

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TCL CORPORATION, TCL COMMUNICATION TECHNOLOGY
HOLDINGS, LTD., TCT MOBILE LIMITED, TCT MOBILE INC., and
TCT MOBILE (US) INC.,
Petitioner,

v.

TELEFONAKTIEBOLAGET LM ERICSSON,
Patent Owner.

Case IPR2015-01674
Patent RE43,931 E

Before BENJAMIN D. M. WOOD, PATRICK R. SCANLON, and
BARBARA A. BENOIT, *Administrative Patent Judges*.

BENOIT, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

TCL Corporation, TCL Communication Technology Holdings, Ltd., TCT Mobile Limited, TCT Mobile Inc., and TCT Mobile (US) Inc. (collectively, “Petitioner”) filed a Petition for *inter partes* review of claims 1–12 and 15 of U.S. Patent No. RE43,931 E (Ex. 1001, “the ’931 patent”). Paper 2 (“Pet.”). Telefonaktiebolaget LM Ericsson (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a).

Upon consideration of the Petition and the Preliminary Response, we determine that the information presented shows there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of claims 1–12 and 15.

A. Related Matters

The parties indicate that the ’931 patent is at issue in *Ericsson Inc. v. TCL Communication Technology Holdings, Ltd.*, No. 2:15-cv-11 (E.D. Tex.). Pet. 1–2; Paper 5, 2. In addition, the parties identify the district court proceedings *Ericsson Inc. v. TCL Communication Technology Holdings, Ltd.*, No. 2:14-cv-667 (E.D. Tex.) and *Ericsson Inc. v. Apple Inc.*, No. 2:15-cv-289 (E.D. Tex.) as related matters. Pet. 1–2; Paper 5, 2. Petitioner also has filed additional petitions for *inter partes* review of the ’931 patent.

B. The '931 patent

The '931 patent is a reissue of U.S. Patent No. 6,278,888. Ex. 1001, [64]. The '931 patent relates to radiotelephones “in which control of a radiotelephone’s display and/or radiotelephone communications transceiver is effected using a contact-sensitive transducer such as a resistive or capacitive touch strip mounted on the radiotelephone.” *Id.* at 2:9–13. Figures 1 and 2 of the '931 patent are reproduced below:

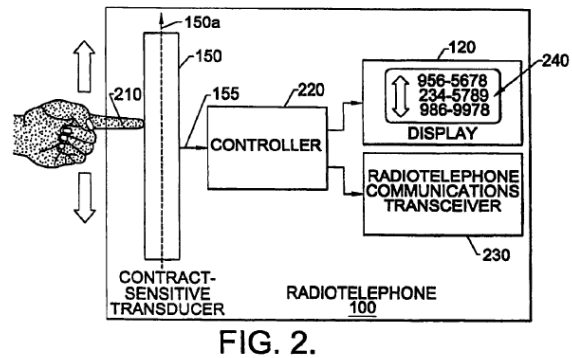
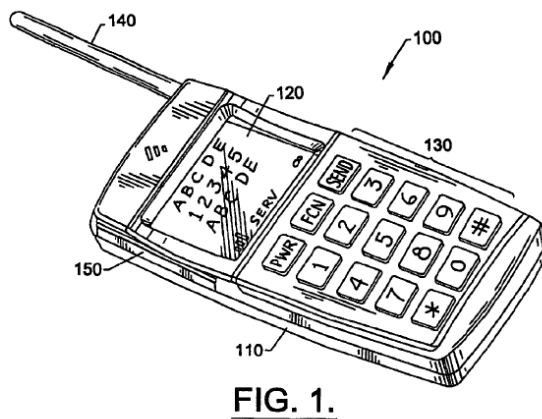


Figure 1 illustrates radiotelephone 100, and Figure 2 is a block diagram of the radiotelephone. *Id.* at 4:15–18. Radiotelephone 100 comprises housing 110 supporting display 120 and keys 130. *Id.* at 5:1–3. Mounted on a side surface of housing 110 is contact-sensitive transducer 150. *Id.* at 5:10–11. Alternatively, the contact-sensitive transducer can be mounted to the front face of the radiotelephone housing. *Id.* at 9:61–65, Fig. 11.

