

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MAXLINEAR, INC.,  
Petitioner,

v.

CRESTA TECHNOLOGY CORP. and CF CRESPE LLC,  
Patent Owners.

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Case IPR2015-00594  
Patent 7,265,792 B2

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Before PHILLIP J. KAUFFMAN, GREGG I. ANDERSON, and  
PATRICK M. BOUCHER *Administrative Patent Judges*.

KAUFFMAN, *Administrative Patent Judge*.

FINAL WRITTEN DECISION  
*35 U.S.C. § 318(a) and 37 C.F.R. § 42.73*

## I. INTRODUCTION

### A. PROCEDURAL OVERVIEW

Petitioner, MaxLinear, Inc., filed a Petition (Paper 2, “Pet.”) to institute an *inter partes* review of claims 1–29 (the “challenged claims”) of U.S. Patent No. 7,265,792 B2<sup>1</sup> (Exhibit 1101, the “’792 patent”). Patent Owner, then Cresta Technology Corporation, timely filed a Preliminary Response (Paper 9, “Prelim. Resp.”). In the August 21, 2015, Decision to Institute (Paper 13, “Dec.”), we instituted trial on claims 1–29 with one ground based on 35 U.S.C. § 102(e) and seven grounds based on 35 U.S.C. § 103(a).<sup>2</sup>

Subsequently, Patent Owner filed a Patent Owner Response (Paper 23, “PO Resp.”), and Petitioner filed a corrected Reply (Paper 45, “Pet. Reply”).

Pursuant to a request from Petitioner, we directed Patent Owner to serve certain information as routine discovery.<sup>3</sup> Patent Owner did not file a motion to amend. Petitioner and Patent Owner each filed a Motion to Exclude certain evidence, which we discuss in Section II below.

Prior to Due Date 5, Cresta Technology Corporation filed for bankruptcy, and the Board suspended all deadlines in the case. *See* Paper 51 (notifying the Board); Paper 56 (ordering all deadlines suspended).

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<sup>1</sup> *See* Certificate of Correction dated March 11, 2014.

<sup>2</sup> The grounds are detailed in Section III.E. below.

<sup>3</sup> *See* Papers 25 (authorizing a motion), 27 (motion), 30 (Patent Owner’s Opposition), 33 (Petitioner’s Reply to the Opposition), 35 (decision on the Motion), 38 (Patent Owner’s notice of compliance); *see also* Ex. 1176 (Petitioner’s proposed Requests for Production identifying the requested information).

Subsequently, the '792 patent was assigned to CF CRESPE LLC, Cresta's counsel was retained, and this proceeding resumed. Papers 64<sup>4</sup> (defining the remaining schedule), 76 (CF CRESPE power of attorney), 77 (mandatory notice), 78 (motion to add Patent Owner), 81<sup>5</sup> (granting motion); Ex. 2011 (assignment to CF CRESPE, May 19, 2016).

Oral hearing was held on Friday, June 3, 2016, and a transcript of the oral hearing is included in the record.<sup>6</sup> Paper 89 ("Tr.").

For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 1–17 and 24–29 of the '792 patent are unpatentable, but has not made such a showing for claims 18–23.

#### B. RELATED PROCEEDINGS

Patent Owner asserted the '792 patent against Petitioner in *Cresta Technology Corp. v. Maxlinear, Inc.*, Case No. 1:14-cv-00079-RGA (D. Del.), and U.S. International Trade Commission Investigation No. 337-TA-910. *See* Pet. 1; Ex. 1102; Ex. 1103.

Petitioner and Petitioner's co-defendant in those proceedings, Silicon Laboratories, Inc., has filed the following petitions:

1. *IPR2014-00728 ("the '728 IPR") (US 7,075,585)*

We determined that claims 1–3, 5, 10, and 16–19 are unpatentable. *Silicon Laboratories, Inc. v. Cresta Technology Corp.*, Case IPR2014-00728,

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<sup>4</sup> *See also* Paper 66 confirming the resumed schedule.

<sup>5</sup> *See also* Paper 84 erratum to granting the motion.

<sup>6</sup> The hearing was held in conjunction with the hearing for IPR2015-00592, and a single transcript was produced.

(PTAB Oct. 21, 2015) (Paper 53). Patent Owner has appealed. *Id.* at Paper 55.

2. *IPR2014-00809 (“the ’809 IPR”) (US 7,265,792)*

We determined that claims 1–17 of the ’792 patent are unpatentable. *Silicon Laboratories, Inc. v. Cresta Technology Corp.*, Case IPR2014-00809, (PTAB Oct. 21, 2015) (Paper 56). Patent Owner has appealed. *Id.* at Paper 58.

3. *IPR2014-00881 (US 7,251,466 B2, “the ’466 patent”)*

We determined that claims 1, 2, 5, 8, 12, 13, 20, 21, 25, 26, 31, 32, 35, and 36 of the ’466 patent are unpatentable. *Silicon Labs., Inc. v. Cresta Tech. Corp.*, Case IPR2014-00881 (PTAB Oct. 21, 2015) (Paper 47).

4. *IPR2015-00591 (US 7,075,585)*

We denied institution of a trial. *MaxLinear, Inc., v. Cresta Technology Corp.*, Case IPR2015-00591 (PTAB June 15, 2015) (Paper 9).

5. *IPR2015-00592 (US 7,075,585)*

We instituted trial on claims 1–4, 6–9, and 16–21. *MaxLinear, Inc., v. Cresta Technology Corp. and CF CRESPE LLC.*, Case IPR2015-00592 (PTAB Aug. 14, 2015) (Paper 9).

6. *IPR2015-00593 (US 7,265,792)*

We denied institution of a trial. *MaxLinear, Inc., v. Cresta Technology Corp.*, Case IPR2015-00593 (PTAB Aug. 14, 2015) (Paper 9).

7. *IPR2015-00615 (US 7,075,585)*

We instituted trial on claims 11–15 and 20. *Silicon Laboratories, Inc. v. Cresta Technology Corp. and CF CRESPE LLC*, Case IPR2015-00615 (PTAB Aug. 14, 2015) (Paper 9). Oral hearing was held in conjunction with IPR2015-00626 on June 1, 2016.

8. IPR2015-00626 (US 7,265,792)

We instituted trial on claims 18, 19, and 24–29. *See Silicon Laboratories, Inc. v. Cresta Technology Corp. and CF CRESPE LLC*, Case IPR2015-00626, (PTAB Aug. 14, 2015) (Paper 9).

## II. PRELIMINARY MATTERS

### A. PETITIONER’S MOTION TO EXCLUDE EVIDENCE

Petitioner moves to exclude: (1) paragraphs 2 and 6–24 of the Declaration of Dominique Python (Ex. 2007), (2) paragraphs 2 and 6–24 of the Declaration of Didier Margairaz (Ex. 2008), and (3) the corresponding portions of Patent Owner’s Response.<sup>7</sup> Paper 50, 1–2 (“Pet. Mot.”). Patent Owner filed an Opposition to the Motion, and Petitioner filed a Reply to the Opposition. Papers 68, 75. At times, our analysis only addresses one of the two Declarations because the Declarations are largely identical in substance. *See* Mot. 2; Ex. 2007, Ex. 2008. For the reasons that follow, Petitioner’s motion is *denied-in-part and granted-in-part*.

