

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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IPR2021-01103  
Patent RE45,140 E

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

CHANG, *Administrative Patent Judge.*

DECISION  
Denying Institution of *Inter Partes* Review  
35 U.S.C. § 325(d)

## I. INTRODUCTION

Intel Corporation (“Petitioner”) filed a Petition requesting an *inter partes* review (“IPR”) of claims 14–38 (“the challenged claims”) of U.S. Patent No. RE45,140 E (Ex. 1001, “the ’140 patent”). Paper 2 (“Pet.”), 1. ACQIS LLC (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”). Pursuant to our prior authorization, Petitioner filed a Reply to the Preliminary Response. Paper 7 (“Reply”). Patent Owner filed a Sur-reply. Paper 8 (“Sur-reply”).

In determining whether to institute an *inter partes* review, “the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d) (2018). For the reasons stated below, we exercise our discretion under § 325(d) not to institute an *inter partes* review of the challenged claims of the ’140 patent.

### A. Related Matters

The parties indicate that the ’140 patent is involved in *ACQIS LLC v. Lenovo Group Ltd.*, No. 6:20-cv-00967 (W.D. Tex. 2020). Pet. 1; Paper 4, 2.

### B. The ’140 Patent

The ’140 patent relates to an interconnection between two physically separate units of a personal computer system. Ex. 1001, 14:5–7. The first unit, an attached computing module, contains the core computing power and environment for a computer user. *Id.* at 14:7–9. The second unit, a

peripheral console, contains the power supply and primary input and output devices for the computer system. *Id.* at 14:9–11. The units are coupled together to form a fully functional personal computer system. *Id.* at 14:11–13. Figure 13 of the '140 patent is reproduced below.

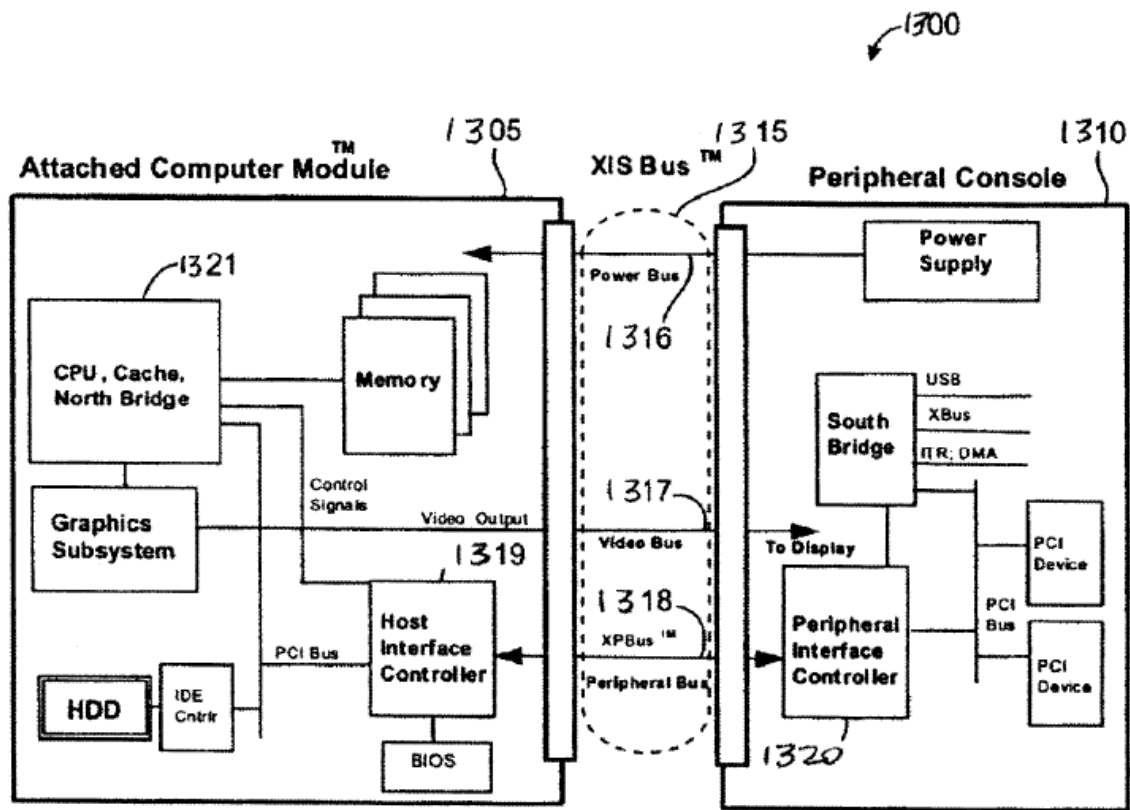


Figure 13 above shows a block diagram of a computer system using an interface. *Id.* at 18:30–40. As shown, computer system 1300 includes attached computer module (ACM) 1305 and peripheral console 1310. *Id.* at 18:41–42. ACM 1305 and peripheral console 1310 are interfaced through exchange interface system (XIS) bus 1315. *Id.* at 18:46–48. XIS bus 1315 includes power bus 1316, video bus 1317 and peripheral bus (XPBus) 1318, which is also referred to as an interface channel. *Id.* at 18:46–51.