As shown in Figure 2, “the contact-sensitive transducer 150 produces an output signal 155 that characterizes contact of an object, such as a user’s finger 210, along an axis 150a of the transducer 150.” *Id.* at 5:22–25.

Controller 220 selectively displays an image, such as one or more rows 240 of alphanumeric characters, on display 120 in response to output signal 155. *Id.*

at 5:28–30. Controller 220 also controls radiotelephone communications transceiver 230 according to output signal 155. *Id.* at 5:31–33.

In addition, “the controller has a first mode wherein the controller is responsive to contact with the contact-sensitive transducer and a second mode wherein the controller is unresponsive to contact with the contact-sensitive transducer.” *Id.* at 3:34–38. The controller is placed into the first or second mode in response to an input from a user. *Id.* at 3:38–41.

C. Illustrative Claim

Of the challenged claims in the '931 patent, claim 1 is independent and is illustrative of the claimed subject matter. Italicized text in claim 1 indicates language that was added to the claims during prosecution of the reissue application. Bracketed text indicates language that was removed.

1. A radiotelephone, comprising:

a housing having a front surface, a rear surface and first and second side surfaces adjoining respective opposite edges of the front surface and extending from the respective opposite edges of the front surface to respective opposite edges of the rear surface, the housing configured to be held in a user's hand such that the rear surface confronts the user's palm;

a radiotelephone communications transceiver, supported by the housing;

a display, supported by the housing, that displays an image at the front surface of the housing;

a contact-sensitive transducer, supported by the housing and having a contact-sensitive surface disposed at [at least one of the first and second side surfaces] *said front surface*, which produces an output signal [that characterizes] *in response to moving* contact of an object along the contact-sensitive surface of the contact-sensitive transducer; and

a controller, responsive to the output signal and operatively associated with the display and the radiotelephone communications transceiver, which controls at least one of the display and the radiotelephone communications transceiver [according to] *and which scrolls displayed rows along an axis of the display based upon the output signal of the contact-sensitive transducer, the controller having a first mode wherein the controller is responsive to contact with the contact-sensitive transducer and a second mode wherein the controller is unresponsive to contact with the contact-sensitive transducer, the second mode being entered in response to an input from a user.*

Ex. 1001, 10:25–55.

D. Asserted Grounds of Unpatentability

Petitioner contends that claims 1–12 and 15 of the '931 patent are unpatentable based on the following specific grounds¹ (Pet. 14–59):

References	Basis	Claims Challenged
Palatsi ² and Moore ³	§ 103	1–11 and 15
Palatsi, Moore, and Tiilikainen ⁴	§ 103	12

¹ Section 3(c) of the Leahy-Smith America Invents Act (“AIA”) amended 35 U.S.C. § 103. Pub. L. No. 112-29, 125 Stat. 284, 287–288 (2011). Because the '931 patent has a filing date before March 16, 2013 (effective date of section 3), the pre-AIA version of § 103 applies in this proceeding. *See id.*, § 3(n)(1), 125 Stat. at 293.

² U.S. Patent No. 5,892,475, issued Apr. 6, 1999 (Ex. 1087, “Palatsi”).

³ U.S. Patent No. 4,566,001, issued Jan. 21, 1986 (Ex. 1012, “Moore”).

⁴ European Patent Application EP0721272A2, published July 10, 1996 (Ex. 1088, “Tiilikainen”).

II. DISCUSSION

A. Claim Construction

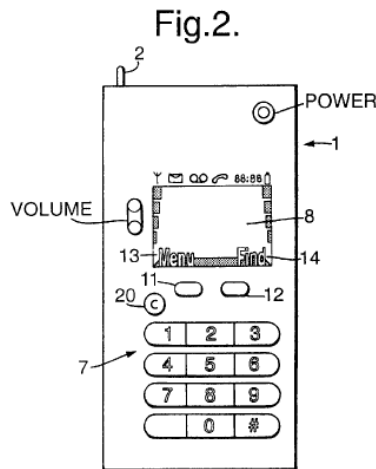
Petitioner asserts the broadest reasonable construction of “contact-sensitive transducer . . . which produces an output signal” is “a device that converts physical contact of an object with the device to an electrical signal” and the broadest reasonable construction of “graphical object(s)” is “visual element(s) including image(s) and/or row(s) of alphanumeric characters.” Pet. 11–13. At this preliminary stage, Patent Owner does not propose any express constructions or challenge Petitioner’s proposed constructions. *See generally* Prelim. Resp. 1–30. We determine that no terms require express construction for this decision.

