

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SZ DJI TECHNOLOGY, CO., LTD.,
Petitioner,

v.

DARELTECH, LLC,
Patent Owner.

Case IPR2019-00716
Patent 9,037,128 B2

Before BRIAN J. McNAMARA, KEVIN C. TROCK, and
JASON W. MELVIN, *Administrative Patent Judges*.

McNAMARA, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
35 U.S.C. § 314
37 C.F.R. § 42.4(a)

BACKGROUND

SZ DJI Technology, Co., Ltd. (“Petitioner”) filed a petition, Paper 2 (“Pet.” or “Petition”), to institute an *inter partes* review of claims 1–29 (the “challenged claims”) of U.S. Patent No. 9,037,128 B2 (“the ’128 patent”). 35 U.S.C. § 311. Dareltech, LLC (“Patent Owner”) timely filed a Preliminary Response, Paper 7 (“Prelim. Resp.”), contending that the Petition should be denied as to all challenged claims. We have jurisdiction under 37 C.F.R. § 42.4(a) and 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted unless the information presented in the Petition “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.” Having considered the arguments and the associated evidence presented in the Petition and the Preliminary Response, for the reasons described below, we institute *inter partes* review of all claims based on all challenges.

RELATED PROCEEDINGS

The Petition states that the ’128 patent is the subject of the following litigation: *Dareltech, LLC v. DJI Tech. Inc. et al.*, No. 1-18-cv-08873 (S.D.N.Y.) filed September 27, 2018; *Dareltech, LLC v. Xiaomi Inc. et al.*, No. 1-18-cv-08729 (S.D.N.Y.), filed September 24, 2018; and *Dareltech, LLC v. B&H Foto & Elec. Corp.*, No. 1-18-cv-16398 (D.N.J.), filed November 21, 2018.

Petitioner also identifies IPR2019-00717 concerning the ’128 patent. Petitioner identifies the following IPR petitions filed against other members of the ’128 patent family: IPR2019-00722 (U.S. Patent No. 9,055,144, “the ’144 patent”); IPR2019-00718 and IPR2019-00719 (U.S. Patent No.

IPR2019-00716
Patent 9,037,128 B2

9,503,627, “the ’627 patent”); and, IPR2019-00721 (U.S. Patent No. 9,571,716, “the ’716 patent”). Each of the other members of the patent family challenged in the listed IPRs is asserted against Petitioner in the above identified case, *Dareltech LLC v. DJI Tech. Inc.* in the U.S. District Court for the Southern District of New York.

REAL PARTIES IN INTEREST

The Petition identifies Petitioner (DJI Europe B.V., DJI Technology, Inc.), iFlight Technology Company Limited, DJI Japan K.K., and DJI Research LLC as real parties-in-interest. Pet. 56. Patent Owner identifies itself as the sole party-in-interest. Paper 4.

Citing 35 U.S.C. § 312(a), Patent Owner contends that we should dismiss the Petition because Petitioner failed to identify the following persons or entities as real parties-in-interest: (i) the People’ Republic of China and the Chinese Communist Party (“the Chinese Government”); (ii) Liu Ziwei; and (iii) Cui Mingyuan. Prelim. Resp. 11–12. According to Patent Owner, the Chinese Government, through Petitioner, “is attempting to send a message to this country and American small businesses: it will not respect U.S. intellectual property and instead will fight American small businesses on their own turf.” *Id.* at 12. We note, however, that the Petition was filed by an entity sued by Patent Owner in the United States, i.e., the filing date accorded the Petition is February 22, 2019 (*see* Paper 3), which is after September 27, 2018, the date the court states Patent Owner filed suit against Petitioner for infringement of the challenged patent in the U.S. District Court for the Southern District of New York. Ex. 3001. Petitioner was served on October 12, 2018. *Id.* On February 28, 2019, the case in the district court was stayed pending the outcome of this proceeding. Ex. 3002.

Patent Owner cites a number of unauthenticated references and speculative reports to argue (i) that the Chinese Communist party is embedded in Chinese companies such as Petitioner and Huawei, and as a result of its relationship with the Chinese Government, Petitioner benefits from favorable tax treatment and government subsidies, and (ii) that Petitioner's drone business represents a threat to the security of the United States. Prelim. Resp. 12–15. Petitioner's drone technology that Patent Owner contends is subsidized by the Chinese Government (*id.* at 13) is not the subject matter of the patent claims challenged in this proceeding. Patent Owner has not identified any official government action that prevents Petitioner from doing business in the United States. We are not persuaded that the evidence concerning the collateral matters identified by Patent Owner demonstrates an interest in the outcome of this proceeding or has any other bearing on this proceeding.

Patent Owner also contends that the Chinese Government is a real party-in-interest because it has granted Petitioner subsidies and tax cuts. *Id.* at 15. A government's grant of tax preferences to incentivize corporate actions is a common occurrence. Patent Owner provides no evidence or legal authority to support the proposition that the Chinese Government is a real party-in-interest relationship for purposes of 35 U.S.C. § 312(a).

