

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 IPR2015-01806
Patent RE43,931 E

Before PATRICK R. SCANLON, BARBARA A. BENOIT, and
STACY B. MARGOLIES, *Administrative Patent Judges*.

BENOIT, *Administrative Patent Judge*.

DECISION
Final Written Decision
U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

This *inter partes* review, instituted pursuant to 35 U.S.C. § 314, challenges the patentability of claims 58–69 of U.S. Patent No. RE43,931 E (Ex. 1001, “the ’931 patent” or “the challenged patent”), owned by Telefonaktiebolaget LM Ericsson (“Patent Owner”). We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. This Final Written Decision is issued concurrently with a Final Written Decision in IPR2015-01646, which also challenges the patentability of claims 58–69 of the ’931 patent.

For the reasons discussed herein, Petitioner has shown by a preponderance of the evidence that claims 58–69 of the ’931 patent are unpatentable.

A. Procedural History

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 58–69 (“the challenged claims”) of the ’931 patent. Paper 1 (“Pet.”). We instituted an *inter partes* review of the challenged claims as unpatentable on certain grounds. Paper 8 (“Inst. Dec.”).

Patent Owner filed a Patent Owner Response to the Petition (Paper 20, “PO Resp.”), to which Petitioner filed a Reply (Paper 25, “Pet. Reply”). Petitioner relies on the Declarations of Andrew Wolfe, Ph.D. (Exhibits 1208 and 1211) in support of its contentions, and Patent Owner

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relies on the Declaration of Jean Renard Ward (Exhibit 2057) in support of its contentions.

An oral hearing was held on December 15, 2016. A transcript of the oral hearing is included in the record. Paper 35 (“Tr.”).

B. Related Matters

As required by 37 C.F.R. § 42.8(b)(2), each party identifies various judicial or administrative matters that would affect or be affected by a decision in this proceeding. Pet. 1–2; Paper 4 (Patent Owner’s Related Matters). The parties indicate that the ’931 patent is at issue in *Ericsson Inc. v. TCL Commc’n Tech. Holdings, Ltd.*, No. 2:15-cv-11 (E.D. Tex.). Pet. 1–2; Paper 4. In addition, the parties identify *Ericsson Inc. v. TCL Commc’n Tech. 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 4.

Claims of the ’931 patent also are subject to *inter partes* review in IPR2015-01602, IPR2015-01637, IPR2015-01641, IPR2015-01646, IPR2015-01674, IPR2015-01676, and IPR2015-01761. With particular regard to the claims at issue in this proceeding, Petitioner filed two Petitions for *inter partes* review of claims 58–69 of the ’931 patent, which were designated as IPR2015-01646 and IPR2015-01806, respectively. The Petition in IPR2015-01646 was filed August 3, 2015, whereas the Petition for this proceeding was filed August 28, 2015.

Petitioner relies on U.S. Patent No. 5,892,475 (“Palatsi”) and U.S. Patent No. 4,566,001 (“Moore”) in IPR2015-01674, IPR2015-01676,

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IPR2015-01761, and IPR2015-01806. Paper 14 (“Consolidation Order”). Subsequent to institution of these *inter partes* reviews, and after conferring with the parties neither of whom opposed consolidation, we ordered an identical, consolidated patent owner response under 37 C.F.R. § 42.120 be filed in the record of these *inter partes* reviews involving assertions that various claims of the ’931 were unpatentable over Moore and Palatsi. *Id.* Similarly, we ordered Petitioner’s reply, if any, to be an identical, consolidated reply filed in each *inter partes* review. *Id.* We also expanded the permitted length to two-and-a-half times the length limit provided in 37 C.F.R. § 42.24(b)(1) for both the patent owner response and petitioner’s reply. *Id.* In addition, we held a consolidated hearing for these four *inter partes* reviews. Tr. at 2:17–19.

C. The ’931 Patent

The ’931 patent is a reissue of U.S. Patent No. 6,278,888, which issued on August 21, 2001 from an application filed on July 25, 2000. Ex. 1001, [64]. The earliest effective filing date claimed by the ’931 patent is December 30, 1997. *Id.* at [63].

1. The Written Description

The ’931 patent identifies “the need for improved input devices for radiotelephones.” *Id.* at 1:66–67. The patent describes conventional approaches of using one or more keys to control the scrolling of graphical objects on the display or using “a wheel-like input device . . . mounted on the radiotelephone case that may be turned by a user to effect scrolling of graphical objects on the display.” *Id.* at 1:48–56. The patent indicates that

the use of “[k]eys for scrolling and invoking display selections . . . may consume valuable space on the keypad of the radiotelephone.” *Id.* at 1:60–63.

The patent describes 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:

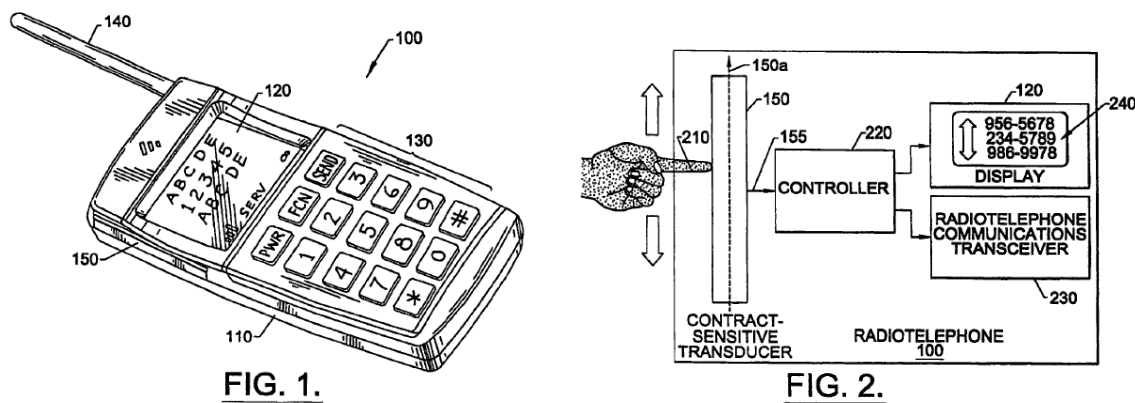


Figure 1 illustrates radiotelephone 100, and Figure 2 is a block diagram of the radiotelephone. *Id.* at 4:15–18. Radiotelephone 100 comprises housing 110, supporting display 120, and keys 130. *Id.* at 5:1–3. Mounted on a side surface of housing 110 is contact-sensitive transducer 150. *Id.* at 5:10–11.

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

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