

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

XILINX, INC.,
Petitioner,

v.

POLARIS INNOVATIONS LIMITED,
Patent Owner.

IPR2023-00517
Patent 6,701,473 B2

Before JEAN R. HOMERE, BARBARA A. PARVIS, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*

DECISION

Denying Petitioner's Request for Rehearing of Decision
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Xilinx, Inc. (“Petitioner”) filed a Request for Rehearing (Paper 13, “Reh’g Req.”) of the Decision Denying Institution of *Inter Partes* Review (Paper 12, “Decision,” “Decision Denying Institution,” or “Dec.”) of claims 1–5, 7–10, 13, 14, 20–24, 26–29, 32, and 33 (“challenged claims”) of U.S. Patent No. 6,701,473 B2 (Ex. 1001, “the ’473 patent”). For the reasons that follow, the Request for Rehearing is *denied*.

II. STANDARD OF REVIEW

A party requesting rehearing bears the burden of showing that the decision should be modified. 37 C.F.R. § 42.71(d) (2023). The party must identify specifically all matters we misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, a reply, or a sur-reply. *Id.* When reconsidering a decision on institution, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion will be found if a decision is based on an erroneous interpretation of law, rests on a factual finding not supported by substantial evidence, or represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000).

III. ANALYSIS

In the Request for Rehearing, Petitioner contends that we (1) overlooked Patent Owner’s admissions; (2) overlooked the intrinsic record in our analysis of “during testing” recited in claim 1 and “while testing” recited in claim 20; and (3) misapprehended Slemmer’s disclosure. For the reasons discussed below, we are not persuaded by Petitioner’s

arguments, and Petitioner has not shown that we abused our discretion in the Decision to deny institution. Thus, the Request for Rehearing is *denied*. To the extent our discussion herein provides further explanation or support for our conclusions in our Decision Denying Institution, we modify our Decision Denying Institution with the further explanation and support herein.

A. Petitioner’s Argument That We Overlooked Patent Owner’s Admissions (Reh’g Req. 3–4)

Petitioner argues “the Board overlooks Patent Owner’s own admissions in its Preliminary Response that Slemmer ‘teaches outputting the [] data **during testing** at times t4 to t6 and at time t8’ (Prelim. Resp. 25–26, emphasis added) and ‘that **during the testing** of [Slemmer’s] circuit component’ there are also ‘intervals of time where no data is output’ (Prelim. Resp. 33, emphasis added).” Reh’g Req. 4.

Petitioner relies on portions of two unrelated sentences in the Preliminary Response that appear to be taken out of context. As we indicated in the Decision Denying Institution, “[i]n the Preliminary Response, Patent Owner asserts that Slemmer does not teach ‘outputting no data to said bus’ ‘during testing’ as recited in claim 1 (limitation [1.3]) or ‘while testing’ as recited in claim 20 (limitation [20.3]).” Dec. 18 (citing Prelim. Resp. 29–34). After consideration of Petitioner’s arguments in its Request for Rehearing (Reh’g Req. 3–4), we still find that Patent Owner’s position that the recitations in limitations 1.3 and 20.3 are not taught is sufficiently clear from the Preliminary Response.

Nevertheless, in an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed.

Cir. 2016); *see also* 35 U.S.C. § 312(a)(3) (2018) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”). That burden of persuasion never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015); *see also In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1375–78 (Fed. Cir. 2016) (discussing the burden of proof in *inter partes* review). As explained in our Decision Denying Institution (Dec. 14–20), Petitioner has not set forth sufficient argument and supporting evidence to show sufficiently that Slemmer teaches limitations [1.3] and [20.3].

In summary, Petitioner has not shown that we abused our discretion by overlooking Patent Owner’s admissions.

B. Petitioner’s Argument That We Overlooked the Intrinsic Record in Our Analysis of “during testing” Recited in Claim 1 and “while testing” Recited in Claim 20 (Reh’g Req. 4–6)

Petitioner argues that we concluded that claim limitations [1.3] and [20.3] require performing a test operation and not just entering a test mode of the circuit component to be tested. Reh’g Req. 4–5. Petitioner argues in doing so, we overlooked the Specification of the ’473 patent. *Id.* at 5–6. Petitioner identifies disclosures in the ’473 patent Specification that Petitioner argues support its position. *Id.* (citing Ex. 1001, 8:4–9, 10:5–15, 10:24–27).

