

American Megatrends, Mico-Star Intl, MSI Computer Corp., Giga-Byte Tech, G.B.T.v. Kinglite Holdings: Decision Denying Institution IPR2015-01189

Article By:

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Takeaway: If an application is a continuation of an abandoned application, but is not filed until after the abandoned application went abandoned and there is no incorporation by reference of the abandoned application into the continuation, then the continuation is not entitled to the abandoned application's priority date.

In its [Decision](#), the Board found that there was not a reasonable likelihood that Petitioner would prevail with respect to any of the challenged claims (1-28) of the '013 Patent. Therefore, the Board denied institution of *inter partes* review. The '013 Patent describes chipset (platform)-independent methods for compressing and decompressing system ROM code of a computer.

All of Petitioner's challenges relied upon Kikinis CIP. Petitioner contends that although the '574 Application resulting in the issuance of the Kikinis CIP was filed after the critical date (August 11, 1994) of the '013 Patent, the effective date of the Kikinis CIP reaches back before the critical date through a priority claim to the '592 Application, which was filed on February 19, 1993. Patent Owner contended that the Kikinis CIP is not prior art against the challenged claims because the '592 Application went abandoned on June 18, 1997 before the filing of the '574 Application, and there is no incorporation by reference into the '574 Application.

The Board did not find an explicit incorporation by reference, and also noted that because the '592 Application went abandoned prior to the filing of the '574 Application, there is no direct continuity. The Board noted that the Related U.S. Application Data lists the '567 Application, which could provide continuity, however, no evidence was presented regarding the subject matter of the '567 Application. Therefore, the Board found that Petitioner had not established that Kikinis CIP is prior art.

American Megatrends, Inc., Mico-Star International Co., Ltd., MSI Computer Corp., Giga-Byte Technology Co., Ltd., and G.B.T., Inc. v. Kinglite Holdings, Inc., IPR2015-01189

Paper 15: Decision Denying Institution of *Inter Partes* Review Dated: November 20, 2015
Patent 5,836,013

Before: Phillip J. Kauffman, Glenn J. Perry, Trevor M. Jefferson, and Brian J. McNamara

Written by: Perry

Related Matters: *Kinglite Holdings Inc. v. Micro-Star Int'l Co. Ltd.* CV 14-03009 JVS (PJWx) (D.D. Cal.); IPR2015-01079; IPR2015-01081; IPR2015-01132; IPR2015-01133; IPR2015-01140; IPR2015-01141; IPR2015-01189; IPR2015-01191; IPR2015-01197

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