IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Magnus Goertz

U.S. Patent No.: 8,812,993 Attorney Docket No.: 50095-0016IP1

Issue Date: August 19, 2014

Appl. Serial No.: 13/310,755

Filing Date: December 4, 2011
Title: USER INTERFACE

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. 8,812,993 PURSUANT TO 35 U.S.C. §§311–319, 37 C.F.R. §4



TABLE OF CONTENTS

EXH	IBITS		iii	
I.	REQ	UIREMENTS FOR IPR UNDER 37 C.F.R. §42.104	1	
II.	THE	'993 PATENT	3	
	A.	The '993 Patent Alleged Invention	3	
	B.	The '993 Patent Prosecution History	7	
	C.	Claim Construction	8	
III.	PRIC	PRIOR ART		
	A.	Well-Known Concepts by the Critical Date	8	
	B.	Prior Art Combinations	10	
		1. Hisatomi, Ren, Allard-656, Tanaka, and Kodama	10	
		2. Hansen and Gillespie	18	
IV.	EXPLANATION OF UNPATENTABILITY		27	
	A.	Ground 1A: Claims 1-3, 7, and 8 are rendered obvious by Hisatomi in view of POSA knowledge and/or Ren	27	
	В.	Ground 1B: Claim 4 is rendered obvious by Hisatomi in view of POSA Knowledge and Allard-656 and/or Ren and Allard-656	54	
	C.	Ground 1C: Claim 5 is Rendered Obvious by Hisatomi in view of POSA knowledge and Tanaka and/or Ren and Tanaka		
	D.	Ground 1D: Claim 6 is Rendered Obvious by Hisatomi in view of POSA knowledge and Kodama and/or Ren and Kodama	60	
	Е.	Ground 2A: Claims 1-3, 7, and 8 are rendered obvious by Hansen in view of Gillespie	63	



	F.	Grounds 2B, 2C, and 2D: Claims 4-6 are rendered obvious by Hansen and Gillespie in view of Allard-656, Tanaka, or Kodama	79
V.	INSTITUTION SHOULD NOT BE DENIED UNDER 35 U.S.C. § 325(d)		
	A.	Petitioner's Grounds and Obviousness Rationales Were Not Previously Considered by The Office	83
	B.	The Office Erred in Granting the '993 Patent	86
VI.	PTAB DISCRETION UNDER § 314(a) SHOULD NOT PRECLUDE INSTITUTION		
	A.	Factor 1: Institution Will Enable a Stay	88
	B.	Factor 2: Uncertain District Court Schedule	89
	C.	Factor 3: Early Stage of Parallel Proceedings	90
	D.	Factor 4: The Petition Raises Unique Issues	91
	E.	Factor 5: The Petition Will Enable Cancellation of Claims That Might Be Reasserted	92
	F.	Factor 6: Other Considerations Support Institution	93
VII.	CON	CLUSION	93
VIII.	MAN	DATORY NOTICES UNDER 37 C.F.R § 42.8(a)(1)	93
	A.	Real Party-In-Interest Under 37 C.F.R. § 42.8(b)(1)	93
	B.	Related Matters Under 37 C.F.R. § 42.8(b)(2)	93
	C.	Lead And Back-Up Counsel Under 37 C.F.R. § 42.8(b)(3)	94
	D.	Service Information	94



