

**UNITED STATES INTERNATIONAL TRADE COMMISSION  
Washington, D.C.**

**IN THE MATTER OF  
CERTAIN COMPUTER AND COMPUTER  
PERIPHERAL DEVICES, COMPONENTS THEREOF  
AND PRODUCTS CONTAINING SAME**

**Investigation No. 337-TA-841**

**RESPONDENTS ACER, INC., KINGSTON TECHNOLOGY COMPANY, INC.,  
NEWEGG, INC., AND ROSEWILL INC.'S PETITION FOR REVIEW OF INITIAL  
DETERMINATION FINDING A VIOLATION BASED ON U.S. PATENT NO. 6,976,623**

**RESPONDENTS' CONDITIONAL PETITION FOR REVIEW OF INITIAL  
DETERMINATION OF FINDING OF VALIDITY AND DOMESTIC INDUSTRY OF  
THE REMAINING PATENTS IN SUIT**

**SUMMARY OF SAME**

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SUMMARY OF PETITION

I. INTRODUCTION ..... I

II. THE ALJ ERRED IN FINDING A VIOLATION BASED ON THE '623 PATENT ..... I

III. THE ALJ ERRED IN FINDING THAT TPL ESTABLISHED A DOMESTIC INDUSTRY WITH RESPECT TO EACH ASSERTED PATENT BASED ON ITS LICENSING ACTIVITIES ..... IV

IV. THE “ACTIVE ADAPTER” PATENTS: THE ‘443, ‘424 AND ‘847 PATENTS. .... VI

V. THE “ERROR CORRECTION DETERMINATION” PATENT: THE ‘549 PATENT ..... VII

VI. ADDITIONAL BASES OF NON-INFRINGEMENT OF THE ACTIVE ADAPTER PATENTS NOT ADDRESSED IN THE ID..... VIII

PETITION AND CONTINGENT PETITION

I. INTRODUCTION ..... 1

A. Background of the Technology..... 2

B. Petition for Review – The ‘623 Patent..... 2

C. Contingent Petition for Review – The ‘443, ‘424, ‘847, and ‘549 Patents..... 4

II. THE ALJ ERRED WITH REGARD TO U.S. PATENT NO. 6,976,623 ..... 6

A. Background Of The ‘623 Patent ..... 6

B. The ALJ’s Claim Construction Ruling ..... 7

C. The ALJ’s Infringement Findings With Regard To The ‘623 Patent Constitute Reversible Error ..... 7

1. The ALJ’s Construction of “Accessible in Parallel To Transfer Data” is Erroneous ..... 8

2. The Undisputed Facts Show that the Accused Products Are Unable To Operate Two Memory Cards in Parallel ..... 13

3. The ID Improperly Shifts the Burden of Proof to Respondents ..... 18

D. The ALJ Clearly Erred By Declining To Find The ‘623 Patent Invalid..... 19

PUBLIC VERSION OF A CONFIDENTIAL DOCUMENT

1. The ALJ Erred By Finding That The Pro II Does Not Anticipate The ‘623 Patent..... 20

2. The ALJ Erred By Finding That The Uno Mas Article Does Not Anticipate the Asserted Claims of the ‘623 Patent. .... 28

3. The ALJ Erred By Finding That the Kaneshiro Patent Does Not Render the Asserted Claims Invalid..... 32

E. TPL Did Not Establish That A Domestic Industry Exists For The ‘623 Patent... 38

F. Conclusion Regarding The ‘623 Patent ..... 39

III. THE ALJ ERRED IN FINDING THAT TPL ESTABLISHED A DOMESTIC INDUSTRY WITH RESPECT TO EACH ASSERTED PATENT BASED ON ITS LICENSING ACTIVITIES ..... 39

A. Introduction and Summary ..... 39

B. The ALJ Improperly Concluded that There is an “Adequate” Nexus Between the Asserted Patents and TPL’s CORE Flash Portfolio Activities ..... 42

1. There is No Evidence that TPL’s Licensees’ Efforts Relate to “An Article Protected By” Any of the Asserted Patents ..... 42

2. The Evidence Demonstrates the Relative Weak Value Contributed by the Asserted Patents to the CORE Flash Portfolio ..... 45

3. The Scope of the Technology Covered by the CORE Flash Portfolio is Much Broader than the Scope of Any of the Asserted Patents ..... 47

C. The ALJ Failed To Allocate TPL’s Licensing Expenses to Any of the Asserted Patents, Including the ‘623 Patent ..... 49

D. The Evidence Presented by TPL Fails to Establish that TPL’s Investment in the ‘623 Patent, or Any Other Asserted Patent, is Substantial ..... 52

1. The ALJ Erred in Attributing the Entire ██████████ in Expenses that He Found Relate to Licensing to the Asserted Patents ..... 53

2. The ALJ Erred in Applying or Failing to Address Factors Relevant in Determining the Substantiality of TPL’s Licensing investments ..... 54

E. OnSpec Issues ..... 59

IV. THE “ACTIVE ADAPTER” PATENTS: THE ‘443, ‘424 AND ‘847 PATENTS ..... 60

A. Invalidity ..... 60

PUBLIC VERSION OF A CONFIDENTIAL DOCUMENT

- 1. The Asserted Claims Are Invalid Over the Lipponen References under the ALJ’s Claim Construction and Regardless of the Priority Dates Assigned..... 60
- 2. If the Commission Reverses the ALJ’s Non-Infringement Holding, the SD Specification Invalidates the Asserted Claims of the ‘443, ‘424 and ‘847 Patents..... 62
- 3. The ALJ Erroneously Found That The ’928 Publication Does Not Invalidate The Asserted Claims Of The Active Adapter Patents. .... 67
- 4. The ALJ Misapplied Federal Circuit Law on Priority Dates, which Caused Other Prior Art to be Disqualified in Error. .... 69
- V. THE “ERROR CORRECTION DETERMINATION” PATENT: THE ‘549 PATENT ..... 74
  - A. The ALJ Erred in Finding That AwYong Was Not Invalidating Prior Art. .... 74
    - 1. Respondents Presented Sufficient Evidence to Demonstrate that AwYong Was Publicly Available Prior Art..... 74
    - 2. The Asserted Claims of the ‘549 Patent Are Invalid under AwYong ..... 76
  - B. To the Extent the Commission Disagrees With the ALJ’s Interpretation of the Claim Language, Then U.S. Patent No. 6,987,927 (“the ’927 Patent”) Anticipates the Asserted Claims of the ’549 Patent..... 79
- VI. ADDITIONAL BASES OF NON-INFRINGEMENT OF THE ACTIVE ADAPTER PATENTS NOT ADDRESSED IN THE ID ..... 82
  - A. If The Commission Decides To Review Non-Infringement, It Also Should Review Certain Claim Limitations of the Active Adapter Patents Not Addressed In The ID..... 82
    - 1. TPL Did Not Prove That Respondents’ Accused Products Have Contact Pins Separate and Distinct from Interconnection Means/Pins..... 83
    - 2. TPL Did Not Prove That Respondents’ Accused Products Have Contact Pins Mounted on a Housing Surface at Locations Adapted to Interface with Different Types of Cards. .... 85
    - 3. TPL Did Not Prove That Respondents’ Accused Products Have Contact Pins Integrated Within or That Protrude from Molded Plastic of an Adapter..... 87
- VII. CONCLUSION..... 89

PUBLIC VERSION OF A CONFIDENTIAL DOCUMENT

CASES

*Becton, Dickinson and Co. v. Tyco Healthcare Group, LP*,  
616 F.3d 1249 (Fed. Cir. 2010).....12

*Certain Auto. Multimedia Display & Navigation Sys.*,  
Inv. No. 337-TA-657, Initial Determination at 110-112 (Oct. 27, 2009).....75

*Certain Devices for Mobile Data Communication*,  
Inv. No. 337-TA-809, Order No. 58 .....75

*Certain Elec. Devices With Image Processing Systems, Components Thereof, &  
Associated Software*,  
337-TA-724, Order No. 29 .....75

*Certain Integrated Circuits, Chipsets, and Products Containing Same Including  
Television*,  
Inv. No. 337-TA-786, ID at 166-167 (Aug. 17, 2012) .....43

*Certain Mobile Devices, Associated Software and Components Thereof*,  
Inv. No. 337-TA-744, Final Initial Determination, at 117 (December 20, 2011) .....31

*Certain Video Game Systems and Controllers*,  
Inv. No. 337-TA-743, Comm'n Op at 4-5 (Jan. 20, 2012).....43

*Chimie v. PPG Indus., Inc.*,  
402 F.3d 1371 (Fed. Cir. 2005).....9, 10

*Coaxial Cable Connectors & Components Thereof & Prods. Containing Same*,  
337-TA-650, Comm'n Op. at 50 (Apr. 14, 2010).....40

*Computer Forensic Devices & Prods. Containing Same*,  
337-TA-799, ID at 17 (Nov. 27, 2012).....51

*Digital Photo Frames & Image Display Devices & Components Thereof*,  
337-TA-807.....43

*Elekta Instrument S.A. v. O.U.R. Scientific Intern., Inc.*,  
214 F.3d 1302 (Fed. Cir. 2000).....12

*Ferring BV v. Barr Labs., Inc.*,  
437 F.3d 1181 (Fed. Cir. 2006).....62

*Graham v. John Deere Co.*,  
383 U.S. 1 (1966).....35

PUBLIC VERSION OF A CONFIDENTIAL DOCUMENT

*Honeywell Int'l, Inc. v. United States*,  
81 Fed. Cl. 514 (Fed. Cl. 2008), *rev'd on other grounds*, 596 F.3d 800 (Fed. Cir.  
2010).....75

*In re Cronyn*,  
890 F.2d 1158 (Fed. Cir. 1989).....75

*In re Hall*,  
781 F.2d 897 (Fed. Cir. 1986).....75

*In re Katz*,  
687 F.2d 450, 215 USPQ 14 (CCPA 1982).....29

*In Re Lister*,  
583 F.3d 1307 (Fed. Cir. 2009).....75

*Integrated Circuits*,  
337-TA-786, ID at 166 (Aug. 20, 2012).....46, 52, 53

*Integrated Circuits, Chipsets, & Prods. Containing Same Including Televisions*,  
337-TA-786, Comm'n Op. at 24 (Oct. 10, 2012)..... passim

*InterDigital Communications v. International Trade Commission*,  
707 F.3d 1295 (Fed. Cir. 2012).....55

*Invitrogen Corp. v. Clontech Labs., Inc.*,  
429 F.3d 1052 (Fed. Cir. 2005).....62

*John Mezzalingua Assoc., Inc. v. Int'l Trade Comm'n*,  
660 F.3d 1322 (Fed. Cir. 2011).....48, 54, 55, 56

*Lemelson v. U.S. et al.*,  
752 F.2d 1538 (Fed. Cir. 1985).....18

*Liquid Crystal Display Devices, Including Monitors, Televisions, & Modules, &  
Components Thereof*,  
337-TA-749/741, Comm'n Op. at 117, 122 (Jul. 6, 2012).....41

*Lockwood v. American Airlines, Inc.*,  
107 F.3d 1565 (Fed. Cir. 1997).....70, 71

*Motiva, LLC v. Int'l Trade Comm'n*,  
716 F.3d 596 (Fed. Cir. 2013).....55

*Multiform Desiccants, Inc. v. Medzam, Ltd.*,  
133 F.3d 1473 (Fed. Cir. 1998).....12

PUBLIC VERSION OF A CONFIDENTIAL DOCUMENT

*Multimedia Display & Navigation Devices & Sys., Components Thereof, & Prods. Containing Same,*  
337-TA-694, Comm’n Op. at 7-8 (Jul. 22, 2011).....40, 48

*Phillips v. AWH Corp.,*  
415 F.3d 1303 (Fed. Cir. 2005) (en banc).....12

*PowerOasis, Inc. v. T-Mobile USA, Inc.,*  
522 F.3d 1299 (Fed. Cir. 2008).....70, 72, 73

*Prods. Having Laminated Packaging, Laminated Packaging, & Components Thereof,*  
337-TA-874, ID at 44 (July 5, 2013) .....58, 59

*Riverwood Intern. Corp. v. R.A. Jones & Co., Inc.,*  
324 F.3d 1346 (Fed. Cir. 2003).....29

*Seal-Flex, Inc. v. Athletic Track and Court Const.,*  
172 F.3d 836 (Fed. Cir 1999).....18, 19

*Semiconductor Chips & Prods. Containing Same,*  
337-TA-753, Comm’n Op. at 48-49 (Aug. 17, 2012).....42

*Thomson, S.A. v. Quixote Corp.,*  
166 F.3d 1172 (Fed. Cir. 1999).....27

*Tokai Corp. v. Easton Enterprises, Inc.,*  
632 F.3d 1358 (Fed. Cir. 2011).....38

**STATUTES**

5 U.S.C. § 556(d) .....75

19 U.S.C. § 1337(a)(2).....59

35 U.S.C. § 102..... passim

35 U.S.C. § 120..... VII, VIII, 5

*Omnibus Trade & Competitiveness Act of 1988, Pub. L. No. 100-418, § 1342, 102 Stat. 1107, 1213*.....54, 56

**SUMMARY OF PETITION**

**I. INTRODUCTION**

While the ALJ correctly found non-infringement with respect to all but one of the Asserted Patents, the ALJ made clear legal and factual errors with regard to that one patent – U.S. Patent 6,976,623 (“the ’623 Patent”). Specifically, with regard to the ’623 patent, the ALJ erroneously construed a critical claim term, misapplied the undisputed factual record, and incorrectly found that Complainant Technology Properties Limited, LLC (“TPL”) had a domestic industry for the ’623 Patent. The ALJ compounded this error by performing either a flawed analysis or in two cases, no analysis at all of the prior art. As discussed below, for each of these reasons, the finding of a violation based on the ’623 Patent should be reversed.

With respect to the remaining patents, if the ALJ’s finding of no violation is upheld, no additional consideration is necessary. However, in the unlikely event that the Commission reverses the ALJ’s finding of non-infringement set forth in the Initial Determination (“ID”), a myriad of additional bases for finding the lack of a violation remain. Some of the additional bases were erroneously dismissed by the ALJ in the ID; others were not addressed in the ID. As described below, each one, however, provides a sufficient basis for finding no violation of Section 337.

**II. THE ALJ ERRED IN FINDING A VIOLATION BASED ON THE ’623 PATENT**

TPL has asserted combinations of independent claims 1, 9, and 17 and dependent claims 2-4, 10-12, 18 of the ’623 Patent against Acer, Kingston, and Newegg/Rosewill (“the ’623 Respondents”). The ’623 Patent was filed on November 18, 2002, and is not entitled to an earlier filing date for prior art purposes. Each claim of the ’623 Patent requires that multiple different memory card interfaces be accessible in parallel, though the language of the claims varies slightly.



The ALJ committed legal error in his construction and interpretation of the “accessible in parallel” limitation, and as a result committed clear error in finding the independent claims to be infringed. During prosecution of the ‘623 Patent, the applicant told the Patent Office that the claims of the ‘623 Patent were different from the prior art based on the “accessible in parallel” limitation. Specifically, the applicant argued that the prior art disclosed switching between memory cards, and thus that access of memory cards in different card slots was necessarily **in sequence**. The applicant argued its claims require that the card slots be accessible **in parallel**.

Despite acknowledging the disclaimer, the ALJ’s interpretation of the “accessible in parallel” limitation constitutes legal error, as it includes systems in which slots are only accessible in sequence. The ALJ also erroneously found that merely being able to insert multiple cards at the same time satisfies the “accessible in parallel” limitation regardless of whether those system *accessed* cards in sequence (as distinguished in prosecution) or in parallel. This construction is also erroneous because it obviates the term “in parallel” in the asserted claims. Additionally, the ALJ committed legal error because he interpreted the claims from the perspective of a lay user, rather than one of skill in the art. As a result, the ALJ erroneously focused on what “appears to be happening at the same time to the user” rather than the actual timing of the relevant events.

The ALJ’s erroneous claim construction resulted in an erroneous infringement finding. The undisputed evidence shows that Respondents’ products operate in sequence, which is exactly what the applicant distinguished from the Asserted Claims during prosecution. Respondents’ experts presented un rebutted technical evidence that accesses to multiple memory cards occur in sequence one at a time, and the technical documents produced during discovery clearly show the switching circuits present in the disclaimed prior art systems. Finally, the ALJ

improperly shifted the burden of proof to the Respondents by ignoring the evidence of sequential access, saying it “does not necessarily mean that the memory cards are incapable of being accessed in parallel.”

The ALJ also clearly erred by declining to find the ‘623 Patent invalid – dismissing several of Respondents’ references with absolutely no analysis.

First, the ALJ clearly erred by finding that the Atech Pro II device does not anticipate the ‘623 Patent. It is undisputed that the Pro II discloses each limitation of each asserted claim of the ‘623 Patent. While Respondents’ expert testified based on factual evidence produced by Atech, TPL’s expert failed to provide **any** evidence, including expert testimony, about the Pro II. It is also undisputed that the Pro II is prior art to the ‘623 Patent. Atech’s witness testified that he displayed the device to the public at the Comdex show in Las Vegas in November, 2001, and provided invoices evidencing the sale of at least eight Pro II devices to a commercial customer in February of 2002. Since the evidence establishes that (1) the functionality of the Pro II satisfied the claims of the ‘623 Patent and (2) the product never changed during the relevant time period, it was clear error for the ALJ to find that the Pro II does not anticipate the ‘623 Patent.

The ALJ also clearly erred by finding that the Uno Mas Article does not anticipate the ‘623 Patent. Respondents provided undisputed evidence that the Uno Mas Article discloses each limitation of each claim of the ‘623 Patent, and presented a *prima facie* case that the article is prior art to the ‘623 Patent under 35 U.S.C. § 102(a). Since TPL did nothing to dispute that evidence (and even used the described prior art Uno Mas product as proof of technical DI), the Uno Mas Article clearly anticipates the ‘623 Patent. The ALJ’s brief statement about the Uno Mas Article, which concludes that it does not invalidate the ‘623 Patent simply because Respondents’ arguments about the uncontroverted evidence were relatively brief, is clear error.

The ALJ also clearly erred by finding that the Kaneshiro patent does not invalidate the '623 Patent. The Kaneshiro patent is unquestionably prior art, and TPL's expert did not dispute that it anticipates the independent claims. Respondents' arguments regarding obviousness of the dependent claims constituted clear and convincing evidence that the combination of the Kaneshiro patent with either the '369 Patent or the Dell Inspiron 3000 Manual renders the dependent claims obvious. As with the Uno Mas Article, the ALJ's dismissal of Respondents' arguments out of hand constitutes clear error.

Finally, the ALJ erred by finding that TPL established a domestic industry in the '623 Patent. TPL's domestic industry evidence is not specific to any particular patents in its large portfolio, and is especially lacking because the '623 Patent was not even a focus of TPL's licensing activities. Accordingly, TPL cannot establish a domestic industry in the '623 Patent.

### **III. THE ALJ ERRED IN FINDING THAT TPL ESTABLISHED A DOMESTIC INDUSTRY WITH RESPECT TO EACH ASSERTED PATENT BASED ON ITS LICENSING ACTIVITIES**

The '623 Respondents request the Commission to review the ALJ's determination that the economic prong of the domestic industry requirement was satisfied with respect to the '623 Patent, and all Respondents seek conditional review, for the same reasons, that a domestic industry exists for any of the remaining Asserted Patents.

The ALJ erred in finding that TPL's licensing activities establish a domestic industry. The ALJ applied the wrong legal standard, ignoring Federal Circuit and Commission precedent and the legislative history, in concluding that TPL's revenue-driven licensing activities related to its CORE Flash Portfolio satisfied the economic prong of the domestic industry requirement under Section 337(a)(3)(C). The ALJ failed to properly consider whether TPL's portfolio licensing activities had the requisite nexus to the particular asserted patents, whether TPL's expenditures constituted licensing investments, and whether TPL's investments in the asserted

patents were substantial. Indeed, the ALJ characterized the determination on substantiality as an “extremely close call.”

The ALJ’s conclusions are in contradiction with the facts and based only on TPL’s self-serving testimony that is unsupported by any documentation. There is no evidence that TPL’s activities are related “to the articles protected by the patent,” and the ALJ himself found in his technical prong analysis that TPL failed to demonstrate that its licensees’ products practice any claim of any Asserted Patent. There is no evidence that the value of the asserted patents to the CORE Flash Portfolio is anything but weak -- none of the Asserted Patents have been successfully litigated, and the evidence demonstrates that TPL’s licensing activity actually focuses on the entire CORE Flash Portfolio. There is also no evidence that the scope of the CORE Flash Portfolio and the Asserted Patents are at all similar, and none of the Asserted Patents are related to an industry standard. Further, TPL failed to allocate its licensing expenses to any of the asserted patents and instead relied on its expenses for the entire CORE Flash Portfolio.

The ALJ erred in determining that the totality of the expenses from TPL’s revenue-driven licensing program constituted a substantial investment in any of the asserted patents, and the ALJ’s findings in the ID were not specific to any Asserted Patent, including the ‘623 Patent on which a violation was found. The ALJ also failed to address other factors related to substantiality: the fact that TPL does not engage in ancillary licensing activities, such as ensuring compliance with license agreements, and providing training, design assistance or technical support to licensees; the fact that TPL does not exploit the Asserted Patents in some manner other than licensing, such as research, development or engineering activity; and whether TPL’s alleged licensing activities are continuing in light of its bankruptcy filing.

Additionally, while the ALJ correctly found that TPL is not permitted to rely on OnSpec's expenditures and that TPL's sales of OnSpec products alone are insufficient to satisfy the economic prong of domestic industry, the ALJ erred in failing to consider Respondents' additional arguments that [REDACTED] [REDACTED] are too remote in time to establish a valid domestic industry.

Thus, if the Commission reviews the ALJ's ID, Respondents respectfully request that the determination that TPL established a domestic industry be reversed.

#### **IV. THE "ACTIVE ADAPTER" PATENTS: THE '443, '424 AND '847 PATENTS.**

To the extent that the Commission reverses the ALJ's finding of non-infringement for the '443, '424, and '847 patents, the Commission should nonetheless find no violation because the record evidence clearly shows that these patents are invalid and the ALJ clearly erred by finding otherwise.

First, the ALJ improperly held that the asserted claims are valid over a prior art reference, Lipponen, that describes a multi-card reader that accepts MMC and SIM cards. The ALJ held that a SIM card is not a memory card but, in doing so, overlooked Lipponen's description that demonstrates a SIM card stores messages, subscriber contacts and other data. Lipponen renders the asserted claims of the '443, '424 and '847 Patents invalid.