B. Asserted Ground of Obviousness over Palatsi and Moore

Petitioner contends that claims 1–11 and 15 of the ’931 patent are unpatentable under 35 U.S.C. § 103 as obvious over Palatsi and Moore. Pet. 14–54. Petitioner supports its contentions with citations to the references and with declaration testimony of Andrew Wolfe, Ph.D. Ex. 1205.

1. Summary of Palatsi

Palatsi issued April 6, 1999 from an application filed June 23, 1997. Ex. 1087, [22], [45]. Palatsi describes a need for portable, hand-held telephones to be smaller, which requires the size of the keypad on the device to be smaller. *Id.* at 1:21–24. As a result, the device may be less easy to use because the keys are small. *Id.* at 1:24–26. Figure 2 of Palatsi, reproduced below, depicts a portable telephone.



As shown in Figure 2, portable telephone 1 has antenna 2, keypad 7, display 8, and a volume control (not identified by a reference numeral). *Id.* at 2:17–26. Keypad 7 includes two “soft” keys 11, 12. *Id.* at 2:26. “The function of the ‘soft’ keys vary from time to time.” *Id.* at 2:34–35. In one example, a user may press soft key 11 to move a displayed cursor to the first displayed menu item and then may press soft key 11 twice again to toggle between “off” and “on” to change the setting of the first displayed menu item. *Id.* at 3:20–26; Fig. 4. In another example, Palatsi describes using soft key 11 to scroll through menu items. *Id.* at 2:63–66, 3:34–42. Palatsi also indicates that keys can be touch sensors. *Id.* at 4:17–19 (“Rather than having one or more keys as an input means[,] the telephone could have, for example, one or more touch sensors.”).

2. Summary of Moore

Moore, titled “Touch Strip Input for Display Terminal,” issued January 21, 1986. Ex. 1012, [45], [54]. Moore describes a “display terminal” that includes “a position sensitive touch strip extending along an edge of the display screen,” the output of which is “dependent on the distance along the strip of the position touched by a terminal user.” *Id.* at 1:42–48. Figure 1 of Moore, reproduced below, depicts a display terminal.

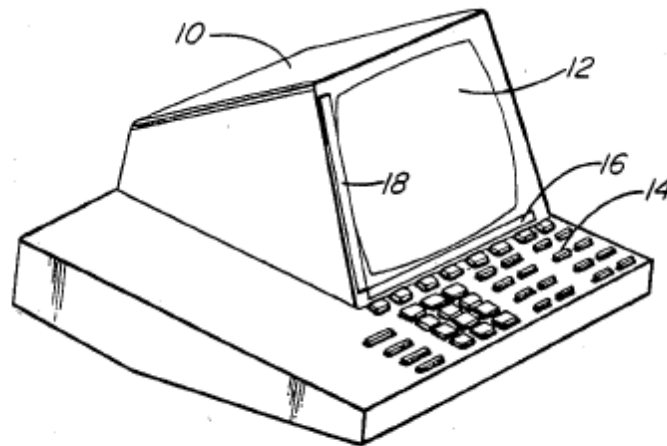


FIG. 1

As shown in Figure 1, the display terminal includes “a cathode ray tube (CRT) unit 10 with a rectangular screen 12” and keyboard 14. *Id.* at 2:15–19. Along respective adjacent edges of display screen 12 are two touch strips 16, 18. *Id.* at 2:20–26, 4:30 – 31. One touch strip is horizontal and the other vertical. *Id.* Each touch strip “has a voltage output which is representative of the distance along it at which it is touched.” *Id.* at 2:20–26. Moore also describes an alternative embodiment in which “a bank of such touch strips [is] mounted along each edge” of the display screen. *Id.* at 4:33–34. In this embodiment “keys associated with the . . . keyboard must permit switching between different ones of the banks of strips.” *Id.* at 4:34–36.

