

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

ACQIS LLC,
Patent Owner.

IPR2021-01103
Patent RE45,140 E

Before THU A. DANG, JONI Y. CHANG, and PATRICK M. BOUCHER,
Administrative Patent Judges.

CHANG, *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

Intel Corporation (“Petitioner” or “Intel”) filed a Petition requesting an *inter partes* review (“IPR”) of claims 14–38 (“the challenged claims”) of U.S. Patent No. RE45,140 E (Ex. 1001, “the ’140 patent”). Paper 2 (“Pet.”), 1. ACQIS LLC (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”). Pursuant to our prior authorization, Petitioner filed a Reply to the Preliminary Response. Paper 7 (“Reply”). Patent Owner filed a Sur-reply. Paper 8 (“Sur-reply”). Upon consideration of the parties’ contentions and evidence, we exercised our discretion under 35 U.S.C. § 325(d) to deny institution. Paper 9 (“Decision” or “Dec.”). Subsequently, Petitioner filed a Request for Rehearing of the Decision.¹ Paper 10 (“Req. Reh’g”). For the reasons that follow, Petitioner’s Request for Rehearing is *denied*.

II. STANDARD OF REVIEW

A party requesting rehearing bears the burden of showing that the decision should be modified. 37 C.F.R. § 42.71(d). Under 37 C.F.R. § 42.71(d), a petitioner who requests rehearing of a decision denying institution must identify specifically all matters we misapprehended or overlooked, and the place where each matter was previously addressed in its petition. *Id.* When reconsidering a decision on institution, we review the

¹ Petitioner also filed a Request for Precedential Opinion Panel (POP) Review. Paper 11; Ex. 3001. Upon consideration, the POP panel denied Petitioner’s Request for POP Review on October 17, 2022. Paper 12, 2.

decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may be determined if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005).

III. ANALYSIS

In its Request for Rehearing, Petitioner argues that “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 . . . analyses.”² Req. Reh’g 1. We disagree.

As we explained in our Decision, institution of an *inter partes* review is discretionary. Dec. 6–7. Section 325(d) of 35 U.S.C. provides that “[i]n determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.”

“Under § 325(d), the Board uses the following two-part framework:
(1) whether the same or substantially the same art previously was presented

² *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential) (setting forth a two-part framework for determining whether to exercise discretion to deny institution under § 325(d)).

to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of the first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics*, Paper 6 at 8. “If reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability. At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Id.* at 9.

1. Part I – whether the same or substantially the same arguments previously were presented to the Office

For Part I of the *Advanced Bionics* framework, Petitioner advances two arguments. First, Petitioner argues that “the Board overlooks that a priority analysis is distinct from a new matter or § 112 analysis.” Req. Reh’g 14–15.

We are not persuaded by Petitioner’s argument. As noted in our Decision (Dec. 10), in its Petition, Petitioner argues that the ’140 patent is not entitled to a priority date before June 17, 2011, because the parent applications did not properly incorporate by reference Chu ’886³, and that the amendments adding the subject matter from Chu ’886 improperly introduced new matter. Pet. 16–31. Notably, Petitioner’s priority argument

³ U.S. Provisional Application No. 60/083,886 (“Chu ’886”).

rests on its new matter and § 112 arguments. *Id.* Our Decision merely addressed Petitioner’s arguments as set forth in its Petition. Dec. 5–25. Therefore, we did not overlook that a priority analysis is distinct from a new matter or § 112 analysis as Petitioner alleges.

Second, Petitioner argues that the *Advanced Bionics* test does not apply here 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 [*Advanced Bionics*] when the Examiner had no obligation to consider the issue.” Req. Reh’g 13–14.

However, Petitioner ignores the prosecution history showing that Applicant specifically presented the argument that its claims are entitled to the priority date of the earlier filed application. Ex. 1009, 363. “When a patentee argues that its claims are entitled to the priority date of an earlier filed application, the examiner must undertake a priority analysis to determine if the patentee meets the requirements of § 120.” *In re NTP, Inc.*, 654 F.3d 1268, 1277 (Fed. Cir. 2011).

As explained in our Decision (Dec. 10–11⁴), the prosecution history shows that, when the subject matter from Chu ’886 was added to the ’138 application⁵, an intermediate application in the priority chain of the ’140

⁴ A timeline of the priority chain of the ’140 patent and other related applications is provided in our Decision. *Id.* at 8–10.

