

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MENTOR GRAPHICS CORPORATION,
Petitioner,

v.

IN-DEPTH TEST LLC,
Patent Owner.

Case IPR2017-02094
Patent 6,792,373 B2

Before JUSTIN T. ARBES, BARRY L. GROSSMAN, and GARTH D. BAER,
Administrative Patent Judges.

BAER, *Administrative Patent Judge.*

DECISION
Denying Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Petitioner, Mentor Graphics Corporation, filed a Petition for an *inter partes* review of claims 1–20 of Patent 6,792,373 B2 (“the ’373 patent”). Paper 1 (“Pet.”). Patent Owner, In-Depth Test LLC, filed a Preliminary Response pursuant to 35 U.S.C. § 313. Paper 6 (“Prelim. Resp.”). Pursuant to the panel’s authorization (Ex. 1017), Petitioner also filed a Reply (Paper 7) to the Preliminary Response. In a March 14, 2018, Decision, the panel denied the Petition. Paper 8 (“Dec.”).

Petitioner filed a Request for Rehearing of the Decision. Paper 9 (“Reh’g Req.”). The Request is denied.

II. NO EXPANDED PANEL

The Request for Rehearing suggests an expanded panel should decide the Request. Reh’g Req. 9–10.

Our governing statutes and regulations do not provide for parties to request, or panels to authorize, an expanded panel. *See generally* 35 U.S.C. § 6; 37 C.F.R. §§ 41.1–42.412. Our standard operating procedures, however, provide the Chief Judge with discretion to expand a panel to include more than three judges. PTAB SOP 1, 2–5 (§§ II, III) (Rev. 14); *see id.* at 2 (introductory language explaining that the Director has delegated to the Chief Judge the authority to designate panels under 35 U.S.C. § 6); *see also In re Alappat*, 33 F.3d 1526, 1532 (Fed. Cir. 1994), *abrogated on other grounds by, In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008) (providing that Congress “expressly granted the [Director] the authority to designate expanded Board panels made up of more than three Board members”).

The Chief Judge may consider panel expansions upon a “suggestion” from a judge, panel, or party. PTAB SOP 1, 3–4; *see also Apple Inc. v. Rensselaer Polytechnic Inst.*, Case IPR2014-00319, slip op. at 2 n.1 (PTAB Dec. 12, 2014) (Paper 20) (expanded panel) (per curiam).

The standard operating procedure exemplifies some of the reasons for which the Chief Judge may expand a panel. PTAB SOP 1, 3 (§ III.A). For example, an expanded panel may be appropriate when “[t]he proceeding or AIA Review involves an issue of exceptional importance” or when “[c]onsideration by an expanded panel is necessary to secure and maintain uniformity of the Board’s decisions.” *Id.* (§ III.A.1, 2).

In this case, the Chief Judge has considered Petitioner’s suggestion for an expanded panel, but has determined that an expanded panel is not warranted.

III. STANDARD OF REVIEW

“The burden of showing a decision should be modified lies with the party challenging the decision,” which party “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed” in a paper of record. 37 C.F.R. § 42.71(d). And, because Petitioner seeks rehearing of the Decision denying the Petition, it must show an abuse of discretion. *See* 37 C.F.R. § 42.71(c) (“When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.”).

IV. ANALYSIS

A. Petitioner's Argument Regarding the Construction of "Outlier"

Petitioner argues the panel misapprehended 37 C.F.R. § 42.104(b)(3) by interpreting it as prohibiting alternative claim constructions. Reh'g Req. 3–4. In the Decision, the panel stated:

Petitioner's failure to take a clear position on the term "outlier" is grounds alone for denying the Petition. *See* 37 C.F.R. § 42.104(b)(3) (requiring a petition to "identify . . . [h]ow the challenged claim is to be construed").

Dec. 9.

The panel did not misapprehend the rule or otherwise interpret it as prohibiting a petitioner from advancing unpatentability arguments under alternative claim constructions. Rather, the panel denied the Petition because it was unable to determine what construction(s) of "outlier" Petitioner was proposing and applying to show how the asserted prior art allegedly meets that limitation. *See* Dec. 7–9 (noting, for example, Petitioner's citations to both the previous construction in Case IPR2015-01998 and a new "alternatively-worded construction," as well as the fact that, in a declaration supporting the Petition, Petitioner's declarant testifies that he was "told that [he] should apply" the previous construction in opining on patentability (*see* Ex. 1005 ¶ 18), but subsequently refers to a different construction in his analysis (*see* Ex. 1005 ¶ 37)).

