

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PNY TECHNOLOGIES, INC.,
Petitioner,

v.

PHISON ELECTRONICS CORP.,
Patent Owner.

Case IPR2013-00472¹
Patent 7,518,879 B2

Before KEVIN F. TURNER, STEPHEN C. SIU, and RAMA G. ELLURU,
Administrative Patent Judges.

TURNER, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
Inter Partes Review
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

¹ Case IPR2014-00150 has been joined with this proceeding.

I. INTRODUCTION

PNY Technologies, Inc. (“PNY”) filed a Petition (“1st Pet.,” Paper 2) requesting *inter partes* review of claims 1–4, 8–12, and 16 of U.S. Patent No. 7,518,879 B2 (“the ’879 Patent”). Patent Owner Phison Electronics Corp. (“Phison”) filed a Preliminary Response thereto (Paper 7). On February 4, 2014, we instituted an *inter partes* review of claims 1–4, 8–12, and 16 on multiple grounds of unpatentability alleged in the Petition. Paper 10 (“1st Dec.”). PNY also filed a second Petition (“2nd Pet.,” Paper 1, IPR2014-00150), alleging other grounds, and Phison filed a Preliminary Response thereto (Paper 6, IPR2014-00150). On April 28, 2014, we instituted an *inter partes* review of claims 1–21 on multiple grounds of unpatentability alleged in the second Petition. (“2nd Dec.,” Paper 8, IPR2014-00150). We granted a joint motion for joinder (Paper 7, IPR2014-00150), joining the IPR2014-00150 case with the IPR2013-00472 case (Paper 9, IPR2014-00150).

After institution of trial, Phison filed a Patent Owner Response (PO Resp.,” Paper 24) and PNY filed a Reply thereto (“Reply,” Paper 29). An oral argument was held on November 12, 2014. The transcript of the consolidated hearing has been entered into the record. “Tr.,” Paper 36.

We have jurisdiction under 35 U.S.C. § 6(c). This final written decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

PNY has shown by a preponderance of the evidence that claims 1–21 of the ’879 Patent are unpatentable.

A. The '879 Patent (Ex. 1001)

The '879 Patent relates to a Universal Serial Bus (USB) memory device. Ex. 1001, Abs. As context for the figures reproduced below, the upper portion of the connector illustrated in Figs. 5 and 6 would be part of the “male” USB connector that is inserted into a “female” USB socket.

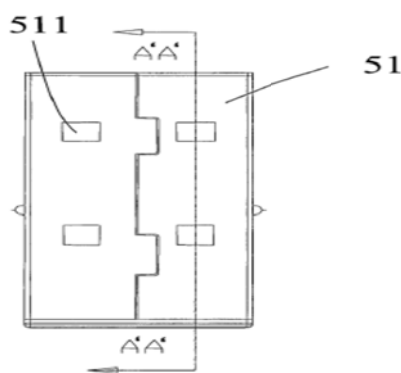


Fig. 5

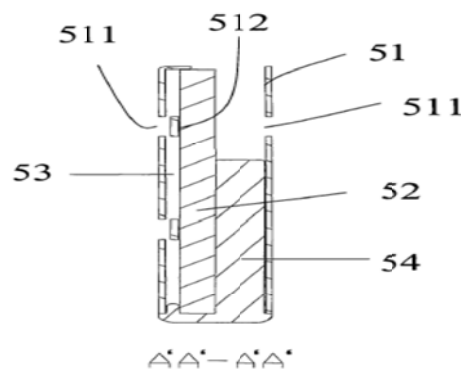


Fig. 6

Figs. 5 and 6 illustrate a USB memory apparatus

The USB memory apparatus includes housing 51 having a plurality of orientated indentations 511 and a plurality of concave props 512, wherein the plurality of orientated indentation facilitates the USB memory apparatus to be connected through insertion into the female USB socket. Ex. 1001 at 4:14–27. The apparatus also includes print circuit board assembly (PCBA) 52 disposed in the housing with end base 54, wherein the PCBA is fixed by means of pressing of the plurality of concave props 512 and forms space 53 between the housing and the PCBA. *Id.*

B. Illustrative Claim

The '879 Patent includes claims 1–21, and a trial was instituted on all of those claims. Claims 1, and 9, and 17 are independent claims.

Independent claim 1 is reproduced below (with emphases):

1. A Universal Serial Bus (USB) memory plug,
comprising:

a housing having a plurality of orientated indentations and a *plurality of concave props*, wherein said plurality of orientated indentation facilitates said USB memory plug to be connected while said USB memory plug is inserted into a female USB socket; and a print circuit board assembly (PCBA) disposed in said housing, wherein said *PCBA is fixed by means of pressing of said plurality of concave props*, and a space is formed between said housing and said PCBA.

C. Prior Art Relied Upon

PNY relies upon the following prior art references in its alleged grounds of unpatentability:

Takahashi	US 2004/0027809 A1	June 13, 2007	Ex. 1006
Minneman	US 7,352,601 B1	Apr. 1, 2008	Ex. 1003
Elbaz	US 2004/0259423 A1	Dec. 23, 2004	Ex. 1003 ²
Deng	US 6,829,672 B1	Dec. 7, 2004	Ex. 1004 ²

Admitted Art – the Background of the Invention section of the '879 Patent (Ex. 1001, 1:41–52; Fig. 1; 1:10–2:26).

² The cited exhibit numbers come from exhibits in the IPR2014-00150 proceeding.

D. Grounds of Unpatentability Instituted for Trial

The following table summarizes the challenges to patentability that were instituted for *inter partes* review³:

References	Basis	Claims challenged
Minneman and Takahashi	§ 103	1–4, 8–12, and 16
Elbaz and Deng	§ 103	1, 3–9, and 11–21
Elbaz, Deng, and Admitted Art.	§ 103	2 and 10

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b). Claim terms also are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech, Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

Concave Prop

The claim term “concave prop” is recited in independent claims 1, 9, and 17. We determined, in the Decision to Institute, that “concave prop” means “a structure curving inwards from a housing providing support.” 2nd Dec. 8. Phison disputes this construction, arguing that “concave” must

³ An anticipation ground over Minneman was also part of the instituted grounds (1st Dec. 16), but was later removed as a ground of the trial. Paper 16, 3.

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