

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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INTEL CORPORATION  
Petitioner,

v.

ACQIS LLC,  
Patent Owner

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Case IPR2021-01103  
Reissue Patent 45,140

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**PATENT OWNER'S PRELIMINARY RESPONSE**

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EX2002	Scheduling Order in <i>ACQIS LLC v. Lenovo Group Ltd.</i> , Case No. 6-20-cv-00967 (W.D. Tex.)
EX2003	Second Amended Docket Control Order and First Amended Docket Control Order in <i>ACQIS LLC v. Samsung Elecs. Co. Ltd., et al.</i> , Case No. 2:20-cv-00295-JRG (E.D. Tex.)
EX2004	Excerpts from Defendants' P.R. 3-3 and 3-4 Invalidity Contentions and Disclosures and Subject Matter Eligibility Contentions, Case No. 2:20-cv-00295-JRG (E.D. Tex.)
EX2005	Excerpts from Pacer docket sheet for <i>ACQIS LLC v. Lenovo Group Ltd.et al.</i> , Case No. 6:20-cv-00967-ADA (W.D. Tex.)
EX2006	June 24, 2021 Judge Albright Order Governing Proceedings - Patent Case

## **I. PRELIMINARY STATEMENT**

Petitioner Intel Corporation (“Petitioner”)<sup>1</sup> raises the same failed argument that was already considered five times by the USPTO, including three times by the Board. Petitioner’s recycled arguments fair no better here, and the Board should deny institution. Specifically, none of the references relied on in the Petition qualify as prior art to U.S. Pat. No. RE45,140 (the “’140 patent”), therefore Petitioner has not met its burden of showing a reasonable likelihood of prevailing on its proposed grounds of unpatentability.

The inventor of the ’140 patent, William Chu, is a prolific inventor with dozens of issued patents, and ACQIS has licensed its portfolio to numerous significant technology companies, including multiple Fortune 100 companies. In spite of this track record, Petitioner challenges a significant portion of ACQIS’s portfolio, including the ’140 patent, by walking the tightest possible rope: advancing the priority date of the ’140 patent over ten years in an attempt to use the inventor’s own prior, commonly-owned patents and provisional applications against him. In particular, the Petition alleges that the earliest non-provisional priority application, U.S. Pat. App. No. 09/312,199 (the “’199 application”) and

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<sup>1</sup> Intel also identifies various Lenovo entities as real parties-in-interest (“RPI Lenovo Defendants”). Pet. at 8.



two subsequent applications in the priority chain fail to provide written description for certain claimed features because of an alleged improper incorporation by reference. Petitioner contends that due to this alleged improper incorporation by reference, the '140 patent included new matter and is only entitled to a priority date of June 17, 2011, more than ten years after the May 14, 1999 filing date of the '199 application. The Petitioner is wrong, and the Board should not institute *inter partes* review of claims 14-38 of the '140 patent for the following independent reasons.

***First***, the Board should exercise its discretion to deny institution of *inter partes* review because the arguments advanced by Petitioner have been considered, and rejected, multiple times by the USPTO (including three times by the Board). Petitioner is merely recycling the same argument already asserted earlier this year against Patent Owner and the '140 patent in IPR2021-00607. The Board denied institution less than three weeks ago. *See Samsung Electronics Co., Ltd., et al. v. ACQIS LLC*, IPR2021-00607, Paper 7 at 21 (PTAB October 7, 2021).<sup>2</sup>

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<sup>2</sup> The Board has also considered and rejected the same argument for other of Patent Owner's patents in IPR2021-000604, IPR2021-000605, and IPR2021-00606. *See Samsung Electronics Co., Ltd., et al. v. ACQIS LLC*, IPR2021-00604, Paper 7 at 21 (PTAB August 9, 2021) ("denying institution where "Petitioner has not shown

In IPR2021-00607, the Board explained that “Petitioner has *not* shown sufficiently that the ’777 patent and the applications in the ’140 patent’s priority chain did not properly incorporate by reference Chu ’330 and Chu ’886, or that the examiner erred in entering the amendments that added the subject matter from Chu ’886 to the ’138 application.” *Id.* (emphasis added). “As such, [the Board was] not

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sufficiently that the applications in the ’750 patent priority chain did not properly incorporate by reference Chu ’330 and Chu ’886, or that the examiner erred in entering the amendments that added the subject matter from Chu ’886 to the ’912 application.”); *Samsung Electronics Co., Ltd., et al. v. ACQIS LLC*, IPR2021-00605, Paper 7 at 27 (PTAB August 23, 2021) (denying institution where “Petitioner has not shown sufficiently that the applications in the ’768 patent priority chain did not properly incorporate by reference Chu ’330 and Chu ’886, or that the examiner erred in entering the amendments that added the subject matter from Chu ’886 to the ’912 application.”); *Samsung Electronics Co., Ltd., et al. v. ACQIS LLC*, IPR2021-00606, Paper 7 at 21 (PTAB August 25, 2021) (denying institution where “Petitioner has not shown that the applications in the ’797 patent priority chain failed to properly incorporate by reference Chu ’330 and Chu ’886, or that the Examiner erred in entering the amendments that added the subject matter from Chu ’886 to the ’912 application.”).

persuaded by Petitioner’s argument that the earliest possible priority date for the challenged claims of the ’140 patent is November 10, 2011.”<sup>3</sup> *Id.* The Board “determine[d] that the same or substantially the same arguments previously were presented to the Office [during prosecution of the ’138 application] and that Petitioner fails to show that the Examiner erred.” *Id.* (internal quotes omitted). Because the argument Petitioner presses here has been previously decided by the Office and now has been decided by the Board, the Board here should also exercise its discretion pursuant to 35 U.S.C. § 325(d) to deny the Petition.<sup>4</sup>

***Second***, none of the art cited in the Petition is actually *prior* art, but relies on an argument that new matter was introduced (but not rejected) during examination of patents in the ’140 patent priority chain. Petitioner’s new matter argument is

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<sup>3</sup> Samsung argued November 10, 2011 in IPR2021-00607 and Petitioner here argues June 17, 2011. The slightly different dates are irrelevant to the issues here.

<sup>4</sup> While the underlying “prior” art and combinations thereof vary between Samsung’s petition (IPR2021-00607) and Intel’s petition here, each of these petitions raises the same argument in an attempt to move the priority date of the patents in the ’140 patent’s priority chain (to reach the “prior” art): the examiner allegedly erred in entering the amendments that added the subject matter from Chu ’886 to the ’138 application.

fatally flawed.<sup>5</sup> The Petition incorrectly asserts that applications in the '140 patent's priority chain failed to properly incorporate by reference a previous application. Specifically, the Petition incorrectly asserts that U.S. Pat. No. 6,345,330 ("Chu '330") failed to properly incorporate by reference U.S. Provisional Pat. App. No. 60/083,886 ("Chu '886"). Petitioner *must* make this strained (multiple times rejected) form-over-function argument to reach its "prior art" of choice. Each of Petitioner's specific grounds of invalidity relies on Chu '330 as the primary reference. *See* Pet. at 35.