Second, if the Commission reverses the ALJ's non-infringement holding that the Respondents' accused products do not perform "mapping" as claimed, then it should also reverse the ALJ's holding that the '443, '424 and '847 Patents are valid over the SD Specification. TPL's infringement claims are directed to products that support MMC and SD cards in a common slot, subject matter that is disclosed in the prior art SD Specification. The ALJ correctly held that the Respondents' support of MMC and SD cards does not constitute mapping and, as a consequence, held that the SD Specification does not invalidate the asserted claims. If

the Commission finds otherwise, then the SD Specification invalidates the asserted claims because it discloses the same SD/MMC operations that are performed in the Respondents' products.

Third, the ALJ erroneously dismissed the extensive, unrebutted evidence that Respondents cited regarding Japanese Patent Publication JP H11-15928 ("the '928 Publication"). In the event that the Commission decides to review the ALJ's non-infringement finding, Respondents submit that it should also review the determination that the '928 Publication does not invalidate the Active Adapter Patents.

Fourth, the ALJ misapplied Federal Circuit law when awarding a priority date to the '443, '424, and '847 Patents based on a parent patent, U.S. Patent No. 6,438,638 (the '638 Patent). The ALJ acknowledged testimony from TPL's expert witness admitting that the '638 Patent does not disclose all elements of the '443, '424, and '847 Patents' claims but nonetheless awarded the priority date because the missing subject matter was known to persons of skill in the art. This is legal error. The '638 Patent fails to disclose: 1) molded plastic connectors and embedded contact pins as claimed in the '443 Patent, and 2) multiple sets of contact pins for multiple card types mounted in a single housing as claimed in the '424 and '847 Patents. The '638 Patent, therefore, cannot provide the basis for a priority claim under 35 U.S.C. § 120 by the '443, '424, and '847 Patents, regardless of what would have been known by someone of skill. The ALJ's error in this regard led to other errors, causing him to reject several prior art references from further analysis.

**V. THE "ERROR CORRECTION DETERMINATION" PATENT: THE '549 PATENT**

To the extent that the Commission reverses the ALJ's finding of non-infringement of the '549 patent, the Commission should nonetheless find no violation because the Asserted

Claims of the '549 Patent are invalid. In the ID, the ALJ erred in ignoring the documentary evidence and assigning no weight to sworn testimony establishing the prior art date of the AwYong thesis. The AwYong thesis was publicly available prior to the critical date of the '549 Patent, and it renders the asserted claims of the '549 Patent invalid. Additionally, if the Commission decides that the ALJ's interpretation of the claim language of the '549 Patent was incorrect and instead adopts TPL's proposed interpretation regarding the "determining" and "detector to determine" claim limitations, then U.S. Patent No. 6,987,927 to Battaglia *et al.* invalidates the '549 Patent.

**VI. ADDITIONAL BASES OF NON-INFRINGEMENT OF THE ACTIVE ADAPTER PATENTS NOT ADDRESSED IN THE ID**

The ALJ correctly found that there is no violation with respect to any of the asserted claims of the '443, '424 or '847 Patents on the ground that Respondents' accused products do not perform "mapping" as claimed in those patents, and the Commission need not review that aspect of the ID. In addition to the "mapping" argument, Respondents argued that the accused products do not infringe because the configuration of the contact pins in those products does not meet certain limitations of the asserted claims of the '443, '424 or '847 Patents. The ALJ did not address those additional non-infringement arguments in the ID, and Respondents submit that the Commission should review those arguments in the event it determines to review the ALJ's ruling of non-infringement.

**PETITION AND CONTINGENT PETITION**

**I. INTRODUCTION**

In this Section 337 investigation, Complainant TPL asserted 38 claims scattered among six patents against hundreds of products provided by 19 separate Respondents. At hearing, TPL largely failed to prove infringement. The Administrative Law Judge (“ALJ”) found no violation on four patents due to TPL’s failure to prove infringement and its failure to satisfy the technical prong of the domestic industry requirement. As for a fifth patent, the ALJ found a violation only as to a subset of the asserted claims and that TPL had established a domestic industry under Section 337(a)(3)(C). Infringement issues on the sixth patent were rendered moot because TPL settled with the only Respondent accused under that patent.

Regarding the ‘623 Patent under which a violation was found, Respondents Acer Inc.; Kingston Tech. Co., Inc.; and Newegg, Inc./Rosewill Inc. respectfully request the Commission to review the ALJ’s finding of a violation in light of the following three issues: (1) the erroneous finding of infringement; (2) the improper dismissal of several invalidity arguments; and (3) the incorrect conclusion that the economic prong of the domestic industry requirement was satisfied.

Should the Commission decide to review the ID with respect to the four patents for which no violation was found (U.S. Patent Nos. 7,295,443; 7,522,424; 7,719,847; and 7,162,549 (“the ‘443, ‘424, ‘847, and ‘549 Patents”), Respondents Acer Inc.; Canon Inc.; Hewlett-Packard Co.; Seiko Epson Corp.; Kingston Tech. Co., Inc.; Newegg, Inc./Rosewill Inc.; and HiTi Digital, Inc. respectfully request review of the following issues: (1) the ALJ’s finding of a domestic industry based on TPL’s licensing activities; (2) legal errors in the ALJ’s invalidity analyses; and (3) failure to address additional bases for finding no infringement.



**A. Background of The Technology**

The asserted patents in this investigation relate to flash memory technology, specifically, flash memory card readers. Since the mid-1990s, a variety of flash memory cards have emerged on the market. Each type of card has its own standard setting forth the instructions for designing both the cards themselves and the readers that interface with them. Originally intended for use with digital cameras, today's flash memory cards are used in a variety of products – such as computers, printers, tablets, and even cell phones – many of which include built-in card readers. Whether integrated within a computer device or sold as a stand-alone product, all flash memory card readers include two basic components: a “slot” for physically receiving a card, and a controller for interfacing with it.

TPL's patents are directed generally to multi-format card readers. Neither TPL nor the patents' inventors invented flash memory technology or flash memory card readers. Many of the flash memory standards at issue here (*e.g.*, SD, MMC, CompactFlash, SmartMedia) predate the asserted patents and are thus prior art. Two of these prior art card standards – MMC and SD – are designed to be used in a common card slot. Throughout this investigation, TPL read its patents' claims to cover any device capable of reading more than one type of flash memory card in a single slot (in the case of the '443, '424, and '847 Patents); any device capable of reading flash memory cards both with and without controllers (in the case of the '549 Patent); and any device capable of transferring files from one memory card to another (in the case of the '623 Patent).

**B. Petition For Review – The '623 Patent**

Respondents Acer, Kingston, Newegg, and Rosewill (collectively, “the '623 Respondents”) respectfully seek Commission review of those portions of the ID that address the issues of infringement, invalidity, and domestic industry under the '623 Patent. Commission

review is warranted because the ALJ committed legal error in construing certain claim terms in the '623 Patent, which in turn resulted in and contributed to clearly erroneous factual findings of infringement and no invalidity. Specifically, the '623 Respondents seek review on the following three issues.

First, the ALJ erred in finding that the '623 Respondents' products infringed the '623 Patent. This infringement finding rests on an erroneous construction of the claims' "accessible in parallel" term. Moreover, the undisputed facts demonstrate that Respondents' products cannot access two memory cards in parallel. Further, the ALJ improperly shifted the burden to Respondents to prove that its products do not infringe.

Second, the ALJ overlooked a myriad of prior art devices, patents, and publications in upholding the validity of the '623 Patent. This petition focuses on three pieces of prior art: the Pro II prior art device, the Uno Mas Article, and the Kaneshiro Patent.

Third, the ALJ erred in finding that TPL established a domestic industry. The ALJ applied the wrong legal standard, ignoring Federal Circuit and Commission precedent and the legislative history, in concluding that TPL's revenue-driven licensing activities related to its CORE Flash Portfolio satisfied the economic prong of the domestic industry requirement under Section 337(a)(3)(C). The ALJ failed to properly consider whether TPL's portfolio licensing activities had the requisite nexus to the particular asserted patents, whether TPL's expenditures constituted licensing investments, and whether TPL's investments in the asserted patents were substantial. Indeed, the ALJ characterized the determination on substantiality as an "extremely close call."

The ALJ's conclusions on domestic industry are in contradiction with the facts and based only on TPL's self-serving testimony that is unsupported by any documentation. There is no

evidence that TPL's activities are related "to the articles protected by the patent," that the value of the asserted patents to the CORE Flash Portfolio is anything but weak, or that the scope of the CORE Flash Portfolio and the Asserted Patents are at all similar. TPL failed to allocate its licensing expenses to any of the asserted patents, and the ALJ erred in determining that the totality of those expenses constituted a substantial investment in any of the asserted patents.

**C. Contingent Petition For Review – The '443, '424, '847, And '549 Patents**

Should the Commission decide to review the ALJ's determination of no violation for the '443, '424, '847, and '549 Patents, Respondents Acer, Canon, HP, Seiko Epson, Kingston, Newegg, Inc./Rosewill Inc., and HiTi respectfully request consideration of the following issues.

First, for the same reasons as discussed with respect to the '623 Patent in the Petition for Review, the ALJ erroneously determined that TPL's licensing activities establish a domestic industry for all of the asserted patents. Also, while the ALJ correctly found that TPL is not permitted to rely on OnSpec's expenditures and that TPL's sales of OnSpec products alone are insufficient to satisfy the economic prong of domestic industry, the ALJ erred in failing to consider Respondents' additional arguments that OnSpec's alleged investments, which ceased in 2008 when it was dissolved, are too remote in time to establish a valid domestic industry.

Second, the ALJ improperly held that the asserted claims are valid over a prior art reference, Lipponen, that describes a multi-card reader that accepts MMC and SIM cards. The ALJ held that a SIM card is not a memory card but, in doing so, overlooked Lipponen's description that demonstrates a SIM card stores messages, subscriber contacts and other data. Lipponen renders the asserted claims of the '443, '424 and '847 Patents invalid.

Third, if the Commission reverses the ALJ's non-infringement holding that the Respondents' accused products do not perform "mapping" as claimed, then it should also reverse the ALJ's holding that the '443, '424 and '847 Patents are valid over the SD Specification.

TPL's infringement claims are directed to products that support MMC and SD cards in a common slot, subject matter that is disclosed in the prior art SD Specification. The ALJ correctly held that the Respondents' support of MMC and SD cards does not constitute mapping and, as a consequence, held that the SD Specification does not invalidate the asserted claims. If the Commission finds otherwise, then the SD Specification invalidates the asserted claims because it discloses the same SD/MMC operations that are performed in the Respondents' products.

Fourth, the ALJ misapplied Federal Circuit law when awarding a priority date to the '443, '424, and '847 Patents based on a parent patent, U.S. Patent No. 6,438,638 (the '638 Patent). The ALJ acknowledged testimony from TPL's expert witness admitting that the '638 patent does not disclose all elements of the '443, '424, and '847 Patents' claims but nonetheless awarded the priority date because the missing subject matter was known to persons of skill in the art. This is legal error. The '638 Patent fails to disclose: 1) molded plastic connectors and embedded contact pins as claimed in the '443 Patent, and 2) multiple sets of contact pins for multiple card types mounted in a single housing as claimed in the '424 and '847 Patents. The '638 Patent, therefore, cannot provide the basis for a priority claim under 35 U.S.C. § 120 by the '443, '424, and '847 Patents, regardless of what would have been known by someone of skill. The ALJ's error in this regard led to other errors, causing him to reject several prior art references from further analysis.

Fifth, the ALJ erred in ignoring the documentary evidence and assigning no weight to sworn testimony establishing the prior art date of the AwYong thesis. The AwYong thesis was publicly available prior to the critical date of the '549 Patent, and it renders the asserted claims of the '549 Patent invalid. Additionally, if the Commission decides that the ALJ's interpretation of

the claim language of the '549 Patent was incorrect and instead adopts TPL's proposed interpretation regarding the "determining" and "detector to determine" claim limitations, then U.S. Patent No. 6,987,927 to Battaglia *et al.* invalidates the '549 Patent.

Sixth, the ID offers no guidance regarding the ALJ's consideration of numerous bases of non-infringement that were presented and argued at the hearing. If the Commission determines to review the ALJ's position on "mapping" with respect to the '443, '424, and '847 Patents, Respondents respectfully offer an additional basis for finding no infringement: TPL's failure to show that the accused products meet the claimed "contact pin" limitations. Specifically, TPL failed to prove that the accused products have (1) contact pins separate and distinct from interconnection means/pins, as required by the asserted claims of the '424 and '847 Patents; (2) contact pins mounted on a housing surface at locations adapted to interface with different types of cards, as required by the asserted claims of the '424 and '847 Patents; and (3) contact pins integrated within or that protrude from molded plastic of an adapter, as required by the asserted claims of the '443 Patent.

## **II. THE ALJ ERRED WITH REGARD TO U.S. PATENT NO. 6,976,623**

### **A. Background of The '623 Patent**

The '623 Patent is entitled "Flash Juke Box," was filed on November 18, 2002, issued on December 20, 2005, and names Sreenath Mambakkam, Venkidu Arockiyaswamy, and Larry Lawson Jones as inventors. (JX-0001.0003). There is no dispute that the '623 Patent is entitled to an effective filing date of its actual filing date, November 18, 2002. (ID at 85).

TPL asserted independent claims 1, 9, and 17, and dependent claims 2-4, 10-12, 18, and 19 against Acer, Newegg, and Rosewill. (ID at 12). TPL asserted independent claims 1, 9, and 17, and dependent claims 2, 10, and 18, against Kingston. (ID at 12). Each asserted claim of the '623 Patent requires multiple memory card interfaces that are accessible in parallel. Specifically,

independent claims 1 and 9 require that “the memory card of the first type and the memory card of the second type are accessible in parallel to transfer data from the memory card of the first type to the memory card of the second type.” (JX-0001, 5:33-37, 6:11-15). Independent claim 17<sup>1</sup> requires “selectively operating the first and second subsets to provide access to the memory cards of the first and second types in parallel to transfer data from the memory card of the first type to the memory card of the second type.” (JX-0001, 6:44-47). These terms are referred to as the “accessible in parallel” terms.

### **B. The ALJ’s Claim Construction Ruling**

During claim construction, the parties briefed the following terms of the ‘623 Patent:

1. [Memory Cards] “accessible in parallel” (claims 1 and 9);
2. “to provide access... in parallel” (claim 17); and
3. “to transfer data from the memory card of the first type to the memory card of the second type” (claims 1, 9, and 17).

The ALJ, who incorporated his Order 23 regarding claim construction by reference in the ID, construed the terms “accessible in parallel” and “to provide access to the memory cards of the first and second types in parallel” together, and found that those terms have their plain and ordinary meaning. (ID at 31; Order 23 at 63). The ALJ construed the third disputed phrase, “to transfer data ...” to have its plain and ordinary meaning. Order 23 at 69.

### **C. The ALJ’s Infringement Findings With Regard to The ‘623 Patent Constitute Reversible Error.**

As the ALJ correctly notes in the ID, the dispute regarding infringement of the ‘623 Patent relates to the meaning and application of the claim term “accessible in parallel to transfer

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<sup>1</sup> With respect to claims 17-19, the ‘623 Respondents note that their petition is technically a contingent petition as the ALJ found claims 17-19 to be non-infringed for a separate and independent ground. However, because the ALJ’s finding of infringement of the “accessible in parallel” limitation applied to all of the Asserted Claims, Respondents address this limitation collectively for all of the claims.

data.” If the Accused Products are able to *access* two memory cards in parallel to transfer data, they practice this limitation, whereas if they cannot, they do not. The ALJ erroneously concluded, however, that the Accused Products practiced this limitation despite a complete lack of credible evidence of infringement and substantial, unrebutted evidence that the Accused Products are in fact *incapable* of accessing two memory cards in parallel.

**1. The ALJ’s Construction of “Accessible in Parallel to Transfer Data” is Erroneous.**

Although the ALJ found that the accessible in parallel terms have their plain meaning, the ALJ nonetheless provides an erroneous claim construction for these terms. In particular, in the claim construction order and the ID, the ALJ asserted that “[t]he ’623 patent contains no requirement that each memory card in the invention will be transmitting or receiving data simultaneously...This language does not require that the cards function simultaneously, *but rather that it is possible for them to be in their respective slots simultaneously*, so the operator of the system can access them without taking them in or out.” (Order No. 23 at 61; ID at 53) (emphasis added).

This construction is legally flawed, because it does not require that an Accused Product actually *be capable* of accessing two memory cards in parallel. The ALJ’s erroneous construction removes any requirement that memory cards be accessible in parallel and replaces it with the requirement it merely be possible for an Accused Product to hold two cards at one time. Under the ALJ’s construction, a product that can only access memory cards in sequence one at a time would still practice the claims as long as two cards could be physically inserted at the same time. This construction is clear error, as it ignores the intrinsic evidence.

**a. The Applicant Disclaimed Switching Between Memory Cards.**

The term “accessible in parallel” was expressly discussed during the prosecution of the ’623 patent, so its construction is subject to prosecution history estoppel. *See Chimie v. PPG Indus., Inc.*, 402 F.3d 1371, 1384 (Fed. Cir. 2005).

During prosecution the applicant distinguished the “accessible in parallel” limitation from the prior art by saying the prior was only accessible in sequence.<sup>2</sup> In particular, the applicant expressly disclaimed systems in which “no more than one interface can be operative at a given point in time”:

In fact, Pua describes that the memory card control interface 20 comprises a memory card switching circuit which is switched to one of the interfaces 30 under control of a microprocessor. For example, in paragraph 32, Pua states, “If, for example, the host reads from or writes to a Compact Flash card, the microprocessor will switch this circuit to the Compact Flash interface. If, for example, the host reads from or writes to a Smart Media card, the microprocessor will switch this circuit to the Smart Media interface.” Thus, in other words, depending on the type of card being written to or read from, the microprocessor switches the memory card switching circuit to the interface that supports the card being written to or read from. Since the memory card switching circuit is switched between interfaces, it follows that no more than one interface can be operative at a given point in time. Thus, access to the interfaces does not occur in parallel.

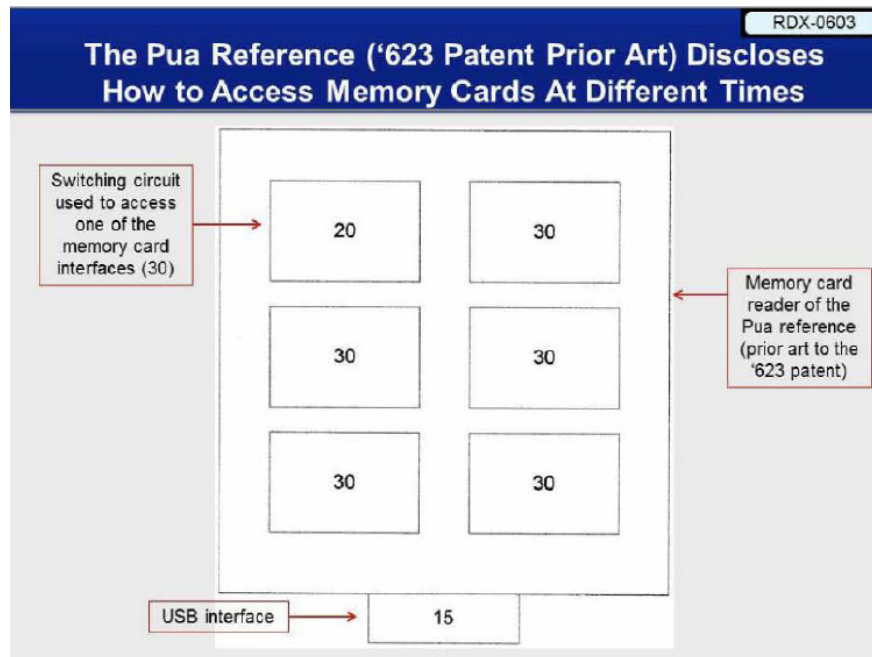
(RX-0043.121-22).

Moreover, the applicant admitted that in prior art configurations with a “switching circuit”, the “access...does not occur in parallel.” (*Id.*) (emphasis in original). The architecture of this disclaimed sequential (non-parallel) system is shown below in Figure 1 of Pua:

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<sup>2</sup> This distinction between accessing in sequence and accessing in parallel is critical as the Accused Products use the precise type of sequential switching that the applicant distinguished during the prosecution of the ’623 Patent.





(RDX-0603; *see also* RX-2983.0002)

As shown above, the distinguished-over prior art disclosed a multiple memory card adapter 10 that included five separate memory card connectors 30. (RX-2983.0007 at ¶¶25, 27). These five memory card connectors 30 could hold five memory cards *at one time*. (*Id.*) The memory card controller interface 20 includes “a memory card switching circuit” that switches between each of the five memory card connectors 30 as needed. (*Id.* at ¶ 32, “[i]f for example, the host reads from or writes to a compact flash card, the microprocessor will switch this circuit to the compact flash interface. If for example, the host reads or writes to a smart media card, the microprocessor will switch this circuit to the smart media interface”).

The ALJ acknowledged the disclaimer of a system that includes a sequential switching circuit, stating that “the claim construction order explained that the patent applicants indicated that the memory cards claimed in the '623 Patent ‘can be operated at a given point in time,’ not that they must be operated at the same time.” (ID at 55). As described below, however, the ALJ did not apply the clear prosecution history disclaimer.

**b. The ALJ’s “Located in Their Respective Slots” Construction Ignores the Prosecution History.**

The ALJ’s “located in their respective slots” construction effectively erases the disclaimer he acknowledged, finding that the mere presence of multiple memory cards within an Accused Product means that the cards means the cards are accessible in parallel, regardless of whether multiple cards can actually be operative at a given point in time. ID at 55-56. As the applicant acknowledged during prosecution, the disclaimed prior art could accommodate at least five memory cards in five different connectors 30. Thus, merely being able to insert multiple cards is not enough, To access in parallel, a product must be able to operate multiple cards at the same time. (See RX-0043.121-22). If it cannot, as the applicant explained, “access to the interfaces *does not occur in parallel.*” (*Id.* (emphasis added)).

**c. The ALJ’s “Located in Their Respective Slots” Construction Renders the Claim Term “in Parallel” Superfluous.**

The “located in their respective slots” construction arrived at by the ALJ also defies well established principles of claim construction by making the term “in parallel” superfluous, as the asserted claims already require the presence of two memory cards that are each connected to interfaces. (See, e.g., JX-0001, claim 1, reciting a “first memory card” and a “second memory card”). This flaw in the “in their respective slots simultaneously” construction can be further demonstrated by removing the words “in parallel” from, for example, claim 1:

wherein the memory card of the first type and the memory card of the second type are accessible ~~in parallel~~ to transfer data from the memory card of the first type to the memory card of the second type.