⁵ U.S. Application No. 12/561,138 (“the ’138 application”) issued as U.S. Patent No. RE42,984 (“the ’RE984 patent”).

patent, Applicant specifically directed the Examiner to the incorporation by reference statement in the transmittal form as support for the amendments and argued that the '138 application is a continuation reissue application for the reissue of the '777 patent⁶, wherein “the '777 patent incorporated by reference U.S. Application No. 09/149,882 (now issued as U.S. Patent No. 6,345,330” (“Chu '330”), “which in turn, claimed the benefit of and incorporated by reference U.S. Provisional Application No. 60/083,886” (“Chu '886”) “(See checked incorporation by reference box in utility patent application transmittal of U.S. Application No. 09/149,882 filed on September 8, 1998).” Ex. 1009, 393. Therefore, we determined that the Petition presented the same or substantially the same arguments that were previously presented to the Office, satisfying the first part of the *Advanced Bionics* framework. Dec. 8–13. In short, we are not persuaded by Petitioner’s argument that the *Advanced Bionics* test does not apply here.

2. Part II – whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of the challenged claims

As to Part II of the *Advanced Bionics* framework, Petitioner advances several arguments. First, Petitioner argues that the Board incorrectly applied the “person of ordinary skill in the art” standard under *Hollmer v. Harari*,

⁶ U.S. Patent No. 6,643,777 (“the '777 patent”).

681 F.3d 1351 (Fed. Cir. 2012) (“*Harari II*”⁷) because under *Harari II*, “the POSITA’s analysis is confined to the specification—and does *not* include the transmittal.” Req. Reh’g 3, 5–10.

Petitioner’s argument is unavailing, as Petitioner improperly conflates “application” with “specification.” As noted in our Decision (Dec. 20), the Federal Circuit in *Harari II* clearly explained that the incorporation by reference analysis includes “the four corners of the *application*.” *Harari II*, 681 F.3d at 1358. Our rule specifically states that a transmittal form is a part of the application. *See* 37 C.F.R. § 1.77(a) (1998) (“The elements of the application, if applicable, should appear in the following order: (1) Utility Application Transmittal Form . . .”). Courts have repeatedly considered application transmittals in their incorporation by reference analyses. *See, e.g., Harari v. Hollmer*, 602 F.3d 1348, 1352–53 (Fed. Cir. 2010); *Harari II*, 681 F.3d at 1353–54; *Pregis Corp. v. Doll*, 698 F.Supp.2d 584, 598–599 (E.D. Va. 2010) (The court in its analysis considered the incorporation by reference of a prior provisional application and a patent submitted in a transmittal letter.). Here, it is undisputed that Applicant used a USPTO form that provided a check box to incorporate by reference each prior application. Ex. 1011, 79–82.

⁷ Petitioner refers to the Federal Circuit’s *Hollmer v. Harari* decision as *Harari II*, whereas our Decision denying institution cites to this case as *Hollmer*.

Second, Petitioner argues that the Board overlooked or misapprehended the fact that the transmittal introduces ambiguities as to which application was meant to be incorporated by reference. Req. Reh’g 10–13. According to Petitioner, “the Board erred in holding that the transmittal incorporates *every one* of the cross-referenced applications in Chu330,” because “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*’” and “Chu330’s transmittal does not sufficiently distinguish Chu886 from the other two cross-referenced applications.” *Id.*

We are not persuaded by Petitioner’s arguments. As noted in our Decision, Applicant clearly identified its prior applications (including Chu ’886) in the first sentence of the Specification. Dec. 13–20. Notably, the first sentence of the Specification of Chu ’330 states that “[t]his application claims any and all benefits as provided by law of U.S. Provisional Application No. 60/083,886” (Chu ’886) “and of U.S. Provisional Application No. 60/092,706 filed on July 14, 1998.” Ex. 1011, 83. The USPTO accepted the benefit claims to these two prior applications (including Chu ’886) by placing them on the file wrapper cover of Chu ’330 and the Examiner verified them by placing his or her initials on the file wrapper cover. *Id.* at 78.