However, Chu '330 incorporated Chu '886 by reference as of the filing date of the application that issued as Chu '330. Patent Owner called the examiner's attention to the incorporation by reference of Chu '886 when later amending to explicitly add previously incorporated material from Chu '886 to the pending U.S. Pat. App. No. 12/561,138 (the "'138 application"). Chu '330 and Chu '886 are part

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<sup>5</sup> Patent Owner does not concede that any of the amendments challenged in the Petition are the only disclosure that provide written description for the challenged claims. However, for the limited purpose of this Patent Owner Preliminary Response, Patent Owner assumes that the added figures and disclosure from Chu '886 are necessary to support the challenged claim limitations. Patent Owner reserves the right to argue otherwise if *inter partes* review is instituted.

of the disclosure of each application in the priority chain, and the '140 patent is entitled to a priority date of no later than May 12, 1999—the filing date of the '199 application. Based on this priority date, *none* of the references relied on in the Petition qualifies as prior art. The Petition should be denied.

*Third*, the Board should exercise its discretion to deny the Petition under 35 U.S.C. § 314(a) and *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential). The RPI Lenovo Defendants advance the same argument—that the examiner allegedly erred in entering the amendments that added the subject matter from Chu '886 to the '138 application—that they have raised in an attempt to move the priority date of the patents in the '140 patent's priority chain in a parallel proceeding in the Western District of Texas<sup>6</sup>—a matter in the midst of claim construction and set for trial before the deadline for a Final Written Decision on this Petition. Due to the overlap of issues and the advanced stage of the District Court proceeding, institution of this *inter partes* review would be a waste of resources for the Board, the District Court, and the parties.

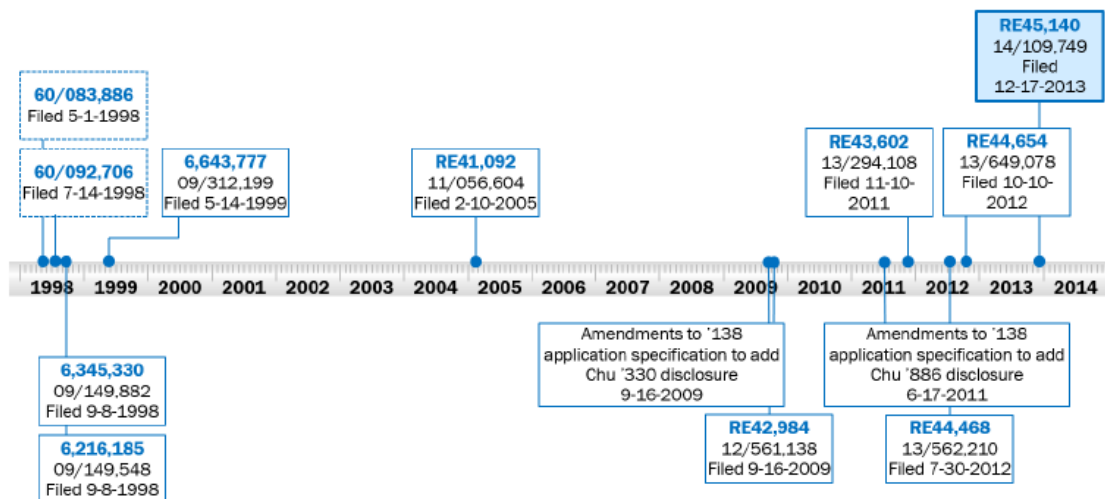
## **II. PROSECUTION BACKGROUND OF THE '140 PATENT**

The '140 patent was filed as U.S. Pat. App. No. 14/109,749 on December 17, 2013. The '140 patent is one of several reissue patents of U.S. Pat. No.

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<sup>6</sup> *ACQIS LLC v. Lenovo Group Ltd.*, Case No. 6-20-cv-00967-ADA (W.D. Tex.).

6,643,777 (the “’777 patent”). The ’140 patent is a continuation reissue that claims priority through a series of four preceding reissue applications going back to the ’777 patent, the application for which (the ’199 patent) was filed May 14, 1999, as shown in the timeline below.



Each application in the priority chain accurately identifies each prior application in the priority chain as required by 35 U.S.C. § 120 and incorporates such applications by reference.

Each application/patent in the priority chain utilizes the long-standing practice of incorporation by reference to incorporate material from the inventor's prior Patent Application No. 09/149,882. *See, e.g.*, EX1015 at 34; EX1014 at 30. This '882 application corresponds to the asserted reference, Chu '330. EX1003 at 1. Petitioner does not dispute that Chu '330 is properly incorporated by reference.

During prosecution of the '138 application<sup>7</sup>, one of the applications in the '140 patent's priority chain, Patent Owner amended the specification of the '138 application to explicitly recite certain disclosure, verbatim, from Chu '886, to which Chu '330 claimed priority, and which was incorporated by reference in Chu '330.<sup>8</sup> EX1009 at 345-346. Specifically, on June 17, 2011, Patent Owner submitted an Amendment to explicitly include Figures 8 and 9 from Chu '886 (as Figures 19 and 20) and the corresponding description of those figures. *Id.* at 363. The remarks accompanying this preliminary amendment explain that Figures 19 and 20 are from Chu '886, and directed the examiner to the incorporation by reference of Chu '886 into Chu '330. *Id.* The examiner did not object to the amendment as containing new matter or reject the claims based on the inclusion of new matter under M.P.E.P. §1453. *See id.* at 446 (notice of allowance following

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<sup>7</sup> Referred to by Petitioner by the Reissue Patent Number 42,984 (the "RE984"), but to be consistent across multiple IPR proceedings, it is referred to as the '138 application here. *See* Pet. at 21; EX1009 (referred to by Petitioner as "RE984 FH").

<sup>8</sup> Like the '140 patent, the '138 application also explicitly incorporated by reference Chu '330, which in turn incorporated by reference Chu '886. EX1009 at 25.

amendments). Following the amendments—including the June 17, 2011 amendment—approved and entered during prosecution of the '138 application, each subsequent application in the '140 patent's priority chain was amended to include the same figures and disclosure added by amendments in the '138 application and in each case approved by the Examiner. For the '140 patent, the Examiner had another chance to review the amendments, when the same amendments were entered via preliminary amendment, and were once again approved and entered by the Examiner. EX1006 at 145; *see also id.* at 201-204 (non-final rejection containing no new matter rejection).

### **III. CLAIM CONSTRUCTION**

Patent Owner does not believe that any claim terms require express construction to deny the Petition. Accordingly, the claims should be given their ordinary and customary meaning in light of the specification and prosecution history, as understood by a person of ordinary skill in the art. 37 C.F.R. § 42.100(b); *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005).

### **IV. LEGAL STANDARD**

The Board may not institute an *inter partes* review unless the Petition demonstrates that there is a reasonable likelihood that the petition would prevail with respect to at least one of the claims challenged in the petition.

35 U.S.C. § 314(a). The Petitioner bears the burden to prove that the references



relied on qualify as prior art. *Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 772 (Fed. Cir. 2018).

**V. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION UNDER §325(d)**

The USPTO has already considered and rejected Petitioner’s argument multiple times – during examination and, critically, by the Board just weeks ago. The Board should deny the Petition under 35 U.S.C. § 325(d) based on the two separate examiners’ rejection, and the Board’s rejection, of Petitioner’s arguments here.

Section 325(d) provides that “[i]n determining whether to institute or order a proceeding . . . the Director may take into account whether, and reject the petition or request because, the same or substantially the same . . . arguments previously were presented to the Office.” 35 U.S.C. § 325(d); *see also Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17-18 (PTAB Dec. 15, 2017) (precedential as to Section III.C.5, first paragraph); *Advanced Bionics, LLC v. Med-el Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, at 8-9 (PTAB Feb. 13, 2020) (precedential, designated March 24, 2020) (“Thus, under § 325(d), the Board uses the following two-part framework: (1) . . . whether the same or substantially the same arguments previously were presented to the Office; and (2) . . . whether the petitioner has demonstrated that the Office erred in a manner

material to the patentability of challenged claims.”). The Board has previously exercised its discretion under § 325(d) to deny institution where, as here, the examiner previously considered and affirmed the efficacy of an incorporation by reference in the context of a priority claim. *SMR Auto. Sys. USA, Inc. v. Magna Mirrors of Am., Inc.*, IPR2018-00931, Paper 7 at 14 (PTAB Sept. 14, 2018).