#### 1. Objections

The Declarations at issue were filed on Friday, December 4, 2015, in association with Patent Owner’s Response. Petitioner’s objections were

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<sup>7</sup> Petitioner does not seek to exclude the entirety of the cited paragraphs; rather, Petitioner seeks to exclude the portions of the identified paragraphs that are highlighted in the versions of Exhibits 2007 and 2008 attached to that Motion as Appendix A and Appendix B, respectively. *See* Mot. 1 n.1.

timely filed on Friday, December 11, 2015.<sup>8</sup> *See* Paper 24; 37 C.F.R. § 42.64(b)(1).

Regarding content, Petitioner objected to paragraphs 6–24 of both exhibits with sufficient particularity by asserting that the declarants lacked personal knowledge and that the testimony was improper opinion by a lay witness. *See* Paper 24, 1–4; 37 C.F.R. § 42.64(b)(1). Petitioner did not object to paragraph 2 of either Declaration, nor did Petitioner object to the corresponding portions of Patent Owner’s Response.<sup>9</sup> *See* Paper 24. For that reason, Patent Owner was not afforded an opportunity to correct in the form of supplemental evidence. *See* 37 C.F.R. § 42.64(b)(1). Consequently, Petitioner’s Motion is deficient on this basis with regard to paragraph 2 of the Exhibits at issue and the corresponding portions of Patent Owner’s Response.

Petitioner preserved the objections by filing this Motion to Exclude, asserting that the testimony in the identified portions is not based on the personal knowledge of the witness, and is improper opinion by a lay witness. Pet. Mot. 1.

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<sup>8</sup> Petitioner states that the Exhibits at issue were served on December 7, 2015, while Patent Owner’s certificate of service indicates the Exhibits were served on December 4, 2015. *See* Paper 24, 1; PO Resp. 27. We need not determine when the Exhibits were served because Petitioner’s filing is timely for either service date.

<sup>9</sup> With regard to the corresponding portions of Patent Owner’s Response, Petitioner’s Motion is deficient in that it fails to identify those portions. *See* 37 C.F.R. §§ 42.20(c), 42.22. Additionally, a motion to exclude applies to evidence and not a paper, such as Patent Owner’s Response. *See generally* 37 C.F.R. §§ 42.61, 42.63(a), 42.64.

2. *Personal Knowledge*

Petitioner argues that the portions of the exhibits at issue should be excluded because the declarants lack the personal knowledge required by Federal Rule of Evidence 602. Mot. 2–3; Paper 75, 1–5.

Most of Petitioner’s Motion and Reply to Patent Owner’s Opposition deals with issues other than admissibility. For example, Petitioner mentions that: the Declarations were prepared by Patent Owner’s CTO (Mr. Murgulescu), the named inventors disagree on who conceived of what subject matter, Patent Owner “concocted” the declarant’s alleged misunderstanding of conception, the testimony at issue is inconsistent with prior testimony, and the burden of proof has not shifted back to Petitioner. Mot. 2–4; Paper 75, 2–5. Such matters do not relate to the admissibility of the evidence. See Paper 68, 1–4 (pointing out some of these matters); see also Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012) (“A motion to exclude must explain why the evidence is not admissible (*e.g.*, relevance or hearsay) but may not be used to challenge the sufficiency of the evidence to prove a particular fact.”).

Petitioner makes one contention related to admissibility, namely, that the declarants had no personal knowledge of Mr. Mombers’s deposition. Mot. at 4–5; Paper 75, 1. Of the evidence identified by Petitioner, only the last two sentences of the highlighted portion of paragraph 20 of Exhibit 2007 relate to Mr. Mombers’s testimony. The highlighted portion of paragraph 20 follows:

Regarding the subject matter claimed by claims 1, 2, 4, 5, 11 and 24-29 of the '792 patent, Mr. Mombers worked to build products that practiced certain elements of the claims, which I understand is referred to as “reducing the invention to practice.” He did not conceive of the claimed features of the

products, and instead helped, under the guidance and supervision of others, to build the Xceive products that operated according to our inventions. Mr. Mombers' testimony that he "conceived" of some parts of claims 1, 4, 5, 24, and 25 is incorrect under the particular meaning of "conception" as it applies in patent law. Mr. Mombers is an engineer, and likely testified using that term as it would be understood by a layman or engineer.

Pet. Mot. App'x A ¶ 20.

Mr. Python was not present at Mr. Mombers's deposition, and did not discuss that deposition with Mr. Mombers. Mot. 4–5; Paper 75, 1; Ex. 1208, 27:3–28:8. Mr. Python has personal knowledge that Mr. Mombers is an engineer. Ex. 2007 ¶¶ 7–24. However, we find Mr. Python has no personal knowledge of whether Mr. Mombers's understanding of the term "conception" is attributable to Mr. Mombers being an engineer. Pet. Mot. 4–5; Ex. 1208, 28:1–31:10. Patent Owner's contentions regarding Mr. Python's personal knowledge do not explain persuasively how Mr. Python observed or perceived anything that provided knowledge of Mr. Mombers's understanding of the term "conception." See Paper 68, 4–8. Consequently, we find Mr. Python lacks personal knowledge for the statement, "Mr. Mombers is an engineer, and likely testified using that term as it would be understood by a layman or engineer."

In contrast, we find Mr. Python has personal knowledge of whether Mr. Mombers conceived of some parts of certain claims. For example, Mr. Python testified that Mr. Mombers worked under Mr. Python's direction to build products that were separately conceived. Ex. 2007 ¶¶ 1, 23. Even though Mr. Python did not attend Mr. Mombers's deposition and did not discuss that deposition with Mr. Mombers, Mr. Python has personal

knowledge of what is stated, namely, whether Mr. Momber's conceived some parts of certain claims. Based on this, we find Mr. Python had personal knowledge for stating that "Mr. Mombers' testimony that he 'conceived' of some parts of claims 1, 4, 5, 24, and 25 is incorrect under the particular meaning of 'conception' as it applies in patent law."

Accordingly, Petitioner has persuaded us that the last sentence of paragraph 20 of Exhibits 2007 and 2008 should be excluded under Federal Rule of Evidence 602 due to a lack of personal knowledge by the declarant. Petitioner has not so persuaded us with regard to any other identified testimony. *See* 37 C.F.R. §§ 42.20(c), 42.22

3. *Lay Opinion*

Petitioner argues that the identified portions of the Declarations are inadmissible under Federal Rule of Evidence 701. Mot. 6–7. In support, Petitioner repeats the assertion that the witnesses lack personal knowledge. *Id.* According to Petitioner, Patent Owner's CTO drafted the Declarations, illustrating that the declarant's statements regarding conception are Patent Owner's perceptions and not their own. *Id.* Petitioner also contends that the declarations further confuse the issue because they are inconsistent with prior testimony. *Id.* at 7.

As detailed above with regard to Federal Rule of Evidence 602, the witnesses lack personal knowledge for the statement, "Mr. Mombers is an engineer, and likely testified using that term as it would be understood by a layman or engineer." Consequently, this statement is not rationally based on the witness's perception and also should be excluded under Federal Rule of Evidence 701.

