

Case IPR2021-01103
U.S. Reissued Patent No. 45,140

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Intel Corporation
Petitioner

v.

ACQIS LLC
Patent Owner

Case IPR2021-01103

U.S. Reissued Patent No. 45,140

PETITIONER'S REQUEST FOR REHEARING
PURSUANT TO 37 C.F.R. §42.71(d)

Mail Stop Patent Board
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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PETITIONER’S EXHIBIT LIST

Petitioner Exhibit No.	DESCRIPTION
1001	U.S. Reissued Patent No. 45,140 (“RE140”)
1002	Declaration of Dr. Bill Lin
1003	U.S. Patent No. 6,345,330 (“Chu330”)
1004	U.S. Patent Publication No. 2003/0135771 (“Cupps”)
1005	U.S. Patent No. 6,216,185 (“Chu185”)
1006	File history of RE140 (“RE140 FH”)
1007	U.S. Patent No. 6,643,777 (“Chu777”)
1008	U.S. Reissued Patent No. 42,984 (“RE984”)
1009	File history of RE984 (“RE984 FH”)
1010	U.S. Patent Application No. 60/083,886 (“’886 Provisional”)
1011	File history of Chu330 (“Chu330 FH”)
1012	August 12, 2011 Amendment from File History of Control No. 90/010,816 (Reexamination of Chu185)
1013	U.S. Reissued Patent No. 41,092 (“RE092”)
1014	U.S. Reissued Patent No. 43,602 (“RE602”)
1015	U.S. Reissued Patent No. 44,468 (“RE468”)
1016	U.S. Reissued Patent No. 44,654 (“RE654”)
1017	U.S. Patent No. 6,621,760 (“Ahmad”)
1018	<i>Reserved</i>
1019	RE140 with highlights of substantively identical portions from Chu330, Chu185, ’886 Provisional, and Chu777
1020	File history of U.S. Reissued Patent No. 43,602 (“RE602 FH”)
1021	File history of U.S. Reissued Patent No. 44,468 (“RE468 FH”)
1022	<i>ACQIS LLC v. EMC Corp.</i> , Civil Action No. 1:14-cv-13560, No. 185 (D. Mass. Jan. 20, 2017) (EMC Corporation’s Opening Claim Construction Brief)
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I. Introduction and Relief Requested

Petitioner requests rehearing of the Board’s denial of institution under 35 U.S.C. §325(d). The Board misapprehended or overlooked statutes, regulations, Federal Circuit precedent, and facts advanced by the Petitioner, leading to errors in its *Advanced Bionics* I and II (hereinafter “*AB-I*”/“*AB-II*”) analyses.

In its **AB-II** analysis, the Board misapprehended or overlooked two material issues. *First*, the Board misapprehended the difference between (1) the “new matter” analysis an Examiner might undertake (*Harari v. Hollmer*, 602 F.3d 1348 (Fed. Cir. 2010) (“*Harari I*”), which requires a reasonable Examiner standard) and (2) the separate “priority” analysis a POSITA would undertake to determine whether the *earlier issued parent applications* provide continuous priority back to the original parent patent under 35 U.S.C. §120 (*Hollmer v. Harari*, 681 F.3d, 1351 (Fed. Cir. 2012) (“*Harari II*”), which requires a POSITA standard). Only the latter was raised in Intel’s Petition, yet the Board collapsed those inquiries and determined that the Examiners had assessed priority under §120 based on the mere entry of ACQIS’s amendments during prosecution. And even if the Examiners did perform a priority analysis, they erred by not doing so under the POSITA standard. The Board further compounded its material error by misapprehending the meaning of the “four corners of the *application*,” which *Harari II* makes clear is confined to the *specification* for a POSITA’s priority analysis under §120 without consideration of the transmittal.

Second, the Board overlooked that none of the cross-referenced applications in Chu330’s specification meets the description of the single “prior application, from which a copy of the oath or declaration is supplied,” purported to be incorporated by the transmittal. The purported incorporation therefore suffers the same ambiguity as in *Harari II*, and a POSITA would **not** have been able to determine that it was the Chu886 provisional that was intended to be incorporated.

