

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY COMPUTER ENTERTAINMENT AMERICA LLC
Petitioner

v.

APLIX IP HOLDINGS CORPORATION
Patent Owner

Case No. IPR2015-00396
Patent 7,218,313

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

PURSUANT TO 37 C.F.R. § 42.120

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I. INTRODUCTION

Most of the substantive positions advanced by PO in this proceeding are a criticism of how the teachings of a secondary reference would allegedly be incorporated into the physical structure of a primary reference. PO resorts to vague notions of design principles, reasoning that (in the view of PO and its experts) the combinations would be physically subpar. Last week, the Federal Circuit rejected exactly this type of reasoning, and reiterated the longstanding principle that “[t]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference....” *MCM Portfolio LLC v. Hewlett-Packard Co.*, --- F.3d ----, No. 2015-1091, 2015 WL 7755665, at *9-10 (Fed. Cir. Dec. 2, 2015) (quoting *In re Keller*, 642 F.2d 413, 425 (CCPA 1981)) (citing *In re Mouttet*, 686 F.3d 1322, 1333 (Fed. Cir. 2012)). “Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.” *Id.* Even where physical incorporation of one technology into another would have conflicted, there was no error in the determination that the claimed subject matter would have been obvious. *Id.* For exactly the same reason, PO’s arguments are fatally flawed, because PO focuses on combining one physical structure into another, and overlooks what the combinations here would have suggested to a PHOSITA.

Another prominent and flawed theory in PO’s argument involves interpreting prior art teachings. Without identifying any support for its approach, PO relies on a

form of hyper-rigid textualism. According to PO, a PHOSITA must consider only the narrowest possible interpretation of language, blinding herself to other interpretations or implications of prior art teachings. The Supreme Court and Federal Circuit have instructed otherwise. *See, e.g., KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007) (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”); *MCM Portfolio*, 2015 WL 7755665, at *9-10 (no requirement “that the claimed invention must be expressly suggested in any one or all of the references.”).

PO’s remaining positions involve reading limitations from the specification into the claims, or excluding scope from the field of endeavor that the inventors of the ‘313 Patent explicitly included in the specification. These theories are rooted in oversimplifications of the record and misapplications of the law. The Board should consider the entire record, rather than the limited and oversimplified view that PO promotes. When the correct legal principles for obviousness and claim interpretation are applied, the Board should find that all Challenged Claims are unpatentable.

II. ARGUMENT

A. Willner and Hedberg are Analogous Art

Without proposing a definition for the field of endeavor of the ‘313 Patent, and without identifying any evidence to support a narrow definition, PO concludes that Willner and Hedberg are not analogous. *See Paper 15, Response* at 3-17. Once the field of endeavor is correctly defined, applying that definition to Willner and Hedberg

shows that both references are within the field of endeavor of the '313 Patent.

Support for defining the field of endeavor come from a patent's "written description and claims, including the structure and function of an invention." *In re Bigio*, 381 F.3d 1320, 1326 (Fed. Cir. 2004). Like in the copending proceedings, review of the written description and claims of the '313 Patent shows that the field of endeavor should be defined to include: "hand-held electronic devices with one or more input elements." *See, e.g., Ex. 1001, '313 Patent* at Claims; Col. 1:5-11 (broadly defining relevant devices); 4:25-37; 6:16-20; 7:50-65; 8:31-52; Figs. 1-3a; *see also, e.g., In re Shaneour*, 600 Fed. App'x 734, 738 (Fed. Cir. 2015).

Like in the copending proceedings, no authority cited by the PO supports a narrower definition for the '313 Patent's field of endeavor. *Clay* limited the field of endeavor to scope that was explicitly required by the claims and the context of the specification, and *Wang Labs.* found no error where the field of endeavor excluded scope that was explicitly distinguished by the patent. *See In re Clay*, 966 F.2d 656, 657-58 (Fed. Cir. 1992); *Wang Labs., Inc. v. Toshiba Corp.*, 993 F.2d 858, 863 (Fed. Cir. 1993). PO's proposition here is something different. PO would exclude from the field of endeavor scope that is explicitly included by the '313 Patent. None of the cases cited by PO supports PO's view. Rather, these cases support the conclusion that the field of endeavor should be construed as broadly as the patentee has described and claimed it to be. *See id.*; *see also In re Singhal*, 602 Fed. App'x 826, 830 (Fed. Cir.

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