EXHIBITS

Exhibit No.	<u>Description</u>
1001	U.S. Patent No. 8,812,993 ("the '993 patent")
1002	Declaration of Benjamin B. Bederson
1003	File History for U.S. Patent No. 8,812,993
1004	Benjamin B. Bederson CV
1005	Certified translation of JP Published Patent Application No. 2002-55750 ("Hisatomi"), published February 20, 2002
1006	Xiangshi Ren & Shinji Moriyama, "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")
1007	U.S. Patent No. 5,422,656 to Allard et al. ("Allard-656")
1008	U.S. Patent No. 5,249,296 to Tanaka ("Tanaka")
1009	U.S. Patent No. 5,615,384 to Allard et al. ("Allard-384")
1010	U.S. Patent No. 5,537,608 to Beatty et al. ("Beatty")
1011	U.S. Patent No. 5,903,268 to Hirayama ("Hirayama")
1012	U.S. Patent No. 5,305,435 to Bronson ("Bronson")
1013	U.S. Patent No. 6,133,898 to Ludolph et al. ("Ludolph")
1014	Tammara T. A. Combs and Benjamin B. Bederson "Does
	zooming improve image browsing?" Proceedings of the Fourth
	ACM Conference on Digital Libraries (DL '99), ACM, New
	York, NY, USA, (August 1999) 130-137
1015	Dean Harris Rubine, "The Automatic Recognition of Gestures," CMU-CS-91-202, December, 1991.
1016	U.S. Patent No. 6,710,791 to Kodama et al. ("Kodama")
1017	IBM Corp., User's Manual, "Simon Says 'Here's How!" Part. No. 82G2557 (1994) ("IBM")
1018	Benjamin B. Bederson & James D. Hollan, <i>Pad++: A Zooming</i>
1010	Graphical Interface for Exploring Alternate Interface Physics,
	UIST '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
1019	David Rogers et al., Tossing Objects in a Desktop Environment,
	submitted to Conference on Human Factors in Computing
	Systems (1996)



	11 K of O.S. 1 atom 140. 0,012,773
1020	David Rogers et al., Exemplar Figure of Tossing from <i>Tossing</i>
	Objects in a Desktop Environment, submitted to Conference on
	Human Factors in Computing Systems (1996)
1021	Benjamin B. Bederson, Fisheye Menus, UIST '00 Proceedings of
	ACM Conference on User Interface Software and Technology
	217 (2000), DOI: <u>10.1145/354401.317382</u>
1022	Leslie E Chipman et al., SlideBar: Analysis of a Linear Input
	Device, 23 Behaviour & Info. Tech. 1 (2004), DOI:
	10.1080/01449290310001638487
1023	Hilary Browne et al., Designing a Collaborative Finger Painting
	Application for Children, HCIL-2000-17, CS-TR-4184,
	UMIACS-TR-2000-66 (Sept. 2000), available at
	https://hcil.umd.edu/pub-perm-link/?id=2000-17
1024	Pekka Parhi, Amy K. Karlson, and Benjamin B. Bederson. 2006.
	Target size study for one-handed thumb use on small touchscreen
	devices. In Proceedings of the 8th Conference on Human-
	Computer Interaction with Mobile Devices and Services
	(MobileHCI '06). Association for Computing Machinery, New
	York, NY, USA, 203–210.
	DOI:https://doi.org/10.1145/1152215.1152260
1025	Karlson, Amy & Bederson, Benjamin & Contreras-Vidal, José.
	(2008). Understanding One-Handed Use of Mobile Devices.
	Handbook of Research on User Interface Design and Evaluation
	for Mobile Technology. 86-101. DOI:10.4018/978-1-59904-871-
	0.ch006
1026	Apple Newton Message Pad Handbook (1993)
1027	Handbook for Palm m500 Series Handhelds (1998)
1028	HP Jornada 520 Series Pocket PC User Guide (2001)
1029	U.S. Patent No. 5,821,930 to Hansen ("Hansen")
1030	U.S. Patent Application Publication No. 2005/0024341
	("Gillespie")
1031	Declaration of Mr. Jacob Munford
1032	Norman, D. A. (1988). The psychology of everyday things.
	BasicBooks. IBSN: 0-465-06709-3.
1033	U.S. Publication No. 2001/0043189 to Brisebois ("Brisebois")
1034	Trial Delay Statistics
1035	Order Governing Proceedings - Patent Case, Neonode
	Smartphone LLC v. Apple Inc., 6:20-cv-00505 (W.D.Tex. Oct. 5,
	2020)



DOCKET

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.

