Trials@uspto.gov
Tel: 571-272-7822

Paper 61
Entered: December 11, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELPHI TECHNOLOGIES, LLC[1],
Petitioner,

v.

MICROCHIP TECHNOLOGY INC.,
Patent Owner.

Case IPR2017-00864
Patent 7,523,243 B2

Before BRIAN J. McNAMARA, DANIEL N. FISHMAN, and MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

FISHMAN, *Administrative Patent Judge.*

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

[1] Petitioner filed a notice of its name change from "Delphi Technologies, Inc." to "Delphi Technologies, LLC." Paper 49, 1–2.

I. INTRODUCTION

Microchip Technology Inc. ("Patent Owner") requests rehearing ("Req. Reh'g." or "Request," Paper 60) of our Final Written Decision ("Dec." or "Decision," Paper 59), which determined that Petitioner had shown, by a preponderance of the evidence, that claims 1, 3–5, 7–9, 11–15, and 18–21 of U.S. Patent No. 7,523,243 B2 (Ex. 1001, the "'243 patent") are unpatentable (Dec. 82).

For the reasons below, the request is *denied*.

II. LEGAL STANDARD

"The burden of showing a decision should be modified lies with the party challenging the decision," and, "[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 the record. 37 C.F.R. § 42.71(d).

III. DISCUSSION

Patent Owner's Request does not identify *any* arguments that we "misapprehended or overlooked" let alone "specifically identify" all such matters. Thus, Patent Owner's Request fails to comply with our rules. Despite this failure of Patent Owner's Request, we address the substance of Patent Owner's argument as follows.

Patent Owner correctly asserts our Final Written Decision construed the term "dedicated USB connection" to mean "a USB connection that may include some shared physical communication path and includes a buffer for maintaining dedicated address, configuration, and response information for

the connection." Req. Reh'g. 1. Patent Owner argues our Decision failed to apply that construction in our analysis of the anticipation ground for independent claims 1, 3, 7, 18, and 23 (and their respective dependent claims). *Id*. at 1–3. Specifically, Patent Owner asserts our Final Written Decision identifies the above construction of dedicated USB connection and notes that the question is "discussed further below" but Patent Owner argues there is no further discussion below in the Final Written Decision of a buffer that maintains "dedicated address, configuration, and response information for the connection" as allegedly required by our construction. *Id*. at 1–2 (citing Dec. 60, 64–65). Patent Owner contends there is no disclosure in Dickens of such a buffer memory and nothing in the Petition or evidence of record to support such a finding. *Id*. at 2. Therefore, Patent Owner argues our Final Written Decision should find claims 1, 3, 7, 18, and 23 (and their respective dependent claims) patentable for the same reasons the Decision found claims 17, 22, and 24 patentable—namely, "because they each require 'a buffer for maintaining dedicated address, configuration, and response information.'" *Id*. at 3.

First, we are not persuaded our Decision overlooked or misapprehended any argument. Furthermore, we are unpersuaded that our Decision was in error regarding independent claims 1, 3, 7, 18, and 23 because these claims have a different scope than claims 17, 22, and 24. As Patent Owner correctly noted, our construction of "dedicated USB connection" is "a USB connection that may include some shared physical communication path and includes a buffer for maintaining dedicated address, configuration and response information for the connection." Dec. 33. Thus, a dedicated USB connection must include a buffer that is *capable*

of storing/maintaining "dedicated address, configuration and response information" regardless of whether such data is actually stored/maintained therein.

Independent claims 1, 3, 7, 18, and 23 do not positively recite that the buffer actually does store or maintain such information. Rather, they merely require a structure that includes a dedicated USB connection—i.e., a USB connection that includes a buffer. Our analysis of independent claims 1, 3, and 7 finds that the Petition has shown (by a preponderance of the evidence) that Dickens discloses the structure of dedicated USB connections including a buffer—namely DRAM 144 of controller 140. Dec. 60. The discussion further below identified in the Decision refers to the discussion on pages 64 through 65 addressing the specific recitation of "endpoint buffers" in dependent claims 2, 6, 16, and 25. Dec. 64–65. The Petition again identifies DRAM 144 within controller 140 of Dickens as the recited endpoint buffers but we were unpersuaded because DRAM 144 is not coupled as recited *between* controller 140 and upstream ports 150. *See id*.

By contrast, apparatus claim 17, dependent from claim 7, specifically recites that *the controller is configured to* maintain such "dedicated address, configuration and response information." In other words, claim 17 positively recites that the controller of claim 7 must be configured to maintain the recited information in the buffer of the dedicated USB connection. In like manner, apparatus claim 24, dependent from claim 23, narrows the apparatus of claim 23 to require that the *controller is operable to* maintain the recited "dedicated address, configuration and response information." Claims 17 and 24, therefore, further limit the structure of the claimed apparatus to require a particular function of the claimed controller.

Dependent method claim 22 similarly narrows the method of claim 18 to require *the additional step* of maintaining the "dedicated address, configuration and response information." Each of claims 17, 22, and 24 positively recites a requirement that "dedicated address, configuration and response information" be stored/maintained in the buffer of the dedicated USB connections. Thus, for each of these dependent claims (17, 22, and 24), our Decision found the Petition failed to show where in Dickens that specific information was stored/maintained as required by each of these dependent claims.

Therefore, we are unpersuaded by Patent Owner that our reasoning for *not* finding claims 17, 22, and 24 (*see* Dec. 66–67) unpatentable necessarily applies to the recitations of independent claims 1, 3, 7, 18, and 23.

IV. CONCLUSION

We have reviewed all of the arguments in the Request for Rehearing and find them to be without merit. Patent Owner has not persuasively shown that our Final Written Decision misapprehended or overlooked any arguments or evidence relating to our finding that claims 1, 3, 7, 18, and 23 (and their respective dependent claims) are unpatentable..

V. ORDER

In view of the foregoing discussion, it is hereby:

ORDERED that Patent Owner's Request for Rehearing is *denied*.

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