We are not persuaded that the factors cited by Patent Owner, alone or collectively, connect the Chinese Government, as defined by Patent Owner to include the Peoples Republic of China or the Chinese Communist party, to a specific interest in the outcome of this proceeding for purposes of 35 U.S.C. § 312(a).

Patent Owner also asserts that Liu Ziwei and Cui Mingyuan are real parties-in-interest because they filed separate requests under Article 45 of the Chinese Patent Law for Invalidation of Patent Rights in China against Patent Owner's Chinese patent to which the '128 patent claims priority. Prelim. Resp. 15. Patent Owner acknowledges that the case filed by Liu Ziwei was voluntarily withdrawn and closed on February 26, 2019. *Id.* at 16. Patent Owner provides no other basis on which to find Liu Ziwei to be a real party-in-interest.

Patent Owner also acknowledges that Cui Mingyuan, who purportedly filed a Request for Invalidation of Patent Owner's Chinese patent on March 6, 2019, is a member of Petitioner's Intellectual Department. *Id.* (citing Ex. 2010 at 1). As a member of Petitioner's Intellectual Department, Patent Owner acknowledges that Cui Mingyuan is acting as an employee or an agent for Petitioner and has no apparent interest in the outcome of this proceeding separate from that of Petitioner.

In view of the circumstances, we are not persuaded that the Chinese Government, Liu Ziwei, or Cui Mingyuan is a real party-in-interest for purposes of 35 U.S.C. § 312(a).

THE '128 PATENT (EXHIBIT 1001)

The '128 patent describes a handle for a handheld terminal, e.g., a mobile phone, that can be used for taking photographs or creating videos or to control the phone remotely. Ex. 1001, 1:22–24; 3:65–4:1; 3:7–8; 4:10–11. The handle provides a wired or wireless connection to the handheld terminal through a first wired or wireless interface module. *Id.* at 2:41–43. The first interface module may be, e.g., a USB interface or an iPhone interface and the wireless interface module may be, e.g., WIFI or

Bluetooth. *Id.* at 2:57–61; 3:51–54. A power supply module provides power for the handle device and may include various types of batteries that can be charged and discharged. *Id.* 2:44–46, 63–65; 3:55–57. The handle may also include a key module for users to input commands. *Id.* at 2:43–44, 62–63; 4:43–44. Figure 2 of the '128 patent is reproduced below.

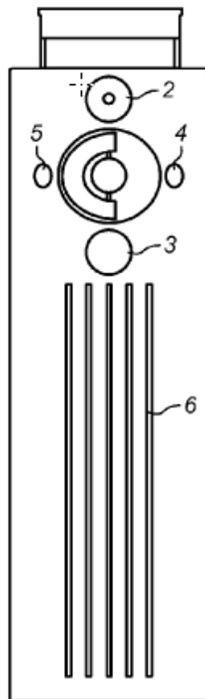


Figure 2 is a front view of the handle. The handle in Figure 2 includes camera key 2, a camera/video shift key, first zoom key 4, second zoom button 5 (the first and second zooms may correspond to object with different focal lengths) and slots 6. *Id.* at 3:40–50.

Figure 3 of the '128 patent is reproduced below.

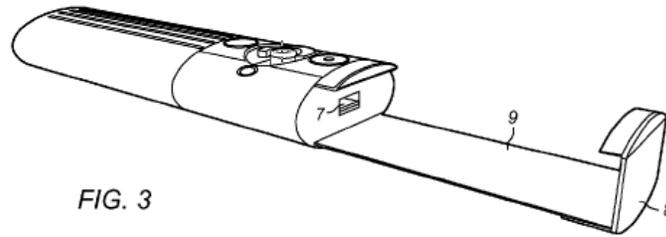


Figure 3 illustrates the handle's sliding plate. *Id.* at 2:7–8. The handle base module includes transformable chuck 8, sliding plate 9, a magnet and spring (not shown), button 1 (not shown) used to open and close sliding plate 9 to fix the position of the handheld terminal and transformable chuck 8. *Id.* at 3:31–37; 4:1–9.

ILLUSTRATIVE CLAIM

Apparatus claims 1 and 11 and method claim 23 are independent. Claim 1, reproduced below, is illustrative of the subject matter claimed in the '128 patent.

1. A handheld device for holding and operating a mobile phone, the handheld device comprising:
 - a handle;
 - a coupler that couples the handle of the handheld device to a housing of the mobile phone wherein the coupler is configured to releasably affix the handheld device to the housing of the mobile phone;
 - a power supply module with one or more batteries for providing power for a wireless connection to the mobile phone;
 - a wireless interface module configured to provide the wireless connection to the mobile phone, wherein the handheld device is configured to provide remote control of camera features of the mobile phone via the wireless interface module;
 - a user-operated command key comprising at least one selected from a camera key, video key, or zoom key, the

user-operated command key configured for selection by a user; and
a key module configured to receive an indication of selection of the user-operated command key and send an indication of the selection to the mobile phone via the wireless interface module such that the mobile phone can be held via the handheld device with one hand and such that the one hand can operate user-operated command key while the one hand is also holding the handheld device.

