

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

ACQIS LLC,
Patent Owner.

IPR2021-01105
Patent 8,977,797 B2

Before THU A. DANG, JONI Y. CHANG, and SCOTT A. DANIELS,
Administrative Patent Judges.

DANIELS, *Administrative Patent Judge.*

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

I. INTRODUCTION

Intel Corporation (“Petitioner” or “Intel”) filed a Petition requesting an *inter partes* review (“IPR”) of claims 1–3, 7–13, and 18–20 (“the challenged claims”) of U.S. Patent No. 8,977,797 B2 (Ex. 1001, “the ’797 patent”). Paper 2 (“Pet.”), 1. ACQIS LLC (“Patent Owner” or “Acqis”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”). Pursuant to our prior authorization, Petitioner filed a Reply to the Preliminary Response. Paper 9 (“Reply”). Patent Owner filed a Sur-reply. Paper 10 (“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 ’797 patent.

A. Related Matters

The parties indicate that, *inter alia*, the ’797 patent is involved in *Acqis LLC v. Lenovo Group Ltd. et al.*, No. 6:20-cv-00967 (W.D. Tex. 2020). Pet. 5; Paper 6, 2. Petitioner also challenges the ’797 patent in IPR2021-01104. Paper 3, 5.¹

¹ Petitioner filed an Explanation of Multiple Petitions (Paper 3).

