

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BROADCOM LTD., BROADCOM CORP.,
AVAGO TECHNOLOGIES LTD., and
AVAGO TECHNOLOGIES U.S., INC.
Petitioner,

v.

INVENSAS CORP.,
Patent Owner.

Case IPR2017-00107
Patent 6,849,946 B2

Before MICHAEL R. ZECHER, LYNNE E. PETTIGREW, and
KAMRAN JIVANI, *Administrative Patent Judges*.

JIVANI, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Broadcom Ltd., Broadcom Corp., Avago Technologies Ltd., and Avago Technologies U.S., Inc. (collectively, “Petitioner”) requests rehearing (Paper 8, “Reh’g Req.”) of our Decision Denying Institution (Paper 7, “Decision” or “Dec. on Inst.”) of an *inter partes* review of claims 16–20 and 22 (“Challenged Claims”) of U.S. Patent No. 6,849,946 B2 (“the ’946 patent,” Ex. 1001).

We observed in our Decision: “Independent claim 16 recites in relevant part ‘wherein a lateral dimension of at least one of the laterally spaced dummy trenches is less than a lateral dimension of the first trench and greater than a lateral dimension of at least one of the series of second trenches’ (hereinafter the “Dimensional Limitation”).” Dec. on Inst. 8.

Petitioner contends, “[t]he Board . . . clearly erred and abused its discretion when it relied on *Hockerson-Halberstadt* in its analysis of the disclosures of Takahashi Figure 4B and Kishii Figure 4B, and found, based entirely on *Hockerson-Halberstadt*, that these prior art references do not disclose the Dimensional Limitation of independent claim 16.” Reh’g Req. 7. More specifically, Petitioner asserts we erred in our Decision because: (i) the “Dimensional Limitation merely recites *relative* dimensions” and “[n]o ‘particular sizes’ are claimed” (*id.* at 9); (ii) Takahashi’s Figure 4B and Kishii’s Figure 4B allegedly each disclose the Dimensional Limitation (*id.* at 10); and (iii) *Hockerson-Halberstadt* “is clearly inapplicable” to the circumstances presented in this case (*id.* at 11).

“The burden of showing a decision should be modified lies with the party challenging the decision . . .” who “must specifically identify all matters the party believes [we] misapprehended or overlooked, and the place

where each matter was previously addressed in a motion, an opposition, or a reply.” 37 C.F.R. § 42.71(d). When rehearing a decision on a petition, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may be indicated if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000).

For the reasons discussed below, Petitioner’s Request for Rehearing is *denied*.

II. ANALYSIS

We are not persuaded by Petitioner’s first argument that, because the Dimensional Limitation merely recites relative dimensions and not particular sizes, we erred in our Decision. Reh’g Req. 9. In our Decision, we relied on *Hockerson-Halberstadt* for the principle that “it is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.” Dec. on Inst. 9 (quoting *Hockerson-Halberstadt, Inc. v. Avia Grp. Int’l, Inc.*, 222 F.3d 951, 956 (Fed. Cir. 2000) (internal citations omitted)). Petitioner’s argument reduces to an assertion that the “particular sizes” referred to in *Hockerson-Halberstadt*’s articulation of this long-standing principle are exclusive of relative dimensions. *Hockerson-Halberstadt*, however, is not so limited. Indeed, as Petitioner acknowledges, *Hockerson-Halberstadt* addressed an issue of relative dimensions, namely, whether the specification in that case “contains figures

depicting a groove that is wider than the fins.” Reh’g Req. 13 (citing *Hockerson-Halberstadt*, 222 F.3d at 956).

We further are not persuaded by Petitioner’s second argument that Takahashi’s Figure 4B and Kishii’s Figure 4B each allegedly disclose the Dimensional Limitation. Reh’g Req. 10. Petitioner asserts, “the Board did not dispute the Petitioner’s factual analysis of what these prior art figures show; the Board only disputed the scope of what is being claimed in the Dimensional Limitation.” *Id.* Petitioner misapprehends our Decision. We found therein: “Petitioner fails to identify passages of Takahashi’s specification describing the proportions of Figure 4B in sufficient detail so as to anticipate the Dimensional Limitation.” Dec. on Inst. 9. We similarly found: “Petitioner fails to identify passages of Kishii’s specification describing the proportions of Figures 4B and 4C in sufficient detail so as to teach or suggest the Dimensional Limitation.” *Id.* at 10. Thus, contrary to Petitioner’s argument, we addressed Petitioner’s reliance on Takahashi’s Figure 4B and Kishii’s Figure 4B and found this reliance insufficient to carry Petitioner’s burden of showing a reasonable likelihood it would prevail on its asserted anticipation and obviousness grounds. *Id.* at 8–10.

Finally, we are not persuaded by Petitioner’s third argument that *Hockerson-Halberstadt* “is clearly inapplicable.” Reh’g Req. 11–14. As discussed above, *Hockerson-Halberstadt* addressed an issue of relative dimensions, similar to the Dimensional Limitation at issue in this proceeding. *See supra*. Moreover, the principle of *Hockerson-Halberstadt* that we applied is well-established in the precedential decisions of the U.S. Court of Appeals for the Federal Circuit. *Hockerson-Halberstadt*, 222 F.3d at 956. In support of its argument, Petitioner cites principally a non-

precedential *ex parte* appeal decision of this Board. Reh’g Req. 13. Petitioner fails to identify, and we are unaware of, controlling Federal Circuit or U.S. Supreme Court precedent abrogating the principle of *Hockerson-Halberstadt*.

We are not persuaded, therefore, that we misapprehended or overlooked any argument made by Petitioner regarding whether Takahashi and Kishii meet the Dimensional Limitation. Thus, we did not abuse our discretion in determining that Petitioner did not demonstrate a reasonable likelihood of prevailing on its challenges to claims 16–20 and 22.

Accordingly, it is

ORDERED that pursuant to 35 U.S.C. § 314 (a), Petitioner’s Request for Rehearing is *denied*.

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