

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner,

v.

IMMERSION CORPORATION,  
Patent Owner.

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Case IPR2017-01368  
Patent 8,581,710 B2

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Before MICHAEL R. ZECHER, BRYAN F. MOORE, and MINN CHUNG,  
*Administrative Patent Judges.*

CHUNG, *Administrative Patent Judge.*

DECISION

Denying Institution of *Inter Partes* Review  
35 U.S.C. § 314(a) and 37 C.F.R. § 42.108

## I. BACKGROUND

### A. Introduction

Apple Inc. (“Petitioner”) filed a Petition (Paper 1, “Second Petition,” or “Second Pet.”) requesting an *inter partes* review of claims 13 and 18–20 (the “challenged claims”) of U.S. Patent No. 8,581,710 B2 (Ex. 1101, “the ’710 patent”). As discussed further below, the claims challenged in the Second Petition cover essentially the same scope as the claims Petitioner challenged in its prior petition filed in Case IPR2016-01603 (*Apple Inc. v. Immersion Corp.*, Case IPR2016-01603 (filed Aug. 12, 2016) (Paper 1, “First Petition” or “First Pet.”)). Immersion Corporation (“Patent Owner”) timely filed a Preliminary Response (Paper 7, “Prelim. Resp.”).

Institution of *inter partes* review is discretionary. *See* 35 U.S.C. § 314(a); 37 C.F.R. § 42.108(a). Under the circumstances of this case, for the reasons explained below, we exercise our discretion to not institute an *inter partes* review as to any of claims 13 and 18–20 of the ’710 patent.

### B. Related Proceedings

According to the parties, the ’710 patent is the subject of the following proceedings: (1) *Immersion Corp. v. Apple Inc.*, Nos. 1:16-cv-00077 and 1:16-cv-00325 (D. Del.); and (2) *In the Matter of: Certain Mobile and Portable Electronic Devices Incorporating Haptics (Including Smartphones and Laptops) and Components Thereof*, ITC Investigation No. 337-TA-1004 (USITC). Second Pet. 1; Paper 5, 2.

The ’710 patent is also the subject of an instituted trial proceeding in Case IPR2016-01603. *Apple Inc. v. Immersion Corp.*, Case IPR2016-01603 (PTAB Feb. 23, 2017) (Paper 7, “1603 Dec. on Inst.”).

### *C. The '710 Patent*

The '710 patent describes a system and method for haptic confirmation of commands on electronic devices. Ex. 1101, Abstract. In one exemplary embodiment, the device recognizes a speech input, e.g., “call home,” and determines a command associated with the recognized speech, e.g., making a telephone call to the phone number designated as “home.” *Id.* at col. 2, ll. 17–25. If the spoken command is recognized successfully, the device generates a haptic effect to provide a tactile feedback to the user that the command has been recognized and that the device will perform the requested function. *Id.* at col. 2, ll. 19–23. If, on the other hand, the device does not recognize a command, it generates a different haptic effect to indicate that no command is recognized and that no function will be performed. *Id.* at col. 2, ll. 25–29.

In another embodiment, the device recognizes a touch input on a touch-sensitive display and determines a command corresponding to the touch input. *Id.* at col. 12, ll. 30–45. Figure 6 of the '710 patent is reproduced below.