*C. Illustrative Claim*

Of the challenged claims, claims 14, 18, 22, 26, 30, and 35 are independent. Claims 15–17 depend from claim 14; claims 19–21 depend from claim 18; claims 23–25 depend from claim 22; claims 27–29 depend from claim 26; claims 31–34 depend from claim 30; and claims 36–38 depend from claim 35. Claim 14 is illustrative:

14. A method of improving performance of a computer, comprising:

obtaining an integrated Central Processing Unit (CPU) with a graphics controller in a single chip;

connecting a Differential Signal channel directly to the integrated CPU and graphics controller to output video data;

conveying Transition Minimized Differential Signaling (TDMS) signals through the Differential Signal channel;

connecting memory directly to the integrated CPU and graphics controller;

providing a connector for the computer for connection to a console; and

providing a first Low Voltage Differential Signal (LVDS) channel to couple to the connector, the first LVDS channel comprising two unidirectional, serial bit channels that transmit data in opposite directions.

Ex. 1001, 22:44–60.

*D. Prior Art Relied Upon*

Petitioner relies upon the references listed below (Pet. 3–4):

Name	Reference	Date	Exhibit No.
Chu (“Chu ’330”)	U.S. Patent No. 6,345,330 B2	Feb. 5, 2002	1003
Cupps	U.S. Patent Publication No. 2003/0135771 A1	July 17, 2003	1004

*E. Asserted Ground of Unpatentability*

Petitioner asserts the following ground of unpatentability (Pet. 35)<sup>1</sup>:

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
14–38	103(a)	Chu ’330, Cupps

II. ANALYSIS

*A. Discretionary Denial Under 35 U.S.C. § 325(d)*

Petitioner relies upon Chu ’330 in its sole asserted ground. Pet. 35. Petitioner argues that while Chu ’330 appears on the voluminous list of

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<sup>1</sup> For purposes of this Decision, we assume the challenged claims have an effective filing date prior to March 16, 2013, the effective date of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), and we apply the pre-AIA versions of 35 U.S.C. §§ 102, 103 and 112.

references considered by United States Patent and Trademark Office (“USPTO” or “Office”), no Examiner cited Chu ’330 against any claims of the ’140 patent or any of its related applications. *Id.* at 117. Petitioner also argues that “the Examiner did not determine the proper priority date of any of the challenged claims during prosecution.” *Id.* According to Petitioner, “[t]he Examiner simply accepted the applicant’s representation that [the ’140 patent] properly incorporated by reference the materials found only in” U.S. provisional application No. 60/083,886 (Chu ’886). *Id.* Petitioner further argues that “even wrongly assuming the Examiner made an implicit determination regarding the priority date, such determination would have been materially erroneous.” *Id.* at 118.

Patent Owner counters that the USPTO has already considered and rejected Petitioner’s argument regarding the incorporation by reference of Chu ’330 and Chu ’886. Prelim. Resp. 10–31. Patent Owner argues that the Board should exercise its discretion under § 325(d) to deny institution because the Examiner previously considered and affirmed the efficacy of an incorporation by reference in the context of a priority claim. *Id.* at 12 (citing *SMR Auto. Sys. USA, Inc. v. Magna Mirrors of Am., Inc.*, IPR2018-00931, Paper 7 at 14 (PTAB Sept. 14, 2018)).

For the reasons set forth below, we are persuaded by Patent Owner’s arguments to exercise our discretion to deny institution of *inter partes* review under 35 U.S.C. § 325(d).

Institution of an *inter partes* review is discretionary. The U.S. Supreme Court has explained that, because § 314 includes no mandate to

institute review, “the agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.” *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016); *see also Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (explaining that under § 314(a), “the PTO is permitted, but never compelled, to institute an IPR proceeding”). Moreover, 35 U.S.C. § 325(d) states, in relevant part, that “[i]n determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d); *see also Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential); *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).

