



PTAB Finds That Petitioner Failed to Prove Anticipation of Claims from Patents Covering Self-Testing Memory Modules

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In its institution decision, the PTAB construed the term “generate” to mean “produce or cause.” In its response, the patent owner argued that the term should be construed as only “produce” and that a construction including “cause” is inconsistent with the intrinsic and extrinsic evidence. In its reply, Petitioner disagreed and argued that the PTAB was correct in its institution decision. In its final written decision, the PTAB determined that, consistent with its construction of these same terms in the previous IPRs, the broadest reasonable construction of “generate” was “produce.” Petitioner’s evidence here did not convince the panel otherwise. Accordingly, the PTAB changed the construction it had used in the institution decision and construed “generate” to mean “produce.” Under this construction, the PTAB found that Petitioner failed to show that the cited reference included every claim element, and, accordingly, Petitioner had failed to prove the claims anticipated. This may be a case where the difference between the ‘broadest reasonable interpretation’ standard, currently applied by the PTAB, and the *Phillips* standard for claim construction applied by the district courts could have a material impact on the ultimate outcome.

Smart Modular Techs. Inc. v. Netlist, Inc., IPR2014-01372; IPR2014-01374 (PTAB Mar. 9, 2016).
[Gaudette (opinion), Moore, Chen]

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