

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 No. 6,850,414 B2

**PETITIONER'S REQUEST FOR REHEARING
& MOTION TO LIMIT THE PETITION**

Pursuant to 37 C.F.R. §§ 42.5, 42.71(d), and the Board’s May 21, 2018 written order granting permission to file this motion, Petitioner Kingston Technology Company, Inc. (“Petitioner” or “Kingston”) requests rehearing to address the effects of the Supreme Court’s decision on *SAS Inst., Inc. v. Iancu*, 584 U.S. ____ (U.S. Apr. 24, 2018) on this trial, prior to the matter going to any appeal.

I. Petitioner’s Motion to Limit and Request for Rehearing

In Paper 39, the Board authorized the filing of a “Joint Motion to Limit the Petition by removing specific claims and grounds upon which we did not institute review in the original Decision on Institution.” Paper 39 at 8. Petitioner requested that Patent Owner join a motion to remove claims 2 and 3 from the Petition. Patent Owner opposes. Thus, Kingston moves (at least on its own) that the Board limit the petition to exclude review of claims 2 and 3. To the extent that the Board decides that it is required to institute claims 2 and 3 in order to institute on claim 4, Petitioner requests institution on all claims and grounds in its original Petition. *See* Ex. 1029 at 6:3-17, 23:17-24:5. However, Kingston disclaims any challenge to claims 2 and 3 and therefore presents no briefing on them here.

Under *SAS*, the Board must issue a Final Written Decision that addresses Claim 4 on the ground of Simpson in view of the Intel Specification (or alternatively all grounds and claims if the motion to limit is denied). The Supreme Court held in *SAS* that the Board may not institute on less than the set of challenged claims. *SAS*,

584 U.S. ___ at *9 (stating that “§318(a) categorically commands the Board to address in its final written decision ‘any patent claim challenged by the petitioner.’”). As the grounds related to claim 4 were not addressed in the FWD, Petitioner requests that the Board reconsider its final written decision and provide a supplemental FWD that addresses claim 4 (and 2-3 to the extent not limited).

II. The Board Can Render a FWD on Claim 4 Without Further Briefing

This case is atypical because although the Board did not originally institute claim 4, the Board has already adjudicated the additional limitation of dependent claim 4 (the “height limitation”). This is because the Patent Owner re-injected the height limitation of claim 4 back into the proceeding through its own voluntary decision to file a motion to amend. *See* Paper 35 at 21 (“Regardless as to the reasons underlying Patent Owner’s actions, it is because of those actions that the height limitation of claim 4 is again involved in this proceeding.”). The parties had full opportunity for briefing and oral argument as to the patentability of the height limitation, and the Board rendered a FWD that the height limitation in combination with claim 1 (and even the added material from claim 8) was not patentable.

There are no due process concerns in the Board rendering a decision on the height limitation. Patent Owner was permitted to argue for the patentability of the height limitation in its motion to amend, then again in its reply to the motion (Papers 18 & 23). Patent Owner was then permitted to argue for the patentability of the

height limitation during the Hearing. Through each of these stages, Patent Owner made a strategic choice to focus its arguments for patentability mainly on several misconceptions rather than on substance.¹ Notably, these misconceptions were not affected by SAS, but instead arise where Petitioner relied on the wrong portion of the IPR statutes. *See* FWD, Paper 35, at 16-19. As the Board previously noted, Patent Owner was fully advised that the Board had not found the patentability of claim 4. FWD, Paper 35 at 19 (“In denying that request for reconsideration, we confirmed “[i]n neither decision [denying institution as to claim 4] did the Board determine affirmatively that claim 4 is patentable over the prior art asserted in the respective petitions.” IPR2017-00974, Paper 9, 5. Accordingly, Patent Owner’s reliance on those prior decisions is misplaced”). SAS did not change any of this. For example, even if the Petition been rejected in full, Patent Owner it would not have any weight on the patentability of those claims as the institution standard 35 U.S.C. 314 is different than the standard for rendering decisions on patentability under 35 U.S.C. 318

While Patent Owner’s strategy was ultimately unsuccessful, Patent Owner was never denied the full and fair opportunity to argue for the patentability of the height limitation in whatever way it chose. Given that, if as per the guidance in *SAS*,

¹ Patent Owner did substantively argue patentability though. *See* Paper 23 at 10-11.

the Board chooses to institute on claim 4, it can immediately render a FWD on claim 4 finding the claim unpatentable for the same reasons that it found claim 9 unpatentable.² Indeed, it is axiomatic that claim 4 cannot be patentable if claim 9 was not.

III. There is No Waiver as to Claim 4

Patent Owner was incorrect on the conference call to argue that Kingston failed to preserve the *SAS* issue. *See* Paper 39 at 5. After the Board's institution decision, the scope of the trial was set, and the non-instituted claims were out of the case. It would have been futile (and in contravention of the Board's order) to continue arguing claim 4 when it had not been instituted. Nor could Kingston have properly urged a *SAS* type argument in its request for rehearing, as it was not the then current law and it had not been in the Petition. Indeed, prior to the *SAS* decision, the first opportunity Kingston would have had to challenge the non-institution of a

² If the Board denies Petitioner's Motion to Limit, Patent Owner should be given the option to provide supplemental briefing on claims 2 and 3 (if PO desires it) as those claims were not in the Motion to Amend. Moreover, while Patent Owner already had multiple chances to argue the height limitation, Petitioner would not oppose additional briefing on it if the Board believed it warranted. In either case, Petitioner requests a reply to any additional briefing, as Petitioner retains the ultimate burden.

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