Paper 27 Date: July 31, 2020

### 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<sup>1</sup> 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)

<sup>1</sup> 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.



IPR2019-00613 IPR2019-01011 Patent 9,633,373 B2

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.").<sup>2</sup> 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

<sup>&</sup>lt;sup>2</sup> 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.



IPR2019-00613 IPR2019-01011 Patent 9,633,373 B2

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

130

130

1100

130

1100

120

121

120



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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:<sup>3</sup>

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 handsfree 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

<sup>&</sup>lt;sup>3</sup> Claims 1 and 11 were corrected in a certificate of correction dated June 27, 2017. Ex. 1001.



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