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 PATENT OWNER'S MOTION FOR OBSERVATIONS ON CROSS-EXAMINATION OF PETITIONER'S REPLY WITNESS

Petitioner respectfully submits this Response to Patent Owner's Motion for Observations on Cross-Examination of Petitioner's Reply Witness (the "Motion"), Dr. Jay P. Kesan. All page and line references are to Exhibit 2030.

Observations 1-5

At ¶¶ 1-5 of the Motion, Patent Owner cites portions of Dr. Kesan's testimony regarding his educational and professional background, and concludes that these observations are relevant "because Dr. Kesan's educational background and qualifications are inconsistent with the uncontested definition of a person of ordinary skill in the art as of the time of the invention." These observations are not relevant, because they do not account for Dr. Kesan's testimony at page 83, line 21 – page 84, line 4 and page 84, line 20 – page 85, line 1, which reads (emphasis added):

> Q: . . . And by common knowledge of one of ordinary skill, you're referring to the skill that you possess as one in the art?
>
> A. No. I mean, I'm just looking at it as somebody who has some knowledge, probably has a Bachelor's degree in engineering.
>
> * * *
>
> A. But at the same time, this is not complicated technology, and a person with an engineering degree and a couple of years of work experience should be able to – would be the person of ordinary skill in the art.

That is, Dr. Kesan provided further testimony clarifying his earlier position on the level of ordinary skill, rendering it no longer "uncontested."

Observation 10

At ¶ 10 of the Motion, regarding "changing," Patent Owner cites Dr. Kesan's testimony concerning "moving those symbols and images on the display," concluding this testimony is relevant "because it concerns Dr. Kesan's understanding of the term 'manipulate.'" This observation is not relevant, because it fails to account for Dr. Kesan's testimony at p. 31, lines 18-19 that further relates to his understanding of the term "manipulate":

Q. Manipulate includes removing entirely?

A. I suppose it could.

That is, Dr. Kesan's full testimony indicates that his understanding of "manipulate" is not limited to "moving those symbols and images on the display."

Observation 11

At ¶ 11 of the Motion, Patent Owner cites Dr. Kesan's answer of "No, I didn't" to the question "Did you rely on the petition in forming your opinion?", contrasts this to Dr. Kesan's Declaration in which he states he considered the Petition, and concludes that the testimony is relevant "because it explains new arguments not previously raised in the Petition." This observation is not relevant to the extent that it takes Dr. Kesan's answer out of context and suggests a

contradiction in his testimony that does not exist. Dr. Kesan's full answer at page 46, lines 2-5, was:

> A. No, I didn't. I was really focused on responding to the patent owner's response, the declaration of Ms. Elizabeth Knight, and PTAB's institution decision.

That is, whether Dr. Kesan relied on the Petition, as questioned, is distinct from whether Dr. Kesan considered the Petition, as stated in his Declaration.

Observation 12

At ¶ 12 of the Motion, concerning the question of whether the examples of the '066 Patent supported the term "portion" meaning an entirety, Patent Owner cites Dr. Kesan's answer of "Not that I recall, but it certainly doesn't exclude it," concluding that the testimony is relevant because it "concerns Dr. Kesan's understanding of the term 'portion.'" This observation is not relevant, because it does not account for Dr. Kesan's testimony at page 98, line 15 – page 99, line 10:

> Q. Can you explain to us your opinion with respect to how the word "comprising" in the claims affects a portion?
>
> A. Right. As I mentioned in my declaration, you know, the – it's my understanding that when a claim uses the term "comprising," then that is considered to be open-ended language. And so if we say that the casing conformably fits around a portion of the housing, then it has to conformably fit around at least a portion of the housing, but it could be more because of the open-ended language "comprising."

Q. And there's also been some discussion about how the figures in the '066 patent might impact the term "portion." What is your opinion on that?

A. It's my understanding that examples in a patent are there to illustrate the invention, and the claims are not limited to those specific examples. They could be broader.

Observations 16, 19

At ¶ 16 of the Motion, Patent Owner cites the question "Is there anything in the disclosure of Philo that would suggest grasping Brick Simon by the stand?" and Dr. Kesan's answer of "I mean, not that I recall, but it's clear that those structural features are disclosed, and they allow the Brick Simon to be grasped." At ¶ 19 of the Motion, Patent Owner cites similar testimony concerning whether Brick Simon affirmatively discloses "grasping." Patent Owner asserts that these portions of testimony are relevant because they "admit[] that Philo does not disclose a 'hand grip section.'" Petitioner submits that these observations are not relevant because the conclusion does not follow. Observing that the specific action of "grasping" is not affirmatively disclosed is not an admission that a structure (i.e., "hand grip section") capable of being grasped is absent, and Dr. Kesan specifically identified those structural features of Brick Simon that are capable of being grasped.

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