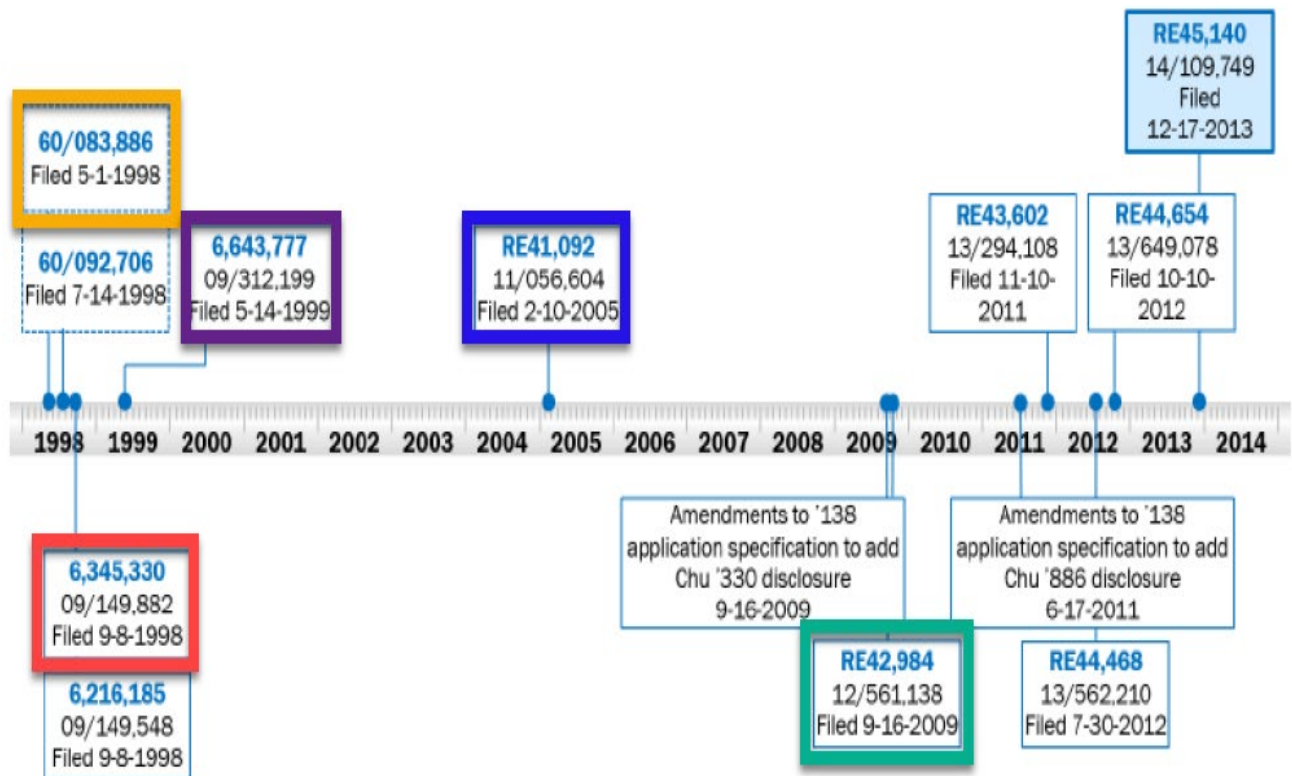
“Under § 325(d), the Board uses the following two-part framework: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of the first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics*, Paper 6 at 8. If the petitioner fails to show that the Office erred, the Director may exercise his or her discretion not to institute *inter partes* review. *Id.*; *see also Becton, Dickinson*, Paper 8,

24 (exercising discretion where “Petitioner has not pointed to error by the Examiner”).

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

We first determine whether the same or substantially the same arguments previously were presented to the Office. *Advanced Bionics*, Paper 6 at 8. Patent Owner’s Figure (reproduced below with color annotations added) provides a timeline of the priority chain of the ’140 patent (light-blue filled box), relevant amendments, and other related applications, including Chu ’886 (yellow) and U.S. Application No. 09/149,882 (“the ’882 application”), which was issued as Chu ’330 (red). Prelim. Resp. 7.





Annotated Patent Owner's Figure above shows the filing dates of the reissue applications in the priority chain of the '140 patent, relevant amendments, and other related applications. The '140 patent was issued from U.S. Application No. 14/109,749 ("the '749 application"), which claimed priority to U.S. Application No. 11/056,604 ("the '604 application"), now U.S. Patent No. RE41,092 ("the '092 patent") (dark blue), through a chain of continuation applications. Ex. 1001, codes (21), (63). The initial parent application, the '604 application (the '092 patent), was a reissue application of U.S. Patent No. 6,643,777 ("the '777 patent") (dark purple), which was issued from U.S. Application No. 09/312,199 ("the '199 application") filed on **May 14, 1999**. Ex. 1013, code (64);

Ex. 1007, codes (21), (22). Both the '199 application and the '604 application incorporated by reference the '882 application (Chu '330), which in turn claimed priority to and incorporated by reference Chu '886.

Ex. 1007, 5:9–13; Ex. 1013, 5:19–23; Ex. 1011, 78, 81, 83 (Prosecution History of Chu '330). Each subsequent reissue application in the '140 patent's priority chain identified each preceding application as required by 35 U.S.C. § 120 and incorporated by reference the prior applications and the '882 application. *See, e.g.*, Ex. 1001, code (63), 1:24–31, 5:67–6:4; Ex. 1008, 1:18–21, 5:50–54.

U.S. Reissue Application No. 12/561,138 (“the '138 application”), now U.S. Patent No. RE42,984 (“the '984 patent”) (green), filed on September 16, 2009, is an intervening application in the priority chain of the '140 patent. Ex. 1001, code (63). During prosecution, the applicant amended the '138 application on June 17, 2011, by adding Figures 8 and 9 and the accompanying description from Chu '886. Ex. 1009, 363 (Prosecution History of the '984 patent).

