

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Magnus Goertz
U.S. Patent No.: 8,095,879 Attorney Docket No.: 50095-0015IP1
Issue Date: January 10, 2012
Appl. Serial No.: 10/315,250
Filing Date: December 10, 2002
Title: USER INTERFACE FOR MOBILE HANDHELD COMPUTER
UNIT

Mail Stop Patent Board

Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION FOR *INTER PARTES* REVIEW OF UNITED STATES PATENT
NO. 8,095,879 PURSUANT TO 35 U.S.C. §§311–319, 37 C.F.R. §4**

TABLE OF CONTENTS

I.	REQUIREMENTS FOR IPR UNDER 37 C.F.R. §42.104.....	1
A.	Grounds for Standing Under 37 C.F.R. §42.104(a).....	1
B.	Challenge Under 37 C.F.R. §42.104(b) and Relief Requested.....	1
II.	THE '879 PATENT.....	3
A.	Alleged Invention.....	3
B.	Prosecution History.....	5
C.	Claim Construction.....	5
III.	PRIOR ART.....	6
A.	Known Electronic Devices.....	6
B.	References.....	7
1.	Ren.....	7
2.	Hirayama307.....	8
3.	Tanaka.....	9
4.	Allard and IBM Simon.....	10
5.	Henckel.....	12
6.	Hirayama878.....	13
7.	Motivation to Combine Ren, Tanaka, Hirayama307, Hirayama878, and Allard.....	14
8.	Jermyn.....	14
IV.	EXPLANATION OF UNPATENTABILITY.....	16
A.	Ground 1A: Claims 1, 14-17 are Obvious Over Ren and Tanaka.....	16

B.	Ground 1B: Claims 2, 4, and 5 are Obvious Over Ren, Tanaka, and Hirayama307	35
C.	Ground 1C: Claim 3 is Obvious Over Ren, Tanaka, Hirayama307, and alternatively Hirayama878	39
D.	Ground 1D: Claims 6 and 13 are Obvious Over Ren, Tanaka, and Allard	43
E.	Ground 1E: Claim 12 is Obvious Over Ren, Tanaka, and Henckel.....	47
F.	Ground 2A: Claims 1, 2, 4, and 5 are Obvious Over Hirayama307 and Ren	49
A.	Ground 2B: Claim 3 is Obvious Over Hirayama307, Ren, and Hirayama878	70
B.	Ground 2C: Claims 6 and 13 are Obvious Over Hirayama307, Ren, and Allard.....	72
C.	Ground 2D: Claim 12 is Obvious Over Hirayama307 and Henckel.....	74
D.	Ground 3: Claims 1, 14, and 15 are Obvious Over Jermyn.....	75
V.	INSTITUTION SHOULD NOT BE DENIED UNDER 35 U.S.C. § 325(d).....	85
VI.	PTAB DISCRETION UNDER 35 U.S.C. § 314(a) SHOULD NOT PRECLUDE INSTITUTION	87
A.	Factor 1: Institution Will Enable a Stay	87
B.	Factor 2: Uncertain District Court Schedule.....	88
C.	Factor 3: Early Stage of Parallel Proceedings.....	89
D.	Factor 4: The Petition Raises Unique Issues.....	90
E.	Factor 5: The Petition Will Enable Cancellation of Claims That Might Be Reasserted	91
F.	Factor 6: Other Considerations Support Institution	92

VII. CONCLUSION.....92

VIII. MANDATORY NOTICES UNDER 37 C.F.R § 42.8(a)(1).....92

 A. Real Party-In-Interest Under 37 C.F.R. § 42.8(b)(1)92

 B. Related Matters Under 37 C.F.R. § 42.8(b)(2)92

 C. Lead And Back-Up Counsel Under 37 C.F.R. § 42.8(b)(3)93

 D. Service Information.....93

EXHIBITS

<u>Exhibit No.</u>	<u>Description</u>
1001	U.S. Patent No. 8,095,879 (“the ’879 patent”)
1002	Declaration of Benjamin B. Bederson
1003	File History for U.S. Patent No. 8,095,879
1004	Xiangshi Ren & Shinji Moriya, “Improving Selection on Pen-Based Systems: A Study of Pen-Based Interaction for Selection Tasks,” ACM Transactions on Computer-Human Interaction, Vol. 7, No. 3, September 2000, pp. 384-416 (“Ren”)
1005	U.S. Patent No. 5,249,296 (“Tanaka”)
1006	U.S. Patent No. 5,406,307 (“Hirayama307”)
1007	U.S. Patent No. 5,949,418 (“Shields”)
1008	CV of Benjamin B. Bederson
1009	U.S. Patent No. 6,100,878 (“Hirayama878”)
1010	U.S. Patent No. 5,615,384 (“Allard”)
1011	IBM Simon User’s Manual (1994)
1012	Andrew Sears, et al., “A new era for touchscreen applications: High precision, dragging icons, and refined feedback,” ADVANCES IN HUMAN-COMPUTER INTERACTION, Vol. 3, R. Hartson, D. Hix, Ed. 1992 (“Sears”)
1013	U.S. Patent No. 5,463,725 (“Henckel”)
1014	Jermyn, et al., “The Design and Analysis of Graphical Passwords,” Proceedings of the 8th USENIX Security Symposium, Washington, DC, USA, August 23-26, 1999 (“Jermyn”)
1015	Benjamin B. Bederson & James D. Hollan, <i>Pad++: A Zooming Graphical Interface for Exploring Alternate Interface Physics</i> , USIT ’94 Proceedings of the 7th Annual ACM Symposium on User Interface Software and Technology 17 (1994), DOI: http://dx.doi.org/10.1145/192426.192435
1016	David Rogers et al., <i>Tossing Objects in a Desktop Environment</i> , submitted to Conference on Human Factors in Computing Systems (1996)
1017	Benjamin B. Bederson, <i>Fisheye Menus</i> , UCIT ’00 Proceedings of ACM Conference on User Interface Software and Technology 217 (2000), DOI: 10.1145/354401.317382
1018	Leslie E Chipman et al., <i>SlideBar: Analysis of a Linear Input</i>

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.