**A. The Same or Substantially the Same Arguments were Previously Presented to the Office**

**1. The Examination Division of the Office Has Already Twice Considered and Rejected Petitioner’s Argument**

When the disclosure from Chu ’886 was added to the ’138 application, Patent Owner specifically directed the examiner to the transmittal form as support for the amendment:

Background and Specification

The subject application is a continuation reissue application, for the reissue of original U.S. Patent No. 6,643,777 (the “’777 patent”). At col. 5, lines 9-13, the ’777 patent incorporated by reference U.S. Application No. 09/149,882, now issued as U.S. Patent No. 6,345,330 (the “’330 patent”), which, in turn, claimed the benefit of and incorporated by reference U.S. Provisional Application No. 60/083,886 (the “’886 provisional application”) (See checked incorporation by reference box in utility patent application transmittal of U.S. Application No. 09/149,882 filed on September 8, 1998). By this paper, the subject application is amended to specifically include certain figures and text from the ’330 patent, as well as certain figures and

EX1009 at 363 (emphasis added). The examiner did not object to the inclusion of the amendment as new matter or issue a rejection under § 112. *Id.* at 446. The same amendments first presented and approved by the examiner in the ’138

application, were entered via a preliminary amendment in the '140 Patent, with the Patent Owner again highlighting the same incorporation by reference in the transmittal. EX1006 at 145. Again, the amendments were approved and entered by the Examiner as they did not contain new matter. *Id.* at 201-204.

In addition to the reissue examiner considering the amendments, ***two other examiners*** have also considered and rejected Petitioner's argument. Patent Owner entered a similar amendment while prosecuting U.S. App. No. 13/087,912, as part of a separate priority chain, again directing the examiner to the transmittal letter submitted with Chu '330. EX2001 at 26. And again the examiner (different from the examiner of the '138 application) allowed the amendment without objection. *See id.* at 311-320 (non-final office action issued after entry of amendment adding figures and disclosure from Chu '886 containing no new matter or § 112 rejections). Thus, the Office has at least three separate rejected the Petitioner's argument, and Patent Owner is entitled to an "especially weighty presumption" that Chu '886 is properly incorporated by reference in Chu '330. *Commonwealth Sci. & Indus. Rsch. Organisation v. Buffalo Tech. (USA), Inc.*, 542 F.3d 1363, 1380 (Fed. Cir. 2008) (quoting *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1574-75 (Fed. Cir. 1992)).

In its cursory dismissal of the Section 325(d) framework (Pet. at 117–118), Petitioner attempts to sidestep the prior consideration and rejection by the

examiner by focusing only on the examination of the application that issued as the '140 Patent. The proper time for analyzing the incorporation by reference issue was at the time the figures and description were actually added to the priority family, and Figures 19 and 20 were first added during examination of the '138 application. *See* M.P.E.P. § 608.04, 8th Ed. Rev. 7 (July 2008) (“When new matter is introduced into the specification, the amendment should be objected to under 35 U.S.C. 132 (35 U.S.C. 251 if a reissue application) and a requirement made to cancel the new matter. The subject matter which is considered to be new matter must be clearly identified by the examiner.”); *see id.* § 1411.02 (“New matter, that is, matter not present in the patent sought to be reissued, is excluded from a reissue application in accordance with 35 U.S.C. 251. The claims in the reissue application must be for subject matter which the applicant had the right to claim in the original patent. Any change in the patent made via the reissue application should be checked to ensure that it does not introduce new matter.”). The argument raised by Petitioner now had already been considered and rejected during the earlier prosecution of the '138 application and again during examination of the '140 application during pendency.

## **2. The Board Has Already Considered and Rejected the Central, Necessary Argument in the Petition**

The Petition survives or perishes at the institution phase on the strength of the argument that “[t]he amendments that introduced Figures 19-20 and associated disclosure to RE984 added new matter, because none of RE984’s parent applications properly incorporated by reference the ’886 Provisional.” Pet. at 23. But the Board has already considered and rejected the substantive merits of this *exact same issue* presented in IPR2021-00607: “Petitioner argues that ‘Chu ’886 was not properly incorporated by reference into the ’140 Patent family, and the earliest priority date to which the claims relying on the Chu ’886 disclosure are entitled is November 10, 2011.’ ...Petitioner also argues that ‘the Examiner erred by not realizing that Chu ’330 and Chu ’886 qualify as 35 U.S.C. § 102(b) prior art and are material to the patentability of the claims in the ’140 Patent.’” *Samsung Electronics Co., Ltd., v. ACQIS LLC*, IPR2021-00607, Paper 7 at 6 (PTAB October 7, 2021); *see also Samsung Electronics Co., Ltd., et al. v. ACQIS LLC*, IPR2021-00604, Paper 7 at 6 (PTAB August 9, 2021); *Samsung Electronics Co., Ltd., et al. v. ACQIS LLC*, IPR2021-00605, Paper 7 at 8–9 (PTAB August 23, 2021); *Samsung Electronics Co., Ltd., et al. v. ACQIS LLC*, IPR2021-00606, Paper 7 at 6 (PTAB August 25, 2021). In that proceeding, the Board explained that “the examiner considering the ’138 application did not object to the inclusion of the

amendments as new matter or issue a rejection under 35 U.S.C. § 112, ¶ 1.”

*Samsung Electronics Co., Ltd., et al. v. ACQIS LLC*, IPR2021-00607, Paper 7 at 11 (PTAB October 8, 2021). “Instead, the Examiner entered the amendments and subsequently allowed the ’138 application with the subject matter added from Chu ’886.” *Id.* The Board determined that “Petitioner has not sufficiently shown that the ’777 patent and the applications in the ’140 patent’s priority chain did not properly incorporate by reference Chu ’330 and Chu ’886, or that the Examiner erred in entering the amendments that added the subject matter from Chu ’886 to the ’138 application.” *Id.* at 21. “As such, we are not persuaded by Petitioner’s argument that the earliest possible priority date for the challenged claims of the ’140 patent is November 10, 2011.” *Id.* The Board exercised its discretion to deny institution based on the examiner’s previous consideration of the issue during prosecution. *Id.* at 22. In addition, the Board in IPR2021-00604, IPR2021-00605, and IPR2021-00606 exercised its discretion to deny institution in those proceedings based on the examiner’s previous consideration of the incorporation by reference issue during prosecution of Patent Owner’s ’912 application. *See Samsung Electronics Co., Ltd., et al. v. ACQIS LLC*, IPR2021-00604, Paper 7 at 21 (PTAB August 9, 2021); *Samsung Electronics Co., Ltd., et al. v. ACQIS LLC*, IPR2021-00605, Paper 7 at 27 (PTAB August 23, 2021); *Samsung Electronics Co., Ltd., et al. v. ACQIS LLC*, IPR2021-00606, Paper 7 at 21 (PTAB August 25, 2021).

Thus, the USPTO has already considered and rejected, on multiple, separate occasions, the same or substantially the same arguments as those presented by Petitioner here. The first part of the *Advanced Bionics* framework is satisfied many times over.