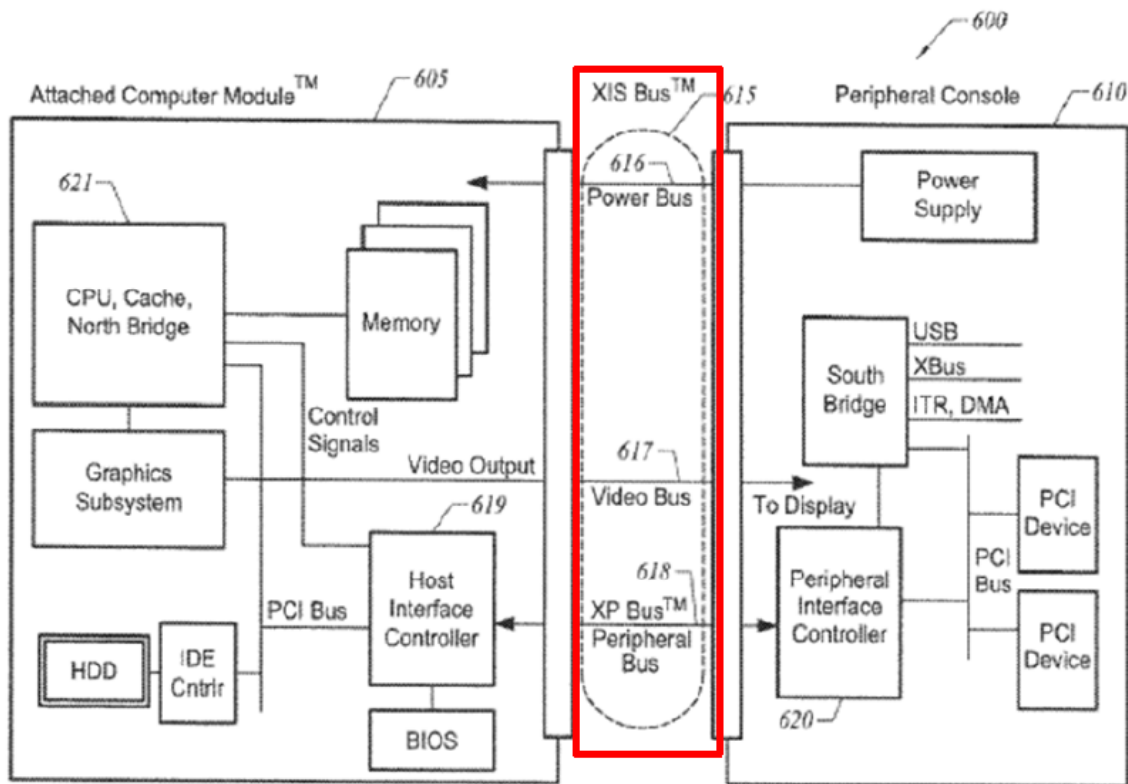
B. Real Parties-in-Interest

Petitioner identifies Lenovo Group Ltd.; Lenovo PC HK Limited; LCFC (HEFEI) Electronics Technology Co., Ltd.; Lenovo Information Products (Shenzhen) Co., Ltd.; Lenovo (Beijing) Information Technology Ltd.; and Lenovo Centro Tecnológico S. de R.L. de C.V. as additional real parties-in-interest. Pet. 8.

C. The '797 Patent

The '797 patent relates to computer interfaces, specifically an interface channel that “interfaces two computer interface buses that operate under protocols that are different from that used by the interface channel.” Ex. 1001, 3:10–12.

Figure 6 of the '797 patent is reproduced below with a red annotation added by the Board that highlights the interface channel.



Annotated Figure 6 above shows a block diagram of a computer system using an interface. Ex. 1001, 15:15–16. As shown, computer system 600 includes attached computer module (ACM) 605 and peripheral console 610. *Id.* at 15:16–18. ACM 605 and peripheral console 610 are interfaced through exchange interface system (XIS) bus 615. *Id.* at 15:23–24. XIS bus 615 includes power bus 616, video bus 617 and peripheral bus (XPBus) 618, which is also referred to as an interface channel. *Id.* at 15:24–27.

D. Illustrative Claim

Of the challenged claims, claims 1, 7, 10 and 18 are independent method claims. Claims 2 and 3 depend from claim 1, claims 8 and 9 depend

from claim 7, claims 11–13 depend from claim 10, and claims 19 and 20 depend from claim 18. Claim 1 is illustrative:

1. A method of improving computer peripheral data communications, comprising:
 - connecting a Central Processing Unit (CPU) directly to a peripheral bridge on a printed circuit board of a computer system;
 - connecting a Low Voltage Differential Signal (LVDS) channel directly to the peripheral bridge on the printed circuit board, the LVDS channel comprising two unidirectional, serial channels that transmit data in opposite directions;
 - increasing data throughput of the serial channels by providing each channel with multiple pairs of differential signal lines;
 - conveying encoded address and data bits of a Peripheral Component Interconnect (PCI) bus transaction in serial form over the serial channels to preserve the PCI bus transaction;
 - coupling the peripheral bridge to an Ethernet connection through the LVDS channel to improve data throughput between the CPU and the Ethernet connection;
 - using the Ethernet connection to connect the computer system to an Ethernet network; and applying power to the computer system.

Ex. 1001, 37:55–38:10.

E. Prior Art Relied Upon

Petitioner relies upon the references listed below (Pet. 9–10):

Name	Reference	Date	Exhibit No.
Chu ("Chu '330")	U.S. Patent No. 6,345,330 B1	Feb. 5, 2002	1003

Name	Reference	Date	Exhibit No.
Peleg (“Peleg ’065”)	U.S. Patent No. 6,557,065 B1	April 29, 2003	1034
Helms (“Helms ’510”)	U.S. Patent No. 7,146,510 B1	Dec. 5, 2006	1044
Chu (“Chu ’777”)	U.S. Patent No. 6,643,777 B1	Nov. 4, 2003	1054

F. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability (Pet. 40)²:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
7–8, 18–20	103(a)	Chu ’330, Peleg ’065, Helms ’510
1–3, 9–13	103(a)	Chu ’330, Peleg ’065, Helms ’510, Chu ’777

² 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.

