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 IPR2019-00654
Patent 7,565,469 B2

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

LEE, JAMESON, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

On January 31, 2019, Petitioner filed a Petition to institute *inter partes* review of claims 19 and 20 of U.S. Patent No. 7,565,469 B2 (Ex. 1001, "the '469 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 exercise discretion under 35 U.S.C. § 325(d) not to institute review, and further find, in the alternative, that Petitioner has not shown a reasonable likelihood that it would prevail in establishing the unpatentability of either claim 19 or claim 20 on any alleged ground of unpatentability.

B. Related Matters

The parties identify a civil action involving the '469 patent: *Memory Technologies, LLC v. Kingston Technology Corp., et al.,* No. 8-18-cv-00171 (C.D. Cal.). Pet. 2, Paper 3, 1. Patent Owner further identifies the following terminated litigations involving the '469 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 3, 1. Patent Owner additionally identifies another petition for *inter partes* review of claims in the '469 patent: IPR2017-00979 (terminated prior to institution decision). *Id.* The petitioner in IPR2017-00979 is not the petitioner in this proceeding.

C. The '469 Patent

The '469 patent is directed to an interface over a bus between a first unit and a second unit, where the bus includes a data signal line. Ex. 1001, 1:57–59. First information is driven over the data signal line from the first unit to the second unit, and the second unit causes a change of state of the data signal line to convey a first meaning. *Id.* at 1:59–63. In response to that change of state of the data signal line, the first unit drives second information to the second unit over the data signal line. *Id.* at 1:62–64. Then the second unit causes a change of state of the data signal line to convey a second meaning. *Id.* at 1:64–67. Thus, the meaning of a change of state of the data signal line at the second unit varies depending on whether it is first information or second information that is communicated from the first unit to the second unit.

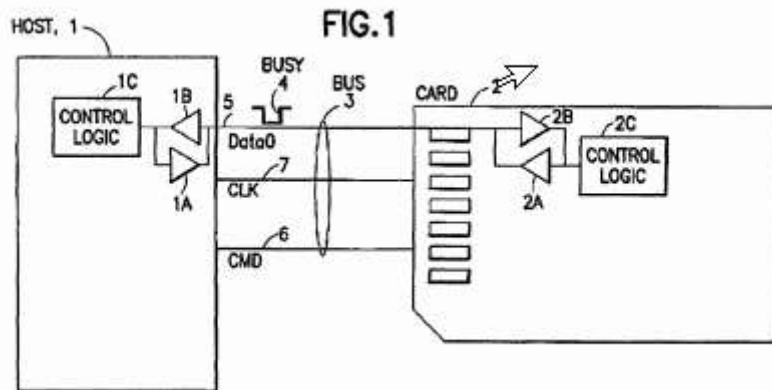Figure 1 of the '469 patent is reproduced below:

Figure 1 is a block diagram showing a first unit coupled to a second unit over a bus. *Id.* at 3:39–40. The first unit is host 1, and the second unit is memory card 2. *Id.* at 3:46–47. Connecting host 1 and memory card 2 is bus 3 that includes data line 5, command line 6, and clock line 7. *Id.* at 3:46–50. Figure 1 illustrates busy signal 4 associated with data line 5. *Id.* at

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3:47–48. Host 1 can be a cellular telephone, a digital camera, a PC, or any other suitable device that can use memory card 2. *Id.* at 3:60–62. Host 1 includes driver 1A and receiver 1B coupled to data line 5, and control logic 1C coupled to driver 1A and receiver 1B. *Id.* at 3:62–65. Memory card 2 includes driver 2A and receiver 2B coupled to data signal line 5, and control logic 2C coupled to driver 2A and receiver 2B. *Id.* at 3:66–4:3.