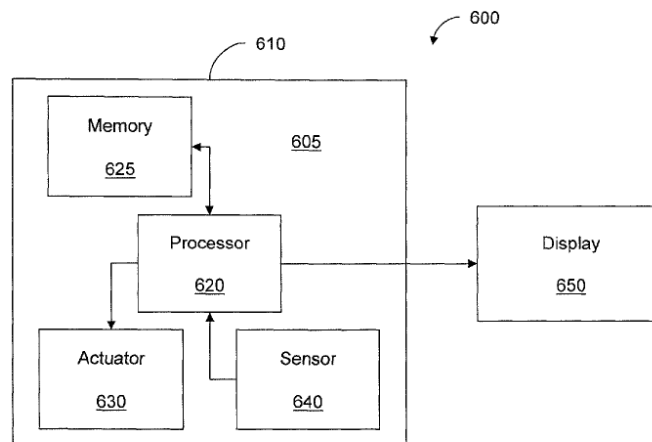


Figure 6

Figure 6 depicts a block diagram of a system for haptic confirmation of commands in an exemplary embodiment. *Id.* at col. 11, ll. 12–14. As shown in Figure 6 above, the system comprises device 610 having housing 605, and display 650, which may be coupled to the housing or disposed within the housing. *Id.* at col. 11, ll. 14–15, 21–22. Device 610, in turn, comprises processor 620, memory 625, actuator 630, and sensor 640. *Id.* at col. 11, ll. 15–17. In an embodiment, display 650 is a touch-sensitive display, which transmits sensor signals to the processor when a user touches a location on the touch-sensitive display. *Id.* at col. 12, ll. 32–34.

Upon receiving sensor signals from the touch-sensitive display, the processor attempts to identify a command corresponding to the signals, e.g., a button or other user interface element on the display corresponding to the location of the user touch on the touch-sensitive display. *Id.* at col. 12, ll. 38–42. If the processor determines a command corresponding to the user touch input, it generates an actuator signal to produce a haptic effect that indicates that a command was recognized successfully. *Id.* at col. 12, ll. 42–45, 53–56. Otherwise, the processor generates another actuator signal to produce a haptic effect that indicates no command was recognized. *Id.* at col. 12, ll. 46–49. In either case, the processor then transmits the actuator signal to the actuator to output the appropriate haptic effect. *Id.* at col. 12, ll. 49–52, 56–59. If a command has been recognized, the processor executes the function associated with the command. *Id.* at col. 12, ll. 59–61.

*D. Illustrative Claim*

Claim 13 is the only independent claim at issue. Claims 18–20 depend directly from claim 13. Claim 13 is illustrative of the challenged claims and is reproduced below:

13. A computer-implemented method comprising the steps of:  
receiving, from a sensor, a sensor signal associated with a user input;  
recognizing the user input and determining a command associated with the speech information;  
if the user input is recognized and the command is determined:  
generating a first actuator signal configured to cause an actuator to output a first haptic effect; and  
transmitting the first actuator signal to the actuator;  
otherwise:  
generating a second actuator signal configured to cause the actuator to output a second haptic effect; and  
transmitting the second actuator signal to the actuator.

Ex. 1101, col. 14, l. 58–col. 15, l. 5.

*E. First Petition in IPR2016-01603*

On August 12, 2016, Petitioner filed the First Petition in Case IPR2016-01603 requesting an *inter partes* review of claims 1, 7–10, and 12 of the ’710 patent. First Pet. 3, 57. In the First Petition, Petitioner asserted the following grounds of unpatentability (*id.* at 3).

Claim(s) Challenged	Statutory Basis	Reference(s)
1, 7–10, and 12	§ 103(a)	Martin <sup>1</sup>
1, 7, 9, 10, and 12	§ 103(a)	Martin and Nokia <sup>2</sup>
8	§ 103(a)	Martin, Nokia, and Rank <sup>3</sup>

On February 23, 2017, based on the arguments and evidence presented in the First Petition, we instituted an *inter partes* review as to claims 1, 7–10, and 12 of the ’710 patent on the grounds that these claims are unpatentable under 35 U.S.C. § 103(a) as obvious over Martin alone or Martin combined with Nokia. 1603 Dec. on Inst. at 39.

*F. Asserted Grounds of Unpatentability in the Second Petition*

On May 4, 2017, which was more than two months after our Decision on Institution in Case IPR2016-01603 was entered, Petitioner filed its Second Petition in this case requesting an *inter partes* review of claims 13

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<sup>1</sup> U.S. Patent No. 7,336,260 B2 (issued Feb. 26, 2008) (Ex. 1106, “Martin”).

<sup>2</sup> Nokia 9110 Communicator User’s Manual (1999) (“Nokia”).

<sup>3</sup> U.S. Patent Application Pub. No. 2003/0067440 A1 (published Apr. 10, 2003) (“Rank”).

and 18–20 of the ’710 patent. In its Second Petition, Petitioner asserts the following grounds of unpatentability (Second Pet. 3).