In applying **AB** to the facts here, the Board misapprehended Federal Circuit precedent and Office policy that it is improper to assume that an Examiner carried out a “priority” analysis under §120, which requires analyzing the **issued parent patents** themselves. The mere fact that an Examiner did not require the applicant to change the application type from a “continuation” (“CON”) to “continuation-in-part” (“CIP”) does not indicate that an Examiner actually analyzed the **issued parent patents** for priority.

Petitioner is concurrently submitting a request for Precedential Opinion Panel review of the questions raised herein, as well as Director review under the Supreme Court’s decision in *United States v. Arthrex, Inc.*, 141 S. Ct. 1970 (2021). The POP request also challenges the Board’s reliance on Samsung’s petitions in its §325 analysis despite having refused Petitioner an opportunity to address §325 issues, including the Board’s denial of institution of Samsung’s petitions, which occurred **after** Intel filed its Petition—thereby violating Intel’s due process rights.

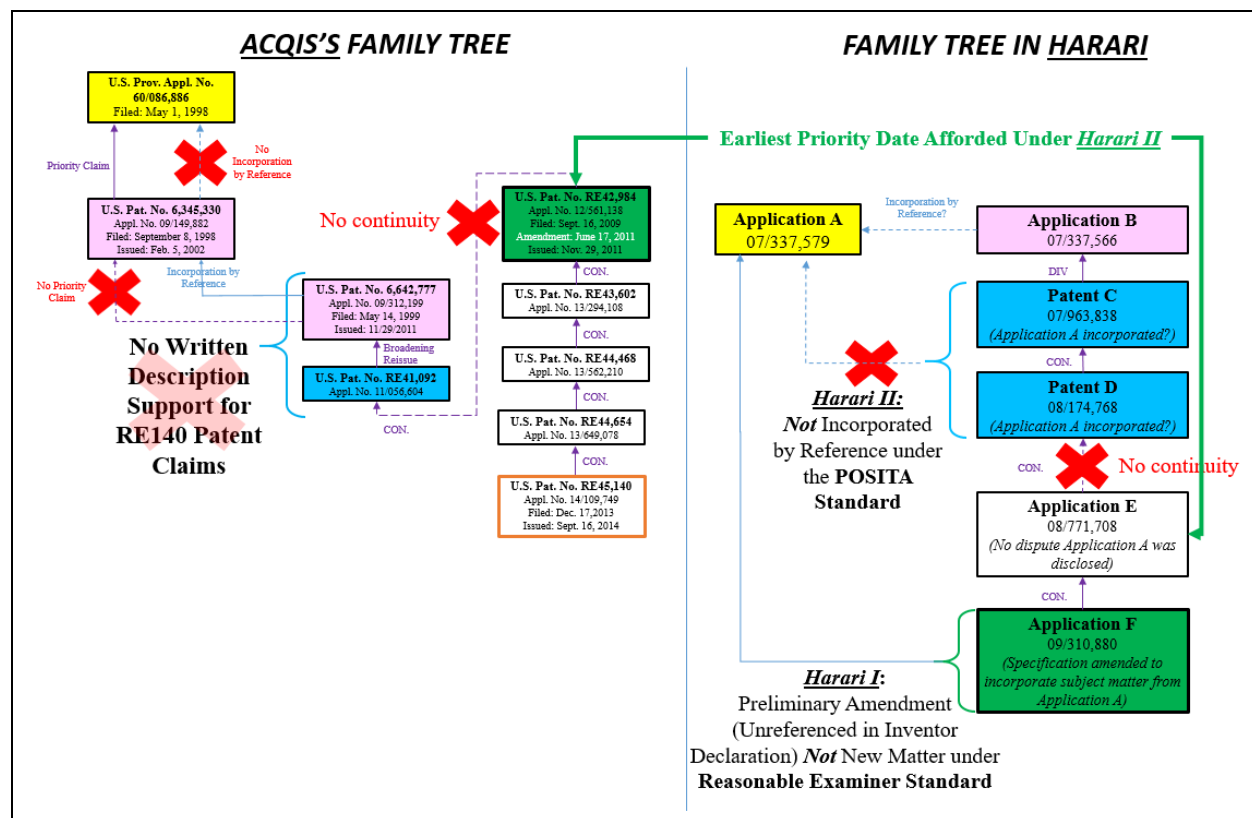
II. The Board Erred In Its *AB-II* Analysis

