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**Subject:** IPR2021-01103: Request for Precedential Opinion Panel review of Petitioner's Request for Rehearing  
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Dear Honorable Board,

I write on behalf of Petitioner, Intel Corporation, to request Precedential Opinion Panel ("POP") Review of the Board's decision in *Intel Corporation v. ACQIS, LLC*, IPR2021-01103, Paper 9 (December 2, 2021). Petitioner's Request for Rehearing (attached) raises issues that are contrary to Federal Circuit precedent, statute, and regulation, and require an answer to one or more precedent-setting questions of exceptional importance, thus requiring POP review:

- (1) Whether the Board's priority analysis under 35 U.S.C. §120 is contrary to Federal Circuit precedent (e.g., *Hollmer v. Harari*, 681 F.3d, 1351 (Fed. Cir. 2012) ("*Harari IP*")), creating a panel split in how priority is analyzed within different panels of the Board;
- (2) Whether the Board erred in applying *Advanced Bionics* because of Patent Owner statements when the Examiner had no obligation to consider them under Federal Circuit precedent and Office policy and no explicit evidence exists to indicate that the Examiner affirmatively or meaningfully did so; and
- (3) Whether a Petitioner's due process rights have been violated when the Board fails to provide Petitioner the ability to respond to facts arising after a petition was filed, but the Board nevertheless relies on those after-arising facts in its Institution Decision.

These issues rise to a level of exceptional importance requiring POP Review because they impact numerous petitions filed by Petitioner and, separately, Samsung. Specifically, these issues apply to over thirteen decisions issued by the Board in 2021, including the present IPR proceeding. See IPR2021-01099, -01103, -01107, -01108, -01109, -01110, -01111, and -01112 filed by Intel, and IPR2021-00604, -00605, -00606, -00607, and -00608 filed by Samsung. And these issues will likely impact eight additional decisions to be issued by the Board in 2022. See IPR2021-01093, -01094, -01095, -01102, -01104, -01105, -01113, and -01114.

In the instant IPR2021-01103, the Petition explained why U.S. Reissued Patent No. 45,140 (RE140) is not afforded priority back to its earliest claimed priority date, because the issued parent applications' specifications did not contain the requisite material added into a later filed application ("RE984"). See Petition, 16-31, 117-118. And under Federal Circuit precedent, a *person of ordinary skill in the art* ("**POSITA**") would not have found the material to be part of the parent patents' specifications based on a vague statement in a transmittal form and clear statements in the specification that only incorporated by reference *another* application ("Chu185") that does not contain the requisite subject matter. None of these statements would

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Ex. 3001

have led the POSITA to the requisite provisional (“Chu886”) that the Patent Owner purports to have been incorporated.

However, the Board denied institution under 35 U.S.C. §325(d) using the *Advanced Bionics* framework. Specifically, the Board found that Part I of the *Advanced Bionics* test was satisfied because **Examiners** were assumed to have properly considered the priority issue by permitting amendments adding the requisite material without objection or rejection—and because a third party Petitioner (Samsung) had previously submitted similar arguments to the Board, which the Board rejected. See DI, 8-13. The Board then found no material error under Part II of the *Advanced Bionics* test by again assuming the **Examiners** had properly considered the issue, and by looking beyond the *specification* and into *the transmittal form*. See DI, 13-25.

These findings by the Board are contrary to Federal Circuit precedent, statute, and regulation because the Board’s analysis (1) substitutes an **Examiner’s** analysis for a **POSITA’s** analysis, and (2) looks beyond the specification and into the transmittal, which is contrary to the POSITA standard.

The Board’s decision also exposes that application of the *Advanced Bionics* analysis was improper in the instant context. As the DI recognized, the *Advanced Bionics* “framework reflects a commitment to defer to previous **Office evaluations** of the evidence of record unless material error is shown.” DI, 13. Here, the Office did not have an obligation to determine priority to enter Patent Owner’s amendments, as articulated in Federal Circuit precedent and Office policy, and there was no evidence of record that the Office had made **any** evaluation directed to the priority analysis.

The Board also relied on denials of institution on third-party Samsung’s petitions as part of its *Advanced Bionics* analysis, (DI, 12-13), without providing Petitioner the opportunity—and in fact, denying the Petitioner’s request for supplemental briefing directed to the §325(d) issues—to address why those decisions were in error, though they had issued **after** filing of the instant Petition. Thus, the panel violated Intel’s due process rights.

Finally, Petitioner also seeks Director Review of the Board’s Institution Decision to remedy the constitutional defects of Rule 42.71(c) to the extent it specifies that a panel, and thus not the Director, decides rehearing requests and to the extent that it requires deference to the original panel when the Director re-hears a decision whether to institute IPR.