In its Petition, Petitioner argues that the '140 patent is not entitled to a priority date before June 17, 2011, because the '984 patent's parent applications did not properly incorporate by reference Chu '886, and that the amendment adding the subject matter from Chu '886 into the '138 application (the '984 patent) improperly introduced new matter. Pet. 16–31.

However, during the prosecution of the '138 application, the applicant argued that the amendment was proper because the '777 patent incorporated by reference the '882 application, which in turn claimed the benefit and

incorporated by reference Chu '886. Ex. 1009, 363. “When a patentee argues that its claims are entitled to the priority date of an earlier filed application, the examiner must undertake a priority analysis to determine if the patentee meets the requirements of § 120.” *In re NTP, Inc.*, 654 F.3d 1268, 1277 (Fed. Cir. 2011).

Indeed, the prosecution history of the '138 application shows that, when the subject matter from Chu '886 was added to the '138 application, the applicant specifically directed the Examiner to the incorporation by reference statement in the transmittal form of the '882 application, as support for the amendment. Ex. 1009, 363. Specifically, the applicant in the Remarks sections of the amendments also argued that “the '777 patent incorporated by reference U.S. Application Nos. 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” (Chu '886) “(See checked incorporation by reference box in utility patent application transmittal of U.S. Application No. 09/149,882 filed on September 8, 1998).” *Id.*

The Examiner did not object to the inclusion of the amendment as new matter or issue a rejection under 35 U.S.C. § 112, ¶ 1. Instead, the examiner entered the amendment and subsequently allowed the '138 application with the subject matter added from Chu '886. Ex. 1009, 446 (Notice of Allowance and Fee(s) Due). As Patent Owner also points out (Prelim. Resp. 8), each subsequent application in the '140 patent's priority chain, including the '749 application (issued as the '140 patent), was

amended to include the same figures and disclosure from Chu '886 and, in each application, the amendment was approved and entered by the Examiner. *See, e.g.*, Ex. 1006 (Prosecution History of the '749 application), 145, 201–204 (Non-Final Rejection containing no new matter rejection).

In addition, another petitioner (Samsung) previously presented to the Office substantially the same arguments that the amendments adding the subject matter from Chu '886 to an intervening application in the challenged patent's priority chain improperly introduced new matter, and that "Chu '330 did not properly incorporate the subject matter of Chu '886," in the following five IPR proceedings:

(1) *Samsung Electronics Co., LTD. v. ACQIS LLC*, IPR2021-00604, Paper 1 at 9–18 (PTAB March 8, 2021) (Petition filed by Samsung);

(2) *Samsung Electronics Co., LTD. v. ACQIS LLC*, IPR2021-00605, Paper 1 at 9–17 (PTAB March 8, 2021) (Petition filed by Samsung);

(3) *Samsung Electronics Co., LTD. v. ACQIS LLC*, IPR2021-00606, Paper 1 at 8–17 (PTAB March 8, 2021) (Petition filed by Samsung);

(4) *Samsung Electronics Co., LTD. v. ACQIS LLC*, IPR2021-00607, Paper 1 at 9–17 (PTAB March 8, 2021) (Petition filed by Samsung); and

(5) *Samsung Electronics Co., LTD. v. ACQIS LLC*, IPR2021-00608, Paper 1 at 10–17 (PTAB March 8, 2021) (Petition filed by Samsung).

Upon consideration of Samsung's arguments, the panel in each of these five IPR proceedings denied Samsung's petition under 35 U.S.C. § 325(d) because the same or substantially the same arguments previously were presented to the Office and Samsung failed to show that the Examiner

erred in entering the amendments or in determining that Chu '330 incorporated by reference Chu '886. *See, e.g.*, IPR2021-00607, Paper 7 at 6–22 (Decision Denying Institution).

For the foregoing reasons, we determine that the Petition presents the same or substantially the same arguments that were previously presented to the Office. Consequently, the first part of the *Advanced Bionics* framework is satisfied.

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

Because the first part of the *Advanced Bionics* framework is satisfied, we next determine whether Petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. *Advanced Bionics*, Paper 6 at 8. “If reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability. At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Id.* at 9.

As discussed above, Petitioner argues that the '140 patent is not entitled to a priority date before June 17, 2011, because the '984 patent's parent applications did not properly incorporate by reference Chu '886, such that the amendment adding the subject matter from Chu '886 improperly introduced new matter. Pet. 16–31. Petitioner admits that the '199 application (issued as the '777 patent) incorporated by reference the '882 application, which issued as Chu '330. *Id.* at 23–24; *see also* Ex. 1007,

5:9–13. It also is undisputed that the '604 application (the initial parent application and a reissue application of the '777 patent) incorporated by reference the '882 application (Ex. 1013, code (64), 5:19–23), and each subsequent application in the priority chain identified each preceding application as required by 35 U.S.C. § 120 and incorporated by reference the prior applications and the '882 application. *See, e.g.*, Ex. 1001, code (63), 1:24–31, 5:67–6:4; Ex. 1008, 1:18–21, 5:50–54. Nonetheless, Petitioner argues that “Chu '330 never incorporated by reference the '886 Provisional” (Chu '886). Pet. 23–31.