AIA STATUS OF '128 PATENT

The first to file provisions of the American Inventors Act (“AIA”) took effect on March 16, 2013. The application that matured into the '128 patent (U.S. Patent Appl. No. 14/475,137) was filed on September 2, 2014 as a continuation of U.S. Patent Appl. No. 13/961,670, filed on August 7, 2013. The '128 patent claims priority to Chinese Patent Application 2012 2 0638696 filed on November 28, 2012 (“the Priority Application”).

The applicant for the '128 patent sought and was granted Track One Prioritized Examination under 37 C.F.R. § 1.102(e)(1). Ex. 1002, 33, 55. An Official Action dated November 6, 2014 (“Office Action”) states that the application for the '128 patent (“the Application”) was examined under pre-AIA first to invent provisions, but that if this determination was incorrect, a correction as to the statutory basis would not be a new ground of rejection if the prior art relied upon and the rationale supporting the rejections would be the same under either status. Ex. 1002, 54. The Office Action does not explain how the Examiner determined that the pre-AIA first to invent provisions should apply.

As originally filed, the Application included a Preliminary Amendment with claims drawn to a handheld device comprising a handle foot stand (at least application claims 22 and 32) and a spring loaded chuck

(at least application claims 26 and 39). *Id.* at 3–6. In the '128 patent, claims 4 and 15 recite the handle foot stand and claims 8 and 21 recite the spring loaded chuck.

Petitioner contends that because the Priority Application does not provide written description support for the subject matter of claims 4, 8, 15, and 21 of the '128 patent, the '128 patent is an AIA patent and the AIA's first to file provisions apply. Based on a review of the Priority Application, we agree with Petitioner that the Priority Application does not support claims 4, 8, 15, and 21.

Patent Owner does not dispute that the subject matter of claims 4, 8, 15, and 21 are not supported by the Priority Application, but instead argues that because Patent Owner has statutorily disclaimed these claims, there is no justiciable dispute that the '128 patent is a pre-AIA patent for purposes of this proceeding and the pre-AIA first to invent provisions apply. Prelim. Resp. 4–5 (citing *Apple Inc. v. Kilbourne*, Case IPR2019-00233, Paper No. 13, at 33–34).

The first inventor to file provisions of the AIA “apply to any application for patent, and to any patent issuing thereon, that contains or contained at any time (A) a claim to a claimed invention that has an effective filing date on or after March 16, 2013.” 35 U.S.C. § 100 (A). The effective filing date is the actual filing date or the “filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right or priority” under applicable sections. 35 U.S.C. § 100 (A)(i), (ii).

In this case, the Application and the '128 patent both included claims that were not supported by the Priority Application and whose effective

filing date is the actual filing date of the parent application in which they first appeared, i.e., U.S. Patent Appl. No. 13/961,670 filed on August 7, 2013. Thus, the '128 patent satisfies the first inventor to file provision that the application “contains or contains at any time (A) a claim to a claimed invention that has an effective filing date on or after March 16, 2013.”

The AIA status of the '128 patent may be relevant in this proceeding because one of the references that forms a basis of Petitioner's challenge (Ex. 1012, “Fenton”) was published on February 9, 2012, i.e. before the August 7, 2013 filing date of the earliest application containing the subject matter of disclaimed claims 4, 8, 15, and 21, but less than one year before the November 28, 2012 filing date of the Priority Application. As the '128 patent is an AIA patent, Fenton cannot be antedated under pre-AIA 35 U.S.C. § 102(b), notwithstanding the disclaimer of the claims 4, 8, 15, and 21.

ART CITED IN PETITIONER'S CHALLENGES

Petitioner cites the following references in its challenges to patentability:

Reference	Designation	Exhibit No.
U.S. Patent No. 7,684,694 issued March 23, 2010	Fromm	Ex. 1010
WIPO Publication No. 2012/018405 published February 9, 2012	Fenton	Ex. 1012
U.S. Patent Appl. Publication No. 2011/0058052, published March 10, 2011	Bolton	Ex. 1020

CHALLENGES ASSERTED IN PETITION

Claims	Statutory Basis	Challenge
1–29	35 U.S.C. § 103(a) ¹	Obvious over Fromm, Fenton, and Bolton

ORDINARY SKILL IN THE ART

Petitioner describes a person of ordinary skill in the art as having: (i) a bachelor’s degree from an accredited institution in mechanical engineering or electrical engineering, or the equivalent, and (ii) “one to three years of experience working on issues related to smart phone accessory product development, including: mechanical engineering of the mechanisms of a holder; electrical engineering of power circuits, buttons, and RF technology; and firmware design associated with the communications with the smart phone.” Pet. 11–12 (citing Ex. 1003, Declaration of Eric Welch (“Welch Decl.”) ¶ 62).² Patent Owner does not discuss the level of ordinary skill. As Petitioner’s description of a person of ordinary skill appears to be consistent with the subject matter of the ’128 patent, in the absence of any dispute, we apply Petitioner’s definition of a person of ordinary skill for purposes of this Decision.

¹Although the Petition asserts the ’128 patent is subject to the first to file provisions of the AIA (Pet. 1–4), the Petition challenges the claims under pre-AIA 35 U.S.C. § 103(a). Pet. 5. A corresponding challenge under the AIA first to file provisions would be made under 35 U.S.C. § 103.