There is no difference in meaning between this “removed” version of the claim and the “in their respective slots simultaneously” construction set forth in the ID. The words “in parallel” are thus rendered completely meaningless. See *Elekta Instrument S.A. v. O.U.R.*

*Scientific Intern., Inc.*, 214 F.3d 1302, 1307 (Fed. Cir. 2000) (refusing to adopt a construction that would “render the reference to 30° superfluous”); *see also Becton, Dickinson and Co. v. Tyco Healthcare Group, LP*, 616 F.3d 1249, 1257 (Fed. Cir. 2010). This result is especially troubling considering that the applicant argued that the “in parallel” limitation distinguished its claims from the prior art, as discussed above.

**d. The ALJ’s “Appears to Be Happening” Construction Violates The Tenets of Claim Construction.**

The ALJ also erred by incorrectly embracing TPL’s position that the plain and ordinary meaning of “accessible in parallel” is determined by what “appears to be happening at the same time *to the user*” rather than what is *actually* occurring within the device, the latter reflecting how a person of ordinary skill in the art would view the claims. (ID at 55). It is black letter law that claim terms are construed through the eyes of one of ordinary skill in the art – not through the eyes of a lay person user. *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998) (“[i]t is the person of ordinary skill in the field of the invention through whose eyes the claims are construed”); *see also Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc). While the ALJ did not expressly rule on the educational level and experience of a person of ordinary skill in the art, both Complainant’s expert and Respondents’ expert agreed that a person of ordinary skill of the ’623 patent would have at least a bachelor's degree in electrical or computer engineering” with at least two years (Respondent) or three years (Complainant) of industry experience. (RX-2891, Q/A 31-33; CX-944, Q/A 58). Complainant’s expert further testified that a person of ordinary skill in the art would have “experience working with computer peripherals and/or external storage devices.” *Id.*

An experienced electrical or computer engineer is far different than a lay person, and it was a clear legal error for the ALJ to apply as a legal standard what “appears to be happening at

the same time to the user” rather than evaluating the claims as one of ordinary skill in the art would. A person of ordinary skill would not evaluate computer processing language based on what “appears to be happening.” Rather, a person of ordinary skill would know to consult product design documents, schematics, and testing to determine how the Accused Products actually operate—that is, whether the Accused Products are capable of accessing two memory cards in parallel. That person of ordinary skill would understand that computers can perform millions of operations per second, and that appearance to the user does not indicate operation of a product. Furthermore, one skilled in the art reading the prosecution history would appreciate that the applicant’s discussion of Pua and its switching circuit was not meant to distinguish Pua based on its *apparent* operation, but rather based on its *actual* operation. As the ID improperly construes the term “accessible in parallel” as being based on the appearance to a user rather than on the meaning to one of ordinary skill, the ALJ’s construction cannot stand.

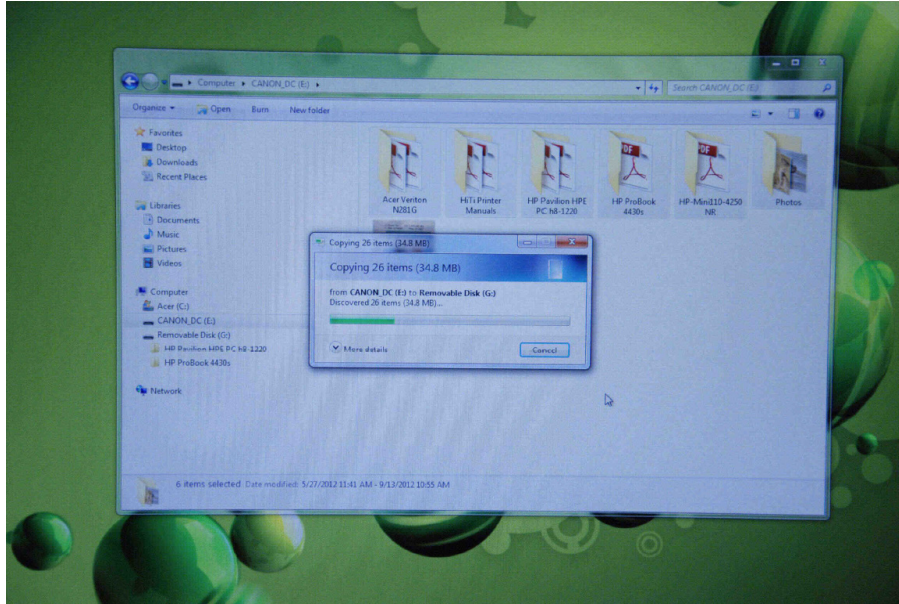
For each of the reasons set forth above, the term “accessible in parallel to transfer data” should be construed to have its plain meaning, which, consistent with the prosecution history disclaimer, requires the capability to access two cards at a given point in time.

**2. The Undisputed Facts Show That the Accused Products Are Unable to Operate Two Memory Cards in Parallel.**

The ALJ’s basis for finding infringement of the “accessible in parallel” limitations (ID at 54-56) is legally and factually erroneous for the following reasons.

**a. The Finding of Infringement is Based on a Generic Windows Graphic.**

The ALJ’s opinion appears to be based on a “screen shot [that] shows files being transferred from the CF memory card in one memory port to an SD memory card in the second memory port.” (ID at 54). That screenshot from CX-0472C is shown below:



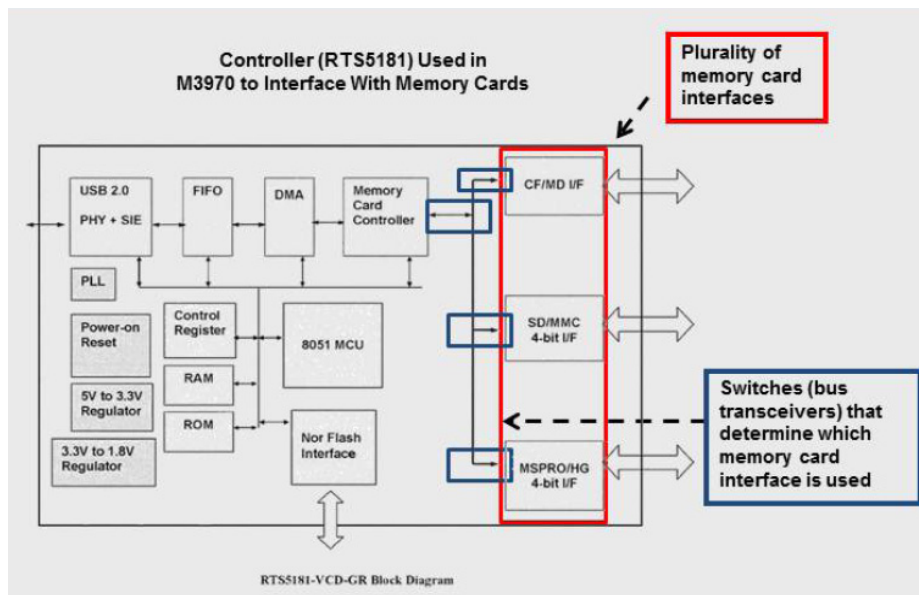
Based on the fact that this screenshot appears to show the copying of a file from one memory card to another, the ALJ found infringement. *Id.* The ALJ identified no other evidence of infringement of the “accessible in parallel” limitation beyond a file copy screenshot for each Accused Product. *Id.* The ALJ’s finding of infringement is a clear factual error because the undisputed evidence shows that this copy operation involves *sequential* access to the memory cards, notwithstanding its appearance to the user.

**b. It Is Undisputed That The Accused Products Use The Disclaimed Prior Art Switching Circuitry**

The screenshot relied upon by the ALJ is a generic graphical depiction used by Windows to show a copy operation; it is not an accurate representation of the operation of any of the memory card interfaces in the underlying Accused Products. (RX-2891, Q/A 94-105). In actuality, the Accused Products are *incapable* of accessing two memory cards in parallel. (*Id.*) As with the Pua prior art reference, the Accused Products *use a switching circuit that is able to select one and only one memory card at a time.* (*Id.* at Q/A 106).

As Respondents' expert testified "[t]his means that if, for example, the host reads from or writes to a Compact Flash card, the controller will switch this circuit to access the Compact Flash interface. If, for example, the host reads from or writes to an SD card, the controller will switch this circuit to the SD interface. The readers can access one and only one card at a given time." (*Id.* at Q/A 94). Like the prior art Pua reference, the Accused Products are unable to access two cards in parallel because the switching circuitry can only select one at a time, and thus access must occur in sequence. (*Id.* at Q/A 106).

Importantly, the use of a prior art selectable switch is not in dispute, as the schematics of the Accused Products clearly show it. An example schematic follows:



(RDX-612, CX-324C RX-2891, Q/A 136-37 (Acer); *see also* RDX-618, RX-3348C, RX-2891, Q/A 155-56 (Kingston); RDX-623, CX-322C, RX-2891 Q/A 177-79 (Newegg/Rosewill)).

As the exemplary schematic above shows, there is a **single connection** into the memory card controller (shown with the single double sided arrow connected to the controller). (*Id.*) This single connection can connect to **one and only one** of the interface switches at a time. (*Id.*) In the schematic shown above, there are three options. (*Id.*) The Accused Product can access the

CF/MD interface or it can access the SD/MMC interface or it can access the MSPRO/HG interface. (*Id.*) Accordingly, in order to perform the file copy “between” two cards shown on the screen, the Accused Products must copy information from one card to the host computer and then from the host computer back to the second card. (*Id.*) While it might be more efficient to be able to access both cards at the same time (*i.e.*, access them in parallel) so that data can be copied directly from one card to another, the design of the Accused Products simply does not permit this. (*Id.*) Importantly, the product schematics and the testimony regarding the switching circuitry in the Accused Products are ***undisputed***. Complainant’s expert never provides a contrasting technical opinion of the schematics and the ALJ never finds the testimony or underlying schematics to be unreliable.

The testimony and schematics are also supported by copious electronic testing, which the ALJ acknowledged in the ID “tracked and logged all disk and memory card activity during the file transfer operation using a Microsoft diagnostic tool.” (ID at 52; *see also* RX-2891 at Q/A 138-46 (Acer), 157-66 (Kingston), 180-90 (Newegg/Rosewill)). This testing conclusively shows that no two memory cards are accessed in parallel during the copy operation the ALJ found to be infringing. An example of this logged disk and memory card activity follows:

Diskmon Log for HS219/1						
4532	39.272429	0.00000954	2	Read	602120	4096
4533	39.277278	0.00021935	1	Write	1110079	128
4534	39.281630	0.00021935	1	Write	1110207	128
4535	39.287765	0.00021935	1	Write	1110335	128
4536	39.293224	0.00021935	1	Write	1110463	128
4537	39.299502	0.00021935	1	Write	1110591	128
4538	39.304937	0.00021935	1	Write	1110719	128
4539	39.311175	0.00021935	1	Write	1110847	128
4540	39.316560	0.00021935	1	Write	1110975	128
4541	39.322984	0.00021935	1	Write	1111103	128
4542	39.328525	0.00021935	1	Write	1111231	128
4543	39.333775	0.00021935	1	Write	1111359	128
4544	39.338068	0.00021935	1	Write	1111487	128
4545	39.343231	0.00021935	1	Write	1111615	128

(RDX-0622; RX-3350). During a copy operation, information is read from memory card 2 at time 39.272429 (first row, highlighted in red), and the subsequent writing to card 1 does not start until time 39.277278 (second row), which is after the read of the first card was finished. (RX-2871 at Q/A 164-166). As with the schematics, neither TPL's expert nor the ALJ find fault with the testing procedure or the consistent conclusions drawn from it.

In fact, the evidence provided by Respondents' expert is so conclusive that even Complainant's expert was forced to concede during the evidentiary hearing that the screenshot relied upon by the ALJ merely "*appears to be* happening at the same time to the user," even if the cards cannot actually be accessed in parallel. (Buscaino, Tr. 716:7-8 (emphasis added)). The ALJ adopted this argument stating that "the ALJ finds Mr. Buscaino's interpretation captures the plain and ordinary meaning." (ID at 55).

Beyond being a legally incorrect claim interpretation, as discussed above, this analysis also constitutes clear factual error of how Respondents accused products actually operate. To



infringe a patent claim, an accused device must actually practice every limitation of the claim limitations – the (incorrect) appearance to untrained layman is unquestionably not sufficient. See *Lemelson v. U.S. et al.*, 752 F.2d 1538, 1551 (Fed. Cir. 1985) (“It is also well settled that each element of a claim is material and essential, and that in order for a court to find infringement, the plaintiff must show the presence of every element or its substantial equivalent in the accused device.”) As the undisputed testimony and evidence show that the Accused Products are technically incapable of accessing two memory cards in parallel, the ALJ’s finding of infringement is clearly erroneous.

### **3. The ID Improperly Shifts The Burden of Proof to Respondents**

In addition, the ALJ’s finding of infringement should be reversed because it improperly shifted the burden to the Respondents to prove non-infringement. Specifically, the ALJ stated that “Respondents’ evidence shows that memory cards in the Accused Products are accessed in sequence, but *that does not necessarily mean that the memory cards are incapable of being accessed in parallel.*” (ID at 55 (emphasis added)). This rationale is clearly both legally and factually erroneous.

First, it is unquestionably TPL’s burden to show that the Accused Products are capable of practicing the “accessible in parallel” limitation. It is not Respondents’ burden to show that the devices are incapable of being accessed in parallel. *Seal-Flex, Inc. v. Athletic Track and Court Const.*, 172 F.3d 836, 842 (Fed. Cir 1999) (“To show infringement of a patent, a patentee must supply sufficient evidence to prove that the accused product or process contains, either literally or under the doctrine of equivalents, every limitation of the properly construed claim”).

As noted above, in view of the product schematics and Respondents’ expert’s testing, TPL has no credible evidence that any Accused Product can actually access two memory cards in parallel. Complainant expert’s only argument for infringement is the “appears to be happening”

argument, which is technical and legally incorrect, as described above. Accordingly, a finding of infringement should not be reached because TPL did not provide evidence to satisfy its burden.

Even though it is not the Respondents' burden to prove non-infringement, the undisputed expert testimony and documents show that the Accused Products are, in fact, *incapable of accessing two memory cards in parallel*. As described above, each of the Accused Products has a *single switch* that must be sequentially switched from one memory card to another. This switch prevents two memory cards from ever being accessed in parallel as the claims require. Quite to the contrary of the statements in the ID, in the Accused Products, memory cards are incapable of being accessed in parallel, and are, thus, incapable of infringing the '623 patent.

**D. The ALJ Clearly Erred by Declining to Find The '623 Patent Invalid.**

Under the claim constructions and their application by the ALJ, the '623 Patent covers myriad prior art devices, patents, and publications available before November 18, 2002. While Respondents presented evidence about many such devices at the hearing, they focus herein on a single device, a single publication, and a single patent: the Atech Flash Technology, Inc. ("Atech") Pro II, the Uno Mas Article, and the Kaneshiro Patent.

The ALJ found that the Respondents did not show that any claim of the '623 Patent is invalid by clear and convincing evidence. (ID at 124-127). The ALJ's invalidity discussion, however, constitutes clear error, and should be reversed, for a number of reasons. *See* 19 C.F.R. § 210.43(b)(1). Specifically, the ALJ clearly erred by:

- (1) Failing to address Respondents' unrebutted element-by-element comparison of the Pro II to the claims of the '623 Patent;
- (2) Failing to acknowledge uncontroverted evidence that the Pro II device was sold and publicly available prior to the filing of the '623 Patent;
- (3) Summarily rejecting Respondents' arguments about the Uno Mas Article because "little more than one page of analysis is simply insufficient," without performing any element-by-element analysis; and

- (4) Summarily rejecting Respondents' arguments about the Kaneshiro Patents because "little more than one page of analysis is simply insufficient," without performing any element-by-element analysis.

These errors are particularly clear in view of the breadth the ALJ was willing to ascribe to the claims of the '623 Patent, under which the mere appearance of being able to transfer data between memory cards in different slots is sufficient to satisfy the claims of the '623 Patent. For each of the reasons above, Respondents request reversal of the ALJ's opinion on the validity of the '623 Patent, or in the alternative, remand for a proper analysis of the evidence Respondents presented at the hearing in this Investigation.

- 1. The ALJ Erred by Finding That The Pro II Does Not Anticipate The '623 Patent**

The Pro II is a multi-slot card reader that includes each of the features the ALJ believes is necessary to satisfy the claims of the '623 Patent, and is clearly prior art to the '623 Patent. (RX-0460C, Q/A 2448-92). Respondents' evidence that the Pro II satisfies the limitations of the asserted claims of the '623 Patent are undisputed. Accordingly, the ALJ committed clear error by finding that the Pro II does not anticipate the '623 Patent.

- a. The Clear and Convincing Evidence Shows The Pro II Discloses Each Limitation of The Claims of the '623 Patent.**

The ALJ did not undertake an analysis of whether the Pro II discloses each limitation of the asserted claims of the '623 Patent. (ID at 124). The entirety of the ALJ's opinion regarding invalidity of the '623 Patent based on the Pro II is reproduced below:

As discussed above, Respondents have not shown by clear and convincing evidence that the Atech Pro II was available before the priority date for the '623 Patent. Accordingly, the ALJ finds that they have not overcome the presumption of validity and proved that the asserted claims of the '623 Patent are invalid in light of the Atech Pro II. (*See supra* Section VI.C.1).

(ID at 124).

Respondents' expert, Mr. McAlexander, opined that the Pro II discloses each limitation of each asserted claim of the '623 Patent, and provided limitation-by-limitation analysis as to why. (RX-0460C, Q/A 2448-92). TPL's expert, on the other hand, offered no testimony in rebuttal; indeed, he did not address the Pro II at all in this Investigation. (*See generally* CX-1205C). Thus, the only expert testimony of record is Respondents' expert's un rebutted testimony that the Pro II discloses each limitation of each asserted claim of the '623 Patent.<sup>3</sup>

The Pro II is a multi-slot card reader that reads at least five kinds of flash memory cards: CompactFlash Type I or II, IBM Microdrive, SD, MMC, and SmartMedia. (RPX-0014; RX-0778.0007, .0009; RX-0797.0003; RX-0460C, Q/A 2449-58; RX-0340C, Q/A 22-25). The front face of an exemplary Pro II clearly shows these card slots and a green LED light:



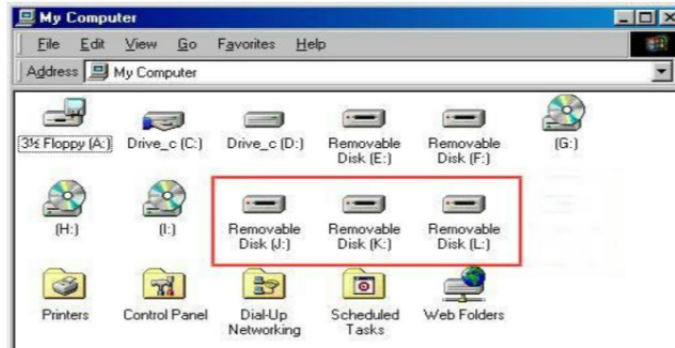
(RX-0778.0008; *see also* RX-0340C, Q/A 22-25; RPX-0014). Accordingly, the Pro II includes “a plurality of memory card interfaces comprising a first subset to interface with a memory card of a first type and a second subset to interface with a memory card of a second type,” as required by claims 1, 9, and 17. (RX-0460C, Q/A 2470, 2481, 2489; JX-0001, 5:30-33, 6:8-11, 6:40-43).

Respondents presented uncontroverted evidence that the Pro II enabled users to transfer data between different flash media card types by dragging-and-dropping a file. (RX-0778.0001, .0007-.0010; RX-0460C, Q/A 2471, 2481, 2490; RX-0340C, Q/A 37-41, 129-30,

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<sup>3</sup> TPL's cross-examination of Mr. McAlexander did not address the substantive disclosure of the Pro II, as it focused solely on the documents Mr. McAlexander relied on in support of his statement that the Pro II is prior art. (McAlexander, Tr. at 1497:15-1508:2).

135-37, 145-148, 151-56). According to the prior art review published on May 9, 2002, by Steve’s Digicams, “[t]he three card slots on the PRO II will appear as removable drives so you can easily move data between different types of flash memory devices.” (RX-0778.0008; *see also* RX-0340C, Q/A 147, 151-56). The following screenshot, from the May 9, 2002 review, illustrates this functionality:



The three card slots on the PRO II will appear as removable drives so you can easily move data between different types of flash memory devices. Shown here is the "My Computer" folder, the removable disks J, K and L are the PRO II drive.

(RX-0778.008; *see also* RX-0460C, Q/A 2471). Mr. Liu, who designed, tested, and sold the Pro II, testified that this drag-and-drop functionality was present in the Pro II:

You insert the memory card from your camera into the PRO II, and it allows you to copy from that Smart Media card and transfer it to say a CompactFlash card. You can just drag a file or files from one drive to copy to the other drive.

(RX-340C, Q/A 146). Based on the unchallenged evidence, the Pro II satisfies the “accessible in parallel” limitations of claims 1, 9, and 17 under the ALJ’s interpretation, which as explained above requires only drag-and-drop copying. (*Id.*; JX-0001, 5:33-37, 6:11-15, 6:44-47; ID at 54).

Claim 9 requires “a controller circuit” and “a bus coupled to the controller circuit.” The Pro II included a controller circuit in the form of the DataFab-stamped Neodio controller. (RX-0340C, Q/A 121-28; RPX-0014; RX-0460C, Q/A 2481). The Pro II connected to a computer via Universal Serial Bus (USB) and therefore included the claimed bus. (RX-0460C, Q/A 2481, *see also* RX-0960.0009, .0018-.0019).

Claim 17 is a method claim that corresponds in scope to claims 1 and 9. Mr. Liu testified that as part of his job at Atech, *he personally performed a test in October, 2001*, including transferring data “from a SmartMedia card to a SD card.” (RX-0340C, Q/A 36-41). The ALJ did not question Mr. Liu’s uncontroverted testimony that he personally operated the device prior to the ‘623 priority date. Thus, Atech practiced the method of claim 17 at least by October, 2001.

Dependent claims 2, 10, and 18 add the limitation that one of the card slots must be capable of reading a plurality of different memory card types. The Pro II satisfies this limitation at least because it included a slot that could read CompactFlash and IBM Microdrive cards. (RPX-0014; RX-0789; RX-0460C, Q/A 2475, 2483, 2492; RX-0340C, Q/A 25, 136). Again, TPL did not contest this point, and the ALJ made no finding otherwise.

Dependent claims 3, 4, 11, 12, and 19 add the limitation that one of the memory card interfaces include an indicator (specified as a light in claims 4 and 12) identifying a status of an operation for a respective memory reader interface. The Pro II includes an LED (a light) that illuminates to indicate when data is being transferred at one of the card reader interfaces. (RPX-0014; RX-0778.0007; RX-0340C, Q/A 25; RX-0460C, Q/A 2476-79, 2484-87, 2493-94). According to the ALJ’s infringement analysis, the presence of a single indicator light, such as in the Pro II, is sufficient to show that dependent claims 3, 4, 11, 12, and 19 of the ‘623 patent are satisfied. (ID at 57-58). Thus, the green LED on the Pro II satisfies the additional limitations of claims 3, 4, 11, 12, and 19. (RX-0460C, Q/A 2476-79, 2484-87, 2493-94).

