

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EMC CORPORATION,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

Case IPR2016-01106
Patent 6,516,442 B1

Before JUSTIN T. ARBES, BRIAN J. McNAMARA, and MINN CHUNG,
Administrative Patent Judges.

CHUNG, *Administrative Patent Judge.*

DECISION
Denying Patent Owner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Intellectual Ventures II LLC (“Patent Owner”) filed a Request for Rehearing (Paper 37, “Req. Reh’g”) of our Final Written Decision (Paper 36, “Final Dec.”) determining claims 1, 5, 9, 10, 12, 24, 28, 32, 33, and 34 of U.S. Patent No. 6,516,442 B1 (Ex. 1001, “the ’442 patent”) to be unpatentable. Patent Owner’s Request for Rehearing is solely focused on the issues relating to full-duplex channels. Patent Owner points to two alleged defects in our Final Written Decision—namely, we misapprehended or overlooked (1) the alleged lack of evidence in the Petition that Reschke discloses a full-duplex channel (Req. Reh’g 11–12) and (2) Patent Owner’s argument in Patent Owner’s Sur-Reply (Paper 33, “PO Sur-Reply”) regarding the purported lack of inherent disclosure of full-duplex channels in Reschke (Req. Reh’g 12–14). In addition, Patent Owner repeats its assertion made in its Sur-Reply that it was deprived of due process because Patent Owner was not permitted to submit declaration evidence on “the lack of inherent disclosure [in Reschke] of full-duplex communications” after the oral hearing. *Id.* at 14–15; *see* PO Sur-Reply 6.

In view of these alleged oversights, Patent Owner requests that we (1) vacate the Final Written Decision and find that the challenged claims have not been shown to be unpatentable or, in the alternative, (2) “reopen the record” to allow Patent Owner to submit a declaration regarding the purported lack of inherent disclosure of a full-duplex channel in Reschke. Req. Reh’g 2, 15. For the reasons set forth below, Patent Owner’s Request for Rehearing is *denied*.

II. STANDARD OF REVIEW

A party requesting rehearing bears the burden of showing that the decision should be modified. 37 C.F.R. § 42.71(d). The challenging party “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed” in a paper of record. *Id.* With this in mind, we address the arguments presented by Patent Owner.

III. ANALYSIS

A. Alleged Lack of Evidence on Full-Duplex Communication in the Petition

Patent Owner asserts that the Petition contained no argument or evidence that Reschke discloses full-duplex communication. Req. Reh’g 11. Patent Owner further argues that our Institution Decision (Paper 9, “Inst. Dec.”) and Final Written Decision overlooked this lack of evidence in the Petition and erroneously determined that Petitioner met its burden at each stage. Req. Reh’g 12.

Patent Owner mischaracterizes our decisions as well as the record evidence underlying the decisions. As discussed in our Institution Decision and Final Written Decision, the Petition identified separate circuitries for forward and reverse communication pathways in Reschke’s channels and argued, based on this disclosure, that Reschke teaches bi-directional and full-duplex channels. *See* Pet. 38–41 (identifying separate circuitries for a “forward” pathway (in Fig. 4A) and “reverse” pathway (in Fig. 4B) of a channel in Reschke) (citing Ex. 1003, col. 11, ll. 37–40, col. 14, ll. 8–11,

Figs. 4A, 4B; Ex. 1002 ¶¶ 136–140); Inst. Dec. 28–30 (citing Pet. 38–41); Final Dec. 45 (citing Pet. 39–41), 47–48.

In our Institution Decision, noting that Patent Owner’s Preliminary Response did not address Petitioner’s argument and evidence regarding the “forward” and “reverse” pathways depicted in Reschke’s Figures 4A and 4B (Inst. Dec. 29–30), we invited the parties to address the “channels” limitation further in their papers, including whether the “forward” and “reverse” pathways in the data switching circuitry of Reschke identified by Petitioner “can operate at the same time to provide full-duplex transmission” (*id.* at 30). In its Patent Owner Response (Paper 15, “PO Resp.”), Patent Owner rejected our invitation as “improper burden shifting” and did not discuss the “forward” and “reverse” pathways of the data switching circuitries described in Figures 4A and 4B of Reschke and relied upon by Petitioner in the Petition. PO Resp. 50–51.

As discussed in our Final Written Decision, our invitation to both parties to discuss the implications of the data switching circuitry disclosed in Figures 4A and 4B of Reschke in no way shifts the burden of proof, which remained at all times on Petitioner. Final Dec. 64. More to the point for purposes of this Decision, the record shows that Patent Owner was aware of our discussion of the evidence in the Petition regarding Reschke’s teaching of full-duplex channels and in fact responded to our discussion, if only to reject our invitation to discuss the evidence presented in the Petition. Nonetheless, Patent Owner in its Request for Rehearing disregards the extensive discussion in our decisions (*see* Req. Reh’g 11 (citing Inst. Dec. 28–30, Final Dec. 43–44)) and contends we overlooked the purported lack of

evidence in the Petition. Patent Owner's argument is unpersuasive because it is based on a mischaracterization of our decisions and the underlying evidence of record.

Patent Owner further asserts that our Final Written Decision overlooked the testimony of Patent Owner's declarant, Donald Alpert, Ph.D., that "Reschke lacks simple disclosure of a processor that can read data from memory simultaneously with writing data to memory, which might evince simultaneous communications in both directions." Req. Reh'g 14 (citing *id.* § II.I); *see also id.* at 10 (citing Ex. 2020 ¶ 81), 7 (citing PO Resp. 51–53; Ex. 2020 ¶ 81).

Patent Owner again mischaracterizes our Final Written Decision and the evidence of record. In the cited portion of the Patent Owner Response, Patent Owner asserted that "[Reschke's] Figure 2, *like Figure 4*, shows data proceeding across a data bus *in one direction* at a time." PO Resp. 53 (first emphasis added) (citing Ex. 2020 ¶ 81). However, as discussed above, Patent Owner at the same time did not discuss, due to purported "improper burden shifting," Figures 4A and 4B of Reschke and whether the "forward" and "reverse" pathways of the data switching circuitries depicted in Figures 4A and 4B can operate simultaneously to provide full-duplex communication. *Id.* at 51. On the very same page of the Patent Owner Response, Patent Owner lumped Figures 4A, 4B, and 4C of Reschke together as "Figure 4" and asserted without adequate explanation that "Figure 4 only shows communications crossing the buses *in one direction at a time*, not simultaneously." *Id.* (citing Ex. 2020 ¶ 81).

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