

Case IPR2021-01103
U.S. Reissued Patent No. RE45,140

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION
Petitioner

v.

ACQIS LLC
Patent Owner

Case IPR2021-01103

U.S. Reissued Patent No. 45,140

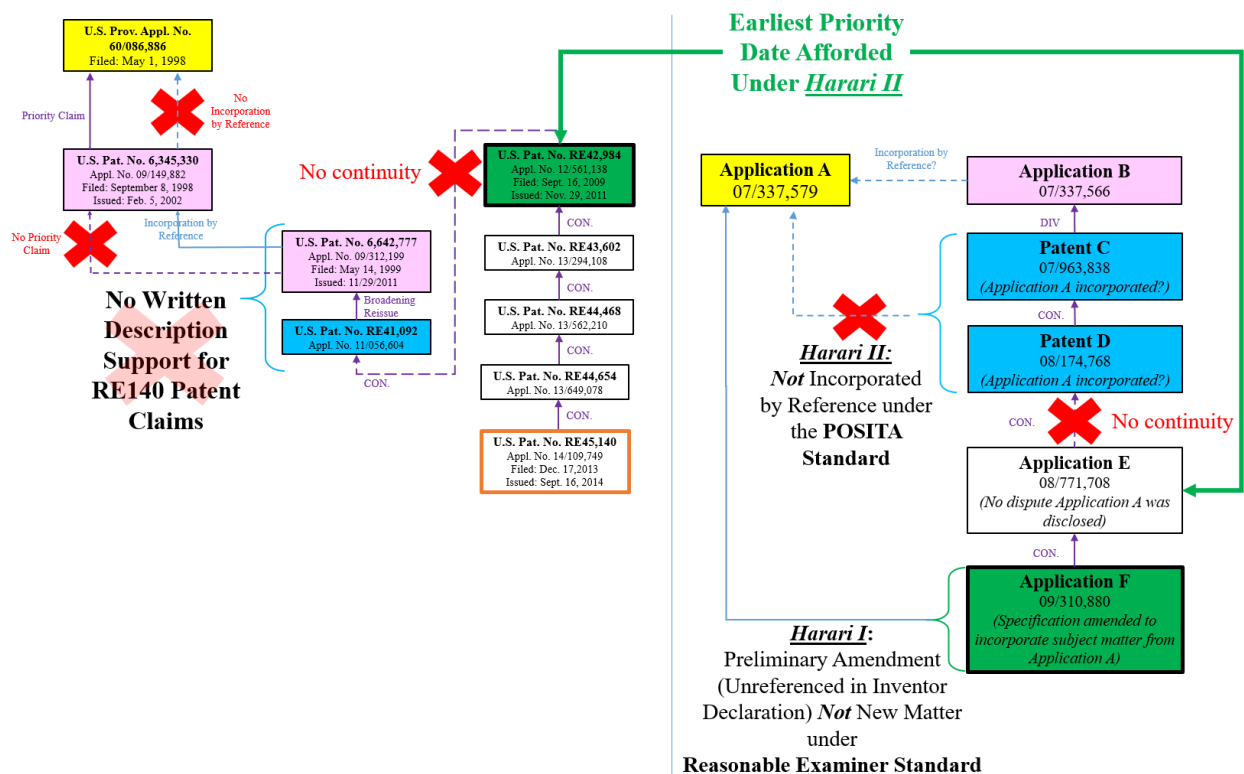
TITLE: DATA SECURITY METHOD AND DEVICE FOR COMPUTER
MODULES

Issue Date: September 16, 2014

PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY
RESPONSE TO PETITIONER'S PETITION FOR
INTER PARTES REVIEW

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U.S. Patent and Trademark Office
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Alexandria, VA 22313-1450

Fintiv Factor 6: PO, without even attempting to rebut the merits of the challenges raised by the Petitioner, argues that “the Board has already analyzed the substance of the Petition arguments that the Chu’330 reference is prior art ... because of [the] alleged defective incorporation by reference.” POPR, 44. That is inaccurate. The Board never considered whether the *RE984 Patent’s parent patents* (blue) incorporated by reference the ’886 Provisional under the proper **POSITA standard**.



In Samsung’s petitions, the Board analyzed whether the RE984 Patent (green) sufficiently incorporated the ’886 Provisional (yellow) under the *reasonable Examiner standard* to determine whether the subject matter added in the preliminary amendment, unreferenced in the inventor declaration, constituted new matter. See *Harari I* (*Harari v. Hollmer*, 602 F.3d 1348, 1352-54 (Fed. Cir. 2010)). That is *not*

the question presented in Intel's petition.

