

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HEAD SPORT GMBH,
Petitioner,

v.

VERMONT SAFETY DEVELOPMENTS LLC,
Patent Owner.

IPR2024-01099
Patent 7,523,953 B2

Before BARRY L. GROSSMAN, MITCHELL G. WEATHERLY. and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

GROSSMAN, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

In its Preliminary Response (Paper 10, “Prelim. Resp.”), Patent Owner raises the issue of whether the claim term “release logic” is a “means-plus-function” limitation written in accordance with 35 U.S.C. § 112(f). Prelim. Resp. 10–12, 19–22. If a claim term is a “means-plus-function” limitation, our rules require that a petition filed to initiate an *inter partes* review “must identify:”

How the challenged claim is to be construed. Where the claim to be construed contains a means-plus-function or step-plus-function limitation as permitted under 35 U.S.C. 112(f), the construction of the claim must identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function.

37 C.F.R. § 42.104(b)(3). This claim construction rule applies solely to the “petition.” *Id.* Failure to comply with this mandatory requirement (“must identify”), will result in a petition being denied. *Id.* Thus, a potentially dispositive issue in this IPR proceeding is whether the claim term “release logic” is “a means-plus-function” limitation.

Patent Owner submitted evidence from the parallel District Court proceeding¹ showing that Petitioner (Defendant in the parallel district Court proceeding) argued to the District Court that the term “release logic” is a “means-plus-function” limitation. *See* Ex. 1014, 3–5, 11–13); Ex. 2001, 3; Ex. 2003 ¶¶ 74–89.

In the Petition in this proceeding, Petitioner asserts that “[n]o terms need construction to resolve the controversy in this forum.” Pet 6. Patent Owner has identified a potentially dispositive issue concerning the

¹ *Vermont Safety Developments LLC v. Head Sport GmbH*, Case No. 2:23-cv-00089-GWC (DVT).

construction of the term “release logic.” We also note, however, that Patent Owner in this IPR proceeding has not specifically argued that the term “release logic” is a limitation that must be construed according to 35 U.S.C. § 112(f). Patent Owner has merely asserted the Petitioner’s burden to do so based on evidence that Petitioner recognizes that “release logic” is a “means-plus-function” limitation. *E.g.*, Prelim. Resp. 11–12 (“when a petitioner knows there is a dispute in district court about whether a limitation in a challenged claim should be construed under Section 112(f), the petitioner is required to address this in the petition, and failing to do so renders a petition ‘deficient on its face.’”) (citations omitted).

Petitioner argued in the parallel District Court proceeding, in support of a stay of the District Court proceeding, to allow this Board to first determine whether to institute an IPR proceeding “under any [claim] construction the PTAB [chooses], and that’s their job. Their job is to construe their claims.” Ex. 2002, 8:16–18. We agree. A key part of nearly every IPR proceeding is construing the words and meaning of a challenged patent claim. In order to determine whether to institute this IPR proceeding, we likely will need to construe the claim term “release logic.”

Unfortunately, in this proceeding neither party has proposed a specific construction for this claim term. Rather than construe this term based on the record before us, we want the parties to have an opportunity to provide their views.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner shall file no later than November 15, 2024, a claim construction brief not to exceed five (5) pages providing a specific construction for the claim term “release logic,” including a statement as to whether the term is, or is not, a “means-plus-function” limitation governed by 35 U.S.C. § 112(f); and

FURTHER ORDERED that Patent Owner shall file no later than November 22, 2024, a response not to exceed five (5) pages to Petitioner’s claim construction brief.

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