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Federal Circuit Patent Bulletin: *In re Rambus, Inc.*

June 5, 2014

"[If] a reexamination involves claims of an expired patent, a patentee is unable to make claim amendments and the PTO applies the [Phillips] claim construction principles."

On June 4, in *In re Rambus, Inc.*, the U.S. Court of Appeals for the Federal Circuit (Rader, Moore, Reyna*) reversed the Patent Trial and Appeal Board's inter partes reexamination decision that U.S. Patent No. 6,426,916, which related to a method and system for improving the efficiency of computer memory, was anticipated by U.S. Patent No.4,734,909 (Bennett). The Federal Circuit stated:

The parties disputed before the PTO whether Bennett discloses "a value that is representative of an amount of time to transpire after which the memory device outputs the first amount of data." The examiner found this limitation lacking in Bennett. The Board disagreed and found that "Parameter VI" in Bennett discloses the claimed "value." Because the Board's conclusion is not supported by substantial evidence, we reverse.

Claims are generally given their "broadest reasonable interpretation" consistent with the specification during reexamination. This claim construction standard is justified, at least in part, because a patentee is able to amend its claims during reexamination. If, as is the case here, a reexamination involves claims of an expired patent, a patentee is unable to make claim amendments and the PTO applies the claim construction principles outlined by this court in Phillips v.

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AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005). . . .

A patent is anticipated "if a single prior art reference discloses each and every limitation of the claimed invention." . . . The Board relied on Figs. 25a and 25b in Bennett, and the related "Parameter VI." These figures are schematic representations of operations occurring on a memory bus. Parameter VI is the internal parameter in Bennett that determines whether the data and wait lines in these figures are dedicated or multiplexed. . . .

In Figs. 25a and b of Bennett, Parameter VI is only "representative" of one source of delay because the actual delay can be longer due to other factors. Switching this parameter from 1 to 3 does not necessarily create a one clock cycle delay before data is transferred due to further potential delay that may result from arbitration. As such, Parameter VI is not a "value that is representative of an amount of time to transpire after which the memory device outputs the first amount of data." As Rambus points out, arbitration may take an indeterminate amount of time because a memory device may "lose" arbitration on successive occasions. If arbitration in Fig. 25b happens to take longer than in Fig 25a, the memory system with multiplexed lines (Fig. 25a) may actually have less delay before data transfer. Similarly, a busy memory device with dedicated lines may have a longer delay, due to wait signals, than an available device with multiplexed lines. Because of these two additional, indefinite, sources of delay, changing Parameter VI from 1 to 3 will not produce a set amount of time after which data is transferred. Therefore, Parameter VI is not "representative" of an amount of time after which data is transferred. . . . Accordingly, we reverse the Board's decision that Bennett anticipates claims 26 and 28 of the '916 patent.