The '469 patent explains that because host devices typically implement a data block size, e.g., 16 k bytes, that is larger than the block size of data transferrable through an interface of a MultiMedia Card (MMC), e.g., 512 bytes, it is practical to use multiblock write commands. *Id.* at 1:32–39. The '469 patent further explains that in pre-existing operation of an MMC, busy signaling is used to indicate to the host device whether the buffers of the MMC are ready to receive next data. *Id.* at 1:24–28. The '469 patent also describes that generally there is only one busy signal line. *Id.* at 1:29–31. Based on this known configuration, the host device may transfer multiple 512 byte blocks of data to the MMC *without* having to poll the ready status of the MMC's buffers. *Id.* at 1:39–42.

The '469 patent describes a "problem" associated with sending the very last data block during execution of a multiblock write command. *Id.* at 1:43–44. When there are no more data blocks to be transferred, the host device has to learn whether the MMC has finished programming all of the received data blocks in the buffer, and thus needs to poll the MMC for its program ready status. *Id.* at 1:45–48. The '469 patent describes this need as "an inefficient use of the host's processing capacity." *Id.* at 1:48–50.

The '469 patent describes changing the meaning of busy signal 4 during command execution. *Id.* at 4:4–6. For instance, in a multiblock data

transfer operation of the MMC, for the first data blocks that are transmitted from the host device, busy signal 4 from the MMC is used by the MMC to indicate its "buffer busy/ready" status and is so interpreted by the host device, according to a pre-existing definition of busy signal 4. *Id.* at 4:6–9. For the last data block transferred, however, busy signal 4 is used by the MMC differently, to indicate its "programming ready/busy" status, which is not according to the pre-existing definition for busy signal 4. *Id.* at 4:9–10. The '469 patent describes that during the data transfer operation there may be data programming taking place within the MMC in connection with the transferred data, and this "programming busy/ready" status, as conveyed by busy signal 4, informs the host device when internal programming of the MMC is completed. *Id.* at 4:10–15.

The '469 patent explains that by using the invention described therein, there is no need for the host device to have to poll the internal "program busy/ready" status of the MMC, and thus the resources of the host device are conserved. *Id.* at 4:16–19.

Claims 19 and 20 are reproduced below:[1]

19.   A memory device comprising:

[a] a bus interface configured to be coupled to a host through a bus having a data signal line,

[b] the bus interface further comprising a driver at said memory device coupled to said data signal line and a receiver at said memory device coupled to the data signal line, said receiver being operable to receive information comprising a first information portion and a second

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[1] The alphabetical labels for each limitation, in brackets, are added by Petitioner. Pet. 30–38.

> > information portion from the host over the data signal line within a command execution;

> > [c] said driver being operable to drive a change of state of the data signal line to the host within the command execution;

> > [d] said bus interface further comprising a controller coupled to said driver and to said receiver and operable to cause the change of state of the data signal line to have a first meaning after receiving the first information portion within the command execution and to have a second meaning different from the first meaning after receiving the second information portion within the command execution from the host over the data signal line.

Ex. 1001, 9:4–23.

> 20. A memory device as in claim 19,

> > where said bus is further comprised of a command signal line, and where the controller is responsive to at least one command for a multiblock transfer that initiates the command execution received through the command signal line from the host for causing the change of state of the data signal line to have the first meaning after receiving the first information portion and to have the second meaning after receiving second information portion from the host over the data signal line.

Id. at 10:1–10.

D.   Evidence Relied Upon

Petitioner relies on the following references:[2]

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[2] The '469 patent issued from Application 11/250,711, filed October 14, 2005. Ex. 1001, [21]. It also lists ancestral Provisional Application 60/629,098, filed November 17, 2004. *Id.* [60].

Reference		Date	Exhibit
MMC 3.31	MMCA Tech. Committee, MultiMediaCard Ass'n, *The MultiMediaCard System Specification*, version 3.31	May 2003	Ex. 1003
CompactFlash	CompactFlash Ass'n, *CompactFlash Specification Revision 1.3*	July 1998	Ex. 1004

Petitioner also relies on the Declaration of Michael Asao (Ex. 1006) and the Affidavit of Christopher Butler (Ex. 1005).

