PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ACCO BRANDS CORPORATION and ACCO BRANDS USA LLC,	:	
	:	***Inter Partes* Review**
Petitioners,	:	**Proceedings No. IPR2015-01167**
v.	:	**U.S. Patent No. 8,717,758**
THINK PRODUCTS, INC.,	:	
Patent Owner.	:	

PATENT OWNER THINK PRODUCTS, INC.'S MOTION FOR OBSERVATIONS ON CROSS-EXAMINATION OF PETITIONERS' EXPERT WITNESS, RYAN WHITE

Patent Owner, Think Products, Inc. ("Think Products") hereby files this motion for observations with the Patent Trial and Appeal Board ("Board") with respect to the cross-examination of Petitioners' expert witness, Ryan White; the Deposition of Ryan White ("Exhibit 1507") conducted April 27, 2016:

I. Observations Concerning Claim Construction and Whether Petitioners' Expert Witness is Qualified to Act as an Expert and Whether Petitioners' Expert Authored His Declaration and Supplemental Declaration (Exhibits 1021, 1024)

I a.) Page 31, lines 15 – 16; Page 36, lines 16 – 18:

Petitioners' cited expert witness testimony is relevant for establishing that Mr. White does not understand how to construe claims.

* * *

I b.) Page 35, lines 19 – 21:

Petitioners' cited expert witness testimony is relevant for establishing that Mr. White does not understand what a claim limitation is.

* * *

I c.) Page 36, line 25 – Page 38, line 14:

Petitioners' cited expert witness testimony is relevant for establishing that Mr. White did not prepare his own declarations.

* * *

I d.) Page 42, line 15-page 44, line 23; Page 56, line 23 – Page 57, line 1; Page 58, lines 8-13[page 190, line 11-page 191, line 9:

Petitioners' cited expert witness testimony is relevant for establishing that Mr. White did not consider or otherwise identify the differences between claims 1 and 16 of the '758 patent; the witness did not construe claim 16, making an erroneous assumption that claims 1 and 16 have the same scope, without any investigation or construction of independent method claim 16.

* * *

I e.) Page 67, lines 10 – 21; Page 121, line 14 – Page 123, line 23:

Petitioners' cited expert witness testimony is relevant for establishing that Mr. White did not construe the term "captive security rod."

* * *

I f.) Page 82, lines 21 – 23:

Petitioners' cited expert witness testimony is relevant for establishing that Mr. White did not construe the term "locking device."

* * *

I g.) Page 82, line 24–page 83, line 23; Page 120, line 9 – Page 121, line 13:

Petitioners' cited expert witness testimony is relevant for establishing that Mr. White did not did author his written expert testimony (Ex. 1021; 1024).

* * *

I h.) Page 121, line 14 – Page 123, line 23:

Petitioners' cited expert witness testimony is relevant for establishing that the alleged limitation "must be stored" partially in said at least one housing during non-use and between deployments is not recited in the claims.

* * *

The cited testimony is relevant in the aggregate because it brings into question whether Petitioners' expert witness provided a qualified opinion in this proceeding (e.g., with respect to claim construction and the meaning of claim terms) and because Petitioners' expert witness admits that he did not author his Declaration of April 30, 2015 (Ex. 1021) and Supplemental Declaration of March 30, 2016 (Exhibit 1024) pertaining to the construction of Patent Owner's patent claims and brings into question whether any portion of the expert's Declaration and Supplemental Declaration were authored by Petitioners' expert witness.

II. Observations Concerning Claim Terms

II a.) Page 75, line 13 – Page 77, line 22; Page 85, lines 13 – 17:

Petitioners' cited expert witness testimony is relevant for establishing that element 286 depicted in Figs 28C, 28D of the '758 patent (Ex. 1001) and of the '144 patent (Ex. 1003) activates the locking mechanism 110 (also shown) upon insertion of a locking end of the element 286 into locking mechanism 110, causing the locking mechanism to securely grasp the locking end of the captive security rod, after the element 286 is first passed through the housing 516, anchoring the element in the housing and securing the device.

