Trials@uspto.gov
571-272-7822

Paper No. 32
Entered: August 25, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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]

Before MICHAEL R. ZECHER, JAMES B. ARPIN, and MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

CLEMENTS, *Administrative Patent Judge*.

ORDER TO SHOW CAUSE
Conduct of the Proceedings
37 C.F.R. § 42.5(a)

[1] Case IPR2017-00513 has been joined to this proceeding.
[2] Case IPR2017-00512 has been joined to this proceeding.
[3] This Order addresses an issue that is identical in both 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.

I. INTRODUCTION

In December 2016, we instituted an *inter partes* review of certain claims ("the instituted claims") of the patents at issue in each of the above-named proceedings. IPR2016-001121, Paper 7; IPR2016-01135, Paper 7.

In August 2017, we issued Final Written Decisions in earlier-filed proceedings involving the same patents in which many of the instituted claims were held unpatentable. *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"); *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").

On August 23, 2017, Patent Owner contacted the Board to confirm that it will not file a Request for Rehearing of the 923 FWD or of the 924 FWD.

As a result, we now order the parties in these proceedings to show cause why we should not terminate these proceedings as to the claims held unpatentable in those earlier Final Written Decisions

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]

924 FWD, 35.

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

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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.

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:

1. Claims 1, 3, 5, 11, and 13 of the '789 patent are unpatentable under § 102(e) as anticipated by Lambrecht;[15]

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

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.

923 FWD, 44.

As a result, all but claims 2, 7, 8, 12, and 14 at issue 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.").

III. DISCUSSION

The rules governing AIA *inter partes* proceedings, including those pertaining to institution, are "construed to secure the just, speedy, and inexpensive resolution of every proceeding." 37 C.F.R. § 42.1(b); *accord* 35 U.S.C. § 316(b) (regulations for AIA *inter partes* proceedings take into account "the efficient administration of the Office" and "the ability of the Office to timely complete [instituted] proceedings"). Moreover, we have discretion not to institute or to terminate a review for reasons of administrative expediency. *See* 35 U.S.C. § 314(a) (authorizing institution of an *inter partes* review under particular circumstances, but not requiring institution under any circumstances); *see also*

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

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