E.   The Asserted Grounds of Unpatentability

Claims Challenged	Basis[3]	Reference(s)
19 and 20	§ 103	MMC 3.31
19 and 20	§ 103	MMC 3.31 and CompactFlash

II.   ANALYSIS

A.   The Law on Obviousness

The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) when in evidence, objective

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[3] 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.

indicia of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). One seeking to establish obviousness based on more than one reference also must articulate sufficient reasoning with rational underpinnings to combine teachings. *See KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007).

B.   The Level of Ordinary Skill in the Art

Petitioner asserts that the level of ordinary skill in the art corresponds to "a person with a bachelor's degree in electrical engineering or a closely related field, and two or three years of experience in the field of memory system design." Pet. 16. Patent Owner has not articulated a different level of ordinary skill and also has not disputed Petitioner's statement of the level of ordinary skill. In this circumstance, and for purposes of this decision, we adopt the level of ordinary skill as articulated by Petitioner.

C.   Claim Construction

For petitions filed on or after November 13, 2018, a claim shall be construed using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340 (Oct. 11, 2018) (codified at 37 C.F.R. § 42.100 (2019)). Petitioner filed its Petition on January 31, 2019. Paper 1. Thus, we apply the claim construction standard as set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc) ("the *Phillips* standard").

Claim terms are generally given their ordinary and customary meaning as would be understood by one with ordinary skill in the art in the context of the specification, the prosecution history, other claims, and even extrinsic evidence including expert and inventor testimony, dictionaries, and learned treatises, although extrinsic evidence is less significant than the intrinsic record. *Phillips*, 415 F.3d at 1312–17. Usually, the specification is dispositive, and it is the single best guide to the meaning of a disputed term. *Id.* at 1315.

The specification may reveal a special definition given to a claim term by the patentee, or the specification may reveal an intentional disclaimer or disavowal of claim scope by the inventor. *Id.* at 1316. If an inventor acts as his or her own lexicographer, the definition must be set forth in the specification with reasonable clarity, deliberateness, and precision. *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249 (Fed. Cir. 1998). The disavowal, if any, can be effectuated by language in the specification or the prosecution history. *Poly-America, L.P. v. API Indus., Inc.*, 839 F.3d 1131, 1136 (Fed. Cir. 2016). "In either case, the standard for disavowal is exacting, requiring clear and unequivocal evidence that the claimed invention includes or does not include a particular feature." *Id.*

Only those claim terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Ltd.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017); *Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011); *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

Petitioner proposes a construction for two terms:

1.   "*within a command execution*" as meaning—while performing in accordance with a command—; and

2.   "*within the command execution*" as meaning— while performing in accordance with the command—.

Pet. 15–16.

Patent Owner has not proposed a construction for any claim term, and has not disputed the above-noted proposed constructions by Petitioner. We determine that it is unnecessary to provide an express construction for these terms because of the lack of dispute between the parties with respect thereto, because Petitioner's construction essentially reflects what the terms facially or plainly indicate, and because we have no reason, on this record, to conclude that the proposed constructions are too broad or too narrow.

D.   Discretionary Denial under 35 U.S.C. § 325(d)

For reasons discussed below, we exercise discretion under 35 U.S.C. § 325(d) to deny the Petition.

"In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office." 35 U.S.C. § 325(d). Institution of review is permitted, but never compelled. *Harmonic Inc. v. Avid Tech, Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016). Based on the discretionary denial authorized by 35 U.S.C. § 325(d), the factors considered include: (a) the similarities and material differences between the asserted art and the prior art evaluated during examination; (b) the cumulative nature of the asserted art and the prior art evaluated

during examination; (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art; (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments. *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, Case IPR2017-01586, slip op. at 17–18 (PTAB Dec. 15, 2017) (Paper 8) (Precedential in relevant part).