² Except for page 1, the pages of the Welch Declaration include a header that reads “Privileged and Confidential Attorney Work Product.” As the Welch Declaration was filed without restricted access and there has been no Motion for Protective Order, we assume that this header is a typographical error and we treat the entire Welch Declaration as neither privileged, nor attorney work product, nor confidential.

CLAIM CONSTRUCTION

The Petition has been accorded a filing date of February 22, 2019. For petitions filed on or after November 13, 2018, we interpret claims of an unexpired patent using the same standard applied by U.S. district courts, as announced in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). *See*, 83 Fed. Reg. 51340, 51345 (Oct. 11, 2018) (announcing amendment of 37 C.F.R. §§ 42.100(b), 42.200(b), and 42.300(b)).

Any special definition for a claim term must be set forth in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

Neither party has proposed any specific constructions. Upon review of the '128 patent, for purposes of this Decisions we apply the plain and ordinary meaning to each of the claims.

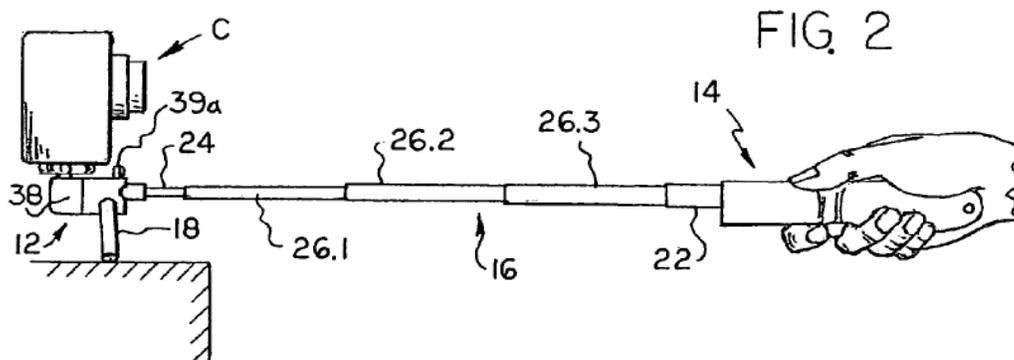
ANALYSIS OF PETITIONER'S PRIOR ART CHALLENGES

Introduction

A patent claim is unpatentable under 35 U.S.C. § 103 if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

Fromm (Ex. 1010)

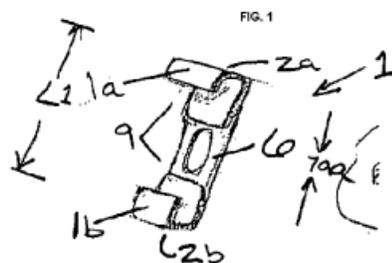
Figure 2 of Fromm is reproduced below.



Fromm Figure 2, above, shows an extensible telescoping support 16 that extends between a base assembly 12, where a camera is secured, and a handgrip 14. Ex. 1010, 1:15–25. A battery powered remote control device, e.g., one integrated into the handle, allows the user to activate a zoom, shutter release, and playback from the remote control using communication codes, e.g., infrared codes. *Id.* at 7:54–8:11.

Fenton (Ex. 1012)³

Figure 1 of Fenton is shown below.



³ Exhibit 1012 has only two pages. The first page is a cover page that includes filing and publication information, a title, an illustrative figure, and an Abstract. The second page of Exhibit 1012 is a page of an International Search Report.

Fenton discloses an apparatus suitable for holding a mobile device and attaching to other apparatus. Ex. 1012, 1. Fenton's apparatus includes fingers that hold the mobile device and a spring that pulls the fingers together. *Id.* Fenton also discloses a "reel" that includes an extendable and retractable length of line and a hook for attaching to other apparatus. *Id.*

Bolton (Ex. 1020)

Bolton discloses an accessory that can remotely control a portable media device (PMD) capable of storing and playing still images and/or recording video and audio. Ex. 1020, Abstract, ¶ 24. Communication between the accessory and the PMD according to a PMD specific protocol is achieved over a physical connection (e.g., USB, FireWire, or universal asynchronous receiver/transmitter (UART)) or a wireless channel (e.g., Bluetooth and Wi-Fi). *Id.* ¶¶ 22, 38–39. The accessory can include a power button, a photo button, a record button, a preview button, playback controls, and a mode button to change operation modes, e.g., to toggle between still photo mode and video mode, and a touch screen or display. *Id.* ¶¶ 22–23.

Motive to Combine

Petitioner contends that a person of ordinary skill would have been motivated to combine Fenton's mobile device holder with the base assembly of Fromm's handle, noting that Fromm states "if [a] camera is a picture phone, a special adaptor may be required." Pet. 19–20 (citing Ex. 1010, 6:31–35, Ex. 1003, Welch Decl. ¶ 76). Petitioner further notes that both Fromm and Fenton are directed to camera holding techniques and are highly relevant to the '128 patent's mechanism for holding a camera phone. *Id.* at 20–21. Noting that Fromm's remote control functionality is limited to certain digital/film cameras, Petitioner argues a person of ordinary skill

would have been motivated to replace Fromm’s remote control functionality with Bolton’s remote control functionality to accommodate smartphones. *Id.* at 21–22.

