

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC. and AMAZON WEB SERVICES, INC.,
Petitioner,

v.

BROADCOM CORPORATION,
Patent Owner.

Case IPR2017-00814
Patent 6,766,389 B2

Before JAMES B. ARPIN, BARBARA A. PARVIS, and
DANIEL J. GALLIGAN, *Administrative Patent Judges*.

GALLIGAN, *Administrative Patent Judge*.

DECISION
Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

On September 1, 2017, Amazon.com, Inc. and Amazon Web Services, Inc. (collectively, “Petitioner”) filed a Request for Rehearing (Paper 14, “Req. Reh’g”) of our Decision (Paper 10, “Dec. on Inst.”) instituting *inter partes* review of some, but not all, of the claims of U.S. Patent No. 6,766,389 B2 (“the ’389 patent”). In particular, Petitioner requests a partial rehearing of our decision not to institute *inter partes* review of claims 4, 9, and 13 as unpatentable under 35 U.S.C. § 102(b) as allegedly anticipated by Shigeeda.¹

For the reasons that follow, Petitioner’s request for rehearing is denied.

STANDARD OF REVIEW

Under 37 C.F.R. § 42.71(c), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” The party requesting rehearing has the burden of showing that the decision from which rehearing is sought should be modified, and “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked.” 37 C.F.R. § 42.71(d). An abuse of discretion may be determined 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. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); and *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000).

¹ US Patent No. 5,778,425 (Ex. 1004).

ANALYSIS

Claim 9

On rehearing, Petitioner argues that we abused our discretion in denying institution as to claim 9 by referring to our analysis for claim 4 because “claim 9 merely requires that coherency be maintained within unspecified components of the integrated circuit,” as opposed to claim 4, which requires the “bridge circuit to operate to maintain cache coherency for the integrated circuit.” Req. Reh’g 5–7. Petitioner contends that, “[g]iven these differing limitations, the Board should have independently considered whether Shigeeda discloses the particular limitations in claim 9.” *Id.* at 5–6. According to Petitioner, “[h]ad the Board considered the Shigeeda passages analyzed in the Petition for claim 9 (and cross-referenced from claim 4), the [Board] would have found that Petitioner is reasonably likely to show that Shigeeda anticipates the broader claim 9.” *Id.* at 8 (citations omitted).

Contrary to Petitioner’s arguments, however, we did consider claim 9’s differing limitations in our Decision on Institution. With respect to claim 4, we first stated that “Petitioner has not explained sufficiently how Shigeeda discloses operation ‘to maintain cache coherency,’ as recited in claim 4.” Dec. on Inst. 20. We further stated:

Petitioner provides no further explanation of this citation [(Shigeeda, 42:38–47)]—specifically why a cache flush that occurs only upon the write-back cache’s becoming full of *dirty* data to “reestablish coherency” discloses “maintain[ing] cache coherency.” Petitioner also cites Shigeeda’s Abstract (Pet. 48 n.105) but provides no further explanation of its relevance. Although Shigeeda’s Abstract mentions a cache flush operation, it does not explain how a cache flush discloses an operation “to maintain cache coherency,” as recited in claim 4.

Dec. on Inst. 20–21 (first alteration added). This explanation was directed to the requirement of claim 4 to “maintain cache coherency.” *Id.* at 20.

Following this explanation, we stated: “Second, Petitioner does not explain sufficiently how bus bridge 716 ‘operate[s] to maintain cache coherency for the integrated circuit,’ as recited in claim 4.” *Id.* at 21. This second reason for denying institution as to claim 4 was specific to claim 4’s requirement of a “bridge circuit to operate to maintain cache coherency for the integrated circuit.” *See id.* at 21–22.

In denying institution as to claim 9 as allegedly anticipated by Shigeeda, we stated:

Because Petitioner’s contentions as to claims 9 and 13 rely on its inadequate explanations as to claim 4 and *do not provide further explanation regarding how Shigeeda allegedly discloses maintaining cache coherency*, we determine the information presented in the Petition does not show a reasonable likelihood Petitioner would prevail in challenging claims 9 and 13 as anticipated by Shigeeda.

Id. at 23–24 (emphasis added). In our decision to deny institution as to claim 9, therefore, we refer to our first reason for denying institution as to claim 4—that Petitioner did not adequately explain how Shigeeda discloses maintaining cache coherency. Our Decision was not based on our second reason for denying institution as to claim 4—Petitioner’s failure to explain, in the Petition, how bus bridge 716 maintains cache coherency.

Because, in our Decision on Institution, we considered the differences in claim language between claims 4 and 9, we did not abuse our discretion in denying institution of review of claim 9.

