

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

TOSHIBA CORPORATION; TOSHIBA AMERICA, INC.;  
TOSHIBA AMERICA ELECTRONIC COMPONENTS, INC.; AND  
TOSHIBA AMERICA INFORMATION SYSTEMS, INC.,  
Petitioner

v.

INTELLECTUAL VENTURES II LLC,  
Patent Owner

---

Case IPR2014-00201  
Patent 6,618,788

---

Before KEVIN F. TURNER, TREVOR M. JEFFERSON,  
and DAVID C. MCKONE, *Administrative Patent Judges*.

MCKONE, *Administrative Patent Judge*.

DECISION  
ON REQUEST FOR REHEARING  
37 C.F.R. § 42.71

## I. INTRODUCTION

In our Institution Decision (Paper 11, “Dec.”), we denied institution of an *inter partes* review of claims 1–27 of U.S. Patent No. 6,618,788 (Ex. 1001, “the ’788 patent”). Dec. 18–19. Specifically, we concluded that Petitioner did not show that Bastiani (Ex. 1003) disclosed or taught “parsing the command block into a sequence of ATA [register] operations necessary to execute the given ATA register-delivered transaction,” as recited in independent claims 1, 10, and 24, or “an ATA command protocol adapter to parse a command packet into a sequence of ATA register operations and cause that sequence of operations to be performed by the ATA register protocol adapter,” as recited in independent claim 24 (collectively, the “parsing limitation”). *Id.* at 9–15, 18.

Petitioner requests rehearing of the Decision, asserting that we misapprehended or overlooked the teachings of Bastiani. Paper 13 (“Req. Reh’g”), at 2. Petitioner contends that: Bastiani explicitly discloses the parsing limitation (Req. Reh’g 3–8); if Bastiani does not explicitly disclose the parsing limitation, it inherently discloses it (*id.* at 8–9); and we improperly relied on several Patent Owner arguments Petitioner deems irrelevant (*id.* at 9–12). None of these contentions is persuasive.

## II. ANALYSIS

When rehearing a decision on institution, the Board reviews the decision for an abuse of discretion. 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. U.S.*, 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). The burden of showing that the Decision should be modified is on Petitioner, the party challenging the Decision. *See* 37 C.F.R. § 42.71(d). In addition, “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” *Id.*

Petitioner first contends that Bastiani expressly discloses the parsing limitation. Petitioner argues that Bastiani’s ASP adaptor, shown in Figure 3, receives from a host an ASP packet with ATA register values and data fields, breaks the packet down into a sequence of ATA register operations, and sends the ATA register operations to an ATA device (Petitioner identifies IDE device 122). Req. Reh’g 3–4. Petitioner primarily relies on Bastiani at column 43, lines 43–49, and column 42, lines 9–13, to show an express disclosure of parsing. Req. Reh’g 5–6.

Regarding Bastiani’s disclosure at column 43, lines 43–49, Petitioner did not, in the Petition, cite this passage as disclosing the parsing limitation. *See* Pet. 16–17, 22–23, 28–29. Thus, we could not have overlooked or misapprehended the applicability of this passage in the Petition. In any case, this passage states that a “device decodes all header fields [of an OUTDATA0/1 packet] for correctness and if any of the header fields (Packet type, DataType, Byte Count) are not correct the device ignores the packet.” Ex. 1003, col. 43, ll. 46–49. Petitioner has not explained

persuasively how this constitutes parsing a command block into a sequence of ATA operations.

Regarding column 42, lines 9–13, of Bastiani, Petitioner argues that this discloses an ASP adaptor generating a sequence of ATA register operations that are sent to an attached ATA device. Req. Reh’g 6. Petitioner contends that we misapprehended Bastiani and failed to recognize that “the adapter of Bastiani clearly is doing more than merely ‘passing commands’ across the ASP bus because the adapter breaks down the Command Block (ATA Command (ATA register values) with associated data fields) in the OUTDATA0/1 packet into a standard sequence of ATA register operations.” Req. Reh’g 7–8. We considered this argument in the Decision and found it unpersuasive, concluding that Petitioner did not identify where Bastiani describes the details of the how the ASP adaptor and/or the IDE device processes the ASP packets. Dec. 10–12. Thus, we did not misapprehend or overlook Petitioner’s argument.

Petitioner also argues that it would not have been possible for Bastiani’s host to have communicated with ATA devices using ASP packets unless the ASP adaptor was parsing the ASP packets. Req. Reh’g 6. This argument is a rephrasing of Petitioner’s argument that “the ASP ADAPTER must parse or break down the ATA Command contained in the OUTDATA0/1 packets into standard sequence of ATA operations, and the ASP ADAPTER then causes those operations to occur by accessing ATA registers on the IDE device,” Pet. 17. Petitioner repeats this argument in its contention that Bastiani inherently discloses the parsing limitation. Req. Reh’g 8–9 (“If the adapter did not [parse ASP packets into ATA register commands], then the host (which issues ASP packets) would be unable to

communicate with the ATA device (which expects ATA register commands).”). We considered this argument and found it unpersuasive. *See* Dec. 13–15. Thus, we did not misapprehend or overlook it.

Petitioner contends that, in denying the Petition, we improperly credited several Patent Owner arguments Petitioner deems “irrelevant.” *Req. Reh’g* 9–12. Petitioner argues that its position is not based on what the ATA standards require; rather, Petitioner argues, “[w]hat matters is that Bastiani describes an adapter that receives an ATA Command encapsulated in an ASP packet, and in response to receiving that ASP packet, causes ATA register operations to be performed by the attached ATA device.” *Id.* at 10–11. Similarly, Petitioner contends that it does not matter whether Bastiani’s ASP adaptor and the ’788 patent’s bridging circuit comport to the same version of the ATA standards; rather, Petitioner argues, “[b]ecause an ATA device understands ATA commands (and not ASP or USB packets), the adapter in Bastiani and the bridge in the ’788 patent must parse the received packets because otherwise the attached ATA device could not be utilized.” *Id.* at 11. Finally, Petitioner argues that it is irrelevant that Bastiani’s ASP adaptor and the ’788 patent’s bridging circuit receive different input because any received packet must be parsed to generate a sequence of ATA register operations. *Id.* at 12.

None of these arguments is persuasive. In the Petition, Petitioner contended that because both Bastiani and the ’788 patent described systems that communicated data between ATA devices and non-ATA devices, according to ATA standards, those systems must have converted data in the same way, including Bastiani using the parsing technique described in the ’788 patent. *Pet.* 16–17. Petitioner relied on its declarant to compare

# 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.