

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  
U.S. Patent 6,850,414 B2

---

PETITIONER'S REQUEST FOR REHEARING OF THE BOARD'S  
INSTITUTION DECISION ON CLAIM 4

Mail Stop **Patent Trial and Appeal Board**  
Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**TABLE OF CONTENTS**

I. INTRODUCTION .....1

II. STATEMENT OF PRECISE RELIEF REQUESTED .....1

III. ARGUMENT.....2

    A. The Petition Did Not Seek to Modify Simpson’s Chip Design for  
    Claim 4 .....2

    B. The Petition Explains Why the Combination Would Be Made .....4

    C. The Petition Also Explains How the Combination Would Be Made ...6

    D. The Claimed Circuit Board Height is a Design Choice Not Entitled to  
    Independent Patentable Weight.....8

IV. CONCLUSION.....9

**TABLE OF AUTHORITIES**

<b>Cases</b>	<b>Page(s)</b>
<i>In re Applied Materials, Inc.</i> , 692 F.3d 1289 (Fed. Cir. 2012) .....	9
<i>Hockerson-Halberstadt, Inc. v. Avia Group Int'l, Inc.</i> , 222 F.3d 951 (Fed. Cir. 2000) .....	3
<i>In re Keller</i> , 642 F.2d 413 (C.C.P.A. 1981) .....	7
<i>In re Rose</i> , 220 F.2d 459 (C.C.P.A. 1955) .....	8
<i>In re Sneed</i> , 710 F.2d 1544 (Fed. Cir. 1983) .....	7
<i>In re Wertheim</i> , 541 F.2d 257 (C.C.P.A. 1976) .....	9
<b>Other Authorities</b>	
37 C.F.R. §42.71 .....	1
MPEP 2144.05(I) .....	9

## I. INTRODUCTION

Pursuant to 37 C.F.R. §42.71, Kingston Technology Company, Inc. (“Petitioner”) hereby respectfully requests rehearing of the Board’s decision denying institution of *Inter Partes* Review of claim 4 of U.S. Patent 6, 850,414 (“the ’414 Patent”). In that decision, the Board held that Petitioner did not sufficiently explain how or why one of ordinary skill in the art would have “modified Simpson to achieve a height of ‘1 to 1.2 inches.’” However, Petitioner did not assert that the chip design of Simpson, which disclosed the elements of claim 1, needed to be modified to satisfy claim 4. Rather, as described in the Petition, “any person of ordinary skill in the art would know to take the *design of Simpson* and *apply the standardized dimensions* and tolerances described in the Intel Specification.” Paper 2 at 36-37. The Board’s decision thus appears to have misapprehended or overlooked Petitioner’s arguments with regard to claim 4. Additionally, as also described in the Petition, the Board appears to have misapprehended the patentable weight of design choices, such as height, which are generally not entitled to independent patentable weight.

## II. STATEMENT OF PRECISE RELIEF REQUESTED

Petitioner requests that the Board reverse its decision denying institution and institute *Inter Partes* Review proceedings with respect to claim 4 of the ’414 Patent on the grounds set forth in the ’414 Petition.

### III. ARGUMENT

In the institution decision, the Board stated that “Petitioner has not explained sufficiently how or why a person of ordinary skill would have modified Simpson to achieve a height of 1 to 1.2 inches perpendicular to said contact strip.” Paper 7 at 17. However, in reaching this decision, the Board did not appear to fully consider Petitioner’s arguments, which are set forth again below.

#### A. The Petition Did Not Seek to Modify Simpson’s Chip Design for Claim 4

First, it appears that the Board may have conflated Petitioner’s arguments with regard to claims 2 and 4. Notably, while Petitioner’s argument for dependent claim 2 required a change to the chip layout of Simpson (removing the top row of chips), claim 4 requires no changes to the Simpson design to be rendered obvious.<sup>1</sup> However, in reaching its decision, the Board appears to have required Petitioner to establish a basis for changing the teachings of Simpson – something that Petitioner did not argue was required. Rather, Petitioner argued that a person of ordinary skill in the art would know to take “the design of Simpson and apply the standardized dimensions and tolerances described in the Intel Specification.” Paper 2 at 36-37. The chip design of Simpson remains unchanged.

---

<sup>1</sup> Claim 4 depends directly from claim 1, and the claim 2 argument is separate from the claim 4 argument

# 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.