The incorporation by reference language in each of the transmittals together with the benefit claims in the first sentence of the Specification of Chu ’330 would have sufficiently identified Applicant’s prior applications

(including Chu '886) as the referenced prior applications, distinguishing them from all other documents. Ex. 1011, 79–83. Petitioner fails to recognize that Applicant submitted a transmittal containing the incorporation by reference statement for each of the prior applications. A reasonably skilled artisan would have recognized that Applicant intended to incorporate both prior applications (including Chu '886) at the time of filing Chu '330.

As to Petitioner's contentions regarding Chu '185⁸, Applicant clearly identified this application as an application “being filed concurrently” and “incorporate[d] the material therein by reference” in the second sentence of the Specification. *Id.* at 83. Indeed, Petitioner admits that Chu '185 “was filed on the *same* day as Chu330 . . . and thus is not a ‘prior application.’” Req. Reh’g 11. Petitioner does not explain why a person of ordinary skill in the art would not have distinguished the prior applications (including Chu '886) from Chu '185.

In short, Chu '330 identified Chu '886 with particularity and would have directly led an ordinarily skilled artisan to the document intended to be incorporated. As the Federal Circuit has explained, “[t]he incorporation standard relies only on the reasonably skilled artisan and his or her ability to deduce from language, however imprecise, what a host document aims to incorporate.” *Husky Injection Molding Systems Ltd. v. Athena Automation Ltd.*, 838 F.3d 1236, 1248 (Fed. Cir. 2016) (citing *Harari v. Lee*, 656 F.3d

⁸ U.S. Non-provisional Application No. 09/149,548, issued as U.S. Patent No. 6,216,185 (“Chu '185”).

1331 (Fed. Cir. 2011)); *cf. KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007) (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”). Moreover, under Part II of the *Advanced Bionics* framework, “[i]f reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability.” *Advanced Bionics*, Paper 6 at 9.

Finally, Petitioner argues that the instant case is factually similar to those in *Harari II*. Req. Reh’g 3–5. However, as noted in our Decision (Dec. 15), the intervening applications in *Harari II* merely identified the referenced application with the title and the language “*filed on the same day as the present application*,” but the intervening applications were not “filed on the same day” as that referenced application and at least two other applications by the same inventors that had the same title as that referenced application. *Harari II*, 681 F.3d at 1353, 1358. Therefore, the Federal Circuit held that the incorporation language in *Harari II* did not directly lead one of ordinary skill in the art to that referenced application, but rather presented several potential documents for incorporation. *Id.* at 1358.

Here, unlike *Harari II*, Chu ’330 provided an incorporation by reference statement for each prior application and clearly identified the prior applications (including Chu ’886) in the first sentence of the Specification. The incorporation by reference language in each of the transmittals together with the benefit claims in the first sentence of the Specification would have sufficiently identified the prior applications (including Chu ’886) as the referenced applications, distinguishing them from all other documents.

Ex. 1011, 79–83. In short, Chu ’330 identified Chu ’886 with particularity and would have directly led an ordinarily skilled artisan to the document intended to be incorporated.

For the foregoing reasons, Petitioner fails to show that we abused our discretion in determining to deny its Petition under 35 U.S.C. § 325(d).

3. Whether the Board violated Intel’s due process rights

Intel argues that we relied on our decisions denying Samsung’s petitions (*see, e.g.*, IPR2021-00607, Paper 9), which were entered after Intel filed its Petition, violating Intel’s due process rights. Req. Reh’g 15.

However, we did not rely on those decisions. Rather, we merely noted that similar arguments were presented in Samsung’s petitions and that the prosecution history of the patents challenged by Samsung shows that the Applicant submitted similar arguments regarding its priority claims and incorporation by reference. Dec. 12–13, 18–19. Both Samsung’s arguments and the prosecution history were available before Intel filed its Petition. Moreover, Intel had the opportunity to present arguments and did present arguments in its Reply to distinguish its Petition from our decisions denying Samsung’s petitions. Reply 1–2 (arguing that “[i]n Samsung’s petitions, the Board analyzed whether the RE984 Patent . . . sufficiently incorporated the ’886 Provisional . . . under the *reasonable Examiner standard* to determine whether the subject matter added in the preliminary amendment, unreferenced in the inventor declaration, constituted new matter”).

For these reasons, we are not persuaded by Petitioner's argument that the Board violated Intel's due process rights.

IV. CONCLUSION

For the foregoing reasons, Petitioner has not demonstrated that we abused our discretion. Consequently, Petitioner's Request for Rehearing is *denied*.

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