

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LEGO SYSTEMS, INC. and
WARNER BROS. HOME ENTERTAINMENT INC.,
Petitioner,

v.

FIGUREFUN LLC,
Patent Owner.

IPR2018-00755
Patent 7,338,377 B2

Before HYUN J. JUNG, GEORGE R. HOSKINS, and
KEVIN W. CHERRY, *Administrative Patent Judges*.

JUNG, *Administrative Patent Judge*.

DECISION

Denying Patent Owner's Request for Rehearing of Final Written Decision
37 C.F.R. § 42.71(d)

I. INTRODUCTION

A. Background

LEGO Systems, Inc. and Warner Bros. Home Entertainment Inc. (collectively, “Petitioner”) filed a Petition (Paper 3, “Pet.”) requesting *inter partes* review of claims 1, 3, 5, 7, 8, 10, and 25 of U.S. Patent No. 7,338,377 B2 (Ex. 1001, “the ’377 patent”). Petitioner contended that the challenged claims were unpatentable under 35 U.S.C. § 103(a) over (1) Levy¹ and Lee,² (2) Katoh³ and Lee, and (3) Mawle⁴ and Lee. Pet. 16–17.

After we issued a Decision to Institute an *inter partes* review of the challenged claims (Paper 8, 20), FigureFun LLC (“Patent Owner”) filed a Patent Owner Response (Paper 12, “PO Resp.”), to which Petitioner replied (Paper 17, “Pet. Reply”). Patent Owner also filed a Sur-Reply (Paper 18, “PO Sur-reply”). Oral argument was conducted on June 24, 2019. *See* Paper 27.

We entered our Final Written Decision on September 26, 2019, in which we determined that Petitioner had shown by a preponderance of the evidence that claims 1, 3, 5, 7, 10, and 25 of the ’377 patent were unpatentable over each of the combinations, but not claim 8. Paper 30, 65 (“Final Dec.”). Patent Owner timely filed a Request for Rehearing in which it asks that we modify the Final Written Decision to find challenged claims 1, 3, 5, 7, 10, and 25 not unpatentable. Paper 31, 1 (“Request,” or “Req. Reh’g”).

¹ U.S. Patent No. 5,190,285, issued March 2, 1993. Ex. 1003.

² U.S. Patent No. 6,460,851 B1, issued October 8, 2002. Ex. 1004.

³ GB 2 365 796 A, published February 27, 2002. Ex. 1005.

⁴ U.S. Patent No. 7,081,033 B1, issued July 25, 2006. Ex. 1006.

For the reasons that follow, we deny Patent Owner's Request to modify our Final Written Decision.

B. Standard for Reconsideration

The party filing a request for rehearing of a final written decision has the burden of showing a decision should be modified, and the request for rehearing must specifically identify all matters the party believes the Board misapprehended or overlooked and the place where each matter was previously addressed in its papers. 37 C.F.R. § 42.71(d); *see also* Req. Reh'g 1 (quoting from the rule). Therefore, Patent Owner bears the burden of establishing that we misapprehended or overlooked the matters that it requests that we review.

II. ANALYSIS

A. Whether the Board erred in not construing "token" to be limited to an "item required to begin play of a game"

Patent Owner argues that the Final Written Decision "does not fully resolve the parties' dispute concerning the scope of the claimed 'token,'" and "overlooks the portion of Patent Owner's proposed construction that limits the claimed token to 'an item required to begin play of a game.'" Req. Reh'g 2–3; *see also id.* at 3 n.1 (citing arguments made at PO Resp. 11–14; PO Sur-reply 2–5). In particular, Patent Owner argues that the Final Written Decision overlooks portions of the Specification of the '377 patent that limit "token" to an "item required to begin play," misapprehends the scope of the challenged claims, and needs to provide a full claim construction in order to decide the parties' dispute. *Id.* at 3–7 (citing PO Resp. 12, 32; PO Sur-reply 2, 9–10; Final Dec. 31–33).

The full record did not indicate to us that Patent Owner’s proposed interpretation of “token” would have resolved the parties’ dispute. *See* Final Dec. 12–13. Petitioner proposed interpreting “token” as a “game piece” (Pet. 12–13; Pet. Reply 1), and Patent Owner argued the “term ‘token’ refers to ‘a disk-like shaped item required to begin play of a game,’” (PO Resp. 11–12). In our Final Written Decision, we “agree[d] with Patent Owner that ‘token’ does not include a ‘figure.’” Final Dec. 12–13. We also determined the claim language itself does “not require ‘token’ to be ‘a disk-like shaped item required to begin play of a game,’” in part because the Specification of the ’377 patent “states that a ‘shape of the abovementioned token with built-in IC chip is not limited’ and that ‘it is preferably disk-shaped like an ordinary token.’” *Id.* at 12 (citing Ex. 1001, 7:48–50). Then, we stated “we need only determine that the term ‘token’ does not include a[] ‘figure.’” *Id.* at 13.