The disclosures identified by Petitioner in the ’473 patent Specification do not support that “during testing” recited in claim 1 and “while testing” recited in claim 20 encompass enabling a test mode. The first of the disclosures relied on by Petitioner describes values of signals “[d]uring testing.” Ex. 1001, 8:4–9. The second of the disclosures relied on

by Petitioner describes conditions during “Test mode” and “Normal operation.” *Id.* at 10:5–15. The third of the disclosures relied on by Petitioner describes deactivating output drivers “during testing.” *Id.* at 10:24–27. Each of the disclosures pertains to conditions either during testing or in test mode, but Petitioner does not identify support that “during testing” recited in claim 1 or “while testing” recited in claim 20 encompass enabling a test mode.

“The name of the game is the claim.” *In re Hiniker Co.*, 150 F.3d 1367, 1369 (Fed. Cir. 1998). We discern no reason based on the record before us to interpret the claim to encompass enablement of a special test mode that occurs prior to testing. Contrary to Petitioner’s argument (Reh’g Req. 4–6), the claims require performing the operation “during testing” as recited in claim 1 or “while testing” as recited in claim 20.

Furthermore, Petitioner has not shown where it previously argued that “during testing” recited in claim 1 and “while testing” recited in claim 20 should be construed to encompass enablement of a test mode of the circuit component. Reh’g Req. 4–6. We cannot have misapprehended or overlooked arguments that were not previously made.

In summary, Petitioner has not shown that we overlooked the intrinsic record in in our analysis of “during testing” recited in claim 1 and “while testing” recited in claim 20.

C. Petitioner’s Argument That We Misapprehended Slemmer’s Disclosure (Reh’g Req. 6–15)

Petitioner argues that we misapprehended (1) Slemmer’s disclosure that determining and acknowledging successful entry into the test mode is a test itself (*see, e.g.*, Reh’g Req. 8); (2) Slemmer’s disclosure that additional test operations are performed (*see, e.g., id.* at 9); and (3) Slemmer’s purpose

for enabling the test mode before performing special test operations (*see, e.g., id.* at 13). We address each of Petitioner’s arguments in turn.

Regarding Petitioner’s first argument (*see, e.g., Reh’g Req. 8*), Petitioner does not identify where it previously argued that Slemmer discloses that determining and acknowledging successful entry into the test mode is a test itself. Petitioner identifies certain pages of the Petition (*id.* at 8–9 (citing Pet. 10, 11, 14, 15, 28, 79)), but the discussion on those pages of the Petition is simply that Slemmer discloses acknowledging entry into test mode. The Petition does not include an argument that acknowledging successful entry into the test mode is a test itself. Pet. 10–11, 14–15, 28, 79. We cannot have misapprehended or overlooked arguments that were not previously made.

Furthermore, Slemmer merely describes providing the user “acknowledgement that the device is in a special mode, prior to such time as special test operations are performed.” Ex. 1005, 35:22–42. On the record before us, the disclosure relied on by Petitioner is of providing an acknowledgement, not performing a test.

Regarding Petitioner’s second argument (*see, e.g., Reh’g Req. 9*), Petitioner has not shown that Slemmer’s additional test operations teach limitations 1.3 and 20.3. Limitation [1.3] recites “said circuit component to be tested configured to perform an operation, during testing thereof, *that is selected from the group consisting of outputting no data to said bus, and outputting data to said bus that is other than data which would be output to said bus during normal operation*” (emphasis added). Limitation [20.3] includes a similar recitation. Each of Slemmer’s disclosures relied on in the Petition is addressed in the Decision Denying Institution. Dec. 14–20. Petitioner does not show that the additional test operations in Slemmer

identified in its Rehearing Request teach an operation “selected from the group consisting of outputting no data to said bus, and outputting data to said bus that is other than data which would be output to said bus during normal operation” as required in limitations [1.3] and [20.3].

Regarding Petitioner’s third argument (*see, e.g.,* Reh’g Req. 13), Petitioner merely states disagreement with our Decision Denying Institution. More specifically, Petitioner argues we wrongly concluded that Slemmer’s enabling the test mode is performed “so that the memory device may be returned to the normal operating mode without performing inadvertent test operations.” *Id.* at 14 (citing Dec. 12–13, 19–20; Ex. 1005, 35:47–51). Slemmer, however, expressly describes that “communication of the enabling of a special test mode allows detection of the inadvertent entry into such a mode, so that the user may perform the necessary cycles to return to the normal operating mode of the device.” Ex. 1005, 35:47–51. A request for rehearing, is not an opportunity merely to disagree with the Board’s assessment of the arguments or weighing of the evidence.

In summary, Petitioner has not shown that we misapprehended Slemmer’s disclosures.

IV. CONCLUSION

We have reviewed and considered the arguments in Petitioner’s Request and conclude that Petitioner has not carried its burden of demonstrating that the Board abused its discretion in denying institution. 37 C.F.R. § 42.71(c)–(d).

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petitioner's Request for Rehearing is *denied*.

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