Kingston Technology Company, Inc. (Petitioner)
v.
Polaris Innovations LTD (Patent Owner)

Original Claims Demonstratives
Trial No. IPR2016-01622
U.S. Patent No. 6,850,414

Before Hon. Hon. S. C. MEDLEY, J. R. HOMERE, and M. R. CLEMENTS, Administrative Patent Judges

Overview

- Consideration of patentability of amended claims
- Introduction to the Claims
- Simpson in view of either the Intel Specification or Karabatsos render substitute Claim 9 obvious
- Response to Patent Owner's arguments
- Arbitrary height limitations are not entitled to patentable weight
- Bechtolsheim in view of Tokunaga and Karabatsos renders substitute Claim 9 obvious
- Kiehl provides evidence of memory chip sizes contemporaneous with the '414 patent

Consideration of Patentability of Amended Claims

- Under *Aqua Products*, the Board is obligated to consider patentability of amended claims.

> "[35 U.S.C. §] 316(e) reaches every proposition of unpatentability at issue in the proceeding."
> *Aqua Products, 2017 WL 439000 at *10.*

> "When a petitioner does contest an amended claim the Board is free to reopen the record to allow admission of any additional relevant prior art proffered by a petitioner . . . The Board may consider all art of record in the IPR, including any newly added art, when rendering its decisions on patentability."
> *Aqua Products, 2017 WL 439000 at *17.*

- Patent Owner's reliance on *Amerigen Pharms. Ltd. v. Shire LLC*, IPR2015-02009 to justify patentability of substitute Claim 9 is unfounded because *Amerigen*:
  1) is not precedential and
  2) applies to an unrelated set of facts – removing a multiple dependency is clearly distinct from adding a limitation to a claim.

Consideration of Patentability of Amended Claims

Non-Institution decision(s) on Claim 4 are not binding because the Board made no decisions on patentability.

inconsistent application of the law because our denial of institution of *inter partes* review of claim 4 is not an affirmative determination that the subject matter of claim 4 is patentable. The denial of institution in the 1622 IPR was based on a deficiency of the petition in that case. *Kingston Technology Company, Inc. v. Polaris Innovations Ltd.*, Case IPR2016-01622, slip op. at (denying request for rehearing). The denial of institution in this proceeding was because, *inter alia*, "we determine[d] that the prior art and arguments asserted in this Petition are 'substantially the same' as those in the first petition" (Dec. 13) and, therefore, declined to reach the merits of the Petition.

In neither decision did the Board determine affirmatively that claim 4 is patentable over the prior art asserted in the respective petitions. As a

IPR2017-00974, Paper 11 at 5.

Canceled Claim 1

We claim:

1. An electronic printed circuit board configuration, comprising:

an electronic printed circuit board having a contact strip for insertion into another electronic unit; and

a memory module having at least nine identically designed integrated semiconductor memories;

each one of said semiconductor memories being encapsulated in a rectangular housing having a shorter dimension and a longer dimension;

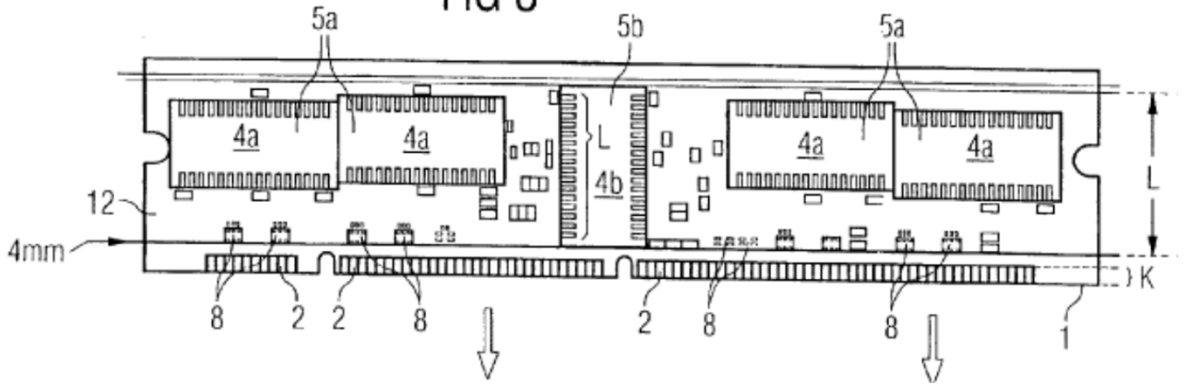
said housing of each one of said semiconductor memories being identically designed and being individually connected to said printed circuit board;

one of said semiconductor memories being connected as an error correction chip;

said longer dimension of said housing of said error correction chip being oriented perpendicular to said contact strip; and

said longer dimension of said housing of each one of said semiconductor memories, other than said error correction chip, being oriented parallel with said contact strip.

FIG 3



DOCKET ALARM

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.