Accordingly, the Commission should reverse the ID and find that the Pro II discloses each limitation of the asserted claims of the ‘623 Patent. The ALJ’s failure to properly consider this evidence and to perform a limitation-by-limitation analysis constitutes clear error.

**b. The ALJ Correctly Recognized That At Least Some Pro II Devices Are Prior Art To The '623 Patent.**

It is undisputed that at least some Pro II devices are prior art to the '623 Patent. Respondents took substantial discovery from third-party Atech regarding the Pro II, which Atech designed, purchased, and re-sold beginning in late 2001. This discovery included document production of sales invoices and other contemporaneous documents, deposition testimony, and trial testimony from Atech corporate designee Mr. Eric Liu, the individual responsible for the initial design and release of the Pro II in 2001. Respondents' post-hearing brief details this evidence, but at the very least business records produced by Atech establish show the following:

**I.** Purchase Order 117-E shows the Pro II was sold by DataFab to Sunus Suntek in California on **October 18, 2001** (RX-0799.0003-.0004; RX-0340C, Q/A 79-82).

**II.** On **February 22, 2002**, Atech sold eight Pro IIs to Elitegroup Computer Systems, in Fremont, California, as evidenced by a sales invoice produced by Atech. (RX-0781.0004; RX-0340, Q/A 91-98; *see generally* RX-0781).

These sales are prior to the November 2002 filing date of the '623 Patent, and were in the United States, so the Pro II is prior art under 35 U.S.C. §§ 102(a) or (b).<sup>4</sup>

TPL did not and cannot dispute these facts. As a result, the ALJ appears to agree that at least some Pro II devices constituted prior art under both 35 U.S.C. §§ 102(a) and 102(b). (ID at 96). Accordingly, it is undisputed that the Pro II is prior art to the '623 Patent.

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<sup>4</sup> Respondents also presented evidence that the Pro II device was publicly displayed at a Las Vegas electronics show on November 15, 2001 and that a third-party product review was published on the same day. ID at 95.

**c. The ALJ Clearly Erred With Regard To The Functionality Of The Pro II.**

The ALJ found that the Pro II is not invalidating prior art for the '623 Patent solely because "Respondents failed to establish by clear and convincing evidence how [Pro II] devices functioned *at that time*." (ID at 96) (emphasis in original). That is, the ALJ rests his opinion that Respondents have not shown clearly and convincingly that the '623 Patent is invalid solely because he believes Respondents' exemplar Pro II device might have been manufactured after November, 2002. (ID at 96). At least because the uncontroverted evidence establishes that the Pro II functionality never changed, and that the Pro II is indeed prior art, the ALJ clearly erred.

First, there is absolutely no basis to conclude that the Pro II device's functionality changed over time. The sales indicated by the invoices noted above are called "Pro II," and the device was always called a Pro II. (RX-0799.0003-.0004; RX-0340C, Q/A 79-82; RX-0781.0004; RX-0340, Q/A 91-98; *see generally* RX-0781). Indeed, as Mr. Liu testified, when Atech released "the next generation of the PRO II," the device that was released was called the "Pro III." (RX-0340C, Q/A 141-142). Moreover, Mr. Liu testified that he *personally* operated a Pro II device in October 2001 and that it had the functionality claimed by the '623 patent, and that Atech publicly displayed and operated the Pro II device at the Las Vegas trade show on November 15, 2001. (RX-0340C, Q/A 54-63; RPX-0009). There is even a contemporaneous, third-party product review that corroborates this testimony. (RX-0778.0001; RX-0340C, Q/A 63-76; RX-0346.0002-.0005). Thus, the mountains of evidence about the Pro II all relate to the same device.

Mr. McAlexander relied in part on the particular Pro II Respondents were able to procure during discovery, but he also relied on many other different kinds of evidence, each of which buttresses the reliability of the evidence as a whole. For example, Mr. McAlexander relied on



Mr. Liu's testimony that *he himself*, in his role at Atech, operated commercial Pro II devices prior to the filing of the '623 Patent, including by testing those devices' drag and drop functionality between memory cards in the memory card slots. (RX-0340C, Q/A 37-41, 129-30, 145-148, 151-56). Mr. Liu, confirmed the unsurprising notion that the Pro II functionality did not change over the product's life. (RX-0340C, Q/A 105-106). That is, even if the particular Pro II Mr. McAlexander relied on was manufactured after November 18, 2002, it functioned identically to Pro II devices manufactured before November 18, 2002.

The ALJ's opinion that the particular Pro II exemplar Mr. McAlexander inspected may not have been prior art misses the point. TPL was unable to present *any* evidence to undermine Mr. Liu's testimony with regard to the Pro II. There is no evidence in the record that any Pro II operated differently from any other Pro II as time went on. Mr. Liu's uncontroverted testimony shows that the device operated in *exactly the same way* as prior art Pro II devices sold or publicly demonstrated by Atech prior to the filing of the '623 Patent. Moreover, the ALJ made an inappropriate, and unsupported assumption that Pro II devices may not have all operated the same way. Regardless of whether the actual Pro II specimen introduced into evidence was itself prior art, the evidence clearly and convincingly shows that the Pro II was always the Pro II, and operated the same from its introduction in 2001 until it was replaced by the Pro II. The ALJ's decision to ignore Mr. McAlexander's testimony that the Pro II functionality he opined about is prior art functionality is clear error in view of the mountain of corroborative evidence.

Notwithstanding the corroborated evidence Respondents have presented, it is clear error to find that Mr. Liu's testimony did not rise to the level of clear and convincing evidence of Atech's activities in 2001/2002. *Eisenberg v. Alimed, Inc.*, 243 F.3d 555 at \*4 (third party testimony about publicly using the claimed invention before the filing of the patent did not

require corroboration to be clear and convincing evidence of invalidity). As a non-party testifying about an unpatented device, Atech's corporate testimony can constitute substantial evidence to support a finding that every limitation in the claims of the '623 Patent is present in the Pro II. *Id.*; see also *Thomson, S.A. v. Quixote Corp.*, 166 F.3d 1172, 1176 (Fed. Cir. 1999).

It was also clear factual error for the ALJ to ignore the cumulative weight of the evidence corroborating Mr. Liu's testimony merely because a few of the corroborating documents were themselves found to not be clear and convincing. (ID at 96). The mere fact that each corroborative document does not establish clear and convincing evidence on its own does not justify the ALJ's finding. While the weight of some documents, on their own, may be insufficient to establish clear and convincing evidence, the fact remains that TPL has pointed to absolutely no inconsistency in Respondents' evidence. Each document Respondents rely on corroborates Mr. Liu's testimony, and all the evidence supports Mr. McAlexander's opinion.

For example, the ALJ's statement that "Mr. Liu testified that he only learned that this may be the controller from discussion he allegedly had with a manufacturer of the device and from testing documents that were not submitted into evidence" is of no moment in the instant inquiry. (ID at 97). Indeed, Mr. Liu testified that Atech designed and DataFab manufactured the Pro II, so it is logical that he would have learned the identity of the controller chip from DataFab. (Liu, Tr. 133:18-24; RX-0340C, Q/A 121). The fact that testing documents no longer exist for a device designed over 12 years ago is also unsurprising. (ID at 96). As Mr. Liu testified, the testing he performed was merely to confirm that the device did what it was supposed to do. (RX-0340C, Q/A 38-41, 89, 117). The lack of documents confirming that the Pro II operated as intended—which would need to be true for the device to be commercially saleable—does not undermine Mr. Liu's sworn testimony that he performed the testing.

Despite the ALJ's focus on the fact that Mr. Liu "Googled" to find one document and performed "internet searches" (ID at 96), as can be seen from the facts detailed above, Atech's document production actually included purchase orders, email discussions, invoices, physical devices and posters, and other admitted business records created contemporaneous with the launch of the Pro II device in 2001. (*See, e.g.*, RX-0799.0003-.0004; RPX-0009; RX-0778.0001; RX-0346.0002-.0005; RX-0347.0001; RX-0781). TPL did not provide a shred of evidence, nor did the ALJ refer to anything in the record, that calls into question the authenticity or veracity of these business records which all establish sales and public demonstrations of the Pro II prior to the '623 Patent's filing. Mr. Liu's testimony, and Respondents' reliance on additional Atech document production simply corroborates this unchallenged testimony.

For these reasons, the ALJ's acceptance of TPL's efforts to undermine Respondents' proofs based on unspecified unreliability constitutes clear error, and the unrebutted testimony of Atech establishes by clear and convincing evidence that all of the evidence refers to the same device. Thus, the ALJ's finding of no invalidity based on the Pro II should be reversed.

**2. The ALJ Erred By Finding That The Uno Mas Article Does Not Anticipate the Asserted Claims of the '623 Patent.**

The ALJ agrees that the March 6, 2002 article entitled "Omniflash Uno Mas universal card reader" ("the Uno Mas Article") is prior art under 35 U.S.C. § 102(a). (ID at 124-25). The ALJ's decision to reject Respondents' solely because he felt that Respondents only had "a little more than one page of analysis" in their post-hearing brief, without any other finding of how the reference was deficient, constitutes clear error. Claims 1-4, 9-12, and 17-19 of the '623 Patent are each anticipated by the Uno Mas Article. (RX-1148; *see also* RX-0460C, Q/A 2421).

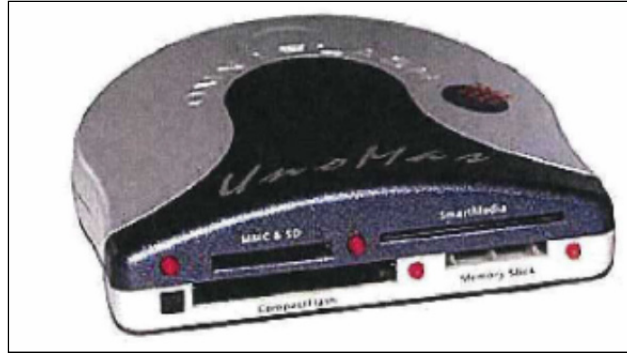
**a. The Uno Mas article qualifies as prior art under 35 U.S.C. § 102(a).**

During the Investigation, TPL's expert's *only* response to Respondents' allegation that the Uno Mas article anticipates the claims of the '623 Patent is his statement that "[i]t is my understanding the controller used in the OmniFlash Uno Mas Universal Card Reader Article contain an Onspec 90C36SC1A controller. It is my understanding that an applicant's invention cannot be used to trigger a §102(a) event." (CX-1250C, Q/A 1038).

The Uno Mas Article is dated March 6, 2002, a date that establishes a *prima facie* case that it is prior art under 35 U.S.C. § 102(a) given the agreed priority date of November 18, 2002. It is TPL's burden to show that the Uno Mas Article is not prior art under 35 U.S.C. § 102(a) by establishing that the subject matter was not attributable to the same inventive entity responsible for the Asserted Claims. *See generally Riverwood Intern. Corp. v. R.A. Jones & Co., Inc.*, 324 F.3d 1346, 1356 (Fed. Cir. 2003); *see also In re Katz*, 687 F.2d 450, 215 USPQ 14 at FN1 (CCPA 1982). TPL did not provide any evidence that the Uno Mas was developed by the same inventive entity as for the asserted claims of the '623 Patent. *Id.* There is no evidence which of TPL's 20 employees (if any) developed the Uno Mas card reader (Iyer, Tr. at 307:14-17), and thus there is no basis to find that TPL disqualified the Uno Mas Article as prior art.

**b. There is no dispute the Uno Mas Card Reader discloses each limitation of the asserted claims of the '623 Patent.**

The card reader described in the Uno Mas Article satisfies each limitation of each asserted claim under TPL's interpretation of the '623 Patent - a fact not disputed by TPL. (RX-0460C, Q/A 2419-39). Specifically, the Uno Mas Article discloses a memory card reader that is able to access four different memory card formats. (RX-0460C, Q/A 2424; RX-1148.0001-.0002). The following figure illustrates the device's plurality of slots and red LEDs:



(RX-1148.0001). Accordingly, the Uno Mas Article discloses “a plurality of memory card interfaces comprising a first subset to interface with a memory card of a first type and a second subset to interface with a memory card of a second type,” as required by claims 1, 9, and 17.

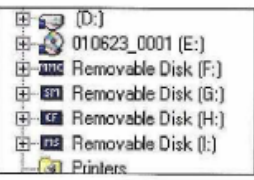
According to TPL’s infringement allegations, a card reader that enables data to be copied between two memory cards satisfies the claims of the ‘623 Patent. (*See e.g.*, CX-0944C at Q/A 460, 1384). The ALJ appears to agree with this conclusion. (ID at 54). The Uno Mas device enabled the “copying between cards” TPL believes satisfies the ‘623 Patent claims:

- Good points:**
- Neat design
  - Well made
  - Easy to install
  - Card drive labelling in Windows Explorer
  - Copying between cards possible

(RX-1148.0002; *see also* RX-0460C at Q/A 2424). The Uno Mas Article also illustrates drive letters assigned to each slot to enable this drag-and-drop functionality:

One really nice touch is the labelling of the individual card drives visible in Windows Explorer file management windows. There is no guessing which drive letter is which slot.

Overall, we can happily recommend the Uno Mas as a good value, versatile, universal memory card reader.



(RX-1148.0002). Thus, the Uno Mas Article discloses the “accessible in parallel” limitations of the independent claims. The Uno Mas Article also discloses the controller circuit and a bus coupled to the controller circuit additionally required by claim 9. (RX-0460C, Q/A 2434).

The additional features of dependent claims 2, 10, and 18 are also disclosed by the Uno Mas Article. (RX-0460C, Q/A 2430, 2436, 2438; RX-1148). The Uno Mas article discloses a single slot for SD and MMC cards (which, according to TPL itself, are two different types of cards), and thus discloses the requirement of claims 2, 10, and 18. (*Id.*)

The Uno Mas article also discloses a light beside each card slot in the Uno Mas, which lights indicate when cards are being accessed. (RX-0460C, Q/A 2431-32; RX-1148.0001). Thus, the Uno Mas article discloses the additional limitation of claims 3, 11, 12, and 19 related to an “indicator” and “a light.” (RX-0460C, Q/A 2431-32, 2436, 2438; RX-1148.0001).

Accordingly, the evidence presented in this Investigation shows that the Uno Mas Article discloses each limitation of each asserted claim of the ‘623 Patent.

**c. The ALJ’s Decision Not To Address Respondents’ Arguments Is Clear Error.**

The entirety of the ALJ’s opinion on the Uno Mas Article is reproduced below:

Respondents contend that the Uno Mas Article (RX-1148) anticipates the asserted claims of the ‘623 Patent. The ALJ finds that a little more than one page of analysis is simply insufficient to overcome the presumption of validity and to meet the clear and convincing standard of proof for invalidity of three patent claims. *See Certain Mobile Devices, Associated Software and Components Thereof*, Inv. No. 337-TA-744, Final Initial Determination, at 117 (December 20, 2011) (unreviewed in relevant part). It is clear to the ALJ from his review of Respondents’ brief, that they had more than sufficient pages to perform a proper analysis. Accordingly, the ALJ declines Respondents’ invitation to find that asserted claims of the ‘623 Patent invalid as anticipated by the Uno Mas Article.

(ID at 125-26).

Respondents’ arguments, while concise, address each and every limitation of each asserted claim of the ‘623 Patent. Indeed, Respondents’ arguments rely primarily on a single

document and unrebutted expert testimony, so it is unnecessary for Respondents' arguments to be lengthy. Nor is it necessary for Respondents to attempt to address TPL's expert opinions, as TPL's expert did not offer substantive opinions on why the Uno Mas Article does not invalidate the '623 Patent. (*See generally* CX-1205C). The ALJ mistakes the brevity of Respondents' arguments as an indicator of their insufficiency. Instead, the brevity of Respondents' arguments reflects (1) the fact that despite the assertion of eleven different claims, TPL believes that only a handful of features must be present for all the claims to be satisfied and (2) the fact that TPL declined to present any rebuttal arguments to Respondents' arguments. The ALJ's conclusion that Respondents' brevity indicates failure to satisfy their is clear error, and should be reversed.

**3. The ALJ Erred By Finding That the Kaneshiro Patent Does Not Render the Asserted Claims Invalid.**

Respondents presented unrebutted evidence that independent claims 1, 9, and 17 of the '623 Patent are anticipated by U.S. Patent No. 6,808,424 (RX-0932) ("the Kaneshiro patent") and that dependent claims 2-4, 10-12, 18, and 19 are obvious over the Kaneshiro patent in view of U.S. Patent No. 6,859,369 (RX-0812) ("the '369 patent") or the Dell Inspiron 3000 Service Manual (RX-1006) ("the Dell Inspiron 3000 Manual"). The ID's contrary conclusion was in error.

**a. The ID Improperly Dismissed Respondents' Arguments Concerning the Kaneshiro Patent.**

Despite finding that "there is no dispute" that the Kaneshiro patent is prior art to the '623 Patent, the ALJ dismissed Respondents' anticipation argument out of hand solely because Respondents "spend only a little more than one page" explaining the applicability of Kaneshiro to the '623 Patent. (ID at 125.) The ID also found that the obviousness analysis, which is based on the anticipation analysis, must be inadequate. (ID at 126.)

However, Respondents provided an element-by-element analysis of why the Kaneshiro patent anticipates each of claims 1, 9, and 17, including pinpoint citations to both the reference itself (RX-0932) and the witness statement of Respondents' invalidity expert, Mr. McAlexander (RX-0460C). (PHB at 243-244.) Like with the Uno Mas Article, the ID sidesteps the substance of this analysis and instead focuses solely on the amount of space it occupied in Respondents' brief. The ID clearly failed to appreciate that: the claims at issue are not complex, are largely repetitive, and contain no more than two or three limitations; the similarities between the Complainant's assertions of infringement and the prior art are instantly recognizable; and there was virtually no rebuttal argument from TPL for Respondents to address. All of these factors show that a lengthy discussion of anticipation is not warranted, much less required.

The ID should have at least considered the merits of Respondents' position. Because it did not, the ID's conclusions regarding the Kaneshiro patent were erroneous and should be reversed or at least remanded. Without such reversal or remand, future Respondents will be encouraged to fill pages with superfluous material when a concise argument will suffice.

**b. There is No Dispute that the Kaneshiro Patent Anticipates Claims 1, 9, and 17 of the '623 Patent**

Had the ALJ given Respondents' argument proper attention, it would have been immediately clear that independent claims 1, 9, and 17 of the '623 Patent, as construed by the ALJ, are anticipated by the Kaneshiro patent.

Like the '623 patent, the Kaneshiro patent is also directed to a multi-slot memory card reader device. Figures 1 and 2 show a "memory card adapter" (MA) with spots for a "first memory card" (MC1) and a "second memory card" (MC2). (RX-0932, 5:54-67; RX-0460C, Q/A 491-92, 523-24, 543-44.)



Claims 1, 9, and 17 each require “a plurality of memory card interfaces comprising a first subset to interface with a memory card of a first type and a second subset to interface with a memory card of a second type.” Figures 1 and 2 of the Kaneshiro patent disclose an apparatus (i.e., “memory card adapter MA”) with a plurality of memory card interfaces (6a, 6b), a first subset of which (interfaces 6a) interfaces with a memory card of a first type MC1 and a second subset (interfaces 6b) to interface with a memory card of a second type. (RX-0932, 5:54-67; RX-0460C, Q/A 491-92, 523-24, 543-44.) The first and second memory cards MC1 and MC2 are based on different memory card standards, and thus are “different types” of cards. (RX-0932, 5:40-42; RX-0460C, Q/A 491-92, 523-24, 543-44.)

The Kaneshiro patent also discloses the “accessible in parallel” limitations, as those limitations have been construed by the ALJ, since data can be transferred from the first memory card MC1 to the second memory card MC2 while the cards are in their respective slots. (RX-0460C, Q/A 494-95, 526-27, 546-47.) For example, the Kaneshiro patent explains that data from the first memory card MC1 is converted by the data converting section 8c to the different standard used by the second memory card MC2 and then sent directly to the second memory card MC2 for storage. (RX-0932, 6:50-63, 7:55-8:8; RX-0460C, Q/A 494-95, 526-27, 546-47.)

Claim 9 additionally requires “a controller circuit” and “a bus coupled to the controller circuit.” The apparatus shown in Figures 1 and 2 of the Kaneshiro patent discloses “a controller circuit” and “a bus coupled to the controller circuit.” (RX-0460C, Q/A 517-18, 520-21.) In Figure 2, the data converting sections 8a, 8b, and 8c and the connection switching part 7 make up a controller circuit that controls the transfer of data between the memory card interfaces. (RX-0932, 6:50-63; RX-0460C, Q/A 517-18, 520-21.) Figure 2 also shows a bus coupled to the data converting sections 8a, 8b, and 8c and the connection switching part. (*Id.*)

TPL does not dispute that the Kaneshiro patent anticipates independent claims 1, 9, and 17 of the '623 Patent as TPL's expert addressed only the *dependent* claims. (CX-1205C, Q/A 120-43.) Thus, for the reasons discussed above, Respondents' have met their burden of clearly and convincingly showing that claims 1, 9, and 17 are anticipated by the Kaneshiro patent.

**c. The ALJ Erred in Not Finding that Claims 2-4, 10-12, 18, and 19 are Obvious Over the Kaneshiro Patent In View Of The '369 Patent or the Dell Inspiron 3000 Manual.**

The additional limitations of dependent claims 2-4, 10-12, 18, and 19 are trivial, well-known features which one skilled in the art would have found obvious to include with the Kaneshiro patent to arrive at the claimed invention. Obviousness is a question of law based on underlying facts, as set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). It was legal error for the ID to not find these claims obvious based on the factual record.

Dependent claims 2, 10, and 18 of the '623 Patent add the limitation that "at least one of the memory card interfaces is configured to read a plurality of different memory card types." The evidence clearly establishes that the additional limitation of claims 2, 10, and 18 is taught by the '369 Patent and the Dell Inspiron 3000 Manual,<sup>5</sup> each of which was correctly found to constitute prior art to the '623 Patent. (ID at 126.) The '369 patent discloses a single memory card interface that is configured to read MMC, SD, MemoryStick cards. (RX-0812, 2:9-16; RX-0460C, Q/A 501, 530, 550.) The Dell Inspiron 3000 Manual also discloses a single memory card interface that is configured to read more than one type of memory card. (RX-0460C, Q/A 501, 530, 550.) Thus, the evidence establishes that the additional limitation of dependent claims 2, 10, and 18 was known in the prior art.

