

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 IPR2017-00974
Patent 6,840,414

PETITIONER'S REQUEST FOR REHEARING

I. BACKGROUND AND RELIEF REQUESTED

Petitioner, Kingston Technology Company, Inc. (“Petitioner”), requests rehearing of the Board’s August 14, 2017 Decision in Paper 8 (hereinafter the “Decision”) declining to institute a trial as to both Grounds identified at pp. 9-10 of the Petition (Paper 2) (hereinafter the “Petition”), which requests *inter partes* review (“IPR”) of claim 4 of U.S. Patent No. 6,840,414 (“the ’414 Patent”). In the Decision, the Board denied a trial purely on discretionary grounds under 35 U.S.C. §§ 314(a) and 325(d).

II. REASONS FOR THE RELIEF REQUESTED

Petitioner respectfully requests that the Board review the instant Petition on the merits in view of Patent Owner’s Motion to Amend (Paper 18) (hereinafter “Motion to Amend”) and Petitioner’s Opposition to the Motion to Amend (Paper 20) (hereinafter “Opposition”) filed in IPR2016-01622 (hereinafter “the ’622 IPR”). In its Motion, Patent Owner has elected to reinsert the subject matter of non-instituted claim 4 (a height limitation) back into the proceeding as a “new” limitation in its new claim (claim 9) (see claim chart below). Patent Owner’s action presents a unique factor for the Board’s consideration in deciding whether to exercise its discretion under 35 U.S.C. § 325(d). In so doing, Patent Owner has instigated a situation in which declining to review the proposed rejections of claim 4 on the merits may result in an inconsistent application of the patent law. This

factor was not considered by the Board in its Institution Decision and was not raised by Petitioner because the Motion to Amend had not yet been filed prior to the filing of the present Petition.

<u>Claim 4 of the '414 Patent</u>	<u>Patent Owner's Proposed Claim 9</u>
The printed circuit board according to claim 1, wherein:	The printed circuit board according to claim 1, wherein:
<u>said printed circuit board has a height of 1 to 1.2 inches perpendicular to said contact strip.</u>	<u>said printed circuit board</u> has a width of 5.25 inches and <u>has a height of 1 to 1.2 inches perpendicular to said contact strip.</u>

Furthermore, the Board did not and could not have considered this issue raised by Patent Owner prior to the Board issuing its Decision because Petitioner had not yet filed its Opposition to the Motion to Amend. Yet, when the Board reviews the Motion to Amend and Opposition it must substantively consider the same references and arguments presented in this Petition, as well as additional arguments and references that directly address chip sizes and the combination of a 5.25 inch board width with a 1-1.2 inch board height. The present Petition can no longer be considered merely an attempt by Petitioner to benefit from the Institution Decision in the '622 IPR because the Patent Owner willingly chose to reinsert the subject matter of claim 4 into the '622 IPR.

Declining to review the present Petition on the merits will potentially result in inconsistent application of the law to identical claim limitations of the same patent. Should the Board determine that Patent Owner's new claim 9 is unpatentable under 35 U.S.C. § 103 (which it is), the Board's decision would create an inconsistency by leaving claim 4 (a broader claim than claim 9) valid, while having determined that the subject matter of claim 4 is, in fact, unpatentable. Such a result is inherently unjust and defies the primary purpose of the U.S. Patent and Trademark Office. *See* 157 Cong. Rec. S5428-9 (daily ed. Sept. 8, 2011) (statement of Sen. Coburn) (“the issuance of quality patents are critical components and should remain the primary goal of the U.S. Patent and Trademark Office”).

Further, declining to review the merits of the present petition in view of the Patent Owner's proposed claim amendments would undermine the goals of the America Invents Act. A specifically stated objective of the America Invents Act was to “*increase the quality and certainty of patent rights*” by providing a “timely alternative to district court litigation.” Cong. Rec. S5354. (daily ed. Sept. 7, 2011) (quoting STATEMENT OF ADMINISTRATION POLICY H.R. 1249—AMERICA INVENTS ACT (Rep. Smith, R–Texas, and 5 cosponsors, June 21, 2011)) (emphasis added); see also Cong. Rec. S5435 9 (daily ed. Sept. 8, 2011) (statement of Sen. Grassley) (“[The America Invents Act] will strengthen patent

quality and reduce costs and will curb litigation abuses and *improve certainty for investors and innovators.*”) (emphasis added). Yet, permitting inconsistent application of the patent law to identical claim features of the same patent would serve only to decrease the quality and certainty of patent rights.

Whether the Board decides to allow Patent Owner’s amendment or deny the amendment as unpatentable, the subject matter of claim 4 would, in either case, be reviewed on the merits. In fact, in evaluating the merit of Patent Owner’s Motion to Amend in the ’622 IPR, the Board will be required to consider the same substantive subject matter it would in the present petition. As such, Petitioner asserts that it would be most efficient for both the Board and the parties for the present IPR to be instituted and aligned in schedule with the ’622 IPR.¹ It would be against the interest of justice to allow subject matter that has been found unpatentable to remain within the patent monopoly. Moreover, Patent Owner’s

¹ By itself requesting consideration of the patentability of the height limitation, Patent Owner has waived any argument that proceeding with IPR 2017-000974 would be inefficient. Moreover, as proposed claim 9 in IPR2016-01622 includes every limitation of claim 4, a finding that proposed claim 9 is not patentable would mean that claim 4 is by definition also not patentable.

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