

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA, INC. AND
APPLE INC.

Petitioners

v.

NEONODE SMARTPHONE LLC
Patent Owner.

Case No. IPR2021-00145
U.S. Patent No. 8,812,993

**PETITIONERS' RESPONSE TO PATENT OWNER'S MOTION TO
SUBMIT SUPPLEMENTAL INFORMATION**

Patent Owner ("Neonode") filed a motion to submit an excerpt of the deposition of Petitioners' expert, Dr. Bederson, taken in co-pending IPR2021-00144. Petitioners' informed Neonode they took no position on the motion. The Board authorized a response to Neonode's motion by email on March 7, 2022.

Neonode argues the testimony of Dr. Bederson is necessary to the issue of whether Ren's $a \rightarrow b \rightarrow c \rightarrow a$ route for *Direct-Off* is a "tap" within the scope of the challenged claims. Paper 63 at 2. The supplemental testimony is not relevant to the issues before the Board for at least two reasons:

- 1) neither Dr. Bederson nor Petitioners relied on Ren's $a \rightarrow b \rightarrow c \rightarrow a$ route as "tap," and therefore the testimony Neonode seeks to submit is not contradictory to the record; and
- 2) there is no dispute that Ren's *Direct-Off* $a \rightarrow c \rightarrow a$ route is a "tap" within the scope of the challenged claims, and therefore whether Ren's $a \rightarrow b \rightarrow c \rightarrow a$ route is a "tap" does not need to be determined in this proceeding.

Neonode admits the Petition does not rely on Ren's $a \rightarrow b \rightarrow c \rightarrow a$ route for disclosure of "tap-activatable" icons. *Id.* Neonode also admits that the issue raised in their motion sprung from the testimony of their own expert, Dr. Rosenberg, regarding whether Ren's *Direct-Off* $a \rightarrow b \rightarrow c \rightarrow a$ route is a "tap" under his construction of "tap-activatable." *Id.* Dr. Rosenberg testified repeatedly, under

oath, without equivocation, that both Ren's $a \rightarrow c \rightarrow a$ route and Ren's $a \rightarrow b \rightarrow c \rightarrow a$ route for *Direct-Off* are a "tap" according to his definition of "tap-activatable." EX1052, 82:11-84:2.¹ Dr. Rosenberg even explained why Ren's $a \rightarrow b \rightarrow c \rightarrow a$ route for *Direct-Off* met his construction of tap-activatable: "because what's important is was the stylus or finger or mouse cursor on the target at the moment that the finger or stylus or mouse button was released." EX1052, 83:19-84:2.

Petitioners and Dr. Bederson pointed out why this testimony regarding Ren's $a \rightarrow b \rightarrow c \rightarrow a$ route contradicted the opinions Dr. Rosenberg expressed in his declaration and Neonode's arguments about (1) the construction of "tap-activatable," and (2) what Neonode called "skewed" error rates for "tap." *See, e.g.*, Pet. Reply at 3, 9-10; EX1051, ¶¶ 24, 49-50. Neither Petitioners nor Dr. Bederson relied on Ren's $a \rightarrow b \rightarrow c \rightarrow a$ route for *Direct-Off* as being within the scope of the term "tap" or "tap-activatable." Accordingly, Dr. Bederson's testimony that a gesture similar to Ren's $a \rightarrow b \rightarrow c \rightarrow a$ route for *Direct-Off* does not contradict his opinions or Petitioners' positions. Nor is a decision as to whether Ren's

¹ Only after review of Petitioners' reply did Neonode seek to "correct" what they allege was "mistaken" testimony by Dr. Rosenberg through submission of an improper errata. *See* Paper 54 (denying Neonode's request to submit an errata with substantive corrections).

Petitioners' Response to Motion to Submit Supp. Information
IPR2021-00145 (U.S. Patent No. 8,812,993)

$a \rightarrow b \rightarrow c \rightarrow a$ route is a “tap” necessary to the proceedings because Neonode does not dispute that Ren otherwise discloses “tap-activatable” targets under their own construction of the term.

Date: March 15, 2022

Respectfully Submitted,
/David L. Holt/
W. Karl Renner, Reg. No. 41,265
Tiffany C. Miller, Reg. 52,032
David Holt, Reg. 65,161
James M. Heintz, Reg. No. 41,828

Attorneys for Petitioners

CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4)(i) *et seq.*, the undersigned certifies that on March 15, 2022, a complete and entire copy of this Petitioners' Response to Motion to Submit Supplemental Information were provided via email to the Patent Owner as follows:

Robert M. Asher
Bruce D. Sunstein
Timothy M. Murphy
Arne Hans

Phil J. Graves
Greer N. Shaw
Mark S. Carlson

rasher@sunsteinlaw.com
bsunstein@sunsteinlaw.com
tmurphy@sunsteinlaw.com
ahans@sunsteinlaw.com
philipg@hbsslaw.com
greers@hbsslaw.com
markc@hbsslaw.com
sunsteinip@sunsteinlaw.com

/Crena Pacheco/

Crena Pacheco
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
(617) 956-5938