

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

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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.¹ 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.

¹ Claim 4 depends directly from claim 1, and the claim 2 argument is separate from the claim 4 argument

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