

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KINGSTON TECHNOLOGY COMPANY, INC.,
Petitioner,

v.

POLARIS INNOVATIONS LTD.,
Patent Owner.

Case IPR2016-01622
Patent 6,850,414 B2

Before SALLY C. MEDLEY, JEAN R. HOMERE,
and KEN B. BARRETT, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

A. *Background and Summary*

Kingston Technology Company, Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–8 of U.S. Patent No. 6,850,414 B2 (“the ’414 patent,” Ex. 1001). Paper 2 (“Pet.”). Polaris Innovations Ltd. (“Patent Owner”)¹ filed a Preliminary Response to the Petition. Paper 6 (“Prelim. Resp.”). The Board instituted *inter partes* review (Paper 7, “Inst. Dec.”) of claims 1 and 5–8 on the ground of obviousness under 35 U.S.C. § 103(a) over Simpson². The Board did not institute a review as to dependent claim 4. Petitioner filed a Request for Rehearing of The Board’s Institution Decision on Claim 4 (Paper 11), which was denied (Paper 16).

Patent Owner filed a Motion to Amend seeking to cancel the instituted challenged claims and proposing to substitute a newly-presented claim 9 for dependent claim 8. Paper 18 (“MTA”). Patent Owner did not file a Response to the Petition. Subsequently, Petitioner filed an Opposition to Patent Owner’s Motion to Amend (Paper 20, “MTA Opp.”), and Patent Owner filed a Reply to Petitioner’s Opposition to Motion to Amend (Paper 23, “MTA Reply”).

On October 4, 2017, the Federal Circuit issued an *en banc* decision in *Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017) addressing the burden of proof that the Board applies when considering the patentability of

¹ Patent Owner identifies Polaris Innovations Ltd., Wi-LAN Inc., and Quarterhill Inc. as real parties-in-interest. Paper 4, 1; Paper 19, 1.

² UK Patent Application GB 2 289 573 A, published Nov. 22, 1995 (Ex. 1002).

substitute claims presented in a motion to amend filed under 35 U.S.C. § 316(d).

Pursuant to our authorization (Paper 25), Petitioner filed a Surreply to Patent Owner's Motion to Amend (Paper 28, "MTA Surreply"). Thereafter and pursuant to our authorization (Paper 29), Patent Owner filed a Brief Addressing Impact of *Aqua Products v. Matal* (Paper 30).

An oral hearing was held on November 14, 2017, and a transcript of the hearing is included in the record. Paper 34 ("Tr.").

This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a). After consideration of the parties' arguments and evidence, and for the reasons discussed below, we determine that Petitioner has shown by a preponderance of the evidence that claims 1 and 5–8 of the '414 patent are unpatentable. Based on the entirety of record before us, we also determine that a preponderance of the evidence establishes that substitute claim 9 presented in the Motion to Amend is unpatentable over the prior art of record.

B. Related Proceedings

According to the parties, the '414 patent is involved in *Polaris Innovations Ltd. v. Kingston Tech. Co., Inc.*, Case No. 8:16-cv-300 (C.D. Cal.). Pet. 1; Paper 4, 1.

Petitioner filed a petition seeking *inter partes* review of claim 4 of the '414 patent in Patent Trial and Appeal Board Case IPR2017-00974 (Paper 2). In that case, the Board exercised its discretion under 35 U.S.C. §§ 314(a) and 325(d) to not institute an *inter partes* review. IPR2017-00974, Paper 8. Petitioner's request for reconsideration of that decision was denied. IPR2017-00974, Papers 9, 11.

C. The '414 Patent

The '414 patent, titled “Electronic Printed Circuit Board Having a Plurality of Identically Designed, Housing-Encapsulated Semiconductor Memories,” issued February 1, 2005, from U.S. Patent Application No. 10/187,763. Ex. 1001 at [54], [45], [21].

The '414 patent generally relates to an electronic printed circuit board having a memory module comprised of identically designed semiconductor memories configured on the printed circuit board. *Id.* at Abstract. “Printed circuit boards of this type are inserted into motherboards of personal computers or network computers and serve as the main memory.” *Id.* at 1:21–23. Figures 1A and 1B are reproduced below.