II. ANALYSIS

A. 35 U.S.C. § 325(d)

Petitioner relies upon Chu '330 in each asserted ground. Pet. 40. Petitioner contends that the United States Patent and Trademark Office (“USPTO” or “Office”) overlooked Chu '330 as prior art because “[t]he '797 Patent is, at best, entitled to a priority date only as to the filing date of U.S. Patent No. 8,234,436,” that is, April 15, 2011. *Id.* at 24. More specifically, according to Petitioner, the written description support for the “CPU-PB” and “LVDS-PB” limitations in the '797 patent claims “was only added to the specification for the first time in the intervening '436 Patent.” *Id.* at 26. To support its contention, Petitioner argues that “Chu [']330 never **incorporated by reference** the '886 Provisional. Chu [']330 merely claimed **priority** to the '886 Provisional.” *Id.* at 28. Thus, Petitioner argues that the challenged claims are not entitled to a priority date based on U.S. provisional application No. 60/083,886 (“the '886 Provisional” or “Chu '886”), but only that of the '436 patent, April 15, 2011. *Id.* at 23–39. Therefore, Petitioner argues, Chu '330 qualifies as 35 U.S.C. § 102(b) prior art and is material to the patentability of the claims in the '797 Patent. *Id.*

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. 11–31. 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 11–12

(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).

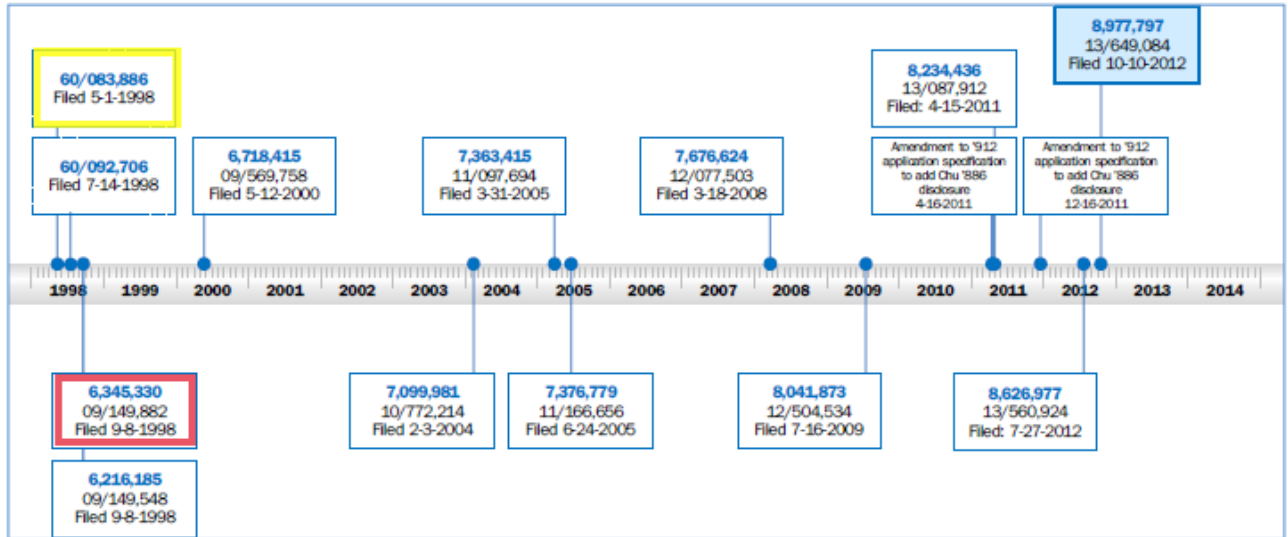
“Under § 325(d), the Board uses the following two-part framework: (1) whether the same or substantially the same art previously was presented

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 at 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, provides a timeline of the priority chain of the ’797 patent (light-blue filled box) and other related applications, including Chu ’886 (highlighted yellow by the Board) and U.S. Application No. 09/149,882 (“the ’882 application”), which was issued as Chu ’330 (highlighted red by the Board). Prelim. Resp. 7.

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Patent Owner's Figure above shows the filing dates of the applications in the priority chain of the '797 patent and other related applications. The '797 patent was issued from U.S. Application No. 13/649,084 ("the '084 application"), which claims priority to U.S. Application No. 09/569,758 ("the '758 application"), filed **May 12, 2000**, through a chain of continuation applications. Ex. 1001, code (63). The '758 application (the initial parent application) incorporated by reference the '882 application (Chu '330), which in turn claimed priority to and incorporated by reference Chu '886. Ex. 1013, 4:50–53; Ex. 1011, 78, 81, 83 (Prosecution History of Chu '330). Each subsequent application in the priority chain identifies 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, 1:10–28, 9:36–39; Ex. 1008, 1:12–27, 9:27–29.

