

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN MEGATRENDS, INC., et al.,
Petitioner,

v.

KINGLITE HOLDINGS INC.,
Patent Owner.

Case IPR2015-01515
Patent 5,978,912

Before GLENN J. PERRY, TREVOR M. JEFFERSON, and
BRIAN J. McNAMARA, *Administrative Patent Judges*.

PERRY, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

This is a Final Written Decision entered in an *inter partes* review instituted pursuant to 35 U.S.C. § 314. For reasons discussed below, we determine that Petitioner has shown by a preponderance of the evidence that some, but not all, of the claims at issue of U.S. Patent No. 5,978,912 (Ex. 1001, “the ’912 patent”) are unpatentable.

A. Procedural History

American Megatrends, Inc., Micro-Star International Co. Ltd, MSI Computer Corp., Giga-Byte Technology Co., Ltd., and G.B.T., Inc. (“Petitioner”) filed a Petition (Paper 7, “Pet.”) to institute *inter partes* review of claims 1–60 of the ’912 patent. 35 U.S.C. § 311. Patent Owner, Kinglite Holdings Inc., timely filed a Preliminary Response (Paper 12, “Prelim. Resp.”) contending that the Petition should be denied as to all. We instituted trial as to claims 1–10, 12–15, 17–19, 21–30, 32–45, and 47–60. Paper 16, “Dec. to Inst.” Patent Owner filed a Patent Owner Response (Paper 22, “PO Resp.”), and Petitioner filed a Petitioner Reply (Paper 23, “Pet. Reply”). Petitioner also requested rehearing of our Decision to Institute. Paper 18. In our rehearing decision, we added claims 11, 16, and 46 to the review. Paper 24, “Dec. on Reh’g.” We authorized and received from Patent Owner a Supplemental Response directed to the added claims (Paper 26, “Supp. Resp.”) and a Petitioner Reply to that Supplemental Response. Paper 27, “Reply to Supp. Resp.” We heard oral argument on October 17, 2016 and entered a transcript of that argument into the record. Paper 29 (“Tr.”).

B. Related Matters

American Megatrends reports the following related matters in civil litigation:

Kinglite Holdings Inc. v. Giga-Byte Tech. Co. Ltd., et al., CV 14-04989 JVS (PJWx) (C.D. Ca); and

Kinglite Holdings Inc. v. Micro-Star Int'l Co. Ltd., et al., CV 14-03009 JVS (PJWx) (C.D. Ca). Paper 6, 1.

American Megatrends reports the following related matters before the Board:

American Megatrends Inc., et al. v. Kinglite Holdings Inc., IPR2015-01079 (U.S. Pat. No. 6,373,498);

American Megatrends Inc., et al. v. Kinglite Holdings Inc., IPR2015-01081 (U.S. Pat. No. 5,987,604);

American Megatrends Inc., et al. v. Kinglite Holdings Inc., IPR2015-01094 (U.S. Pat. No. 6,401,202);

American Megatrends Inc., et al. v. Kinglite Holdings Inc., IPR2015-01132 (U.S. Pat. No. 6,523,123);

American Megatrends Inc., et al. v. Kinglite Holdings Inc., IPR2015-01133 (U.S. Pat. No. 5,732,268);

American Megatrends Inc., et al. v. Kinglite Holdings Inc., IPR2015-01140 (U.S. Pat. No. 6,519,659);

American Megatrends Inc., et al. v. Kinglite Holdings Inc., IPR2015-01141 (U.S. Pat. No. 6,633,976);

American Megatrends Inc., et al. v. Kinglite Holdings Inc., IPR2015-01188 (U.S. Pat. No. 5,836,013);

American Megatrends Inc., et al. v. Kinglite Holdings Inc., IPR2015-01189 (U.S. Pat. No. 5,836,013);

American Megatrends Inc., et al. v. Kinglite Holdings Inc., IPR2015-01191 (U.S. Pat. No. 6,892,304);

American Megatrends Inc., et al. v. Kinglite Holdings Inc., IPR2015-01197 (U.S. Pat. No. 6,487,656);

American Megatrends Inc., et al. v. Kinglite Holdings Inc., IPR2015-01487 (U.S. Pat. No. 6,308,265); and

American Megatrends Inc., et al. v. Kinglite Holdings Inc., IPR2015-01488 (U.S. Pat. No. 7,185,189). *Id.* at 1–2.