The Patent Owner Preliminary Response does not include a substantive response to Petitioner’s contentions concerning a motive to combine the teachings of Fromm, Fenton, and Bolton. In consideration of the above, we are persuaded that for purposes of institution Petitioner has demonstrated the similarity of the subject matter and the problems addressed by these references would have motivated a person of ordinary to combine their teachings.

Independent Claims 1 and 11

Noting that claims 1 and 11 have substantially overlapping limitations, Petitioner treats claims 1 and 11 together. Pet. 23. The preamble of illustrative claim 1 (designated by Petitioner as 1P) and claim 11 (designated by Petitioner as 11P) recites “[A] handheld device for holding and operating a mobile phone.” Pet. 59–60. Petitioner cites Fromm as disclosing a handheld device for holding a camera, including a picture phone and a video phone. *Id.* (citing Ex. 1010, 5:30–35). Petitioner further notes that Fromm discloses a remote control integrated into a handle (*id.* at 24 (citing Ex. 1010, 7:63–65)), and that Bolton states it “relates generally to media players and in particular to controlling a camera in a portable media device” (*id.*, quoting Ex. 1020, Abstract ¶ 1).

Noting that claim 1 recites a handle as a separate limitation (identified by Petitioner as claim element 1A) and claim 11 recites the handle with the coupler limitation (identified by Petitioner as claim element 11 A), Petitioner cites Fromm’s handgrip as the recited handle in both claims. Pet. 25 (citing

Ex. 1010, 2:57–62; 5:53–55; Fig. 2). As to the coupler recited in claim 11 and claim element 1B, Petitioner cites Fromm as disclosing a base assembly that incorporates a coupling mechanism (e.g., a ball seated in the base assembly and a threaded stud carried by the ball) to couple a camera to the handle. *Id.* at 25–26 (citing Ex. 1010, 3:49–52; 6:21–31, Fig. 5). Petitioner further cites Figure 7C of Fenton⁴ as disclosing holder having a main body with overlapping portions, a spring and upper and lower fingers configured such that the spring may be compressed sufficient to hold a mobile device with the holder between the upper and lower fingers. *Id.* at 26–27 (citing Ex. 1012, 41:14–19). Although this subject matter is not included in Ex. 1012 as filed, it is consistent with the disclosure in the Abstract. Ex. 1012, 1. Thus, according to Petitioner, Fenton also discloses the claimed coupler that couples a handle, as claim 11 is best understood.⁵ Pet. 26–27.

As to the claimed “power supply module with one or more batteries for providing power for a wireless connection to the mobile phone,” (claim element 1C, claim element 11D), Petitioner notes that Fromm discloses its remote control is powered by batteries. *Id.* at 28 (citing Ex. 1010, 8:5–11). Petitioner also cites Bolton as disclosing that the remote control functionality establishes a wireless communications channel. *Id.* (citing Ex. 1010 ¶¶ 22, 38).

⁴ The Petition includes a drawing Petitioner asserts is Figure 7C of Fenton and quotes Fenton 41:14–19. Pet. 27–28. Exhibit 1012 does not include Figure 7C or the subject matter quoted from Fenton.

⁵ The Petition notes that the actual language of claim 11 “a that couples a handle” appears to have omitted the word “coupler” and should read “a coupler that couples a handle.” Pet. 28 n.6.

As to the claimed “wireless interface module” (claim element 1D.1, 1D.2, and claim elements 11B.1, 11B.2), Petitioner cites Bolton as disclosing establishing a wireless communication channel, such as Bluetooth, and user interface buttons that allow a user to control camera functions remotely. Pet. 29. Petitioner further states that Bolton’s remote control accessory integrated in Fromm’s handheld device provides the capabilities related to controlling a camera remotely. *Id.* at 30–31.

As to the claimed “user-operated command key” (claim elements 1E.1, 1E.2, and 11C.1, 11C.2), Petitioner cites Bolton’s remote control accessory as having button keys to change camera mode and instruct a camera to capture a still image or a video. Pet. 31. Petitioner argues that because the selection of a remote button by the user results in a command being sent from the remote control to the mobile device, e.g., as integrated into Fromm’s handle, each of the buttons is a user-operated command key. *Id.* at 32.

As to the claimed “key module” (claim element 1F.1, 1F.2) Petitioner cites Bolton as disclosing an accessory that allows a user to send commands remotely to a camera, and when integrated into the handheld device of Fromm, provides one hand operation. Pet. 34–35 (citing Ex. 1020 ¶¶ 33, 38, 39, 57, 62; Ex. 1010, 3:63–65, 8:5–8). As to the gripping position limitation recited in claim 11 (designated by Petitioner as claim element 11E), Petitioner cites Fromm’s disclosure that the handgrip may be coated with rubber or other material to improve the user’s grip. *Id.* at 36 (citing Ex. 1010, 5:57–59).

