

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KINGSTON TECHNOLOGY COMPANY, INC.,
Petitioner,

v.

POLARIS INNOVATIONS LTD.,
Patent Owner.

Case IPR2016-01622
Patent 6,850,414 B2

Before SALLY C. MEDLEY, JEAN R. HOMERE, and
MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.71(d), Kingston Technology Company, Inc. (“Petitioner”) requests rehearing of the Decision (Paper 7, “Dec.”) denying institution of an *inter partes* review of claim 4 of U.S. Patent No. 6,850,414 B2 (Ex. 1001, “the ’414 patent”). Paper 11 (“Req. Reh’g”).

For the reasons set forth below, Petitioner’s Request for Rehearing is *denied*.

II. STANDARD OF REVIEW

A party requesting rehearing bears the burden of showing that the decision should be modified. 37 C.F.R. § 42.71(d). The party must identify specifically all matters we misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a reply. *Id.* When rehearing a decision on a petition, we review the decision for an abuse of discretion. *See* 37 C.F.R. § 42.71(c). An abuse of discretion may be indicated if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *See Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). With this in mind, we address the arguments presented by Petitioner.

III. ANALYSIS

Claim 4 recites, “said printed circuit board has a height of 1 to 1.2 inches perpendicular to said contact strip.” Ex. 1001, 8:20–21. In our Decision on Institution, we determined, *inter alia*, that “Petitioner has not

explained sufficiently how or why a person of ordinary skill in the art would have modified Simpson to achieve a height of ‘1 to 1.2 inches perpendicular to said contact strip.’” Dec. 17.

In its Request for Rehearing, Petitioner argues the following: (1) the Petition did not argue that Simpson required modification (Req. Reh’g 2–4); (2) the Petition explains *why* one of ordinary skill in the art would have combined Simpson and the Intel Specification (*id.* at 4–6); (3) the Petition explains *how* one of ordinary skill in the art would have combined Simpson and the Intel Specification (*id.* at 6–8); and (4) the limitation recited in claim 4 is not entitled to patentable weight (*id.* at 8–9). We address each argument in turn.

A. Whether Simpson Teaches Claim 4

Petitioner argues that “claim 4 requires no changes to the Simpson design to be rendered obvious.” Req. Reh’g 2; *see also id.* (“The chip design of Simpson remains unchanged.”). According to Petitioner, “Simpson places no restriction on height at all – either of the circuit board or of the chips. The invention of Simpson could be implemented at any size circuit board with any size of chips and sockets that would be desirable to one of ordinary skill in the art.” *Id.* at 3. Thus, “it is not a question of changing Simpson, but rather that ‘Simpson could easily be constructed with a height in the range of 1 to 1.2 inches,’ which is a height that ‘had been standardized for some time’ when the ’414 Patent was filed.” *Id.* (quoting Ex. 1006 (“Subramanian Decl.”) ¶ 29¹).

¹ The quoted language appears in paragraph 95 of the Subramanian Declaration. We understand “29” to be a typographical error.

Although Petitioner objects to our use of the word “modified” in the Decision on Institution, we are not persuaded that it mischaracterizes Petitioner’s argument. Petitioner identified nothing in Simpson that teaches explicitly “a height of 1 to 1.2 inches perpendicular to said contact strip,” as recited in claim 4. Instead, in the claim-by-claim analysis, the Petition refers to “limit[ing]” Simpson (Pet. 36) and “apply[ing]” standardized dimensions and tolerances to Simpson (Pet. 37). Earlier in the analysis, the Petition states, “one of ordinary skill in the art at the priority date of the ’414 Patent would have been motivated *to modify Simpson* based on the design dimensions of the Intel Specification.” *Id.* at 14 (emphasis added); *see also id.* at 15 (“One of ordinary skill in the art would recognize that *modifying Simpson* to comply with the physical constraints supplied by the Intel Specification would be a way to modernize Simpson to work with current motherboards and contemporary technology.” (emphasis added)). Dr. Subramanian testifies that Simpson would “incorporate the constraints” and “would be constrained and adapted to comply with the design specifications—specifically the physical dimensions—described in the Intel Specification” (Ex. 1006 ¶ 38). Dr. Subramanian further testifies that “[o]ne of ordinary skill in the art would have been motivated *to modify Simpson* based on the design dimensions of the Intel Specification and would have had a reasonable expectation of success when doing so.” Ex. 1006 ¶ 38 (emphasis added). As a result, we are not persuaded that we misapprehended Petitioner’s argument when we characterized it as proposing a modification of Simpson.