During examination of the '469 patent, an earlier version of MMC 3.31, i.e., Version 3.1 (Ex. 2002 ("MMC 3.1")), was applied by the Examiner against the application claims, first by itself in an obviousness rejection, and then in combination with another reference in a still further obviousness rejection. Ex. 1002, 210, 248. Insofar as the issues involved in this Petition are concerned, the disclosures of MMC 3.31 and MMC 3.1 are essentially the same. The disclosures cited by the Examiner and the disclosures relied on by Petitioner appear in both versions. The disclosures of MMC 3.31 as described immediately below also appear in both versions.

MMC 3.31 provides a system specification for a MultiMediaCard system ("MMC system"). Ex. 1003, 2, 11. It describes MultiMediaCard as a universal low cost data storage and communication media designed to cover a wide area of applications such as electronic toys, organizers, PDAs, cameras, smart phones, digital recorders, MP3 players, pagers, etc. *Id.* at 11. Such a low cost mass storage product is implemented as a "card" with a simple controlling unit, and a compact, easy-to-implement interface. *Id.*

at 15. Communication with the card is achieved through use of a command line or channel CMD and a data line or channel DAT. *Id.* at 18. There also is a separate clock pin CLK on the card for supplying a clock signal. *Id.* With each cycle of a clock signal, a one bit transfer on the command and data lines is carried out. *Id.* The command line is a bidirectional channel used for card initialization and data transfer commands, and the data line is a bidirectional channel, unless the card is a read-only card. *Id.*

The MMC 3.31 describes a block write operation in which a host can write or transfer one or more blocks of data to the card. *Id.* at 38. It describes and supports two different types of block write operations: (1) open-ended multiple block write, and (2) multiple block write with pre-defined block count. *Id.* The command CMD25 starts a transfer of multiple blocks. *Id.* To invoke a transfer with pre-defined block count, the host must additionally use the command CMD23 immediately preceding the command CMD25. *Id.* Otherwise, the command CMD25 would start an open-ended multiple block write operation, in which case the card will continuously accept and program data blocks until a stop transmission command is received. *Id.*

MMC 3.31 describes that the card provides buffers for block writes, so that the next block can be sent while the earlier block is being programmed by the card. *Id.* at 35. MMC 3.31 describes that if the card does not have a free buffer available to receive the next block, it will pull the data line down to low. *Id.* at 63. As soon as one receiving buffer becomes free, the card will stop pulling down on the data line. *Id.* MMC 3.31 further describes: "If all write buffers are full, and as long as the card is in

Programming State (see MultiMediaCard state diagram Figure 19), the DAT line will be kept low." *Id.* at 35.

In the case of an open-ended block write operation, a stop transmission command may be received while the card is busy programming the last received block of data or while the card is idle. *Id.* at 64. In either case, there are still unprogrammed data blocks in the buffers of the card. *Id.* Upon receiving the stop transmission command, the card will activate the busy signal and program these yet to be programmed data blocks. *Id.* MMC 3.31 explains that in the case of multiple block write with a pre-defined block count, a stop command is not required at the end, and that the card will accept the requested number of data blocks and terminate the transaction. *Id.* at 38. MMC 3.31 further describes that the host can use either type of multiple block write at any time. *Id.* For instance, MMC 3.31 describes a host using the stop command to abort the write operation. *Id.*

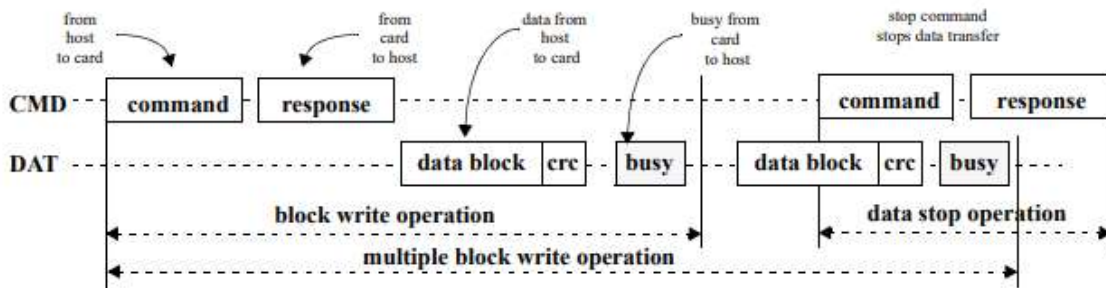Figure 10 of MMC 3.31 is reproduced below:

Figure 10: (Multiple) Block Write Operation

Figure 10 generally illustrates the use of busy signaling on the data line by the card during a multiple block write operation.