For purposes of institution, we are persuaded that Petitioner has demonstrated that the combination of Fromm, Fenton, and Bolton teaches or

would have suggested to one of ordinary skill the limitations recited in claims 1 and 11.

Independent Claim 23

Claim 23 is a method that recites limitations consistent with apparatus claims 1 and 11. At pages 59 and 60 the Petition designates the elements of claim 23 for purposes of analysis. The preamble of claim 23 recites “[A] method of providing remote control of a mobile phone.” As evidence that this feature is disclosed, Petitioner cites its discussion of the preamble of claims 1 and 11 and its discussion of claim element 1D.2, citing Bolton as disclosing establishing a wireless communication channel, such as Bluetooth, and user interface buttons that allow a user to control camera functions remotely. Pet. 36.

Petitioner identifies as claim element 23A the limitation that recites “receiving an indication of an input command from an operation command key of a handheld device.” *Id.* at 37. As to this claim element, Petitioner cites its discussion of claim element 1F.1, explaining that Bolton discloses an accessory that allows a user to send commands remotely to a camera, and when integrated into the handheld device of Fromm, provides one hand operation. *Id.* at 37.

Petitioner identifies as claim element 23B the limitation that recites “a coupler configured to couple the handheld device to the mobile phone.” Petitioner cites its discussion of Fenton’s coupler as disclosing this feature of claim 23. *Id.* (citing Pet. 25–28).

Petitioner identifies as claim element 23C the limitation that recites “the operation command key configured on the device such that the mobile phone can be held via the handheld device with one hand and such that the

one hand can operate user-operated command key while the one hand is also holding the handheld device.” Pet. 37. Petitioner cites its discussion of claim elements 1E.1 and 1F.1, i.e., that Bolton’s remote control accessory has button keys to change camera mode and instruct a camera to capture a still image or a video and, when combined with Fenton and Fromm, discloses this feature of method claim 23. *Id.* (citing Pet. 31–32).

Petitioner identifies as claim element 23D the limitation that recites “providing a wireless interface module configured to provide a wireless connection the mobile phone.” *Id.* As teaching this element, Petitioner cites its discussion of claim element 1D.1 that Bolton discloses establishing a wireless communication channel, such as Bluetooth, and user interface buttons that allow a user to control camera functions remotely. *Id.* (citing Pet. 29).

Petitioner identifies as claim element 23E the limitation that recites “sending the indication of the input command, in response to receipt of the indication, to the mobile phone via the wireless interface module.” Pet. 37. As teaching this element Petitioner cites its discussion of claim element 1F.1. *Id.* For purposes of institution, we are persuaded that Petitioner has demonstrated that the combination of Fromm, Fenton, and Bolton teaches or would have suggested to one of ordinary skill the limitations recited in claim 23.

Claims 4, 8, 15, and 21

Pages 46–47 of the Petition concern a challenge to claims 4 and 15. Pages 50–52 of the Petition address a challenge to claims 8 and 21. Claims 4, 8, 15 and 21 have been disclaimed and are not addressed further in the Decision.

The “handle pillar” of claims 2, 3, 12, 14, 18, 19, and 22

As discussed above neither party has proposed any specific claim constructions and we apply the plain and ordinary meaning to the claim terms. Petitioner notes that each of claims 2, 3, 12, 14, 18, 19, and 22 recites a “handle pillar.” Pet. 37. Petitioner states that the Specification provides few details about the claimed handle pillar and argues that taken in the context of claim 2 and 3, the “handle pillar” includes both the smartphone holder and handle. *Id.* at 37–38. Petitioner cites at least Figures 2 and 15 of Fromm as disclosing a hand held device with base assembly 12, handgrip 14, elongated extensible support (*id.* at 37–38, citing Ex. 1010, 5:48–52), Fenton as disclosing a special adaptor that may be required when a picture is taken (*id.*, citing Ex. 1010 (Fromm) 6:33–34) and Bolton as disclosing remote camera control integrated into the handle (*id.* at 38–39, citing Ex. 1010, 7:63–64, Ex. 1020 ¶ 22). According to Petitioner’s expert, Dr. Welch, the combination of Fromm, Fenton, and Bolton discloses the recited handle pillar. Ex. 1003, Welch Decl. ¶¶ 109–113.

The Specification of the ’128 patent states that the “handle base module includes a transformable chuck, handle pillar and handle tripod.” Ex. 1001, 2:47–48. The Specification also states the “handle pillar includes a slot sliding plate, buttons, magnets, and springs” and that the “button and magnets are used to control the slot sliding plate.” *Id.* at 2:48–50, 3:23–27 (referring to a “handle pillar module”). The Specification provides no further details of the handle pillar. The Specification explains that Figures 2 and 3 show a “handle base module” that “comprises transformable chuck 8, slot sliding plate 9, magnet and spring, the button 1” in which “the magnet, spring, button are used to control the openness and closing of the slot sliding

plate and real-time position of the slots sliding plate 9.” Ex. 1001, 3:31–37. Figures 2 and 3 (reproduced earlier in this Decisions) do not identify a spring or magnet and do not include a reference designation to button 1. In the absence of any further description of these features, we do not construe the recited handle pillar to have any particular telescoping form factor, e.g., using a slot sliding plate with magnets, springs, and buttons, except as recited explicitly in the claims. We now turn to Petitioner’s specific contentions concerning the remaining claims.