Moore also describes “soft keys . . . can be given any of a number of functional designations,” which can be “changed if and when desired during use.” *Id.* at 1:9–14. Soft keys are advantageous because they “limit keyboard size.” *Id.* at 1:9–12. According to Moore, one implementation of a soft key keyboard is used in “a combined telephone and display terminal” marketed commercially. *Id.* at 1:15–26.

3. Petitioner's Contentions

Petitioner asserts Palatsi is prior art to the challenged claims under 35 U.S.C. § 102(e) and similarly asserts Moore is prior art to the challenged claims under 35 U.S.C. § 102(a). Pet. 14, 16. Petitioner provides, with support of its declarant, analysis purporting to explain how the combination of Palatsi and Moore would have conveyed to one of ordinary skill in the art the limitations recited in independent claim 1 and its dependent claims 2–11 and 15. *Id.* at 22–54. Also with support of its declarant, Petitioner provides reasons why one of ordinary skill in the art would have combined the teachings of the references. *See, e.g., id.* at 18–22.

i. Independent Claim 1

In general, Petitioner relies on Palatsi's portable telephone for many of the limitations recited in independent claim 1 and further relies on Moore's teachings regarding touch strips. For example, Petitioner contends that Palatsi's portable telephone, with Moore's touch strips replacing Palatsi's soft keys, would have conveyed to one of ordinary skill in the art the contact-sensitive transducer recited in claim 1. *See, e.g.,* Pet. 18, 27–31. Specifically, Petitioner relies on Moore's teachings that the voltage output of a position-sensitive touch strip is “dependent on the distance along the strip of the position touched by a terminal user” and “[t]o operate the terminal in [scrolling] mode, the user merely strokes the touch strips along their length in the direction in which the displayed field is to move.” *Id.* at 28 (quoting Ex. 1012, 1:42–48, 4:21–28). With support from its declarant, Petitioner contends the combination of Palatsi and Moore would have conveyed to one of ordinary skill in the art “a contact-sensitive transducer that responds to moving contact along its surface and produces an output as ‘a voltage output

which is representative of the distance along it at which it is touched.” *Id.* at 28–30 (citing Ex. 1205 ¶ 167; quoting Ex. 1012, 2:22–26).

Petitioner also contends, with support from its declarant, that Palatsi in combination with Moore would have rendered obvious the claim 1 limitation of the controller “scroll[ing] displayed rows along an axis of the display based upon the output signal of the contact-sensitive transducer.” *Id.* at 35–37 (citing Ex. 1205 ¶¶ 180–81). Specifically, Petitioner argues that Palatsi describes scrolling through menu items by pressing a soft key and that Moore describes scrolling rows by “stroking the touch strips along their length in the direction in which the displayed field is to move.” *Id.* at 35–36 (citing Ex. 1087, 2:6–3:2, 3:29–39, Figs. 3, 4; Ex. 1012, 4:20–25; quoting Ex. 1012, 4:21–28).

Regarding the claim 1 limitation of the controller having a first mode in which it is responsive to contact with the contact-sensitive transducer and a second mode in which it is unresponsive to such contact, Petitioner asserts that the combination of Palatsi and Moore would have conveyed the recited “a first mode wherein the controller is responsive to contact with the contact-sensitive transducer” for the reasons discussed above. *Id.* at 37 (citing Ex. 1205 ¶ 184). For the recited “a second mode wherein the controller is unresponsive to contact with the contact-sensitive transducer, the second mode being entered in response to an input from a user,” Petitioner relies on an alternative embodiment of Moore in which “a bank of such touch strips [is] mounted along each edge” of the display screen and in which keys associated with the . . . keyboard must permit switching between different ones of the banks of strips.” *Id.* at 38 (citing Ex. 1012, 4:33–36). Petitioner contends, with support of its declarant, that one of ordinary skill in the art “would have

appreciated that switching a non-used bank of touch strips off, such that the non-used bank of touch strips . . . would be unresponsive to contact with the non-used bank of touch strips, would intuitively solve [the] problem” of “a user accidentally activating an unintended touch strip.” *Id.* at 38–39 (quoting Ex. 1205 ¶¶ 154–57, 185).

