

Patent No. 8,075,338
IPR2015-01569

Filed on behalf of Patent Owner, PPC Broadband, Inc.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CORNING OPTICAL COMMUNICATIONS RF LLC, CORNING
INCORPORATED, AND CORNING OPTICAL COMMUNICATIONS LLC,
Petitioners,

v.

PPC BROADBAND, INC.,
Patent Owner.

Case IPR2016-01569
Patent 8,075,338

PRELIMINARY PATENT OWNER RESPONSE
37 C.F.R. § 42.107

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	THE ‘338 PATENT	4
III.	CLAIM CONSTRUCTION	5
	A. The Intrinsic Evidence, And Even Petitioner’s Own Admissions In Parallel Claim Construction Proceedings, Confirm That The Claimed “Plurality Of Engagement Fingers” Must Be A Portion Of, And Integral With, The Post.	6
	B. Contrary To Petitioner’s Made-Up BRI Theory, The Specification Does Not “Expressly Contradict” A Construction That The Post Is A Single Component.....	14
	C. Petitioner’s Cherry-Picked Dictionary Definition Of “On” Should Be Rejected Because It Is Contrary To What the ‘338 Patent Fundamentally Teaches, Including How The “Axially Aligned Slots” Limitations of Claim 8 Must Be Formed In The Post.	15
IV.	BENCE CANNOT ANTICIPATE ANY OF THE CHALLENGED CLAIMS BECAUSE IT FAILS TO DISCLOSE OR SUGGEST THE FUNDAMENTAL FEATURE OF THE ‘338 PATENT – A CONSTANT CONTACT POST	19
	A. Admittedly, Bence Fails To Disclose Or Suggest The Claimed “Plurality Of Engagement Fingers” That Must Be A Portion Of, And Integral With, The Post.	20
	B. Admittedly, Bence Fails To Disclose “Axially Aligned Slots Positioned On The Post.”	21
V.	BENCE ALSO CANNOT RENDER THE CLAIMED ‘338 PATENT INVENTION OBVIOUS BECAUSE IT NOT ONLY FAILS TO DISCLOSE OR SUGGEST EACH AND EVERY ‘338 PATENT CLAIM LIMITATION, IT ALSO TEACHES AWAY FROM THEM	23
	A. The Level Of Ordinary Skill In The Art At The Time Of The Invention Confirms That The Prior Art Teaches Away From The Claimed Invention.	24
	B. The Scope And Content Of The Prior Art (Bence), Which Taught The Use Of A Separate Grounding Member From The	

Post That Would Not Interfere With Nut Rotation, Is The Antithesis Of, And Teaches Away, From The Claimed Invention.....	35
C. The Differences Between The Claimed Invention Of The ‘338 Patent And Bence, Which Teaches Away From The Fundamental Feature Of The Claimed Invention, Confirm That The Challenged Claims Are Not Obvious.	39
1. Petitioner Fails To Acknowledge The Differences Between The Claimed Invention And The Prior Art.....	39
2. Bence Teaches Away From Petitioner’s Imagined Modification Of Bence’s Post To Have Engagement Fingers Of The Post Interfering With The Inner Surface Of The Rotating Nut, Which Would Render Bence Inoperable For Its Intended Purpose And Change Its Principal Of Operation.....	41
3. Since Petitioner Admits That Bence Already Discloses A Solution To The Loose Connector Problem, There Is No Reason To Modify Bence According To Petitioner’s Unsupported Obviousness Theory.....	45
4. The Conclusory Purported “Rationales” Offered By Petitioner Cannot Satisfy Petitioner’s Burden of Establishing a Prima Facie Case of Obviousness.	47
D. Petitioner’s Own Patents At The Time Of The Invention Of The ‘338 Patent And Years Later Provide Objective Evidence That Engagement Fingers That Are A Portion Of, And Integrated With, The Post Are Not Obvious.	52
VI. PETITIONER’S ALTERNATIVE GROUNDS OF UNPATENTABILITY ASSERTED IN MULTIPLE PETITIONS AGAINST THE SAME CHALLENGED CLAIMS ARE REDUNDANT AND SHOULD BE DENIED.....	57
VII. SINCE THE SAME PRIOR ART AND ARGUMENTS WERE ALREADY CONSIDERED DURING PROSECUTION OF THE ‘338 PATENT, THE BOARD SHOULD EXERCISE ITS DISCRETION UNDER 35 U.S.C. § 325(D) AND DENY THIS PETITION.....	63

I. INTRODUCTION

Patent Owner, PPC Broadband, Inc. (“PPC”), respectfully submits this Preliminary Patent Owner Response to the Petition for *Inter Partes* Review (“IPR”) of claims 5, 6, and 8 of U.S. Patent No. 8,075,338 (the “‘338 Patent”)(EX1001) filed by Petitioner, Corning Optical Communications RF, LLC et al. (“Petitioner”).

Petitioner alleges that the challenged claims are anticipated and obvious based on U.S. Patent No. 7,114,990 (“Bence”) (EX1002), which is owned by Petitioner.

The petition should be denied for several reasons. First, Petitioner invites the Board to commit legal error by centering its petition on made-up claim construction theories that are unreasonable in light of what the ‘338 Patent clearly teaches, are the antithesis of the fundamental feature of the claimed ‘338 Patent invention, and are even contradicted by Petitioner’s admissions in other proceedings. For instance, Petitioner proposes to construe the claimed ‘338 Patent “engagement fingers” to cover Bence’s “engagement fingers,” which are not integral with the post – even though the only “engagement fingers” taught by the ‘338 Patent must be integral with the post, and even though Petitioner has admitted in parallel claim construction proceedings that the claimed “engagement fingers” must be “portions of the post.”

Second, Petitioner invites the Board to commit legal error by proposing made-up anticipation and obviousness theories that cannot satisfy its burden of establishing *prima facie* cases under longstanding Supreme Court and Federal

Circuit precedent. Petitioner did not even attempt to satisfy the analysis required by *Graham* regarding the level of ordinary skill at the time of the '338 Patent invention. In fact, a wealth of objective and contemporaneous evidence demonstrates how one of ordinary skill at the that time would have readily recognized how the prior art – including Bence – not only fails to disclose or suggest the fundamental features of the claimed invention (*i.e.*, the claimed “engagement fingers” integral with the post to achieve the claimed “biasing” limitations), it also admittedly teaches the opposite of it (*i.e.*, fingers of a grounding member separate from the post). In other words, the claimed '338 Patent invention went against conventional wisdom and was contrary to how those of ordinary skill at that time tried to solve the same loose connector problem.

Indeed, Petitioner’s own engineers, who co-invented Bence and were obviously well aware of its teachings, were only able to offer designs at the time of the '338 Patent invention that also followed conventional wisdom, with not a trace of Patent Owner’s inventive solution. And several years later, when Petitioner, and these Bence co-inventors, belatedly filed their own applications directed to the same fundamental feature of the '338 Patent, they admitted that the use of engagement fingers on the post to provide constant radial contact with the nut was patentable. This admission provides objective evidence of the patentability of the '338 Patent invention and belies Petitioner’s litigation-induced and made-up invalidity theories.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.