In short, under Part II of the *Advanced Bionics* framework, Petitioner has the burden to show that the Examiner erred in determining that Chu '330 incorporated by reference Chu '886. *Advanced Bionics*, Paper 6 at 8.

We address below each of Petitioner's arguments in turn.

*a. Incorporated by reference statement in a transmittal form*

To support its argument that Chu '330 never incorporated by reference Chu '886, Petitioner contends that the transmittal form filed in Chu '330 does not identify Chu '886. Pet. 26–28. The transmittal form is reproduced below with Petitioner's annotations added. Ex. 1011, 81.

APPLICATION ELEMENTS <small>See MPEP chapter 600 concerning utility patent application contents.</small>		ADDRESS TO: Assistant Commissioner for Patents Box Patent Application Washington, DC 20231	
<p>1. <input checked="" type="checkbox"/> Fee Transmittal Form <small>(Submit an original, and a duplicate for fee processing)</small></p> <p>2. <input checked="" type="checkbox"/> Specification <span style="float: right;">[Total Pages <b>45</b>]</span> <small>(preferred arrangement set forth below)</small></p> <ul style="list-style-type: none"> <li>- Descriptive title of the Invention</li> <li>- Cross References to Related Applications</li> <li>- Statement Regarding Fed sponsored R &amp; D</li> <li>- Reference to Microfiche Appendix</li> <li>- Background of the Invention</li> <li>- Brief Summary of the Invention</li> <li>- Brief Description of the Drawings <small>(if filed)</small></li> <li>- Detailed Description</li> <li>- Claim(s)</li> <li>- Abstract of the Disclosure</li> </ul> <p>3. <input checked="" type="checkbox"/> Drawing(s) (35 USC 113) <span style="float: right;">[Total Sheets <b>57</b>]</span></p> <p>4. <input type="checkbox"/> Oath or Declaration <span style="float: right;">[Total Pages <b>  </b>]</span></p> <p style="margin-left: 20px;">a. <input type="checkbox"/> Newly executed (original or copy)</p> <p style="margin-left: 20px;">b. <input type="checkbox"/> Copy from a prior application (37 CFR 1.63(d) <small>(for continuation/divisional with Box 17 completed) [Note Box 5 below]</small></p> <p style="margin-left: 20px;">i. <input type="checkbox"/> <b>DELETION OF INVENTOR(S)</b> <small>Signed statement attached deleting inventor(s) named in the prior application, see 37 CFR 1.63(d)(2) and 1.33(b)</small></p> <p>5. <input checked="" type="checkbox"/> Incorporation By Reference <small>(useable if Box 4b is checked)</small> <small>The entire disclosure of the prior application, from which a copy of the oath or declaration is supplied under Box 4b, is considered as being part of the disclosure of the accompanying application and is hereby incorporated by reference therein.</small></p>	<p>6. <input type="checkbox"/> Microfiche Computer Program <small>(Appendix)</small></p> <p>7. <input type="checkbox"/> Nucleotide and/or Amino Acid Sequence Submission <small>(if applicable, all necessary)</small></p> <p style="margin-left: 20px;">a. <input type="checkbox"/> Computer Readable Copy</p> <p style="margin-left: 20px;">b. <input type="checkbox"/> Paper Copy (identical to computer copy)</p> <p style="margin-left: 20px;">c. <input type="checkbox"/> Statement verifying identity of above copies</p>		
<b>ACCOMPANYING APPLICATION PARTS</b>			
<p>8. <input type="checkbox"/> Assignment Papers (cover sheet &amp; document(s))</p> <p>9. <input type="checkbox"/> 37 CFR 3.73(b) Statement <span style="float: right;"><input type="checkbox"/> Power of Attorney</span> <small>(when there is an assignee)</small></p> <p>10. <input type="checkbox"/> English Translation Document <small>(if applicable)</small></p> <p>11. <input type="checkbox"/> Information Disclosure Statement (IDS)/PTO-1449 <span style="float: right;"><input type="checkbox"/> Copies of IDS Citations</span></p> <p>12. <input type="checkbox"/> Preliminary Amendment</p> <p>13. <input checked="" type="checkbox"/> Return Receipt Postcard (MPEP 503) <small>(Should be specifically itemized)</small></p> <p>14. <input type="checkbox"/> Small Entity <span style="float: right;"><input type="checkbox"/> Statement filed in prior application, Status still proper and desired</span></p> <p>15. <input type="checkbox"/> Certified Copy of Priority Document(s) <small>(if foreign priority is claimed)</small></p> <p>16. <input type="checkbox"/> .....</p>			
<p>17. If a CONTINUING APPLICATION, check appropriate box and supply the requisite information:</p> <p><input type="checkbox"/> Continuation    <input type="checkbox"/> Divisional    <input type="checkbox"/> Continuation-in-part (CIP) of prior application No: _____</p>			