Regarding preparation of the Declarations, we agree with Patent Owner that Mr. Python explained that Mr. Morgulescu (Patent Owner's CTO) did not tell him what to say; rather, Mr. Morgulescu prepared the declarations based on Mr. Python's recollections so that the substance of the declaration was his own. Paper 68, 2–3. Whether Mr. Morgulescu typed-up the Declarations is immaterial to admissibility. *Id.* at 3. Likewise, Petitioner's contention that the Declarations are inconsistent with prior testimony is not material in an admissibility determination.

For the remaining identified portions of the Exhibits at issue, the declarant's opinions are rationally based on the witness's perception as discussed above with regard to Federal Rule of Evidence 602. This information is helpful to understand each witness's testimony regarding a fact in issue (who conceived of which claims), and is not based on specialized knowledge under Federal Rule of Evidence 702.

Accordingly, Petitioner has persuaded us that the last sentence of paragraph 20 of each Exhibit at issue at should be excluded under Federal Rule of Evidence 701 because it is not rationally based on the witness's perception. Petitioner has not so persuaded us with regard to the remaining testimony at issue. *See* 37 C.F.R. §§ 42.20(c), 42.22

#### 4. *Conclusion*

We grant Petitioner's Motion to Exclude Evidence with regard to the last sentence of paragraph 20 of the Declaration of Dominique Python (Ex. 2007) and the Declaration of Didier Margairaz (Ex. 2008). We deny Petitioner's Motion with regard to the remaining portions of those Exhibits as well as the corresponding portions of Patent Owner's Response.

B. PATENT OWNER’S MOTION TO EXCLUDE EVIDENCE

1. *Introduction*

Patent Owner moves to exclude Exhibits 1214–1221. Paper 53, 1 (“PO Mot.”).

| Exhibit # | Description <sup>10</sup>                                                     |
|-----------|-------------------------------------------------------------------------------|
| 1214      | Declaration of Mr. Hiroki Minaki                                              |
| 1215      | Pierre Favrat LinkedIn                                                        |
| 1216      | Philippe Duc LinkedIn                                                         |
| 1217      | Alain-Serge Porret LinkedIn                                                   |
| 1218      | Frederich Mombers LinkedIn                                                    |
| 1219      | Printout showing Xceive’s application for H1B visa granted on August 28, 2001 |
| 1220      | Printout showing Xceive’s application for H1B visa granted on August 29, 2001 |
| 1221      | Didier Margairaz LinkedIn                                                     |

Our analysis does not rely upon any of the challenged exhibits. Consequently, we deny Patent Owner’s Motion to Exclude evidence as moot.

III. PATENTABILITY

A. INTRODUCTION

We agree with Petitioner that Patent Owner essentially asserts that Favrat discloses the limitations of the claims subject to the ground of unpatentability based on anticipation by Favrat, and that Patent Owner presents no arguments that the subject matter of the remaining claims was nonobvious over the asserted grounds of unpatentability. *See* Pet. Reply 3–4, 16–17; PO Resp. 7–18 (detailing how the claims subject to the ground of

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<sup>10</sup> *See* Paper 87, Petitioner’s Corrected Exhibit List.

unpatentability based on anticipation by Favrat were disclosed in the Favrat Specification); Paper 14, 3 (“The patent owner is cautioned that any arguments for patentability not raised in the response will be deemed waived.”). Patent Owner’s only argument other than those discussed in the Preliminary Matters Section above, is that Favrat is not prior art to the ’792 patent. Specifically, Patent Owner contends that Favrat is not prior art in that the claims alleged to be anticipated by Favrat are not “by another” under § 102(e), and the remaining grounds of unpatentability under § 103(a) are precluded by § 103(c). PO Resp. 4–25.

In light of Patent Owner’s arguments, Petitioner contends, in its Reply, that Favrat is also prior art under § 102(a). Pet. Reply 24–25.

In the subsections that follow, we address: (1) whether Favrat is “by another” under § 102(e), (2) the applicability of the safe haven of § 103(c), (3) whether Favrat is prior art under § 102(a), and (4) the remainder of the patentability inquiry.

B. “BY ANOTHER” UNDER 35 U.S.C. § 102(e)<sup>11</sup>  
CLAIMS 1, 2, 4, 5, 11, 24–29

1. *Introduction and Burden*

Petitioner challenges claims 1, 2, 4, 5, 11, 24–29 as anticipated by Favrat under 35 U.S.C. § 102(e). Pet. 19–29. In particular, Petitioner asserts that Favrat and the ’792 patent are by different inventive entities and therefore are “by another” under § 102(e). *Id.* at 14–15.

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<sup>11</sup> Within this subsection the “challenged claims” means the claims subject to the ground of unpatentability based on anticipation by Favrat.

A reference is not prior art under section § 102(e) unless it was created “by another.” 35 U.S.C. § 102(e). A reviewing body “must look beyond the superficial fact that the references were issued to different inventive entities. What is significant is not merely the differences in the listed inventors, but whether the portions of the reference relied on as prior art, and the subject matter of the claims in question, represent the work of a common inventive entity.” *Riverwood Int’l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1356 (Fed. Cir. 2003) (citing *In re DeBaun*, 687 F.2d 459, 462, (CCPA 1982)).

We refer to Pierre Favrat, Didier Margairaz, Alain-Serge Porret, and Dominique Python as Group A, and we refer to Friederich Mombers, Richard P. Perring, Philippe Duc, and Benito Carnero as Group B.<sup>12</sup> The named inventors of Favrat are Group A, and the named inventors of the ’792 patent are Group A and Group B. *See* Ex. 1104 (75); Ex. 1101 (75).

Favrat was, filed on September 6, 2002, published on April 1, 2004, issued on July 11, 2006, and claims priority to provisional application 60/322,548 filed on September 17, 2001. Ex. 1104, 1 (22) (60) (65); *see also* PO Resp. 22 (acknowledging this publication date).

The ’792 patent was filed on July 1, 2004, and makes no claim of priority to any other application, to include the application that became Favrat. Ex. 1101, 1 (22); *see also* Tr. 27:14–25 (Petitioner explaining why the ’792 patent is not a continuation).

The inventorship inquiry is a claim-by-claim analysis. Each of the claims subject to this ground of unpatentability depends from independent

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<sup>12</sup> The parties use the same group designations. *See, e.g.*, PO Resp. 5–6; Pet. Reply 4–5.

claim 1. Consequently, if at least one member of Group B conceived of at least one limitation of claim 1, then Favrat is “by another” as required by § 102(e).

We agree with Patent Owner that the burden of persuasion to establish unpatentability is Petitioner’s burden and that burden never shifts to Patent Owner. See PO Resp. 3–4; 35 U.S.C. § 316(e); *Nike, Inc. v. Adidas AG*, 812 F.3d 1326, 1334 (Fed. Cir. 2016).

Patent Owner argues that Petitioner has not met the burden of establishing that Favrat is “by another” as required by § 102(e). PO Resp. 4–25. Petitioner responds that Patent Owner is incorrect in that the burden of production has shifted to Patent Owner. Pet. Reply 2–3 (citing *Dynamic Drinkware, LLC v. National Graphics, Inc.*, 800 F.3d 1375, 1378–79 (Fed. Cir. 2015)).

