

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NVIDIA CORPORATION,
Petitioner,

v.

POLARIS INNOVATIONS LIMITED,
Patent Owner.

Case IPR2017-01819
Patent 7,124,325 B2

Before SALLY C. MEDLEY, BARBARA A. PARVIS, and
MONICA S. ULLAGADDI, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
35 U.S.C. § 314(a); 37 C.F.R. § 42.108

I. INTRODUCTION

NVIDIA Corporation (“Petitioner”) filed a Petition for *inter partes* review of claims 14, 16–18, and 20 (“the challenged claims”) of U.S. Patent No. 7,124,325 B2 (Ex. 1001, “the ’325 Patent”). Paper 2 (“Pet.”). Polaris Innovations Limited (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

Upon consideration of the Petition, the Preliminary Response and the supporting evidence, we exercise our discretion to deny institution of trial on this Petition under 35 U.S.C. § 314(a) and 37 C.F.R. § 42.108(a). Accordingly, we do not institute an *inter partes* review as to any of the challenged claims of the ’325 Patent.

A. *Related Matters*

The parties state that the ’325 Patent is the subject of a pending lawsuit that includes assertions against Petitioner. Pet. 74; Paper 3 (“Patent Owner’s Initial Mandatory Notices”), 2–3. Patent Owner identifies a lawsuit pending in the Northern District of California, i.e., *Polaris Innovations Ltd. v. Dell Inc.*, Case No. 4:16-cv-07005 (N.D. Cal.).¹ Patent Owner’s Initial Mandatory Notices, 2–3.

Petitioner previously challenged claims 1–20 of the ’325 Patent in IPR2017-00382 (“the 382 IPR”). Pet. 74. Institution was denied in the 382

¹ This lawsuit is referred to herein as the “companion district court lawsuit.” The companion district court lawsuit was transferred from the United States District Court for the Western District of Texas on December 5, 2016. *Id.* That case was *Polaris Innovations Ltd. v. Dell Inc.*, Case No. 5:16-cv-00451 (W.D. Tex.). Pet. 74; Patent Owner’s Initial Mandatory Notices, 2.

IPR on June 23, 2017. See Ex. 1006 (Decision denying institution of *inter partes* review in the 382 IPR).

B. The '325 Patent

The '325 Patent is directed to trimming interface devices on semiconductor devices. Ex. 1001, 1:10–12. Figure 3 of the '325 Patent is reproduced below.

