

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

LG ELECTRONICS, INC., LG ELECTRONICS U.S.A., INC. AND LG  
ELECTRONICS MOBILECOMM U.S.A, INC.

Petitioner,

v.

CYPRESS SEMICONDUCTOR CORP.,

Patent Owner

---

Case No. IPR2014-01405

Patent 6,493,770

---

Before Amy Kattula, Trial Paralegal

**PATENT OWNER'S PRELIMINARY RESPONSE**

TABLE OF CONTENTS

	<u>Page</u>
I. Introduction and Statement of Relief Requested.....	1
II. The Board Should Deny <i>Inter Partes</i> Review on Petitioner’s Multiple Grounds of Invalidity.....	2
A. Petitioner fails to articulate why the multiple grounds of purported invalidity are not redundant, the differences between the grounds, and the differences among the references underlying the grounds.....	4
III. Petitioner’s Asserted USB References Are Defective .....	7
A. Petitioner impermissibly relies on “admitted prior art” as a primary reference .....	7
1. Petitioner’s citation to “admitted prior art” as to Grounds 1 and 2 does not fall within a recognized exception .....	9
2. The portions of the ‘770 Patent cited by Petitioner in Grounds 1, 2 and 4 do not qualify as “admitted prior art” .....	12
B. Patent Owner intends to swear behind the Yap reference .....	17
IV. Petitioner Fails To Establish a <i>Prima Facie</i> Case of Obviousness to Support its Proposed Grounds 2 and 4 .....	18
V. Proceeding on Grounds Based Solely on the PCMCIA References Would Realize Efficiencies across all of Petitioner’s Related Petitions for <i>Inter Partes</i> Review .....	22
VII. Conclusion .....	28

## TABLE OF AUTHORITIES

	<u>Page(s)</u>
<b>CASES</b>	
<i>Carestream Health, Inc. v. Smartplates, LLC</i> , Case No. IPR2013-00600 (Paper 9, March 5, 2014).....	10
<i>Chimei Innolux Corp. v. Semiconductor Energy Lab. Co., Ltd.</i> , Case No. IPR2013-00038 (Paper 9, March 21, 2013).....	9
<i>Constant v. Advanced Micro-Devices Inc.</i> , 848 F.2d 1560 (Fed. Cir. 1988) .....	13
<i>In re Lopresti</i> , 333 F.2d 932 (CCPA 1964).....	13
<i>Intellectual Ventures Mgmt., LLC v. XILINX, Inc.</i> , Case No. IPR2012-00023 (Paper 35, February 11, 2014).....	11
<i>KSR Int’l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (U.S. 2007).....	16, 18, 19
<i>Liberty Mut. Ins. Comp. v. Progressive Ins. Comp.</i> , Case No. CBM2012-00003 (Paper 8, October 25, 2012).....	4
<i>Mintz v. Dietz &amp; Watson, Inc.</i> , 679 F.3d 1372 (Fed Cir. 2012) .....	16
<i>Nichia Corp. v. Emcore Corp.</i> , Case No. IPR2012-00005 (Paper 68, February 11, 2014).....	10
<i>Oracle Corp. v. Clouding IP, LLC</i> , IPR2013-00075 (Paper 15, June 13, 2013).....	5
<i>Riverwood Int’l Corp. v. R.A. Jones &amp; Co.</i> , 324 F.3d 1346 (Fed. Cir. 2003) .....	13
<i>Zoll Lifecor Corp. v. Koninklijke Philips Elecs. N.V.</i> , Case No. IPR2103-00616 (Paper 14, Jan. 13, 2014).....	23
<b>STATUTES</b>	
35 U.S.C. § 102(a) .....	8

35 U.S.C. § 102(b) .....9  
35 U.S.C. §103 .....18, 19, 24  
35 U.S.C. § 311(b) .....*passim*  
35 U.S.C. § 312(a) and § 312(b) .....11  
35 U.S.C. § 314 .....28  
35 U.S.C. § 326(b) .....4

**OTHER AUTHORITIES**

37 C.F.R. § 42.1(b) .....4, 28  
37 C.F.R. § 42.107(a) .....1  
157 Cong. Rec. S1350 (daily ed. March 8, 2011) .....28  
Manual of Patent Examining Procedure § 2129 .....13  
Manual of Patent Examining Procedure § 2143(I) .....19  
Patent and Trademark Office, Office Patent Trial Practice Guide  
(published in Fed. Reg. Vol. 77, No. 157, August 14, 2012) .....2

## LIST OF EXHIBITS

Exhibit No.	Description
2001	U.S. Patent No. 6,012,103 to Sartore et al. (filed on July 2, 1997) (issued on January 4, 2000)
2002	Petition To Institute an <i>Inter Partes</i> Review of U.S. Patent No. 6,012,103 (Case No. IPR2014-01386)
2003	U.S. Patent No. 6,249,825 to Sartore et al. (filed on January 4, 2000) (issued on June 19, 2001)
2004	Petition To Institute an <i>Inter Partes</i> Review of U.S. Patent No. 6,249,825 (Case No. IPR2014-01396)
2005	Patent and Trademark Office, Office Patent Trial Practice Guide (published in Fed. Reg. Vol. 77, No. 157, August 14, 2012)
2006	<i>Liberty Mut. Ins. Comp. v. Progressive Ins. Comp.</i> , Case No. CBM2012-00003 (Paper 8, October 25, 2012)
2007	<i>Oracle Corp. v. Clouding IP, LLC</i> , IPR2013-00075 (Paper 15, June 13, 2013)
2008	<i>Chimei Innolux Corp. v. Semiconductor Energy Lab. Co., Ltd.</i> , Case No. IPR2013-00038 (Paper 9, March 21, 2013)
2009	<i>Nichia Corp. v. Emcore Corp.</i> , Case No. IPR2012-00005 (Paper 68, February 11, 2014)
2010	<i>Carestream Health, Inc. v. Smartplates, LLC</i> , Case No. IPR2013-00600 (Paper 9, March 5, 2014)
2011	<i>Intellectual Ventures Mgmt., LLC v. XILINX, Inc.</i> , Case No. IPR2012-00023 (Paper 35, February 11, 2014)
2012	<i>Zoll Lifecor Corp. v. Koninklijke Philips Elecs. N.V.</i> , IPR2013-00616 (Paper 14, January 13, 2014)

# 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.