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<sup>5</sup> This limitation is also taught by the Dell Inspiron 7000 Manual (RX-1007), and the same analysis applies to this reference, as explained in Respondents' PHB. (PHB at 245-46).

Further, as Respondents' expert Mr. McAlexander explained, a person of ordinary skill in the art at the time of the filing of the '623 Patent would have known about memory card interfaces configured to read a plurality of different memory card formats, such as the ones disclosed in the '369 patent and the Dell Inspiron 3000 Manual, and would have been motivated to modify the apparatus disclosed in the Kaneshiro patent so that at least one of the plurality of memory card interfaces would be configured to read a plurality of different memory card types. (RX-0460C, Q/A 501, 530, 550.) A person of ordinary skill would have been motivated to combine these references at least because the references are in the same field and the combination would achieve predictable results such as reduced size and/or lower cost, thereby supporting the SD specification's requirement for backward compatibility with MMC cards. (*Id.*) Indeed, the Kaneshiro patent teaches that size and cost of a memory card interface are important considerations. (*Id.*)

The only rebuttal TPL presented was the bare assertion of its expert that the Dell Inspiron 3000 does not disclose "at least one of the memory card interfaces is configured to read a plurality of different memory card types." (CX-1205C, Q/A 127, 135, 141.) But TPL's expert did not provide any basis for this belief and, in any event, it is not accurate. (*Id.*) Nor did TPL's expert question Mr. McAlexander's opinion that there are reasons to combine the references in the described manner. Thus, the ALJ erred in not finding claims 2, 10, and 18 obvious based on the Kaneshiro patent in view of the '369 patent or the Dell Inspiron 3000 Manual.

Dependent claims 3, 4, 11, 12, and 19, add only trivial limitations related to "indicators" and "lights," and should have been found obvious over the Kaneshiro patent in view of the Dell Inspiron 3000 Manual. It is not disputed that the Dell Inspiron 3000 Manual teaches these additional limitations in disclosing an indicator panel that includes a light to indicate whether

activity is occurring at a memory card interface, such as when a PC card inserted into the interface is being accessed. (RX-1006.0012-.0013; RX-0460C, Q/A 505, 509, 534, 538, 554.) .

Further, Mr. McAlexander's un rebutted testimony establishes that a person of ordinary skill in the art at the time of the filing of the '623 Patent would have known about a memory card interface that includes an indicator light, such as the one disclosed in the Dell Inspiron 3000 Service Manual, and would have been motivated to combine this feature with the Kaneshiro patent so that at least one of the plurality of memory card interfaces includes such an indicator light. (RX-0460C, Q/A 505, 509, 534, 538, 554.) While the reasons for adding this minor feature are almost self-evident, Mr. McAlexander testified that it would have been obvious at least because these prior art references are in the same field and because the combination would achieve a predictable result of indicating to a user whether it is safe to remove a card from an interface. (*Id.*) TPL's expert addressed these additional claim limitations in a summary fashion, stating that the Dell Inspiron 3000 does not disclose that "at least one of the memory card interfaces includes an indicator identifying a status of an operation for a respective memory reader interface," or that "the indicator includes a light indicating data is being written to a card in the respective memory card interface" without providing any reason for his belief. (CX-1205C, Q/A 129, 132, 137, 139, 143.) The additional "indicator light" limitations are remarkably trivial and clearly taught in the prior art. It was error for the ID to not find these claims obvious based on the record.

The ALJ's critiques of Respondents' obviousness arguments are unfounded. First, the ID states that "Respondents offer no element by element analysis of how the three or four reference combinations" render the claims obvious. (ID at 126.) But the combinations are not "three or four reference combinations" but *two* reference combinations in which the vast majority of the

limitations are met by the primary reference (*e.g.*, the Kaneshiro patent), with the remaining trivial limitations of the dependent claims being found in any one of the secondary references cited. (*See* PHB at 245-48; *see also* RX-0460C at Q/A 477.) Second, the ID’s criticism of Respondents’ reliance on their “inadequate anticipation analysis” is misplaced because Respondents’ anticipation analysis is more than adequate, as explained above. Indeed, it is unrebutted. Finally, the ID states that Respondents’ proffered motivations to combine are “conclusory, unsupported, and insufficient to meet the clear and convincing standard.” (ID at 127.) However, the particular obviousness combinations at issue involve combining familiar elements according to known methods to yield predictable results, and TPL presents nothing to dispute the testimony of Respondents’ expert regarding explicit reasons to modify the anticipatory device disclosed in the Kaneshiro patent to include these well-known features. Such a factual record compels a finding of obviousness. *See, e.g., Tokai Corp. v. Easton Enterprises, Inc.*, 632 F.3d 1358, 1371 (Fed. Cir. 2011).

Thus, the ALJ clearly erred in failing to find each asserted claim invalid as anticipated (claims 1, 9, 17) or obvious (claims 2-4, 10-12, 18, 19) in view of the Kaneshiro patent.

**E. TPL Did Not Establish That a Domestic Industry Exists For The ‘623 Patent.**

As described in detail in Section III below, TPL did not establish that a domestic industry exists for any of the patents asserted in this Investigation. With regard to the ‘623 Patent, TPL’s domestic industry evidence is especially lacking because the ‘623 Patent was not even a focus of TPL’s licensing activities, and it was not asserted against most of the Respondents, so TPL’s tenuous proofs are even more deficient with regard to the ‘623 Patent.

## **F. Conclusion Regarding The ‘623 Patent**

For the foregoing reasons, the ‘623 Respondents respectfully request that the Commission review and reverse the ID as it relates to issues of claim construction, non-infringement, invalidity, and domestic industry for the ‘623 Patent to find as follows:

- (1) The correct construction of “accessible in parallel” requires that devices at least be capable of accessing two memory cards at the same time;
- (2) None of the Accused Products satisfy the “accessible in parallel” limitation because they are not capable of accessing two memory cards in parallel;
- (3) The unrebutted evidence provided by third-party Atech establishes that the prior art Pro II device anticipates each asserted claim of the ‘623 Patent;
- (5) The Uno Mas Article anticipates each asserted claim of the ‘623 Patent;
- (6) The Kaneshiro Patents anticipate or render obvious each asserted claim of the ‘623 Patent; and
- (7) TPL did not establish a domestic industry in the ‘623 Patent.

## **III. THE ALJ ERRED IN FINDING THAT TPL ESTABLISHED A DOMESTIC INDUSTRY WITH RESPECT TO EACH ASSERTED PATENT BASED ON ITS LICENSING ACTIVITIES**

### **A. Introduction and Summary**

The ‘623 Respondents seek review of the determination that TPL established a domestic industry exists as to the ‘623 patent, the only of the five Asserted Patents for which a violation was found, based on activities relating to the CORE Flash Portfolio. All Respondents seek conditional review, on the same bases, of the determination that a domestic industry exists for the remaining Asserted Patents. It is undisputed that (1) TPL is a revenue-driven licensing company, not engaged in invention or exploitation of invention, that obtains revenue by holding up actual inventors and attempting to license manufacturing entities with existing production, (2)

the five Asserted Patents are part of what TPL refers to as its CORE Flash Portfolio, and (3) **TPL's claimed expenses are for the entire Portfolio.** The ALJ applied the wrong legal standard in examining the facts TPL alleged establish a domestic industry for each of the Asserted Patents. In addition, the ALJ's conclusions are contrary to the facts and based only on self-serving testimony of TPL witnesses, unsupported by documentation.

Commission precedent requires that a complainant's investments (1) exploit the asserted patents, (2) relate to licensing, and (3) occur in the U.S.<sup>6</sup> to be considered licensing investments that may establish a domestic industry. *Multimedia Display & Navigation Devices & Sys., Components Thereof, & Prods. Containing Same*, 337-TA-694, Comm'n Op. at 7-8 (Jul. 22, 2011). "Only after determining the extent to which the complainant's investments fall within these statutory parameters can [the Commission] evaluate whether complainant's qualifying investments are 'substantial,' as required by the statute." *Id.* If the activities relate to a portfolio, rather than a single patent, the Commission examines the strength of the nexus between the activity and licensing the asserted patent. *Id.* **A complainant must show that its licensing activities pertain to the particular patent(s) at issue.** *Coaxial Cable Connectors & Components Thereof & Prods. Containing Same*, 337-TA-650, Comm'n Op. at 50 (Apr. 14, 2010).

The ALJ failed to properly apply this legal framework to the present investigation. Specifically, the ALJ failed to consider "the extent to which" TPL's alleged investments in the **entire** CORE Flash Portfolio prove the existence of a domestic industry for **each** Asserted Patent. The ALJ then erroneously credited TPL with the – incorrect – absolute dollar value he found TPL spent on the entire CORE Flash Portfolio, rather than determine an appropriate

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<sup>6</sup> Respondents do not dispute that TPL's activities occur in the United States.

amount to credit each Asserted Patent. Commission precedent is clear that “[n]either the statute nor the legislative history indicates that Congress intended for the Commission to credit all investments in the licensing of a portfolio to each and every patent in the portfolio when evaluating the extent to which complainant’s activities meet the requirement that there be ‘substantial’ investment in exploitation of the ‘patent ... concerned.’” *Navigation Devices*, Comm’n Op. at 13; *see also Integrated Circuits, Chipsets, & Prods. Containing Same Including Televisions*, 337-TA-786, Comm’n Op. at 24 (Oct. 10, 2012); *Liquid Crystal Display Devices, Including Monitors, Televisions, & Modules, & Components Thereof*, 337-TA-749/741, Comm’n Op. at 117, 122 (Jul. 6, 2012).

With respect to whether TPL’s investments are substantial, the ALJ characterized this as an “extremely close call.” (ID at 152.) Citing *InterDigital Communications v. International Trade Commission*, 707 F.3d 1295 (Fed. Cir. 2012), the ALJ disregarded the revenue-driven nature of TPL’s licensing activities. This is **clear legal error**, contrary to Federal Circuit and Commission precedent, and the legislative history, all of which mandate that revenue-driven licensing be given less weight than production-driven licensing. This error alone is enough to tip the scale in an “extremely close call” out of TPL’s favor, particularly considering that TPL spent – at most – [REDACTED] to license the entire CORE Flash Portfolio to various licensees,<sup>7</sup> many of whom only entered a license to settle or avoid litigation with TPL.<sup>8</sup> Importantly, the ALJ did not make any findings regarding the substantiality of TPL’s investments for any Asserted Patent, including the ‘623 patent on which he found a violation.

The evidence leads to only one legal conclusion: TPL’s activities are not the type that

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<sup>7</sup> The ALJ does not include any expenses from 2012 in his domestic industry analysis (ID at 154 fn. 10), and TPL entered [REDACTED] licenses between 2007 and 2011. [REDACTED]

<sup>8</sup> [REDACTED]



Congress intended to establish a domestic industry under section 337(a)(3)(C) and its investment is not substantial. Respondents therefore respectfully request that, if the Commission reviews the ALJ's ID, it reverse the determination that TPL established a domestic industry.

**B. The ALJ Improperly Concluded That There is an “Adequate” Nexus Between The Asserted Patents And TPL’s CORE Flash Portfolio Activities**

The ALJ's conclusion that “TPL has adequately shown there is a nexus between the Flash CORE Portfolio and the Asserted Patents,” (ID at 145), is erroneous and not supported by the evidence. The ALJ legally erred in failing to determine the strength of the nexus between TPL's CORE Flash Portfolio activities and each of the Asserted Patents. *Navigation Devices*, Comm'n Op. at 8-9, 12 (stating, when “activities are associated both with the asserted patents and unasserted patents, **a key issue is the strength of the nexus** between the activities and the asserted patents”) (emphasis added); *see also Semiconductor Chips & Prods. Containing Same*, 337-TA-753, Comm'n Op. at 48-49 (Aug. 17, 2012). Had the ALJ assessed the strength of the nexus, he would have found that it is weak.

**1. There is No Evidence That TPL’s Licensees’ Efforts Relate to “An Article Protected By” Any of The Asserted Patents.**

The ALJ's conclusion that TPL's CORE Flash Portfolio licenses [REDACTED]

[REDACTED] (ID at 140-41), is not supported by the evidence. Most importantly, the ALJ himself found in his technical prong analysis that TPL failed to demonstrate that its licensees' products practice any claim of any Asserted Patent, rejecting TPL's clam charts and expert testimony. (ID at 134-38.) Yet, inexplicably, and on substantially less evidence, he concluded that TPL established that licensee products practice the Asserted Patents in his economic domestic industry analysis.

The only license that the ALJ relies on in support of this statement is TPL's license with

[REDACTED]

[REDACTED] ) This is improper. *See Certain Video Game Systems and Controllers*, Inv. No. 337-TA-743, Comm'n Op at 4-5 (Jan. 20, 2012); *Certain Integrated Circuits, Chipsets, and Products Containing Same Including Television*, Inv. No. 337-TA-786, ID at 166-167 (Aug. 17, 2012).<sup>9</sup> In addition, the ALJ relies on [REDACTED]

[REDACTED] (ID at 141), [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]<sup>10</sup> Thus, any reliance on that section is improper. Finally, [REDACTED]

[REDACTED] Indeed, TPL

did not even accuse [REDACTED] of infringing the '623 patent. Compl. at ¶ 195.

In addition, the ALJ's finding that "approximately half of the [REDACTED] licenses explicitly list approximately [REDACTED] products that are licensed by the CORE Flash Portfolio," (ID at 141), is irrelevant: a listing of licensed products is not an admission or showing of infringement of any Asserted Patent (or any other patent in the CORE Flash Portfolio).<sup>11</sup> None of TPL's

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<sup>9</sup> The ALJ's reliance on this 2012 license is also inconsistent with his statement that he did not include expenses from 2012 in his analysis. (See ID at 154 fn. 10.)

<sup>10</sup> Many other licenses that the ALJ relies on to support his finding that [REDACTED]

[REDACTED]

<sup>11</sup> The ALJ also ignores the fact that at least [REDACTED] licenses on which he relies are with settling respondents from *Digital Photo Frames & Image Display Devices & Components Thereof*, 337-TA-807. [REDACTED] Thus, these licenses are entitled to little or no weight.

CORE Flash Portfolio licenses, including the [REDACTED] cited by the ALJ, specifically discuss any Asserted Patent or indicate that a licensee's products practice any Asserted Patent.<sup>12</sup> In fact, the

CORE Flash Portfolio licenses [REDACTED]

Finally, the ALJ incorrectly relied on TPL claim charts, without any supporting expert testimony, to demonstrate that its licensees' products practice the Asserted Patents. (ID at 141.) In support of this finding, the ALJ relies on testimony from Mr. Hannah, TPL's Chief Financial Officer (CFO), (ID at 141), who has experience in accounting, finance and licensing, not patent analysis. [REDACTED] Mr. Hannah is not qualified to testify about contents of claim charts and his testimony does not support the ALJ's conclusion. [REDACTED]

[REDACTED] ) The ALJ also relies on an opinion from TPL's expert regarding the technical prong of domestic industry for the '623 patent. (ID at 141 [REDACTED])

[REDACTED] However, the ALJ rejected that very same opinion in his technical prong analysis on page 137 of the ID as "an extremely cursory element-by-element analysis." (ID at 137 [REDACTED])

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<sup>12</sup> At most, the licenses state: [REDACTED]

[REDACTED] These statements do not amount to an admission of infringement of the Asserted Patents.



of a final judgment of infringement in federal court for any Asserted Patent, including the ‘623 patent. (See ID at 142 (citing RX-3483, ¶¶ 198-200 (litigation settled) and 202 (litigation stayed pending resolution of Inv. No. 337-TA-807).) In Investigation 337-TA-807, all respondents settled, defaulted, or entered a consent order. (See RX-3483, ¶201.) A settlement, even if considered favorable, does not constitute successful litigation under Commission precedent. See, e.g., *Integrated Circuits*, 337-TA-786, ID at 166 (Aug. 20, 2012) (unreviewed).

**b. The Asserted Patents Are Not Related to an Industry Standard**

There is no evidence that any Asserted Patent relates to an industry standard and the ALJ incorrectly failed to consider this factor. (See RIB at 273.) To the contrary, TPL views the Asserted Patents as being unrelated to any industry standard. (See CX-0689 (the CORE Flash Portfolio is “unconstrained by associations with formal standards-setting processes.”).)

**c. Evidence that the Asserted Patents are Featured in Licensing Discussions, Negotiations, and Resulting Licensing Agreements is Relatively Weak**

The evidence that the Asserted Patents are featured in licensing discussions and resulting licenses is weak. For example, the ALJ cites [REDACTED] as evidence that the Asserted Patents are often attached in licensing correspondence and discussed in depth, (ID at 141), but of those [REDACTED] communications, fewer than [REDACTED] include links to reverse engineering and teardown reports related to an Asserted Patent. [REDACTED]

[REDACTED] The others either reference the entire CORE Flash Portfolio alone or highlight<sup>13</sup> a non-asserted patent [REDACTED], or reference the entire CORE Flash Portfolio and highlight both asserted and non-asserted patents [REDACTED]

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<sup>13</sup> “Highlight” refers to a reference in the correspondence that [REDACTED]





**C. The ALJ Failed to Allocate TPL’s Licensing Expenses to Any of the Asserted Patents, Including The ‘623 Patent**

The ALJ failed to make any finding regarding **what portion** of TPL’s CORE Flash Portfolio licensing-related investments may properly be relied upon to support a domestic industry for any Asserted Patent, including the ‘623 patent. (ID at 145-52.) The ALJ found simply that “TPL’s investments, except those that TPL has explicitly agreed to withdraw, relate to licensing.” (ID at 152.) This is error, as the Commission had made clear that “[s]ome activities are solely related to licensing while others can serve multiple purposes” and, when there is a question whether an alleged licensing activity also relates to non-licensing matters, the evidence is given less weight. *Navigation Devices*, Comm’n Op. at 14, 22-23.

While the ALJ excluded some “litigation expenses, patent prosecution and procurement expenses and TPL’s post-complaint expenses” from his domestic industry analysis, (ID at 150), investments in these activities spanned numerous categories in TPL’s financial documents that the ALJ failed to consider. (ID at 150, 154-55.) First, according to TPL, litigation, patent prosecution and procurement expenses fall under the TPL cost categories known as [REDACTED] and [REDACTED] (CRB at 103-05.) This is supported by TPL’s CFO testimony [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] In his analysis, the

ALJ only removes TPL’s so-called [REDACTED] expenses from the total cost spent on the entire CORE Flash Portfolio. (ID at 154-55.)

The ALJ should have subtracted an additional cost of [REDACTED] from TPL’s expense on the entire CORE Flash Portfolio. [REDACTED]

[REDACTED] The



burdened cost document from which the ALJ calculated TPL’s total expense on the CORE Flash Portfolio, [REDACTED] does not, on its face, include [REDACTED]

However, TPL’s CFO testified that [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Thus, the “total expenditures” for the **entire** CORE Flash Portfolio should be [REDACTED] not [REDACTED].

(ID at 155 fn 11.)

Second, the ALJ fails to take into account the testimony of both TPL’s CFO and the President of Alliacense that [REDACTED]

[REDACTED]

[REDACTED] (See RIB at 261-64; [REDACTED])

[REDACTED]

[REDACTED] This is error, as the Commission has held that it is improper to include employees’ full salaries in the domestic industry calculation when the complainant admits that not every employee spends all of his/her time working on licensing issues. *See Integrated Circuits*, ID at 171-72, *aff’d*, *Comm’n Op.* at 27-28.

There is no reliable way to determine how much of TPL’s employee time is spent on litigation and other non-licensing activity. The ALJ found that “TPL’s business records [show] exactly how many hours each employee worked on licensing the Core Flash portfolio and provide TPL’s ‘burdened cost’ down to the penny for each year from 2007 through September 2012.” (ID at 154.) In doing so, the ALJ accepts TPL’s CFO’s testimony about the licensing activities that TPL/Alliacense employees perform without any corroborating testimony from an

employee who allegedly performs those activities. (ID at 145-47.)<sup>15</sup> The ALJ also accepts TPL’s high-level summary documents that allegedly show the time employees spent on those activities, and the costs associated with those activities, without any corroborating documentation. (ID at 147-48.) TPL’s and Alliacense’s alleged licensing employees [REDACTED]

[REDACTED] (See RIB at 268-69; RRB at 92-93; [REDACTED]  
[REDACTED]) In finding that TPL and

Alliacense employees keep track of the percentage of time at work spent on specific patent [REDACTED] (ID at 145-46, 151), the ALJ ignores the fact that [REDACTED]

[REDACTED] (See RIB at 268-69; RRB at 92-93; [REDACTED]  
[REDACTED]

[REDACTED]  
[REDACTED]<sup>16</sup> TPL’s alleged “business records” are [REDACTED]

[REDACTED]  
[REDACTED]

[REDACTED] Estimates of employee hours are not credible without corroborating documentary evidence or uninterested testimony. *Computer Forensic Devices & Prods. Containing Same*, 337-TA-799, ID at 17 (Nov. 27, 2012) (unreviewed).

Similarly, the ALJ failed to allocate TPL’s leasing and facility expense to either the CORE Flash Portfolio or the Asserted Patents. (See RIB at 267; RRB at 93-94; [REDACTED]

[REDACTED] TPL did not present any evidence to

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<sup>15</sup> TPL’s documents characterize the efforts of Alliacense employees as [REDACTED] in 2012, further casting doubt on the reliability of TPL’s witness testimony on so-called licensing activities. [REDACTED]

<sup>16</sup> There is also no evidence reflecting how much time, if any, TPL and Alliacense employees spend on any Asserted Patent, including the ‘623 patent.

reliably determine how much of that expense is attributable to licensing any Asserted Patent, including the '623 patent, or even the CORE Flash Portfolio, as opposed to another portfolio.<sup>17</sup>

TPL did not dispute that both TPL and its licensing agent, Alliacense, [REDACTED] [REDACTED] (See RIB at 267; RRB at 93-94;

[REDACTED] ) Nor did TPL dispute that [REDACTED] [REDACTED] (See RIB at 267; RRB at 93-94; [REDACTED]

[REDACTED] ) Accordingly, all of TPL's facilities expenses cannot relate to the Asserted Patents or even the CORE Flash Portfolio. *See, e.g., LCD Devices*, Comm'n Op. at 120.

**D. The Evidence Presented by TPL Fails to Establish That TPL's Investment in The '623 Patent, or Any Other Asserted Patent, is Substantial.**

Because TPL failed to establish a reliable level of investment related to its claimed activities for the ALJ to evaluate, his substantiality analysis is void at the outset. If the Commission cannot determine how much licensing-based investment to credit to licenses related to asserted patent(s), it cannot analyze whether the investment is substantial. *See Integrated Circuits*, Comm'n Op. at 32-33. Though a complainant whose showing on one or more of the nexus requirements is relatively weak may establish that its investment is substantial, the ALJ erred in finding TPL did so in this investigation and that finding should be reversed.