The shifting burden of production is not applicable to our analysis under § 102(e). See *In re Magnum Oil Tools Int’l, Ltd.*, 2016 WL 3974202, No. 2015-1300, slip op. at 13–18 (Fed. Cir. 2016). Patent Owner here, like the patent owner in *Magnum Oil Tools*, seeks to disprove Petitioner’s contention. *Magnum Oil Tools*, slip op. at 16. The inquiry before us is whether Petitioner has shown by a preponderance of the evidence that Favrat is “by another” as required by § 102(e).

## 2. *Burden Need Not Be Met in the Petition*

Patent Owner argues that Petitioner was obligated to establish that Favrat is prior art in the Petition itself. PO Resp. 3–4. In support of this argument, Patent Owner cites to several authorities: (1) *Marvell Semiconductor, Inc. v. Intellectual Ventures I LLC*, IPR2014-00552, slip op. at 7 (PTAB Nov. 23, 2015) (Paper 79), (2) 37 C.F.R. § 42.104(b), (3) *Cisco*

*Systems, Inc. v. C-Cation Techs., LLC*, Case IPR2014-00454, slip op. at 10 (PTAB Aug. 29, 2014) (Paper 12) (informative), and (4) Institution Decision at 9. PO Resp. 3–4.

The authorities cited by Patent Owner do not support Patent Owner's argument. *Marvell*, a routine (non-precedential) Board decision, states that a petitioner carries the burden of persuasion to establish that a reference is prior art, but does not state that such burden must be met in the petition. *Marvell Semiconductor, Inc. v. Intellectual Ventures I LLC*, slip op. at 7. Rule 42.104(b) enumerates certain requirements for a petition; however, the rule does not require that a petition meet the ultimate burden of persuasion of a preponderance of the evidence at the institution stage of the proceeding. *Cisco Systems*, an informative (non-precedential) Board decision, does not deal with the sufficiency of proof in a petition; rather, this case stands for the proposition that the practice of citing evidence (*e.g.*, a declaration) to support conclusory statements that are not otherwise in the petition amounts to improper incorporation by reference as prohibited by 37 C.F.R. § 42.6. *Cisco Systems*, slip op. at 9–10 (“[W]e will not consider arguments that are not made in the Petition.”). Our Institution Decision explains that the inventorship shown on the faces of Favrat and the '792 patent would not necessarily meet the ultimate burden of persuasion at the conclusion of these proceedings. Dec. 8–10. This statement was made in the interests of properly developing the record and was not an indication that such showing was required in the petition.

Petitioner's ultimate burden is evaluated here in our Final Written Decision.

3. *Analysis*

a) *ITC Proceeding*

On October 31, 2014, and December 12, 2014, Patent Owner submitted the pre-trial and post-trial briefs to the ITC, and stated in each that Favrat “is prior art to the ’792 patent pursuant to pre-AIA 35 U.S.C. § 102(e).”<sup>13</sup> Ex. 1209, 7;<sup>14</sup> Ex. 1207, 3; Pet. Reply 1. Patent Owner argued that Favrat does not anticipate certain claims of the ’792 patent because Favrat lacks a signal output circuit as claimed. Ex. 1209 at 8–10; Ex. 1207, 3–5; Pet. Reply 1.

Mr. Mombers, a Group B inventor, testified that he conceived of at least one limitation of claim 1 (the signal processor). Ex. 1205, 49:24–52:5<sup>15</sup> (testifying Aug. 5, 2014); Pet. Reply 5–6. Mr. Python, a Group A inventor, testified that Messrs. Mombers and Perring, Group B inventors, conceived of at least one limitation of claim 1 (the signal processor). Ex. 1194, 30:21–31:9 (testifying July 17, 2014); Pet. Reply 5. Mr. Margairaz, a Group A inventor, testified that he could not recall who conceived of various limitations, to include the inability to recall who conceived of the signal processor of claim 1. Ex. 1206, 67:24–70:9; Pet. Reply 8–9.

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<sup>13</sup> Because the ’792 patent was filed before the enactment of the Leahy–Smith America Invents Act, Pub.L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), the pre-AIA version of 35 U.S.C. § 102(e) applies in this trial.

<sup>14</sup> Here, and throughout, we refer to the Exhibit page number rather than the native page number. For example, page 7 of Exhibit 1209 is native page 373, and page 3 of Exhibit 1207 is native page 169.

<sup>15</sup> Native page 49 is page 14 of this Exhibit.

b) *Messrs. Margairez and Python*

As detailed above, Patent Owner now contends that Favrat is not prior art under § 102(e) because it was not created “by another,” and, in support, provides the Declarations of Mr. Python and Mr. Margairez. PO Resp. 4–25. Before analyzing these Declarations in light of all pertinent evidence, we note that we do not treat Patent Owner’s statement to the ITC regarding Favrat as prior art as a thing decided. Rather, the arguments and evidence of the ITC proceeding that are submitted and argued in this proceeding are factors for our consideration here. *See generally Texas Instruments Inc. v. Cypress Semiconductor Corp.*, 90 F.3d 1558, 1569 (Fed. Cir. 1996) (ITC decision has no preclusive effect in other forums but district court can attribute persuasive value to a prior ITC decision, as justified); *see also* Tr. 32:6–11 (acknowledging that Patent Owner may assert a different argument in this *inter partes* review than asserted in the ITC proceeding).

Mr. Margairez prepared for two days for his ITC deposition, and the schedule for that deposition identified conception and reduction to practice as topics. Ex. 1210, 33:9–38:2, 42:1–11.

Mr. Margairez’s Declaration does not explain effectively why at the ITC deposition in August 2014 he could not recall who conceived of which limitation and then in December 2015 in his Declaration for this proceeding, he knew that only Group A inventors conceived of the challenged claims. Pet. Reply 8–9, 13–14; *cf.* Ex. 1210, 67:24–70:9; Ex. 2008 ¶¶ 6–8.

The following exchange took place during cross-examination of Mr. Margairez at his deposition for this proceeding, with regard to preparation for the ITC deposition on the topics of conception and reduction to practice:

Mr. Margairez: We talked about it, but I don't know if at that time I had the right understanding between “conception” and “reduction to practice.” At least today, it’s clear that I understand.

Question: Oh, it’s clear for you now?

Mr. Margairez: Yeah, for me it’s very clear now what is conception, what is reduction to practice.

Question: You have a tough time remembering how clear it was for you eighteen months ago?

Mr. Margairez: Yeah, for sure.<sup>16</sup>

Ex. 1210, 45:10–13; *see also id.* at 54:17–55:1 (stating that with his current knowledge he understood conception); Pet. Reply 10.