C. The '912 Patent (Ex. 1001)

1. Described Invention

The '912 patent describes a computer that, prior to booting its operating system or after an operating system failure, can communicate with a networked computer. Ex. 1001, Abstract. A “multitasking kernel” that supports communication is implemented in a network-enhanced BIOS. *Id.*

Figure 4 of the '912 patent is reproduced below.

Fig 4.

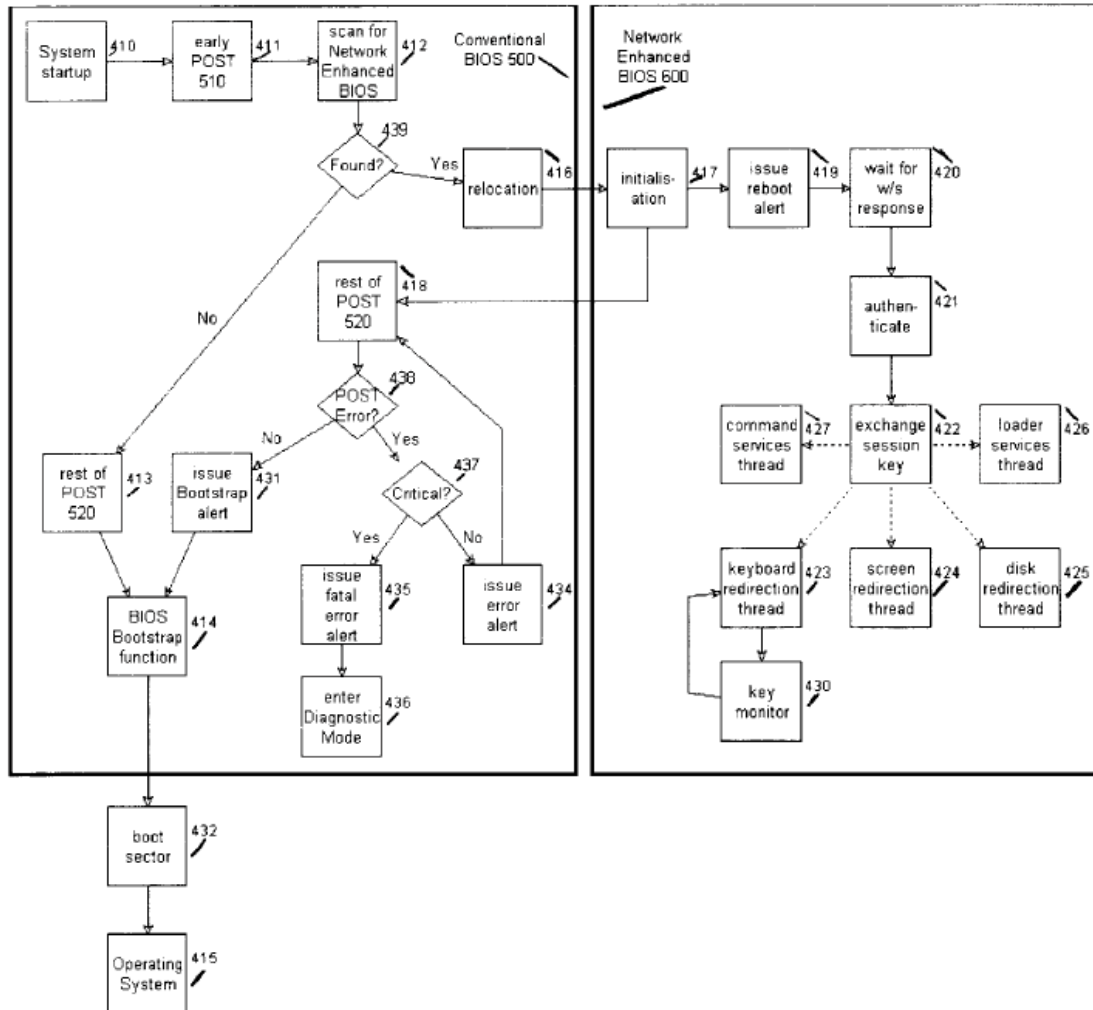


Figure 4 depicts a flowchart showing software contained on a computer configured for communication in accordance with a preferred embodiment.

Figure 4 explains operation of “network-enhanced BIOS” 600, which works with “conventional BIOS” 500 to provide network communication in the absence of a functional operating system. Ex. 1001, 7:1–50. At start-up 410, control passes to “Early Power On Self Test” (POST) 510 which performs preliminary tasks such as programming the memory controller,

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.