Claims Challenged	Statutory Basis	References
13, 19, and 20	§ 103(a)	Martin and Makela <sup>4</sup>
13, 18, and 20	§ 103(a)	Theodore <sup>5</sup> and Shahoian <sup>6</sup>

## II. ANALYSIS

### *A. Discretionary Non-Institution Under 35 U.S.C. § 314(a)*

Patent Owner asserts that the Second Petition should be denied because (1) it would be inequitable to Patent Owner to allow Petitioner’s second challenge to claims of essentially the same scope when Petitioner benefited from Patent Owner’s Preliminary Response and the Board’s Decision on Institution in Case IPR2016-01603, and (2) Petitioner knew or should have known of the prior art references asserted in its Second Petition when filing its First Petition in Case IPR2016-01603. Prelim. Resp. 10–15 (citing *Akamai Technologies, Inc. v. Limelight Networks, Inc.*, Case IPR2017-00358 (PTAB May 2, 2017) (Paper 9)).

Institution of *inter partes* review is discretionary. *See* 35 U.S.C. § 314(a) (authorizing institution of an *inter partes* review under particular circumstances, but not requiring institution under any circumstances);

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<sup>4</sup> U.S. Patent Application Pub. No. 2009/0164207 A1 (published June 25, 2009) (Ex. 1107, “Makela”).

<sup>5</sup> U.S. Patent No. 6,505,159 B1 (issued Jan. 7, 2003) (Ex. 1104, “Theodore”).

<sup>6</sup> U.S. Patent Application Pub. No. 2002/0033795 A1 (published Mar. 21, 2002) (Ex. 1105, “Shahoian”).

37 C.F.R. § 42.108(a) (stating “the Board *may* authorize the review to proceed”) (emphasis added); *Harmonic Inc. v. Avid Tech, Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (explaining that under § 314(a), “the PTO is permitted, but never compelled, to institute an IPR proceeding”). When determining whether to exercise our discretion under § 314(a), we consider the following non-exhaustive factors:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition;
4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite resources of the Board; and
7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

*Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, Case IPR2016-01357, slip op. 15–16 (PTAB Sept. 6, 2017) (Paper 19) (precedential)<sup>7</sup> (hereinafter, “*General Plastic*”) (citing *NVIDIA Corp. v. Samsung Elec. Co.*, IPR2016-00134, slip op. 6–7 (PTAB May 4, 2016) (Paper 9)).

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<sup>7</sup> *General Plastic* was designated precedential on October 18, 2017.



A central issue addressed by the *General Plastic* factors is balancing the equities between a petitioner and a patent owner when information is available from prior Board proceedings for a subsequent proceeding. *General Plastic*, slip op. at 15–19. Accordingly, we use the non-exhaustive *General Plastic* factors as a framework for assessing, under the specific circumstances of this case, the equities of allowing the Second Petition filed by the same Petitioner that challenges claims of the same patent having essentially the same scope as the claims challenged in the First Petition to proceed to trial. We address each of these factors in turn, but note that not all the factors need to weigh against institution for us to exercise our discretion under § 314(a).

*Factor 1: Whether Petitioner Previously Filed a Petition Directed to the Same Claims of the Same Patent*

As discussed above, Petitioner’s First Petition challenged claims 1, 7–10, and 12 of the ’710 patent. First Pet. 3. In its Second Petition, Petitioner challenges claim 13, as well as claims 18–20, which depend from claim 13. *See* Second Pet. 3. Claim 13 is a method claim corresponding to system claim 1 in that claim 13 recites steps that are essentially identical to the steps performed by the “processor” recited in claim 1. *Compare* Ex. 1101, col. 14, ll. 5–17 (claim 1), *with id.* at col. 14, l. 60–col. 15, l. 5 (claim 13). Indeed, Petitioner acknowledges that claim 13 recites “*substantially identical* ‘if’ and ‘otherwise’ conditional limitations as claim 1.” Second Pet. 9–10 (emphasis added). Claims 19 and 20, which depend from claim 13, recite essentially the same limitations as claims 7 and 8, respectively, which depend from claim 1. Hence, claims 13, 19, and 20 challenged in Petitioner’s Second Petition cover essentially the same scope as claims 1, 7,