Claims 4, 9, and 13

In denying institution of review of claims 4, 9, and 13, we stated:

Petitioner also cites a ten-page passage from the testimony of its declarant, Dr. Weissman. *See* Ex. 1003 ¶¶ 112–129 (cited at Pet. 48 n.104). The cited testimony provides a lengthy explanation as to how Shigeeda allegedly discloses cache coherency in two ways. *See id.*; *see also id.* ¶ 116 (“Shigeeda solves the problem of cache incoherency, and maintains the coherence of its caches, in two ways.”). This explanation as to Shigeeda, however, is absent from the Petition. A declaration in support of a petition may be proffered as evidence in support of an argument made in the petition. Such a declaration, however, is not a vehicle through which a petitioner may make an argument that should have been made in the petition. To permit otherwise would allow petitioners to exceed the word limits of our Rules (*see* 37 C.F.R. § 42.24) and force the patent owner to respond to arguments not made *in the petition*.

Dec. on Inst. 22; *see also id.* at 23–24 (“Because Petitioner’s contentions as to claims 9 and 13 rely on its inadequate explanations as to claim 4 and do not provide further explanation regarding how Shigeeda allegedly discloses maintaining cache coherency, we determine the information presented in the Petition does not show a reasonable likelihood Petitioner would prevail in challenging claims 9 and 13 as anticipated by Shigeeda.”).

On rehearing, Petitioner argues the cited portions of Dr. Weissman’s testimony “did not add any new arguments on top of” the arguments in the Petition but, rather, “explain how a [person of ordinary skill in the art] would have understood that cache flush processes, such as those in Shigeeda, reestablish coherency and how Shigeeda’s bus bridge 716 participates in that very process.” Req. Reh’g 10. According to Petitioner, the “citation to paragraphs 112-129 of Dr. Weissman’s declaration serves to identify the

specific portions of the evidence relied upon to support the arguments presented in the Petition, per the Board's rules." Req. Reh'g 10–11.

We disagree. Petitioner's citation to such a lengthy passage in its declarant's testimony (greater than 10 pages) is not an adequate identification of a "specific portion[]" of the evidence," as required by our Rules. *See* 37 C.F.R. § 42.104(b)(5) ("The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge."). Indeed, some of the cited testimony appears to be directed to a theory of how Shigeeda allegedly discloses cache coherency that is not argued in the Petition. *See* Ex. 1003 ¶¶ 116–118. In particular, Dr. Weissman testifies that "Shigeeda solves the problem of cache incoherency, and maintains the coherence of its caches, in two ways." Ex. 1003 ¶ 116. The first way identified by Dr. Weissman is "by implementing cache 704 as a write-through cache," and the "second way involves implementing data circuit 720—which, like cache 704, is also a cache memory—as a write-back cache with a specific cache coherence protocol." Ex. 1003 ¶¶ 116, 119. By contrast, Petitioner identifies only one way in which Shigeeda allegedly discloses cache coherency: "Shigeeda uses an 'automatic write,' or a 'cache flush,' of the write-back cache block to 'reestablish coherency' in its system." Pet. 48 (citing Ex. 1005, Abstract, 42:38–47). This appears to correspond to the second way identified by Dr. Weissman, who testifies that, "[u]pon the write-back cache being full of modified data, an 'automatic write' to main memory—also called a 'cache flush'—is performed to 'reestablish coherency.'" Ex. 1003 ¶ 121 (citing Ex. 1005, Abstract, 31:65–32:20, 42:38–59). Thus, it is unclear what relevance, if any, Dr. Weissman's

testimony regarding the first cache coherency theory has to the arguments in the Petition. Additionally, with respect to Petitioner's contentions as to how the bus bridge allegedly operates to maintain cache coherency, as explained in the Decision on Institution, "Petitioner cites five columns and two figures from Shigeeda without any further explanation in the Petition specifying the relevance or significance of this cited evidence." Dec. on Inst. 21. This lack of clarity as to Petitioner's contentions highlights the problem with naked citations to lengthy portions of the evidence without accompanying explanations.

As to Petitioner's argument that our Decision on Institution "implied that the substance of the testimony in paragraphs 112-129 should have been included in the Petition itself" (Req. Reh'g 9), what is included in a petition is up to the petitioner, of course. However, as we stated in our Decision on Institution, "[a] declaration in support of a petition may be proffered as evidence in support of an argument made in the petition," but it "is not a vehicle through which a petitioner may make an argument that should have been made in the petition." Dec. on Inst. 22. We analyzed the arguments made in the Petition as to claims 4, 9, and 13, and we did not find them sufficiently persuasive to demonstrate a reasonable likelihood of prevailing in *inter partes* review for the reasons explained in our Decision. See Dec. on Inst. 19-24. Thus, the citation to a lengthy passage of a declaration did not overcome insufficient argument and explanation in the Petition.

CONCLUSION

Petitioner has not carried its burden of demonstrating we misapprehended or overlooked any matters in our Decision denying

IPR2017-00814
Patent 6,766,389 B2

institution of *inter partes* review of claims 4, 9, and 13. 37 C.F.R.
§ 42.71(d).

For the foregoing reasons, Petitioner's Request for Rehearing is
denied.

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