#### Issue #1: Board’s Priority Benefit Analysis

Based on my professional judgment, I believe the Board’s Institution Decision is contrary to the following decision(s) of the United States Court of Appeals for the Federal Circuit (and its predecessor court):

- *Harari v. Hollmer*, 602 F.3d 1348 (Fed. Cir. 2010) (“*Harari I*”)
- *Hollmer v. Harari*, 681 F.3d, 1351 (Fed. Cir. 2012) (“*Harari II*”)
- *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010)
- *Bd. of Trustees of Leland Stanford Junior Univ. v. Chinese Univ. of Hong Kong*, 860 F.3d 1367, 1375 (Fed. Cir. 2017)
- *Husky Injection Molding Sys. Ltd. v. Athena Automation Ltd.*, 838 F.3d 1236, 1248-1249 (Fed. Cir. 2016)
- *Centocor Ortho Biotech v. Abbott Labs*. 636 F.3d 1341, 1348-49 (Fed. Cir. 2011)
- *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1280 (Fed. Cir. 2000)
- *Application of Fouché*, 439 F.2d 1237, 1238 (C.C.P.A. 1971)

Moreover, based on my professional judgment, I believe the Board's Institution Decision is contrary to the following statute and regulation:

- 35 U.S.C. §120
- 37 C.F.R. §1.77(a) (1998), including 61 Federal Register, 42790, 42799 (1998)

I believe the Board's Institution Decision is contrary to the above-mentioned Federal Circuit precedents, statute, and regulation in at least the following three ways:

- The decision erred because the Board relied on what an Examiner presumably considered for the analysis of whether issued parent patents provide continuity of subject matter in a priority chain. Federal Circuit precedents, including *Harari II*, limit that analysis to a POSITA standard, which is distinct from a reasonable Examiner standard;
- The decision erred by relying on a purported incorporation by reference statement outside the "four corners of the specification," that is in an application transmittal form, when analyzing issued patents for continuity of subject matter. 35 U.S.C. §120 and Federal Circuit precedents limit that analysis to the *specifications* of those patents under a POSITA standard; and
- The decision erred by ignoring ambiguities in incorporation by reference language and treating *all* potential cross-referenced applications in the specification as effectively incorporated. Federal Circuit precedent requires drafting an incorporation by reference statement in an exacting manner to identify with detailed particularity what specific material it incorporates to a POSITA.

This panel's divergence from Federal Circuit precedent, statute, and regulation has now created a panel split in how priority is analyzed within different panels of the Board. For example, two different panels have correctly held that "[t]he test for written description support 'requires an objective inquiry into the four corners *of the specification from the perspective of a person of ordinary skill in the art.*'" *Unified Patents, LLC v. Dolby Laboratories Licensing Corporation*, IPR2021-00275, Paper 21, 17 (P.T.A.B. Jun 17, 2021); *Gilead Sciences, Inc., v. Regents of the University of Minnesota*, IPR2017-01712, Paper 67, 9 (P.T.A.B. May 21, 2021) (emphases added). As another example, a different panel further correctly recognized that the panel "do[es] not find that the 'reasonable person of ordinary skill in the art' possesses the skills of a registered patent agent or *a patent examiner.*" *Apple Inc., v. e-Watch, Inc.*, IPR2015-00414, Paper 34, 19 (P.T.A.B. June 22, 2016). Nevertheless, the instant panel has gone beyond the four corners of the specification and looked to the transmittal and has replaced the assumed actions of two different Examiners as a proxy for the analysis that would have been undertaken by a reasonable POSITA.

Moreover, this panel has ignored Federal Circuit precedent which holds that "[p]atent draftsmanship is an exacting art, and no less care is required in drafting an incorporation by reference statement than in any other aspect of a patent application." *Harari II*, 1358 (quoting *Zenon Envtl., Inc. v. U.S. Filter Corp.*, 506 F.3d at 1382 n.3). Specifically, *Harari II* held that "ambiguity in incorporation does not suffice" under the POSITA standard. *Id.* Nevertheless, the Board overlooked explicit statements in the specification, as well as ambiguities in the transmittal, that would have led a POSITA to determine that a *different* application (which does not provide the requisite written description support for the challenged claims) was incorporated.

POP Review of this issue is required to prevent further perpetuation of these misapplications of Federal Circuit case law in future cases and to promote consistency in how Federal Circuit

precedent is applied across the different cases handled by the Board.