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<sup>17</sup> For example, in *LCD Devices*, one of complainant's witnesses determined what percent of time each employee spent on the asserted patents, reviewed travel expense reports and verified with the employee whether the expenditures related to licensing the asserted patents, **and** attributed the percent of employee time to the square footage of office space, insurance and overhead to determine the total facility cost attributable to the asserted patents. *LCD Devices*, Comm'n Op. at 120. In this investigation, there is no reliable method to determine how much expense relates to licensing the CORE Flash Portfolio, rather than some other portfolio(s).

**1. The ALJ Erred in Attributing the Entire [REDACTED] in Expenses that He Found Relate to Licensing to the Asserted Patents.**

The ALJ erred in crediting [REDACTED] in CORE Flash Portfolio licensing expenses to TPL for a domestic industry in the Asserted Patents, (ID at 154-55), by failing to consider Commission precedent, which indicates a complainant’s qualifying investments in licensing may not be attributed in their entirety to the asserted patent(s). *See Navigation Devices*, Comm’n Op. at 13, 23 (stating, “we cannot credit Pioneer’s expenses in full to its investment in exploitation of the [asserted] patents through licensing”); *LCD Devices*, Comm Op at 117 (declining to adopt the ALJ’s attribution of complainant’s entire investment in its portfolio to each asserted patent (*LCD Devices*, ID at 420), stating, “Thomson’s investment relates to the entire LCD patent portfolio, not just the asserted patents.”). Here, while the ALJ found that “the evidence shows that TPL’s allocated costs ... are limited to the CORE Flash Portfolio and not the entirety of TPL’s general licensing program,” (ID at 152), he did not determine what portion of those costs should be credited to exploitation of any Asserted Patents, including the ‘623 patent, as required by section 337(a)(3)(C). This is clear legal error. *Navigation Devices*, Comm’n Op. at 13 (stating, “[n]either the statute nor the legislative history indicates that Congress intended for the Commission to credit all investments in the licensing of a portfolio to each patent of the portfolio when evaluating the extent to which complainant’s activities meet the requirement that there be ‘substantial’ investment in exploitation of the ‘patent ... concerned.’”).

The ALJ could not perform the requisite statutory analysis because TPL did not provide the necessary underlying proof. While “the Commission does not require mathematical precision, it does require an adequate evidentiary basis for evaluating the level of investment for the licenses that include [an asserted patent].” *Integrated Circuits*, Comm’n Op. at 30; *see also LCD Devices*, Comm’n Op. at 115. As discussed, *supra*, in Sections III. A-C, TPL failed to

provide reliable evidence to evaluate the extent of its alleged investments in the Asserted Patents.

For example, the ALJ erred in finding that TPL's allocation of expenses is based on [REDACTED]

[REDACTED] The ALJ accepted testimony that the burdened cost is the result of [REDACTED]

[REDACTED] (ID at 152), but Mr. Hannah testified that [REDACTED]

[REDACTED] Instead, [REDACTED]

[REDACTED] Moreover, Mr. Hannah's deposition reveals that [REDACTED]

[REDACTED] TPL did not produce [REDACTED]

[REDACTED] Given this lack of evidence, the ALJ erred in finding that TPL's investments are substantial.

**2. The ALJ Erred in Applying or Failing to Address Factors Relevant in Determining The Substantiality of TPL's Licensing Investments.**

**a. The ALJ Should Have Considered TPL's Purely Revenue-Driven Licensing Program in Assessing the Substantiality of its Alleged Investment.**

TPL's alleged CORE Flash Portfolio licensing investments are undisputedly directed to an exclusively revenue-driven licensing program. The law mandates that such investments be given less weight when evaluating substantiality. *Omnibus Trade & Competitiveness Act of 1988*, Pub. L. No. 100-418, § 1342, 102 Stat. 1107, 1213; *Navigation Devices*, Comm'n Op. at 25; *Mezzalingua*, 660 F.3d at 1327-28. The ALJ should have discounted TPL's alleged investments based on the nature of its CORE Flash licensing program.

The ALJ misapplied recent Federal Circuit precedent and improperly disregarded the revenue-driven nature of TPL's licensing program, which focuses on extracting royalty payments based on existing production. Specifically, the ALJ erroneously concluded that the Federal Circuit's holding that "[i]t is not necessary that a party manufacture the product that is protected by the patent, and it is not necessary that any other domestic party manufacture the protected article" implies that **"the focus is on a complainant's licensing efforts, generally, and not what 'type' of licensing it is, i.e., production-driven or revenue-driven."** (ID at 153 (emphasis added) (citing *InterDigital*, 707 F.3d at 1303-04).)

In *InterDigital*, the Federal Circuit did not alter, or even comment on, the Commission's test to determine whether a complainant's licensing investment is substantial. Rather, the Court concluded that domestic production of goods that practice the asserted patent is not a prerequisite to finding a licensing-based domestic industry. *InterDigital*, 707 F.3d at 1303-04. The Court confirmed its support of the Commission's substantiality test, keeping the nature of the licensing industry as a relevant inquiry, stating that, to establish a domestic industry, the complainant must prove that it made a "sufficiently substantial" investment in licensing the asserted patent. *Id.* The Court stated that it and the Commission "have made clear that the investment in ... licensing must be sufficiently substantial to constitute a domestic industry" to alleviate concern that Commission remedies are available to any domestic patent owner no matter the scale of its exploitation activities. *Id.* at 1299 n2, 1303-04. The Court in no way disturbed the Commission's established criteria for determining substantiality. Moreover, after *InterDigital*, the Court reiterated that litigation-related licensing investments directed to encouraging adoption and development of articles incorporating patented technology, receive more favorable treatment than those that are purely revenue-driven. *See Motiva, LLC v. Int'l Trade Comm'n*, 716 F.3d 596,

600-01 (Fed. Cir. 2013) (citing *InterDigital*, 707 F.3d at 1299, and *Mezzalingua*, 660 F.3d at 1328-29). Thus, the ALJ's conclusion is erroneous as a matter of law.

The record and legal precedent establish that TPL's licensing investments and activities are entitled to less weight because they are revenue-driven and target existing production to monetize the CORE Flash Portfolio [REDACTED]

[REDACTED] TPL targets potential licensees only after they incur sunk costs to incorporate alleged patented technology, raising costs to change to a different technology and increasing the amount they may concede to pay for a license. [REDACTED]

[REDACTED] This is economic hold-up that hurts consumers and directs resources away from innovation, [REDACTED] which TPL exploits by threatening litigation<sup>18</sup> and potential injunctions. [REDACTED] For example, TPL contacted [REDACTED]

[REDACTED] warning it of the potential downside and risks of litigation if [REDACTED] [REDACTED] (Hannah Tr. 248:14-250:12; RX-3482C (claiming HP may be liable for [REDACTED] in damages and [REDACTED]

[REDACTED] under the asserted patents).) TPL presented no evidence that its investments are directed to the type of activities favorably referenced in section 337's legislative history. *See Omnibus Trade & Competitiveness Act of 1988*, Pub. L. No. 100-418, § 1342, 102 Stat. 1107, 1213; *Mezzalingua*, 660 F.3d at 1327-28.

Under the correct legal standard, the revenue-driven nature of TPL's licensing program is highly relevant and tips the scale on the "extremely close call" on the substantiality issue to a finding of no domestic industry. *See, e.g., Navigation Devices*, Comm'n Op. at 25 (according

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<sup>18</sup> Some TPL CORE Flash licensees have entered into a license [REDACTED]

complainant's investment in revenue-driven licensing activities less weight because they were not the type of licensing activities that Congress meant to promote); *see also LCD Devices*, Comm'n Op. at 124; *Integrated Circuits*, ID at 176, aff'd with modification, Comm'n Notice at 3 (Sept. 13, 2012).

**b. The ALJ Failed to Address Additional Factors Relevant to Determining Whether a Complainant's Investment is Substantial**

The ALJ failed to address a number of other factors that he should have considered that further show TPL's claimed licensing investments are not substantial. *See Navigation Devices*, Comm'n Op. at 16. First, the ALJ erred in not considering the fact that TPL does not engage in ancillary licensing activities, such as ensuring compliance with license agreements, and providing training, design assistance or technical support to licensees, which is relevant to substantiality. *Navigation Devices*, Comm'n Op. at 16, 24. It is undisputed that TPL does not engage in any such ancillary activities or that its only alleged post-licensing activities relate to

[REDACTED]

[REDACTED]<sup>19</sup> Next, the ALJ erred in not considering the fact that TPL does not exploit the Asserted Patents in some manner other than licensing, such as research, development or engineering activity, which is also relevant when evaluating substantiality. *Navigation Devices*, Comm'n Op. at 16. TPL's witnesses admitted that [REDACTED]

[REDACTED]

[REDACTED] Finally, the ALJ erred in not considering whether TPL's alleged licensing activities are continuing, another factor relevant to the substantiality inquiry. *See Navigation Devices*, Comm'n Op. at 16. Whether they are continuing is questionable as TPL recently filed a petition

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<sup>19</sup> TPL presented no evidence of [REDACTED].



for reorganization under Chapter 11 under the U.S. Bankruptcy Code. *See* TPL’s Notice of Reorganization (Apr. 22, 2013).<sup>20</sup>

**c. The ALJ Improperly Shifted the Burden to Respondents to Prove that TPL’s CORE Flash Portfolio Investment is Small**

Finally, the ALJ erred in finding that TPL’s CORE Flash Portfolio-based licensing expenses are of a large magnitude. The ALJ improperly placed the burden on Respondents to prove that the magnitude of TPL’s CORE Flash Portfolio licensing investment – at most, [REDACTED] of alleged licensing activity – is small. It is TPL’s burden to prove that its licensing investments are of a large magnitude, not Respondents’ burden to show that the investments are trivial. *See, e.g., Navigation Devices*, Comm’n Op. at 23-25.

It is important to consider the nature of the relevant industry and resources of the complainant in determining whether a complainant’s investment is substantial. *See Navigation Devices*, Comm’n Op. at 15. However, TPL provided no industry evidence to demonstrate that its alleged licensing investments are substantial. In *Laminated Packaging*, the present ALJ found that he could not make a substantiality determination where there was no evidence on the relevant industry. *Prods. Having Laminated Packaging, Laminated Packaging, & Components Thereof*, 337-TA-874, ID at 44 (July 5, 2013).

For completeness of their own substantiality analysis and in the absence of industry evidence produced by TPL, Respondents compared the revenue allegedly generated by the CORE Flash Portfolio, a portfolio that [REDACTED] than at least one other TPL portfolio, to revenue generated by its other portfolios and by the industry. (RIB at 276-77.) The ALJ incorrectly rejected Respondents’ comparisons as too broad, “not adequate,” and providing

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<sup>20</sup> Even if TPL’s licensing activities are continuing, this factor alone “is not enough to support a finding that the investment described supra is ‘substantial’ within the meaning of Section 337.” *Integrated Circuits*, ID at 176.

“little to no value in determining significance of investment.” (ID at 153-54.) The ALJ’s requirement that Respondents compare TPL to “a single entity similar to TPL in the flash memory industry,” (ID at 154), is legal error. *See Navigation Devices*, Comm’n Op. at 24 (evaluating the industry in terms of the “relevant market,” which “include[d] many participants [such as] vehicle-based navigation devices, handheld portable navigation devices, and smartphones with navigation capabilities”); *see also Integrated Circuits*, ID at 175 (comparing complainant’s net sales/cost to the size of the semiconductor industry and finding that its investment was not substantial); *LCD Devices*, Comm’n Op. at 122-23 (comparing complainant’s investment in licensing its LCD portfolio to its total U.S. and worldwide licensing expenditures).

**E. OnSpec Issues**

The ALJ correctly found that TPL should not be permitted to rely on OnSpec’s expenditures and that TPL’s sales of OnSpec products alone are insufficient to satisfy the economic prong. However, the ALJ erred in failing to consider Respondents’ additional arguments. In particular, OnSpec’s alleged investments ceased when [REDACTED] and are thus too remote to constitute a valid domestic industry in this investigation. [REDACTED]

[REDACTED]

[REDACTED] 19 U.S.C. § 1337(a)(2); *see Video Game Sys.*, ID at 164 (Nov. 2, 2011), *aff’d*, Comm’n Op. at 4-5 (Jan. 20, 2012).

#### IV. THE “ACTIVE ADAPTER” PATENTS: THE ‘443, ‘424 AND ‘847 PATENTS.

##### A. Invalidity

##### 1. The Asserted Claims Are Invalid Over the Lipponen References under the ALJ’s Claim Construction and Regardless of the Priority Dates Assigned.

European Patent 1 037 159 (“EP ‘159 patent,” RX-985), which the ALJ found to be § 102(a) prior art to the asserted patents, ID 105, discloses every limitation of—and therefore anticipates—the asserted claims. U.S. Patent No. 6,612,498<sup>21</sup> is also prior art under § 102(a) and § 102(e) to the asserted patents.<sup>22</sup> All of the asserted claims require a media adapter that is able to read from more than one type of memory media card. (*See, e.g.*, JX-3, cls. 1, 3- 4, 7, 9, 11-12, 14 (reciting “multi-memory media adapter”); *id.* cls. 9, 11-12, 14 (reciting “a plurality of memory media cards”); JX-4, cls. 25-26, 28-29, JX-6, cls. 1-3 (reciting “a plurality of different type[s] [of] memory media cards”).) The ALJ correctly found the EP ‘159 patent supports two types of cards, an MMC card and a SIM card. ID 105. The ALJ erred, however, in finding that a SIM card is not a memory card. *Id.* (“[W]hile Respondents have shown that the invention disclosed in the EP ‘159 Patent supports two types of cards, there is only one memory media card disclosed.”). That finding served as the sole basis for holding the EP ‘159 patent did not anticipate the asserted claims.<sup>23</sup> Because the ALJ’s finding that a SIM card is not a memory card

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<sup>21</sup> For clarification, Respondents never intended that the Lipponen references be considered together. *See* ID 104. Rather, because the disclosures of the Lipponen references are effectively identical, and because either reference on its own contains the same anticipating disclosure, Respondents cited the EP ‘159 Patent for efficiency and to avoid duplicative argument.

<sup>22</sup> To the extent the Commission does not reverse the ALJ’s finding that the asserted mapping patents are entitled to a priority date of July 6, 2000—which Respondents contend was an erroneous finding by the ALJ—U.S. Patent No. 6,612,498 is still prior art to the asserted patents under 35 U.S.C. § 102(e).

<sup>23</sup> Respondents established, and the ALJ did not disagree, that the EP ‘159 Patent discloses all of the other limitations of the asserted claims. (RX-0460C at Q1244-Q1357; Tr. at 1540:1-1541:13, 1542:16-1549:19, 1553:10-16; RX-0985 at Abstract, ¶¶ 2, 7, 13, 15, 19, 23-30, 35, Figs. 2b, 4-6, 7b, 9, Table IV.) U.S. Patent No. 6,612,498 discloses all of the other limitations of the asserted claims in the

is unsupported by—and indeed directly contrary to—the record evidence, the Commission should find this limitation satisfied and the asserted claims invalid as anticipated by the EP ‘159 patent.

The only record evidence on the issue establishes that a SIM card *is* a memory card. Respondents’ expert, Joseph McAlexander, testified that the EP ‘159 patent discloses a “multi-memory media adapter” because it “is capable of accepting *both* MultiMediaCard (“MMC”) and Subscriber Identity Module (“SIM”) cards.” (RX-0460C at Q1257.) He also stated that the EP ‘159 patent discloses “a multi-memory media adapter to read data from *a plurality of memory media cards*, including MMC-cards *and* SIM-cards.” (*Id.* at Q1283; *see also id.* Q1308 (“[T]he contact pins are adapted to contact a set of *memory card contacts*, *both* the MMC-card *and* SIM-card contact.”); Q1324 (same); Q1341 (same).) On cross-examination, Mr. McAlexander made clear that one of skill in the art would understand a SIM-card as a type of memory card:

Q. All right. And the only memory card in that reference [the EP ‘159 Patent] was the MMC card, right?

A. The only -- *no, there is a SIM card as well.*

Q. And it is your contention today that *a SIM card is a flash memory card?*

A. It has flash memory on it, yes.

(Tr. at 1553:10-16.)

Mr. McAlexander’s testimony is un rebutted. Complainant’s expert Mr. Buscaino never disputes that the EP ‘159 patent discloses a “multi-memory media adapter,” or a “multi-memory media adapter to read data from a plurality of memory media cards.” (RX-0460C at Q1258, 1284; *see also* CX-1205C at Q446-Q448, Q460-Q462.) In doing so, Mr. Buscaino implicitly

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same manner. (RX-0807 at Abstract, 1:10-32; 2:28-60; 5-42-57; 6:12-32; 7:25-44; 8:6-10:29; 11:51-67, Figs. 2b, 4-6, 7b, 9, Table IV.)

conceded that a SIM-card is a type of memory card. Nor did Complainants offer any evidence at all disputing that a SIM card is a memory card. That is evident from Complainant's post-hearing briefs, which, other than generically incorporating Mr. Buscaino's witness statement, rely solely on unsubstantiated attorney argument. (TPL PHRB at 71-72 (citing the EP '159 patent and its U.S. counterpart).) That is not evidence and cannot support the ALJ's finding. *Invitrogen Corp. v. Clontech Labs., Inc.*, 429 F.3d 1052, 1068 (Fed. Cir. 2005) ("Unsubstantiated attorney argument regarding the meaning of technical evidence is no substitute for competent, substantiated expert testimony."); *Ferring BV v. Barr Labs., Inc.*, 437 F.3d 1181, 1193 (Fed. Cir. 2006) ("Conclusory allegations and attorney arguments are insufficient ... In order to raise a genuine issue of fact, a party must submit conflicting evidence in the form of an affidavit or other admissible evidence."). Because the ALJ's finding that the EP '159 patent does not anticipate is contrary to the unrebutted evidence that a SIM card is a memory card, the Commission should find the asserted claims of the '847, '424, and '443 patents invalid as anticipated.

**2. If the Commission Reverses the ALJ's Non-Infringement Holding, the SD Specification Invalidates the Asserted Claims of the '443, '424 and '847 Patents.**

With respect to the SD Specification, the ALJ's validity analyses of the '443, '424 and '847 Patents mirror its non-infringement analysis for the same patents. Using a proper construction of "mapping," the ALJ held that MMC- and SD-capable card readers do not perform mapping as recited in the asserted claims of the '443, '424 and '847 Patents. ID, § V.B.1. The ALJ held that the SD Specification does not invalidate the asserted claims for the same reason: The SD Specification refers to these same MMC- and SD-based cards and, because they do not perform mapping for purposes of infringement, they cannot perform

mapping for purposes of invalidity. This conclusion was based on a proper interpretation of the asserted claims and, therefore, should not be disturbed.

If, however, the Commission reverses the ALJ's holding of non-infringement and concludes that the '443, '424 and '847 Patents can be infringed by MMC- and SD-capable card readers, then it also should hold the asserted claims are invalid by prior art that discloses this same subject matter. The SD Specification discloses the identical processes that TPL accused as infringing – indeed, the Respondent's products operate according to this prior art – and, therefore, the SD Specification invalidates the claims if they are given sufficient scope to cover Respondents' products.

**a. The SD Specification is Prior Art to the Asserted Claims of the '443, '424 and '847 Patent Regardless of Priority Date.**

The SD Specification qualifies as prior art under 35 U.S.C. § 102(f). TPL failed to contest the § 102(f) issue in their post hearing brief or their post hearing reply brief and, therefore, waived any challenge to this argument. Order No. 16 at GR 11.1 (June 26, 2012). It is unsurprising TPL chose not to argue this issue, given that: 1) their '638 Patent, the earliest filed patent to which these patents attempt to claim priority, identifies the SD Group as the source of SD card and its features (JX-0006, 2:12-37.); and 2) the inventors testified they used the SD Specification as they developed their products and patent filings. (Jones, Tr. 1557:15-1558:7, 1563:2-1564:3, [REDACTED] Iyer, Tr. 376:4-6, 13-17; 377:5-13.) Thus, the SD Specification is prior art to these patents.

**b. The SD Specification Discloses a Controller that Performs the Same Mapping Operations as in the Accused Products.**

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] The host controller communicates with SD and MMC cards over common communication lines – whichever card is connected to the bus. [REDACTED]

[REDACTED] RX-0460C, Q/A 1688-91.)

The SD Specification also describes that SD and MMC cards were designed to be placed in a common socket. [REDACTED] Jones, Tr. 1561:2-22 (inventor)) An MMC card has seven contact pads and an SD card has nine contact pads; both cards engage common contact pins in the socket. [REDACTED] RX-2387.0010-11.) [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] It works according to the MMC host interface for MMC cards, which includes three communication lines - CMD line on pin 2, CLK line on pin 5, and one data line on pin 7. (RX-2387.0070, Fig. 36.) These are same communication lines with the same pin assignments as the SD host interface.





**c. The SD Specification shows all Elements of the Asserted Claims, if the Commission Reverses the ALJ’s Claim Construction.**

As noted above, TPL based its infringement claims at Respondents’ use of the SD Specification. If the Commission reverses the ALJ’s non-infringement holding, then the specification invalidates the asserted claims of the ‘443, ‘424 and ‘847 Patents.

TPL attempted to distinguish the SD Specification on only two grounds: 1) the SD Specification refers only to SD cards but not to multimedia card readers, and 2) the SD Specification does not disclose mapping as required by the asserted claims because there is no sharing of data lines. CRB, at 63.<sup>24</sup> TPL is wrong on both counts.

First, the SD Specification refers to multi-format card readers because it describes both MMC and SD card functionality. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Systems that read different cards, of course, are multi-media card readers.

Second, the SD Specification demonstrates sharing of data lines for both cards. [REDACTED]

[REDACTED]

Moreover, the SD Specification describes processes by which a host controller communicates with a newly-presented card over common signal lines before it identifies the card’s type.

[REDACTED]

[REDACTED]

[REDACTED] If the card is identified as an SD card, the host controller sends a

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<sup>24</sup> In its Post-hearing Brief, TPL incorporated the testimony of Mr. Buscaino wholesale, without particularized argument. This is improper. Order no. 16, GR. 11.3, 11.4.

CMD2 signal to initialize it. If the card is identified as an MMC card, the host controller sends a CMD1 signal to initialize it. Thus, the host controller communicates with the new card over shared lines, not separate lines as TPL alleges.<sup>25</sup>

The ALJ relied on the foregoing description in its non-infringement analysis and ultimately concluded that there is no mapping for SD and MMC cards because “communication with an SD card and an MMC card is identical *according to the specification.*” ID at 45-48 (emphasis added). Because TPL’s infringement claims are based on Respondents’ use of the SD Specification in their products, the Commission should hold that the SD Specification invalidates the asserted claims of the ‘443, ‘424 and ‘847 Patents if it decides to reverse the ALJ’s holding that the claims are not infringed.