Claims 2, 12, 19, and 28

Petitioner notes that claims 2 and 12 recite a non-fixed mode in which the handle pillar and mobile phone are not coupled and handle pillar comprises a wireless interface module configured to provide remote control of the phone. Pet. 39. Petitioner further notes that claims 19 and 28 recite that the handle pillar is configured to act as a remote control of the mobile phone. Given the similarity of the subject matter, Petitioner addresses claims 2, 12, 19, and 28 together, noting (i) that “Bolton’s remote control functionality integrated in the handle of Fromm, can wirelessly control the mobile phone using, for example a Bluetooth connection,” (ii) that Bolton uses buttons on a user interface, and (iii) that the purpose of Bluetooth, as disclosed by Bolton is to provide a wireless interface when the mobile phone is not in a fixed position (a non-fixed mode). Pet. 39–42. In view of the above, for purposes of institution, we are persuaded that Petitioner has demonstrated that the combination of Fromm, Fenton, and Bolton teaches or would have suggested to one of ordinary skill the limitations recited in claims 2, 12, 19, and 28.

Claims 3 and 14

Petitioner notes that claim 3 recites that handle pillar is configured to provide an alternative to the mobile phone being held directly by the user and that claim 14 recites the handheld device can be operated with a user command key using the same hand that holds the handle pillar, i.e. one-handed operation. Pet. 42–43. Petitioner cites Fromm as disclosing a device that allows a user to take photographs by holding the handle with one hand and contends that the combination of Fromm, Fenton, and Bolton discloses the elements of claims 3 and 14. *Id.* at 43 (citing Ex. 1010, 1:55–58, 2:57–62). For purposes of institution, we are persuaded that Petitioner has demonstrated that the combination of Fromm, Fenton, and Bolton teaches or would have suggested to one of ordinary skill the limitations recited in claims 3 and 14.

Claims 9, 22, and 29

Petitioner provides a chart indicating sections of the Petition that address each of the elements of claims 22 and 29. Pet. 44–45. Claims 22 and 29 recite a handle pillar with functional features similar to those discussed above (e.g., an alternative to hold the mobile phone directly) that transforms the mobile phone from two-handed operation to indirect one-hand operation of camera and video functions. Based on this preliminary record, we are persuaded that Petitioner has demonstrated that the combination of Fromm, Fenton, and Bolton teaches or would have suggested to one of ordinary skill the limitations recited in claims 22 and 29. Similarly, we are persuaded by Petitioner’s arguments concerning claim 9, i.e., that Fromm teaches how disadvantages of a user directly holding a

mobile phone are addressed with a handgrip that provides one hand operation. *Id.* at 52–53.

Claims 6 and 18

Claim 6 recites that “the coupler is configured to adjustably couple to mobile phones of various sizes.” Claim 18 depends from claim 17, which depends from claim 11. Claim 18 recites that the handheld device comprises a handle pillar and the coupler is configured to adjust to mobile phones of various sizes. Petitioner explains that Fenton’s universal mobile phone holder may be adjusted to fit mobile devices of different dimensions using a spring, and when integrated into the handheld device of Fromm teaches the features of claims 6 and 18. Pet. 45, 48. For purposes of institution, we are persuaded that Petitioner has demonstrated that the combination of Fromm, Fenton, and Bolton teaches or would have suggested to one of ordinary skill the features recited in claims 6 and 18.

Claims 7, 10, and 20

Claims 7 and 20 recite the added limitation of a chuck configured to hold the mobile phone. As to this limitation, the Petition cites Fenton’s universal holder with upper and lower foldable fingers that are components of a main body and grip a mobile device with a spring that applies force sufficient to hold the mobile device securely. Pet. 48–49.

Claim 10 recites that the added functional limitation that the handheld device when coupled to the mobile phone provides stable and secure hold and control of the mobile phone. Petitioner explains that Fromm’s base assembly provides a coupling mechanism to secure a camera and when used with Fenton’s universal holder to attach a mobile phone, the phone is securely held. *Id.* at 53.

For purposes of institution, we are persuaded that Petitioner has demonstrated that the combination of Fromm, Fenton, and Bolton teaches or would have suggested to one of ordinary skill the features recited in claims 7, 10, and 20.

Claims 5, 16, 24, and 27

Claims 5, 16, 24, and 27 recite the wireless interface module comprises Bluetooth technology. As Petitioner points out, this feature is disclosed by Bolton. Pet. 47 (citing Ex. 1010 ¶¶ 22, 38), 54–55. For purposes of institution, we are persuaded that Petitioner has demonstrated that the combination of Fromm, Fenton, and Bolton teaches or would have suggested to one of ordinary skill the limitations recited in claims 5, 16, 24, and 27.

