

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
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

INTRODUCTION

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.

We have jurisdiction under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted unless the information presented in the Petition shows “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Upon consideration of the Petition, Patent Owner’s Preliminary Response, and the evidence of record, we conclude Petitioner has not established a reasonable likelihood it would prevail with respect to at least one of the challenged claims. We, therefore, deny the Petition.

Real Parties in Interest

Petitioner names no real parties in interest other than the parties listed as Petitioner.

Related Matters

Petitioner indicates that the ’013 Patent is asserted against Micro-star International Co., Ltd. and MSI Computer Corp. in the District Court for the Central District of California in *Kinglite Holdings Inc. v. Micro-Star Int’l Co. Ltd., et al.*, CV 14-03009 JVS (PJWx) (C.D. Ca). Pet. 6; Paper 7, 1.

Petitioner indicates that the following *inter partes* reviews are related. *American Megatrends Inc., et al. v. Kinglite Holdings Inc.*, IPR2015-01079 (U.S. Pat. No. 6,373,498 B1); *American Megatrends Inc., et al. v. Kinglite*

Case IPR2015-01189
Patent 5,836,013

Holdings Inc., IPR2015-01081 (U.S. Pat. No. 5,987,604); *American Megatrends Inc., et al. v. Kinglite Holdings Inc.*, IPR2015-01094 (U.S. Pat. No. 6,401,202 B1); *American Megatrends Inc., et al. v. Kinglite Holdings Inc.*, IPR2015-01132 (U.S. Pat. No. 6,523,123 B2); *American Megatrends Inc., et al. v. Kinglite Holdings Inc.*, IPR2015-01133 (U.S. Pat. No. 5,732,268); *American Megatrends Inc., et al. v. Kinglite Holdings Inc.*, IPR2015-01140 (U.S. Pat. No. 6,519,659 B1); *American Megatrends Inc., et al. v. Kinglite Holdings Inc.*, IPR2015-01141 (U.S. Pat. No. 6,633,976 B1); *American Megatrends Inc., et al. v. Kinglite Holdings Inc.*, IPR2015-01188 (U.S. Pat. No. 5,836,013); *American Megatrends Inc., et al. v. Kinglite Holdings Inc.*, IPR2015-01189 (U.S. Pat. No. 5,836,013); *American Megatrends Inc., et al. v. Kinglite Holdings Inc.*, IPR2015-01191 (U.S. Pat. No. 6,892,304 B1); and *American Megatrends Inc., et al. v. Kinglite Holdings Inc.*, IPR2015-01197 (U.S. Pat. No. 6,487,656 B1). Paper 7, 1–2.

THE '013 Patent (Ex. 1001)

Described Invention

The '013 Patent describes chipset (platform)-independent methods for compressing and decompressing system ROM code of a computer (e.g., BIOS, setup program, and one or more option ROMs). Ex. 1001, Abstract. Compressing takes into account chipset particulars needed for reading to and writing from registers associated with a particular chipset by appending computer specific information (e.g., from a shadow RAM table) to the uncompressed ROM file before compressing portions of it. *Id.*

Illustrative Claim

Claim 1 of the '013 Patent below is illustrative of the challenged claims:

1. In a computer having a processor and storage, a computer-implemented method for generating a system read only memory (ROM) computer file that can access the ROM of a target computer, the method comprising the steps of:

- receiving, for processing by the processor, a system ROM computer file comprising a non-compressible portion and one or more compressible portions, including a setup program and one or more option ROM images,
- the non-compressible portion comprising a decompression program;
- appending, to the non-compressible portion, information on accessing the ROM of a target computer;
- compressing, via the processor, each compressible portion to generate compressed data;
- generating, via the processor, a compressed system ROM computer file comprising the compressed data and the appended non-compressible portion; and
- storing the compressed system ROM computer file in the storage.

PETITIONER'S CHALLENGES

Petitioner contends that claims 10–13, 18, and 20 are unpatentable under 35 U.S.C. § 102 as anticipated by Kikinis CIP;¹ and that claims 1–9, 14–17, 19, and 21–28 are obvious under 35 U.S.C. § 103 based on Kikinis CIP, Research Disclosure,² and Begur.³ Pet. 14. Petitioner's challenges rely upon the testimony of Gabriele Sartori, Ph.D. Ex. 1014. Pet. 13.