**3. The ALJ Erroneously Found That The ‘928 Publication Does Not Invalidate The Asserted Claims Of The Active Adapter Patents.**

The ALJ correctly determined that Japanese Patent Publication JP H11-15928 (“the ‘928 Publication”) is prior art to the Active Adapter Patents, and TPL does not dispute that fact. (ID at 108; TPL PostHB, 253, 256.) The Commission need not review that aspect of the ID. It was, however, clear error for the ALJ to summarily dismiss Respondents’ analysis of the ‘928 Publication without evaluating the extensive, unrebutted evidence cited by Respondents. (ID at 108-09; *see* Resp. PostHB, 153-54.)

The ALJ erroneously claimed that Respondents’ analysis of the ‘928 Publication was “inadequate” and did not present an element-by-element examination of the asserted claims. (ID at 108.) It is apparent from this abrupt rejection of Respondents’ arguments that the ALJ did not

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[REDACTED] TPL’s argument does not consider the entirety of the specification’s disclosure.

review the ample evidence and testimony cited by Respondents in support of their contention that the '928 Publication anticipated and/or rendered obvious the asserted claims of the Active Adapter Patents. Had the ALJ done so it would have been clear that Respondents had met their burden to show invalidity by clear and convincing evidence.

As set forth in Respondents' Post-Hearing Brief, the '928 publication discloses a multi-memory media adapter that allows a plurality of types of small PC cards to be interfaced to a personal computer. (*See* Resp. PostHB, 153-54, *citing* RX-0460C, Q/A 2299; RX-0818, ¶ 1.) The multi-memory media adapter includes a compact housing for individually housing a plurality of types of small PC cards, a control part which distinguishes a small PC card mounted in the housing part and controls the transmission of signals between the small PC card and an external device, and a transmission/reception part for transmitting and receiving signals to and from the external device. This is illustrated in Figure 1 of the '928 publication. (*Id.*) The multi-memory media adapter of the '928 publication has contact pins for use with multiple small PC cards such as a compact flash card, an SSFDC (Solid State Floppy Disk Card), and a miniature card. (*Id.*) Each small PC card is connected to the control part 41 via respective specialized connectors and transmitted to the external device (personal computer) via the transmission/reception part 41 as Fig. 4 illustrates. (*Id.*) Respondents also submitted expert testimony, unrebutted by TPL, describing the '928 Publication's disclosure of each element of asserted claims 1, 3, 4, 7, 9, 11, 12, and 14 of the '443 Patent (*See* Resp. PostHB, 154, *citing* RX-0460C, Q/A 2300-48; RX-818, ¶¶ 15-29, 33-46), asserted claims 25, 26, 28 and 29 of the '424 Patent (*See* Resp. PostHB, 154, *citing* RX-0460C, Q/A 2349-93; RX-818, ¶¶ 15-29, 33-46, 50-51, 55-62), and asserted claims 1, 2 and 3 of the '847 Patent (*See* Resp. PostHB, 154, *citing* RX-0460C, Q/A 2394-2418; RX-818, ¶¶ 15-29, 33-46, 50-51, 56-62). The ALJ's failure to address

that evidence in determining that the '928 Publication did not anticipate or render obvious the asserted claims was clearly erroneous.

Accordingly, in the event that the Commission decides to review the ALJ's non-infringement finding, it should also review the determination that the '928 Publication does not invalidate the Active Adapter Patents.

**4. The ALJ Misapplied Federal Circuit Law on Priority Dates, Which Caused Other Prior Art to be Disqualified in Error.**

The ALJ awarded the asserted claims of the '443, '424 and '847 Patents an improper priority date based on a misapplication of governing law. In particular, the ALJ states that, although a parent patent (the '638 Patent) does not disclose all elements of the asserted claims, the '638 Patent nevertheless provides a priority date for the asserted claims because the missing subject matter was known to persons of skill in the art. This is legal error.

**a. The '638 Patent Fails to Disclose the Molded Plastic Connectors and Embedded Contact Pins Recited in the '443 Patent.**

The ALJ erred when he concluded that the '638 Patent provides written description of the "molded plastic" and "contact pins" of the '443 Patent. These elements appear as follows:

CLAIM	LIMITATION
'443 Patent, all asserted claims:	a set of contact pins protruding from an upper or lower surface / portion of an adapter, wherein the set of contact pins are integrated within molded plastic (embedded).

The '638 Patent describes connectors but only in a generalized, black-box form. It is undisputed that the '638 Patent does not describe any materials (such as "molded plastic") from which connectors are made. (RX-0460C, Q/A 135-45, 157-59; Buscaino, Tr. 608:2-10, 616:3-617:9.) It is undisputed that the '638 Patent does not describe "contact pins integrated within molded plastic." (RX-0460C, Q/A 168, 178, 186; JX-0005, 5:5-34, 8:30-35; Buscaino, Tr. 647:3-12). Moreover, it is undisputed that, during prosecution, Applicant added the "molded plastic"

element to the claims by amendment to overcome rejections based on prior art that disclosed connectors in generalized fashion. (RX-0047.359-60; RX-460C, Q/A 140.) The ALJ accepted TPL's proposed priority date on the basis of Mr. Buscaino's testimony that, even though they are not disclosed in the parent patent, these features were known to people of skill in the art. *Id.*, pp. 90-91. In doing so, the ALJ applied the wrong legal standard.

Priority is proven only when a parent patent discloses *all elements* of a claim, either expressly or inherently. *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1307 (Fed. Cir. 2008); *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). To do so, the parent must describe the later-claimed invention in sufficient detail that one skilled in the art can clearly conclude that the inventor had possession the claimed invention as of the priority date sought. *Lockwood*. Possession of an invention is demonstrated by describing the invention, with all of its claimed limitations. *Id.* When a parent patent omits disclosure of all features of a later-presented claim, the parent does not confer a priority date to that claim, even when the missing subject matter is obvious to one of skill. *PowerOasis*.

Here, because the '638 Patent does not disclose all features recited above, it should have ended the priority date inquiry. When the ALJ considered materials outside the '638 Patent's disclosure – Mr. Buscaino's representations of known connectors – the ALJ deviated from *Lockwood* and *PowerOasis*. In *PowerOasis*, the Federal Circuit rejected evidence, such as TPL's, which claims entitlement to a priority date on the basis that subject matter was missing from a parent patent but was well known to persons of skill. *PowerOasis*, 522 F.3d at 1310 (discussion of features that are "well known" suggests obviousness but is not enough to confer priority). The ALJ should have rejected TPL's extraneous evidence, which is legally insufficient to demonstrate priority, and relied only on the '638 Patent's disclosure.

Moreover, the ‘443 Patent’s prosecution history demonstrates that the ‘638 Patent’s disclosure does not adequately describe molded plastic connectors. There, Applicant amended the claims to include the “molded plastic” feature and argued this feature provided a basis to distinguish prior art that the Patent Office had applied against the claims. TPL stated:

Applicant asserts that it is clearly indistinguishable from Figures 1-5 of Hung-Ju what material the planar surfaces are comprised of. Thus, Figures 1-5 of Hung-Ju is insufficient to teach, motivate, suggest the limitation of the first planar element comprising ‘molded plastic’, of Applicant’s independent claims 1 and 12. (RX-0047.359-60; RX-460C, Q/A 140.)

Because they argued to the Patent Office that the claims’ recitations of “molded plastic” conferred patentability over prior art and the ‘638 Patent has no disclosure of any such subject matter, the ‘638 Patent cannot demonstrate that the inventors had possession of such subject matter. *Lockwood*. The ALJ’s priority award should be reversed.

**b. The ‘638 Patent Fails to Disclose Sets of Contact Pins Mounted in a Common Housing for Multiple Types of Cards as Recited in the ‘424 and ‘847 Patents.**

The ALJ also erred when he concluded that the ‘638 Patent provides written description of the “contact pins” elements of the ‘424 and ‘847 Patents. They appear as follows:

CLAIM	LIMITATION
’424 Patent, claims 25-26	one or more sets of contact pins mounted on said surface at locations adapted to interface with the electrical contacts of a corresponding one of a plurality of different type memory media cards when inserted into said port
’424 Patent, claims 28-29, and ’847 Patent, all claims:	a plurality of sets of contact pins mounted on said surface at locations adapted to interface with the electrical contacts of a corresponding one of a plurality of different type memory media cards when inserted into said port

The ‘638 Patent describes connectors but, again, only in a generalized, black-box form. The ‘638 Patent discloses essentially two embodiments of card readers, one that accepts cards in “adapters” (FIG. 3B) and another that accepts cards in “connectors” (FIG. 6) The ‘638 Patent never characterizes the adapters or the connectors as having separate sets of contact pins.

(Buscaino, Tr. 641:3-12). Further, the '638 Patent never describes locations within a housing where the contact pins might be mounted.

The first embodiment (FIG. 3B) presents a card reader 42 that has a 50-pin connector 44 with contact pins for a single card format – the 50-pin CompactFlash card. ('638 Pat., 5:34-41, JX-0005.0017) Adapters 30 and 34 each support a single card format, SmartMedia and MemoryStick, respectively. (Buscaino, Tr. 642:5-16). Adapter 32 supports both the SD and MMC card formats but has a single set of 9 contact pins for doing so. (Buscaino, Tr. 642:17-22). None of these connectors are disclosed as having a plurality of sets of contact pins to interface with different types of cards or mounting the contact pins at any particular location.

On cross-examination, TPL's expert argued that the connector 44 could correspond to this subject matter because this connector interfaced both with the CompactFlash card 16 and the adapters 30-34 into which other cards were inserted. Of course, this disclosure does not align with the asserted claims, which require: 1) "a plurality of sets of contact pins,"<sup>26</sup> 2) "contact pins mounted on [a common] housing," 3) which "interface with a plurality of different memory media cards." First, the adapters 30-34 are adapters, not memory cards. Second, the connector 44 pins that interface with CompactFlash cards and pins in the adapter 30-34 for another card are on different surfaces, not mounted on a common surface. Thus, this disclosure is insufficient to correspond to the claimed subject matter and cannot confer priority to the asserted claims.

The second embodiment (FIG. 6) presents a card reader with four separate connectors 60-68. Three of them are single format connectors – CompactFlash connector 62, SmartMedia connector 66 and MemoryStick connector 68. (Buscaino, Tr. 645:20-23) The fourth connector

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<sup>26</sup> Claims 25-26 of the '424 Patent refer to "one or more sets of pins." Because *PowerOasis* demands that a parent patent disclose all claim elements, the '638 Patent must disclose one set of contact pins and more than one set in order to confer priority. As discussed, the '638 Patent does not.

supports both MMC and SD cards but uses a single set of 9 contact pins to do so. (Buscaino, Tr. 646:3-647:6). The '638 Patent never states that any connector has separate sets of contact pins. (Buscaino, Hr. Tr. 647:3-6)

Priority is proven only when a parent patent discloses all elements of a claim, either expressly or inherently. *PowerOasis*, 522 at 1307. The ALJ erred because, as shown above, the undisputed evidence demonstrates the '638 Patent does not disclose connectors with multiple sets of contact pins for multiple types of cards as required by the '424 and '847 Patents. Accordingly, the ALJ's priority date analysis is legally wrong and should be reversed.

**c. Respondents' Priority Dates are Proper.**

It is undisputed that the features discussed in the foregoing sections are described in a later patent to which priority is claimed: U.S. Patent 6,859,369 ("the '369 Patent"). (RX-0460C, Q/A 166; Buscaino, Tr. 622:2-16, 633:20-634:19) The '369 Patent was filed on September 4, 2002. (*Id.*; RX-0812). It discloses connectors made of molded plastic, having multiple sets of contact pins mounted therein. (RX-0812, 4:33-49, 4:64-67, FIG. 3; Buscaino, Tr. 622:2-16, 633:20-634:19) Thus, the asserted claims of the '443, '424 and '847 Patents are entitled to a priority date of September 4, 2002.

Because the ALJ applied an incorrect priority date to the asserted claims, several prior art sources were improperly excluded from analysis. These include the MultiFLASH products, the Dazzle product, the Sun reference, the Toshiba reference and Saito reference. ID at 106-109. Accordingly, if the Commission decides to reverse the ALJ's holding that there is no infringement of the '443, '424 and '847 Patents, the Commission also should reverse the ALJ's priority date analysis, vacate the ALJ's invalidity analyses with respect to these references and remand for reconsideration of these references.



**V. THE “ERROR CORRECTION DETERMINATION” PATENT: THE ‘549 PATENT**

**A. The ALJ Erred in Finding That AwYong Was Not Invalidating Prior Art.**

The ALJ held that Respondents presented insufficient evidence to demonstrate that the AwYong thesis (“AwYong”) was prior art to the ‘549 Patent. This was error because AwYong was publicly available prior to the critical date of the ‘549 Patent and renders the asserted claims of the ‘549 Patent invalid.

**1. Respondents Presented Sufficient Evidence to Demonstrate that AwYong Was Publicly Available Prior Art.**

The ALJ erred in finding that Respondents had not proven AwYong was publicly available as of the critical date and thus did not anticipate or render obvious the asserted claims of the ‘549 Patent. ID at 114-118. Respondents put forth clear and convincing evidence to the contrary. Specifically, the AwYong thesis (RX-0456) itself clearly shows that it was publicly available as of December 22, 2000. This is supported by the testimony of a librarian, Dr. Ellett. (RX-0454.)

AwYong is a graduate thesis prepared by a Taiwanese graduate student in June of 2000 and submitted to the library of the National Chiao-Tung University in Taiwan. (RX-0456; RX-0454.8-9, Q&A 26.) The handwritten thesis index number on page 2 shows that AwYong was bound in 2000, page 3 indicates that it was submitted to an advisor in June 2000, and page 4 confirms that it was approved on June 9, 2000. (RX-0456.2-4; RX-0454.7-10, Q&A 25-27.) The MARC (Machine Readable Cataloging) record for AwYong indicates that it was catalogued and indexed on December 16, 2000 (RX-0455; RX-0454.4-5, Q&A 16-17; RX-0454.7, Q&A 24), and the original “Thesis Publication Certification” from National Chiao-Tung University certifies that AwYong was publicly available as of December 22, 2000 (RX-0458; RX-0459; RX-0454.12-14, Q&A 32-33). This evidence is unrebutted.

PUBLIC VERSION OF A CONFIDENTIAL DOCUMENT

To qualify as a “printed publication” under 35 U.S.C. § 102, a reference merely needs to be “sufficiently accessible to the public.” *In re Cronyn*, 890 F.2d 1158, 1160 (Fed. Cir. 1989). A reference in a library is considered publicly accessible if it has been indexed in the library catalogue such that “persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” *See In Re Lister*, 583 F.3d 1307, 1311 (Fed. Cir. 2009); *In re Hall*, 781 F.2d 897, 899-900 (Fed. Cir. 1986). Library records, like AwYong, in conjunction with corroborating library records of availability, like the MARC record and “Thesis Publication Certification,” are sufficient to establish the date of public availability for a prior-art thesis. *Honeywell Int'l, Inc. v. United States*, 81 Fed. Cl. 514, 525 (Fed. Cl. 2008), *rev'd on other grounds*, 596 F.3d 800, (Fed. Cir. 2010) (finding a MARC record and date stamp on a check-out card sufficient to establish date of public availability for a catalogued thesis).

The ALJ erred in failing to credit this documentary evidence and the testimony of Dr. Ellett, who explained how the MARC record corroborates publication information shown on the face of the thesis, even though he acknowledged that hearsay evidence is permitted in Section 337 actions if it is relevant, material, and reliable.<sup>27</sup> ID at 115; *see also* 5 U.S.C. § 556(d); 19 C.F.R. § 210.37(b); *Certain Devices for Mobile Data Communication*, Inv. No. 337-TA-809, Order No. 58 (Pub. Ver.), at 4 (Oct. 11, 2012); *Certain Elec. Devices With Image Processing Systems, Components Thereof, & Associated Software*, 337-TA-724, Order No. 29 (Pub. Ver.) at 8, n.7 (March 11, 2011).

The ALJ’s conclusion to disregard Dr. Ellett’s testimony on the basis that he presented expert opinions as fact testimony is unfounded. First, the ALJ noted a fact witness would be free

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<sup>27</sup> ALJ Essex has relied on hearsay in the past to establish that a reference is prior art under 35 U.S.C. § 102(b). *Certain Auto. Multimedia Display & Navigation Sys.*, Inv. No. 337-TA-657, Initial Determination at 110-112 (Oct. 27, 2009) (relying on the Fukui Declaration (RX-100C) from a third-party witness in Japan to establish that a vehicle qualified as prior art).

to testify about the MARC system generally and how it works. ID at 116. Dr. Ellett did just that. (RX-0454.3-5, Q&A 13-17.) Indeed, during the hearing, the ALJ acknowledged that Dr. Ellett testified as a fact witness. Tr. at 1341 (“Right now, it appears to me that he has particular expertise but was a fact witness as to the MARC system and what [it] did.”) Second, although the ALJ invited TPL to move to strike Dr. Ellett’s testimony and to brief any objections, TPL declined to do so and, thereby, waived its objections. Tr. at 1340-1341. Dr. Ellett’s testimony was not challenged by TPL, is reliable and should have been given weight.

Furthermore, the ALJ notes that testimony regarding the procedures in place at the National Chiao-Tung University library is relevant and material to establishing public availability of the AwYong Thesis. ID at 118. Accordingly, the markings on AwYong, the MARC record, and the “Thesis Publication Certification” provided clear and convincing evidence that AwYong is a printed publication under section 102(b). Dr. Ellett’s testimony corroborated this evidence by explaining how the MARC system works and how the MARC records reflect publication dates. TPL did not rebut this evidence. Thus, the ALJ erred in finding that Respondents had not established by clear and convincing evidence that AwYong was prior art publicly available on December 22, 2000.

**2. The Asserted Claims of the ‘549 Patent Are Invalid under AwYong.**

The ALJ did not address the disclosure of AwYong or the testimony of Dr. Bannerjee (RX-0420C, RX-2884C), which establishes that the asserted claims of the ‘549 Patent are rendered obvious by AwYong. In its Reply Brief, TPL distinguished AwYong on only two bases: 1) AwYong does not disclose a controller chip that determines or detects whether a card has its own controller for error correction, and 2) AwYong does not disclose a controller chip to perform error correction, including bad block mapping. (CRB, p. 83 (distinctions offered generally against all prior art references.) TPL is correct on the first issue – indeed, the ALJ held

Respondents' products do not infringe the '549 Patent for the very same reason – but wrong on the second issue.

Although AwYong discloses a controller (labeled “USB/MP3 Controller” in **Figure 5** below), that controller does not determine expressly whether a newly-presented card has a controller or not; instead, AwYong's controller identifies a type of card that is presented and engages protocols that are specific to that card's type. In this regard, the AwYong system operates identically to Respondents' products. Thus, if the Commission reverses the ALJ's holding that Respondents' products do not infringe the '549 Patent, it also should hold that the asserted claims are invalid over AwYong.<sup>28</sup>

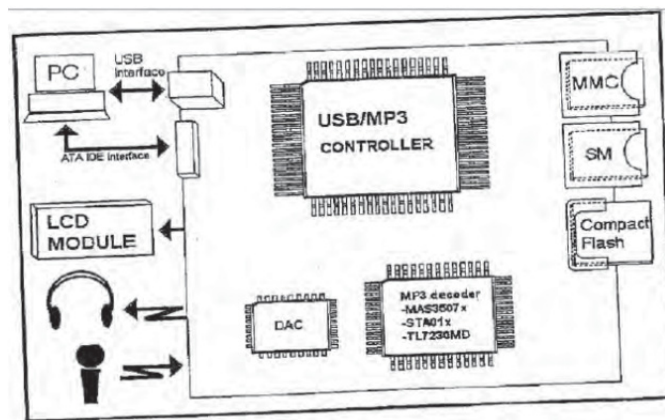


Figure 2-1 Block Diagram of USB/MP3 Controller Application System

**Figure 5: AwYong, FIG. 2-1 (RX-0456.20)**

Nevertheless, AwYong renders the determining/detector limitations obvious. AwYong describes compatibility with multiple types of flash storage systems, including SmartMedia (which does not have a controller) and CompactFlash and MMC (which do have controllers). (RX-0456.14, 17, 23, 48-49, Figs. 2-2, 5-3, 5-4, 5-5 (RX-0456); RX-0420C, Q/A 135.) A person of ordinary skill in the art at the time of the alleged invention would have known to implement

<sup>28</sup> The ALJ properly rejected TPL's conclusory doctrine of equivalents argument as having been waived. (See ID at 77 (“As for TPL's doctrine of equivalent arguments, the ALJ finds that they are waived. These arguments were not presented in TPL's expert's direct witness statement or in its pre-hearing brief. See Ground Rule 8. Thus, the ALJ declines to find that this claim element is met by the doctrine of equivalents.”).)

the determining step and detector element to accommodate other types of flash storage cards including those that have common form factors but vary in whether they include controllers or not. For example, U.S. Patent No. 6,199,122 discusses a detector for such applications (RX-0727 at 12:66-13:8, 13:37-50, Figs. 11, 12), and its combination with AwYong would have been obvious to a person of ordinary skill in the art. (RX-0420C, Q/A 137-38, 163-64.)

On the second issue, however, TPL is wrong. AwYong's controller uses firmware to perform error correction and bad block mapping for SmartMedia cards (controllerless cards) but not for MMC or CompactFlash cards (cards with controllers). (RX-0456.23, Fig. 2-2; RX-0420C, Q/A 140-42.) AwYong states that, because SmartMedia cards have no processor, the "single-chip controller must be capable of ... managing the memories inside SmartMedia storage cards." (RX-0456.0017). Therefore, AwYong's controller chip includes an SM\_ECC module, shown in Figure 5-4 (RDX-0008), which handles error correction for the SmartMedia card. (RX-0456.63, 65, 66, Fig. 5-4; RX-0420C, Q/A 140-142.) AwYong also describes this ECC (error correcting code) module. (RX-0456.63; RX-0420C, Q/A 141.) However, the interface modules for CompactFlash and MMC cards do not contain an ECC module, because those cards have a controller for error correction. (RX-0456.66, Fig. 5-8; RX-0420C, Q/A 142.)

AwYong also discloses bad block mapping operations performed by the controller chip for SmartMedia cards, but not for MMC or CompactFlash cards. Specifically, it describes the process by which "[b]lock Status records whether [a] block is good or damaged" and "block address mapping" for use with SmartMedia cards. (RX-0456.33-35; RX-0420C at Q/A 141.)