U.S. Application No. 13/087,912 (“the ’912 application”), now U.S. Patent No. 8,234,436 (“the ’436 patent”), was filed on April 15, 2011 and is an intermediate application in the priority chain of the ’797 patent claiming the benefit to the ’758 application through several other prior applications. Ex. 1008, code (63). The ’912 application was filed with a preliminary amendment, adding Figures 8 and 9 and corresponding disclosure from Chu ’886 as Figures 8A and 8B and corresponding disclosure in the ’912 application. Ex. 1009, 12–26 (Prosecution History of the ’912 application). The applicant also filed another amendment in the ’912 application, adding Figures 10 and 16 and corresponding disclosure from Chu ’886 as Figures 8C and 24 and corresponding disclosure in the ’912 application. *Id.* at 379–395.

In its Petition, Petitioner argues that “none of the ’436 Patent’s parent applications properly incorporated by reference [Chu] ’886,” and that the written description of the “CPU-PB” and “LVDS-PB” limitations in the claims of the ’797 patent “was only added to the specification for the first time in the intervening ’436 Patent.” Pet. 26–28. However, as we explain below, this is not the case.

During prosecution of the ’912 application (issued as the ’436 patent), the applicant argued that these amendments were proper because the ’758 application (the initial parent application) incorporated by reference the ’882 application, which in turn incorporated Chu ’886 by reference. Ex. 1009, 26, 392. “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 ’912 application shows that when the subject matter from Chu ’886 was added to the ’912 application, the applicant specifically directed the Examiner to the incorporation by reference statement in the transmittal form filed in the ’882 application (Chu ’330) as support for the amendments. Ex. 1009, 26, 392. The applicant in the Remarks sections of the amendments also stated that “[t]he original ’758 patent application incorporated by reference U.S. Application No. 09/149,882 (now issued as U.S. Patent No. 6,345,330), which in turn, claimed the benefit of and incorporated by reference U.S. Provisional Application No. 60/083,886 . . . (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.* at 26. As Patent Owner points out, the Examiner considering the ’912 application did not object to the inclusion of the amendments as new matter or issue a rejection under 35 U.S.C. § 112, ¶ 1. Prelim. Resp. 8–9; Ex. 1009. Nor did the Examiner require the applicant to change the benefit claim from “continuation” to “continuation-in-part.” Instead, the Examiner entered the amendments and subsequently allowed the ’912 application with the subject matter added from Chu ’886. *See* Ex. 1009, 419 (Notice of Allowance and Fee(s) Due).

In addition, both Intel and 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

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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 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);

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

(6) *Intel Corporation v. ACQIS LLC*, IPR2021-01107, Paper 1 at 30–49 (PTAB June 14, 2021) (Petition filed by Intel);

(7) *Intel Corporation v. ACQIS LLC*, IPR2021-01108, Paper 3 at 18–30 (PTAB June 14, 2021) (Petition filed by Intel);

(8) *Intel Corporation v. ACQIS LLC*, IPR2021-01109, Paper 3 at 19–33 (PTAB June 14, 2021) (Petition filed by Intel);

(9) *Intel Corporation v. ACQIS LLC*, IPR2021-01110, Paper 1 at 17–31 (PTAB June 14, 2021) (Petition filed by Intel);

(10) *Intel Corporation v. ACQIS LLC*, IPR2021-01111, Paper 1 at 17–31 (PTAB June 14, 2021) (Petition filed by Intel); and

(11) *Intel Corporation v. ACQIS LLC*, IPR2021-01112, Paper 1 at 27–44 (PTAB June 14, 2021) (Petition filed by Intel).