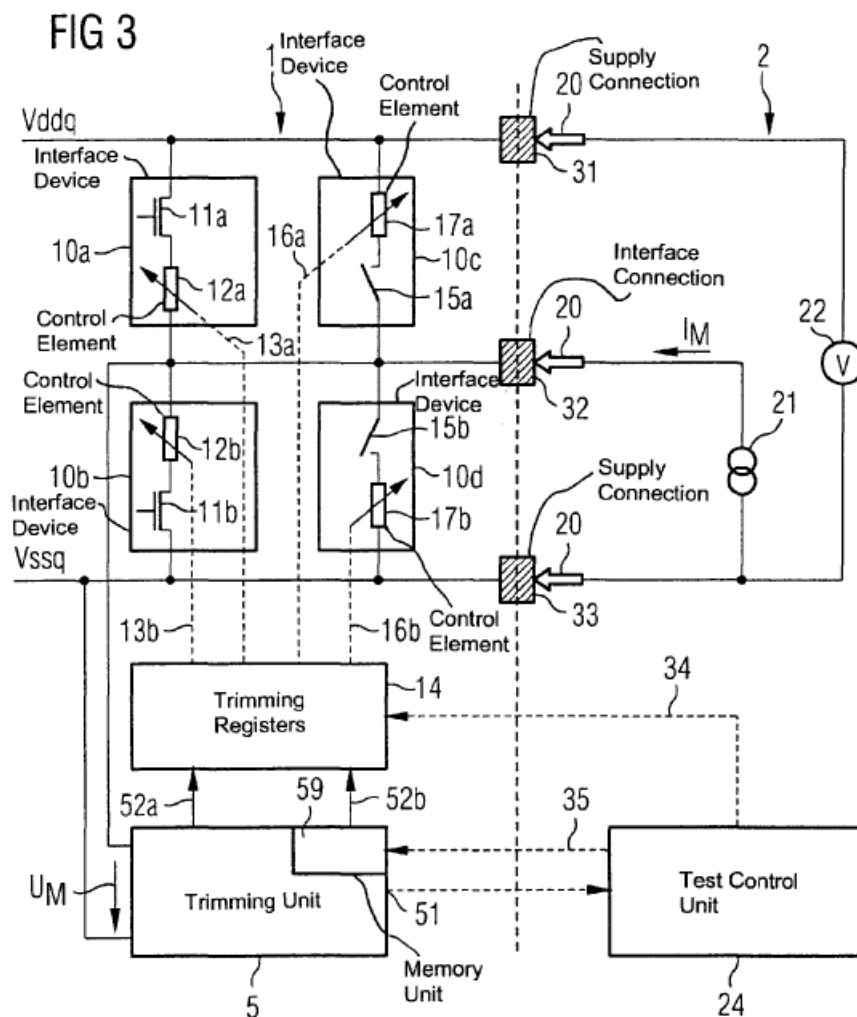


Figure 3 illustrates a schematic diagram of a configuration for trimming interface devices in a semiconductor device.

As shown in Figure 3 above, semiconductor device 1 includes trimming unit 5 that is connected to interface devices 10a–10d in a driver device. *Id.* at 7:61–8:6. Trimming unit 5 is connected to test control unit 24 in test apparatus 2. *Id.* at 8:8–9. Control path 34 connects test apparatus 2 to trimming register 14. *Id.* at 8:10–11.

C. Illustrative Claim

Petitioner challenges claims 14, 16–18, and 20 of the '325 Patent. Pet. 1. Claim 14 is an independent claim. Claims 16–18 and 20 depend, directly or indirectly, from claim 14. Independent claim 14, reproduced below, is illustrative of the claimed subject matter:

14. A semiconductor device comprising:
at least one interface device having a settable control element;
a trimming register connected to said control element; and
a trimming unit for writing to said trimming register based on a measured variable detected on said interface device;
said trimming unit connected to said interface device and said trimming register.

Id. at 10:26–34.

D. Asserted Grounds of Unpatentability

Petitioner asserts that claims 14, 16–18, and 20 are unpatentable, under 35 U.S.C. § 103(a), based on the following grounds (Pet. 1–2):

Reference(s)	Basis	Challenged Claims
Volk 450 ²	§ 102(e)	14 and 16–18
Volk 105 ³	§ 102(b), (e), (a)	14, 16, and 17
Volk 450 and Hiraki ⁴	§ 103(a)	14, 16–18, and 20
Volk 105 and Hiraki	§ 103(a)	14, 16–18, and 20

II. ANALYSIS

A. *Discretionary Non-Institution*

Patent Owner argues Petitioner used the Preliminary Response in the 382 IPR⁵ and the Decision Denying Institution from the 382 IPR⁶ “as a roadmap to mount new challenges to the same claims and has done so without offering any reasonable explanation or justification for why it deserves to have a second chance to attack the ’325 Patent.” Prelim. Resp. 16–17. Patent Owner characterizes the Petition in the instant proceeding as a “follow-on” Petition and argues it poses an inequity to Patent Owner. *Id.* at 22. Consistent with Patent Owner’s contentions (*id.* at 1–2), the 382 IPR petition presented two challenges to each of claims 1–20 of the ’325 Patent (382 Pet. 1) and the instant Petition presents four additional challenges to

² U.S. Patent No. 6,693,450 B1, issued Feb. 17, 2004 (Ex. 1004) (“Volk 450”).

³ U.S. Patent No. 6,356,105 B1, issued Mar. 12, 2002 (Ex. 1005) (“Volk 105”).

⁴ U.S. Patent No. 6,201,733 B1, issued Mar. 13, 2001 (Ex. 1008) (“Hiraki”).

⁵ IPR2017-00382, Paper 7 and submitted as Exhibit 1007 in the instant proceeding.

⁶ IPR2017-00382, Paper 10 and submitted as Exhibit 1006 in the instant proceeding.

independent claim 14 and at least two additional challenges to claims 16–18 and 20 of the '325 Patent (Pet. 1).

Petitioner contends that each of the grounds in the instant proceeding is distinct and different from each other and the grounds set forth in the earlier challenge and, therefore, the grounds are not redundant. Pet. 70–71. Petitioner, additionally, contends that the art presented in the instant Petition “addresses the Board’s previous construction of the term ‘interface device’” and presents “little to no risk of inequity” to Patent Owner. *Id.* at 71.

