

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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RUBICON COMMUNICATIONS, LP  
Petitioner,

v.

LEGO A/S  
Patent Owner.

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Case IPR2016-01187  
Patent 8,894,066

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**PETITIONER'S RESPONSE TO NOTICE OF IDENTIFICATION  
OF IMPROPER NEW MATERIAL**

The Board has rejected the contention that “Petitioner cannot submit additional, belated evidence in its Reply that supports its Petition if it could have been presented in a prior filing.” *The Toro Co. v. MTD Products Inc.*, IPR2016-00219, Paper 38 at 7 (May 10, 2017) (concluding that “[t]his statement of the law is wrong”). The Board clarified:

Our Rule instead states that “[a] reply may only respond to arguments raised in the corresponding . . . patent owner response.” 37 C.F.R. § 42.23. The mere fact that a Reply presents evidence that was not in the record previously does not make that evidence improper. *See Genzyme Therapeutic Prods. Ltd. v. Biomarin Pharm. Inc.*, 825 F.3d 1360, 1367 (Fed. Cir. 2016) (“The purpose of the trial in an *inter partes* review proceeding is to give the parties an opportunity to build a record by introducing evidence—not simply to weigh evidence of which the Board is already aware.”). Patent Owner blurs “belated evidence” with reply evidence; not all evidence first submitted in a reply is belated.

*Toro* at 7-8. Moreover, the Board has held that when a Patent Owner’s Response contains “affirmative contentions” that the cited art fails to disclose claim limitations, “[s]uch contentions differ from mere argument that Petitioner has failed to offer adequate evidence in its Petition,” and a Petitioner may properly present new rebuttal evidence and argument in response. *Nintendo of America, Inc. v. iLife Technologies, Inc.*, IPR2015-00112, Paper 39 at 72-73 (April 28, 2016) (stating that “[t]he very nature of a reply is to rebut the patent owner’s response”).

Petitioner notes that for each of the allegedly improper arguments identified by Patent Owner, the Reply contains pinpoint citations to Patent Owner's Response identifying the issue in the Response to which Petitioner responds. These citations are summarized below.

- Petitioner's discussion of "casing" at 7-8 is responsive to Patent Owner's assertions regarding the Petition's demonstration of this feature. Response at 15-16.
- Petitioner's discussion of "casing" at 9-10, "hand grip section" at 15-16, "exterior shell" at 23-24, and "tactile manipulation" at 28-29, along with supporting evidence, are responsive to Patent Owner's affirmative contentions that neither Philo nor Anderson "disclose[s] each and every limitation" of the claims in question. Response at 14 (generally asserting Philo does not disclose all limitations), 18-19 (casing), 23 (hand grip section), 28 (generally asserting Anderson does not disclose all limitations), 28-29 (casing/housing), 30-31 (conformably fit), 31 (tactile manipulation).
- Petitioner's discussion of what is within "common knowledge" to obtain "predictable results" and the "premise" of the '066 Patent at 18-19, along with supporting evidence, are responsive to Patent Owner's citation of *Arendi*, which requires an assessment of these factors in order to distinguish it. Response at 25-26.

- Petitioner’s discussion regarding Philo’s “casing” at 10-11 and Philo’s “manipulating” of symbols at 13-14, along with supporting evidence, is responsive to Patent Owner’s affirmative contentions that Philo does not disclose these limitations. Response at 14, 18-19, 20.
- Petitioner’s discussion regarding claim 5 and Philo’s “hand grip section” at 15-16, along with supporting evidence, is responsive to Patent Owner’s affirmative contentions that Philo does not disclose these limitations. Response at 14, 23.
- Petitioner’s discussion regarding Anderson’s “tactile manipulation” at 27-29 and Anderson’s “controller” and “casing” at 22-26, along with supporting evidence, is responsive to Patent Owner’s affirmative contentions that Anderson does not disclose these limitations. Response at 28-29, 30-31.
- Petitioner’s discussion of the claim terms “a portion” and “tactile” at 12, 14, and 26, along with supporting evidence, is responsive to Patent Owner’s affirmative contentions that these limitations are not met by Philo or Anderson, along with Patent Owner’s failure to propose constructions of these terms. Response at 18, 22, 30-31.

Respectfully submitted,

Date: September 29, 2017

/ Anthony M. Petro /

Anthony M. Petro (Reg. No. 59,391)

## CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on September 29, 2017 a complete and entire copy of Petitioner's Response To Notice Of Identification Of Improper New Material was provided via Federal Express Standard Overnight, to the Patent Owner by serving the correspondence address of record as follows:

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