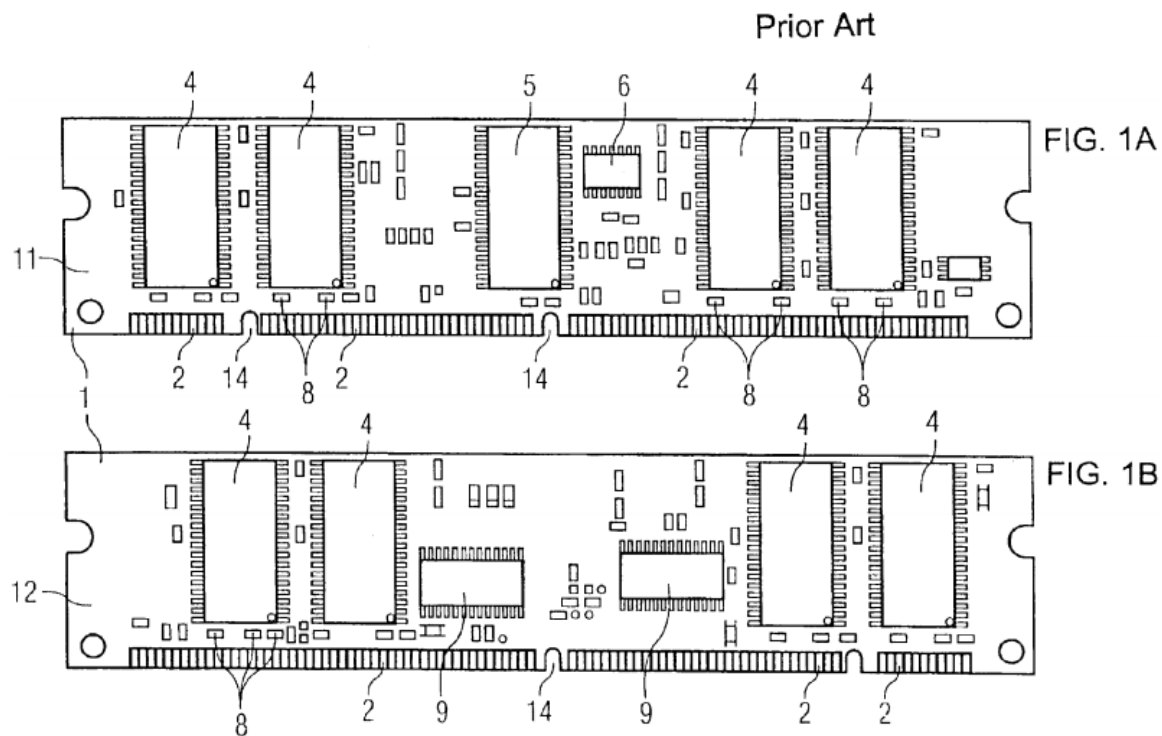
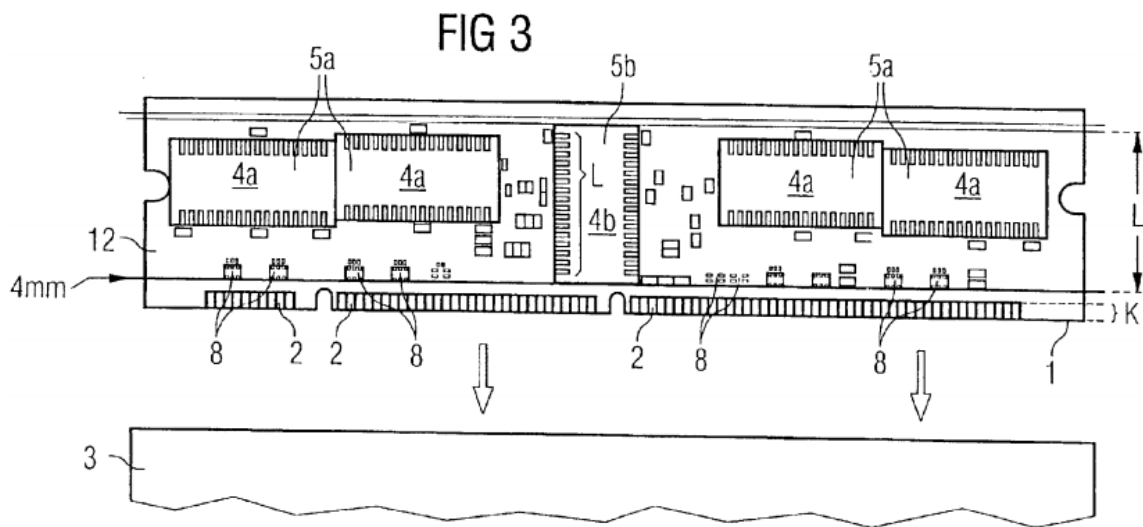


Figure 1A shows the front side of a conventional printed circuit board and Figure 1B shows the rear side of a conventional printed circuit board. *Id.* at 5:6–10. According to the '414 patent, in a conventional arrangement,

semiconductor memories 4 are arranged on the front and rear sides of the printed circuit board in the same orientation as error correction chip 5. *Id.* at 1:62–67. “In the case of this conventional arrangement . . . there is no more leeway for a further reduction of the circuit board height (the height of the printed circuit board perpendicular to the contact strip).” *Id.* at 2:37–41. In network computers, however, “the printed circuit boards are inserted into compartment-type elements having a small height, for which reason the printed circuit boards themselves should also have only a small height.” *Id.* at 1:23–27.

To address this problem, the '414 patent discloses an electronic printed circuit board in which the error correction chip remains oriented perpendicular to the contact strip but the other semiconductor memories are oriented parallel to the contact strip, such that it is “possible to reduce the height of the printed circuit board while enabling the rectangular housing to keep the same physical form.” *Id.* at Abstract. Figure 3 is reproduced below.



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