Institution of *inter partes* review is discretionary. *See* 35 U.S.C. § 314(a) (authorizing institution of an *inter partes* review under particular circumstances, but not requiring institution under any circumstances); 37 C.F.R. § 42.108(a) (“the Board *may* authorize the review to proceed”) (emphasis added); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (explaining that under § 314(a), “the PTO is permitted, but never compelled, to institute an IPR proceeding”). In assessing the equities of allowing Petitioner’s second challenge to certain claims of the '325 Patent, multiple factors, as discussed below, weigh in favor of denying institution of the present Petition under § 314(a) in light of the specific facts of this case. *See General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, Case IPR2016-01357, slip op. at 15–19 (PTAB Sept. 6, 2017) (Paper 19) (“*General Plastic*”) (Section II.B.4.i designated as precedential) (citing *NVIDIA Corp. v. Samsung Elec. Co.*, IPR2016-00134, slip op. 6–7 (PTAB May 4, 2016) (Paper 9)).

1. *First Factor: Petitioner Previously Filed a Petition Challenging All of the Claims Presently Challenged*

Petitioner previously challenged claims 1–20 of the '325 Patent in the 382 IPR. 382 Pet. Patent Owner filed a preliminary response in that case. Ex. 1007. We denied institution of the 382 IPR petition, determining, for example, that Petitioner had not established a reasonable likelihood that it would prevail in showing that independent claim 14 was unpatentable, under 35 U.S.C. § 103(a), over the combinations of (1) Tanaka and Ikehashi; and (2) Garrett and Hassoun. Ex. 1006, 12–17, 19–29.

In the present Petition, Petitioner challenges claims 14, 16–18, and 20 of the '325 Patent (Pet. 1–2), which are a subset of the claims challenged in the 382 IPR petition (382 Pet. 1). Thus, all of the claims challenged in this Petition were challenged by the same petitioner in the previous petition.

2. *Second Factor: Petitioner Knew, or Should Have Known, of the Asserted Prior Art When Filing the Previous Petition*

In determining whether to institute review based on subsequent petitions challenging the same claims of the same patent, we look to whether the petitioner knew, or should have known, of the prior art asserted in its later petition when it filed the earlier one. *See Conopco, Inc. v. Proctor & Gamble Co.*, Case IPR2014-00506, slip op. at 4–5 (PTAB Dec. 10, 2014) (Paper 25) (informative). Petitioner contends that the Petition in the instant proceeding “is based on different art” than was asserted in the 382 IPR. Pet. 71.

The relevant question under the second factor is whether Petitioner knew or should have known of the asserted prior art, i.e., Volk 450, Volk 105, and Hiraki at the time of filing its 382 IPR petition (December 19,

2016). Each of Volk 450, Volk 105, and Hiraki is a U.S. Patent, which consistent with Patent Owner's contentions (Prelim. Resp. 18), was published more than 12 years, 14 years, and 15 years, respectively, before the filing date of the first Petition. See Ex. 1004, [45]; Ex. 1005, [45]; Ex. 1008, [45]. Petitioner does not indicate whether it knew of the asserted prior art when it filed the 382 IPR petition. Pet. 70–72. Even if Petitioner did not know of these references, Petitioner did not provide any explanation as to why these references could not have been found with a reasonably diligent search at the time of the earlier petition. See *General Plastic*, slip op. at 11 (“Petitioner . . . provided no explanation why it could not have found this new prior art earlier—prior to filing the first-filed petitions—through the exercise of reasonable diligence.”), 19–20 (“the record is devoid of any explanation why Petitioner could not have found the newly asserted prior art in any earlier search(es) through the exercise of reasonable diligence”).

3. *Third Factor: Petitioner Had the Benefit of Patent Owner's Preliminary Response and the Board's Decision on Institution in the 382 IPR When Filing the Present Petition*

Importantly, Petitioner had the benefit of knowing and learning from the arguments made by Patent Owner in the 382 IPR when it filed the present Petition. Patent Owner filed its preliminary response in the 382 IPR on April 4, 2017. See Ex. 1007, 69. We issued our Decision Denying Institution of *Inter Partes* Review in the 382 IPR on June 23, 2017. Ex. 1006, 1. Thus, when Petitioner filed the present Petition on July 25, 2017, Petitioner had access to both Patent Owner's preliminary response in the 382

IPR and our Decision Denying Institution of an *inter partes* review in the 382 IPR.