### Issue #2: Applicability of *Advanced Bionics*

Based on my professional judgment, I believe this case requires an answer to the following precedent-setting question of exceptional importance:

- Whether the Board erred in applying *Advanced Bionics* because of Patent Owner statements when the Examiner had no obligation to consider them under Federal Circuit precedent and Office policy and no explicit evidence exists to indicate that the Examiner affirmatively or meaningfully did so.

The panel found that if “the applicant argued that [its] amendments were proper ... the examiner must undertake a priority analysis to determine if the patentee meets the requirements of § 120.” DI, 11. However, the Board’s Institution Decision is contrary to Federal Circuit precedent and Office policy as well. For example, the Federal Circuit held that priority “can only be determined by examining the parent applications.” *In re NTP, Inc.*, 654 F.3d 1268, 1278 (Fed. Cir. 2011). 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)). And this is consistent with the Office policy. See MPEP §201.08 (2010) (“Unless the filing date of the earlier nonprovisional application is actually needed, ...there is no need for the Office to make a determination ... whether the requirement of 35 U.S.C. 120 ... is met.”). Accordingly, even if an applicant argued that its amendments were proper during prosecution, there can be no presumption that the issue of priority was “previously presented to the Office” when Federal Circuit precedent and Office policy indicate that the Examiners did not have an obligation to make any priority analysis. Here, no such evidence exists that any Examiner actually undertook the priority analysis by reviewing the specifications of the parent patents to RE984 to determine if written description support exists. Hence, it was improper for the Board to find that “the Petition presents the same or substantially the same arguments that were previously presented to the Office.” DI, 13.

POP Review of this issue is required to prevent erroneous presumption that a priority analysis has been presented to the Office under the *Advanced Bionics* test, when Federal Circuit precedent and Office policy explicitly states that the Office did not have an obligation to actually undertake a priority analysis.

Alternatively, POP Review of this issue is requested to find that *Advanced Bionics* review should not apply for a priority analysis when there is no evidence in the file history that the Examiner reviewed the specifications of the parent patents to RE984 to actually determine priority. When Federal Circuit precedent and Office policy explicitly states that the Office did not have an obligation to actually consider an issue, like priority, and there is no evidence in the file history that the Examiner did in fact undertake an analysis of the issue, it is impossible to determine if the Examiner erred under the second part of the *Advanced Bionics* test. Petitioners are then trapped in a catch-22 if the Board determines that the first part of *Advanced Bionics* is satisfied, but the Office had not considered an issue raised in a petition because it had no obligation to do so and therefore could not have erred.

### Issue #3: Petitioner’s Due Process Rights

Based on my professional judgment, I believe the Institution Decision is contrary to Petitioner’s Due Process rights under the Fifth Amendment of the U.S. Constitution and the Administrative Procedure Act and requires an answer to the following precedent-setting question of exceptional importance:

- Whether a Petitioner’s due process rights have been violated when the Board fails to provide Petitioner the ability to respond to facts arising after a petition was filed, but the

Board nevertheless relies on those after-arising facts in its Institution Decision.

The Board issued its Institution Decisions for petitions filed by a third-party Petitioner Samsung between August 9 and September 14, 2021 in IPR2021-00604 through -00608. And because the Board issued these Institution Decisions in the Samsung IPRs *after* Petitioner (Intel) had already filed the instant Petition, Petitioner could not have explained the errors in the Samsung Institution Decisions when Petitioner (Intel) was preparing the instant Petition. Accordingly, Petitioner requested a 10-page reply to the POPR to address 35 U.S.C. §314(a) and §325(d) issues. However, the panel partially denied Petitioner's request and only authorized a 3-page reply limited to the §314(a) issues. Nevertheless, the Board relies on Samsung's denial of institution decisions as part of its §325(d) analysis, and held that "another petitioner (Samsung) previously presented to the Office substantially the same arguments" in its *Advanced Bionics* Part I analysis. DI, 12-13. Not only was Petitioner denied a chance to address these exact issues in a reply to the POPR, Petitioner cannot address any errors specific to the Samsung institution decisions even now in its rehearing request, because that would constitute new argument.

