

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 OPPOSITION TO PATENT OWNER'S MOTION TO
AMEND**

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

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III. ARGUMENT2

 A. Simpson in view of the Intel Specification Discloses “said printed circuit board . . . has a height of 1 to 1.2 inches perpendicular to said contact strip,” as Recited in Substitute Claim 9 and Claim 4.4

 1. It would have been both within the skill level of a POSITA and physically possible to apply Simpson’s chip arrangement on Intel’s 5.25” by 1.2” PCB. 4

 2. There was a strong motivation to apply Simpson’s chip arrangement on a 5.25” by 1.2” PCB. 11

 3. Patent Owner’s assertions that claim 9 (and claim 4) are patentable are disingenuous at best. 14

 B. Simpson in view of Karabatsos Discloses “said printed circuit board . . . has a height of 1 to 1.2 inches perpendicular to said contact strip,” as Recited in Substitute Claim 9 and Claim 4.15

 C. Bechtolsheim in view of Tokunaga and Karabatsos Discloses a Memory Module as Recited in Claim 1 where “said printed circuit board . . . has a height of 1 to 1.2 inches perpendicular to said contact strip,” as Recited in Substitute Claim 9 and Claim 4.17

 1. Bechtolsheim in view of Tokunaga and Karabatsos Discloses a Memory Module as Recited in Claim 1. 17

 2. Bechtolsheim in view of Tokunaga and Karabatsos Discloses a Memory Module as Recited in Substitute Claim 9 (and Original Claim 4). 22

 D. The Claimed Circuit Board Height is Not Entitled to Independent Patentable Weight.23

IV. CONCLUSION25

EXHIBIT LIST

Exhibit	Description
1001	U.S. Patent 6,850,414 to Benisek ('414 patent)
1002	UK Patent Application GB 2 289 573 A to Simpson
1003	PC SDRAM Unbuffered DIMM Specification, Version 1.0
1004	U.S. Patent Application Publication No. 2002/0196612 to Gall
1005	PC133 SDRAM Unbuffered DIMM Specification, Version 1.0
1006	Declaration of Professor Vivek Subramanian ("Subramanian")
1007	'414 Patent File History
1008	File History for U.S. Patent No. 6,332,183
1009	District Court Complaint
1010	Professor Vivek Subramanian's <i>Curriculum Vitae</i>
1011	Intel Small Outline Package Guide
1012	Micron 64Mb: x32 SDRAM Features
1013	U.S. Patent 4,954,088 to Fujizaki
1014	Deposition of Dr. Joseph Bernstein
1015	IPR2017-00974 Paper 2: Petition for <i>Inter Partes</i> Review
1016	IPR2017-00974 Ex. 1006: Declaration of Professor Vivek Subramanian

1017	U.S. Patent Application Publication No. 2002/0006032 to Karabatsos
1018	U.S. Patent No. 5,973,951 to Bechtolsheim
1019	U.S. Patent No. 6,038,132 to Tokunaga
1020	German Publication No. DE 101 24 361 A1 (“Kiehl”)
1021	English Translation of German Publication No. DE 101 42 361 A1 (“Kiehl”)
1022	Second Declaration of Professor Vivek Subramanian
1023	Translation Certification for German Publication No. DE 101 42 361 A1 (“Kiehl”)
1024	IPR 016-01623 Paper 16: Patent Owner’s Response to Petition for <i>Inter Partes</i> Review

I. INTRODUCTION

Kingston Technology Company, Inc. (“Petitioner”) respectfully opposes the Patent Owner’s Motion to Amend (Paper 18). In its motion, Patent Owner has elected to reinsert the subject matter of non-instituted claim 4 (a height limitation) back into the present proceeding. Patent Owner’s only stated basis for the patentability of the height limitation is that claim 4 has “already been found to not have been shown by Petitioner in this case to be disclosed or suggested by the prior art.” Paper 18 at 4. This statement is both a mischaracterization of the Board’s decision and factually incorrect. *See* Paper 7 at 18; *see also* Paper 16 at 6. As set forth below, the addition of a height limitation to claim 8 does not make new claim 9 patentable, as building memory modules with a height between 1 inch and 1.2 inches was well known in the art and there were numerous reasons why a person of ordinary skill would use that height with a module meeting the requirements of claim 8. *See* Ex. 1006 at ¶¶95-96; Ex. 1016 at ¶¶35-40, 50-51, 104.

The reasons why proposed claim 9 is invalid are largely set forth in pending IPR2017-00974, which addresses the patentability of claim 4 of the ’414 patent. As claim 4 includes the very height limitation that Patent Owner seeks to add through amendment (and also depends on claim 1), the art and arguments set forth in IPR2017-00974 largely apply here. In fact, in evaluating the merit of Patent Owner’s motion to amend, the Board will be required to consider the same subject

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