Trials@uspto.gov
571.272.7822

Paper No. 18
Filed: July 21, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC., HTC CORPORATION, HTC AMERICA, INC.,
SAMSUNG ELECTRONICS CO. LTD,
SAMSUNG ELECTRONICS AMERICA, INC., and
AMAZON.COM, INC.,
Petitioner,

v.

MEMORY INTEGRITY, LLC,
Patent Owner.

Case IPR2015-00159
Patent 7,296,121 B2

Before JENNIFER S. BISK, NEIL T. POWELL, and KERRY BEGLEY, *Administrative Patent Judges*.

BEGLEY, *Administrative Patent Judge*.

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

Apple Inc., HTC Corporation, HTC America, Inc., Samsung Electronics Co. Ltd., Samsung Electronics America, Inc., and Amazon.com, Inc. (collectively, "Petitioner") timely filed a request for

rehearing of our decision on institution of *inter partes* review ("Rehearing Request"). Paper 14 ("Req. Reh'g"). The request seeks rehearing of our determination to deny institution of *inter partes* review of claim 12 of U.S. Patent No. 7,296,121 B2 (Ex. 1001, "the '121 patent") on the asserted ground of anticipation by U.S. Patent Application Publication No. 2002/0053004 A1 (published May 2, 2002) (Ex. 1003, "Pong"). For the reasons given below, we deny the Rehearing Request.

LEGAL STANDARDS

When rehearing a decision whether to institute *inter partes* review, we review the decision for an "abuse of discretion." 37 C.F.R. § 42.71(c). "The burden of showing [the] decision should be modified lies with the party challenging the decision." 37 C.F.R. § 42.71(d). The request for rehearing "must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in" the petition. *Id.*

DISCUSSION

Claim 12 of the '121 patent depends from claim 11, which, in turn, depends from independent claim 1. *See* Ex. 1001, 30:65–31:7, 31:49–57. Based on its dependency from claims 1 and 11, claim 12 recites "a plurality of processing nodes" "wherein each of the processing nodes is programmed to complete a memory transaction after receiving a first number of responses to a first probe." *Id.* at 30:65–66, 31:49–54. Claim 12 adds the limitation: "and the first number is one." *Id.* at 31:56–57.

The Petition argues that Pong discloses this limitation of claim 12 even though Pong's processors may wait to receive more than one response before completing a memory transaction. *See* Paper 6 ("Pet."), 33–34.

Specifically, the Petition asserts that in one example described in Pong, "the requesting processor may receive, at most, two responses." *Id.* at 33. The Petition then argues that Pong's processors "necessarily" satisfy the claim language because "'the first number is one' simply imparts a temporal requirement . . . that the memory transaction be completed *after* receiving one response." *Id.* at 34. In other words, the Petition contends that in Pong:

> [t]he requesting processor is . . . *programmed to complete a memory transaction after receiving at most, two responses* to a request . . . and, therefore, necessarily is configured to perform a memory transaction after receiving one response, since even in *the case where the requesting processor waits for the second response to complete the memory transaction*, that memory transaction is completed *after* receiving the first response.

Id. (first and second emphases added).

In our Decision, we determined that the Petition does not show sufficiently that Pong inherently discloses "after receiving a first number of responses to a first probe" "and the first number is one," as recited in claim 12. *See* Decision – Institution of *Inter Partes* Review (Paper 12, "Dec."), 23–24. Upon careful review and analysis of the claims and written description of the '121 patent, we concluded that the Petition's proposed interpretation of this limitation as encompassing processing nodes programmed to complete a memory transaction at any time after receiving one response—including after receiving two, three, four, etc. responses—was too broad to be reasonable. *Id.* at 10–13. Instead, we determined that "after receiving a first number of responses to a first probe" "wherein . . . the first number is one" means "after receiving one response—not at least one or more than one response, as Petitioner proposes." *Id.* at 13. Under this claim construction, we were not persuaded by the Petition's argument that Pong

inherently discloses claim 12, which is "premised on the possibility that Pong's processors may receive more than response to a request" before completing a memory transaction. *Id.* at 23–24. We further noted that "the Petition does not point to any evidence that Pong's processors necessarily perform a memory transaction after receiving *one* response." *Id.* at 24.

In its Rehearing Request, Petitioner argues that the Board overlooked or misapprehended the Petition's "citation" to paragraph A-22 of the Declaration of Dr. Robert Horst (Ex. 1014, "Dr. Horst Declaration") in rendering our Decision. Req. Reh'g. In this paragraph, Dr. Horst opines:

> Since Pong does not describe that the directory filter ever informs the requesting processor of the number of responses it should expect to receive, the requesting processor must necessarily be configured to complete a memory transaction as soon as it receives the first response. Otherwise, the requesting processor would have to wait for an unknown number of responses to its request.

Ex. 1014 ¶ A-22.

We acknowledge that one sentence of the Petition features, without explanation, a citation to paragraphs "A-19 to A-24," including paragraph A-22, of the Dr. Horst Declaration, and that Dr. Horst opines in paragraph A-22 that Pong's processors necessarily must be programmed to complete a memory transaction upon receiving one response. *See id.*; Pet. 32. Yet merely pointing to the Petition's citation of this paragraph of the Dr. Horst Declaration—as Petitioner does in its Rehearing Request—is insufficient to warrant rehearing of our determination to deny institution of *inter partes* review of claim 12.

Petitioner's Rehearing Request does not point us to any argument in the Petition that Pong discloses claim 12 because Pong's processors are

configured to perform a memory transaction after receiving one—as opposed to at least one or more than one—response, as required to satisfy claim 12 under the claim construction we adopted in our Decision, which Petitioner does not contest. *See* Req. Reh'g. Rather, the Rehearing Request refers only to a "citation" in the Petition to paragraph A-22 of the Dr. Horst Declaration, in which Dr. Horst states his opinion that Pong's processors must be configured to complete a memory transaction after receiving one response. *See id.*; Ex. 1014 ¶ A-22. Therefore, Petitioner has failed to show sufficiently where the relevant "matter was previously addressed" in the Petition, as required in a request for rehearing. 37 C.F.R. § 42.71(d).

In addition, Petitioner's attempt in its Rehearing Request to rely solely on a paragraph of the Dr. Horst Declaration cited in the Petition is impermissible under our rules. Specifically, 37 C.F.R. § 42.6(a)(3) prohibits incorporating arguments into the Petition by reference to other documents, and 37 C.F.R. § 42.104(b)(5) gives us discretion to "exclude or give no weight to . . . evidence" where the Petition "fail[s] to state its relevance." *See* 37 C.F.R. § 42.6(a)(3) ("Arguments must not be incorporated by reference from one document into another document."); 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.").

Even considering paragraph A-22 of Dr. Horst's testimony, we remain unpersuaded that Pong inherently discloses claim 12. This testimony, opining that Pong's processors "must necessarily be configured to complete a memory transaction *as soon as it receives the first response*," Ex. 1014 ¶ A-22 (emphasis added), is contrary to the position Petitioner takes in the

DOCKET ALARM

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.