Finally, AwYong discloses that the controller chip utilizes firmware to perform the error correction and bad block mapping operations for SmartMedia cards. For instance, in describing the hardware design of the controller chip, AwYong describes that various functions, including

memory management, are part of the “firmware design part,” including “automatic data error detection and correction (ECC=error correcting code) ... of the Smart Media Card Interface.” (RX-0456.41; RX-0420C, Q/A 140-143.) Thus, TPL was wrong when it argued AwYong does not disclose a controller chip to perform error correction, including bad block mapping.

Accordingly, AwYong establishes that the asserted claims of the ‘549 Patent are invalid as obvious, and if the Commission reverses the ALJ’s holding of non-infringement, it also should hold that AwYong invalidates the asserted claims of the ‘549 Patent.

**B. To The Extent The Commission Disagrees With The ALJ’s Interpretation of The Claim Language, Then U.S. Patent No. 6,987,927 (“the ‘927 Patent”) Anticipates The Asserted Claims of The ‘549 Patent.**

To the extent the Commission finds that the ALJ’s interpretation of the claim language of the ‘549 patent was incorrect and instead adopts TPL’s proposed interpretation, then U.S. Patent No. 6,987,927 (“the ‘927 Patent”) would anticipate all four asserted claims and, as such, render them invalid. Though the ALJ correctly found that the ‘927 Patent is prior art under 35 U.S.C. § 102(e), the ALJ disagreed with Respondents’ assertion that the ‘927 Patent anticipates the asserted claims of the ‘549 Patent. (ID at 119.) The ALJ’s finding was based upon his rejection of TPL’s interpretation of the claims which formed the basis of TPL’s infringement allegations. Specifically, the ALJ found, for purposes of infringement, that the “determining” and “detector to determine” limitations of claims 7 and 11, respectively, require more than just merely determining the type of card inserted or a detector to determine the type of card. (*Id.* at 74-75.) Instead, the ALJ found that the claim requires “determining” of or “a detector to determine” whether a card has a controller or not. (*Id.* at 75-77.) Accordingly, he also held that the ‘927 patent was not invalidating under that interpretation. (*Id.* at 119.) Because the ALJ disagreed with TPL’s interpretation of the claim language, he found that the ‘927 Patent does not invalidate the ‘549 Patent. (*Id.* at 119.)

As Respondents' expert testified, under TPL's interpretation of the claims the '927 Patent meets the "determining whether the flash storage system includes a controller for error correction" limitation of claim 7 because it discloses that the media interface 322 includes a "card detect circuit" (396) "which is operable to sense when any" of the multiple types of flash memory cards "are plugged into the enhanced digital data collector" and which then generates a signal to the power supply to turn on power to the inserted card. (RX-0732, 16:12-17, Figs. 8-9; RDX-0012; RDX-0013; RX-0420C, Q/A 371-72.) The processor (320) is capable of determining, based upon the detection by the card detect circuit, the type of flash memory card inserted. (RX-0732, 16:4-23, Figs. 8-9; RDX-0012; RDX-0013; RX-0420C, Q/A 371-72.) The '927 Patent describes compatibility with multiple types of flash storage systems—including SmartMedia cards (which do not have a controller) and CompactFlash, MMC, Memory Stick, and SD cards (which have a controller). (RX-0732, 14:24-31, 15:66-16:11, Figs. 8-9; RDX-0012; RDX-0013; RX-0420C, Q/A 372.) Thus, to the extent the Commission agrees with TPL's interpretation of the claim language that the claim only requires the controller chip to determine the type of card inserted—a contention the ALJ rejected—then the '927 Patent discloses this limitation as well. (RX-0420C, Q/A 371-72.)

Respondents' expert also confirmed that the '927 Patent discloses "a detector to determine whether the flash storage system includes a controller for error correction" as required by claim 11. For the same reasons discussed above regarding the "determining" limitation of claim 7, the '927 Patent discloses this limitation of claim 11. (*See* RX-0732, 14:24-31, 14:43-47, 15:66-16:11, 16:12-17, 16:4-23, Figs. 8-9; RDX-0012; RDX-0013; RX-0420C, Q/A 398.)

Moreover, the '927 Patent renders the determining/detector limitations obvious. The '927 Patent describes compatibility with multiple types of flash storage systems—including

SmartMedia cards (which do not have a controller) and CompactFlash, MMC, Memory Stick, and SD cards (which have a controller). (RX-0732, 14:24-31, 15:66-16:11, Figs. 8-9; RDX-0012; RDX-0013; RX-0420C, Q/A 372.) A person of ordinary skill in the art at the time of the alleged invention would have known to implement the determining step and detector element to accommodate other types of flash storage cards, including those that have common form factors but vary in whether they include controllers or not. For example, U.S. Patent No. 6,199,122 discusses a detector for such applications (RX-0727 at 12:66-13:8, 13:37-50, Figs. 11, 12), and its combination with the '927 Patent would have been obvious to a person of ordinary skill in the art. (RX-0420C, Q/A 373-75, 399-401.)

The ALJ did not dispute that the '927 Patent discloses all of the other limitations of the asserted claims of the '549 Patent. If TPL's claim interpretation of the "determining" and "detector to determine" limitations is adopted,<sup>29</sup> then the unrebutted record evidence demonstrates that the '927 Patent discloses all of the elements of claims 7, 11, 19, and 21 of the '549 Patent and, as such, anticipates all of those claims. (RX-0732 at 14:21-31, 14:43-47, 14:51-57, 15:66-16:23, 16:44-49; 16:54-58, 18:1-3, 19:13-19, Figs. 8-9, 11; RX-0701.0028; RX-0399.0061, Table 28; RX-2400.0050-0063; RX-0763C.0152-53; RX-2370.0015; RX-0702.0030; RX-0703.0024; RX-0711.14; RDX-0012; RDX-0013; RDX-0014; RX-0420C, Q/A 92-100, 358-415; CX-0944C, Q/A 1607.)

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<sup>29</sup> The ALJ properly rejected TPL's conclusory doctrine of equivalents argument as having been waived. (See ID at 77 ("As for TPL's doctrine of equivalent arguments, the ALJ finds that they are waived. These arguments were not presented in TPL's expert's direct witness statement or in its pre-hearing brief. See Ground Rule 8. Thus, the ALJ declines to find that this claim element is met by the doctrine of equivalents."))



**VI. ADDITIONAL BASES OF NON-INFRINGEMENT OF THE ACTIVE ADAPTER PATENTS NOT ADDRESSED IN THE ID**

**A. If The Commission Decides to Review Non-Infringement, It Also Should Review Certain Claim Limitations of The Active Adapter Patents Not Addressed in The ID.**

The ALJ correctly found that there is no violation with respect to any of the asserted claims of the '443, '424 or '847 Patents (collectively “the Active Adapter Patents”). In particular, the ALJ found no violation on the ground that Respondents’ accused products do not perform “mapping” as claimed in the Active Adapter Patents. (ID at 37-49.) This finding was correct, and the Commission should decline to review that aspect of the ID if TPL petitions for review.

Nevertheless, in the event that the Commission decides to review the determination of non-infringement of the Active Adapter Patents on the basis of the “mapping” limitation, there are alternative grounds for finding no violation that the Commission should also review. Specifically, at least the following additional grounds support a finding of non-infringement of the Active Adapter Patents:

- Respondents’ accused products do not have contact pins separate and distinct from interconnection means/pins, as required by the asserted claims of the '424 and '847 Patents;
- Respondents’ accused products do not have contact pins mounted on a housing surface at locations adapted to interface with different types of cards, as required by the asserted claims of the '424 and '847 Patents; and
- Respondents’ accused products do not have contact pins integrated within or that protrude from molded plastic of the adapter, as required by the asserted claims of the '443 Patent.

The ALJ made no determination in the ID regarding any of these issues, presumably because the finding of non-infringement on the “mapping” limitation disposed of all of TPL’s infringement claims. Respondents respectfully submit that these additional issues constitute alternative

grounds on which to base a finding of non-infringement, and that the Commission should address each in the event it determines to review the ALJ's ruling of non-infringement.

**1. TPL Did Not Prove That Respondents' Accused Products Have Contact Pins Separate And Distinct From Interconnection Means/Pins.**

The asserted claims of the '424 and '847 Patents all require an "interconnection means/pins" and "contact pins." The ALJ held during claim construction that interconnection means/pins are "separate and distinct structures" from contact pins. (Order 23 at 20-21.) The ALJ confirmed in the ID that these structures must be "distinct things," otherwise the claim language would be rendered "superfluous," but he did not determine whether Respondents' accused products meet that limitation. (ID at 43.) Respondents submit that the ALJ also should have found no violation based on non-infringement because TPL failed to identify separate and distinct structures in the accused products that correspond to the claimed "interconnection pins/means" and "contact pins." (*See* Resp. PostHB, 53-56; Resp. PostHRB, 9-12; RX-2889C, Q/A 177-84, 192-97, 268-72, 333-37, 389-94 (HP); 1041-46, 1096-98 (Kingston); CX-0555C; CX-0621C.0021 (Newegg/Rosewill); RX-2889C, Q/A 700-16, 740-46 (Canon); RX-2889C, Q/A 441, 446, 469-71, 475-77, 479-81, 502, 518, 523, 546-48, 552-54, 556-58, 579 (Acer); RX-2889C, Q/A 984-85, 993-96, 1014-27; RX-3481C, Q/A 8-9, 29-36, 41-43; RX-3272 (HiTi); RX-2889C, Q/A 1122-26, 1136-44 (Seiko Epson).)

Unable to point to the "separate and distinct" structures required by the claim language and the ALJ's construction, TPL argued that unitary metal terminals, such as those shown in Figure 6 and Figure 7 below, constitute both the "contact pins" and "interconnection means/pins" of the asserted claims. (Mroczkowski, Tr. 986:12-21.) TPL asserted that "the contact pin and interconnection pin *may come from a unitary piece*," but nevertheless argued that this "does not

preclude the interconnection pins / means from being conductive pins / structures separate from the contact pins.” (TPL PostHB, 130 (emphasis added)).

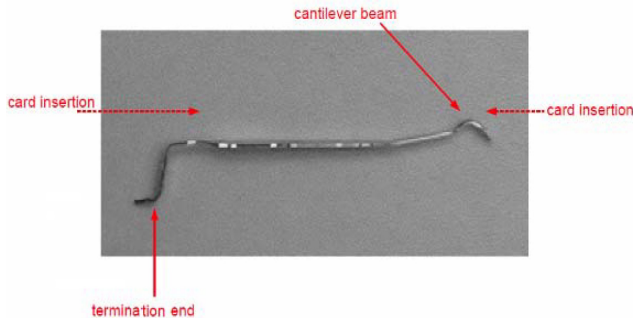


Figure 6: Unitary Terminal from an Exemplary Product (RDX-0501)

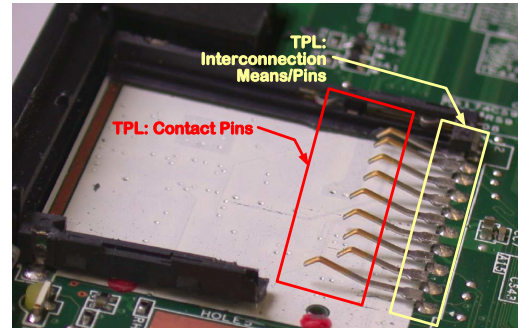


Figure 7: Unitary Terminals in HP 630 Consumer Notebook (RPX-0084)

TPL presented no evidence (nor could it) supporting its irrational argument that a *unitary, single* piece of metal in Respondents’ accused products satisfies the “separate and distinct” requirement of the asserted claims of the ’424 and ’847 Patents. The fact that the purported contact pins and interconnection pins/means are formed from a unitary piece of metal precludes these structures from being separate and distinct from one another, as required by the claim language and the ALJ’s claim construction. (See Resp. PostHB, 54-56; Resp. PostHRB, 9-10; Mroczkowski, Tr. 986:22-987:13.) Neither the alleged function of each end of that unitary piece of metal, nor any coatings applied thereto can alter the fact that it is a single structure. (See Resp. PostHB, 56; Resp. PostHRB, 10-11; Mroczkowski, Tr. 986:22-987:13.)

Accordingly, TPL has not shown that any of Respondents’ accused products include “interconnection means/pins” that are conductive structures separate and distinct from “contact pins,” either literally or under the doctrine of equivalents.<sup>30</sup> In the event the Commission decides

<sup>30</sup> The Commission should reject TPL’s conclusory doctrine of equivalents argument for the additional reason that it has been waived. TPL’s purported support consists of a single conclusory statement by its expert Mr. Buscaino that all of Respondents’ accused products infringe all of the asserted claims under the doctrine of equivalents. (See CX-0944C, Q/A 38.) That is insufficient to preserve the

to review non-infringement, this provides an alternative ground for finding no violation on the basis that Respondents' accused products do not infringe claims 25, 26, 28, or 29 of the '424 Patent or claims 1-3 of the '847 Patent.

**2. TPL Did Not Prove That Respondents' Accused Products Have Contact Pins Mounted on a Housing Surface at Locations Adapted to Interface With Different Types of Cards.**

The asserted claims of both the '424 and '847 Patents require that the contact pins be mounted on a surface of the housing at locations adapted to interface with different types of memory cards. The ALJ construed this limitation to mean "contact pins mounted on said surface arranged to provide electrical connection with" different types of cards. (Order 23 at 12.) Respondents maintained that their accused products do not meet this limitation. The ALJ did not address that argument in the ID. Respondents submit that that ALJ also should have found no violation based on non-infringement because TPL failed to prove that Respondents' accused products meet this limitation. (*See* Resp. PostHB, 57-59; Resp. PostHRB, 12-16; RX-2889C, Q/A 177-84, 192-97, 203-07, 254-58, 319-23, 374-79 (HP); 1081-83 (Kingston); CX-0555C; CX-0621C.0021 (Newegg/Rosewill); RX-2889C, Q/A 443-45, 64-68, 488-92, 502, 520-22, 541-45, 565-69, 579 (Acer); RX-2889C, Q/A 700-16, 736-39, 747-51 (Canon); RX-2889C, Q/A 1122-26 (Seiko Epson); RX-2889C, Q/A 1010-13, 984-92 (HiTi).)

Respondents' accused products do not have contact pins mounted on a housing surface at locations adapted to interface with different types of cards. Instead, the terminals within Respondents' accused products are mounted to a printed circuit board (PCB), not a surface of the adapter housing, as required by the plain language of the claims. (*See* Resp. PostHB, 58;

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argument under Ground Rule 8.1(f). (*See* ID at 77 ("As for TPL's doctrine of equivalent arguments, the ALJ finds that they are waived."))

Mroczkowski, Tr. 969:23-970:12, 989:14-19.) TPL argued that Respondents’ accused products satisfy this limitation because a portion of the terminal comes into contact with or passes through the plastic in the socket housing. TPL is wrong. (See Resp. PostHB, 57-58.) At no point do the terminals attach to the housing in a way that could be considered “mounting.” (See Resp. PostHRB, 13.) “Mounted on” requires more than mere contact with a supporting structure, as occurs in Respondents’ accused products. (See Resp. PostHRB, 14.) Indeed, when the plastic housing is removed, the terminals remain mounted to the PCB. (Buscaino, Tr. 458:12-459:3; RPX-0122A; RPX-0084.)

Moreover, TPL presented no evidence that the terminals’ mounting locations are “adapted to interface with the electrical contacts of ... different types of memory media cards.” If anything, the *geometry* of the terminals themselves is adapted to allow for contact with different memory cards, not the *locations* at which the terminals are mounted. (See Resp. PostHB, 58; Buscaino, Tr. at 970:4-12.) FIG. 3 of the Active Adapter Patents depicts contact pins 315 mounted to surfaces of the housing directly underneath or above the contacts of an inserted memory card. In that figure, the mounting *locations* themselves have more to do with interfacing with an inserted card than the pin *geometry* itself.

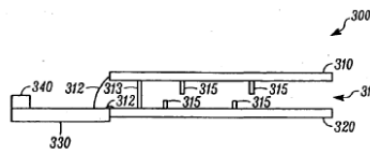


FIG. 3

Figure 8 – FIG. 3 of the ’443 Patent (JX-0003.0006)

In Respondents’ accused products, the reverse is true. As shown below, Respondents’ accused products look similar to the admitted prior art in FIG. 2 of the patents, rather than the invention shown in FIG. 3.

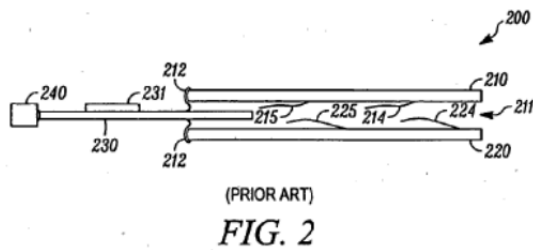


Figure 9 – FIG. 2 of the '443 Patent (JX-0003.0005)  
5in1 Card

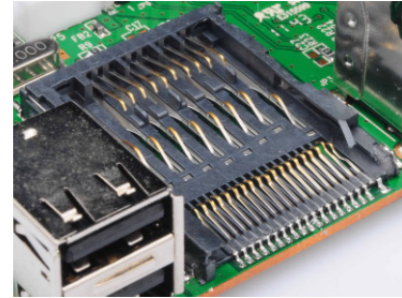


Figure 10 - Connector in Acer  
Reader (CX-0464C)

TPL did not meet its burden to show that Respondents' accused products have contact pins mounted on a surface of the housing at locations adapted to interface with different types of memory cards, either literally or under the doctrine of equivalents.<sup>31</sup> In the event the Commission decides to review non-infringement, this provides an alternative ground for finding no violation on the basis that TPL has not demonstrated infringement of claims 25, 26, 28, and 29 of the '424 Patent and claims 1 – 3 of the '847 Patent.

**3. TPL Did Not Prove That Respondents' Accused Products Have Contact Pins Integrated Within or That Protrude from Molded Plastic of an Adapter.**

Claims 1 and 9 of the '443 Patent each require contact pins that are “integrated within” and that “protrud[e] from” molded plastic of an adapter. The ALJ construed “integrated within” as “embedded within” (Order 23 at 22), but made no determination regarding these limitations in the ID. Respondents submit that the ALJ also should have found no violation based on non-infringement because TPL failed to demonstrate that Respondents' accused products meet these

<sup>31</sup> The Commission should reject TPL's conclusory doctrine of equivalents argument for the additional reason that it has been waived. TPL's purported support consists of a single conclusory statement by its expert Mr. Buscaino that all of Respondents' accused products infringe all of the asserted claims under the doctrine of equivalents. (See CX-0944C, Q/A 38.) That is insufficient to preserve the argument under Ground Rule 8.1(f). (See ID at 77 (“As for TPL's doctrine of equivalent arguments, the ALJ finds that they are waived.”).)

limitations. (*See* Resp. PostHB, 60-62; Resp. PostHRB, 16-19; RX-2889C, Q/A 116-162, 163-175, 217-219, 220-243, 244-252, 279-283, 284-310, 311-317, 342-344, 345-364, 365-373, 401-405, 598-642, 643-653, 679, 709-711, 730-734 (HP); 1041-46, 1068-74, 1077 (Kingston); RX-2889C, Q/A 700-16, 730-35 (Canon); RX-0944C, Q/A 1420-22; CX-0555C; CX-0556C; CX-0621C.0021 (Newegg/Rosewill); RX-2889C, Q/A 1122-32 (Seiko Epson); RX-2889C, Q/A 443-45, 453-63, 502, 530-39, 579 (Acer); RX-2889C, Q/A 984-97, 1004-07 (HiTi).)

Respondents' accused products do not have contact pins that protrude either from "upper surfaces" or "lower surfaces" of an adapter (as required by claim 1), or from "upper portions" or "lower portions" of an adapter (as required by claim 9). (*See, e.g.*, Resp. PostHB, 61; RX-2889C, Q/A 700-16, 730-35 (Canon).) Instead, Respondents' accused products have terminals that extend through the back or front surfaces of card reader sockets. (*See* Resp. PostHB, 61; Mroczkowski, Tr. 960:8-23, 965:6-18, 989:20-990:5.)

Moreover, Respondents' accused products do not have contact pins that are "integrated within molded plastic," as required by the asserted claims of the '443 Patent. To satisfy this limitation, the ALJ's construction requires contact pins to be "embedded" into plastic. (Order 23 at 22-23.) But the ends of the terminals in Respondents' accused products are soldered to a PCB and extend through the rear of the socket housing. (*See* Resp. PostHB, 61-62; Mroczkowski, Tr. 960:8-23.) TPL's unsupported argument that the contact pins are embedded within the molded plastic "[a]s long as the contact pins are integrated such that they are limited in movement by the molded plastic" (TPL PostHB, 103) impermissibly rewrites the ALJ's construction. (*See* Resp. PostHRB, 18.)

TPL has not met its burden to show that Respondents' accused products have contact pins that are "integrated within" or that "protrud[e] from" molded plastic of an adapter, either literally

or under the doctrine of equivalents.<sup>32</sup> In the event the Commission decides to review non-infringement, this provides an alternative ground for finding no violation on the basis that TPL has not demonstrated infringement of claims 1 and 9 of the '443 Patent.

## VII. CONCLUSION

For each of the reasons set forth above in Sections II & III of this petition, it is clear that the ALJ's finding of a violation in regards to the '623 patent was clear legal and factual error. Accordingly, the ALJ's finding of infringement should be reversed, or to the extent that the ALJ's finding of infringement is maintained, the claims of the '623 patent should be found invalid. In either case, the ALJ's determination of domestic industry should be reversed and no violation should be found.

Further, to the extent that the Commission decides to overrule the ALJ's finding of non-infringement of the '443, '424, '847, and '549 patents, the Commission should still find no violation because Complainant lacks a domestic industry in each of these patents and because the claims of each of these patents were clearly and convincingly shown to be invalid. Moreover, with respect to the '443, '424, and '847 patents, the ALJ did not consider in the ID multiple additional grounds of non-infringement – each of which further demonstrates that the Respondents' products do not infringe the '443, '424, and '847 patents.

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<sup>32</sup> The Commission should reject TPL's conclusory doctrine of equivalents argument for the additional reason that it has been waived. TPL's purported support consists of a single conclusory statement by its expert Mr. Buscaino that all of Respondents' accused products infringe all of the asserted claims under the doctrine of equivalents. (See CX-0944C, Q/A 38.) That is insufficient to preserve the argument under Ground Rule 8.1(f). (See ID at 77 ("As for TPL's doctrine of equivalent arguments, the ALJ finds that they are waived.")) Moreover, TPL is barred from arguing equivalents by the doctrine of prosecution history estoppel. (See Resp. PostHRB, 19, citing *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 727 (2002).)



PUBLIC VERSION OF A CONFIDENTIAL DOCUMENT

Dated: August 22, 2013

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**CERTIFICATE OF SERVICE**

I, David M. Hoffman, an attorney, certify that I caused copies of the foregoing document to be served on the parties in the manner and on the date set forth below:

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