

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KINGSTON TECHNOLOGY COMPANY, INC.,
Petitioner,

v.

MEMORY TECHNOLOGIES, LLC,
Patent Owner.

Case IPR2019-00644
Reissued Patent RE45,542 E

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

REPKO, *Administrative Patent Judge.*

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

I. INTRODUCTION

A. Background

Kingston Technology Company, Inc. (“Petitioner”) filed a petition to institute *inter partes* review of claims 18, 23, 24, 28, 29, 32, 33, and 37–40 of U.S. Reissued Patent No. RE45,542 E (Ex. 1001, “the RE542 patent”). Paper 1 (“Pet.”). Memory Technologies, LLC (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

To institute an *inter partes* review, we must determine “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). For the reasons discussed below, Petitioner has not shown a reasonable likelihood that it would prevail in showing that any challenged claim is unpatentable. Thus, we deny the Petition and do not institute an *inter partes* review.

B. Related Matters

The parties identify a civil case involving the RE542 patent: *Memory Technologies, LLC v. Kingston Technology Corp.*, No. 8:18-cv-00171 (C.D. Cal. Jan. 31, 2018). Pet. 2; Paper 4, 1. Patent Owner also identifies two terminated proceedings involving the RE542 patent: *Memory Technologies, LLC v. SanDisk LLC*, No. 8:16-cv-02163 (C.D. Cal. Dec. 6, 2016); and *Certain Memory Devices and Components Thereof*, No. 337-TA-1034 (ITC Dec. 5, 2016). Paper 4, 1. Patent Owner identifies an earlier-filed petition for *inter partes* review of claims in the RE542 patent: *SanDisk LLC v. Memory Technologies, LLC*, IPR2017-01022 (PTAB May 3, 2017) (terminated before decision on institution). *Id.*

C. Reissued Patent RE45,542 E

The RE542 patent describes an invention for determining a peripheral device's power consumption. Ex. 1001, Abstract. A peripheral device's power consumption should not exceed the maximum power that can be supplied by the host device. *Id.* at 1:61–64. But power-consumption requirements vary among peripheral devices. *Id.* at 1:67–2:4. So to determine the required operating voltage, known peripheral devices exchange signals with the host device when the devices are powered on. *Id.* at 2:21–30. To improve operational flexibility, among other things, the peripheral device in the claimed invention negotiates a suitable power-consumption value with an electronic device in different operating situations. *Id.* at 3:4–7. This allows the peripheral device to adjust its power consumption to meet the needs of a given situation. *Id.*

Of the challenged claims, reissued claims 18 and 28 are independent and reproduced below:

18. A peripheral device comprising:
 - a memory storing a default value and a limiting value for power consumption *of the peripheral device*;
 - means for connecting the peripheral device to an electronic device for supplying power to the peripheral device,
 - wherein the power consumption of the peripheral device is set at a startup stage to said default value,

wherein at least said limiting value, which is higher than said default value, is defined for *the power consumption of the peripheral device*, wherein the peripheral device comprises means for setting a maximum power consumption of the peripheral device to a value which is in a range from said default value to said limiting value, said range including said default value and said limiting value, and wherein the peripheral device is configured to receive information from the electronic device for setting the maximum [of the] power consumption of the peripheral device.

Ex. 1001, 12:31–49.

28. A peripheral device comprising:

a memory storing a default value and a limiting value for power consumption *of the peripheral device*;

a connector configured to connect the peripheral device to an electronic device for supplying power to the peripheral device,

wherein [the] *a maximum* power consumption of the peripheral device is set at a startup stage to said default value,

wherein at least said limiting value, which is higher than said default value, is defined for *the power consumption of the peripheral device*,

wherein the peripheral device comprises means for setting [a] *the* maximum power consumption of the peripheral device to a value which is in a range from said default value to said limiting value, said range including said default value and said limiting value, [and]

wherein the peripheral device is configured to receive information from the electronic device for setting the maximum [of the] power consumption of the peripheral device, *and*

wherein the means for setting the maximum power consumption of the peripheral device is configured to obtain the value, as indicated by the received information, and to set the maximum power consumption of the peripheral device to the

value.

Id. at 13:42–14:9.

D. Evidence Relied Upon

Petitioner relies on the following references:

Name	Reference	Exhibit
Garner	U.S. Patent No. 5,724,592	1007
Toombs	U.S. Patent No. 6,279,114 B1	1008

Petitioner also relies on the Declarations of R. Jacob Baker, Ph.D., P.E. Ex. 1002.

E. The Asserted Grounds of Unpatentability

Statutory Basis	Reference(s)	Claim(s) Challenged
Pre-AIA ¹ § 102	Garner	18, 23, 28, 29, 32, 33, 37, 38, and 40
Pre-AIA § 103	Garner and Toombs	18, 23, 24, 28, 29, 32, 33, and 37–40

II. ANALYSIS

A. Principles of Law

The question of obviousness is resolved by underlying factual determinations including: (1) the scope and content of the prior art; (2) any

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, 125 Stat. 284, 287–88 (2011).

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