Petitioner argues that nothing in the transmittal form above identifies “with *detailed particularity* what specific material” Chu ’330 incorporates, citing testimony of Bill Lin, Ph.D., for support. Pet. 28 (quoting *Hollmer v. Harari*, 681 F.3d, 1351, 1357 (Fed. Cir. 2012) (“*Hollmer*”); citing Ex. 1002 ¶¶ 70–72). Petitioner also avers that “the box 5 states that it is only ‘useable if Box 4b is checked[,]’ which is *not* checked,” and that “[e]ven if Box 4b were checked, Box 4b was limited ‘for continuation/divisional with Box 17 completed.’” *Id.* at 27–28 n.5.

However, Petitioner’s arguments and Dr. Lin’s testimony narrowly focus on the transmittal form alone. *Id.* at 27–28; Ex. 1002 ¶¶ 70–72.

As the Federal Circuit has explained, the incorporation by reference analysis includes “the four corners of the application.” *Hollmer*, 681 F.3d at 1358.

In addition, it is instructive to review the facts in *Hollmer*. In that case, the intervening applications merely identified the referenced application with the title of the invention and the language “*filed on the same day as the present application*,” but the intervening applications were not “filed on the same day” as that referenced application and at least two other applications by the same inventors that had the same title as that referenced application. *Id.* at 1353, 1358. Therefore, the Federal Circuit held that the incorporation language in *Hollmer* did not directly lead one of ordinary skill in the art to that referenced application, but rather presented several potential documents for incorporation. *Id.* at 1358.

Unlike *Hollmer*, the ’882 application (issued as Chu ’330) here provided an incorporation by reference statement of the applicant’s prior applications in the transmittal form and clearly identified the applicant’s prior applications (including Chu ’886) in the first sentence of the Specification on filing. In particular, the ’882 application was filed with a transmittal form with the “incorporation by reference” box checked:

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

Ex. 1011, 81 (emphases added). This checked box on a USPTO transmittal form shows that the applicant intended to incorporate by reference his prior applications, in their entirety, when he was filing the ’882 application.



The applicant also clearly identified his prior applications in the '882 application on filing. Notably, the first sentence of the Specification of the '882 application states that “[t]his application claims any and all benefits as provided by law of U.S. Provisional Application No. 60/083,886” (Chu '886) “and of U.S. Provisional Application No. 60/092,706 filed on July 14, 1998.” *Id.* at 83. The USPTO accepted the benefit claims to these two prior applications (including Chu '886) by placing them on the file wrapper cover of the '882 application and the Examiner verified them by placing his or her initials on the file wrapper cover. *Id.* at 78. Moreover, the Cross-Reference to Related Applications Section of the '882 application listed only these two prior applications and another concurrently-filed application. *Id.* at 83.

A reasonably skilled artisan would have recognized that the applicant intended to incorporate his prior applications (including Chu '886) at the time of filing the '882 application. The incorporation by reference language together with the benefit claims in the first sentence of the Specification of the '882 application would have sufficiently identified the applicant's prior applications (including Chu '886) as the referenced prior applications, distinguishing them from all other documents.

A reasonably skilled artisan would not have ignored the applicant's incorporation by reference statement just because Box 4b was not checked or because the applicant was not filing a continuation or divisional application. As the Federal Circuit has explained, “[t]he incorporation standard relies only on the reasonably skilled artisan and his or her ability to

deduce from language, however, imprecise, what a host document aims to incorporate.” *Husky Injection Molding Systems Ltd. v. Athena Automation Ltd.*, 838 F.3d 1236, 1248 (Fed. Cir. 2016) (citing *Harari v. Lee*, 656 F.3d 1331 (Fed. Cir. 2011); *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1283 (Fed. Cir. 2000)); *cf. In re Fouche*, 439 F.2d 1237, 1239–1240 (CCPA 1971) (“It seems amply clear that an applicant should be permitted to incorporate the disclosure of a copending application . . . so long as the reference application is sufficiently well identified to distinguish it from all others.”).

As we pointed out in our Decision Denying Institution in IPR2021-00604, Paper 7 at 17–18, two different Examiners on three separate occasions considered the transmittal form together with the benefit claims and recognized that the applicant incorporated by reference Chu ’886 including:

(1) when the applicant filed a preliminary amendment that added Figures 8 and 9 and corresponding disclosure from Chu ’886 as Figures 8A and 8B and corresponding disclosure in U.S. Application No. 13/087,912 (“the ’912 application”), in which the applicant directed the Examiner to the transmittal form as support for the amendment (IPR2021-00604, Ex. 1011, 15, 16, 26–28);

(2) when the applicant filed another amendment on December 16, 2011, in the ’912 application that added Figures 10 and 16 and corresponding disclosure from Chu ’886 as Figures 8C and 24 and corresponding disclosure in the ’912 application, in which the applicant also

directed the Examiner to the transmittal form as support for this amendment (*id.* at 382, 392, 401); and

(3) when the applicant filed a similar amendment in the '138 application, directing the Examiner to the transmittal form submitted in the '882 application as support for the amendment (Ex. 1009, 363).

