

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

IMMERSION CORPORATION,
Patent Owner.

Case IPR2017-01371
Patent 7,808,488 B2

Before BRYAN F. MOORE, PATRICK R. SCANLON, and
MINN CHUNG, *Administrative Patent Judges*.

SCANLON, *Administrative Patent Judge*.

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

I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition (Paper 1, “Second Petition,” or “Second Pet.”) requesting an *inter partes* review of claims 3–8, 11–16, and 19–28 of U.S. Patent No. 7,808,488 B2 (Ex. 1101, “the ’488 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 IPR2016-01907 (*Apple Inc. v. Immersion Corp.*, Case IPR2016-01907 (filed Sept. 29, 2016) (Paper 1, “First Petition” or “First Pet.”)). Immersion Corporation (“Patent Owner”) filed a Preliminary Response (Paper 6, “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 3–8, 11–16, and 19–28 of the ’488 patent.

II. BACKGROUND

A. Related Matters

The parties indicate that the ’488 patent is at issue in the following related cases: *Immersion Corp. v. Apple Inc.*, Nos. 1:16-cv-00077 and 1:16-cv-00325 (D. Del.); and *In the Matter of: Certain Mobile Electronic Devices Incorporating Haptics (Including Smartphones and Smartwatches) and Components Thereof*, ITC Investigation No. 337-TA-990 (USITC), which has been consolidated with *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 '488 patent is also the subject of an instituted trial proceeding in Case IPR2016-01907. *Apple Inc. v. Immersion Corp.*, Case IPR2016-01907 (PTAB Apr. 3, 2017) (Paper 10, "1907 Dec. on Inst.").

B. The '488 patent

The '488 patent, titled "Method and Apparatus for Providing Tactile Sensations," issued on October 5, 2010. Ex. 1101, (54), (45). The '488 patent describes a system and method for providing tactile sensations to input devices, including non-mechanical input devices, such as soft-keys displayed on a screen. *Id.* at Abstract; 3:3–7. In particular, the '488 patent describes different tactile sensations to users manipulating an input device such as a touchscreen, based in part on varying levels of pressure applied to the input device by the users. *Id.* at 5:39–58. Figure 2 of the '488 patent is reproduced below.

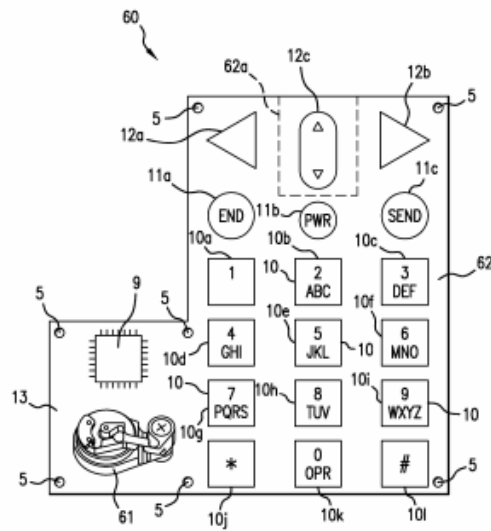


FIG.2

Figure 2 depicts apparatus 60 with multiple input devices arranged as keys in a key pad for a telephone or mobile telephone, including twelve fixed or pre-assigned alphanumeric input buttons 10a-l, three pre-assigned function

buttons 11*a-c*, and three assignable function buttons 12*a-c*. *Id.* at 5:40–48. Each of alphanumeric buttons 10 is capable of receiving multiple levels of pressure, such as button 10*i* capable of resolving five levels of increasingly greater pressure. *Id.* at 5:63–6:9. Pre-assigned function buttons 11 are capable of resolving three levels of increasingly greater pressure. *Id.* at 6:50–53. Actuator 61 is in communication with input devices and with controller 9 and is configured to provide vibrations of varying frequencies to the input devices in response to signals transmitted from the controller. *Id.* at 7:64–8:23.

Figure 4 of the '488 patent is reproduced below.