KIKINIS CIP AS PRIOR ART

All of Petitioner's challenges rely on Kikinis CIP. Pet. 25–31 and 47–

¹ U.S. Patent 6,523,079 B2—Kikinis *et al.*, issued February 18, 2003 (Ex. 1005, “Kikinis CIP”).

² RESEARCH DISCLOSURE; January, 1992, Number 333; Kenneth Mason Publications Ltd. (Ex. 1008, “Research Disclosure”).

³ U.S. Patent 5,202,994—Begur *et al.*, issued April 13, 1993 (Ex. 1006, “Begur”).

59.

The following is an image of a portion of the first page of Kikinis CIP specifying its “related U.S. Application Data.”

Related U.S. Application Data

- (63) Continuation of application No. 08/683,567, filed on Jul. 17, 1996, now abandoned, which is a continuation-in-part of application No. 08/144,231, filed on Oct. 28, 1993, now Pat. No. 5,835,732, and a continuation-in-part of application No. 08/019,592, filed on Feb. 19, 1993, now abandoned.

Petitioner contends that although U.S. Application 09/785,574 (“the ’574 Application”) resulting in issuance of Kikinis CIP was filed after the critical date (August 11, 1994) of the ’013 Patent, the effective date of Kikinis CIP reaches back in time to before the ’013 Patent critical date through a priority claim to abandoned U.S. Patent Application 08/019,592 (“the ’592 application”) which was filed on February 19, 1993. Pet. 14.

Petitioner argues that: 1) “the Kikinis CIP [which] restates the salient description of the compressed BIOS of the [’592] application” (*id.*); 2) “Kikinis et al. applied for substantially the same invention years before the filing of the application of the [’]013 Patent” (*id.* at 16); and 3) the “Kikinis CIP issued as U.S. Pat. No. 6,523,079 (Ex. 1005, which incorporates the entirety of the Kikinis Application [(referring to the ’592 application)] by reference).” *Id.* at 17. Petitioner argues “how similar the conceptions of the [’]013 Patent and [the Kikinis (’592) application] are” by comparing claim 12 of the ’592 application with claim 10 of the ’013 Patent. Pet. 18–19.

Patent Owner contends that Kikinis CIP is not prior art against the challenged claims because the ’592 application went abandoned on June 18, 1997 (Ex. 1010, 3), well before the filing (February 15, 2001) of the ’574 application. Further, Patent Owner argues that there is no “incorporation by

reference” into the ’574 application. Prelim. Resp. 7.

We have reviewed Kikinis CIP and find that although there may be subject matter in it that also appears in the ’592 application, we do not find an explicit “incorporation by reference” of the ’592 application.

Furthermore, Patent Owner is correct that the ’592 application went abandoned well before the filing of the ’574 application. Thus, there is no direct continuity between the ’592 application and the ’574 application.

We note from the “Related U.S. Application Data,” above that Kikinis CIP also recites that the ’574 application is a continuation of application 08/683,567 (“the ’567 application”) which, in turn, is a continuation-in-part of the ’592 application. However, there is no evidence presented in this record concerning the subject matter of the ’567 application. Petitioner has not traced the subject matter relied upon from the ’592 application through the ’567 application. Given that the ’567 application is a continuation-in-part of the ’592 application, we make no assumption regarding the extent of any common subject matter between them.

Accordingly, Petitioner has not established that Kikinis CIP is entitled to the benefit of the ’592 application.

CONCLUSION

For the subject matter of Kikinis CIP on which Petitioner relies, Petitioner has not established a priority date prior to the critical date of the ’013 Patent. All of Petitioner’s challenges rely upon Kikinis. We therefore determine that the Petition does not establish a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of claims 1–28 under 35 U.S.C. § 102 or § 103 based on Kikinis CIP alone and in combination.

ORDER

Accordingly, it is

ORDERED that pursuant to 35 U.S.C. § 314, an *inter partes* review is hereby denied as to all grounds raised in the Petition for the reasons stated above and no trial is instituted.

PETITIONER:

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

PATENT OWNER

Christopher Frerking
chris@ntknet.com

George C. Summerfield
STADHEIM & GREAR LTD.
summerfield@stadheimgrear.com