magnetar Techs. Corp.</i> , 483 F.3d 1328 (Fed. Cir. 2007) .....	7
<i>Kinetic Concepts, Inc. v. Smith &amp; Nephew, Inc.</i> , 688 F.3d 1342 (Fed. Cir. 2012) .....	18
<i>Princeton Biochemicals, Inc. v. Coulter, Inc.</i> , 411 F.3d 1332 (Fed. Cir. 2005) .....	13, 19

### Rules, Statutes, and Other Authorities:

M.P.E.P § 2143.01(V).....	12
---------------------------	----

### TABLE OF EXHIBITS

Exhibit	Description
2001	Declaration of Dr. Alfred C. Weaver
2008	Bederson Deposition Transcript

Patent Owner Firstface Co., Ltd. (“Firstface” or “Patent Owner”) submits this Sur-Reply to the Petitions<sup>1</sup> of Apple Inc. (“Apple” or “Petitioner”) seeking *inter partes* review of claims 1-4, 6-7, 9-13, and 15-17 of U.S. Patent No. 9,779,419 (Ex. 1001, the “’419 patent”).

## **I. Introduction**

Petitioner’s Reply, like its Petition, fails to show that the Challenged Claims are unpatentable. None of the cited art, alone or in combination, discloses all limitations of the Challenged Claims. Petitioner’s arguments otherwise rely on overly generous readings of the references and an incorrect interpretation of the Challenged Claims. The Board should reject Petitioner’s arguments and find all Challenged Claims patentable.

## **II. Ground 1: The Combination of Griffin, Davis, and iOS Does Not Render Obvious the Challenged Claims.**

---

<sup>1</sup> Petitioner originally filed a Petition seeking *inter partes* review of claims 1-4, 6-7, 10-13, and 15-17 in Case IPR2019-00614. Petitioner subsequently filed a Petition seeking *inter partes* review of claim 9 in Case IPR2019-1012. The Board instituted review in both proceedings and consolidated them for trial. This Sur-Reply therefore addresses the arguments made in both Petitions.

# 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.