

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICRON TECHNOLOGY, INC.,
Petitioner,

v.

INNOVATIVE MEMORY SYSTEMS, INC.,
Patent Owner.

Case IPR2016-00320
Patent 6,169,503 B1

Before KARL D. EASTHOM, JAMES B. ARPIN, and
KEVIN W. CHERRY, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

DECISION on REHEARING
Withdrawal of Final Written Decision and Authorization of Sur-Reply
37 C.F.R. §§ 42.5(a) and (b) and 42.71(d)

I. INTRODUCTION

Patent Owner filed a Request for Rehearing (Paper 41, “Reh’g Req.” or “Rehearing Request”) asserting that the panel misapprehended or overlooked two issues in the Final Written Decision (Paper 40, “FWD”). *See* Reh’g Req. 1.

In a rehearing request, “[t]he burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, opposition, or a reply.” 37 C.F.R. § 42.71(d).

For the reasons provided below, we authorize Patent Owner’s request for a sur-reply, rendering other portions of the Rehearing Request moot, and withdraw the Final Written Decision pending consideration of the sur-reply.

II. DISCUSSION

Patent Owner contends the panel misapprehended Patent Owner’s actions in stating “that Patent Owner chose not to avail itself of the opportunity to seek to respond to Petitioner’s new argument and evidence raised in the Baker Reply Declaration (Ex. 1030), overlooking that Patent Owner did, in fact, request [in a post-hearing email] permission to file a sur-reply and expert declaration.” Reh’g Req. 1. Patent Owner also contends the panel misapprehended a portion of the Specification describing an embodiment of Figure 7A of the challenged patent, U.S. Patent No. 6,169,503 B1 (“the ’503 patent,” Ex. 1001). *See id.* at 5–9.

A. Post-Hearing Request

As indicated above, Patent Owner asserts we overlooked Patent Owner’s post-hearing email request for additional briefing and evidence.

See Reh’g Req. 1–4. Without having knowledge of Patent Owner’s attempted post-hearing email request (see Ex. 2016, App’x), we initially found, in the Final Written Decision, that Patent Owner had not sought additional briefing and evidence:

In its Motion [to Exclude (Paper 31)], Patent Owner asserts the following basis for striking the Baker Reply Declaration: “*Patent Owner has no further opportunity to submit any other paper to the Board that can substantively address the new evidence and theories raised by Dr. Baker.*” Mot. 2. During the Oral Hearing, we queried Patent Owner and Petitioner about how to provide an opportunity for Patent Owner to address and alleviate Patent Owner’s stated concerns regarding the alleged new arguments and evidence in the Reply and Baker Reply Declaration, including discussing the possibility of additional briefing and evidence by Patent Owner. *Patent Owner declined the opportunity.* See Tr. 52:3–57:14.

Because Patent Owner chose not to avail itself of an opportunity to seek to respond to what it asserts are new argument and evidence, and its Motion indicates that such an opportunity would have been sufficient (Mot. 2), Patent Owner’s Motion is *denied*. See *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1081 (Fed. Cir. 2015) (“With no Board denial of concrete, focused requests before us, we are not prepared to find that [the appellant] was denied a meaningful opportunity to respond.”); Opp. 15 (“Patent Owner also could have, but did not, request a sur-reply.”) (citing *Belden*, 805 F.3d at 1081).

FWD 54–55 (footnote omitted) (emphases added).¹

¹ During the Oral Hearing, after Patent Owner indicated it needed more time to decide how to respond to the Baker Reply Declaration and Reply, we instructed Patent Owner to confer with Petitioner and contact the Board via email to inform the Board of Patent Owner’s intention regarding additional briefing or other options. See Tr. 57:3–14.

