

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTERNATIONAL BUSINESS MACHINES CORPORATION and
ORACLE AMERICA, INC.,
Petitioner,

v.

ELECTRONICS AND TELECOMMUNICATIONS RESEARCH
INSTITUTE,
Patent Owner.

Case IPR2014-00976
Patent 6,978,346

Before BRIAN J. McNAMARA, MIRIAM. L. QUINN, and
GREGG I. ANDERSON, Administrative *Patent Judges*.

QUINN, *Administrative Patent Judge*.

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

INTRODUCTION

The Board declined to initiate *inter partes* review of U.S. Patent No. 6,978,346. Paper 14, (“Dec.”). Petitioner filed a Request for Rehearing contending that the Board abused its discretion in declining to institute review because two “findings regarding Chong’s disclosures” were “erroneous, misapprehending and/or overlooking pertinent disclosures.” Paper 15, (“Req. for Reh’g”) 1.

We have reviewed Petitioner’s contentions presented in the Request for Rehearing and we are not persuaded that Petitioner has pointed out that we misapprehended or overlooked Chong’s pertinent disclosures. In our Decision on Institution we explained that we were persuaded by Patent Owner’s analysis and conclusions regarding whether Chong disclosed identical data written to each of two data storage devices. Dec. 7–9. Petitioner now argues that Patent Owner’s arguments were “misleading, [and] misrepresenting Chong’s disclosures.” Req. for Reh’g 2. In an attempt to explain the shortcomings of Patent Owner’s arguments, Petitioner recasts its argument to point to a “different data flow” allegedly presented in the Petition. *Id.* These explanations, however, do not show that we overlooked or misapprehended the evidence presented in the Petition.

First, Petitioner cites in its Request for Rehearing numerous citations and paragraphs of allegedly supporting materials that were neither cited nor explained in the Petition for the contention that Chong discloses a RAID. *See, e.g.*, Paper 1 (“Pet.”) 12–15 (citing exclusively to Dr. Katz’s Declaration, Ex. 1001 ¶¶ 36–37, 40); *Cf.* Req. for Reh’g 2 (citing to Ex. 1001 ¶¶ 36, 40, 42, 48, 50, 57, 60, 63, 93, 95). A Request for Rehearing is

not an opportunity to expand argument or explain allegedly supporting facts otherwise not presented *in the Petition*.

Notwithstanding the expanded explanations presented for the first time in the Request for Rehearing, we are not persuaded that we misapprehended the operation of Chong. At the heart of the issues raised by Petitioner is the allegation that Chong transfers identical data to both data storage devices. Req. for Reh'g 3–5, 8–12. Patent Owner alleged, and we agreed, that although Chong teaches caching the data at the controllers, Chong does not disclose that data is written from the controller 116 to the data storage device 125. *See* Dec. 8; Prelim. Resp. 32. There is no express disclosure in Chong of writing identical data to both data storage devices in either Figure 3 or Figure 4. Neither can we infer from the citations in Chong that Petitioner proffers in its Request for Rehearing that identical data is written to both data storage devices in either Figure 3 or 4. For example, Petitioner points to Chong's disclosures in Ex. 1005, 3:16–22, 25–30, 34–40, and 4:26–29. These disclosures, at best, show that identical data is cached at each of controllers 16, 22 because both controllers receive the same data in a fiber channel loop. But Chong states that “[f]rames addressed to data storage device 24 are passed through PSOC 62 via cache 66 [, i.e., controller 16].” Ex. 1005, 3:36–38. There is no disclosure of the same data being passed through controller 22 to the data storage device 24 in any of the proffered citations, ergo no “data mirroring” occurs. Chong also states, with reference to Figure 3, that “each of controllers 116 and 122 is equivalent to the combination of primary and secondary controllers 16 and 22 in FIG. 1.”

Ex. 1005, 4:26–28. Again, controllers 116 and 122 cache the same data, but they do not write identical data to their respective data storage devices.

Indeed, without an express disclosure of the identical writing operation Petitioner alleges, it makes no sense to read Chong as writing identical data to both storage devices. For example, Chong discloses that when a primary controller fails, the secondary controller with the cached data takes over the writing function to the *same* data storage device. *See* Ex. 1005, 4:59–67 (explaining that the host continues to write to data storage device 125, regardless of which controller actually performs the service). That is, there is no need to copy data to another data storage device because the data storage device assigned to the host continues to serve that host, even though a different controller may service the host in the event of a failure. Accordingly, Petitioner has not persuaded us that the panel misapprehended or overlooked Chong’s disclosures alleged to support Petitioner’s contention that “data mirroring” is supported by Chong.

Furthermore, disagreements with the Board’s conclusions are not a basis for alleging that the Board misapprehended or overlooked the arguments and evidence presented. We analyzed the facts as presented by both parties, and Patent Owner’s arguments regarding Chong were persuasive. The Request for Rehearing starts with a premise that Patent Owner mischaracterized Chong, and asks us to conclude that Petitioner’s proffered version of Chong is better supported. We disagree with Petitioner’s premise, and further conclude that Petitioner has not met its burden of showing that we should modify our decision based on the arguments presented in the Request for Rehearing.

We also have considered Petitioner’s argument that Chong discloses fail-over of data storage devices, a fact that Petitioner contends we misapprehended or overlooked. Req. for Reh’g 12–13. Again, upon review of Chong, we agreed with Patent Owner that Chong’s disclosure of fail-over operation of the controllers does not support the contention that Chong also discloses a fail-over operation for the data storage devices. Dec. 9. The Request for Rehearing points out that Chong states that the disclosed fail-over operation also applies to failure of data storage devices. Req. for Reh’g 12. But we did not misapprehend or overlook this disclosure, for we noted this in our Decision by stating that: “Even if we consider that Chong summarily states that the disclosed fail-over operation also ‘applies if one of the data storage devices 124 and 125 fails . . . the conclusion reached by Dr. Katz is based on a combination of ‘data mirroring’ and ‘fault tolerance’—a combination that we are not persuaded has been shown sufficiently.” Dec. 9. Contrary to Petitioner’s assertion, we did not misapprehend the “significance” of the cited Chong disclosures. *See* Req. for Reh’g 12–13 (citing Ex. 1005, 3:3–6, 4:28–32, 5:2–3). We were not persuaded that these disclosures amount to *sufficient* evidence¹ amounting to a reasonable likelihood that Petitioner would prevail when considering the evidence presented by the Petition and the arguments made in the Patent Owner Preliminary Response.

¹ We noted in our Decision on Institution that Patent Owner presented arguments regarding the conclusory opinions of Dr. Katz on the point of fault tolerance. Dec. 9 (citing Prelim. Resp. 37–38).

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.