UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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KINGSTON TECHNOLOGY COMPANY, INC.,
Petitioner,

v.

MEMORY TECHNOLOGIES, LLC,
Patent Owner.

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Case IPR2019-00638
Patent 7,827,370 B2

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Before JAMESON LEE, J. JOHN LEE,
and JASON M. REPKO, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

DECISION
Denying Instituting of *Inter Partes* Review
35 U.S.C. § 314

I.   INTRODUCTION

A.   Background

On January 29, 2019, Petitioner filed a Petition to institute *inter partes* review of claims 1–3, 5–7, 12–15, 19, and 25 of U.S. Patent No. 7,827,370 B2 (Ex. 1001, "the '370 patent"). Paper 1 ("Pet."). Patent Owner filed a Preliminary Response. Paper 6 ("Prelim. Resp.").

To institute an *inter partes* review, we must determine that the information presented in the Petition 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). Having considered all submissions of both parties, we determine that Petitioner has not demonstrated a reasonable likelihood that it would prevail in establishing the unpatentability of any of claims 1–3, 5–7, 12–15, 19, and 25.

The Petition is *denied*, and no *inter partes* review is instituted.

B.   Related Matters

The parties identify a civil action involving alleged infringement of the '370 patent: *Memory Technologies, LLC v. Kingston Technology Corporation et al.*, No. 8-18-cv-00171-JLS-JDE (C.D. Cal.). Pet. 2, Paper 4, 1. Patent Owner further identifies the following terminated litigations involving the '370 patent: *Memory Technologies, LLC v. SanDisk LLC et al.*, No. 8-16-cv-02163 (C.D. Cal.); *Certain Memory Devices and Components Thereof*, No. 337-TA-1034 (ITC). Paper 4, 1. Patent Owner additionally identifies another petition for *inter partes* review of claims in the '370 patent: IPR2017-00868 (terminated prior to institution decision). *Id.* The petitioner in IPR2017-00868 is not the petitioner in this proceeding.

C.   The '370 Patent

The '370 patent is directed to a method and apparatus that permanently write protects just a portion of a memory. Ex. 1001, Abstr. "Write protect" in that context means the data written into the protected area of memory cannot be written over or erased, like in the case of a read-only-memory. *See id.*, at 1:45–48. The '370 patent explains that preexisting memory cards did not provide the ability for a user to permanently write protect just a portion of a memory card, although it was possible to permanently write protect the entire card. *Id.* at 1:45–54. The '370 patent further explains that the standard Multi-Media Card (MMC) specification provided a command to write protect a portion of the memory card, but that protection can be canceled by another command and, thus, was not permanent. *Id.* at 1:66–2:1.

According to the '370 patent, a new definition for the MMC standard is provided for permanently write protecting a portion of a multi-media card. *Id.* at 2:6–8. A portion of the multi-media card can be permanently write protected while other portions are still available to the user. *Id.* at 2:8–12. Specifically, that is achieved by (1) identifying a bit in a specific data register of the memory card, (2) setting the bit to have a certain predefined value that causes a pre-existing write-protection command to mean permanent write protection of a part of the memory of the memory card, (3) writing information to that memory, and (4) executing the write-protection command concerning that memory. *Id.* at 2:12–21.

Claims 1, 12, and 25 are independent and reproduced below:

1. A method comprising:

write protecting at least one part of a memory by a command;

setting at least one bit in a data register configured to indicate that permanent write protection of the at least one part of the memory is allowed in order to redefine the command to allow permanent write protection, that cannot be un-protected by a command, of the at least one part of the memory; and

executing the command in order to permanently write protect said at least one part of the memory.

Ex. 1001, 5:55–65.

12. An apparatus comprising:

an interface controller arranged to write protect at least one part of a memory of said apparatus by a command;

a data register arranged to define at least one bit to indicate that permanent write protection of the at least one part of the memory is allowed;

a controller arranged to set the at least one bit in order to redefine the command to allow permanent write protection, that cannot be un-protected by a command, of the at least one part of the memory of said apparatus, and

the controller arranged to execute the command in order to permanently write protect said at least one part of the memory.

Id. at 6:31–43.

25. A memory device having stored therein instructions that, when executed, perform:

write protecting at least one part of a memory by a command;

setting at least one bit in a data register configured to indicate that permanent write protection of the at least one part of the memory is allowed in order to redefine the command to allow permanent write protection, that cannot be un-

> protected by a command, of the at least one part of the memory; and
>
> executing the command in order to permanently write protect said at least one part of the memory.

Id. at 8:10–21.

D.   Evidence Relied Upon

Petitioner relies on the following references:[1]

References		Date	Exhibit
Chevallier	U.S. Pub. App. 2004/0083346 A1	Apr. 29, 2004, filed Oct. 24, 2002	Ex. 1003
Toombs	U.S. Patent No. 6,279,114 B1	Aug. 21, 2001	Ex. 1004
Estakhri	U.S. Patent No. 6,262,918 B1	July 17, 2001	Ex. 1005

Petitioner also relies on the Declarations of R. Jacob Baker, Ph.D., P.E. (Ex. 1006).

E.   The Asserted Ground of Unpatentability

Claims Challenged	Basis[2]	References
1–3, 5, 6, 12–15, 25	§ 102(a) / 102(e)	Chevallier
1–3, 5, 6, 12–15, 25	§ 103(a)	Chevallier[3]

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[1] The '370 patent issued from Application 11/176,669, filed July 8, 2005.

[2] The Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112–29, 125 Stat. 284, 287–88 (2011), revised 35 U.S.C. § 103 effective March 16, 2013. Because the challenged patent was filed before March 16, 2013, we refer to the pre-AIA version of § 103.

[3] Petitioner actually asserts the ground as "Chevallier IN VIEW OF THE KNOWLEDGE OF A POSA [Person of Ordinary Skill in the Art]." Pet. 40.

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