**B. Petitioner has Not Demonstrated that the Office Erred in a Manner Material to Patentability**

Petitioner attempts to sidestep the Office's repeated rejections of its argument by incorrectly reframing the argument: the only alleged error identified by Petitioner is that the wrong standard of review was applied when evaluating an incorporation by reference. Pet. at 25 n.4. This is not an error because, the Patent Owner complied with the M.P.E.P. requirements for incorporation by reference at the time of prosecution. As the Board in IPR2021-00607, and in IPR2021-00604, IPR2021-00605, and IPR2021-00606, expressly recognized and applied, the correct standard for evaluating the sufficiency of the incorporation by reference during prosecution is the reasonable examiner standard. *See Samsung Electronics Co., Ltd., et al. v. ACQIS LLC*, IPR2021-00607, Paper 7 at 16 (PTAB October 8, 2021). Moreover, the issued '140 patent (that is, the one that would be looked at by a POSITA) indisputably contains Figures 19-20 and the associated disclosures within "the four corners" of the specification and thus has no written description issue or need to rely on incorporation by reference. *See* Pet. at 28 n.6 (citing

*Hollmer v. Harari*, 681 F.3d 1351, 1358 (Fed. Cir. 2012) (“The incorporation by reference analysis, therefore, is similarly constrained by the four corners of the application.”).)

For these reasons and the reasons discussed below in Section VI.b., Petitioner has not demonstrated that the USPTO erred in a manner material to patentability in any of the instances where the USPTO considered the same argument. *See Advanced Bionics, LLC v. Med-el Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, at 9 (PTAB Feb. 13, 2020) (“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.”).

## **VI. THE PETITION FAILS TO DEMONSTRATE A REASONABLE LIKELIHOOD OF PREVAILING ON ANY ASSERTED GROUND**

The Petition fails to demonstrate a reasonable likelihood of success because none of the asserted references qualifies as prior art. As already decided multiple times by the Office (including the Board), the ’140 Patent is entitled to at least a priority date of May 14, 1999. Petitioner asserts that Chu ’330 is prior art as issued in February 5, 2002, and U.S. Patent Application No. 2003/0135771 as of July 17, 2003, both of which are after May 14, 1999. Pet. at 9-10. Because none of the



asserted references is prior art in relation to this priority date, the Petition is not supported by any actual *prior* art, and institution should be denied.

**A. The Amendments to the '138 Application**

As an initial matter, solely for purposes of its Petition, Petitioner concedes that Figures 19-20, and the corresponding disclosure, found at column 19, lines 8-13 in the '140 patent, provide written description for all of the challenged limitations. Pet. at 20-22. The cited portion of the specification states:

FIG. 19 shows an attached computer module with integrated CPU/NB/Graphics 1915 and Integrated HICISB 1920. FIG. 20 shows an attached computer module with single chip 2025 fully integrated: CPU, Cache, Core Logic, Graphics controller and Interface controller.

EX1001 at 19:8-13.

When claims were added to the '138 application, Patent Owner submitted an amendment to explicitly set forth this material previously incorporated by reference (the allegedly “only arguable support”) in the specification.

The claims of the '138 application and the resulting U.S. Reissue Patent No. 42,984 are in sharp contrast to the claims of the applications and patents that preceded them in the priority chain. During prosecution of the '138 application, the claims were amended on June 17, 2011, to add limitations that had not appeared before in any claims in the priority chain. *See* EX1009 at 347-372. The new and amended '138 application claims included certain new limitations that are similar

to the limitation identified by the Petition, including limitations reciting a CPU “integrated” with other components, like a graphics controller/subsystem in a “single chip,” and “directly” connected to an LVDS channel. *See, e.g.*, EX1009 at 359 (June 17, 2011 Amendment, claim 66 (“The system of claim 20, wherein the central processing unit and the interface controller are integrated in a single chip.”), claim 67 (“The system of claim 66, wherein the central processing unit comprises a graphics subsystem in the single chip.”)); *see also id.* at 368 (explaining new claims 66, 67).

With these amendments and additions to the claims of ’138 application, the correct procedure, and the procedure followed by Patent Owner, was to amend the specification to explicitly set forth the material previously incorporated by reference. 37 C.F.R. § 1.57 (g) (2007). Specifically, the version of § 1.57 in effect when the ’138 application was filed provided:

(g) An incorporation of material by reference that does not comply with paragraphs (b), (c), or (d) of this section is not effective to incorporate such material ***unless corrected*** within any time period set by the Office, but in no case later than the close of prosecution as defined by § 1.114(b), or abandonment of the application, whichever occurs earlier.

37 C.F.R. § 1.57(g) (2007) (emphasis added). Similarly, the version of M.P.E.P. § 608.01(p) in effect when the ’138 application was filed provided:

An incorporation by reference of essential material to an unpublished U.S. patent application, a foreign application or

patent, or to a publication is improper under 37 C.F.R. § 1.57(c). The improper incorporation by reference is not effective to incorporate the material ***unless corrected by the applicant*** (37 C.F.R. § 1.57(g)). Any underlying objection or rejection (e.g., under 35 U.S.C. § 112) should be made by the examiner ***until applicant corrects the improper incorporation by reference by submitting an amendment to amend the specification or drawings to include the material incorporated by reference.***

M.P.E.P. § 608.01(p), 8th Ed. Rev. 7 (July 2008) (emphases added); *see also id.* at Example 2 (expressly permitting applicants to amend the specification to support newly essential material). Thus, both § 1.57 and the M.P.E.P. allow an applicant to amend the specification to specifically include the previously non-essential disclosures incorporated by reference where those disclosures became essential due to claim amendments.

Patent Owner was proactive in complying with both § 1.57 and the M.P.E.P. When new claims were added in the '138 application, Patent Owner amended the specification to explicitly recite any arguably essential material, exactly as the M.P.E.P. prescribes. Unsurprisingly, the examiner allowed these routine amendments of the patent specification after the Patent Owner validly stated that they were not new matter because they were previously incorporated into the patent specification by reference.

**B. Chu '330 Properly Incorporated By Reference Chu '886**

The Petition contends that Chu '330 failed to properly incorporate by reference Chu '886. Petitioner is wrong.

When the application that issued as Chu '330 was filed, Patent Owner submitted a transmittal form with the application that expressly indicated “the entire disclosure of the prior application . . . is considered as being part of the disclosure of the accompanying application and is hereby incorporated by reference therein.” EX1011 at 79. These prior applications, U.S. Provisional Application No. 60/083,886 (*i.e.* Chu '886) and U.S. Provisional Application No. 60/092,706, were *specifically identified* on the face of Chu '330 with the application papers as-filed. EX1011 at 83. Specifically, the specification as-filed expressly identified Chu '886 and the '706 applications by serial number, which allowed these two applications to be identified during intake processing at the USPTO (even before hitting the examiner’s desk) as “continuing domestic data” including “provisional application no. 60/086,886.” EX1011 at 78.