Upon consideration of Samsung’s and Intel’s arguments, the panel in each of these eleven IPR proceedings denied each petition under 35 U.S.C. § 325(d) because the same or substantially the same arguments previously were presented to the Office and that Samsung and Intel 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.*, IPR2021-00604, Paper 7 at 6–21 (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 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 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 takes the position that because Chu

'886 was not properly incorporated by reference into the '797 Patent family, “the purported written description support [for the '797 claims] was added to the specification for the first time in the intervening '436 Patent.” Pet. 26 (citing Ex. 1009, 12–16, 26–28, 379–395). Petitioner admits that the '758 application (the initial parent application in the '797 Patent family) incorporated by reference the '882 application. *Id.* at 28; *see also* Ex. 1013, 4:50–53. It also is undisputed that 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, 1:10–28, 9:36–39; Ex. 1008, 1:12–27, 9:27–29. Nonetheless, Petitioner argues that “Chu '330 never incorporated by reference the '886 Provisional” (Chu '886). Pet. 30–37.

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. 30–32. The transmittal form is reproduced below with Petitioner's annotations added. Ex. 1011, 81.

APPLICATION ELEMENTS See MPEP chapter 600 concerning utility patent application contents.		ADDRESS TO: Assistant Commissioner for Patents Box Patent Application Washington, DC 20231	
1. <input checked="" type="checkbox"/> Fee Transmittal Form (Submit an original, and a duplicate for fee processing)		6.* <input type="checkbox"/> Microfiche Computer Program (Appendix)	
2. <input checked="" type="checkbox"/> Specification [Total Pages 45] (preferred arrangement set forth below)		7.* Nucleotide and/or Amino Acid Sequence Submission (if applicable, all necessary)	
- Descriptive title of the invention		a. <input type="checkbox"/> Computer Readable Copy	
- Cross References to Related Applications		b. <input type="checkbox"/> Paper Copy (identical to computer copy)	
- Statement Regarding Fed sponsored R & D		c. <input type="checkbox"/> Statement verifying identity of above copies	
- Reference to Microfiche Appendix			
- Background of the invention		ACCOMPANYING APPLICATION PARTS	
- Brief Summary of the invention		8.* <input type="checkbox"/> Assignment Papers (cover sheet & document(s))	
- Brief Description of the Drawings (if filed)		9.* <input type="checkbox"/> 37 CFR 3.73(b) Statement <input type="checkbox"/> Power of Attorney (when there is an assignee)	
- Detailed Description		10.* <input type="checkbox"/> English Translation Document (if applicable)	
- Claim(s)		11.* <input type="checkbox"/> Information Disclosure Statement (IDS)/PTO-1449 <input type="checkbox"/> Copies of IDS Citations	
- Abstract of the Disclosure		12.* <input type="checkbox"/> Preliminary Amendment	
3. <input checked="" type="checkbox"/> Drawing(s) (35 USC 113) [Total Sheets 57]		13. <input checked="" type="checkbox"/> Return Receipt Postcard (MPEP 503) (Should be specifically itemized)	
4.* <input type="checkbox"/> Oath or Declaration [Total Pages 1]		14.* <input type="checkbox"/> Small Entity <input type="checkbox"/> Statement filed in prior application, Statement(s) Status still proper and desired	
a. <input type="checkbox"/> Newly executed (original or copy)		15.* <input type="checkbox"/> Certified Copy of Priority Document(s) (if foreign priority is claimed)	
b. <input type="checkbox"/> Copy from a prior application (37 CFR 1.63(d)) (for continuation/divisional with Box 17 completed) (Note Box 5 below)		16.* <input type="checkbox"/>	
i. <input type="checkbox"/> DELETION OF INVENTOR(S) Signed statement attached deleting inventor(s) named in the prior application, see 37 CFR 1.63(d)(2) and 1.33(b)			
5. <input checked="" type="checkbox"/> 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.			
17. If a CONTINUING APPLICATION, check appropriate box and supply the requisite information: <input type="checkbox"/> Continuation <input type="checkbox"/> Divisional <input type="checkbox"/> Continuation-in-part (CIP) of prior application No: _____			

Petitioner argues that nothing in the transmittal form above identifies “with *detailed particularity* what specific material” Chu ’330 incorporates, citing testimony of John Kubiadowicz, Ph.D., for support. Pet. 31 (quoting *Hollmer v. Harari*, 681 F.3d, 1351, 1357 (Fed. Cir. 2012) (“*Hollmer*”); citing Ex. 1002 ¶ 105). Petitioner also avers that “box 5, which is *not* checked, states that it is only ‘useable if Box 4b is checked.’” and that “[e]ven if Box 4b were checked, Box 4b was limited ‘for continuation/divisional with Box 17 completed.’” *Id.* at 31, n.5.