Claim 13

Claim 13 recites the added feature of a key module that is configured to receive an indication of selection of the user operated command key and to send a corresponding instruction to the mobile phone via the wireless interface. Petitioner cites Fromm, Fenton, and Bolton as disclosing this feature for the same reasons as they disclose similar claim element 1.F previously discussed. Pet. 53–54. For purposes of institution, we are persuaded that Petitioner has demonstrated that the combination of Fromm, Fenton, and Bolton teaches or would have suggested to one of ordinary skill the limitations recited in claim 13.

Claim 17

Claim 17 recites the added limitation that a button controls the coupler that couples the handle to the mobile phone housing. Petitioner cites Fenton as disclosing a locking means such as a button. *Id.* For purposes of

institution, we are persuaded that Petitioner has demonstrated that the combination of Fromm, Fenton, and Bolton teaches or would have suggested to one of ordinary skill the limitations recited in claim 17.

Claim 25

Claim 25 recites the added limitation that the input command can be a zoom, camera, or video command and the handle pillar comprises different buttons for indicating the selection of the respective input command. Petitioner cites Bolton as disclosing user operated command keys including photo button 153, record button 154, and mode button 155 to change camera mode. *Id.* at 55 (citing Ex. 1010 ¶ 22). For purposes of institution, we are persuaded that Petitioner has demonstrated that the combination of Fromm, Fenton, and Bolton teaches or would have suggested to one of ordinary skill the limitations recited in claim 25.

Claim 26

Claim 26 recites the added limitation that the handheld device provides feedback that the mobile phone received the input command. Petitioner cites Bolton as disclosing once an image is captured by a PMD, notification to effect is received by the accessory from the PMD. Pet. 56 (citing Ex. 1010 ¶ 22). For purposes of institution, we are persuaded that Petition has demonstrated that the combination of Fromm, Fenton, and Bolton teaches or would have suggested to one of ordinary skill the limitations recited in claim 26.

ARGUMENTS UNDER 35 U.S.C. § 314(a)

Patent Owner contends that we should exercise our discretion under 35 U.S.C. § 314(a) and decline institution of *inter partes* review because the Petition is not “particularized” and at the same time is “decidedly

voluminous.” Prelim. Resp. 8. Patent Owner argues that it has not been put on “sufficient notice of what prior art is directed toward what limitation, how the references are purportedly combined for specific limitations, and other important issues necessary for an expedient and fair proceeding.” *Id.* at 9. We disagree. Aside from its generalized allegations, Patent Owner’s Preliminary Response does not allege specific failings in the Petition. As discussed above, Petitioner has explained how the references disclose specific limitations of each claim and how a person of ordinary skill would have combined the teachings of the references.

Patent Owner also argues that we should deny related Petition IPR2019-00717, which challenges the ’128 patent on different grounds. Patent Owner does not address any of the factors to be considered in determining whether to exercise discretion to deny a petition that challenges the same patent as a previous petition. *See, General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, Case IPR2016-01357, slip op. at 15–16 (PTAB Sept. 6, 2017) (Paper 19) (precedential). Except for the existence of two petitions concerning the ’128 patent,⁶ none of the other *General Plastic* factors weighs in favor of denying institution. For example, the petitions in both IPR2019-00716 and IPR2019-00717 were filed on the same day and were not filed in response to a patent owner preliminary response to a previous petition. Petitioner also acted in a timely fashion. Petitioner was served with Patent Owner’s infringement complaint on October 12, 2018 and filed the Petitions about four months later on February 22, 2019—well

⁶ Four other petitions Petitioner filed on February 22, 2019 address patents other than the ’128 patent that are also the subject of the same district court litigation.

before the one year statutory deadline. Ex. 3001. In addition, the Petitions were filed by a deadline imposed by the District Court to qualify for a stay of the litigation that has been granted pending the outcome of the IPR proceedings. Ex. 3002. In view of these circumstances, we are not persuaded that we should exercise discretion under Section 314(a) to decline institution of either IPR2019-00716 or IPR2019-00717.

SUMMARY

For the reasons discussed above, we are persuaded that Petitioner has demonstrated a reasonable likelihood that it will succeed on its challenge to patentability of claims 1–29 as obvious over Fromm, Fenton, and Bolton.

ORDER

In consideration of the foregoing, it is hereby

ORDERED that pursuant to 35 U.S.C. § 314(a) an *inter partes* review of the '128 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.

FURTHER ORDERED that the trial is authorized on all grounds set forth in the Petition, in particular claims 1–29 as obvious over Fromm, Fenton and Bolton;

FURTHER ORDERED that the trial will be conducted in accordance with the accompanying Scheduling Order. In the event that an initial conference call has been requested or scheduled, the parties are directed to the Office Trial Practice Guide, 77 Fed. Reg. 48756, 48765–66 (Aug. 14, 2012), for guidance in preparing for the initial conference call, and should come prepared to discuss any proposed changes to the scheduling order

IPR2019-00716
Patent 9,037,128 B2

entered herewith and any motions the parties anticipate filing during the trial.

IPR2019-00716
Patent 9,037,128 B2

PETITIONER:

Lori Gordon
Steven Peters
KING & SPALDING LLP
lgordon@kslaw.com
speters@kslaw.com

PATENT OWNER

David Hecht
PIERCE BAINBRIDGE BECK PRICE & HECHT LLP
dhecht@piercebainridge.com