Petitioner, with support of its declarant, provides reasons one of ordinary skill in the art would have modified Palatsi’s portable telephone by using touch strips described by Moore and why such a modification would have been obvious to one of ordinary skill in the art. *See, e.g., id.* at 18–22, 30–31, 36–37. For example, Petitioner contends that one of ordinary skill in the art would have looked to Moore for improved input methods because both references are directed to improving a user interface. *Id.* at 18 (citing *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) (“When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one.”)). According to Petitioner, user interface improvements (such as using a touch strip of Moore to cover functionality provided by multiple push-type keys of Palatsi and using a touch strip of Moore to provide for a more intuitive method of scrolling) would have been reasons one of ordinary skill in the art would have substituted Moore’s touch strip for Palatsi’s soft keys. *Id.* at 18, 19.

Petitioner further contends that, because “Palatsi already contemplates substituting ‘one or more touch sensors’ to replace ‘one or more keys’ used for input to the telephone, it would have been obvious for [one of ordinary skill in the art] to try the proposed modification.” *Id.* at 18–19 (citing *KSR*, 550 U.S. at 417). Finally, Petitioner also contends that substituting Moore’s touch strips for Palatsi’s soft keys “amounts to nothing more than employing a

‘predictable use of’ touch strip sensors, as known in the art, to accomplish their ‘established function[.]’” *Id.* at 22 (quoting *KSR*, 550 U.S. at 417); *see KSR*, 550 U.S. at 417 (In evaluating an obviousness challenge, “a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.”).

ii. Dependent Claims 2–11 and 15

In general, Petitioner relies on its proposed combination of Palatsi’s portable telephone with Moore’s touch strips replacing Palatsi’s soft keys for the additional limitations recited in claims 2–11 and 15, which each depend ultimately from independent claim 1. For example, claim 2 additionally recites “wherein the contact-sensitive surface, when the housing is held within the user’s hand such that the rear surface confronts the user’s palm, confronts a finger or a thumb of the holding hand.” Petitioner, with support of its declarant, contends that a user would be able to hold Palatsi’s portable telephone modified with Moore’s touch strips “such that the rear surface of the housing opposes the user’s palm while the user’s thumb wraps around the phone to confront or engage the contact-sensitive surface of the touch strip” on the front surface of the phone’s housing. Pet. 41 (citing Ex. 1087, 1:21–25; Ex. 1205 ¶ 191). Thus, Petitioner concludes that the proposed combination of Palatsi and Moore would have conveyed to one of ordinary skill in the art the additional limitation of dependent claim 2.

In another example, Petitioner contends that its proposed combination would have conveyed to one of ordinary skill in the art the additional limitations recited in dependent claim 15. *Id.* at 53–54. Claim 15 additionally recites “wherein the contact-sensitive transducer comprises one of a resistive transducer, a capacitive transducer and a semiconductive transducer.”

Petitioner further contends that Moore’s touch strips consist of “resistive material spaced from conductive material, and are controlled by applying a voltage gradient along the resistive strips and reading an output voltage that correlates to position.” *Id.* at 54 (citing Ex. 1012, 1:60–2:5, 2:38–67, 4:37–41). Petitioner concludes, with support from its declarant, that Moore’s description discloses a resistive contact-sensitive transducer” that meets the additional claim limitation recited in claim 15. *Id.* (citing Ex. 1205 ¶ 211).

4. Patent Owner’s Contentions

Patent Owner contends that Petitioner “fail[s] to address the differences between the prior art and the claimed invention” because it “provides only a cursory discussion of the significant size differences between the touch strips of the display terminal of Moore and the handheld—*i.e.*, much smaller—aspect of the claimed invention (claim 1 requires that the radiotelephone comprises [a] housing ‘configured to be held in a user’s hand’).” Prelim. Resp. 14–15. According to Patent Owner, this alleged deficiency means that Petitioner “has failed to show that the cited prior art references could be successfully combined by [one of ordinary skill in the art] to result in the invention of claims 1–11 and 15 of the ’931 patent.” *Id.* at 15.

