

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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OPENSKY INDUSTRIES, LLC,  
Petitioner,

v.

VLSI TECHNOLOGY LLC,  
Patent Owner.

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IPR2021-01056  
Patent 7,523,373 B2

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Before THOMAS L. GIANNETTI, BRIAN J. MCNAMARA, and  
JASON W. MELVIN, *Administrative Patent Judges*.

MELVIN, *Administrative Patent Judge*.

DECISION  
Denying Petitioner's Request on Rehearing of  
Decision Denying Institution of *Inter Partes* Review  
37 C.F.R. § 42.71(d)

## I. INTRODUCTION

OpenSky Industries, LLC (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting institution of *inter partes* review of claims 1–3, 5, 6, 9–11, and 13 (“the challenged claims”) of U.S. Patent No. 7,523,373 B2 (Ex. 1001, “the ’373 patent”). VLSI Technology LLC (“Patent Owner”) filed a Preliminary Response. Paper 9 (“Prelim. Resp.”). As authorized, Petitioner filed a Preliminary Reply (Paper 14 (“Prelim. Reply”)), and Patent Owner filed a Preliminary Sur-Reply (Paper 17).

We instituted review. Paper 18 (“Institution Decision” or “Inst.”). Petitioner filed a Request for Rehearing of our Institution Decision. Paper 19 (“Req. Reh’g.”).

## II. ANALYSIS

Petitioner argues that we abused our discretion in the Institution Decision by: (1) failing to consider “non-expert factual support” for invalidity (Req. Reh’g 5–13); (2) giving “improper effect” to certain documents from another proceeding (*id.* at 13–15); and (3) refusing to consider Petitioner’s alternatives for expert support (*id.* at 15–17). For the reasons discussed *infra*, we deny Petitioner’s request for rehearing.

### A. ALLEGED FAILURE TO CONSIDER FACTUAL SUPPORT FOR INVALIDITY

In our Institution Decision, we concluded that Petitioner relied on the testimony of an expert (Dr. Singh) that Petitioner likely cannot produce for cross-examination and would likely be excluded. Inst. 9. Under these circumstances, we determined that the Petition did not warrant institution. *Id.*

Petitioner claims that we incorrectly concluded the Petition relied on Dr. Singh’s declaration as the “sole support” to justify certain assertions. *Id.*

at 8–9 (citing Inst. 6). We do not agree that we misapprehended or overlooked any facts or arguments in reaching this decision. *See* 37 C.F.R. § 42.71(d) (A rehearing request “must specifically identify all matters the party believes the Board misapprehended or overlooked”).

As to combining Abadeer<sup>1</sup> with Harris,<sup>2</sup> the Petition asserts generally that the combination would have been obvious. Pet. 26 (citing Ex. 1002 ¶ 73). Then it explains Harris’s teaching of a “minimum operating threshold” voltage and Abadeer’s teaching for determining such a voltage. *Id.* As to the reason to combine those teachings, the Petition cites only Dr. Singh’s testimony. *Id.* (citing Ex. 1002 ¶ 74). Similarly, the Petition asserts that the combination “would have involved nothing more than combining known prior art techniques . . . according to known methods . . . to yield predictable results” and cites only to Dr. Singh’s testimony. *Id.* at 27–28 (citing Ex. 1002 ¶ 76). Thus, the Institution Decision was not incorrect in stating that “the Petition cites to Dr. Singh’s declaration in some instances as the sole support for an assertion.” Inst. 6.

#### B. ALLEGED RELIANCE ON DOCUMENTS FROM ANOTHER PROCEEDING

Petitioner argues that we abused our discretion by relying on documents from another proceeding showing that Dr. Singh has been exclusively retained by another petitioner (PQA) challenging the ’373 patent. Req. Reh’g. 13–15. Our order authorizing Petitioner to file a Preliminary Reply clearly states that “the panel requests that Petitioner respond to Patent Owner’s arguments regarding hearsay and Petitioner’s ability to make the declarants available for cross examination.” Paper 11, 3.

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<sup>1</sup> US Pub. 2006/0259840 A1, published Nov. 16, 2006 (Ex. 1004).

<sup>2</sup> US 5,867,719, issued Feb. 2, 1999 (Ex. 1003).

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That order cites the documents in question, as does Patent Owner's Preliminary Response. *Id.* at 2; Prelim. Resp. 28–29. Petitioner's Preliminary Reply addresses the issue and even cites to the record in IPR2021-01229, while never arguing that considering documents from that proceeding would be improper. Prelim. Reply 9–10. And, as Petitioner recognizes, Patent Owner filed the pertinent documents in this proceeding. Ex. 2037; Ex. 2038; *see* Req. Reh'g. 14. Thus, we conclude Petitioner was not prejudiced by us considering the documents arising in IPR2021-01229, nor was it “improper” for us to consider them, as Petitioner alleges.

Petitioner raises questions about various details of the agreements between Dr. Singh and PQA (Req. Reh'g. 14–15), but those arguments ask us to revisit our prior determinations (*see* Inst. 7). Petitioner had an opportunity during pre-institution briefing to develop evidence that Dr. Singh would testify on Petitioner's behalf. It did not do so, and we therefore concluded that the evidence of record supported denying institution. Inst. 7.

#### C. ALLEGED REFUSAL TO CONSIDER PETITIONER'S ALTERNATIVES FOR EXPERT SUPPORT

Petitioner presents two other complaints that it alleges rise to the level of abuse of discretion. *Id.* at 15–17. Petitioner argues that we abused our discretion by refusing to consider authorizing Petitioner to: (1) seek a subpoena compelling testimony from Dr. Singh (Req. Reh'g. 15–16); and (2) submit a substitute declaration (*id.* at 16–17). Petitioner is incorrect. The panel did consider those proposals from Petitioner. Inst. 8, 9 n.9. That we reached our decision not to institute does not show we abused our discretion, as those possible remedies are not available to Petitioner by right, but are within the Board's discretion. *See* 37 C.F.R. § 42.52(a) (requiring

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authorization for a party seeking to compel testimony). Moreover, as we noted in the Institution Decision, Petitioner created its own difficulty by relying on a prior declaration without securing Dr. Singh's testimony in this proceeding. Inst. 8.

Although Petitioner points out that events after filing the Petition have led to Dr. Singh's unavailability (*see* Req. Reh'g. 17), that was a risk that should have been evident to Petitioner when it filed the Petition. *See Smart Modular Techs. Inc. v. Netlist, Inc.*, IPR2014-01372, Paper 24, 4 (July 7, 2015) (declining to authorize a party to seek a subpoena where the issue was foreseeable). We do not agree that "OpenSky was justified in relying on Dr. Singh's sworn statements that he would be willing to testify." Req. Reh'g. 17. Dr. Singh's declaration does not provide an open-ended agreement subjecting himself to cross examination for any purpose, but instead recognizes that his declaration would be filed in a specific PTAB case and agrees to cross examination "in the case." Ex. 1003 ¶ 174. It was not reasonable for Petitioner to rely on that statement as indicating Dr. Singh agreed to cross examination in this proceeding.

Having considered all of Petitioner's arguments for rehearing, we conclude Petitioner has not provided a persuasive reason that our decision was an abuse of discretion.

### III. ORDER

Accordingly, it is

ORDERED that Petitioner's Request for Rehearing under 37 C.F.R. § 42.71(d)(2) is denied.

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