* * *

II b.) Page 97, lines 2-17;

Petitioners' cited expert witness testimony is relevant for establishing that movement of element 286, as depicted in Fig. 28D of the '758 patent (and the '144 patent), is limited, i.e., anchored once passed through the housing 516 and inserted to activate and lock to locking device 110.

* * *

II c.) Page 103, line 11-page 104, line 17;

Petitioners' cited expert witness testimony is relevant for establishing that element 286 depicted in Fig. 28D of the '758 patent is partially in and

partially out of the housing 516 once inserted to activate and lock to locking device 110, i.e., before and during locking use, as shown.

* * *

II d.) Page 112, lines 10-21;

Petitioners' cited expert witness testimony is relevant because even though the witness disagrees that element 291 "is" a captive security rod (see col. 14, line 29 of the '758 patent), he nevertheless admits that in Fig. 30, rod 291 is anchored to the housing, as shown, and is partially out of the housing.

* * *

II e.) Page 128, line 12-page 135, line 12;

Petitioners' cited expert witness testimony is relevant because he agrees that element 291 as shown in Fig. 30 is a captive security rod that, if modified as to scale, could be used to activate the locking device 110 by insertion therein, where the insertion activates the locking mechanism to securely grasp the locking end and thereby lock element 291 and portable electronic device to the locking device.

* * *

II f.) Page 159, line 23-page 160, line 4;

Petitioners' cited expert witness testimony is relevant because he agrees that the elements depicted in patent drawings are not always drawn to scale.

* * *

II g.) Page 188, lines 17-24;

Petitioners' cited expert witness testimony, on redirect, is relevant because he contradicts his earlier testimony, i.e., he states that element 291 does not have a locking end, where he had already testified that if modified as to scale, inserting the other end of element 291 (which is opposite the end anchored in the housing as shown in Fig. 30) into locking device 110 would activate the locking device.

* * *

II h.) Page 40, line 17-page 42, line 21; page 190, lines 11-21;

Petitioners' cited expert witness testimony, on cross and redirect is relevant because he admits he did not construe method claim 16 of the '758 patent.

* * *

The cited testimony is relevant in the aggregate because it shows that independent method claim 16 was never assessed or otherwise construed by Petitioners' expert witness and that claim 16 is indeed different in scope than

claim 1; that Petitioner's expert witness acknowledges that the written specification and drawing figures of the '758 patent support that Patent owner had possession of the invention as claimed.

Respectfully submitted,

THINK PRODUCTS, INC.

Dated: May 23, 2016
Huntington, New York

By _____
John F. Vodopia
Reg. No. 36,299
191 New York Avenue
Huntington, New York 11743

Telephone: (631)673-7555, Ext. 5
E-Mail: jvodopia@gmail.com

Edwin D. Schindler
Reg. No. 31,459
4 High Oaks Court
P. O. Box 4259
Huntington, New York 11743-0777

Telephone: (631)474-5373
Fax: (631)474-5374
E-Mail: EDSchindler@att.net
EDSchindler@optonline.

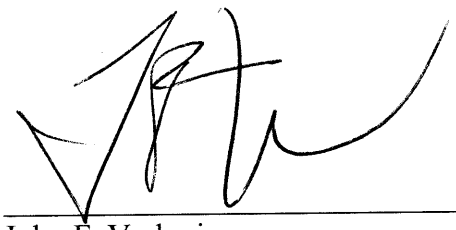
Attorneys for Patent Owner
Think Products, Inc.

CERTIFICATE OF SERVICE

I, JOHN F. VODOPIA, hereby certify that I served a true and complete copy (including all cited Exhibits) of the PATENT OWNER THINK RODUCTS, INC.'S MOTION FOR OBSERVATIONS ON CROSS-EXAMINATION OF PETITIONERS' EXPERT WITNESS, RYAN WHITE, on the following counsel for Petitioners/Requesters ACCO Brands Corporation and ACCO Brands USA LLC. via e-mail (as the parties have so agreed):

Thomas L. Duston	E-Mail: tduston@marshallip.com
Michael R. Weiner	E-Mail: mweiner@marshallip.com
Sandip H. Patel	E-Mail: spatel@marshallip.com

on May 23, 2016.



John F. Vodopia
Reg. No. 36,299

Attorney for Patent Owner
Think Products, Inc.