In the rejection by the Examiner based on MMC Version 3.1 alone, the Examiner cited to the following disclosure: "If all write buffers are full, and as long as the card is in *Programming State* (see MultiMediaCard state

diagram figure 19), the DAT line will be kept low." Ex. 2002, 28 (cited at Ex. 1002, 212). The Examiner then reasoned that this busy signaling gives notification of the card being busy based on the buffers being full and based on the card being in a programming state. *Id.* In response, the Applicants for patent argued that the cited language only notifies about buffer status and not about the card's programming state. *Id.* at 237–238. Then the Examiner applied a new rejection based on MMC Version 3.1 in combination with U.S. Patent 6,977,656 ("Lee"). *Id.* at 248. Thereafter, Applicants amended the claims to require the change of state to occur during an information transmission operation wherein the meaning of that signal changes from a first meaning to a second meaning. *Id.* at 264–272, 276, 277 (cited at Pet. 13). Applicants argued that the applied prior art does not disclose a change in meaning of the busy signal during an information transmission operation but between two distinct modes of operation. *Id.* at 277. The Examiner still maintained the rejection, but later agreed to allow the claims if the independent claims were amended to require the busy signaling to occur "during the command execution." *Id.* at 308, 311–316 (cited at Pet. 13). That is how patent claim 19 (application claim 31) came to include the requirement of having the change of state reflect two different meanings within the same command execution. *Id.* at 317–319.

Here, Petitioner seeks to apply teachings from the open-ended block write operation of MMC 3.31, which involves a write and a stop command, to MMC 3.31's block write operation with a pre-defined block count, which does not use a stop command. Pet. 38–51. According to Petitioner, in case of the former, MMC 3.31 discloses a busy signal that takes on different meanings depending on the identity of the command being executed. *Id.*

at 44. Petitioner proposes to modify MMC 3.31's block write operation with a pre-defined block count such that it also would apply a busy signal with two different meanings depending on the circumstance even if all the circumstances are within the same command execution. *Id.* at 45–51. Such a proposal directly challenges the Examiner's decision to allow the claims when the claims were amended to include the requirement of "within the command execution." The record shows that MMC 3.1 was fully considered by the Examiner and, in particular, within the context of whether the busy signaling or change of state takes on two different meanings within the same command execution.

As Patent Owner has noted (Prelim. Resp. 20 (citing Ex. 1002, 18, 19, 213, 228, 239)), the Examiner was aware of the open-ended block write operation of MMC 3.1. For example, original application claims 19, 23, and 27 were first rejected by the Examiner on the basis of MMC 3.1's open-ended multiple block write operation. Ex. 1002, 213. Additionally, Petitioner has not specifically or clearly explained what might have been a source of misunderstanding or error on the part of the Examiner to merit a second review of essentially the same prior art.

For the foregoing reasons, all of the factors (a) through (f) of *Becton, Dickinson* weigh in favor of discretionary denial of the Petition, insofar as the alleged ground of unpatentability over MMC 3.31 is concerned. However, we still need to consider the effect of Petitioner's inclusion of another ground of unpatentability, i.e., MMC 3.31 in combination with CompactFlash. For reasons discussed below, this additional ground does not sufficiently merit instituting review. Thus, we determine the Petition should be discretionarily denied under 35 U.S.C. § 325(d).