Intel's argument is whether "[t]he *RE984's Parent Applications* [blue] ... Incorporated By Reference the '886 Provisional [yellow]," Petition, 26, under the *POSITA standard* based on *Harari II* (*Hollmer v. Harari*, 681 F.3d 1351 (Fed. Cir. 2012)). *RE984 Patent's Parent Applications* (blue) (and even Chu330 (pink)) did not include any information about the '886 Provisional's (yellow) application number within the specification—just like *Harari II's* Patents C and D (blue). *Harari II* held that, *unlike a reasonable Examiner, a POSITA's analysis is "constrained by the four corners of the application."* *Harari II* at 1354, 1357; Petition, 28. And because Applications C and D (blue) did not clearly incorporate Application A (yellow) with language that "actually appear[s] within the specification," Application F (green) cannot claim priority to Application B (pink); indeed, "amendments in later applications cannot cure an otherwise defective application in a priority chain." *Harari II* at 1358. When amending the RE984 Patent on June 17, 2011 (green), ACQIS added subject matter (*e.g.*, Figures 19 and 20) not found in its parent patent (blue). Accordingly, none of the *RE984 Patent's parent application (blue)* (or even Chu330 (pink)) provide written description support for the challenged claims, and the Petitioner's references are therefore available as prior art. *See id.*, 20-31. *That* is the argument presented in Intel's petition.

Indeed, in an attempt to avoid disclaimer, ACQIS argued (for another asserted

patent family) that a parent “patent[] for which the *EMC* court found disclaimer do[es] not include **Figures 8A and 8B.**” Ex. 1025, 37; *see also id.*, 11, fn2, fn3.

Figures 8A and 8B in that family corresponds to **Figures 19 and 20** of RE984 (green), which is similarly not found in the parent RE092 (blue). *See* Ex. 1013.

Fintiv Factor 4: PO asserts that Lenovo’s “willingness to stipulate in no way ‘mitigates any concerns of duplicative efforts between the district court and the Board.’” POPR, 40. However, PO omits that, in addition to the explicit stipulation proffered in Defendant’s Preliminary Invalidity Contentions, Ex. 1023, 8, RPIs have served an expanded *Sotera*-type stipulation in the District Court. *See* Ex. 1024.

Fintiv Factor 2: PO ignores the fact that the Board may issue its institution decisions earlier. *See, e.g., Moen v. Kohler*, IPR2018-01053, Paper 7 (2018). Moreover, when overlap with the district court is minimized and/or the merits are strong (*see* Factors 4 and 6), the Board often institutes even if the trial date precedes the FWD date by several months. *See, e.g., Intel Corp. v. Health Discovery Corp.*, IPR2021-00552.

Finally, *Arthrex* did not “change[] when the inter partes review process becomes final.” POPR, fn14. There has always been a rehearing request process that could extend the IPR timeline. *See* 37 C.F.R. § 42.71(d). More importantly, it is the *statute* that determines finality. *See* 35 U.S.C. § 316(a)(11) (“requiring that the *final* determination in an [IPR] be issued not later than 1 year after ... institution...”). *See also id.*, § 319.

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Dated: November 2, 2021

Reply to POPR

Respectfully submitted,

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PETITIONER'S EXHIBIT LIST

Petitioner Exhibit No.	DESCRIPTION
1001	U.S. Reissued Patent No. 45,140 ("RE140")
1002	Declaration of Dr. Bill Lin
1003	U.S. Patent No. 6,345,330 ("Chu330")
1004	U.S. Patent Publication No. 2003/0135771 ("Cupps")
1005	U.S. Patent No. 6,216,185 ("Chu185")
1006	File history of RE140 ("RE140 FH")
1007	U.S. Patent No. 6,643,777 ("Chu777")
1008	U.S. Reissued Patent No. 42,984 ("RE984")
1009	File history of RE984 ("RE984 FH")
1010	U.S. Patent Application No. 60/083,886 ("886 Provisional")
1011	File history of Chu330 ("Chu330 FH")
1012	August 12, 2011 Amendment from File History of Control No. 90/010,816 (Reexamination of Chu185)
1013	U.S. Reissued Patent No. 41,092 ("RE092")
1014	U.S. Reissued Patent No. 43,602 ("RE602")
1015	U.S. Reissued Patent No. 44,468 ("RE468")
1016	U.S. Reissued Patent No. 44,654 ("RE654")
1017	U.S. Patent No. 6,621,760 ("Ahmad")
1018	<i>Reserved</i>
1019	RE140 with highlights of substantively identical portions from Chu330, Chu185, '886 Provisional, and Chu777
1020	File history of U.S. Reissued Patent No. 43,602 ("RE602 FH")
1021	File history of U.S. Reissued Patent No. 44,468 ("RE468 FH")
1022	<i>ACQIS LLC v. EMC Corp.</i> , Civil Action No. 1:14-cv-13560, No. 185 (D. Mass. Jan. 20, 2017) (EMC Corporation's Opening Claim Construction Brief)
1023	Defendants' Preliminary Invalidity Contentions
1024	Lenovo's <i>Sotera</i> Stipulation
1025	<i>ACQIS LLC v. MiTAC et al.</i> , Civil Action No. 6:20-cv-00967-ADA, No. 85 (W.D. Tx.) (ACQIS's Responsive Claim Construction Brief – with added highlights)

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on November 2, 2021 a complete copy of the Reply to the POPR and newly cited exhibits were served on counsel of record for the Patent Owner by filing this document through PTAB E2E and by sending this document via electronic mail to the following addresses:

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