Patent Owner’s argument does not address Petitioner’s reliance on Palatsi’s portable telephone and Palatsi’s disclosure of the need to make handheld telephones smaller. *See, e.g.*, Pet. 22–23 (citing Ex. 1087, 1:21–24 (quoting “[t]here is a need for portable telephones (especially hand-portable telephones) to be smaller to make them more convenient to carry”), 2:17–18 (describing a portable telephone with a radio transceiver shown in Fig. 2)). “[T]he test for obviousness is what the combined teachings of the references

would have suggested to those having ordinary skill in the art.” *In re Mouttet*, 686 F.3d 1322, 1333 (Fed. Cir. 2012).

Patent Owner further contends that Petitioner’s alleged combination “appears to assume that the touch-sensitive strips of Moore are devices that can literally be stripped from their native environment [on a display terminal] and pasted onto the portable telephone of Palatsi.” Prelim. Resp. 21. Patent Owner asserts the Petition is insufficient because Moore does not describe “how the functionality or structure of the touch-sensitive strips can be incorporated into a handheld portable telephone, such as that disclosed by Palatsi, which already has existing hardware contained in the housing.” *Id.* at 22–23. Patent Owner concludes that “the Petition’s failure to articulate how Palatsi’s handheld mobile phone would actually be modified is a fatal omission, especially” in view of the housing limitations recited by claim 1. *Id.* at 25. Claim 1 requires, among other limitations, “the housing [be] configured to be held in a user’s hand such that the rear surface confronts the user’s palm.” *Id.*

Patent Owner’s contentions essentially require the bodily incorporation of Moore’s touch strips into Palatsi’s handheld, portable telephone. The test for obviousness, however, is not whether the features of a reference may be bodily incorporated into another reference to produce the claimed subject matter; rather, it is what the combination of references makes obvious to one of ordinary skill in the art. *Mouttet*, 686 F.3d at 1332 (“It is well-established that a determination of obviousness based on teachings from multiple references does not require an actual, physical substitution of elements.”) (citing *In re Etter*, 756 F.2d 852, 859 (Fed. Cir. 1985) (en banc) (“Etter’s assertions that Azure cannot be incorporated in Ambrosio are basically irrelevant, the criterion being not

whether the references could be physically combined but whether the claimed inventions are rendered obvious by the teachings of the prior art as a whole.”)).

Furthermore, Patent Owner contends that Petitioner’s alleged combination would not have been predictable to one of ordinary skill in the art and additionally that Moore’s display terminal and Palatsi’s portable telephone are not similar devices. Prelim. Resp. 23. Recognizing that Patent Owner has not yet had an opportunity to submit new testimonial evidence,⁵ we are not persuaded that these contentions are supported sufficiently in the present record.

5. Conclusion

On the present record, Petitioner has made a sufficient showing that the combination of Palatsi and Moore would have conveyed to one of ordinary skill in the art the limitations of claims 1–11 and 15. Petitioner also has provided, with support from its declarant, reasons one of ordinary skill in the art would have combined the references. For the foregoing reasons, we determine that Petitioner has provided adequate evidence to show a reasonable likelihood of prevailing in its assertions that claims 1–11 and 15 would have been obvious over Palatsi and Moore.

C. Asserted Ground of Obviousness over Palatsi, Moore, and Tiilikainen

Petitioner asserts claim 12 is unpatentable under 35 U.S.C. § 103 as obvious over Palatsi, Moore, and Tiilikainen. Pet. 54–59. Petitioner supports its contentions with citations to the references and with declaration testimony. *Id.*

⁵ See 37 C.F.R. § 42.107(c) (“The preliminary response shall not present new testimony evidence beyond that already of record, except as authorized by the Board.”).

1. Summary of Tiilikainen

Tiilikainen published July 10, 1996. Ex. 1088, [43]. Tiilikainen describes “a mobile telephone [that] is equipped with an alphanumerical display . . . and a scrolling key.” Ex. 1088, 1:19–22, Fig. 1 (showing mobile phone 10 with alphanumerical display 11 and scrolling key 12). Tiilikainen also indicates that a mobile phone may be a “pocket-size phone.” *Id.* at 1:4–10.

Tiilikainen further describes “a method of quick-dialing a telephone number” that includes a user making “a selection [of a telephone number on the mobile telephone’s display] by double-pressing, i.e. pressing the required column quickly two subsequent times.” Ex. 1088, 1:3–4, 3:22–24; *see id.* at 3:8–19 (describing scrolling to display a telephone number on the mobile telephone’s display).