The change in Mr. Margairez’s testimony from an inability to recall who conceived of which limitation to stating that Group A alone conceived of the challenged claims, is a significant change. Mr. Margairez’s Declaration offers no explanation for that change. Mr. Margairez’s statement at the deposition for this proceeding that, “I don’t know if at the time [meaning at the time of the ITC deposition] I had the right understanding” is unpersuasive for two reasons: it lacks detail, and it lacks conviction. Mr. Margairez does not provide persuasive details regarding the change in testimony. Mr. Margairez did not state unequivocally that during the ITC proceeding he did not understand; rather, he states that he does not know if he did. Further, given two days of preparation, and that conception was a known topic for the deposition, it is reasonable to conclude that Mr. Margairez’s preparation for the ITC deposition covered conception and reduction to practice.

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<sup>16</sup> Mr. Margairez testified with the aid of a French interpreter. *See* Ex. 1208, 2:25.

At the ITC deposition Mr. Python was charged with making answers for the corporation, and conception was a scheduled topic. Ex. 1208, 54:19–25, 55:25–56:11; Pet. Reply 8. Mr. Python’s Declaration does not explain why at the ITC deposition in July 2014 he stated that Mr. Mombers and Mr. Perring, Group B inventors, conceived of the signal processor of claim 1 of the ’792 patent and then in his December 2015 Declaration he stated that only Group A inventors conceived of the challenged claims. Ex. 1194, 145:21–146:9; Ex. 2007 ¶¶ 6–8; Pet. Reply 10, 13–14. At his deposition for this proceeding, with regard to the topic of conception during the ITC deposition, Mr. Python stated,

at the time some confusion in my answer between conception, between reduction to practice. So, and sometimes when we’d review this, it’s clear I had -- some of my questions are maybe not totally accurate.<sup>17</sup>

Ex. 1208, 58:7–12; Pet. Reply 10.

The change in Mr. Python’s testimony from stating that Group B inventors (Mr. Mombers and Mr. Perring) conceived of the signal processor of claim 1 to stating that Group A alone conceived of the challenged claims, is a significant change. Mr. Python’s Declaration offers no explanation for the change. Mr. Python’s statement at his deposition for this proceeding that he had “some confusion” at the time of the ITC deposition lacks both detail and conviction. Mr. Python does not provide persuasive details regarding the change in testimony. For example, during the ITC proceeding Mr. Python stated that Mr. Perring conceived of the signal processor of claim 1 and Mr. Python’s Declaration makes a general reference to Group B

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<sup>17</sup> Mr. Python testified with the aid of a French interpreter. See Ex. 1208, 2:25.

inventors, but does not mention Mr. Perring specifically. Mr. Python did not state unequivocally that during the ITC proceeding he did not understand conception; rather, he states that he had “some confusion.” Further, given that Mr. Python was authorized to answer for the corporation, and that conception was a known topic for the deposition, it is reasonable to conclude that Mr. Python’s preparation for the ITC deposition covered conception.

*c) Digital/Analog Distinction*

Group A specialized in analog design and Group B in digital. *See, e.g.*, Ex. 1210, 24:1–14; Ex. 1208, 68:13–25; Pet. Reply 11, 16. The signal processor of claim 1 is a digital component, suggesting that the digital expertise, such as Group B inventors was required. *See* Pet. Reply 11–12, 16; Ex. 1211 (copy of the ’792 patent as marked by Mr. Margairez).

Mr. Python and Mr. Margairez each state that Mr. Mombers did not conceive any of the challenged claims; rather, he assisted in reducing the subject matter of those claims to practice. Ex. 2007 ¶¶ 20–23; Ex. 2008 ¶¶ 20–23. We give this testimony little weight for the reasons given above. Additionally, the Declarations of Messrs. Python and Margairez do not explain cogently how this digital aspect of claim 1 was conceived by Group A having only analog expertise. Exs. 2007, 2008.

*d) Disclosure of Favrat*

Patent Owner contends that the subject matter of claims 1, 4, 5, and 11 of the ’792 patent were fully disclosed in Favrat. PO Resp. 7–11 (citing Ex. 2007 ¶¶ 9–19, Ex. 2008 ¶¶ 9–19). This line of argument sheds little or no light on our inventorship inquiry. If Group B inventors contributed to subject matter that was disclosed but not claimed in Favrat, those individuals

would not be listed as inventors on Favrat because their contributions were not claimed.

*e) Claims 13–23*

Patent Owner contends that the Group B inventors only contributed to claims 13–23. PO Resp. 11–15 (citing Ex. 2007 ¶¶ 6–8, 10–19, Ex. 2008 ¶¶ 6–8, 10–19). This line of argument sheds little or no light on our inventorship inquiry. Petitioner’s contention is that at least one Group B inventor contributed to claims 1, 2, 4, 5, 11, 24–29, and whether Group B inventors contributed to claims 13–23 is largely an independent question.

*f) Corroboration*

As mentioned above, Mr. Mombers, a Group B inventor, testified that he conceived of at least one limitation of claim 1 (the signal processor). Ex. 1205, 49:24–52:5<sup>18</sup>; Pet. Reply 5–6. This testimony is consistent with all of the evidence presented to the ITC as detailed above. Further, this testimony is corroborated by Patent Owner’s statement to the ITC that Favrat is prior art. See Ex. 1209, 7; Ex. 1207, 3; Pet. Reply 1; see also *Zenith Electronics Corp. v. PDI Communication Systems, Inc.*, 522 F.3d 1348, 1357 (Fed. Cir. 2008) (relying upon an opposing party’s admissions as corroboration for inventor testimony). Whether or not corroboration was required on this issue, the presence of corroboration is a factor weighing in favor of Mr. Mombers’s testimony to the ITC. See generally *Medtronic, Inc. v. White, et al*, 526 F.3d 487, 498 (Fed. Cir. 2008) (“[A]ll that is necessary to constitute an admission is a previous statement by an adversary party which

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<sup>18</sup> Native page 49 is page 14 of this Exhibit.

is inconsistent with the position he is taking in litigation.” (quoting *Technitrol, Inc. v. United States*, 440 F.2d 1362, 1370 (1971))).

We do not agree with Petitioner that Patent Owner failed to carry its burden of production due to a lack of corroboration because, as detailed above, the burden of production is not applicable to this inquiry. *See* Pet. Reply 9–10. However, whether or not the witness testimony provided by Patent Owner must be corroborated, the lack of corroboration reduces the weight we afford these Declarations. *See In re Garner*, 508 F.3d 1376, 1380 (Fed. Cir. 2007) (“[A]n inventor’s testimony as to the facts of invention must be corroborated by independent evidence.”); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1368 (Fed. Cir. 2004) (“[T]he Board is entitled to weigh the declarations and conclude that the lack of factual corroboration warrants discounting the opinions expressed in the declarations.”).

*g) Patent Owner’s Alternative Argument*

Patent Owner asserts that even if Groups A and B jointly conceived of the subject matter of the challenged claims, controlling precedent makes clear that Favrat is not prior art under § 102(e). PO Resp. 18–21 (citing *In re Kaplan*, 789 F.2d 1574 (Fed. Cir. 1986)). Patent Owner provides the following quote from *Kaplan*,

When . . . inventor A commonly discloses the invention of A & B in the course of describing his sole invention and when he so describes the invention of A & B he is not disclosing 'prior art' to the A & B invention, even if he has legal status as 'another.' [the reference to 'another' is to that word as used in 35 USC 102(e) and (g).]

PO Resp. 20 (quoting *Kaplan*, 789 F.2d at 1576).

