Trials@uspto.gov
571-272-7822

Paper No. 41
Entered: August 14, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

PARTHENON UNIFIED MEMORY ARCHITECTURE LLC,
Patent Owner.

Case IPR2016-01114
Patent 7,777,753 B2

APPLE INC., HTC CORPORATION, and HTC AMERICA, INC.
Petitioner,

v.

PARTHENON UNIFIED MEMORY ARCHITECTURE LLC,
Patent Owner.

Case IPR2016-01121 (Patent 5,960,464)[1]
Case IPR2016-01135 (Patent 5,812,789)[2,3]

[1] IPR2017-00513 has been joined to this proceeding.
[2] IPR2017-00512 has been joined to this proceeding.
[3] This Order addresses an issue that is identical in all three cases. We, therefore, exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

Before JAMES B. ARPIN, MATTHEW R. CLEMENTS, and SUSAN L. C. MITCHELL, *Administrative Patent Judges*.

CLEMENTS, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

I. INTRODUCTION

On August 11, 2017, a teleconference was held between counsel for Petitioner, counsel for Patent Owner, and Judges Zecher, Arpin, and Clements. The panel requested the call to discuss the effects of our recent Final Written Decisions ("FWDs") in IPR2016-00923 and IPR2016-00924 on the ongoing proceedings in IPR2016-01121 and IPR2016-01135, and on the parties' outstanding requests for oral hearing in IPR2016-01114, IPR2016-01121, and IPR2016-01135. *See, e.g.*, IPR2016-01121, Paper 7, 3 n.1. For the reasons discussed below, we vacate Due Date 7 and order the parties to identify other dates on which they are available for a hearing or hearings in these cases.

II. BACKGROUND

A. The '464 patent

On December 5, 2016, we instituted we instituted an *inter partes* review of claims 1, 3, 4, 7, 8, 10, 12, 13, 16, 17, and 19–23 of U.S. Patent 5,960,464 ("the '464 patent") under 35 U.S.C. § 103(a) as obvious over Gulick[4] and Nale[5]. IPR2016-01121, Paper 7, 18.

[4] U.S. Patent No. 5,797,028.
[5] U.S. Patent No. 5,793,385.

On August 4, 2017, we issued a Final Written Decision in IPR2016-00924, in which we found claims 1–4, 7–13, 16–24, 32–36, and 40 of the '464 patent to be unpatentable based on the following grounds:

1. claims 1, 3, 4, 8–10, 12, 13, 16–21, 23, 24, 32, 33, 35, 36, and 40 of the '464 patent are unpatentable under § 102(b) as anticipated by Notarianni[6];
2. claims 7 and 22 of the '464 patent are unpatentable under § 103(a) as obvious over the teachings of Notarianni;
3. claims 2 and 11 of the '464 patent are unpatentable under § 103(a) as obvious over the combined teachings of Notarianni and Moore[7]; and
4. claim 34 of the '464 patent is unpatentable under § 103(a) as obvious over the combined teachings of Notarianni and Rathnam[8].

Apple Inc., HTC Corporation, and HTC America, Inc., v. Parthenon Unified Memory Architecture LLC, Case IPR2016-00924 (PTAB Aug. 4, 2017) (Paper 39) ("924 FWD").

As a result, all of the claims, upon which we instituted in IPR2016-01121, have been held unpatentable in IPR2016-00924. *See* IPR2016-01121, Paper 7, 3 n.1 ("If we issue a Final Written Decision in [IPR2016-00924], it will be appropriate to determine whether Petitioner is estopped from maintaining this proceeding. *See* 35 U.S.C. § 315(e)(1). If we determine at that time that Petitioner

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[6] U.S. Patent No. 5,404,511.
[7] Gordon E. Moore, Cramming More Components onto Integrated Circuits, 38 ELECTRONICS 114 (1965).
[8] Selliah Rathnam & Gert Slavenburg, An Architectural Overview of the Programmable Multimedia Processor, TM-1, 1996 IEEE PROC. COMPCON '96, at 319.

is estopped, we may terminate this proceeding and vacate this Decision on Institution.").

Patent Owner, however, has until September 4, 2017, to file a request for rehearing of that decision. 37 C.F.R. § 42.71.

B. The '789 patent

On December 6, 2016, we instituted an *inter partes* review of claims 1–8 and 11–14 of U.S. Patent 5,812,789 ("the '789 patent") on the following grounds:

1. Claims 1–5 and 12–14 as unpatentable under § 103(a) over the combination of Bowes[9], TMS[10], and Thomas[11];
2. Claims 6 and 8 as unpatentable under § 103(a) over the combination of Bowes, TMS, Thomas, and Gove[12];
3. Claim 7 as unpatentable under § 103(a) over the combination of Bowes, TMS, Thomas, and Ran[13]; and
4. Claim 11 as unpatentable under § 103(a) over the combination of Bowes, TMS, Thomas, and Celi[14].

IPR2016-01135, Paper 7, 28–29.

On August 4, 2017, we issued a Final Written Decision in IPR2016-00923, in which we found claims 1, 3–6, 11, and 13 of the '789 patent to be unpatentable based on the following grounds:

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[9] U.S. Patent No. 5,546,547.
[10] TMS320C8x System-Level Synopsis, Literature Ref. No. SPRU113B, Texas Instruments, Inc. (Sept. 1995).
[11] U.S. Patent No. 5,001,625.
[12] Robert J. Gove, The MVP: A Highly-Integrated Video Compression Chip, IEEE (1994).
[13] U.S. Patent No. 5,768,533.
[14] U.S. Patent No. 5,742,797.

1. claims 1, 3, 5, 11, and 13 of the '789 patent are unpatentable under § 102(e) as anticipated by Lambrecht[15];
2. claim 4 of the '789 patent is unpatentable under § 103(a) as obvious over the combined teachings of Lambrecht and Artieri[16]; and
3. claim 6 of the '789 patent is unpatentable under § 103(a) as obvious over the combined teachings of Lambrecht and Moore.

Apple Inc., HTC Corporation, and HTC America, Inc., v. Parthenon Unified Memory Architecture LLC, Case IPR2016-00923 (PTAB Aug. 4, 2017) (Paper 39) ("923 FWD").

As a result, all but claims 2, 7, 8, 12, and 14 in IPR2016-01135 have been held unpatentable in IPR2016-00923. *See* IPR2016-01135, Paper 7, 3 n.1 ("If we issue a Final Written Decision in [IPR2016-00924], it will be appropriate to determine whether [Petitioner] is estopped from maintaining this proceeding. *See* 35 U.S.C. § 315(e)(1). If we determine at that time that [Petitioner] is estopped with respect to claims 1, 3–6, 11, and 13, because claim 1 is the sole independent claim under review, we terminate this proceeding with respect to claims 2, 7, 8, 12, and 14 and, if appropriate, vacate this Decision on Institution.").

Patent Owner, however, has until September 4, 2017, to file a request for rehearing of that decision. 37 C.F.R. § 42.71.

III. DISCUSSION

Oral argument in these cases is scheduled for September 5, 2017. *See, e.g.*, IPR2016-01114, Paper 15. Both parties requested oral argument. *See, e.g.*,

[15] U.S. Patent No. 5,682,484.
[16] U.S. Patent No. 5,579,052.

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