Despite Patent Owner's protestations that Petitioner "circumvented the Board's explicit restriction under the guise of *Fintiv* Factor 6," Petitioner was not afforded an opportunity to provide a *meaningful* response addressing the errors of the §325(d) analysis in the Samsung Institution Decisions. The Board's refusal to allow Petitioner to address the §325(d) issues in its reply to the POPR violated Petitioner's due process rights. *See* 5 U.S.C. §554(c) ("The agency shall give all interested parties opportunity for ... submission and consideration of facts, arguments ... when time, the nature of the proceeding, and the public interest permit"), and §556(d) ("A party is entitled to present his case or defense by oral or documentary evidence, to submit rebuttal evidence, and to conduct such cross-examination as may be required for a full and true disclosure of the facts."). "The indispensable ingredients of procedural due process are notice and an opportunity to be heard by a disinterested decision-maker." *Abbott Labs. v. Cordis Corp.*, 710 F.3d 1318, 1328 (Fed. Cir. 2013). Indeed, when a party is deprived of its opportunity to meaningfully respond, the Federal Circuit has held that the party's due process rights have been violated. *Dell Inc. v. Acceleron, LLC*, 818 F.3d 1293, 1301 (Fed. Cir. 2016) (holding that due process rights have been violated by relying on "assertion introduced into the proceeding only at oral argument, after Acceleron could meaningfully respond."). POP Review of this issue is required to prevent future violation of petitioners' due process rights. At a minimum, should the POP panel determine that Samsung's IPR proceedings can be utilized as part of the *Advanced Bionics* analysis, Petitioner requests reopening of the proceedings to provide Petitioner an opportunity to address why the *Advanced Bionics* parts were not met.

*Issue #4: Director Review to Remedy Constitutional Defect of Rule 42.71(c)*

Further, based on my professional judgment, I believe this case requires an answer to the following precedent-setting question of exceptional importance:

- Whether 37 C.F.R. § 42.71(c) is unconstitutional to the extent it specifies that a panel, and thus not the Director, decides rehearing requests and to the extent that it requires deference to the original panel when the Director re-hears a decision whether to institute IPR.

Petitioner requests review of a question of exceptional importance that was previously raised in *Intel Corp. v. Health Discovery Corp.*, IPR2021-00555, Ex. 3001 and *Intel Corp. v. Koninklijke Philips N.V.*, IPR2021-00328, Ex. 3001.

Statutory authority for rehearing Board decisions is found in 35 U.S.C. § 6(c), which states that "[o]nly the Patent Trial and Appeal Board may grant rehearings." In *Arthrex*, the Supreme Court found that "Section 6(c) cannot constitutionally be enforced to the extent that its

requirements prevent the Director from reviewing final decisions rendered by APJs.” *United States v. Arthrex, Inc.*, 141 S. Ct. 1970, 1981 (2021).

Rule 42.71(c), the regulatory analog to § 6(c), provides that “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c) (emphasis added). Rule 42.71(c) suffers from the same constitutional defect as § 6(c) to the extent it precludes Director review of an institution denial. Such a decision is “final”—the statute itself says so. 35 U.S.C. § 314(d) (providing that a decision whether to institute a trial “shall be final”). Regardless of whether 35 U.S.C. § 314(d) prevents a judicial appeal from a final denial of institution, a plain reading of *Arthrex* dictates that any final decision of the Board must be reviewable by the Director. Indeed, judicial review is irrelevant because “it cannot provide the necessary supervision.” *Arthrex*, 141 S. Ct. at 1982. When APJs are deciding whether to institute IPR they are exercising executive power and therefore “must remain ‘dependent on the President.’” *Id.* (quoting 1 *Annals of Cong.*, at 611-612 (J. Madison)).

Rule 42.71(c) is further flawed in that it limits the scope of the Director’s review. Consistent with *Arthrex*, the Director should be able to review institution decisions free of the limits created by Rule 42.71(c), which provides that an institution decision is reviewed “for an abuse of discretion.” The Supreme Court explained that when conducting his or her own review, the Director may “reach his [or her] own decision.” *Arthrex*, 141 S. Ct. at 1987. Abuse-of-discretion is a deferential standard of review that would prevent the Director from reaching “his [or her] own” decision and is therefore improper.

Rule 42.71(c) is particularly egregious because it walls off the Director from rehearing a decision statutorily assigned to the Director per 35 U.S.C. § 314(a)-(c). That rule is further suspect given the language of Rule 42.4, which delegates to the Board the authority only to institute review. See 37 C.F.R. § 42.4(a) (providing that “[t]he Board institutes the trial on behalf of the Director”) (emphasis added). That regulatory delegation is silent as to the Board’s ability to exercise whatever discretion the Director has to deny a petition. Rule 42.71(c) is thus doubly suspect because it limits rehearing of discretionary denials to the Board, which has not been delegated such authority in the first place.

The Board’s procedure to address *Arthrex* does not remedy the constitutional defect of Rule 42.71(c) because it has not made Director review available for institution denials. Petitioner requests that the Director reconsider all issues raised in Petitioner’s Request for Rehearing.

### Conclusion

Appeals are unavailable in these institution decisions. To promote fairness for Petitioner, POP review of these legal errors is necessary. See SOP 2 at 2 (citing 35 U.S.C. §§ 311-329); Section 18 of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284, 329 (2011).

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