The Petition asserts that the checked box on the transmittal does not “identify” Chu '886 and that the Box 5 selection was ineffective because Box 4b was not also checked. Pet. at 26-28. These arguments ignore standard examination

practice and M.P.E.P. procedure in utilizing application transmittal forms for incorporation by reference and place form over function.<sup>9</sup>

The version of the M.P.E.P. in effect at the time Chu '330 was filed stated “an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are ‘hereby incorporated herein by reference.’ The statement may appear in the specification *or in the application transmittal letter.*” M.P.E.P. § 201.06(c), 7th Ed. (July 1998) (emphasis added). That is exactly what Patent Owner did here. Patent Owner specifically identified the prior filed applications in the specification and informed the examiner that “the entire

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<sup>9</sup> “Procedural lapses during examination, should they occur, do not provide grounds of invalidity. Absent proof of inequitable conduct, the examiner’s or the applicant’s absolute compliance with the internal rules of patent examination becomes irrelevant after the patent has issued.” *Aristocrat Techs. Australia PTY Ltd. v. Int’l Game Tech.*, 543 F.3d 657, 663 (Fed. Cir. 2008) (quoting *Magnivision, Inc. v. Bonneau Co.*, 115 F.3d 956, 960 (Fed. Cir. 1997)). Failure to check one of two related boxes is the epitome of an inconsequential “procedural lapse.” The Petition does not identify any case in which failure to check a box on a transmittal form resulted in invalidation of a patent.

disclosure of the prior application . . . is hereby incorporated by reference . . . .”

EX1011 at 79. Thus, Chu ’330’s transmittal letter was effective to incorporate Chu ’886 by reference under the applicable rules at the time, particularly in view of the statement in the Chu ’330 specification that “[t]his application claims any and all benefits as provided by law of U.S. Provisional Application No. 60/083,886 [Chu ’886], filed May 1, 1998 . . . .” EX1003 at 60. Notably, both the right to claim priority and the ability to incorporate other documents by reference are “benefits provided by law.” 35 U.S.C. §119(e) (priority benefit via a provisional application); *Advanced Display Sys. v. Kent State Univ.*, 212 F.3d 1272, 1282-83 (Fed. Cir. 2000) (detailing the common law basis for the practice of incorporation by reference); 69 Fed. Reg. 56482, 56498 (Sept. 21, 2004) (discussing 37 CFR 1.57 (2005) as “codifying the incorporation by reference practice as set forth in [the] MPEP. . .”); 37 CFR 1.57 (2005) (codification of the incorporation by reference doctrine).

The Petition further argues that Chu ’330’s incorporation by reference of Chu ’886 was ineffective because Chu ’330 was not a continuation or divisional application of Chu ’886. Pet. at 27 n.5. Again, the Petition cites no case in support of this argument. In *Pregis Corp. v. Doll*, the U.S. District Court for the Eastern District of Virginia found that a continuation-in-part application’s incorporation by reference in the transmittal letter of a provisional patent application and a parent

patent was effective. 698 F. Supp. 2d 584, 598-99 (E.D. Va. Mar. 16, 2010). The fact that the patent at issue was not a continuation or divisional of either of the incorporated applications did not factor into whether the incorporation by reference was effective. *Id.* Rather, the court found that “this letter indicates that [the relevant figures] were part of the information disclosed when the applicants filed the . . . [a]pplication.” *Id.*

The Court in *Pregis* was correct to reject a naked attempt to exploit a formalistic non-issue to invalidate a property right issued by the Patent Office, and the Board should follow the same course. *Aristocrat Techs.*, 543 F.3d at 663 (“Absent proof of inequitable conduct, the . . . applicant’s absolute compliance with the internal rules of patent examination becomes irrelevant after the patent has issued.”). Thus, Chu ’330’s application transmittal form, as well as the reference to Chu ’886 in the Chu ’330 specification, was effective to incorporate by reference Chu ’886, and Chu ’886 is “part of the information disclosed” in Chu ’330.

*Samsung Electronics Co., Ltd., et al. v. ACQIS LLC*, IPR2021-00607, Paper 7 at 21 (PTAB October 8, 2021) (“Petitioner has not shown sufficiently that the ’777 patent and the applications in the ’140 patent’s priority chain did not properly incorporate by reference Chu ’330 and Chu ’886, or that the examiner erred in entering the amendments that added the subject matter from Chu ’886 to the ’138 application.”).

Petitioner admits, as it has to, that the specification of Chu '330 precisely identified Chu '886. Pet. at 23. Thus, Chu '886 was clearly identifiable within the “four corners” of the specification of Chu '330, even without reference to the transmittal form. EX1011 at 78, 347 (showing an internal information sheet used by the USPTO at intake and filing receipt both confirming identification of Chu '886). *Cf. Hollmer*, 681 F.3d at 1358 (*Harari II*) (the language on the face of the applications did not specifically identify an application and the description provided could be used to describe several different applications). By not addressing the reasonable examiner standard beyond dismissing the same in a footnote, Petitioner apparently concedes that a reasonable examiner would recognize Chu '330's incorporation by reference of Chu '886 when filed (as two separate examiners certainly did). *See* Pet. at 25 n.4.

In an attempt to disguise its argument as a new one, Petitioner asserts, in a footnote, that a POSITA standard (rather than a reasonable examiner standard) now applies to the assessment because the '912 application and/or Chu '330 eventually issued as patents. *See* Pet. at 25 n.4. But as the Board in IPR2021-000607 has already confirmed just a few weeks ago, the correct standard here is the reasonable examiner standard. *Samsung Electronics Co., Ltd., et al. v. ACQIS*



*LLC*, IPR2021-00607, Paper 7 at 16 (PTAB October 8, 2021).<sup>10</sup> *See also* M.P.E.P. § 1445, 8th Ed. Rev. 7 (July 2008) (“As stated in 37 CFR 1.176, a reissue application, including all the claims therein, is subject to ‘be examined in the same manner as a non-reissue, nonprovisional application.’ Accordingly, the claims in a reissue application are subject to any and all rejections which the examiner deems appropriate.”).

Petitioner latches on to the “narrow circumstances” soundbite in *Harari II*, but does not actually apply the Federal Circuit’s reasoning in that case. *See* Pet. at 25 n.4. In *Harari II*, the Federal Circuit explained that “[q]uestions surrounding incorporation by reference statements do not arise in isolation but instead generally manifest as an initial hurdle that first must be crossed before reaching an underlying issue” and “[i]t is this underlying issue that provides the framework for resolving the incorporation by reference question.” *Hollmer*, 681 F.3d at 1357; *see also id.* at 1353 n. 2. (“Because *Harari I* did ‘not involve an issued patent or

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<sup>10</sup> *See also Samsung Electronics Co., Ltd., et al. v. ACQIS LLC*, IPR2021-00604, Paper 7 at 16 (PTAB August 9, 2021) (same); *Samsung Electronics Co., Ltd., et al. v. ACQIS LLC*, IPR2021-00605, Paper 7 at 22 (PTAB August 23, 2021) (same); *Samsung Electronics Co., Ltd., et al. v. ACQIS LLC*, IPR2021-00606, Paper 7 at 16 (PTAB August 25, 2021) (same).

language that is intended to appear in an issued patent,’ we held that the proper inquiry focused on the reasonable examiner, not the person of ordinary skill.”)

Here, the “underlying issue” was whether Patent Owner could amend the specification of the ’138 application to add disclosure from Chu ’886. That necessarily required the examiner to determine whether or not the ’138 application properly incorporated Chu ’886. If the answer was no, the examiner would have issued a new matter rejection. This “underlying issue” is one for a reasonable examiner and was in fact considered by two separate examiners at the time.

EX1009 at 363, 446; EX1006 at 145; EX2001 at 26, 311-320.