and 8 that were challenged in its First Petition. This leaves claim 18 as the only claim challenged in the Second Petition that had no corresponding challenge in the First Petition. However, because claim 18 depends from claim 13, a challenge to claim 18 necessarily invokes a challenge to claim 13. Thus, on the whole, the Second Petition overwhelmingly challenges the claims covering essentially the same scope as the claims challenged in the First Petition filed in Case IPR2016-01603. Apart from asserting that it was attempting to conserve the resources of the Board and the parties (Second Pet. 50)—which is unpersuasive for the reasons discussed below—Petitioner does not explain adequately why it could not have addressed claims 3 and 18–20 in the First Petition. Accordingly, this factor weighs against institution.

*Factor 2: Whether Petitioner Knew of the Prior Art Asserted in the Second Petition When It Filed the First Petition*

As discussed above, the Second Petition presents two separate grounds—one based on Martin in view of Makela, and the other based on Theodore in view of Shahoian. Second Pet. 3. In these grounds, Petitioner relies on Martin and Theodore as the primary references in that Petitioner relies on them to teach most of the claim limitations of the challenged claims. *See id.* at 3, 15–33, 38–49.

Petitioner knew of Martin when it filed the First Petition because, as discussed above, the First Petition asserted grounds involving Martin. As Patent Owner notes, the Reference Cited section on the face of the '710 patent lists the international application of Theodore (WO 99/45531). Ex. 1101 at [56]; Prelim. Resp. 12. Indeed, Petitioner acknowledges that WO 99/45531 listed on the face of the '710 patent is “the PCT application of

Theodore.” Second Pet. 36. Hence, Petitioner knew or should have known of Theodore when it filed its First Petition. In other words, at the time of filing its First Petition, Petitioner knew or should have known of both of the two primary references relied upon in its Second Petition.

Patent Owner argues that Petitioner also knew or should have known of Shahoian at the time of its filing of the First Petition because Petitioner asserted grounds based on Shahoian in its Petition in Case IPR2016-01777, which was filed about a month after the First Petition was filed in Case IPR2016-01603. Prelim. Resp. 12–13. Although the record is somewhat unclear as to whether Petitioner knew or should have known of Shahoian when filing its First Petition, the timing of the filing of its Petition in Case IPR2016-01777 seems to indicate that Petitioner was likely aware of Shahoian when filing its First Petition in Case IPR2016-01603. Further, Petitioner says nothing about why it could not have presented Shahoian in the First Petition. *See* Second Pet. 50.

Similarly, although there is not sufficient evidence in the record before us that Petitioner was aware of Makela prior to filing the First Petition, Petitioner says nothing about whether it reasonably should have known about Makela or why it could not have presented Makela in the First Petition. *See id.*

Because Petitioner knew or should have known of three out of the four references, including the two primary references, asserted in its Second Petition when it filed its First Petition, and provided no explanation of why it could not have raised the last reference in the First Petition, this factor weighs against institution.

*Factor 3: Whether Petitioner Had Patent Owner's Preliminary Response and the Board's Institution Decision on the First Petition When Petitioner Filed the Second Petition*

Patent Owner filed its Preliminary Response to the First Petition on November 28, 2016. *See* Case IPR2016-01603, Paper 6. We issued our Decision on Institution addressing the First Petition on February 23, 2017. 1603 Dec. on Inst. at 1. Hence, when Petitioner filed the Second Petition on May 4, 2017 (*see* Second Pet. 51), Petitioner had both Patent Owner's Preliminary Response to the First Petition and the Board's Decision on whether to institute review addressing the First Petition. Consequently, this factor weighs against institution.

*Factor 4: The Elapsed Time Between When Petitioner Had Patent Owner's Preliminary Response and the Board's Institution Decision on the First Petition and When Petitioner Filed the Second Petition*

The delay between when Petitioner had Patent Owner's Preliminary Response to the First Petition, as well as the Board's Decision on Institution addressing the First Petition, and when Petitioner filed the Second Petition left Petitioner with sufficient time to take advantage of Patent Owner's and the Board's responses to the First Petition. When Petitioner filed its Second Petition on May 4, 2017, Petitioner had Patent Owner's Preliminary Response to the First Petition for over five months, and our Decision on Institution addressing the First Petition for over two months. Thus, Petitioner not only had the relevant materials from Patent Owner and the Board when it filed its Second Petition, but had ample time to take advantage of those materials in crafting its arguments in the Second Petition. As a result, this factor weighs against institution.