However, Petitioner’s arguments and Dr. Kubiadowicz’s testimony narrowly focus on the transmittal form alone. *Id.* at 30–32; Ex. 1002 ¶ 105. 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 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.”).

The evidence before us shows that 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 the ’912 application, in which the applicant directed the Examiner to the transmittal form as support for the amendment (Ex. 1009, 26);

(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 392); and

(3) when the applicant filed a similar amendment in U.S. Application No. 12/561,138, as part of a separate priority chain of six reissue applications of U.S. Patent No. 6,643,777 B1 (Chu '777), directing the Examiner to the transmittal form submitted in the '882 application as support for the amendment (Ex. 2001, 363, 446 (Notice of Allowance and Fee(s) Due issued after entry of amendment adding figures and disclosure from Chu '886)).

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 F.3d at 1277. Instead, the Examiner entered the amendments and subsequently allowed the '912 application with the subject matter added from Chu '886. Ex. 1009, 419 (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 '758 application (initial parent application), and all eight continuation applications in the priority chain of the '797 patent, as well as Chu '777 and all six reissue applications in the priority chain of Chu '777, as noted in our Decision Denying Institution in IPR2021-00607, Paper 7 at 20. Moreover, none of the Examiners required the applicant to change its benefit claims from “continuation” to “continuation-in-part” in those 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) properly incorporated Chu '886 by reference. In addition, as discussed above, Petitioner admits that the '758 application (the initial parent application) incorporated by reference the '882 application. Pet. 28; *see also* Ex. 1013, 4:50–53. It also is undisputed that 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, 1:10–28, 9:36–39; Ex. 1008, 1:12–27, 9:27–29. As such, we also find that Petitioner has *failed to show* (1) the '797 patent is not entitled to a priority date before April 15, 2011, (2) the '436 patent's parent applications did not properly incorporate by reference Chu '886, (3) the amendments adding the subject matter from Chu '886 improperly introduced new matter, and (4) that there is no support for the added written description in the '436 patent, and hence the '797 patent, in the respective parent applications. Pet. 23–39.

(b) Transmittal form is part of the application

Petitioner argues that “[e]ven if the transmittal form of Chu [']330 included a statement that purportedly incorporated by reference the '886 Provisional” (Chu '886), “that statement would be inoperative because a [person of ordinary skill in the art]’s analysis of what a patent incorporates is limited to the four corners of the patent itself.” Pet. 32. 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.* Petitioner contends that “any incorporation by reference statement must have appeared in Chu [’]330 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; *PregisCorp. 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. 31–32 n.5.

Therefore, we are not persuaded by Petitioner’s arguments that (1) an incorporation by reference statement appearing 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 Chu [’]330 itself.” *Id.* at 32.

(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. 33 (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. 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 '912 application.

(d) *The incorporation by reference standard*

Petitioner argues that “[t]he reasonable Examiner standard does not apply to the analysis of the '797 Patent’s priority chain because these patents have issued.” Pet. 30 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’ (‘POSITA’) and ‘directly lead[s]’ a POSITA to the document . . . intended to be incorporated.” *Id.* at 29–30 (quoting *Hollmer*, 681 F.3d at 1357) (emphasis omitted, alterations in original).

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 “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 amendments that added the subject matter from Chu ’886 in the ’912 application so as to provide written description support for the claims of the ’797 patent. Accordingly, we exercise our discretion not to institute *inter partes* review. *Advanced Bionics*, Paper 6 at 8; *see also Becton, Dickinson*, Paper 8 at 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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