Petitioner asserts:

> To the extent that MMC 3.31 alone is not deemed to render causing the change of the data signal line "to have a second meaning different from the first meaning after receiving the second information portion within the command execution from the host over the data signal line" obvious, CompactFlash discloses this limitation.

Pet. 60. Petitioner explains that CompactFlash, like MMC 3.31, discloses commands for transferring multiple sectors of data to a card, and that these data sectors correspond to the data blocks of MMC 3.31. *Id.* at 61. Petitioner relies on CompactFlash's disclosure of the use of an "interrupt" as a change of state that takes on two different meanings depending on the circumstance. *Id.* at 61–62. Specifically, Petitioner relies on the following description in CompactFlash of the generation of an interrupt in connection with data transfer of multiple sectors:

> This command writes from 1 to 256 sectors as specified in the Sector Count Register. A sector count of zero requests 256 sectors. The transfer begins at the sector specified in the Sector Number Register. When this command is accepted, the CompactFlash storage card sets BSY, then sets DRQ and clears BSY, then waits for the host to fill the sector buffer with the data to be written. No interrupt is generated to start the host transfer operation. No data should be transferred by the host until BSY has been cleared by the host.

> For multiple sectors, after the first sector of data is in the buffer, BSY will be set and DRQ will be cleared. *After the next buffer is ready for data*, BSY is cleared, DRQ is set and *an interrupt is generated.* When the final sector of data is transferred, BSY is set and DRQ is cleared. It will remain in this state *until the command is complete* at which time BSY is cleared and *an interrupt is generated*.

Ex. 1004, 80 (emphases added) (cited at Pet. 61–62).

Petitioner has not adequately explained the above-cited operation of CompactFlash to support a reasonable likelihood that Petitioner would prevail in establishing that either claim 19 or 20 of the '469 patent is unpatentable over MMC 3.31 and CompactFlash. For instance, Petitioner has not explained the form of the generated interrupt and whether the interrupt merely is a call for attention in response to which the host has to investigate the status of other control lines or signals to ascertain what action is needed. In that case, the meaning of the "interrupt" is the same, no matter when it is generated. Also, Petitioner has not explained whether the BSY signal also is communicated by the card to the host, in addition to any interrupt. If so, the status of the card would seem to be indicated by the BSY signal rather than by an "interrupt." Petitioner has, in its reasoning, oversimplified a complex structure provided by CompactFlash for communication between a host and a card, and has not provided a sufficient explanation. In summary, Petitioner's explanation of CompactFlash is inadequate to support its contentions.

Of the two grounds advanced in the Petition, one presents substantially the same prior art (MMC 3.31) and arguments as was considered during prosecution. The other, also based in part on MMC 3.31, adds a new reference but is insufficiently explained to merit institution. For the foregoing reasons, we exercise discretion under 35 U.S.C. § 325(d) to deny the Petition.[4]

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[4] Patent Owner asserts that because Petitioner failed to certify in its Petition, as is required by 37 C.F.R. § 42.104(a), that the patent for which review is sought is available for *inter partes* review, and that Petitioner is not barred or estopped from requesting review, we should discretionarily deny the

E.   MMC 3.31 Not Sufficiently Shown as Constituting
         Printed Publication Prior Art Against the '469 Patent

Alternatively, notwithstanding our decision to deny the Petition under

35 U.S.C. § 325(d), we determine that Petitioner has not shown a reasonable

likelihood that it would prevail in establishing unpatentability of any

challenged claim, because Petitioner has not sufficiently shown that MMC

3.31 constitutes "printed publication" prior art against the '469 patent.

Only patents and printed publications may serve as the applied prior

art under 35 U.S.C. §§ 102 and 103 in a petition for *inter partes* review.

35 U.S.C. § 311(b). MMC 3.31 is a system specification for a

MultiMediaCard system, provided by the MultiMediaCard Association.

Ex. 1003, 2, 3, 11. It is not a patent. Therefore, MMC 3.31 must qualify as

a printed publication to be applied by Petitioner.