Factor 5: Whether Petitioner Has Provided Adequate Explanation

The fifth *General Plastic* factor is “whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent.” *General Plastic*, slip op. at 9, 16. A closely related factor often considered when determining whether to exercise our discretion under § 314(a) is “whether the petitioner provides adequate explanation why we should permit another attack on the same claims of the same patent.” *Akamai*, slip op. at 9; *Xactware Sols., Inc. v. Eagle View Techs., Inc.*, Case IPR2017-00034, slip op. at 7–8 (PTAB Apr. 13, 2017) (Paper 9).

Petitioner addresses our discretion to deny institution only briefly. Petitioner asserts that the Second Petition addresses different claims based on different prior art. Second Pet. 50. Petitioner also cites a previous Board decision in Case IPR2016-00448 and states that Petitioner has not “‘overwhelmed Patent Owner with an unreasonable number of challenges of patentability’ because this is only the second petition that Petitioner has filed regarding the ’710 patent.” *Id.* Petitioner also asserts that the Second Petition challenges additional claims because the additional claims are asserted in the related district court proceedings, but were not asserted in the related ITC investigation. *Id.* Petitioner states that it omitted challenges of the additional claims from the prior Petition in order to conserve the resources of the Board and the parties. *Id.*

These explanations, without more, do not justify permitting Petitioner to wait to file its Second Petition until after it has had the advantage of seeing our Decision on Institution addressing the First Petition. Petitioner’s stated reason for filing two separate petitions, i.e., to conserve resources of

the Board and the parties, does not explain why Petitioner could not have filed the petitions at the same time and simultaneously challenged all of the claims asserted in the related ITC and district court proceedings. As the First and Second Petitions indicate, Petitioner knew of both the ITC and the district court proceedings when the First Petition was filed. *See* First Pet. 1, Second Pet. 1.

Furthermore, as discussed above, the claims challenged in Petitioner's Second Petition cover essentially the same scope as the claims challenged in its First Petition. Hence, contrary to Petitioner's contention, the resources of both the Board and the parties would have been saved if the challenges to these claims were raised at the same time. Consequently, this factor also weighs against institution.

*Factors 6 and 7: Board Considerations*

The sixth and seventh General Plastic factors consider “the finite resources of the Board” and “the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.” *General Plastic*, slip op. at 9–10, 16.

We conclude that these factors are not implicated under the circumstances of this case, and, therefore, do not weigh for or against exercising our discretion.

*Weighing the Factors for Discretionary Non-Institution Under § 314(a)*

We view Petitioner's strategy in this particular case as burdensome to Patent Owner and the Board. Additionally, Petitioner has not provided a persuasive explanation of why its challenges raised in the Second Petition should be allowed. Petitioner does not even attempt to explain why it could

not have raised the challenges in the Second Petition simultaneously with the challenges raised in the First Petition. And we find Petitioner's explanation of why it chose to delay filing the Second Petition unpersuasive. We do not take lightly denying a petition on grounds unrelated to its substantive patentability challenges. Nor do we hold that multiple petitions against claims of the same patent that cover essentially the same scope are never permitted. Here, however, weighing the relevant factors under the circumstances of this case, which, as we explain above, all favor exercising our discretion not to institute, we view the prejudice to Patent Owner to be greater than that to Petitioner. We, therefore, decline to institute *inter partes* review under 35 U.S.C. § 314(a).

### III. CONCLUSION

For all of the reasons discussed above, we exercise our discretion under 35 U.S.C. § 314(a) and 37 C.F.R. § 42.108(a) not to institute review in this proceeding with respect to claims 13 and 18–20 of the '710 patent.

### IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied* as to all challenged claims of the '710 patent, and no trial is instituted.

IPR2017-01368  
Patent 8,581,710 B2

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