2. Petitioner’s Contentions

Claim 12, which depends ultimately from independent claim 1, additionally recites “wherein the controller is operative to initiate the action in response to detection of a plurality of momentary contacts occurring within a predetermined time interval.” Petitioner characterizes “a plurality of momentary contacts occurring within a predetermined time interval” as “double-tapping.” *See, e.g.*, Pet. 58 (“a plurality of momentary contacts occurring within a predetermined time interval’ (i.e., double tapping)”).

Petitioner asserts Tiilikainen is prior art under 35 U.S.C. § 102(a). *Id.* at 54. Petitioner contends that Tiilikainen’s description of making a selection by double-pressing part of a mobile telephone’s display would have conveyed to one of ordinary skill in the art the additionally recited limitation in claim 12. *Id.* at 59 (quoting Ex. 1088, 3:22–24 (indicating “the selection can

be thought to be activated by double-pressing, i.e. pressing the required column quickly two subsequent times”)); *see id.* at 54–55 (describing Tiilikainen’s disclosure).

Petitioner, with support of its declarant, also provides reasons why one of ordinary skill in the art would have combined Tiilikainen’s quick-dialing method with the combination of Palatsi and Moore described previously with respect to independent claim 1. *Id.* at 56–58, 59. For example, Petitioner asserts combining Tiilikainen with the combination of Palatsi and Moore “amounts to nothing more than employing a ‘predictable use of’ a method of selecting information displayed on [a] mobile telephone [graphical user interface], as known in the art, to accomplish its ‘established function.’” *Id.* at 57–58 (citing Ex. 1205 ¶ 152; quoting *KSR*, 550 U.S. at 417). Petitioner further contends one of ordinary skill in the art would have combined Tiilikainen with the combination of Palatsi and Moore to enhance the “user-friendliness” of a mobile telephone, which purportedly would have been consistent with a stated goal of Palatsi. *Id.* at 56 (citing Ex. 1087, 1:24–29; Ex. 1205 ¶ 151). Petitioner also contends that one of ordinary skill in the art would have combined the references because both Palatsi and Tiilikainen are patents directed to improving the same manufacturer’s mobile telephones. *Id.* (citing Ex. 1205 ¶ 151).

3. Patent Owner’s Contentions

At this preliminary stage, Patent Owner argues merely that Tiilikainen does not remedy the alleged deficiency in Petitioner’s combination of Palatsi and Moore. Prelim. Resp. 29–30. Specifically, Patent Owner asserts that, like Palatsi, Tiilikainen does not disclose “a moving contact” as required in independent claim 1. *Id.* at 30.

4. Conclusion

On the present record, Petitioner has made a sufficient showing that the combination of Palatsi, Moore, and Tiilikainen would have conveyed to one of ordinary skill in the art the limitations of claim 12. Petitioner also has provided, with support from its declarant, reasons one of ordinary skill in the art would have combined the references. For the foregoing reasons, we determine that Petitioner has provided adequate evidence to show a reasonable likelihood of prevailing in its assertions that claim 12 would have been obvious over Palatsi, Moore, and Tiilikainen.

III. CONCLUSION

For the foregoing reasons, we determine that there is a reasonable likelihood that Petitioner would prevail in showing that at least one of claims 1–12 and 15 of the '931 patent is unpatentable.

Any discussion of facts in this Decision are made only for the purposes of institution and are not dispositive of any issue related to any ground on which we institute review. The Board has not made a final determination with respect to the patentability of any challenged claim. The Board's final determination will be based on the record as fully developed during trial.

IV. ORDER

After due consideration of the record before us, it is:

ORDERED that *inter partes* review is authorized on the following grounds of unpatentability asserted in the Petition:

Claims 1–11 and 15 under 35 U.S.C. § 103(a) as unpatentable over Palatsi and Moore, and

Claim 12 under 35 U.S.C. § 103(a) as unpatentable over Palatsi, Moore, and Tiilikainen;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of the '931 patent is hereby instituted commencing on the entry date of this Order, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; and

FURTHER ORDERED that the trial is limited to the grounds identified above, and no other ground set forth in the Petition as to any challenged claim is authorized.

IPR2015-01674
Patent RE43,931 E

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