Harari II unambiguously held that the POSITA standard applies when determining the priority of an issued patent containing a disputed incorporation by reference—not the reasonable Examiner. Petition, 25, n.4. Nevertheless, the Board held that because “two different *Examiners* on three separate occasions considered *the transmittal form together* with the benefit claims” and that “none of the *Examiners* required the applicant to change its benefit claims from [CON] to [CIP],” the priority issue Intel raised was considered without material error. DI, 18-19; *see* Petition, 16-31, 117-118. That is incorrect under *Harari II*, because the POSITA’s analysis is confined to the specification—and does *not* include the transmittal. Petition, 26-31, 118. Although a reasonable Examiner may have looked to a transmittal to assess new matter, a POSITA would not have looked beyond the issued parent patent’s specification during a priority analysis. Petition, 28-29, n.6.

A. Instant Case Is Factually Similar To Federal Circuit’s *Harari II*

The Reply to the POPR (p. 1) laid out graphically the parallel fact patterns between the families of the instant ACQIS patent (left) and *Harari I/II* (right) cases. As shown below, **RE140** is the sixth CON originating from Chu777. In 1999, ACQIS filed Chu777 *as a separate family* from Chu330 and Chu185 (not shown)—the only two patents to ever issue from Chu886. Chu777 incorporated by reference, but did not claim priority to, Chu330. Petition, 23-24. Over a decade after filing

Chu777, ACQIS filed RE984, adding text and figures from Chu886 (*i.e.*, subject matter that ACQIS could no longer otherwise draft claims to—and subject matter which indisputably is required to provide written description support for the challenged claims). *See id.*, 18-22; POPR generally. As support, ACQIS relied on a transmittal filed with Chu330, but the transmittal did not identify Chu886 and merely included a checkbox that indicated an “incorporation by reference” of a single, unidentified “prior application.” *Id.*, 26-27. In contrast to RE984, no such amendments were ever made in the issued parent patent or Chu777. *Id.*, 20-22.



The factual similarities between the instant case and *Harari I/II*, are highlighted below.

ACQIS's Family Tree	<i>Harari I and II</i> Family Tree
<ul style="list-style-type: none"> • RE984 claims priority back to Chu777 through CON • Chu777 incorporates by reference Chu330 • Chu330 claims “benefit” to two provisionals (e.g., Chu886) and contains a separate “incorporation by reference” to a different non-provisional Chu185 (not pictured) • RE984 amended to insert text/drawings from Chu886 	<ul style="list-style-type: none"> • Application F (“AppF”) claims priority back to Application B (“AppB”) through CONs/divisionals (“DIVs”) • AppB contains incorporation by reference language mentioning title of an application “filed on the same day” (Application A (“AppA”)) • AppF amended to insert text/drawings from AppA
<ul style="list-style-type: none"> • Petitioner did <i>not</i> challenge whether matter added to RE984 constitutes new matter in the Petition 	<ul style="list-style-type: none"> • Held that matter added to AppF is not new matter under the <u>reasonable Examiner standard</u>
<ul style="list-style-type: none"> • Challenged that the earlier patents (e.g., RE092)—never amended to include the text/drawings from Chu886—do not satisfy §120’s continuity requirements under the <u>POSITA standard</u> 	<ul style="list-style-type: none"> • Held that the earlier patents (e.g., Patent D)—never amended to include the text/drawings from AppA—do not satisfy §120’s continuity requirements under the <u>POSITA standard</u>

B. The Board Erroneously Arrived At The Opposite Conclusion Than Federal Circuit’s *Harari II*

Under *Harari I*, the analysis for the narrow question—whether amendments to RE984’s specification constituted new matter relative to that specification—is

analyzed from the reasonable Examiner standard. *Harari II*, 1354; Petition, n.4.