The cases cited by Petitioner are inapposite, as the “underlying issues” in those cases actually implicate the understanding of one of ordinary skill. *See, e.g., Advanced Display Sys. v. Kent State Univ.*, 212 F.3d 1272 (Fed. Cir. 2000) (evaluating incorporation by reference for purposes of an anticipation invalidity argument).<sup>11</sup> In *Harari II*, where the POSITA standard applied, the “underlying

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<sup>11</sup> *In re Seversky* is distinguishable as well. *See* 474 F. 2d 671 (C.C.P.A. 1973). In that case, the relevant subject matter was present in a grandparent application but not the parent application, and the *only* reference to the grandparent application in the parent application was that the parent application was a *continuation-in-part* (not a continuation) of the grandparent). *Id.* at 674.

issue” was “the intervening ’838 and ’797 applications—*which never were amended*—in the context of the § 120 priority analysis.” (emphasis added).

*Holmer*, 681 F.3d at 1356. In contrast, in *Harari I*, where the reasonable examiner standard applied, the “underlying issue” was “the language of the ’880 application *viewed in light of the preliminary amendment and accompanying transmittal sheet.*” *Id.* Petitioner’s bald claim about the “correct” standard is inconsistent with the Federal Circuit’s reasoning in *Harari II* and the Board’s recent decisions in IPR2021-000604, IPR2021-00605, IPR2021-00606, and IPR2021-00607.

For the purposes of this Petition, Petitioners do not argue (nor could they) that the ’138 application or the ’140 patent (as issued) lack written description—a POSITA would find Figures 19-20 and the associated disclosures within the “four corners” of the specifications. *See* Pet. at 28 n.6 (citing *Hollmer*, 681 F.3d, 1358 (“The incorporation by reference analysis, therefore, is similarly constrained by the four corners of the application.”)). That is, contrary to *Harari II*, the ’140 patent *was amended* to include information incorporated by reference. Compare this with *Harari II* in which the applications at issue were *not amended* to include information incorporated by reference *or* specific reference to applications incorporated by reference, and “[s]uch ambiguity in incorporation does not suffice.” 681 F.3d at 1358. Petitioner is grasping at straws to revive a previously rejected argument by identifying any potential error in the Office’s previous

treatments of the issue. Petitioner is incorrect: the correct standard is from the perspective of a reasonable examiner.

Even if the Board accepted Petitioner's argument that the person of ordinary skill in the art standard applies to an amendment during examination, the specific reference to Chu '886 on the face of Chu '330 would be sufficient to identify Chu '886 to a POSITA. A POSITA is understood to look to the file history of the patent that eventually issues from the application, including any transmittal forms. *See Phillips*, 415 F.3d at 1313. A patent is to be understood from the perspective of a POSITA at the time of invention, and for this reason courts look to "those sources available to the public that show what a person of skill in the art would have understood" about the disclosed invention. *Id.* at 1314. This includes the prosecution history of the patent, which is "the complete record of the proceedings before the PTO . . . [and] provides evidence of how the PTO and the inventor understood the patent." *Id.* at 1317.

Because Chu '330 incorporated Chu '886 by reference, and the '199 application incorporated Chu '330 by reference, both Chu '330 and Chu '886 are part of the original disclosure of the '199 application. *Telemac Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d 1316, 1329 (Fed. Cir. 2001) ("When a document is 'incorporated by reference' into a host document, such as a patent, the referenced document becomes effectively part of the host document as if it were explicitly

contained therein.”). Thus, the ’199 application, and every subsequent application in the priority chain, may rely on Chu ’330 and Chu ’886 to satisfy the written description requirement, consistent with the examiner’s conclusion during prosecution of the ’138 application.

**C. None of the Asserted References Qualifies as Prior Art**

It is undisputed for purposes of this Petition that Chu ’886 provides adequate written description for the challenged terms. The Petition admits as much. Pet. at 20-22. Because Chu ’886 provides written description for the challenged limitations, and every patent in the ’140 patent’s priority chain properly incorporated Chu ’886 by reference through Chu ’330, the challenged claims are entitled to a priority date of no later than May 14, 1999, the filing date of the ’199 application. *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306 (Fed. Cir. 2008) (explaining that a patent application is entitled to the benefit of the filing date of an earlier filed application if the disclosure of the earlier application provides support for the claims of the later application). This date is earlier than the alleged prior art date of each of the asserted references. *See* Pet. at 9–10 (alleging that Chu ’330 is available as prior art as of February 5, 2002, and that Cupps is available as prior art as of July 17, 2003). Because the ’199 application antedates all of the asserted references, none of the asserted references qualifies as prior art

to the '140 patent, and the Petition should be denied. *NetApp, Inc. v. KOM Software, Inc.*, IPR2019-00605, Paper 10 at 17 (PTAB Sept. 9, 2019).

## **VII. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION UNDER §314**

35 U.S.C. § 314(a) gives the Board discretion to deny institution in view of parallel district court proceedings on the same patent. *See NHK Spring Co. v. Intriplex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019). The Board analyzes six non-exclusive factors for determining whether discretionary denial is appropriate (the “*Fintiv* factors”). *See Apple Inc., v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (PTAB Mar. 20, 2020) (precedential, designated May 5, 2020) (hereinafter cited as “*Fintiv*”). Because *each of the six factors* favors denial of the Petition, the Board should deny the Petition.

### **1. Factor 1: No Stay Has Issued, Petitioner Has Not Sought Stay in View of its Petition, and the Court is Unlikely to Stay the Parallel Litigation**

The first factor weighs against institution. The Lenovo defendants, RPIs in this proceeding (“RPI Lenovo Defendants”), are accused of infringement in a parallel district court proceeding before Judge Albright of the Western District of Texas, *ACQIS LLC v. Lenovo Group Ltd.*, Case No. 6:20-cv-00967-ADA. The RPI Lenovo Defendants have not moved for a stay in view of this Petition. Petitioner is

not a party to that case and cannot move for a stay. Petitioner offers no evidence that the district court proceeding or any related cases would be stayed if this IPR is instituted.

As discussed above, the Board has considered and denied the IPR petition of a defendant in the Eastern District of Texas as to the '140 patent. For this reason, the court in that case denied a motion to stay in view of the now-denied IPR petition to review the '140 patent and that case will proceed toward trial.<sup>12</sup> No defendant in either the Eastern or Western District of Texas cases has moved to stay its litigation pending the Board's institution decision in this proceeding.

The '140 patent is asserted by ACQIS in five cases before Judge Albright in the Western District of Texas ("WDTX cases"), including the case against real parties in interest in this proceeding. Judge Albright, on similar procedural schedules across those five cases, has scheduled the trial on the infringement of the '140 patent beginning December 12, 2022. *See* EX2002 (WDTX Scheduling

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<sup>12</sup> *See ACQIS LLC v. Samsung Elecs. Co. Ltd., et al.*, Case No. 2:20-cv-00295-JRG (E.D. Tex.), Dkt. 97 (October 12, 2021 order denying motion to stay where "the PTAB denied all ten petitions for IPR regarding" Patent Owner's "U.S. Patent Nos. 9,529,768 ("768 Patent"), 8,977,797 ("797 Patent"), 9,703,750 ("750 Patent"), RE44,654 ("654 Patent"), and RE45,140 ("140 Patent)").

Order) at 6. The institution decision in this matter is expected to be filed on or about January 20, 2022. By that time, the parties will have submitted all *Markman* briefing and conducted the *Markman* hearing, the parties will have served their final infringement and invalidity contentions, and approximately three of the seven months appointed for fact discovery will have elapsed. *See id.* at 3-4. Petitioner provides no reason to believe that Judge Albright would stay a case at this procedural posture, and no defendant in the cases moved for such relief.

