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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Case IPR2019-01012
Patent 9,779,419 B2

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

CASS, *Administrative Patent Judge*.

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

Apple Inc. ("Petitioner") previously filed a Petition pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 1–4, 6, 7, 10–13, and 15–17 of U.S. Patent No. 9,779,419 B2 ("the '419 patent"), which we instituted for trial on August 19, 2019. IPR2019-00614, Paper 10. Petitioner filed this Petition seeking *inter partes* review of claim 9 of the '419 patent. Paper 1 ("Pet"). Petitioner states claim 9 was inadvertently overlooked in its earlier petition. Paper 1, 11. Firstface Co., Ltd. ("Patent Owner") filed a Preliminary Response. Paper 7 ("Prelim. Resp."). Applying the standard set forth in 35 U.S.C. § 314(a), which requires demonstration of a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim, we grant Petitioner's request to institute an *inter partes* review of claim 9 of the '419 patent.[1]

To administer this proceeding more efficiently, we also exercise our authority under 35 U.S.C. § 315(d) to consolidate it with IPR2019-00614 and conduct the proceedings as one trial. *See also* 37 C.F.R. § 42.122(a) ("Where another matter involving the patent is before the Office, the Board may during the pendency of the *inter partes* review enter any appropriate order regarding the additional matter including providing for the stay, transfer, consolidation, or termination of any such matter.").

I. BACKGROUND

A. *The '419 Patent (Ex. 1001)*

The '419 patent describes a method and mobile communication terminal for performing a specific function when a mobile communication

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[1] Although we granted Petitioner's motion to seal certain exhibits filed with the Petition (Paper 8), we do not refer to any sealed material in this Decision.

terminal is activated. Ex. 1001, 1:16–18. Figure 1 of the '419 patent is reproduced below.
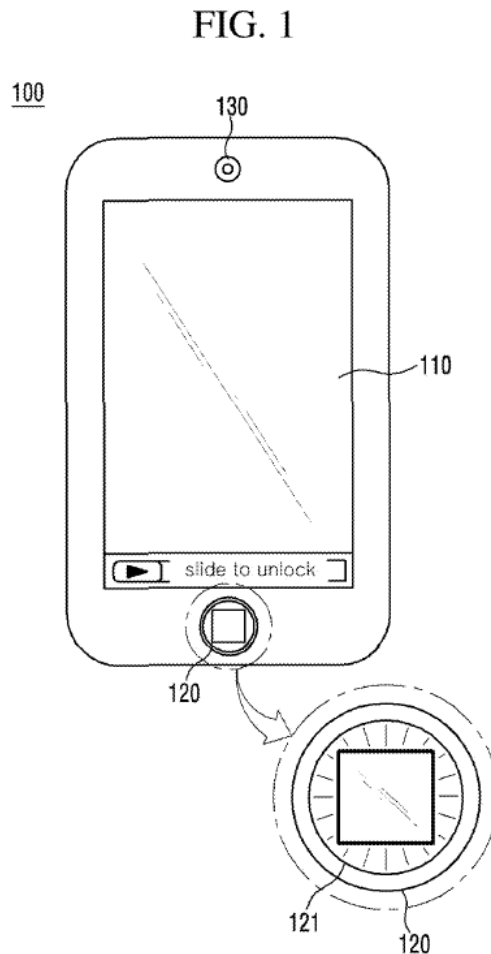
FIG. 1

Figure 1 illustrates the 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. When the user presses the activation button, the terminal 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 3:21–34; 4:22–27.

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 in addition to switching to the active state. *Id.* at 4:36–40. The terminal may also perform different operations according to the number of presses or the press time of the activation button. *Id.* at 4:58–61. For example, the terminal may perform a first operation if activation button 120 is pressed once for a short time, and a second operation if activation button 120 is pressed once for a longer time. *Id.* at 4:65–5:2.

The '419 patent describes a number of operations that can be performed when the activation button is pressed. *Id.* at 5:51–57. One of those functions is a user identification function, which performs a security authentication process. *Id.* at 7:14–17. According to this process, when mobile communication terminal 100 is in the inactive state, it senses that the user has pressed the activation button, and then operates the user identification function. *Id.* at 7:22–28. The '419 patent describes an example user identification unit 420 that uses camera activation element 421, iris detection element 422, and user identification element 423 for sensing and recognizing the iris of a user's eye. *Id.* at 7:29–8:6. The 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 8:13–20. Mobile communication terminal 100 may also be switched to a hands-free function by pressing activation button 120. *Id.* at 9:22–28.

B. Claim 9 of the '419 Patent

At issue in this proceeding is claim 9, which is dependent on claim 1.

Claims 1 and 9 are reproduced below:[2]

> 1. A mobile communication terminal comprising:
>
> a touch screen display;
>
> 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,
>
> 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 perform a fingerprint authentication function 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 response to the one-time pressing of the activation button while the touch screen display being turned off,
>
> in addition to turning on the touch screen display and displaying the lock screen, the one-time pressing while the touch screen display being turned off initiates the fingerprint authentication function,
>
> the lock screen is displayed on the touch screen display when the fingerprint authentication function initiated by the one-time pressing is being performed,

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[2] Claim 1 was corrected in a certificate of correction dated March 20, 2018. Ex. 1001.

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