

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

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| In re U.S. Patent No. 6,240,376 | Trial No.: | IPR 2012-00042 |
| Application No.: 09/127,587 | | |
| Filed: July 31, 1998 | | |
| Issued: May 29, 2001 | | |
| Inventors: Alain Raynaud Luc M. Burgun | Atty. Dkt. No. | 007121.00004 |
| Patent Owner: Mentor Graphics Corporation | | |
| For: METHOD AND APPARATUS FOR GATE- LEVEL SIMULATION OF SYNTHESIZED REGISTER TRANSFER LEVEL DESIGNS WITH SOURCE-LEVEL DEBUGGING | | |

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**PATENT OWNER'S REQUEST FOR REHEARING ON DECISION TO
INSTITUTE *INTER PARTES* REVIEW UNDER 37 C.F.R. § 42.71**

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EXHIBIT LIST**Previously Filed**

- MG 2001 First Amended Complaint in *Mentor Graphics Corp. v. EVE-USA, Inc. and Emulation and Verification Engineering, SA*, 6:06-CV-00341-AA (D. OR., filed March 13, 2006)
- MG 2002 Defendants' Unopposed Motion By Special Appearance For Extension Of Time To Respond To Plaintiff's First Amended Complaint in *Mentor Graphics Corp. v. EVE-USA, Inc. and Emulation and Verification Engineering, SA*, 6:06-CV-00341-AA (D. Or., filed May 23, 2006)
- MG 2003 Order of Dismissal in *Mentor Graphics Corp. v. EVE-USA, Inc. and Emulation and Verification Engineering, SA*, 6:06-CV-00341-AA (D. Or., filed November 20, 2006)
- MG 2004 Complaint for Declaratory Judgment and Injunctive Relief in *Synopsys, Inc., EVE-USA, Inc. and Emulation and Verification Engineering, S.A. v. Mentor Graphics Corp.*, 3:12-cv-05025 (N.D. Cal., filed September 27, 2012)
- MG 2005 Banner & Witcoff, Ltd.'s "Messenger Log"
- MG 2006 October 4, 2012 Synopsys Press Release "Synopsys Acquires EVE"
- MG 2007 EVE-USA's Supplemental Corporate Disclosure Statement, Docket No. 7, filed October 26, 2012 in *Synopsys, Inc. et al. v. Mentor Graphics Corp.*, 3:12-CV-05025 (N.D. Cal. filed September 27, 2012)
- MG 2008 Jansen, D., The Electronic Design Automation Handbook, Kluwer Academic Publishers, 2003, Chapter 2
- MG 2009 Bhatnagar, Advanced ASIC Chip Synthesis: Using Synopsys® Design Compiler™ and PrimeTime®, Kluwer Academic Publishers, 1999

MG 2010 Gregory et al. U.S. Patent No. 5,937,190

MG 2011 HDL Compiler™ for VHDL User Guide, Version F-2011.09-SP4, March 2012, SYNOPSYS, Section 4

Currently Filed

MG 2012 Plaintiffs' Opposition to Mentor Graphics Corporation's Motion to Transfer, dated January 25, 2013

MG 2013 Notice of Incomplete Petition, mailed November 30, 2012 in *CMI Corp. v. Yoshiharu, et. al.*, PTAB Case IPR 2013-00066

MG 2014 Response to Notice of Incomplete Petition Issued November 30, 2012, filed November 30, 2012 in *CMI Corp. v. Yoshiharu, et. al.*, PTAB Case IPR 2013-00066

MG 2015 Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response, mailed December 5, 2012 in *CMI Corp. v. Yoshiharu, et. al.*, PTAB Case IPR 2013-00066

MG 2016 Declaration of Allison Anderson

MG 2017 Notice of Filing Date Accorded to Petition and Notice for Setting the Time Period for Filing Patent Owner Preliminary Response

**PATENT OWNER'S REQUEST FOR REHEARING ON DECISION TO
INSTITUTE *INTER PARTES* REVIEW UNDER 37 C.F.R. § 42.71**

Rehearing of the Board's Decision to institute an *inter partes* review trial over the statutory bar in 35 U.S.C. §315(b) is respectfully requested. The Patent Owner's Preliminary Response asserted that *inter partes* review based on Petitioner Synopsys' Petition was barred by 35 U.S.C. §315(b), because Synopsys is in privity with EVE¹ and EVE was served with a Complaint alleging infringement of the '376 patent more than one year **before** the date on which the Petition was filed. The Board disagreed, finding that Synopsys' Petition was not barred under §315(b).

I. The Standard for Rehearing Is Met

This request is authorized by 37 C.F.R. § 42.71(c) and (d). The standard of review is abuse of discretion, and the burden of showing that a Decision should be modified lies with the party challenging the Decision. *Id.* Here, it is respectfully submitted that the standard for rehearing on the Decision to institute a trial is met on the basis of legal error because, as demonstrated below, the Decision misapprehends the privity requirement of §315(b), including when the privity

¹ EVE-USA, Inc. and Emulation and Verification Engineering, S.A., the defendants in the 2006 litigation, will be referred together as "EVE."

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