Judge Albright's prior disposition of such motions strongly indicates he would not grant such a motion, and this may well be why the defendants in the WDTX cases have not moved for this relief. For example, in *Multimedia Content Mgmt. LLC v. Dish Network*, Judge Albright denied a motion to stay the litigation in view of two IPR petitions where the court had already conducted *Markman* proceedings, fact discovery had not yet started, and the scheduled trial date preceded the Final Written decision deadline. *See* No. 6:18-CV-00207-ADA, 2019 U.S. Dist. LEXIS 236670, \*4-\*7 (W.D. Tex. May 30, 2019). The facts in this situation are at least as unfavorable for a stay for the same reasons.

Because there is no reason to believe that Judge Albright will stay any of the WDTX cases, and because the Eastern District of Texas case will not be stayed following the prior, unsuccessful petitions for IPR of the '140 patent, this factor weighs against institution.



## **2. Factor 2: Trial Dates Precede the Board’s Statutory Deadline for a Final Written Decision**

The second factor weighs against institution. Trial in the parallel litigation is set to begin earlier than the Board’s statutory decision deadline. Trial in the WDTX cases is set to begin on December 12, 2022. *See* EX2002 at 6. The Order Governing Proceedings in the WDTX cases states that “[a]fter the trial date is set, the Court will not move the trial date except in extreme situations.” EX2006 at 6. The December 12, 2022 trial would begin before the Board’s deadline to issue its Final Written Decision. In exigent circumstances, trial may predate the Board’s deadline by as much as six months.<sup>13</sup> Thus, the trial date precedes the Board’s statutory decision deadline. The ’140 patent is also asserted in the Eastern District of Texas against Samsung. That trial will take place in February of 2022—more than 10 months before the Board’s statutory deadline to issue the Final Written Decision. *See* EX2003 at 1.

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<sup>13</sup> The Board is obligated to issue its institution decision within three months of receipt of this preliminary response and its Final Written Decision within a year of institution. 35 U.S.C. § 314(b); 35 U.S.C. § 316(1)(11). Because this preliminary response is filed on October 20, 2021, the Board’s final written decision (if instituted) is due no later than January 20, 2023.

“If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution . . .”. *Fintiv* at 9.<sup>14</sup> Petitioner’s argument on this factor improperly relies on the filing of this Petition – not the projected statutory deadline – relative to the trial date. *See* Pet. at 121. Moreover, Petitioner attempts to gloss over that

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<sup>14</sup> *Fintiv* factor 2, as originally decided, compares the “proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision.” *Id.* at 6. At the time *Fintiv* was decided, comparing the district court trial date to the projected statutory deadline for final written decision made sense because APJs had “the power to render a final decision on behalf of the United States without any such review by their nominal superior or any other principal officer in the Executive Branch.” *United States v. Arthrex, Inc.*, 141 S. Ct. 1970, 1981 (2021) (quotation and citation omitted). The Supreme Court’s decision in *Arthrex*, however, has changed when the inter partes review process becomes final. Now, “[d]ecisions by APJs must be subject to review by the Director.” *Id.* at 1986. To comply with the Supreme Court’s decision, *Fintiv* factor 2 must be updated to consider court’s trial date’s proximity to Director’s projected deadline for review. If review were to be instituted, after the issuance of a final written decision, the parties will then have an additional 30 days to request director review.

the trial date is in fact earlier than the projected statutory deadline by stating that, “RPIs’ trial date is estimated to *be approximately the same time* as the expected final written decision date.” *See id.* (emphasis added). This factor *favors* denial of institution.

### **3. Factor 3: Courts and Litigants Have Invested Significant Resources in Pending Litigation**

The third factor weighs against institution. Petitioner makes two key mistakes in concluding that this factor favors institution. Petitioner’s first mistake is performing its analysis from the time it filed its Petition. *See* Pet. at 121 (“The Petition is being filed at the early stages of the WDTX cases . . .”). But *Fintiv* requires the analysis to be performed from the perspective of “the time of the institution decision.” *Fintiv* at 9-10. “Specifically, if, at the time of the institution decision, the district court has issued substantive orders related to the patent at issue in the petition, this fact favors denial. Likewise, district court claim construction orders may indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial.” *Id.* This is likely to be the case in the parallel district court cases in which the ’140 patent is asserted.

All *Markman* briefing has been submitted in the EDTX cases and the court held its *Markman* hearing on August 24, 2021—more than four months before the Board’s institution deadline in this matter. EX2003 at 9. In the WDTX cases,

including the parallel litigation, the parties have finished briefing *Markman* issues, with the hearing to take place on November 8, 2021. *See* EX2002 at 3. Given the efficiency of Judge Albright in the Western District of Texas, that court's *Markman* order may well issue in the three months that will elapse before the Board's January 20, 2022 institution deadline.

Petitioner's second mistake is its substitution of the relevant inquiry—the *investment* of the court and the parties in the parallel proceeding (*see Fintiv* at 9-10)—for an analysis based on the *effect* that those efforts in the parallel proceedings might have on the IPR, if instituted. *See* Pet. at 121 (“because no claim terms need be construed for the purposes of the instant IPR, any investment in the parallel WDTX cases is expected to have little effect in the instant proceeding.”). Petitioner's improper focus is likely because, by the January 20, 2022 deadline to issue an institution decision in this matter, the EDTX cases in which the '140 patent is asserted will be less than two months from jury selection (*see* EX2003 at 1 (Samsung trial schedule)) and the WDTX cases will be well into discovery. By the institution decision deadline, the parties in the WDTX cases, including the parallel proceeding, will have completed jurisdictional discovery, *Markman* briefing and related oral argument, exchanged final infringement and invalidity contentions, and completed approximately three of the seven months appointed for fact discovery. *See* EX2002 at 3-4.

Accordingly, courts and litigants in the parallel proceedings in which the '140 patent is asserted will have made a substantial investment in their respective proceedings by “the time of the institution decision,” and which favors denying institution.

**4. Factor 4: There is Significant Overlap Between the Issues in the Parallel Litigation and Those Raised in the Petition**

This factor weighs against institution. *Finitiv* counsels that denial is favored where “the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding.” *Fintiv* at 12. Despite this targeted inquiry, Petitioner does not present the Board with any direct accounting of whether the combination of references and arguments in the Petition are also asserted in the parallel case or prior cases involving the '140 patent. *See* Pet. at 121–23. Petitioner opts, instead, to argue that it challenges more claims here than are challenged in the WDTX proceedings, and Petitioner speculates that denial of the Petition will “incentivize ACQIS to pursue these unchallenged claims against” the WDTX defendants. *See* Pet. at 122. Patent Owner responds to Petitioner’s omissions and arguments in turn.

The WDTX defendants advance the same priority date argument—that the examiner allegedly erred in entering the amendments that added the subject matter

from Chu '886 to the '138 application—in the parallel WDTX proceeding that Petitioners raise here.

As to Petitioner's argument that it challenges more claims in the Petition than are challenged in the parallel case, denial of review will not, as Petitioner nakedly argues, "incentivize ACQIS to pursue these unchallenged claims against" the RPI defendants at least because the Scheduling Order in the parallel proceeding does not allow Patent Owner to add any patent claims to its already-served preliminary infringement contentions without leave of court. *See* EX2006 at 8 n.8.