*B. Whether Petitioner’s Reason to Combine Simpson
and the Intel Specification was Adequate*

Petitioner argues that the Petition “set forth several reasons why a person of ordinary skill in the art would be motivated to use the invention of Simpson on a circuit board that is between 1 inch and 1.2 inches as described in the Intel Specification.” Req. Reh’g 4. Specifically, Petitioner points to its argument that “modifying Simpson to comply with the physical constraints supplied by the Intel Specification would be a way to modernize Simpson to work with current motherboards and contemporary technology” (*id.* at 5 (citing Pet. 15)), and that by “mid-2001, the dimensions of printed circuit boards had been standardized for some time” (*id.* (citing Pet. 36)).

Petitioner also argues that the Petition “explains how one of ordinary skill would have been able to use the dimensions from the Intel Specification with the chip design of Simpson.” Req. Reh’g 6. Specifically, Petitioner points to its argument that “any person of ordinary skill in the art would know to take the design of Simpson and apply the standardized dimensions and tolerances described in the Intel Specification.” *Id.* at 6–7 (citing Pet. 36–37). Petitioner concludes that

one of ordinary need merely use the images and dimensions of the Intel Specification while building the memory module of Simpson to satisfy the requirements of claim 4. Only routine knowledge and the disclosure of prior art is required to apply Simpson to a standard sized printed circuit board (as claimed).

Id. at 7.

Petitioner’s argument is unavailing. Simpson teaches a printed circuit board with a height sufficient to accommodate the components mounted thereon—i.e., two rows of *horizontally*-oriented memory chips 12A–H.

Petitioner relies upon *both* rows of memory chips as teaching “at least nine identically designed integrated semiconductor memories,” as recited in claim 1. Pet. 18–19. The Intel Specification, by contrast, teaches a single row of *vertically*-oriented memory chips. Ex. 1003, 7. The Petition and Dr. Subramanian propose modifying the height of Simpson’s printed circuit board, but do not address whether a height in the range of 1 to 1.2 inches would be sufficient to accommodate two rows of horizontally-oriented memory chips, as taught by Simpson. Neither the Petition nor Dr. Subramanian addresses, for example, the dimensions of the components taught by Simpson, whether two rows of memory chips would fit on a printed circuit board that has a height of only 1 to 1.2 inches, or—if the memory chips taught by Simpson would not fit—what a person of ordinary skill in the art would have known about the dimensions of similar memory chips as of the critical date that would have made it obvious to fit two rows of them on a printed circuit board having a height of only 1 to 1.2 inches.

In its Rehearing Request, Petitioner does not identify where in the Petition these issues were addressed. As a result, we are not persuaded that we misapprehended or overlooked any arguments and evidence when we concluded that “Petitioner has not explained sufficiently how or why a person of ordinary skill in the art would have modified Simpson to achieve a height of ‘1 to 1.2 inches perpendicular to said contact strip.’” Dec. 17.

C. Whether Claim 4 is Entitled to Patentable Weight

Petitioner argues that the circuit board height recited in claim 4 is a design choice that is not entitled to independent patentable weight. Req. Reh’g 8–9 (citing *In re Rose*, 220 F.2d 459 (C.C.P.A. 1955); *In re Applied Materials, Inc.*, 692 F.3d 1289 (Fed. Cir. 2012)). Although the Petition uses

the phrase “design choice” twice in the analysis for claim 4 (Pet. 36), it does not include any argument that the limitation recited in claim 4 is not entitled to patentable weight. Moreover, the Petition cites neither *In re Rose* nor *In re Applied Materials, Inc.* As a result, we could not have overlooked or misapprehended this argument because it was not made in the Petition.

IV. ORDER

For the reasons given, it is:

ORDERED that Petitioner’s Request for Rehearing (Paper 11) is *denied*.

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