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.

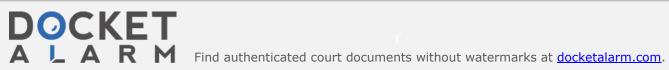
Case IPR2016-01569 Patent 8,075,338

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



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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



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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.



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