Trials@uspto.gov
571-272-7822

Paper No. 38
Date: December 12, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SANDISK CORPORATION,
Petitioner,

v.

NETLIST, INC.,
Patent Owner.

IPR2015-01020 (Patent 7,881,150 B2)
IPR2015-01021 (Patent 8,081,536 B1)

Before BRYAN F. MOORE, GEORGIANNA W. BRADEN, and PETER P. CHEN, *Administrative Patent Judges.*

CHEN, *Administrative Patent Judge*.

DECISION
Denying Requests for Rehearing After Final Written Decisions
37 C.F.R. § 42.71

I. INTRODUCTION

Patent Owner has filed virtually identical Requests for Rehearing from the Final Written Decisions in IPR2015-01020 and IPR2015-01021.[1] Paper 37, "Req. Reh'g." Patent Owner argues the Board misapprehended or overlooked that: (i) Petitioner and its expert Dr. Jagannathan "repeatedly–and clearly–explained . . . that the chip select signal was itself the logic signal to enable bit-switches"; (ii) Petitioner's Reply presented "a 'new theory of invalidity' and an 'entirely new rationale'"; and (iii) Patent Owner "was not on notice of 'Petitioner's' new combination theory as of the Patent Owner Response." Req. Reh'g 2, 5, 7.

We have reviewed Patent Owner's requests for rehearing and have considered the arguments presented. The Requests for Rehearing are denied.

II. STANDARD OF REVIEW

Under 37 C.F.R. § 42.71(d), the request for rehearing "must specifically identify all matters the party believes the Board misapprehended or overlooked." *See* 37 C.F.R. § 42.71(d). Section 42.71(d) further provides that the request must identify where each matter was previously addressed.

III. ANALYSIS

Patent Owner first argues that the Final Written Decisions (Paper 36, "Final Dec.") incorrectly assessed as merely "inartful," Dr. Jagannathan's testimony in his first declaration (Ex. 1002) about the chip select signal in the Takeda reference. Req. Reh'g 1–4. Patent Owner asserts that Dr. Jagannathan, and Petitioner, intentionally and repeatedly referred to Takeda's chip select signal as constituting the logic signal enabling bit

[1] Citations herein are to the Request for Rehearing in IPR2015-01020.

switches, and not as a signal that generates another logic signal that in turn enables the bit switches. *Id.*

As we stated in the Final Written Decisions, however, in paragraph 106 of the first Jagannathan declaration, filed concurrently with the Petition, he testified, "[t]hus, when a chip-select output from the bank control unit is used to enable a particular DDR SDRAM device, it is also *used to enable the bit switch*." Final Dec. 23 (citing Ex. 1002 ¶ 106) (emphasis added). This described Petitioner's evidence on the chip select signal, namely, that Dr. Jagannathan did not testify that the chip select signal "is also the bit switch enable signal," but rather, that the chip select signal "is used to" generate the enable signals to the bit switch. In Petitioner's post-hearing brief (Paper 30), Petitioner cited to pages 35 and 36 of the Petition, and to Dr. Jagannathan's deposition testimony:

> Q. So what I'm trying to understand is, in that paragraph, it seems that you're saying it's the same signal that's being used.
>
> A. No, I don't -- I disagree with that. What I am trying to say here is the chip select signal -- those signals that I talked about earlier in the sentence, they're effectively being used to generate the enable signals.

Paper 30 (citing Ex. 2002, 218:6–17). Petitioner asserted in its post-hearing brief, "[w]hen taken as a whole, in context, Dr. Jagannathan's testimony supports the rationale in the Petition." Paper 30, 4. As set forth in the Final Written Decision, we agree. Nothing argued by Patent Owner persuades us that in the Final Written Decision we misapprehended or overlooked the nature of Dr. Jagannathan's testimony in his first declaration.

Patent Owner's second argument is that Petitioner's theory of the chip select signal generating another logic signal, as presented in its Reply, was an "entirely new rationale." Req. Reh'g 4–7. We disagree. As noted above, there was no new rationale presented, and we found that Petitioner did not assert a new theory. Petitioner's Reply was based on the same ground of obviousness, involving the same combination of references (Takeda, JEDEC, and Connolly), and proffering the same particular application of the Takeda reference, as set forth in the Petition. Therefore, we determine that we did not misapprehend or overlook the nature of Petitioner's arguments in its Reply.

Lastly, Patent Owner argues that we misapprehended the timeline of events regarding the chip select signal issue. Specifically, Patent Owner argues it did not have notice of Petitioner's supposedly changed theory until Petitioner's Reply, because Dr. Jagannathan's testimony at his deposition (which occurred prior to Patent Owner's Response being filed), where he again testified that the chip select signal enables a logic signal, did not constitute a position taken by the Petitioner. Req. Reh'g 7–8. Patent Owner avers, "there was no indication, nor assumption, at the time of the Patent Owner Response that Petitioner would adopt Dr. Jagannathan's new combination theory and discard its original combination theory." *Id.* at 8.

We disagree. As set forth in the Final Written Decisions, we did not misapprehend the sequence of events. Final Dec. 24–25. Moreover, even assuming Patent Owner's hypothesis is correct – i.e., that at his deposition, Dr. Jagannathan was testifying not on behalf of Petitioner but instead only in his individual capacity – it is undisputed that Patent Owner subsequently

could have addressed the issue of his testimony about Takeda's chip select signal in the Patent Owner Response. Patent Owner chose not to do so. Therefore, we determine that we did not misapprehend the record in the Final Written Decisions.

In sum, Patent Owner has not shown how we overlooked or misapprehended its arguments or evidence, as required by 37 C.F.R. § 42.71(d). Rather, Patent Owner uses its Requests for Rehearing as an opportunity to reargue its position; a position with which we disagree. Merely disagreeing with our analysis or conclusions does not serve as a proper basis for a rehearing. Thus, Patent Owner's challenge does not meet the standard set forth for a request for rehearing.

IV. CONCLUSION

For the foregoing reasons, we are not persuaded Patent Owner has shown that the Board overlooked or misapprehended evidence or arguments in the Final Written Decisions.

V. ORDER

Accordingly, it is hereby ORDERED that Patent Owner's Requests for Rehearing in IPR2015-01020 and IPR2015-01021 are denied.

PETITIONER:

Lori Gordon
Rob Sokohl
STERNE, KESSLER, GOLDSTEIN & FOX PLLC
lgordon-PTAB@skgf.com
rsokohl-PTAB@skgf.com

PATENT OWNER:

Mehran Arjomand
David Kim
Erol Basol
Jean Nguyen
Jonathan Statman
MORRISON & FOERSTER LLP
63516-150-IPR3@mofo.com
63516-536-IPR2@mofo.com