B. Petitioner's Argument Regarding the Application of "Outlier"

Petitioner argues the panel misunderstood how the "sorting sigma" feature of Lane related to the claim term "outlier." Reh'g Req. 5. Assuming *arguendo*

Petitioner is correct in that regard, the Request still would not show that the Decision “should be modified,” as required under 37 C.F.R. § 42.71(d).

In denying the Petition, which asserted a single ground of unpatentability (obviousness over Lane and Western), the panel held the following:

Based on the disclosure of Lane to remove from the data set “bad data points” consisting of “all data more than σ *std away from the mean of all measured data” (Ex. 1012, 51: table 18), we determine that a person of ordinary skill, upon reading the reference, would be led in a direction divergent from the path that was taken by the applicant, which requires the identification of outliers.

Alternatively, even if a person of ordinary skill in the art were to combine Lane and Western as Petitioner asserts, Petitioner fails to show how that combination would result in the subject matter of any challenged claim. More specifically, Petitioner fails to account sufficiently for Lane’s teaching that “all data more than σ *std away from the mean of all measured data is rejected as bad data points” prior to plotting SQC charts and, thus, how potential outliers would survive the “sorting σ ” step long enough to be identified, if Lane were modified (based on the teachings of Western) to chart individual measurements as proposed by Petitioner.

Dec. 17 (emphasis added).

Petitioner’s argument on rehearing pertains only to the “[a]lternative[.]” reason for why the panel was not persuaded there was a reasonable likelihood of Petitioner prevailing in showing that claims 1–20 are unpatentable over Lane and Western. Petitioner’s Request does not argue, let alone show, an abuse of discretion in the determination that a person of ordinary skill would not have combined Lane and Western in the manner asserted by Petitioner.

C. Petitioner's Argument Regarding "Inconsistency"

As the panel acknowledged in the Decision, the Board previously instituted an *inter partes* review of claims 1–20 on the same ground as presented in the Petition. See Dec. 4; Ex. 1006 (*Linear Tech. Corp. v. In-Depth Test LLC*, Case IPR2015-01998 (PTAB Apr. 1, 2016) (Paper 10)).

On rehearing, Petitioner argues that "[t]o resolve the inconsistency between the decisions in the two proceedings, the Board should grant rehearing." Reh'g Req. 2. In other words, Petitioner argues that the prior institution decision is binding on us. Petitioner does not cite any law to support that proposition, and it is one with which we disagree.

The prior "determination . . . whether to institute an *inter partes* review" was "nonappealable." 35 U.S.C. § 314(d). And, the merits of the prior petition were never tested at trial and decided in a final written decision. Instead, the prior *inter partes* review was terminated pursuant to settlement and, thus, without a final written decision that could be appealed. See *Linear Tech. Corp. v. In-Depth Test LLC*, Case IPR2015-01998 (PTAB Sept. 7, 2016) (Paper 20). Without any supporting law, we will not interpret the prior, nonappealable institution decision as binding on Patent Owner or as otherwise mandating institution in this proceeding.

Moreover, per 35 U.S.C. § 314(a), the determination of whether there is reasonable likelihood that Petitioner would prevail is to be based on "the information presented in the petition filed under section 311 and any response filed under section 313." As pointed out in the Decision, the "response filed under

section 313,” i.e., Patent Owner’s Preliminary Response, was different substantively than the one Patent Owner filed in Case IPR2015-01998, and included new arguments that the panel found to be persuasive based on the record in this proceeding. *See* Dec. 18 n.6 (explaining that “the preliminary response in [the] prior *inter partes* review did not point out Lane’s teaching about the ‘sorting sigma’ nor present arguments based on that teaching”).

V. CONCLUSION

Petitioner has not carried its burden of demonstrating that the Decision should be modified. *See* 37 C.F.R. § 42.71(d).

VI. ORDER

Petitioner’s Request for Rehearing is denied.

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