Petitioner points out that Patent Owner’s quote omits important language, (language omitted by Patent Owner is underlined):

When the joint and sole inventions are related, as they are here, inventor A commonly discloses the invention of A & B in the course of describing his sole invention and when he so describes the invention of A & B he is not disclosing “prior art” to the A & B invention, even if he has legal status as “another.”

Pet. Reply 14. Favrat and the '792 patent are not related. See Ex. 1101, 1; Ex. 1104, 1 (60). We agree with Petitioner that *Kaplan* is distinguishable on this basis.<sup>19</sup> See Pet. Reply 14–16.

*h) Conclusion*

Patent Owner admitted before the ITC that Favrat was prior art under § 102(e), and now in our proceeding argues that it is not. Such a contention is analogous to a patent owner asserting one claim construction to avoid anticipation and another construction to find infringement, a practice the Federal Circuit has strongly discouraged. See *Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1351 (Fed. Cir. 2001) (“A patent may not, like a ‘nose of wax,’ be twisted one way to avoid anticipation and another to find infringement.” (quoting *Sterner Lighting, Inc. v. Allied Elec. Supply, Inc.*, 431 F.2d 539, 544 (5th Cir. 1970))).

Mr. Mombers, a Group B inventor, testified to the ITC that he conceived of the signal processor of claim 1, the sole independent claim of the '792 patent, and thus conceived of every claim of the '792 patent. All of the evidence presented to the ITC that was submitted and argued here is consistent with Mr. Mombers's assertion. Patent Owner corroborated this testimony by stating that Favrat is prior art under § 102(e), meaning it is “by another.” Considering the entire admissible record, we determine that a

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<sup>19</sup> *In re Land*, 368 F.2d 866 (Fed. Cir. 1966), is also distinguishable because the patents were related.

preponderance of the evidence demonstrates that Favrat is “by another” as required by § 102(e).

C. FAVRAT UNDER 35 U.S.C. § 103(c)<sup>20</sup>

1. *Introduction and Burden*

The remaining grounds of unpatentability are based at least in part on Favrat under § 103(a), and involve claims 3, 6–10, and 12–23. Prior art under § 102(e) may not render a claim obvious under § 103 where both patents were, “at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.” 35 U.S.C. § 103(c)(1).

As explained above, Petitioner bears the burden of persuasion to prove unpatentability by a preponderance of the evidence, and that burden never shifts to Patent Owner. However, where, as here, a patent owner affirmatively seeks to establish a proposition not relied on by Petitioner and not a necessary predicate for unpatentability, the shifting burden of production is warranted. *See Magnum Oil Tools*, slip op. at 16. Patent Owner’s contention that the safe haven of § 103(c) applies is such a proposition. Consequently, Patent Owner bears the burden of production to establish: (1) the date on which the ’792 patent was made, and (2) that as of that date, the ’792 patent and Favrat were “owned by the same person or subject to an obligation of assignment to the same person.” *See* 35 U.S.C. § 103(c)(1); *see, e.g., Marvell Semiconductor, Inc. v. Intellectual Ventures I*

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<sup>20</sup> As explained above, the ’792 patent was assigned to CF CRESPE LLC on May 19, 2016. *See* Ex. 2011. This assignment is not relevant to our analysis here.

*LLC*, IPR 2014-00552, slip op. at 7 (PTAB Nov. 23, 2015) (Paper 79). This interpretation is consistent with Manual of Patent Examining Procedure § 706.02(l)(2) which provides (emphasis added):

[t]o place the burden upon the patent examiner **or the defendant in litigation** would not be appropriate since evidence as to common ownership at the time the claimed invention was made might not be available to the patent examiner or the defendant in litigation, but such evidence, if it exists, should be readily available to the patent applicant or the patentee.

See generally *Promega Corp. v. Applied Biosystems, LLC*, No. 13-cv-2333, 2013 WL 2898260, \*5 (N.D. Ill. June 12, 2013) (citing with approval this MPEP guidance).

## 2. Analysis

Regarding when the '792 patent “was made,” Patent Owner states that “[t]he '792 invention presumptively ‘was made’ [it’s filing date of] July 1, 2004.” PO Resp. 24 (citing *Yasuko Kawai v. Metlesics*, 480 F.2d 880, 886 (CCPA 1973) and citing Dec. 10).<sup>21</sup> Patent Owner cites *Yasuko Kawai* for the proposition that the filing date is the constructive reduction to practice of an invention. *Id.*

Regarding common ownership or an obligation of assignment, Patent Owner provides argument and evidence that Favrat was assigned to Xceive Corporation on September 5, 2002, and was owned by Xceive until it was assigned to Cresta Technology Corporation in 2011. PO Resp. 23–24 (citing assignment records at Exs. 2003, 2004). Patent Owner contends that all of the named inventors of the '792 patent (Groups A and B) assigned their

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<sup>21</sup> See also PO Resp. 22–23 (asserting that the '792 patent was filed on July 1, 2004, with regard to a contention that Favrat is not prior art under § 102(b)).

rights to Xceive on June 30, 2004, and this assignment was submitted to the Patent Office on July 1, 2004. PO Resp. 24 (citing Ex. 2005). Patent Owner contends that the '792 patent was owned by Xceive until 2011 when it was assigned to Cresta Technology Corporation. *Id.* (citing Ex. 2004). Patent Owner's argument and evidence applies to all of the claims subject to a ground of unpatentability under § 103(a), and shifted the burden of production to Petitioner.<sup>22</sup>

In response, Petitioner argues that Patent Owner has not demonstrated that the safe haven of § 103(c) applies. Pet. Reply 16–24 (citing Patent Owner's response to interrogatories from the ITC proceeding in Exhibit 1212). We evaluate Petitioner's argument in two claim groupings.

a) *Claims 3, 6–10, and 12–17*

With regard to these claims, Petitioner presents argument and evidence that Patent Owner previously asserted an earlier conception and reduction to practice. *See* Pet. Reply 16–24; Ex. 1212, 5–6. This carried Petitioner's burden of production. The inquiry is then whether the evidence demonstrates that the safe haven of § 103(c) applies.

Patent Owner offers no evidence regarding conception or reduction to practice; rather, Patent Owner seeks to rely on the filing date of the '792 patent. *See* PO Resp. 24. Reliance on such a presumption fails, where, as here, there is sufficient contrary evidence to rebut the presumption. During the ITC proceeding, Patent Owner responded to interrogatories by stating

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<sup>22</sup> The burden of production is the burden of “producing additional evidence and presenting persuasive argument based on new evidence or evidence already of record.” *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008) (cited with approval in *Magnum Oil Tools*, slip op. at 15).

that claims 3, 6–10, and 12–17 were conceived in May 2001 and reduced to practice in May 2003. Ex. 1212, 5–5. In order to assert these dates in good faith, Patent Owner was required to have evidence of such. Even if Patent Owner subsequently discontinued an attempt to prove an earlier priority date, that does not negate the fact that Patent Owner had some evidence and made a representation of earlier conception and reduction to practice dates.<sup>23</sup>

Consequently, with regard to claims 3, 6–10, and 12–17, Patent Owner has failed to carry its burden of establishing when the '792 patent “was made.” As a result, the safe haven of § 103(c) does not apply, and we need not reach the question of common ownership or obligation of assignment as of the filing date of the '792 patent.