The Examiner in each of these cases did not object to the amendments as new matter or issue a rejection under 35 U.S.C. § 112, ¶ 1 for lack of written description support for the claims. *NTP*, 654 at 1277. Instead, the Examiner entered the amendments and subsequently allowed the '138 application with the subject matter added from Chu '886. Ex. 1009, 446 (Notice of Allowance and Fee(s) Due).

The incorporation by reference statement in the transmittal form also was never objected to by any Examiner during prosecution of the '882 application (Chu '330), the '199 application (the '777 patent), and all six reissue applications in the priority chain of the '140 patent, as well as all eleven continuation applications in the priority chain of U.S. Patent No. 9,703,750 (“the '750 patent”) as we noted in our Decision Denying Institution in IPR2021-00604, Paper 7 at 18. Moreover, none of the Examiners required the applicant to change its benefit claims from “continuation” to “continuation-in-part” in those eleven continuation applications.

For the foregoing reasons, the '882 application identified Chu '886 with particularity and would have directly led an ordinarily skilled artisan to the document intended to be incorporated. Accordingly, we determine that

Petitioner fails to show that the Examiner erred in determining that the '882 application (Chu '330) incorporated Chu '886 by reference.

In addition, as discussed above, Petitioner admits that the '199 application (issued as the '777 patent) incorporated by reference the '882 application (issued as Chu '330). Pet. 23–24; *see also* Ex. 1007, 5:9–13. It also is undisputed that the '604 application (the initial parent application and a reissue application of the '777 patent) incorporated by reference the '882 application (Ex. 1013, code (64), 5:19–23), and each subsequent application in the priority chain identified each preceding application as required by 35 U.S.C. § 120 and incorporated by reference the prior applications and the '882 application. *See, e.g.*, Ex. 1001, code (63), 1:24–31, 5:67–6:4; Ex. 1008, 1:18–21, 5:50–54. As such, we also find that Petitioner has failed to show (1) the '140 patent is not entitled to a priority date before June 17, 2011, (2) the '984 patent's parent applications did not properly incorporate by reference Chu '886, and (3) the amendments adding the subject matter from Chu '886 in the '138 application (issued as the '984 patent) improperly introduced new matter. Pet. 16–31.

*b. Transmittal form is part of the application*

Petitioner argues that “[e]ven if the transmittal form of Chu330 included a statement that purportedly incorporated by reference the '886 Provisional” (Chu '886), “that statement would be inoperative because a person of ordinary skill’s analysis of what a patent incorporates is limited to *the four corners of the patent itself.*” Pet. 28. According to Petitioner, a person of ordinary skill in the art “would not have known if a patent

incorporates another document based on *a statement buried in a transmittal form.*” *Id.* at 28–29 (emphasis added). Petitioner contends that “any incorporation by reference statement must have appeared in Chu330 itself.” *Id.*

We are not persuaded by Petitioner’s arguments. The Federal Circuit has explained that the incorporation by reference analysis includes “the four corners of the *application.*” *Hollmer*, 681 F.3d at 1358. A transmittal form is a part of the application. *See* 37 C.F.R. § 1.77(a) (1998) (“The elements of the application, if applicable, should appear in the following order: (1) Utility Application Transmittal Form . . .”). Courts have repeatedly considered application transmittals in their incorporation by reference analyses. *See, e.g., Harari v. Hollmer*, 602 F.3d 1348, 1352–53 (Fed. Cir. 2010) (“*Harari I*”); *Hollmer*, 681 F.3d at 1353–54; *Pregis Corp. v. Doll*, 698 F.Supp.2d 584, 598–599 (E.D. Va. 2010) (The court in its analysis considered the incorporation by reference of a prior provisional application and a patent submitted in a transmittal letter.). Moreover, Petitioner admits that an applicant filing a continuation or divisional application could have used the USPTO transmittal form, which includes a check box for incorporating by reference a prior application. Pet. 28–29 n.5.

Therefore, we are not persuaded by Petitioner’s arguments that (1) an incorporation by reference statement appeared in a transmittal form “would be inoperative,” (2) a person of ordinary skill in the art “would not have known if a patent incorporates another document based on a statement

buried in a transmittal form,” and (3) “any incorporation by reference statement must have appeared in Chu330 itself.” *Id.* at 28–29.