In its Rehearing Request, Patent Owner shows that contrary to the emphasized phrase above as quoted from the Final Written Decision, Patent Owner did attempt to contact the PTAB with a post-hearing email to avail itself of an opportunity to respond with additional briefing and evidence. *See* Reh’g Req. 3–4 (citing Ex. 2016; Ex. 2017).² We were incorrect when we stated “Patent Owner chose not to avail itself of an opportunity to seek to respond to what it asserts are new argument and evidence.” *See* FWD 55.

Regrettably, we first learned of Patent Owner’s attempt to contact the Board through Patent Owner’s Rehearing Request—Patent Owner attached a copy of Patent Owner’s post-hearing email requesting additional briefing and evidence as an exhibit to its Rehearing Request. *See* Ex. 2016, App’x; *supra* note 2.

Patent Owner does not now explicitly request an opportunity to submit a sur-reply or declaration evidence. *See* Reh’g Req. 1–4. Nevertheless, we hereby interpret the Rehearing Request, in light of the post-hearing email request, as a request for a sur-reply. *See* Reh’g Req. 4; Ex. 2016, App’x; FWD 54–55; Paper 31, 2. In its post-hearing email

² Patent Owner provides declaration testimony that it sent a post-hearing email (specifically on Monday, March 27, 2017) following the Thursday (March 23, 2017) Oral Hearing, regarding a possible sur-reply and then followed up thereafter to determine if someone at the Board received the email. *See* Reh’g Req. 3; Ex. 2016; Ex. 2017. Patent Owner’s evidence shows it followed up within a week of the post-hearing email, and “Patent Owner was advised [by a paralegal at the Board] that the Board had received the email.” Reh’g 3–4 (citing Ex. 2017 ¶¶ 6–7). Patent Owner attaches a copy of the email (which includes Petitioner as a recipient) as an appendix to Exhibit 2016.

request, Patent Owner sought to provide briefing to respond to what it contends constitutes new theories of patentability “in the Reply Declaration of Dr. Baker (specifically, paragraphs 24, 31–41, and 51–53, and Exhibits 1031 and 1035 to which Patent Owner objected in Patent Owner’s Motion To Exclude filed in this case).” *See* Ex. 2016, App’x 1; *see also* Paper 31, 2. For its part, Petitioner objects. *See* Ex. 2016, App’x. Patent Owner does not specify a page request for any sur-reply in its email or Rehearing Request. *See* Reh’g Req. 4; Ex. 2016, App’x. Based on the record, we grant Patent Owner a sur-reply not to exceed seven (7) pages to respond to what it contends constitutes new theories of patentability by Petitioner and Dr. Baker. *See* Ex. 2016, App’x.; Paper 31, 2–3.

Notwithstanding that the post-hearing email reflects a past desire by Patent Owner to submit additional declaration evidence with its sur-reply, Patent Owner does not renew that request in its Rehearing Request. *See* Reh’g Req. 1–4; Ex. 2016, App’x. In any case, the record does not warrant additional expert testimony, as the panel will be able to consider Patent Owner’s arguments based on the record as supplemented by the sur-reply.

B. Figure 7A, Claim Construction

Granting additional briefing as discussed above renders moot (as premature) Patent Owner’s contention that we misapprehended aspects of Figure 7A. To support its argument, Patent Owner filed the Madisetti Declaration (Ex. 2018). *See* Reh’g Req. 7 n.2. Patent Owner’s arguments regarding this issue as presented in the Rehearing Request may be addressed subsequently in a re-entered Final Written Decision. As we do not now reach the issue with respect to Figure 7A, Exhibit 2018, which was not authorized and is not authorized by our rules, is expunged.

III. CONCLUSION

Based on the foregoing discussion, we grant Patent Owner authorization to file a sur-reply, as described herein.

IV. ORDER

For the reasons given, it is

ORDERED that Patent Owner may file a sur-reply as outlined above not to exceed seven (7) pages due on or before November 8, 2017;

FURTHER ORDERED that Exhibit 2018 is expunged; and

FURTHER ORDERED that the Final Written Decision is withdrawn pending consideration any sur-reply filed by Patent Owner.

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