

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MENTOR GRAPHICS CORPORATION,
Petitioner,

v.

SYNOPSIS, INC.,
Patent Owner

Case IPR2014-00287
Patent 6,836,420 B1

Before JENNIFER S. BISK, SCOTT A. DANIELS, and
PHILIP J. HOFFMANN, *Administrative Patent Judges*.

DANIELS, *Administrative Patent Judge*.

ORDER
Petitioner's Motion to Submit Supplemental Information
37 C.F.R. § 42.123

At the initial conference call on July 8, 2014, the Board granted Mentor's request to file the present Motion to Submit Supplemental Information under 37 C.F.R. § 42.123(a), and authorized Synopsys to file an opposition to such a motion. Paper 13. Mentor filed their Motion on July 11, 2014. Paper 14. Synopsys filed their Opposition on July 18, 2014. Paper 15.

In the Motion, Mentor sought to file excerpts from Synopsys's infringement contentions served on Mentor in the underlying district court litigation, *Synopsys, Inc. v. Mentor Graphics Corporation*, Case No. 3:12-cv-06467-MMC (N.D. Cal.), ("the district court litigation") involving the same patent, U.S. Pat. No. 6,836,420 B1 ("the '420 patent"). Mentor argued that Synopsys's preliminary infringement contentions read certain claims of the '420 patent onto specific products, thus reflecting Synopsys's assessment of claim scope. Paper 14. According to Mentor, Synopsys asserted in the district court litigation for example "that a memory with a '[r]eset that clear [sic] the output registers on read ports of the memory' is a type of resettable memory," and that such preliminary infringement contentions are relevant to the broadest reasonable interpretation standard applied by the Board. *Id.* Synopsys contends in the Opposition that because Synopsys served Mentor with preliminary infringement contentions on April 12, 2013, Mentor "knew of—but did not submit—Synopsys's preliminary contentions with its petition." Paper 15. Synopsys further disputed that the preliminary infringement contentions are relevant to any claim on which the Board has instituted this inter partes review because the preliminary infringement contentions have been superceded by final infringement contentions, as well as the District Court's Claim Construction Order. *Id.*

We are not persuaded that Mentor has shown that the preliminary infringement contentions, or excerpts therefrom, are relevant to any claims for which we instituted this trial. The only relevance the preliminary infringement contentions have is the alleged inconsistency with arguments made by Synopsys in its Patent Owner's Preliminary Response. While potentially inconsistent, the preliminary infringement contentions were served prior to any substantive discovery in the district court litigation and subsequently supplanted by final infringement contentions, as well as the District Court's Order Construing Claims (Ex. 1016), which has been submitted in this case. It is not uncommon for a patent owner to change their scope of claim interpretation during district court litigation, or take one position on claim scope before the Patent Office, because the Board applies the broadest reasonable construction, which may not be the same standard adopted by the district court. 37 C.F.R. § 42.100(b). Although a district court's construction may be informative, on this record, the preliminary infringement contentions are too tenuous to be relevant to the Board's application of the broadest reasonable construction standard.

We note that Mentor may bring these preliminary infringement contentions to our attention in its Reply, provided the evidence is responsive to an argument made by Patent Owner. *See* 37 C.F.R. § 42.23(b) (a reply "may only respond to arguments raised in the corresponding . . . patent owner response"); Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions; Final Rule, 77 Fed. Reg. 48,612, 48,620 (Aug. 14, 2012) ("Oppositions and replies may rely upon appropriate evidence to support the positions asserted. Reply evidence, however, must be responsive and not

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merely new evidence that could have been presented earlier to support the movant's motion.”).

In consideration of the foregoing, it is hereby:

ORDERED that Mentor's Motion to Submit Supplemental Information is DENIED.

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