*c. Benefit claims*

Petitioner argues that the statement “[t]his application claims any and all benefits as provided by law of U.S. Provisional Application No. 60/083,886 filed May 1, 1998” appeared in the first sentence of Chu ’330 “is at best a priority claim to the ’886 Provisional that is distinct from an incorporation by reference.” Pet. 29–30 (citing *In re de Seversky*, 474 F.2d 671, 674 (CCPA 1973) (“[A] mere *reference* to another application, or patent, or publication is not an *incorporation* of anything therein into the application.”)).

Petitioner’s reliance on *de Seversky* is misplaced here. In *de Seversky*, “the parent application . . . contains no ‘incorporation-by-reference’ language whatsoever.” *de Seversky*, 474 F.2d at 674. In contrast, the applicant here filed a transmittal form in the ’882 application that includes an incorporation by reference statement of his prior applications. Ex. 1011, 81. Petitioner fails to consider the incorporation by reference statement together with the benefit claims in the first sentence of the Specification that clearly identifies the applicant’s prior applications (including Chu ’886). *Id.* at 81, 83.

As discussed above, the incorporation by reference language together with the benefit claims in the first sentence of the Specification of the ’882 application would have sufficiently identified the applicant’s prior applications (including Chu ’886) as the referenced prior applications,

distinguishing them from all other documents. In short, the '882 application identified Chu '886 with particularity and would have directly led a reasonably skilled artisan to the document intended to be incorporated.

Therefore, Petitioner has not shown that the Examiner erred in determining that the '882 application (Chu '330) incorporated Chu '886 by reference or in entering the amendments that added the subject matter of Chu '886 in the '138 application.

*d. The incorporation by reference standard*

Petitioner argues that “[t]he reasonable Examiner standard does not apply to the analysis of RE140’s priority chain because these patents have issued.” Pet. 25–26 n.4 (citing *Harari I*, 602 F.3d at 1348; *Hollmer*, 681 F.3d at 1357). According to Petitioner, “[t]he incorporation by reference is proper only if the host document ‘identif[ies] *with detailed particularity* what specific material it incorporates *to a person of ordinary skill*’ and ‘directly lead[s] one of ordinary skill’ to the document that the patent-drafter intended to be incorporated.” *Id.* at 25 (quoting *Hollmer*, 681 F.3d at 1357).

We are not persuaded by Petitioner’s arguments. As discussed above, Petitioner has the burden to show that the Examiner erred in determining that the '882 application (issued as Chu '330) incorporated by reference Chu '886. In *Advanced Bionics*, the Board stated that “[i]f reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability. At bottom, this framework reflects a commitment to defer to previous Office

evaluations of the evidence of record unless material error is shown.”

*Advanced Bionics*, Paper 6 at 9.

Here, Petitioner does not explain why the Examiner erred if a reasonable examiner would have found that the identification in the ’882 application was reasonably precise to incorporate Chu ’886 by reference. Nor does Petitioner provide any meaningful differences between applying the “reasonable examiner” standard and applying the “person of ordinary skill in the art” (“POSITA”) standard to the particular facts in this proceeding under the *Advanced Bionics* framework.

In any event, even applying the “POSITA” standard here, we find that Petitioner fails to show that the Examiner erred in determining that the ’882 application (issued as Chu ’330) incorporated Chu ’886 by reference.

As discussed above in Section II.A.2.a, unlike *Hollmer* where the incorporation language did not directly lead one of ordinary skill in the art to the referenced application because it presented several potential documents for incorporation, the ’882 application here provided an incorporation by reference statement of the applicant’s prior applications and clearly identified the applicant’s prior applications (including Chu ’886) in the first sentence of the Specification on filing.

The incorporation by reference language together with the benefit claims in the first sentence of the Specification of the ’882 application would have sufficiently identified the applicant’s prior provisional applications (including Chu ’886) as the referenced prior applications, distinguishing them from all other documents. *Husky Injection*, 838 F.3d at 1248. In short,



the '882 application identified Chu '886 with particularity and would have directly led an ordinarily skilled artisan to the document intended to be incorporated. *Hollmer*, 681 F.3d at 1357–58. Accordingly, even under the “POSITA” standard, we find that Petitioner fails to show that the Examiner erred in determining that the '882 application (issued as Chu '330) incorporated Chu '886 by reference.

3. Conclusion on Discretionary Denial under § 325(d)

For the foregoing reasons, we determine that the same or substantially the same arguments previously were presented to the Office and that Petitioner fails to show that the Examiner erred in determining that the '882 application (issued as Chu '330) incorporated Chu '886 by reference or in entering the amendment that added the subject matter from Chu '886 in the '138 application. Accordingly, we exercise our discretion not to institute *inter partes* review. *Advanced Bionics*, Paper 6 at 8; *see also Becton, Dickinson*, Paper 8, 24.

III. CONCLUSION

For the foregoing reasons, we exercise our discretion under § 325(d) to deny institution of an *inter partes* review.

IV. ORDER

Accordingly, it is

ORDERED that the Petition is *denied*, and no trial is instituted.

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