And, under that standard, an Examiner has the “benefit of the transmittal sheet and the preliminary amendment.” *Id.* Intel did not challenge whether the Examiner erred under this standard. Petition, 24-25, n.4.

In contrast, Intel challenged whether a POSITA would have determined that the same material added to RE984 is found in the *specifications* of the issued parent applications preceding RE984.¹ See, e.g., Reply to POPR, 2 (“none of the RE984 Patent’s parent application ... provide written description support for the challenged claims.”); see also Petition, 23-30. *Harari II* made clear that “§120 requires that the disclosure actually appear within the specification.” *Harari II*, 1357; see also Petition 25, 28-30. Specifically, *Harari II* held that AppF’s issued parent patents

¹ In its POPR, ACQIS created confusion between *Harari I/II*, arguing that “the ‘underlying issue’ was whether Patent Owner could amend the specification of [RE984] to add disclosure from Chu’886 ... This ‘underlying issue’ is one for a reasonable examiner and was in fact considered by two separate examiners at the time.” POPR, 26-27. ACQIS further argued that “as the Board in IPR2021-00607 has already confirmed just a few weeks ago, the correct standard here is the reasonable examiner standard.” *Id.*, 25. But this mischaracterization by ACQIS is contrary to the review sought in the Petition. See Petition, 23-31.

(e.g., **Patent D**) must be reviewed under the POSITA standard to determine if the same matter added in **AppF** was also properly incorporated into the specification of the **parent patents** to provide §120 continuity back to **AppB**. *Harari II*, 1356-57; *see also* Petition, 24-30, n.4. And because the incorporation language in the specification did not directly lead a POSITA to **AppA**, continuity was broken. *Harari II*, 1358; *see also* Petition, 30. *Harari II*'s holding demonstrates the Board materially erred by looking beyond the specification to the transmittal and arriving at a conclusion opposite the Federal Circuit, despite the factual similarities between the instant case and *Harari I/II*. Petition, 24-30; *see also* Reply to POPR, 1-2.

1. “Four Corners of the *Application*” Refers to the *Specification*

The Board further misapprehended the distinction between *Harari I* and *II* by holding that the “[t]ransmittal form is part of the application.” DI, 20. The term “*application*” in *Harari II* refers to the “*specification*” of the issued **parent patents** (e.g., **Patent D**). *See* Petition, 25, 29 (“any incorporation by reference statement must have appeared in Chu330 itself.”); *see also* DI, 20-22.

i. Statute And Federal Circuit Precedents Consistently Require Analysis of the Specification

Harari II makes clear that in order “[t]o gain the benefit of the filing date of an earlier application under 35 U.S.C. §120, each application in the chain leading back to the earlier application must comply with the written description of 35 U.S.C. §112.” *Harari II*, 1355. Specifically, *Harari II* held that “§120 requires that the

disclosure actually appear *within the specification*.” *Id.*, 1358; *see also* 35 U.S.C. §120 (“the *specification* shall contain a written description of the invention.”). “The incorporation by reference analysis, therefore, is similarly constrained by the four corners of the application.” *Harari II*, 1358; *see also* Petition 28-29, n.6. Indeed, numerous Federal Circuit precedents have focused on whether language *within the specification* was sufficient to identify what material the host document aimed to incorporate. *See, e.g., Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (“test requires an objective inquiry into the four corners of the specification from the perspective of a [POSITA]”); *Bd. of Trustees of Leland Stanford Junior Univ. v. Chinese Univ. of Hong Kong*, 860 F.3d 1367, 1375 (Fed. Cir. 2017); *Centocor Ortho Biotech v. Abbott Labs.*, 636 F.3d 1341, 1348-49 (Fed. Cir. 2011) (using the terms “four corners of the specification” and “CIP application” interchangeably); *Husky Injection Molding Sys. Ltd. v. Athena Automation Ltd.*, 838 F.3d 1236, 1248-1249 (Fed. Cir. 2016) (“*Husky*”); *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1280 (Fed. Cir. 2000) (“*ADS*”); *Application of Fouche*, 439 F.2d 1237, 1238 (C.C.P.A. 1971) (“*Fouche*”) (cited at DI, 17); *see also* Petition, 28-30, n.6, n.7. In other words, a POSITA would not have gone beyond the four corners of the *specification*, such as a transmittal, to search for additional incorporation by reference language. Petition, 28-30.

