UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC., HTC CORPORATION, HTC AMERICA, INC.,
SAMSUNG ELECTRONICS CO. LTD, SAMSUNG ELECTRONICS AMER-
ICA, INC., AMAZON.COM, INC., SONY CORP.,
SONY ELECTRONICS INC., SONY MOBILE COMMUNICATIONS AB,
SONY MOBILE COMMUNICATIONS (USA) INC.,
LG ELECTRONICS, INC., LG ELECTRONICS USA, INC., AND
LG ELECTRONICS MOBILECOMM USA, INC.,

Petitioners,

v.

MEMORY INTEGRITY, LLC,
Patent Owner.

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Case IPR2015-00159
Patent 7,296,121

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**PETITIONERS' OPPOSITION TO
PATENT OWNER MOTION TO AMEND
PURSUANT TO 37 C.F.R. § 42.23**

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EXHIBITS

APPL-1031   Opposition Declaration of Dr. Robert Horst

I. Introduction

Petitioners submit this Opposition to Memory Integrity's ("MI") Motion to Amend ("MTA") (Paper 26). The MTA should be denied for three primary reasons. First, MI failed to meet its burden of proof under 37 C.F.R. § 42.20(c) by failing to identify how the features in the proposed substitute claims are distinguished from even the prior art of record. Second, the substitute claims are not enabled. Third, the prior art combination discussed below render the substitute claims obvious.

II. MI's Motion to Amend Fails to Comply with 37 C.F.R. § 42.20(c)

MI "has the burden of proof to establish that it is entitled to the requested relief." *See* 37 C.F.R. § 42.20(c). Section 42.20(c) "places the burden on the patent owner to show a patentable distinction of each proposed substitute claim over the prior art." *Idle Free Sys., Inc. v. Bergstrom, Inc.*, Case IPR2012-00027, slip op. at 7 (PTAB June 11, 2013) (Paper 26); *Microsoft Corp. v. Proxyconn, Inc.*, No. 2014-1542, 2015 WL 3747257, at *13-14 (Fed. Cir. June 16, 2015) (affirming denial where patent owner failed to establish the patentability over the prior art of record).

Here, MI failed to meet the burden imposed by § 42.20(c) for at least two reasons. First, MI argues that, "all of the substitute claims find support in the '347 Application, [thus] the Koster reference is not prior art to any of the proposed substitute claims." MTA, p. 22. MI provides no discussion comparing Koster's teachings to the "proposed new limitations." However, claims 19-24 are not entitled to

the '347 Application's priority date. Because MI did not establish patentability of

the substitute claims over Koster, MI has not met its burden under Section

42.20(c).

More specifically, in identifying support for the limitations of original

claims 19-24, MI relies entirely upon disclosure in "the '893 App." MTA, pp. 6-8.

However, Section 1.57(c) requires "essential material" to be incorporated by refer-

ence "to a U.S. patent … which … does not itself incorporate such essential mate-

rial by reference." 37 C.F.R. § 1.57(c); *see also* 37 C.F.R. § 42.121(b)(1)(must

identify support in the original disclosure of the patent). However, here, the '893

App is incorporated by reference into U.S. Application No. 10/157,388, which is

incorporated by reference into the '347 App, which is incorporated by reference

into the '161 App (the '121 Patent's application). *See* MTA, p. 6.

In other words, the relied upon essential material that is said to support

claims 19-24 is only present in an application that requires multiple incorporation

by references before finding its way into the '161 App. For example, claim 19 re-

cites "[a]t least one computer-readable medium having data structures stored

therein representative of the probe filtering unit of claim 16." Neither, the '347

App nor the '388 App contain any description of this feature, or any of the other

features recited in claims 20-24. Therefore, claims 19-24 (and the corresponding

substitute claims) are only entitled to a priority date no earlier than the filing date

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