"Public accessibility" is the "touch-stone" in determining whether a

prior art reference constitutes a printed publication. *Acceleration Bay, LLC*

v. Activision Blizzard Inc., 908 F.3d 765, 772 (Fed. Cir. 2018); *Jazz Pharm.,*

Inc. v. Amneal Pharm., LLC, 895 F.3d 1347, 1355 (Fed. Cir. 2018); *In re*

Hall, 781 F.2d 897, 898–99 (Fed. Cir. 1986). A reference is considered

publicly accessible if it was disseminated or otherwise made available to the

extent that persons interested and ordinarily skilled in the subject matter can

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Petition. Prelim. Resp. 15. Patent Owner further asserts that because
Petitioner failed to inform the Board that it urged a different claim
construction in related litigation before the United States District Court
relative to what it proposes in its Petition, we should discretionarily deny the
Petition. *Id.* at 15–17. Petitioner made the required certification on July 19,
2019 (Paper 8), and, as explained herein, we determine the Petition should
be denied for other reasons. Thus, we need not consider whether these
alleged shortcomings of the Petition warrant denial.

locate it with exercise of reasonable diligence. *Acceleration Bay*, 908 F.3d at 772; *Jazz Pharm.*, 895 F.3d at 1355–1356. We do not read the Petition as alleging actual dissemination or presenting proof of actual dissemination. Thus, we discuss only whether Petitioner sufficiently has shown that MMC 3.31 was made available such that persons interested and ordinarily skilled in the subject matter could locate it with exercise of reasonable diligence.

According to Petitioner,

> MMC 3.31 bears a copyright date of May 2003 and was publicly available on the MultiMediaCard Association ("MMCA") website, www.mmca.org, at least as of June 3, 2003. Ex. 1003 at 3; Ex. 1005, at 5. As of November 22, 2001, the MMCA website homepage contained a link for host platform developers to buy an MMCA specification. Ex. 1005 at 11. As of June 3, 2003, the linked page stated that MMC 3.31 was available for purchase. Ex. 1005 at 5. This page provided links to a "System Summary," a "Table of Contents of the MMCA System Specification," and a link to place an order for MMC 3.31. *Id.* The linked System Summary document bears a copyright date of March 2003, and was available on the MMCA website as of at least June 29, 2003. Ex. 1005 at 14–51. As of August 18, 2003, the link to place an order redirected you to a form requesting "Customer Information" and "Product Interest" that would be submitted with the order for MMC 3.31. Ex. 1005 at 6.

Pet. 25.

All of the above-noted assertions are sufficiently supported by the cited evidence. Exhibit 1005, cited by Petitioner, is an Affidavit of Christopher Butler, Office Manager at Internet Archive, who testifies: (1) "The Internet Archive is a website that provides access to a digital library of Internet sites and other cultural artifacts in digital form"; (2) "The Internet Archive has created a service known as the Wayback Machine. The Wayback Machine makes it possible to surf more than 450 billion pages

stored in the Internet Archive's web archive"; (3) "The archived data made viewable and browseable by the Wayback Machine is compiled using software programs known as crawlers, which surf the Web and automatically store copies of web files, preserving these files as they exist at the point of capture"; and (4) "The Internet Archive assigns a URL on its site to the archived files in the format http://web,archive.org/web/[Year in yyyy][Month in mm][Day in dd][Time code in hh:mm:ss]/[Achived URL]." Ex. 1005 ¶¶ 1–4. Mr. Butler further explains:

> The links on the archived files, when served by the Wayback Machine, point to other archived files (whether HTML pages or images). If a visitor clicks on a link on an archived page, the Wayback Machine will serve the archived file with the closest available data to the page upon which the link appeared and was clicked.

Id. ¶ 3.

Attached to the Affidavit of Christopher Butler is Exhibit A, which includes copies of the archived pages from the Wayback Machine at the Internet Archive that correspond to the webpages and homepages referred to by Petitioner in the above-quoted assertions.