The Board’s reliance on *Pregis Corp. v. Doll*, 698 F. Supp. 2d 584, 598-599

(E.D. Va. 2010) for the proposition that “[c]ourts have repeatedly considered application transmittals in their incorporation by reference analyses,” (DI, 21) is misplaced. *First*, *Pregis* (E.D. Va.) pre-dates *Harari II* (Fed. Cir.). *Second*, *Pregis*’ incorporation by reference did not occur in the transmittal. The *specification* incorporated by reference the ’286 Patent, and the ’286 Patent *specification* incorporated by reference a provisional application.² *Pregis*, 588-9.

ii. Legislative History of 37 C.F.R. §1.77 Makes Clear that the Transmittal Is Not Part of the Specification

The Board cited to Rule 77(a)(1998) to hold that the transmittal is part of the *application*. DI, 20-22. But as clarified at 61 Federal Register 42790, “[t]he Application Transmittal Form ... set forth in §1.77 [is] not part of the specification.” Ex. 1026, p. 10. In other words, the transmittal cannot be used to assess whether the incorporation by reference was proper within the §120 context because it is not within the four corners of the *specification*. *See, e.g.*, Petition, 28-30, n.6.

2. The Specification Makes Clear That Applicant Did Not Incorporate By Reference Chu886

The cross-references language in Chu330’s *specification* demonstrates it

² The Board’s reliance on *Harari I/II* is also misplaced because these cases only refer to the use of transmittals in the context of a reasonable Examiner standard and the purported incorporation was in the *specification*, not the transmittal. *See* DI, 21.

clearly distinguished between the two provisional applications that Chu330 merely claimed “benefit” to versus *Chu185*, which Chu330 *actually* did incorporate by reference. *See* Petition, 29-30; Ex. 1003, 1:7-15. And a POSITA would have determined that only *Chu185*—*not* Chu886—was incorporated by reference. *Id.*

This application claims any and all benefits as provided by law of U.S. Provisional Application No. 60/083,886 filed May 1, 1998 and of U.S. Provisional Application No. 60/092,706 filed on Jul. 14, 1998.

This application is being filed concurrently with the application of William W. Y. Chu for “Personal Computer Peripheral Console With Attached Computer Module”, filed on Sep. 8, 1998 now U.S. Pat. No. 6,216,185, and incorporates the material therein by reference.

Accordingly, there was no incorporation of Chu886 into any of RE984’s issued parent applications, and RE140 is only deserving of priority to RE984’s June 17, 2011 priority date. *See generally*, Petition, 16-31.

C. The Board Overlooked or Misapprehended The Fact That The Transmittal Introduces Ambiguities As To Which Application Was Meant To Be Incorporated By Reference, Much Like *Harari II*

Even if a POSITA would have looked at the transmittal—which, to be clear, a POSITA would *not* have—the Board erred in holding that the transmittal incorporates *every one* of the cross-referenced applications in Chu330. *See* DI, 16-17, 24-25; Petition, p. 27 (“Nothing in the transmittal form ‘identif[ies] with *detail particularity* what specific material [Chu330] incorporates[.]”), n.5. Specifically, the Board overlooked several ambiguities that would have led a POSITA to determine that there were “several potential documents for incorporation.” *See*

First, the Board misapprehended Petitioner’s argument, holding that “Petitioner *admits* that an applicant ... could have used the USPTO transmittal form.” DI, 21 (citing to Petition, 28-29 n.5). However, n.5 is not an admission that a POSITA can look to the transmittal for incorporation by reference during a priority analysis.³ It instead highlights the ambiguities introduced by that transmittal, given the fact that box 4b was not even checked at all. Indeed, DI correctly recognized that “Petitioner contends that ‘any incorporation by reference statement must have appeared in Chu330 itself.’” DI, 21 (citing Petition, 28-29).

