

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN MEGATRENDS, INC.,
MICRO-STAR INTERNATIONAL CO., LTD,
MSI COMPUTER CORP.,
GIGA-BYTE TECHNOLOGY CO., LTD., AND
G.B.T., INC.,
Petitioner,

v.

KINGLITE HOLDINGS INC.
Patent Owner

Case IPR2015-01189
Patent 5,836,013

Before PHILLIP J. KAUFFMAN, GLENN J. PERRY,
TREVOR M. JEFFERSON, and BRIAN J. McNAMARA,
Administrative Patent Judges.

PERRY, *Administrative Patent Judge.*

DECISION
Granting Petitioner's Request for Reconsideration
37 C.F.R. § 42.71(c, d)

American Megatrends, Inc., Micro-Star International Co., Ltd., MSI Computer Corp., Giga-Byte Technology Co., Ltd., and G.B.T., Inc., (collectively, “Petitioner”) filed a Petition (Paper 6, “Pet.”) to institute an *inter partes* review of claims 1–28 of Patent 5,836,013 (“the ’013 Patent”) pursuant to 35 U.S.C. § 311 *et seq.* Patent Owner Kinglite Holdings, Inc. filed a Preliminary Response (Paper 13, “Prelim. Resp.”) to the Petition.

Both of Petitioner’s challenges rely upon Patent 6,523,079 (“Kikinis CIP,” Ex. 1005). We denied the Petition. Paper 15, “Dec.”

In our decision we concluded that Petitioner had not established an effective date for Kikinis CIP that pre-dates the Aug. 11, 1994 effective date of the ’013 patent and therefore dismissed the Petition. Dec. 7. Petitioner requests reconsideration of our decision. Paper 16.

Petitioner argues in its request for reconsideration that Kikinis CIP be accorded an effective date based on Application 08/019,592, the filing date of which precedes Aug. 11, 1994.

Inter partes review permits a petitioner to challenge a patent claim “only on the basis of prior art consisting of patents or printed publications.” 35 USC §311. In this case, Petitioner brings a challenge based on US Patent 6,523,079 (“Kikinis CIP”)(Ex. 1005). Because a *inter partes* review challenge cannot be made based on the disclosure of an abandoned patent application, the subject matter of the Kikinis application is irrelevant *unless* Petitioner establishes in the Petition that Kikinis CIP is entitled to a priority date based on the Kikinis application.

To establish priority, there must be a continuity of applications each disclosing the subject matter relied upon. Our understanding of the relationships among various applications and patents relevant to this

description” in another application is to no avail without a priority benefit that requires both continuity and the “salient description” being present in each application establishing the continuity. An *inter partes* review cannot be based on “salient description” or on an abandoned application.

There are two possible paths of continuity from the Kikinis application to Kikinis CIP. The first is the path is the one argued by Petitioner – that the Kikinis CIP copied subject matter from an abandoned application. Because the copied from application was abandoned before filing of the application issuing as the Kikinis CIP, that incorporation does not establish continuity.

The second possible path of continuity (indicated by three bold arrows in the diagram) is through application 08/683,567 (“the ’567 application”), which is a CIP of the Kikinis application. A CIP application must have some subject matter in common with its parent. However, it can have less than all of the parent subject matter and it can have additional subject matter. Petitioner did not discuss this path in the Petition. The Kikinis CIP states on its face that it is a “continuation” of the ’567 application. Ex. 1005. Therefore, we presume that Kikinis CIP and the ’567 application have the same specification.

Petitioner favorably compared the Kikinis CIP with the Kikinis application. Pet. 17 (comparing Ex. 1004, pp. 15–17, Figs. 1–3 with Ex. 1005, pp. 23–24, Figs. 21–22). Even though Petitioner did not discuss the content of the ’567 application, we assume for purposes of this decision that because the ’574 application is a continuation of the ’567 application these two applications must have identical disclosures. If that is not the case, we urge Patent Owner to come forward with evidence to that effect.

Case IPR2015-01189
Patent 5,836,013

Even though Petitioner does not discuss the '567 application, not even once, the record evidence reflects the “continuation” relationship between the '567 application and the '574 application leading to the Kikinis CIP. We therefore conclude that it would be appropriate to evaluate the alleged grounds substantively and we will do so. A decision on the merits of the alleged grounds will follow in due course.

ORDER

Accordingly, it is

ORDERED that the requested relief is *granted*. The Board will consider the challenges set forth in the Petition.

PETITIONER:

Vivek Ganti
Gregory Ourada
HILL, KERTSCHER & WHARTON, LLP
vg@hkw-law.com
go@hkw-law.com

PATENT OWNER

Christopher Frerking
chris@ntknet.com