*b) Claims 18–23*

The evidence provided by Petitioner does not address claims 18–23. See Ex. 1212, 5–6. That is, Patent Owner did not assert these claims were conceived and reduced to practice at an earlier date. Given the absence of evidence to the contrary, the presumption that the '792 patent “was made” as of its filing date applies. Our inquiry is then whether as of that date, Favrat and the '792 patent were “owned by the same person or subject to an obligation of assignment to the same person.” See 35 U.S.C. § 103(c)(1).

As explained above, Patent Owner asserts, with supporting evidence, that Favrat and the '792 patent were commonly owned as of the filing date of the '792 patent. Petitioner provides no evidence to the contrary regarding

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<sup>23</sup> Petitioner contends, without supporting evidence, that because the references asserted against Patent Owner in the ITC proceeding predated even the May 2001 date, Patent Owner changed to rely upon the filing date of the '792 patent as the priority date. Pet. Reply 19 n.9.

common ownership or evidence of assignment as of the filing date of the '792 patent. Rather, Petitioner provides argument and evidence regarding common ownership and obligation of assignment for dates prior to the filing date of the '792 patent. *See* Pet. Reply 17–24. We need not consider this argument and evidence as it does not pertain to the date at issue (i.e., the filing date of the '792 patent, which is the date that claims 18–23 were made). In light of this, Patent Owner has demonstrated that claims 18–23 are subject to the safe haven of § 103(c). Consequently a ground of unpatentability based on obviousness may not be asserted against Patent Owner for these claims.

D. FAVRAT UNDER § 102(a)

The applicable version of § 102(a) requires that “the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.” 35 U.S.C. § 102(a). Petitioner’s Reply relies on the filing date of the '792 patent (July 1, 2004) for the contention that Favrat is prior art under § 102(a). Pet. Reply 24–25. The significance of this contention is that if Favrat is prior art under § 102(a), the safe haven of § 103(c) does not apply.

Patent Owner asks that we not consider the arguments in Petitioner’s Reply related to § 102(a).<sup>24</sup> Paper 52, 1–2. According to Patent Owner, such argument is beyond the scope of a permissible reply under 37 C.F.R.

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<sup>24</sup> We authorized Patent Owner to submit a paper “describing why the argument at pages 24–25 of Petitioner’s Reply is beyond the scope of permissible reply under 37 C.F.R. § 42.23(b).” Paper 48, 1.

§ 42.23(b). *Id.* In particular, Patent Owner contends that the Petition did not assert § 102(a), and no ground of unpatentability was instituted on § 102(a). *Id.* at 1–2. Patent Owner also contends that Petitioner’s argument is a new statutory basis, raised the new issue of publication, and could have been raised earlier. *Id.* at 2 (citing 37 C.F.R. § 42.23(b) and Office Patent Trial Practice Guide, Part II § I, 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012)).

Petitioner’s argument is not prohibited by 37 C.F.R. § 42.23(b) because it is in response to Patent Owner’s argument in the Response that Favrat is not prior art under § 102(a). *See* PO Resp. 22 n.2; Paper 71, 1. However, this does not end our inquiry. If the assertion that Favrat is prior art under § 102(a) was required to be in the Petition, then the fact that the issue was raised in Patent Owner’s Response does not cure that oversight. As the Federal Circuit recently emphasized,

It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify “with particularity” the “evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3). *Intelligent Bio-Systems*, 821 F.3d 1359, 1367–68 (Fed. Cir. 2016); *see also* 37 C.F.R. § 42.104(b)(2) (requiring a petition to specify the specific statutory grounds under 35 U.S.C. § 102).

Prior to filing of the instant Petition, Petitioner knew from Patent Owner’s contentions in the ITC proceeding that the safe haven of § 103(c) was a potential issue. *See* Ex. 1207, 3. Even armed with this knowledge, Petitioner chose not to assert in the Petition that Favrat is prior art under § 102(a). If Petitioner had asserted both § 102(a) and § 102(e), perhaps Patent Owner would have chosen a different response and the evidence in this proceeding would have developed differently. In the particular

circumstances of this case, adding consideration of § 102(a) at this late date would deprive Patent Owner of due process. Consequently, we do not consider Petitioner's contention that Favrat is prior art under § 102(a).

E. REMAINDER OF PATENTABILITY ANALYSIS

We instituted trial on the following grounds:

- (1) claims 1, 2, 4, 5, 11, 24–29 as unpatentable under 35 U.S.C. § 102(e) over Favrat (“the ’585 patent”)<sup>25</sup>;
- (2) claim 3 as unpatentable under 35 U.S.C. § 103(a) over Favrat and Arambepola<sup>26</sup>;
- (3) claim 6 as unpatentable under 35 U.S.C. § 103(a) over Favrat and Yang<sup>27</sup>;
- (4) claims 7–9 and 12 as unpatentable under 35 U.S.C. § 103(a) over Favrat and Wilkie<sup>28</sup>;
- (5) claim 10 as unpatentable under 35 U.S.C. § 103(a) over Favrat and Vorenkamp<sup>29</sup>;
- (6) claims 13–15 and 18 as unpatentable under 35 U.S.C. § 103(a) over Favrat and Oku<sup>30</sup>;

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<sup>25</sup> Ex. 1104, U.S. 7,075,585 B2 (July 11, 2006).

<sup>26</sup> Ex. 1139, U.S. 7,280,616 B2 (Oct. 9, 2007).

<sup>27</sup> Ex. 1105, U.S. 5,663,768 (Sept. 2, 1997).

<sup>28</sup> Ex. 1106, U.S. 5,526,017 (June 11, 1996).

<sup>29</sup> Ex. 1107, U.S. 7,106,388 B2 (Sept. 12, 2006).

<sup>30</sup> Ex. 1108, U.S. 6,310,654 B1 (Oct. 30, 2001).

(7) claims 16, 17 and 19 as unpatentable under 35 U.S.C. § 103(a) over Favrat, Oku, and Gray<sup>31</sup>;

(8) claims 20–23 as unpatentable under 35 U.S.C. § 103(a) over Favrat, Oku, Eglit<sup>32</sup>, and Wilkie.

As explained above, claims 18–23 may not be asserted against Patent Owner in a ground of unpatentability based on obviousness. Consequently, Petitioner has not demonstrated by a preponderance of the evidence that these claims are unpatentable.

With regard to the remaining challenged claims, we assess patentability based on the totality of the record as follows.

1. *Anticipation by Favrat*  
*Claims 1, 2, 4, 5, 11, and 24–29*

Petitioner contends that claims 1, 2, 4, 5, 11, and 24–29 are anticipated by Favrat. Pet. 20–29. Petitioner specifically alleges where each element of the claim is found in the prior art with citations by exhibit number to the specific portion of the evidence that supports the challenge, and also provides a supporting Declaration (Ex. 1113, Declaration of Dr. Hossein Hashemi) that is cited and explained as applicable. *Id.* For example, with regard to claim 1, the Petition explains that Favrat discloses a frequency conversion circuit as claimed. *Id.* at 20–21 (citing Ex. 1104, 3:45–55, 59–63; Ex. 1113 ¶ 29). Petitioner makes a similar showing with regard to the remaining limitations of claim 1 and the remaining claims subject to this ground of unpatentability.