Petitioner's final argument is flawed on its face for two reasons. First, the WDTX cases' invalidity contentions are a joint invalidity contention, not one advanced solely by the RPI Lenovo Defendants. Thus, the Lenovo entities' willingness to stipulate, if effected, will not impact the invalidity arguments in the other pending WDTX cases. Second, even if each of the defendants in the WDTX cases joined the RPI Lenovo Defendants in the stipulation proffered by Petitioner, Chu '330 remains a backbone of the invalidity arguments presented in the EDTX cases against the '140 patent and other of Patent Owner's patents, and that case will go to trial in February, as much as ten months before the final written decision would be expected in this matter. *See* EX2004 at 3-4 (invalidity contentions from EDTX cases); EX2003 at 1 (scheduling order in Samsung case). Unlike in *VMware, Inc. v. Intellectual Ventures I LLC*, inaptly cited by Petitioner, the RPI

Lenovo Defendants’ purported willingness to stipulate in no way “mitigates any concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions.” IPR2020-00470, Paper 13 at 20 (PTAB Aug. 18, 2020). Again, this factor weighs against institution.

**5. Factor 5: The Petitioner is Closely Related to and Coordinating with the Lenovo Defendant RPIs, who are Parties in the Parallel Litigation**

This factor weighs against institution. Petitioner makes a single argument for Factor 5 – it is not a defendant in the WDTX cases, so it would go against Congressional intent to deny institution of its Petition. Pet. at 123. Petitioner’s argument is incorrect. Petitioner’s argument cites a footnote in the *Fintiv* decision found in discussion of factor 3. *Id.* That footnote, and the statement of Congress found therein, are unrelated to the application of factor 5. Rather, they discuss estoppel and the one-year time bar for parallel litigants, their real-parties-in-interest, and their privies. *See Fintiv* at 11 n.20. The same footnote directs the reader to factor 5 in instances where the Petitioner is not a party to the parallel litigation. *Id.*

Factor 5 does not ask, as Petitioner intimates, whether the defendant in the parallel litigation and the Petitioner are the same entity; instead, it analyzes whether “a petitioner **is unrelated to a defendant in an earlier court proceeding,**” and, if there is no relation, “the Board has weighed this fact against exercising

discretion to deny institution. . .”. *Fintiv* at 13-14 (emphases added). Here, there is no doubt that Petitioner and at least the RPI Lenovo Defendants in the parallel case are closely related:

- Petitioner has named the RPI Lenovo Defendants as RPIs<sup>15</sup> to its Petition (Pet. at 7);
- Petitioner makes representations to the Board on behalf of the RPI Lenovo Defendants (*id.* at 122);
- Petitioner is represented before the Board by Chris Dorman of Desmarais LLP (*id.* at 8); Mr. Dorman represents the RPI Lenovo Defendants in the parallel litigation (*see* EX2005 at 2 (PACER Docket Sheet for parallel litigation against RPI Lenovo Defendants)); and

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<sup>15</sup> The AIA requires a petitioner to name RPIs to advance the AIA’s estoppel provisions, which seek “to protect patent owners from harassment via successive petitions by the same **or related parties**, to prevent parties from having a ‘second bite at the apple,’ and to protect the integrity of both the USPTO and Federal Courts by assuring that all issues are promptly raised and vetted.” United States Patent and Trademark Office, Patent Trial and Appeal Board Consolidated Trial Practice Guide, 12 (Nov. 2019) (emphasis added). Petitioner’s decision to name the Lenovo defendants as RPIs is an admission of their relatedness to Petitioner vis-à-vis this proceeding.



- Intel has a manifest interest in preventing “ACQIS [from] pursu[ing] . . . claims against [] defendants” in the WDTX cases based in part on their use of Intel products, including RPI Defendants. *See* Pet. at 118, 122.

Where, as here, a Petitioner is closely related to a parallel district court defendant through sale of products implicated in parallel infringement litigation, and the defendant coordinated with Petitioner in its filing of the Petition,<sup>16</sup> the Board has found that *Fintiv* factor 5 counsels against institution. For example, in *Applied Materials, Inc. v. Demray, LLC*, IPR2021-00104, Paper 13 at 16 (PTAB May 11, 2021), the Board credited a patent owner’s arguments that parallel district court defendants were named RPIs of the petitioner and “have coordinated with Petitioner in filing this Petition.” In view of these facts and argument, the Board held, “[a]lthough Petitioner and the [] defendants are not ‘the same party,’ because Petitioner and the [] defendants are related, and because of the degree of involvement by the [] defendants in the preparation of the instant Petition, we find this factor weighs slightly in favor of exercising discretion to deny institution.”

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<sup>16</sup> It must be assumed that Petitioner coordinated with and received instructions to act on behalf of the RPI Lenovo Defendants before representing to the Board that the RPI Lenovo Defendants are willing to stipulate to waive defenses in the parallel litigation.

*Id.*<sup>17</sup> Accordingly, because of the close relationship and coordination between Petitioner and the RPI Lenovo Defendants, this factor weighs against institution.

**6. Factor 6: The Board Has Already Considered and Rejected the Substance of Petitioners' Invalidity Theory**

This factor also weighs against institution. Under factor 6, the Board considers other factors bearing on its discretionary determination. *Fintiv* at 14-16. The only explicit example of an analysis under this factor is the substantive strength of the grounds of the petition: the stronger the grounds, the more likely the factor favors institution. *Id.* But the Board has already analyzed the substance of

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<sup>17</sup> The Board takes the same pragmatic approach in applying the analogous *General Plastic* factors. “[O]ur application of the *General Plastic* factors is not limited solely to instances when multiple petitions are filed by the same petitioner. Rather, when different petitioners challenge the same patent, we consider any relationship between those petitioners when weighing the *General Plastic* factors.” *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11 at 2 (PTAB Apr. 2, 2019) (precedential); *see also id.* at 10 (denying institution where, as here, the parties have a supplier-customer relationship giving rise to the infringement litigation and, thus, “there is a significant relationship between Valve and HTC with respect to Patent Owner’s assertion of the ’934 patent.”)

the Petition arguments that the Chu '330 reference is prior art to the '140 patent because of alleged defective incorporation by reference. *See supra* Section V.A.2. The Board rejected this argument on its merits, finding insufficient evidence that the Chu '330 reference is prior art, and denied institution on that basis. *See id.* Thus, the Board has already found the merits of this argument to be too weak to merit institution. Factor 6 counsels for denial of the Petition.

Accordingly, all six *Fintiv* factors counsel for denial of the Petition, and the Board should exercise its discretion and deny the Petition.

## VIII. CONCLUSION

Because none of the references relied upon qualifies as prior art, because the examiner of the '138 application and the application that issued as the '140 patent and the Board in IPR2021-00607 already considered and rejected Petitioner's arguments, and because the *Fintiv* factors favor denial, the Petition for *inter partes* review should be denied.

Date: October 20, 2021

Respectfully Submitted,

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**CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATION**

I hereby certify that this Patent Owner's Preliminary Response complies with the word count limit, and contains less than 14,000 words in 14 point Times New Roman font as calculated by the word count feature Microsoft Office 2016, in compliance with 37 C.F.R. § 42.24(a)(1)(i). This word count is inclusive of all text and footnotes but not including a table of contents, a table of authorities, a certificate of service or word count, or appendix of exhibits or claim listing.

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**CERTIFICATE OF SERVICE**

I hereby certify that on this October 20, 2021, a copy of Patent Owner's Preliminary Response, including all accompanying attachments, appendices, and exhibits, has been served in its entirety via e-mail (as was consented to by Petitioner) on Petitioner at the following e-mail addresses:

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