As explained by Petitioner, and supported by the evidence Petitioner cites, MMC 3.31 was available for download from the website of the MultiMediaCard Association ("MMCA") by August 18, 2003. Specifically, the website of MMCA contained a link for those who wanted to buy an MMCA specification. Ex. 1005, 11. The link lead to a webpage that offered a link to place an order for MMC 3.31 at $500 dollars per copy, and one did not need to be a member of MMCA to place the order. *Id.* at 5. The order link, as of August 18, 2003, led to a form requesting "Customer

Information," including name and address, and a "submit" button at the bottom of the page. *Id.* at 6.

Patent Owner argues that Petitioner has not shown that the download link on MMCA's website actually worked. Prelim. Resp. 28. The argument is misplaced. In an *inter partes* review, Petitioner need only prove unpatentability by a preponderance of the evidence. 35 U.S.C. § 316(e). In the absence of any reason to suspect a "submit" button on a webpage was a non-working feature, Petitioner does not have to show more in that regard.

Despite the foregoing, however, conspicuously absent is Petitioner's explanation of how an interested and ordinarily skilled person would have arrived at the homepage of MMCA's website. As is noted by Patent Owner, Petitioner has made no assertion or showing that the website of MMCA was sufficiently indexed such that it would be findable by an internet search engine. Prelim. Resp. 29–30 (citing *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1349 (Fed. Cir. 2016)). Similarly, Patent Owner asserts that Petitioner has made an insufficient showing that a person of ordinary skill in the art nonetheless, without MMCA's website being indexed, would have been independently aware of MMCA's website. *Id.* We agree.

The most we can find in the Petition in that regard is the following assertion: "The MMC specification was well-known to those of skill in the art at the time of the invention of the '469 Patent. Ex. 1015 at ¶ 112. The MMC specification was used for commercially available memory cards, with which a POSA would have been familiar. Ex. 1015 at ¶ 112; Ex. 1007." Pet. 26. The supporting testimony of Dr. Baker is as follows:

> 112. MMC cards are removable electronic cards that can be used as memory devices in portable computers and electronic devices. (Ex. 1003 at 11, 15). The MMC specification was well

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known to those of skill in the art at the time of the invention of the '469 Patent. The MMC specification was used for commercially available memory cards, with which one of ordinary skill in the art would have been familiar. (*See* Ex. 1007).

Ex. 1015 ¶ 112. There is a gap, however, between knowing the technical features of a standard, and knowing where that standard came from or where to locate documentation for that standard. The two are not the same. Petitioner does not assert or provide evidence indicating that the MultiMediaCard Association or its website were well known to one with ordinary skill in the art, or that one with ordinary skill in the art would have otherwise been aware of, or directed to, the MMCA website to obtain MMC 3.31. The deficiency is unchanged even if some commercial memory cards at the relevant time implemented the standard described by MMC 3.31. Accordingly, Petitioner has failed to explain sufficiently how interested persons with ordinary skill in the art would have arrived at the home page of MultiMediaCard Association. It is incumbent upon Petitioner to provide an adequate explanation in the Petition. Petitioner did not do so here.

For the foregoing reasons, Petitioner has not sufficiently shown, for purposes of instituting review, that MMC 3.31 constitutes a "printed publication" against the '469 patent. Because all alleged grounds of unpatentability rely at least in part on MMC 3.31, Petitioner has not shown a reasonable likelihood that it would prevail in establishing unpatentability of any challenged claim.

III. CONCLUSION

We exercise discretion under 35 U.S.C. § 325(d) not to institute review and to deny the Petition. In the alternative, without regard to

discretionary denial under 35 U.S.C. § 325(d), we determine that Petitioner has not shown a reasonable likelihood that it would prevail in establishing unpatentability of any claim.

<div align="center">IV.   ORDER</div>

It is

ORDERED that the Petition is *denied* and that no *inter partes* review is instituted for any challenged claim on any ground of unpatentability.

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