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<sup>31</sup> Ex. 1109, U.S. 4,872,054 (Oct. 3, 1989).

<sup>32</sup> Ex. 1110, U.S. 5,642,139 (June 24, 1997).

We agree with Petitioner’s contentions, and determine that Petitioner has demonstrated by a preponderance of the evidence that claims 1, 2, 4, 5, 11, 24–29 are unpatentable.

2. *Obviousness Over Favrat and Arambepola*  
*Claim 3*

Claim 3 depends from claim 1 and recites, “wherein the television receiver is formed as a monolithic integrated circuit.”

Petitioner contends that claim 3 is unpatentable under 35 U.S.C. § 103(a) over Favrat and Arambepola. Pet. 29–30. Petitioner explains how claim 3 is unpatentable, including specifying where each element of the claim is found in the prior art, and explaining and identifying supporting evidence. *Id.* Petitioner explains that Arambepola discloses a multi-standard television receiver embodied as one or more monolithic integrated circuits. *Id.* Petitioner explains that it would have been obvious to modify Favrat to be embodied as a monolithic circuit, as taught by Arambepola, to improve performance and reduce manufacturing cost. *Id.*

We agree with Petitioner’s contentions, and determine that Petitioner has demonstrated by a preponderance of the evidence that claim 3 is unpatentable.

3. *Obviousness Over Favrat and Yang*  
*Claim 6*

Claim 6 depends from claim 5, which depends from claim 4, which depends from claim 1. Claim 6 recites, “wherein the first decoder circuit comprises a PAL/SECAM/NTSC decoder circuit.”

Petitioner contends that the subject matter of claim 6 would have been obvious over Favrat and Yang. Pet. 30–32.<sup>33</sup> Petitioner explains how claim 6 is unpatentable, including specifying where each element of the claim is found in the prior art, and explaining and identifying supporting evidence. *Id.* In particular, Petitioner explains that Yang discloses a multi-standard television receiver having selectable NTSC, PAL, and ATSC detectors. *Id.* at 30–31. Petitioner explains that a person of ordinary skill in the art would have modified Favrat to include selectable NTSC, PAL, and ATSC detectors as disclosed by Yang, to permit viewing of a plurality of broadcasting systems. *Id.* at 31–32.

We agree with Petitioner’s contentions, and determine that Petitioner has demonstrated by a preponderance of the evidence that claim 6 is unpatentable.

4. *Obviousness Over Favrat and Wilkie  
Claims 7–9 and 12*

Petitioner contends that the subject matter of claims 7–9 and 12 would have been obvious over Favrat and Wilkie. Pet. 32–35. These claims depend, directly, or indirectly, from claim 1.

Petitioner explains how the claims are unpatentable, including specifying where each element of the claims is found in the prior art, and explaining and identifying supporting evidence. *Id.* Petitioner explains that it would have been obvious to incorporate Wilkie’s selectable driver circuit because Wilkie discloses a system for transfer of multimedia signals having a selectable driver circuit for converting a signal from a single-ended to

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<sup>33</sup> Petitioner relies upon Favrat alone for the limitations of claims 1, 4 and 5. See Pet. 20–24; section V.A. above.

differential if a subsequent demodulator required a different signal. *Id.* at 32–33 (citing Ex. 1106, Abstract; Ex. 1113 ¶¶ 56–59).

We agree with Petitioner’s contentions, and determine that Petitioner has demonstrated by a preponderance of the evidence that claims 7–9 and 12 are unpatentable.

5. *Obviousness Over Favrat and Vorenkamp*  
*Claim 10*

Claim 10 depends from claim 1 and requires that the receiver further comprises a bandpass filter and a variable gain amplifier.

Petitioner contends that the subject matter of claim 10 would have been obvious over Favrat and Vorenkamp. Pet. 35–37. Petitioner explains how the claims are unpatentable, including specifying where each element of the claims is found in the prior art, and explaining and identifying supporting evidence. *Id.* Petitioner explains that Favrat discloses a bandpass filter and that Vorenkamp discloses a variable gain amplifier. *Id.* at 37 (citing Ex. 1113 ¶¶ 66–71; Ex. 1104, 4:3–7, 20–25, 31–33, Fig. 2; Ex. 1107, 107:11–12, Fig. 83). Petitioner explains that it would have been obvious to modify Favrat to include a variable gain amplifier as disclosed by Vorenkamp to improve the dynamic range of the receiver. *Id.* at 36.

We agree with Petitioner’s contentions, and determine that Petitioner has demonstrated by a preponderance of the evidence that claim 10 is unpatentable.

6. *Obviousness Over Favrat and Oku*  
*Claims 13–15*

Claims 13–15 depend, directly or indirectly, from claim 1.

Petitioner contends that the subject matter of claims 13–15 and 18 would have been obvious under 35 U.S.C. § 103(a) over Favrat and Oku.

Pet. 37–44. Petitioner explains how the claims are unpatentable, including specifying where each element of the claims is found in the prior art, and explaining and identifying supporting evidence. *Id.* Petitioner explains that the limitations added by these claims were known elements that may be added with predictable results. *Id.* at 38.

We agree with Petitioner’s contentions, and determine that Petitioner has demonstrated by a preponderance of the evidence that claims 13–15 are unpatentable.

7. *Obviousness Over Favrat, Oku and Gray  
Claims 16 and 17*

Petitioner contends that the subject matter of claims 16 and 17 would have been obvious under 35 U.S.C. § 103(a) over Favrat, Oku, and Gray. Pet. 44–45. Claims 16 and 17 depend, directly, or indirectly, from claim 1. Claim 16 adds that the receiver further comprises a low pass filter in a given configuration and claim 17 adds a low pass filter in a different configuration.

Petitioner explains how the claims are unpatentable, including specifying where each element of the claims is found in the prior art, and explaining and identifying supporting evidence. *Id.* at 44–45. Petitioner explains that it would have been obvious to incorporate Gray’s low pass filter with Oku’s driver circuit for removing artifacts produced by the digital-to-analog converter before interfacing with a subsequent demodulator and/or decoder. *Id.* at 44 (citing Ex. 1113 ¶¶ 91–94).

We agree with Petitioner’s contentions, and determine that Petitioner has demonstrated by a preponderance of the evidence that claims 16 and 17 are unpatentable.

#### IV. ORDER

For the reasons given, it is:

ORDERED that claims 1–17 and 24–29 of U.S. Patent No. 7,265,792 B2 have been shown by a preponderance of the evidence to be unpatentable;

FURTHER ORDERED that claims 18–23 of U.S. Patent No. 7,265,792 B2 have not been shown by a preponderance of the evidence to be unpatentable;

FURTHER ORDERED that Petitioner’s Motion to Exclude is denied-in-part and granted-in-part;

FURTHER ORDERED that Patent Owner’s Motion to Exclude is denied as moot; and

FURTHER ORDERED that, because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2015-00594  
Patent 7,265,792 B2

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