

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RUBICON COMMUNICATIONS, LP

Petitioner,

v.

LEGO A/S

Patent Owner.

Case IPR2016-01187

Patent 8,894,066

PETITIONER'S REPLY

I. Introduction

The '066 Patent discloses a casing for an electronic controller. The casing has a patterned surface that allows mating with “building elements,” thereby enabling expression of the user’s creative preferences. Contrary to Patent Owner’s assertions, Response 2, the '066 Patent does not purport to have invented a “controller.” Indeed, the Background of the '066 Patent acknowledges the prevalence of numerous types of controllers, including cellular telephones, television remote controllers, and video game peripherals. '066 Patent 1:43-47; *see also* Declaration of Jay P. Kesan (“Decl.”), Exhibit 1036, ¶25. Properly understood, the focus of the '066 Patent is a customizable casing for a controller, not any improvement to a controller itself. Decl. ¶28. The controller plays no particular functional role in the '066, other than being passively modified by the recited “casing” and the “building elements” mated to it.

In its Response, Patent Owner insists that the cited references “do not disclose each and every element of the challenged claims nor do they render obvious the subject matter of the '066 Patent.” Response 1. As discussed below, Petitioner disagrees, and respectfully requests cancellation of claims 1-8.

II. Claim Construction

Patent Owner proposes constructions for the controller “housing” and the “casing” that receives it, for “conformably fit” and “mating,” and for “manipulate.”

The proposed constructions of “casing” and “housing” reintroduce ambiguity regarding their separability, and so require clarification. Patent Owner’s reliance on “joining” in its proposed constructions of “conformably fit” and “mating” likewise requires clarification to ensure Patent Owner’s preferred embodiment is not excluded. Finally, Patent Owner’s construction of “manipulate” is never employed and is faulty, and should therefore be rejected.

A. Patent Owner’s proposed construction of “casing” merely requires that it be distinguishable from the “housing,” rather than separable or removable.

Patent Owner originally argued that a “casing” must be “separable from” the recited “housing.” Preliminary Response (Paper 20) 20-22. The Board rejected this construction, finding that Patent Owner failed to establish “why a structure inseparably attached to a housing cannot constitute” the recited “casing.” Institution Decision (Paper 38) 11.

Patent Owner now proposes that the broadest reasonable interpretation (BRI) of “casing” is “[a] structure that is separate from and covers one or more surfaces of the housing of the manual controller.” Response (Paper 70) 8. “Separable” is absent. But in justifying its proposed construction, Patent Owner emphasizes the passage of the ’066 Patent stating that “[m]ain housing 14 ... is readily separable from main casing 16.” Response 9 (quoting ’066 Patent 3:7-8) (Patent Owner’s emphasis). Patent Owner also argues that the “casing” must be “separate and

distinct” from the “housing” for the former to “fit around” and “receive” the latter.
Response 10.

The '066 Patent does state that the “casing” of Figure 1 is “separable.” But the claims nowhere use language of separability or removability, and nowhere does the '066 Patent’s intrinsic record show intent to limit the claims. Indeed, the '066 Patent characterizes Figure 1 as merely a “preferred embodiment,” and states that “many changes may be made to the details of the above-described embodiments” and “[t]he scope of the present invention should ... be determined only by the following claims.” '066 Patent, 2:67; 6:45-50.

The Federal Circuit has “repeatedly cautioned against limiting the claimed invention to preferred embodiments or specific examples” absent intrinsic evidence of intent to do so. *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1346-47 (Fed. Cir. 2015) (internal citations/quotations omitted).¹ Absent such evidence, the mere fact that Figure 1 discloses a separable “casing” does not entail that an inseparable “casing” cannot satisfy the claim language—consistent with the Board’s original statement. All that Patent Owner’s construction requires is that the “casing” be distinguishable from the “housing.” Decl. ¶30.

¹ The narrower *Markman* standard applied in *Williamson*. But if it is improper to import a limitation under a narrower standard, it is equally improper to do so under BRI.

Moreover, a “casing” that is distinguishable from a “housing” prior to final assembly remains “separate and distinct” even if inseparably assembled with the “housing.” Decl. ¶¶31-32. Contrary to Patent Owner’s suggestion, inseparable assembly does not prevent a “casing” from “fit[ting] around” and “receiv[ing]” the “housing,” as the claims require. Decl. ¶33.

B. If “joining” is properly part of Patent Owner’s proposed constructions of “conformably fit” and “mating” under the BRI standard, it must encompass joining by abutment without requiring fastening or connection.

Patent Owner proposes that “conformably fit” means “[j]oining of parts relying on matching forms and dimensions,” and that “mating” means “[j]oining of building element(s) to the patterned surface using cylindrical bosses and recesses.” Response 8. Patent Owner originally contended that “conformably fit” and “mating” have non-overlapping meanings, but facing skepticism from the Board, Patent Owner now concedes that these terms may overlap, and that “‘mating’ could constitute one way to ‘conformably fit.’” Preliminary Response 24-25; Institution Decision 8-9; Response 11.

The dictionary definition of “join” carries connotations of linking or connecting: “to put or bring together so as to form a unit” as in to “join two blocks of wood with glue,” or “to come together so as to be connected” as in “the place where two rivers join.” Exhibit 1038. The specification does not use the terms “join,” “fasten,” “link,” “connect,” or similar terms to describe the relationship

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