The full record indicated to us that adopting Patent Owner’s proposed interpretation of “token” as an “item required to begin play of a game” did not distinguish over the asserted references. Patent Owner proposed interpreting “game initial data” in claims 1 and 25 to mean “a data set required for commencement of [a] game.” PO Resp. 15–16. In the Final Written Decision, we explained why, even if we accepted Patent Owner’s interpretation of “game initial data,” Petitioner shows by a preponderance of the evidence that claim 1 is unpatentable over the asserted combinations of the references. *See* Final Dec. 24–25, 34–35 (Levy and Lee); *id.* at 40–41, 48–49 (Kato and Lee); *id.* at 54–55, 62–64 (Mawle and Lee). The same analysis would apply to Patent Owner’s proposed interpretation of “token” as an “item required to begin play of a game.”

Moreover, Petitioner argued “the term ‘token’ is in the preamble and should not limit the claim, especially under the broadest reasonable interpretation requirement,” and “the body of the claims defines a structurally complete invention, and the preamble is used only to state a name (‘token’) and purpose or intended use of the invention (‘a token for a gaming machine on which a player plays a game by controlling a character’).” Pet. Reply 2–3. Petitioner further argued that Patent Owner’s attempt to read “required to begin play of a game” into the meaning of “token” is an attempt “to arbitrarily read in an additional functional limitation on the use of a token without any basis, much less in accordance with the BRI requirement.” *Id.* at 3. Patent Owner did not meaningfully reply to Petitioner’s argument that “‘token’ is in the preamble,” “should not limit the claim,” and states a “purpose or intended use.” *See* PO Sur-reply 2–4; *see also* Final Dec. 9–12 (summarizing the parties’ dispute regarding “token”).

Also, the body of independent claims 1 and 25 recite structurally complete inventions, and do not rely on the word “token,” from the preamble, for any antecedent basis of terms in the body of the claim. The deletion of this preamble language would not affect the structure of the claimed inventions and confirms that the language of the preamble, which names the machine or manufacture claimed as a token, and states its intended use, is not limiting. *See Am. Med. Sys., Inc. v. Biolitec, Inc.*, 618 F.3d 1354, 1358-59 (Fed. Cir. 2010).

Further, because the bodies of the claims, reciting an “integrated circuit chip” (claim 1) and “storage section” (claim 25), fully define the structure of the claimed tokens and do not rely on the “token” name of the invention to recite the limitations of their structural components, the term

“token” does not require construction. It is of *no significance* in assessing the meaning of the claims. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999). Because the term “token” does not require construction, and is of no significance in determining the meaning of the claim language, we did not adopt Patent Owner’s additional limitation of a token being required to begin play of a game.

B. Whether the Board misapprehended Lee and the showing that the Board must make to satisfy a finding of obviousness.

Patent Owner argues that, as previously addressed in its papers, Lee does not disclose a “token” under any reasonable construction of the term. Req. Reh’g 7 (citing PO Resp. 3, 32; PO Sur-reply 9–10). Patent Owner also argues “the Board misapprehended or overlooked its obligation to provide an evidentiary basis for and articulate why it concluded the alleged prior art teaches or otherwise discloses a ‘token.’” *Id.* at 8. According to Patent Owner, the Final Written Decision “seems to identify *Lee* as allegedly disclosing the claimed ‘token . . . being attachable to and detachable from a figure,’” but “provides no explanation for why the Board contends the disclosure of *Lee* teaches the claimed ‘token.’” *Id.* at 8–9 (citing Final Dec. 22–23, 31–32, 37–39, 46–47, 52–53, 59–62); *see also id.* at 9–10 (“the ‘transducer’ of *Lee* does not satisfy the claimed ‘token’ . . . because the transducer is not required to begin game play”).

As discussed above, Patent Owner misunderstands the basis of our Final Written Decision, which finds that each of the combinations (Levy and Lee, Katoh and Lee, and Mawle and Lee) discloses the limitations of claims 1, 3, 5, 7, 10, and 25 (Final Dec. 19–33, 36–48, 50–62, 64–65), that one of ordinary skill in the art would have combined the references in the manner asserted by Petitioner and as claimed (*id.* at 34–35, 48–49, 62–65), and thus,

Petitioner's proposed combination of references would have rendered obvious the "token" of the challenged claims.

A separate showing, in only one reference, of a "token," as asserted by Patent Owner, is unnecessary and would be incorrect, because the claimed token is fully described in the body of the claims. For the reasons in the Final Written Decision, based on the full record, Petitioner persuades us by a preponderance of the evidence that the recited limitations in the bodies of claims 1 and 25 are found in the prior art. *See* Final Dec. 19–33, 36–48, 50–62, 64–65.

Patent Owner further argues that our Final Written Decision fails to explain, and misapprehends the disclosure of Lee, as to dependent claims 7 and 10 (Req. Reh'g 9), because the "transducer disclosed by *Lee* is a simple electronic component; it is not a 'token' under any reasonable construction of the term" (*id.* at 10). As stated in the Final Written Decision (*see, e.g.*, Final Dec. 30, 32), Patent Owner did not present any arguments specifically for the dependent claims. *See generally* PO Resp. We could not have misapprehended or overlooked a matter not previously presented.

