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Paper No. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HP INC.,
Petitioner

v.

JAMES B. GOODMAN,
Patent Owner

Case No. IPR 2017-01994
Patent No. 6,243,315

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE TO PETITION

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I. INTRODUCTION

From the beginning of this proceeding, Patent Owner has made minimal efforts to save the challenged claims. The Patent Owner filed a Preliminary Response and a Response to the Petition[1] but did not provide an expert declaration or offer any other evidence. The Patent Owner did not cross-examine Petitioner's expert. Nor did Patent Owner object to any evidence proffered by Petitioner or deny that the Schaefer, Qureshi or Mazur references were prior art to U.S. Patent No. 6,243,315. Therefore, Petitioner's expert testimony and other evidence stands unrebutted. In response, Patent Owner has offered only attorney argument already deemed unpersuasive by the Board.

Patent Owner disputes only three issues: 1) whether "selectively electrically isolating said memory devices from respective address lines and respective control lines" requires electrically isolating *all* address and control lines; 2) whether the combination of Schaefer and Qureshi meets the "memory access enable control device" element; and 3) whether Petitioner has provided evidence for combining

[1] Patent Owner filed a "Patent Owner's Response to the Decision on the Petition" (Paper No. 8) on June 1, 2018, and later that day filed another version (Paper No. 9) with minor corrections of exhibit numbers. Paper No. 9 is referenced herein as "Resp."

Mazur with Schaefer and Qureshi to render claims 10 and 16 obvious. The Board already rejected Patent Owner's position on all three issues in the institution decision. Patent Owner has waived any other disputes not raised in its Response to the Petition.

Accordingly, the Board should cancel challenged claims 1, 5, 10 and 16 of the '315 Patent because the claims are obvious under 35 U.S.C. § 103(a) as described in the Petition.

II. CLAIM CONSTRUCTION

Patent Owner urges the Board to adopt the agreed claim constructions from the district court litigation between the parties. Resp. at 12. Patent Owner argues that "it would be reasonable for the aforementioned claim constructions to be applied herein because the claim construction for each term mentioned above is obviously as broad as possible, thereby complying with *In re Translogic Technology Inc*." *Id*. Patent Owner does not articulate why any of the district court constructions represent the broadest reasonable interpretation ("BRI") of the terms. Petitioner maintains that claim construction is not necessary for the Board to determine that the challenged claims are rendered obvious.

There are at least two reasons why the Board should not apply the claim constructions from the district court case. First, Patent Owner has not shown that the Board needs to construe any claim term. The mere suggestion by Patent Owner

that a term should be construed is not enough. *Vivid Techs., Inc. v. Am. Sci. & Eng., Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) ("[O]nly those terms need to be construed that are in controversy, and only to the extent necessary to resolve that controversy."). Second, even if the Board adopted the parties' agreed construction of "selectively electrically isolating said memory devices from respective address lines and respective control lines" from the district court case, the challenged claims are still obvious. The parties construed that term as "inhibiting signals on respective address and respective control lines from the memory devices such that signals on those lines do not arrive at the memory devices." Resp. at 11, Ex. 2001 at 2. Importantly, this construction does not contain the word "all." Thus, the construction advanced by Patent Owner here is *narrower* than the agreed district court construction, even though the BRI standard is *broader* than the claim construction applied in district court. *See, e.g., In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004). The Patent Owner's flawed reasoning underscores why the Board should not adopt the claim constructions from the district court case.

If the Board determines that this term requires construction, it should reject Patent Owner's improperly narrow construction. As the Board observed in the institution decision, "we do not understand claim 1 to require electrically isolating memory devices from *all* address and control lines. Indeed, such a reading would

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