The elapsed time between when Petitioner had Patent Owner's Preliminary Response and the Decision Denying Institution addressing the 382 IPR petition and when Petitioner filed the present Petition provided Petitioner sufficient time to take advantage of Patent Owner's responses and the Board's findings and conclusions with respect to the 382 IPR petition. When Petitioner filed the present Petition on July 25, 2017, it had Patent Owner's preliminary response to the 382 IPR petition for over three months, and our Decision Denying Institution addressing the 382 IPR petition for over one month. *See* Ex. 1007, 69; Ex. 1006, 1. Thus, Petitioner not only had relevant information from Patent Owner and the Board when it filed the present Petition, but had ample time to take advantage of that information in drafting the present Petition.

4. *Fifth Factor: Petitioner Has Not Provided an Adequate Reason Why We Should Permit This Later Attack on the Claims of the '325 Patent*

Petitioner contends that we denied institution in the 382 IPR because we “agreed with the Patent Owner’s construction of the term ‘interface device’” and the Petition in the instant proceeding “addresses” our construction of the term “interface device” in the 382 IPR that Petitioner “could not have known about.” Pet. 71. Petitioner, however, was aware when it filed the petition in the 382 IPR that claim construction is always an issue. 37 C.F.R. § 42.104(b)(3). Also, we explained in our Decision in the 382 IPR, we were persuaded based on the “consistent usage” of the term “interface device” in the '325 Patent Specification and we set forth our

analysis of the usage of that term throughout the '325 Patent Specification in our Decision. Ex. 1006, 8–10.

Furthermore, as we explained in the Decision in the 382 IPR, Petitioner did not offer contrary guidance, explicitly or implicitly, as to how “interface device” should be interpreted and, instead, identified examples of interface devices in the '325 Patent Specification that are consistent with the construction adopted in the 382 IPR Decision. *Id.* Indeed, as we explained, “Petitioner acknowledges that output drivers and terminations are exemplary ‘interface devices’ contending ‘[i]nterface devices, like output drivers and terminations [], have parameters that affect reading and writing from a data bus.’” Ex. 1006, 8 (alteration in original) (citing 382 IPR Pet. 3). We further noted that “[a]dditionally, Dr. Tredennick testifies that ‘interface devices include output drivers and terminations.’” *Id.* (citing 382 IPR Ex. 1002 ¶ 16). We, therefore, are not persuaded that Petitioner could not have known about the broadest reasonable interpretation of “interface device” based on the consistent usage of that term in the '325 Patent Specification, consistent with the examples identified by Petitioner.

Petitioner also contends that the instant Petition “challenges a smaller subset” of the claims challenged in the 382 IPR petition. Pet. 71. As we indicated in the 382 IPR Decision, with respect to one of the grounds, the 382 IPR petition “lacks a requisite showing” that components identified in the Petition “are associated with an interface.” Ex. 1006, 16–17. With respect to the second of the grounds, we noted that certain of Petitioner’s contentions were “conclusory” and Petitioner did not provide “sufficient explanation as to which of the prior art teachings applies or why and how

one having ordinary skill in the art would have combined or modified the different teachings identified by Petitioner.” *Id.* at 26–28.

Petitioner’s strategy of challenging a smaller subset of claims and modifying its asserted art and argument based on Patent Owner’s contentions and our Decision Denying Institution in the 382 IPR imposes inequities on Patent Owner. Furthermore, we are not persuaded that the determination regarding the broadest reasonable interpretation of “interface” was unexpected and, instead, that determination was consistent with Petitioner’s implicit claim construction in its contentions regarding that term.

B. Summary

In sum, the factors discussed above support denying institution of the Petition, and we determine that none of the other factors discussed in *General Plastic* favor institution. Given the circumstances present in this case, we determine that Petitioner used Patent Owner’s preliminary response and our previous decision denying institution in the 382 IPR as a “roadmap” to modify the grounds asserted and the arguments made in the Petition, which is unfair to Patent Owner, and is an inefficient use of the Board’s time and resources. We, thus, exercise our discretion to deny institution of the Petition.

III. CONCLUSION

For the foregoing reasons, we exercise our discretion under 35 U.S.C. § 314 and 37 C.F.R. § 42.108(a) not to institute review of claims 14, 16–18, and 20 of the ’325 Patent.

IV. ORDER

Accordingly, it is:

ORDERED that the Petition is *denied*.

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