Moreover, the claim language does not support Patent Owner's argument presented in the Request. Claim 1 recites a "token" that comprises only the "integrated circuit chip" recited in the body of the claim. Ex. 1001, 23:67–24:2. Claims 7 and 10 each recite "[t]he token according to claim 1," with the remainder of the claim being a "wherein" clause. *Id.* at 24:26–28, 24:36–38. Claim 7 recites that "the token is attachable to the figure by insertion into a recess in a surface of the figure," and claim 10 recites that "the token is securable in a recess formed in a bottom face of a base portion of the figure." *Id.*

Claim 1 only requires a single structure, the recited “integrated circuit chip,” and claims 7 and 10 do not require any structure other than the “integrated circuit chip” of claim 1. *See id.* at 23:58–24:2, 24:26–27, 24:36–38. These claims also do not require a *separate* token from the integrated circuit chip. *See id.* Thus, the scope of claims 1, 7, and 10 would encompass a mere integrated circuit chip that is attachable to a figure or securable in a recess. *See id.*

In view of the claim language, Patent Owner’s argument in its Request does not show that we misapprehended or overlooked its arguments related to “token.” *See* Req. Reh’g 9–10. Also, for the reasons discussed in the Final Written Decision, we would still determine that Petitioner persuades us by a preponderance of the evidence that each combination of references teaches or suggests the limitations of claims 1, 3, 5, 7, 10, and 25 (Final Dec. 19–33, 36–48, 50–62, 64–65) and that one of ordinary skill in the art would have combined the references in the manner asserted by Petitioner (*id.* at 34–35, 48–49, 62–65).

C. Whether the Final Written Decision lacks a rationale for modifying or combining the alleged prior art to achieve the claimed subject matter

Patent Owner argues that the Final Written Decision “does not explain why one of skill in the art would have included the references’ integrated circuit ***in a token*** that is attachable to and detachable from a figure (as is required by the claims).” Req. Reh’g 11. This is based on Patent Owner’s view that “the correct interpretation of the challenged claims is that they require a token (as opposed to merely an integrated circuit/storage) being attachable to and detachable from a figure.” *Id.* at 11–12 (citing PO Resp. 21–22; Final Dec. 12). Patent Owner also argues that the reason for combining each combination of references “is too broad and generic to

support the conclusion that one of ordinary skill in the art would have modified *Levy/Katoh/Mawle* to arrive at the subject matter of claims 1, 3, 5, 7, 10, and 25.” *Id.* at 12–13 (citing Final Dec. 34–35, 49, 63–64). More specifically, Patent Owner contends:

It is not enough to show that one of skill in the art would have had a reason to make the integrated circuit of *Levy, Katoh, or Mawle* detachable. The claims require a “token” (not merely an integrated circuit) “being attachable to and detachable from a figure.[”] An integrated circuit, by itself, is not a “token” (indeed, it is a separately claimed element), and the Board offers no explanation for how making the integrated circuit of *Levy/Katoh/Mawle* detachable makes the disclosed integrated circuit a “**token** . . . that is attachable to and detachable from a figure.”

Id. at 13–14.

We disagree with Patent Owner, because the arguments are not commensurate with the scope of the claims. Claim 1 and its dependent claims recite that the token *is*, at least, an “integrated circuit chip” having attributes, such as being detachable from a figure, and claim 25 similarly recites that the token *is*, at least, a “storage section” that is detachable.

III. CONCLUSION

For the above reasons, we deny the Patent Owner's request.

Outcome of Decision on Rehearing:

Claims	35 U.S.C. §	References/Basis	Denied	Granted
1, 3, 5, 7, 10, 25	103(a)	Levy, Lee	1, 3, 5, 7, 10, 25	
1, 3, 5, 7, 10, 25	103(a)	Katoh, Lee	1, 3, 5, 7, 10, 25	
1, 3, 5, 7, 10, 25	103(a)	Mawle, Lee	1, 3, 5, 7, 10, 25	
Overall Outcome			1, 3, 5, 7, 10, 25	

Final Outcome of Final Written Decision after Rehearing:

Claims	35 U.S.C. §	References/Basis	Claims Shown Unpatentable	Claim Not Shown Unpatentable
1, 3, 5, 7, 8, 10, 25	103(a)	Levy, Lee	1, 3, 5, 7, 10, 25	8
1, 3, 5, 7, 8, 10, 25	103(a)	Katoh, Lee	1, 3, 5, 7, 10, 25	8
1, 3, 5, 7, 8, 10, 25	103(a)	Mawle, Lee	1, 3, 5, 7, 10, 25	8
Overall Outcome			1, 3, 5, 7, 10, 25	8

IV. ORDER

Accordingly, it is ORDERED that Patent Owner's Request for Rehearing is *denied*.

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