UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC. & MICROSOFT CORPORATION
Petitioners

v.

Neodron, Ltd.
Patent Owner

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Case No. IPR2020-00998
U.S. Patent No. 8,749,251

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**PETITION FOR *INTER PARTES* REVIEW
OF U.S. PATENT NO. 8,749,251**
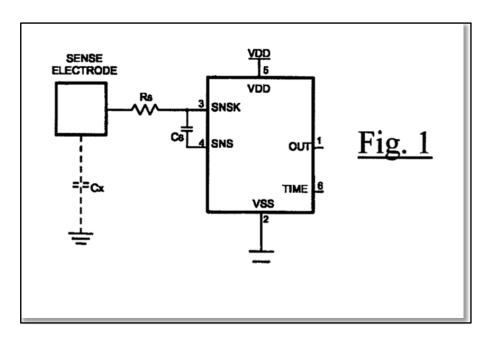
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I. INTRODUCTION

Petitioners Apple Inc. and Microsoft Corporation ("Petitioners") request an *Inter Partes* Review ("IPR") of claims 1-20 (the "Challenged Claims") of U.S. Patent No. 8,749,251 ("the '251 Patent").

II. SUMMARY OF THE '251 PATENT

A. Description of the alleged invention of the '251 Patent

The '251 Patent generally relates to managing power consumption related to sensors that detect a user's touch or close proximity based on changes in capacitance generated by a finger or other objects (e.g., a stylus). *'251 Patent* (Ex. 1001), 1:37-41, 4:7-8, 4:24-34. The control circuit can implement an "auto-off" functionality or other power saving procedures "where an apparatus has inadvertently been left on or with the erroneous perception that a user is still present." *Id.* at 4:55-58. Figure 1 illustrates an exemplary "sense electrode" connected to a programmable controller:

Fig. 1

B. Prosecution history of the '251 Patent

The Application that resulted in the '251 Patent was filed on May 26, 2011 as U.S. App. No. 13/116,764 ("the '764 Application"). The '764 Application claims priority to U.S. App. No. 12/179,769 filed on July 25, 2008 (now U.S. Pat. No. 7,952,366), which claims priority to a provisional application filed on July 26, 2007. *'251 Patent* (Ex. 1001).

The Challenged Claims were not subject to any prior art-based rejections. A Notice of Allowability issued on January 31, 2014 and noted that no prior art of record taught the limitations directed to initiating a function (e.g., a power save function) after a determined amount of time has elapsed since the sensing element last detected a change of capacitance indicative of a key touch on the touch screen. *'251 Patent File History* (Ex. 1002), 244-251.

C. Level of skill of a person having ordinary skill in the art

A person having ordinary skill in the art (PHOSITA) at the time of the '251 Patent would have been a person having at least a bachelor's degree in electrical engineering, computer engineering, computer science, or a related field, and at least two years of experience in the research, design, development, and/or testing of human-machine interfaces such as touch sensors and the firmware or system software that govern said interfaces, or the equivalent, with additional education substituting for experience and vice versa. *Givargis Decl.* (Ex. 1003), ¶¶20-22.

III. REQUIREMENTS FOR INTER PARTES REVIEW UNDER 37 C.F.R. § 42.104

A. Grounds for standing under 37 C.F.R. § 42.104(a)

Petitioners certify that the '251 Patent is available for IPR and that the Petitioners are not barred or estopped from requesting IPR challenging the claims of the '251 Patent. Specifically, (1) Petitioners are <u>not</u> the owners of the '251 Patent, (2) Petitioners have <u>not</u> filed a civil action challenging the validity of any claim of the '251 Patent, and (3) this Petition is filed less than one year after Petitioners were served with complaints alleging infringement of the '251 Patent.

B. Discretionary Considerations

a. The petition presents non-cumulative grounds of prior art—35 U.S.C. § 325(d)

The Board applies a two-part framework to assess discretionary denials under 35 U.S.C. § 325(d): "(1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of [the] first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims." *Advanced Bionics, LLC v. MED-EL Elektromedizinische Gerate GmbH*, IPR2019-01469, Paper 6 at 8-9 (PTAB Feb. 13, 2020) (applying the *Becton* factors) (precedential).

As discussed in Sec. II.B. above, the Challenged Claims were not subject to ***any*** prior art-based rejections. Instead, the Examiner issued a first action Notice of

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