Second, none of the three applications cross-referenced in Chu330 meets the transmittal’s purported incorporation of only one “*prior application, from which a copy of the oath or declaration is supplied.*” See Petition, 26-27; DI, 15. The provisional applications, such as Chu886, do *not* include an oath or declaration. See 35 U.S.C. §111(b)(1998). On the other hand, the non-provisional *Chu185* does include an oath or declaration, see 35 U.S.C. §111(a)(1998), but it was filed on the *same day* as Chu330, Ex. 1003, 1:11-15, and thus is not a “prior application.” The

³ Use of the transmittal for incorporation is limited to CONs/DIVs that use a parent’s oath/declaration in case the application was inadvertently filed with pages missing from the parent application. See MPEP 201.06(c)(1998); see Petition, 26-30.

transmittal introduces ambiguities, and a POSITA would have been “presented [with] several potential documents for incorporation,” DI, 24, just like *Harari II*.

a. ☐ Newly executed (original or copy)

b. ☐ Copy from a prior application (37 CFR 1.63(d))
(for continuation/divisional with Box 17 completed)
(Note Box 5 below)

i. ☐ DELETION OF INVENTOR(S)
Signed statement attached deleting inventor(s) named in
the prior application, see 37 CFR 1.63(d)(2) and 1.33(b)

5. ☒ Incorporation By Reference (useable if Box 4b is checked)
The entire disclosure of the prior application, from which a copy of the
oath or declaration is supplied under Box 4b, is considered as being
part of the disclosure of the accompanying application and is hereby
incorporated by reference therein.

The Board’s reliance on *Husky*, *ADS*, and *Fouche* is also misplaced.⁴ DI, 17-18. In fact, *Fouche* held that “an applicant should be permitted to incorporate ... *so long as the reference application is sufficiently well identified to distinguish it from all others.*” *Fouche*, 1239-40. But, as explained above, **Chu330**’s transmittal does not sufficiently distinguish **Chu886** from the other two cross-referenced applications. See Petition, 26-30, n.5. *Harari II* confirms that when several candidate documents are identified, none of which satisfy the incorporation language, there can be no incorporation by reference. *Harari II*, 1358.

⁴ *Husky* was not about the *identity* of the document, but about what *portions* of a document that was already *precisely identified* were incorporated. See *Husky*, 1248-9. *ADS* discussed whether it was proper to charge the jury to determine “whether and what material was incorporated by reference.” *ADS*, 1283.

Accordingly, even if a POSITA were to have looked at the transmittal (which, again, it would *not* have done so), the transmittal merely introduces ambiguities and does not directly lead a POSITA to Chu886. Petition, 26-27. Therefore, there was no incorporation of Chu886 into any of RE984's issued *parent applications* and RE140 is only deserving of priority to RE984's June 17, 2011 priority date. *See*, Petition, 16-31. Hence, the denial of institution was improper under AB-II.

III. The *AB* Test Does Not Apply Here

A. For *AB* To Apply, There Must Be Evidence The Examiner Actually Did A Priority Analysis

The Board's reliance on *In re NTP*, 654 F.3d 1268 (Fed. Cir. 2011) is misplaced. DI, 11. As *NTP* made clear, priority "can only be determined by examining the *parent application*." *NTP*, 1278; *see also Thermo Fisher Scientific Inc., v. The Regents of the Univ. of California*, IPR2018-01347, Paper 9, 21-23 (P.T.A.B. 2019). Moreover, "there is no presumption that the examiner considered whether the written description of the *parent applications* supports the claims." *Id.* Indeed, unless required, "the PTO does not make such findings as a matter of course in prosecution." *Id.* (citing *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1305 (Fed. Cir. 2008)); *see* Petition, 117-118; *see also Natural Alternatives v. Iancu*, 904 F. 3d 1375 (Fed. Cir. 2018); *Droplets, Inc. v. E*Trade Bank*, 887 F.3d 1309, 1317 (Fed. Cir. 2018). This is consistent with Office policy, which the Board similarly overlooked. *See* MPEP §201.08 (2010) ("there is no need for the Office to

make a determination ... whether the requirement of ... [§]120 ... is met.”). It is therefore immaterial that the Examiner did not require the applicant to change the application type from a CON to a CIP. DI, 19. And because no evidence exists in the file history that the Examiner actually reviewed the **parent applications** for a priority analysis, it is improper to hold that the issue had been presented to the Office under *AB-I* when the Examiner had no obligation to consider the issue. *See* Petition, 117-118. Alternatively, even if *AB-I* was satisfied, it is not possible to determine if the Examiner erred under *AB-II* when there was no obligation to act and no evidence that the Examiner did in fact act on the issue. Accordingly, §325(d) is inapplicable.

