

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 6,850,414 B2

Before SALLY C. MEDLEY, MATTHEW R. CLEMENTS, and
KEVIN C. TROCK, *Administrative Patent Judges*.

CLEMENTS, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

On February 24, 2017, Petitioner filed a Petition requesting *inter partes* review of claim 4 (“the challenged claim”) of U.S. Patent No. 6,850,414 (Ex. 1001, “the ’414 patent”). Paper 2 (“Pet.”). Claim 4 recites “wherein: said printed circuit board has a height of 1 to 1.2 inches perpendicular to said contact strip.”

On May 16, 2017, Polaris Innovations Ltd. (“Patent Owner”) filed a Motion to Amend in a related case involving the ’414 patent, *Kingston Technology Company, Inc. v. Polaris Innovations Ltd.*, Case IPR2016-01622 (“the 1622 IPR”). Paper 18. In its Motion, Patent Owner proposes the following substitute claim:

Claim 9 (Proposed substitute for original Claim 8, with correlation to original claim): The printed circuit board according to claim 1, wherein: said printed circuit board has a width of 5.25 inches and has a height of 1 to 1.2 inches perpendicular to said contact strip.

Id. at 2. Patent Owner states in its Motion that “the substitute claim is the same as challenged claim 8 in every respect, except that it simply adds the limitations of claim 4.” *Id.* at 1.

On August 14, 2017, we exercised our discretion under 35 U.S.C. §§ 314(a) and 325(d) to decline to institute an *inter partes* review of claim 4 of the ’414 patent based, in part, on our determination that the arguments and evidence were “substantially the same” as presented by Petitioner and found to be unpersuasive in the 1622 IPR. Paper 8 (“Dec.”), 7–14.

On August 30, 2017, pursuant to 37 C.F.R. § 42.71(d), Kingston Technology Company, Inc. (“Petitioner”) requested rehearing of our Decision Denying Institution. Paper 9 (“Req. Reh’g”).

In its Request for Rehearing, Petitioner argues that our analysis of the factors for discretionary non-institution under §§ 314(a) and 325(d) overlooked a “unique factor”—i.e., Patent Owner’s choice “to reinsert the subject matter of non-instituted claim 4 (a height limitation) back into [the 1622 IPR] as a ‘new’ limitation in its new claim (claim 9).” Req. Reh’g. 2.

For the reasons set forth below, Petitioner’s Request for Rehearing is *denied*.

II. STANDARD OF REVIEW

A party requesting rehearing bears the burden of showing that the decision should be modified. 37 C.F.R. § 42.71(d). The party must identify specifically all matters we misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a reply. *Id.*

When rehearing a decision on a petition, we review the decision for an abuse of discretion. *See* 37 C.F.R. § 42.71(c). An abuse of discretion may be indicated if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *See Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). With this in mind, we address the arguments presented by Petitioner.

III. ANALYSIS

Petitioner argues that our analysis of the factors for discretionary non-institution under §§ 314(a) and 325(d) overlooked a “unique factor”—i.e., Patent Owner’s choice “to reinsert the subject matter of non-instituted claim

4 (a height limitation) back into [the 1622 IPR] as a ‘new’ limitation in its new claim (claim 9).” Req. Reh’g. 2. Petitioner notes that “[t]his 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.” *Id.* at 2–3.

According to Petitioner, “[d]eclining 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” if the panel in the 1622 IPR determines that proposed substitute claim 9 is unpatentable and we, by denying institution, “leav[] claim 4 (a broader claim than claim 9) valid.” *Id.* at 4. Such an “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,” contrary to the goal of the America Invents Act to “increase the quality and certainty of patent rights.” *Id.* Petitioner notes that “[t]he eight factors used by the Board for deciding whether to exercise its discretion pertain primarily to efficient conduct of the post grant proceedings and fairness towards the Patent Owner,” but concludes that “such considerations are overridden by the interests of justice when, as here, Patent Owner itself instigates issues that give rise to inconsistent applications of the law to a single patent.” *Id.* at 6.

We are not persuaded by Petitioner’s argument because we disagree with its premise—i.e., that denying *inter partes* review of claim 4 may result in an inconsistent application of the law. As an initial matter, Petitioner’s argument depends upon speculation about whether the panel in the 1622 IPR will determine that the subject matter of proposed, substitute claim 9 is unpatentable. Even if that becomes true, however, it would not result in an

IPR2017-00974
Patent 6,850,414 B2

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 17, 18 (PTAB February 15, 2017) (Paper 7) (determining, with respect to claim 4, that Petitioner did not explain persuasively how and/or why a person of ordinary skill in the art would have made the proposed modifications to Simpson alone or in view of the teachings of the Intel Specification); *see id.*, slip op. at 6 (PTAB April 6, 2017) (Paper 16) (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 result, even if the panel in the 1622 IPR later determines that proposed substitute claim 9 is unpatentable, that determination will not be inconsistent with our denial of institution of *inter partes* review of claim 4.

II. ORDER

Accordingly, it is ORDERED that Petitioner’s Request for Rehearing is *denied*.

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.