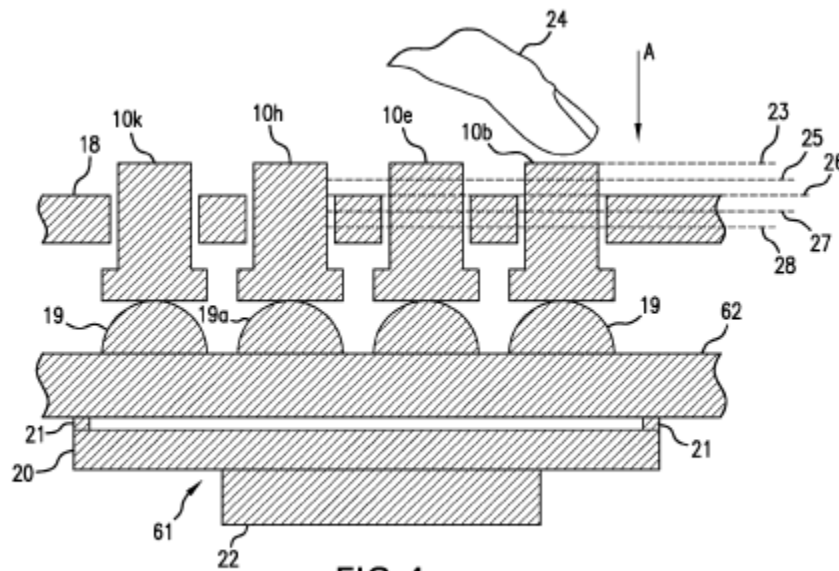


FIG. 4

Figure 4 depicts alphanumeric input buttons or keys 10 in a mobile telephone, passing through case 18 of the telephone and contacting a plurality of switches 19 that are in communication with controller 9 and disposed on printed circuit board (PCB) 62. *Id.* at 8:35–40. PCB 62 in turn is in communication with actuator 61, which is a piezo-electric actuator

having metal diaphragm 20 in contact with piezo-ceramic element 22. *Id.* at 8:51–56.

Object 24, for example a user’s finger, selects one or more of keys 10 by applying pressure in direction of arrow A, causing the selected key to progress through a plurality of positions such as rest position 23, second position 25, third position 26, fourth position 27, and fifth position 28, as greater pressure is applied to button 10. *Id.* at 8:61–9:1. Figure 3 of the ’488 patent is reproduced below.

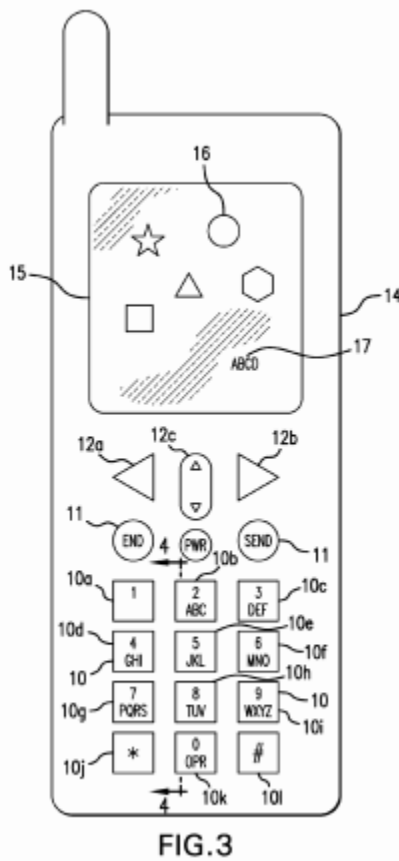


Figure 3 depicts mobile telephone 14, with controller 9, actuator 61, and PCB 62 of apparatus 60 from Figure 2 encased in case 18. *Id.* at 8:24–28. Display screen 15 displays graphical objects 16 and alphanumeric information 17. *Id.* at 8:28–30. When user presses the “9” key/button 10i,

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