B. A New Matter Analysis Is Distinct From A Priority Analysis

The Board further relies on the fact that the Examiner “did not object to the inclusion of the amendments as new matter or issue a rejection under ... §112.” DI, 11. However, the Board overlooks that a priority analysis is distinct from a new matter or §112 analysis. *See NTP*, 1278 (“Deciding whether a patent application satisfies § 112 requires a distinct and separate analysis from deciding whether that application satisfies § 120.”). In fact, the amendments introduced into **RE984** may not have even been considered by the Examiner for a new matter analysis. *See NTP*, 1279 (holding that lack of response by Examiner is not an admission that written description arguments were considered and accepted); *ICN Photonics, Ltd. v. Cynosure, Inc.* 73 F. App’x 425, 430 (Fed. Cir. 2003) (“the failure of the PTO to

issue a new matter rejection [does not] automatically create[] a[] ... presumption[] of compliance with the written description requirement.”).

IV. The Board Violated Intel’s Due Process Rights

The Board also violated Intel’s due process rights. *See Dell Inc. v. Acceleron, LLC*, 818 F.3d 1293, 1301 (Fed. Cir. 2016) (finding due process violation when a party cannot meaningfully respond). Specifically, after the Samsung petitions were denied institution, Intel requested supplemental briefing to address the errors under *AB-II* in the Board’s decisions—decisions that were not yet in existence when Intel filed its Petition. The Board denied that request, but now relies on Samsung’s denial of institution decisions for its §325(d) analysis, violating Intel’s due process rights. DI, 12-13. Nor can Intel address these related issues in the instant Rehearing Request, as that would constitute new argument. At a minimum, the Board should reopen the proceeding and provide Intel an opportunity to address those errors.

V. Conclusion

Accordingly, because the Board misapprehended and/or overlooked critical issues that were material to both its *AB-I* and *-II* analyses, and violated Intel’s due process rights in the process, denial of institution was improper. Reconsideration and institution of the Petition is respectfully requested.

Case IPR2021-01103
U.S. Reissued Patent No. 45,140
Dated: December 30, 2021

Respectfully submitted,

/Yung-Hoon Ha/
Yung-Hoon Ha (Reg. No. 56,368)

DESMARAIS LLP
230 Park Avenue
New York, NY 10169
Telephone: 212-351-3400
Facsimile: 212-351-3401

Counsel for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on December 30, 2021 a complete copy of the Request for Rehearing and newly cited exhibit were served on counsel of record for the Patent Owner by filing this document through PTAB E2E and by sending this document via electronic mail to the following addresses:

Mark Miller (Reg. No. 44,944)
Dorsey & Whitney LLP
111 South Main Street, Suite 2100
Salt Lake City, UT 84111
Telephone: 801-933-4068
Facsimile: 801-933-7373
Email: miller.mark@dorsey.com

Gina Cornelio (Reg. No. 64,336)
Dorsey & Whitney LLP
1400 Wewatta Street, Suite 400
Denver, CO 80202
Telephone: 303-352-1170
Facsimile: 303-629-3450
Email: cornelio.gina@dorsey.com

Docketing-DV@dorsey.com

Case Collard (Reg. No. 72,901)
Dorsey & Whitney LLP
1400 Wewatta Street, Suite 400
Denver, CO 80202
Telephone: 303-352-1116
Facsimile: 303-629-3450
Email: collard.case@dorsey.com

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Respectfully submitted,

/Yung-Hoon Ha/
Yung-Hoon Ha (Reg. No. 56,368)
DESMARAIS LLP
230 Park Avenue
New York, NY 10169
Telephone: 212-351-3400
Facsimile: 212-351-3401

Counsel for Petitioner