

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMKOR TECHNOLOGY, INC.
Petitioner

v.

TESSERA, INC.
Patent Owner

Case IPR2013-00242
Patent 6,046,076

Before KEVIN F. TURNER, JUSTIN T. ARBES, and
CARL M. DeFRANCO, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

DECISION
Request for Rehearing
37 C.F.R. § 42.71

INTRODUCTION

Amkor Technology, Inc. (“Amkor”), the petitioner, filed a Request for Reconsideration (Paper 45, “Req.”) of the Decision on Institution (Paper 37, “Dec.”), which instituted *inter partes* review of claims 1-8, 10-13, 18, 19, 24, and 25 of Patent 6,046,076 (“the ’076 patent”). In its request, Amkor argues essentially that the Board erred in determining that certain grounds of unpatentability, asserted in Amkor’s Petition (Paper 1, “Pet.”), are cumulative over the instituted grounds. Req. 1; Dec. 32-33. Specifically, Amkor requests reconsideration of the Board’s decision to not institute *inter partes* review based on the asserted grounds relying on Nakano¹ (“grounds A-I”). The request for reconsideration is *denied*.

ANALYSIS

When reconsidering a decision on institution, the Board will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may be determined if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315-16 (Fed. Cir. 2000).

¹ Japanese published patent application JP S63-241955, published October 7, 1988, submitted as Exhibit 1001.

Amkor begins by citing to the M.P.E.P.'s (Manual of Patent Examination Procedure) definition of cumulative references and argues that "Nakano is neither cumulative nor redundant." Req. 2. First, we note that the Board is not bound necessarily by the strictures proscribed by the M.P.E.P. Second, the Decision discussed that the *grounds* of unpatentability proffered were cumulative to the instituted grounds. Dec. 33. The Decision did not address the cumulative nature of the teachings of Nakano, but rather the cumulative nature of the grounds. Lastly, as indicated in the Decision: "even if each reference cited is distinctive, instituting a trial on each ground proffered would not result in a 'just, speedy and inexpensive resolution of every proceeding,' 37 C.F.R. § 42.1(b), with a final determination being made generally no later than one year after institution." Dec. 33. As such, even if we agreed with Amkor that the differences between the teachings of Nakano and Oldham are significant, Req. 3-4, that would not mean necessarily that instituting on additional grounds would be warranted to provide a just, speedy and inexpensive resolution of this proceeding.

Additionally, based on the Decision's claim construction of "microelectronic assembly," Dec. 17-18, Nakano's disclosure of a "flip-chip device," Req. 4, does not distinguish over the assembly discussed in Oldham. Dec. 20. While Amkor is correct that Tessera's main argument attempting to overcome Oldham in its preliminary response was that Oldham does not teach a microelectronic assembly, Req. 5-6, the Decision fully addressed that argument, where we determined, based on the record presented, that the argument was not persuasive. Dec. 20. We are not persuaded that we have misapprehended or overlooked any aspect of Tessera's

argument, or that instituting on additional grounds would be warranted under the circumstances.

Amkor also argues that adopting the non-instituted, Nakano grounds would not jeopardize the Board's ability to provide a speedy and inexpensive trial because Nakano is already being considered with respect to another, instituted ground (i.e., claim 19 as unpatentable under 35 U.S.C. § 103 over Oldham and Nakano). Req. 6. However, familiarity with the teachings of a reference does not posit that an additional ground based on that reference would not tax the proceeding further. Such logic would require the Board to consider multiple grounds, based on multiple combinations of references, in every instance where multiple references were cited, which would slow and increase the cost of each trial instituted. We are not persuaded that such a result is warranted in this proceeding.

Lastly, Amkor argues that the Decision on Institution was not “‘just’ to Amkor.” Req. 7. Amkor argues because of estoppel, not instituting on all of its proffered grounds would not “ensure that Amkor has a full, fair, and just hearing on its unpatentability issues.” Req. 8. Given the competing demands for speedy and inexpensive resolution and providing dispositive determinations of the patentability of claims, we are not persuaded that any injustice has been done to Amkor in instituting on the specified grounds. Dec. 34.

For the foregoing reasons, Amkor has not shown that the Board abused its discretion in instituting the instant *inter partes* review on the grounds of unpatentability specified.

ORDER

Accordingly, it is

ORDERED that Amkor's request for reconsideration is *denied*.

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