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Paper 13
Entered: March 13, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SMART MODULAR TECHNOLOGIES INC.,
Petitioner,

v.

NETLIST, INC.,
Patent Owner.

Case IPR2014-01370
Patent 8,301,833 B1

Before: LINDA M. GAUDETTE, BRYAN F. MOORE, and GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge.*

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Smart Modular Technologies Inc. ("Petitioner") filed a Corrected Petition requesting an *inter partes* review of claims 1–30 of US Patent No. 8,301,833 B1 (Ex. 1009, "the '833 patent"). Paper 8 ("Pet."). Netlist, Inc. ("Patent Owner") filed a Preliminary Response. Paper 11 ("Prelim. Resp.").

We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may be authorized only if "the information presented in the petition . . . and any [preliminary] response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a). Pursuant to 35 U.S.C. § 314, the Board does not find a reasonable likelihood that Petitioner would prevail with respect to at least one claim of the '833 patent and, thus, does not authorize an *inter partes* review to be instituted as to those claims.

A. Related Proceedings

Petitioner recites the District Court proceedings related to this *inter partes* review. Pet. 2–3. This *inter partes* review challenges the same patent at issue in the decision entered in IPR2014-00994 in which we denied institution. IPR2014-00994 (Paper 8).

B. The '833 Patent

The invention in the '833 patent relates to a specific configuration of hybrid memory systems that addresses non-volatile memory backup while running the volatile memory subsystem at lower power, and, therefore, at lower clock speeds. Ex. 1001, col. 16, ll. 29–34. Specifically, the alleged invention of the '833 patent includes circuitry for providing a regular high-speed clock frequency (first clock frequency) during communications between the host and the volatile memory subsystem, and a slower clock frequency during communications between the volatile memory subsystem (using a third clock frequency) and the non-volatile memory subsystem (using a second clock frequency). *Id.* at col. 21, ll. 5–21. Further, the second and third clock frequencies may be substantially equal. *Id.* at col. 21,

ll. 23–24.

C. Illustrative Claim

Of the challenged claims, 1 and 5 are independent claims. Claim 1 is illustrative of the claimed subject matter of the ’833 patent, and is reproduced below:

> 1. A method for controlling a memory system operatively coupled to a host system, the memory system including a volatile memory subsystem and a non-volatile memory subsystem, the method comprising:
>
> operating the volatile memory subsystem at a first clock frequency when the memory system is in a first mode of operation in which data is communicated between the volatile memory subsystem and the host system;
>
> operating the non-volatile memory subsystem at a second clock frequency when the memory system is in a second mode of operation in which data is communicated between the volatile memory subsystem and the nonvolatile memory subsystem; and
>
> operating the volatile memory subsystem at a third clock frequency when the memory system is in the second mode of operation, the third clock frequency being less than the first clock frequency.

D. Prior Art Relied Upon

Petitioner relies upon the following prior art references:

Reference	Patent Number	Exhibit Number
Fukuzo ’295Pub	US 2006/0294295 A1	Ex. 1012
Leete ’210Pub	US 2004/0190210 A1	Ex. 1013
Ichikawa ’142	US 7,600,142 B2	Ex. 1014
Long ’552	US 7,421,552 B2	Ex. 1015
Tsunoda ’618	US 7,062,618 B2	Ex. 1016

E. The Asserted Grounds

Petitioner asserts that the challenged claims are unpatentable based on the following grounds:

Reference[s]	Basis	Claims Challenged
Fukuzo ’295Pub	§ 102	1, 2, 4, 6–13, 15, 16, 18, 20, and 22–29[1]
Fukuzo ’295Pub and Leete ’210Pub	§ 103	3, 5, 14, 17, 19, 21 and 30
Ichikawa ’142	§ 102	1, 2, 7, 8, 11–13, 15, 18, 23, 24 and 27–29
Ichikawa ’142 and Leete ’210Pub	§ 103	3–6, 9, 10, 14, 16, 17, 19–22, 25, 26, and 30
Long ’552	§ 102	1, 2, 4, 5, 7, 12, 13, 15, 18, 20, 21, 23, 28, and 29[2]

[1] We note the challenged claims are listed at page 6 of the Petition. Also, analysis is provided starting at page 26 of the Petition. Although Claim 16 is not listed, analysis provided at page 29 of the Petition.

[2] We note the Petition isn’t consistent. The challenged claims are listed as 1, 2, 4, 5, 12, 13, 15, 18, 20, 21, 28, and 29. Pet. 7. Nonetheless, analysis

Reference[s]	Basis	Claims Challenged
Long ’552 and Leete ’210Pub	§ 103	3, 6–11, 14, 16, 17, 19, 22–27, and 30
Tsunoda ’618	§ 102	1, 2, 4, 5, 12, 13, 15, 16, 18, 20, 21, 28, and 29
Tsunoda ’618 and Leete ’210Pub	§ 103	3, 6–11, 14, 16, 17, 19, 22–27, and 30

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b). Under the broadest reasonable construction standard, claim terms are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Any special definition for a claim term must be set forth with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

Petitioner and Patent Owner propose constructions for several terms. Pet. 19–24; Prelim Resp. 15–21. We determine that none of the terms cited by the parties require explicit construction for the purpose of this Decision.

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provided for claims 1, 2, 4, 5, 7, 12, 13, 15, 18, 20, 21, 23, 28, and 29. *See* Pet. 43–44.

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