

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INFINERA CORP.,
Petitioner,

v.

CORE OPTICAL TECHNOLOGIES, LLC,
Patent Owner.

Case IPR2018-01259
Patent 6,782,211 B1

Before KEN B. BARRETT, PATRICK M. BOUCHER, and
MATTHEW J. McNEILL, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

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

I. INTRODUCTION

Infinera Corporation (“Petitioner”) filed a Request for Rehearing (Paper 10, “Request” or “Req. Reh’g”) of our Decision Denying Institution of *inter partes* review of claims 15–18, 23, 25, 30, 32, 33, 35, and 37 of U.S. Patent No. 6,782,211 B1 (“the ’211 patent,” Ex. 1001). Paper 9, “Decision” or “Dec.”). For the reasons provided below, Petitioner’s Request for Rehearing is *denied*.

II. ANALYSIS

A party requesting rehearing bears the burden of showing that the decision should be modified. 37 C.F.R. § 42.71(d). “The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” *Id.* When rehearing a decision on a petition, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c).

In its Request, Petitioner argues that we: A) “misapprehended Petitioner’s claim construction positions”; B) “misapprehended Petitioner’s arguments in support of its grounds for review, which were directed to multiple, alternative claim constructions”; and C) in determining “that Petitioner did not adequately articulate why a person of ordinary skill in the art would have combined the teachings,” we “did not address the statements cited in the Petition from Patent Owner (the named inventor), the PTO, and Dr. Cusani that all explained how a POSITA would understand that technologies and prior art teachings associated with radio communication would apply equally in the context of optical systems.” Req. Reh’g 1–4. We address each in turn.

A. Claim Construction Positions

In the Decision, we noted that the meaning of the claim term “cross polarization interference canceller,” or “XPIC,” is implicated in Petitioner’s arguments as to why the challenged claims allegedly are unpatentable. Dec. 10. We also noted that the phrase had been construed at least three times in three different ways, including in two district court claim construction orders and in a prior *inter partes* review. *Id.* at 10–11. We further noted that, “[i]n addition to the three above-listed constructions, Petitioner’s patentability arguments suggest two more implied proposed constructions for XPIC, notwithstanding Petitioner’s position that XPIC needs no ‘specific’ construction.” *Id.* at 12 (citing Pet. 20). We acknowledge that the full assertion by Petitioner was “no specific construction is necessary under the BRI” followed by a footnote (which we quoted, in part, at page 8 of the Decision):

Should the Board adopt the District Court’s constructions, the prior art cited in this Petition would nevertheless render the challenged claims unpatentable for the reasons set forth below. Petitioner has included in its grounds for review sufficient citation to prior art references that teach the claim limitations regardless of the final claim construction adopted by the Board.

Pet. 20 n.2.

In reaching our decision to not institute an *inter partes* review, we explained our reasoning:

This is not the first time that the ’211 patent has been before a tribunal. It cannot be said that Petitioner is unaware of the important claim construction matters that go to the heart of dispositive patentability issues. Petitioner, on the facts of this case,[□] has failed to identify adequately its proposed construction applicable to its patentability challenges.

Further, Petitioner cannot avoid its duty to comply with Rule 104(b)(3)¹ by merely inviting us to apply a means-plus-function interpretation rather than affirmatively advocating (in this forum) the application thereof. Petitioner has neither taken a definitive position nor provided complete briefing, and we decline to assume Petitioner's task of fully analyzing the claim construction for XPIC. Petitioner's failure in this regard is reason enough to deny the petition.

Dec. 13–14 (footnote omitted). We further denied institution because Petitioner's articulation of a single ground implicated the application of multiple potential constructions. *See* Dec. 16–17 (explaining—in the context of Petitioner's challenge to claim 15 over Cusani 1992, Cusani 1997, and Kavehrad—“[t]he number of possible asserted combinations is further multiplied by the overlay of the multiple potential claim constructions discussed above.”).

Petitioner, in its Request, argues that we “misapprehended Petitioner's alternative claim construction proposals and explanation of the district court's claim construction order as a failure to articulate a claim construction position for XPIC, and overlooked the relevant authority on arguing under alternative claim constructions.” *Req. Reh'g* 4. Petitioner identifies those purported alternative constructions for XPIC in the Petition as the statement that “no construction was necessary ‘under the BRI,’” and the quotation from the most recent District Court claim construction order. *Id.* at 5 (quoting *Pet.* 20), 6 (citing *Pet.* 19–20). The former—an assertion that no construction is necessary—is not a construction, alternative or otherwise.

¹ The cited rule provides that, where a claim contains a means-plus-function limitation, “the construction [in the petition] of the claim must identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function.” 37 C.F.R. § 42.104(b)(3).

The latter merely is a statement of fact, which, in the Petition, was prefaced with the statement: “the district court issued the following constructions.” Pet. 18. Petitioner does not identify any place in the Petition where, as it now asserts, it advocated that the district court constructions should be applied as “alternative, . . . specific constructions.” Req. Reh’g 6. Rather, as we indicated in the Decision, “Petitioner lists the District Court’s constructions in the co-pending litigation, but does not propose that we adopt those constructions.” Dec. 8. Petitioner’s footnote stating that, “[s]hould the Board adopt the District Court’s constructions, the prior art cited in this Petition would nevertheless render the challenged claims unpatentable,” Pet. 20 n.2, does not, under the circumstances of this case, rise to the level of a developed, affirmatively-proposed construction in the Petition.

In the Decision, we identified at least five possible constructions for the XPIC that *could* be applied in the single, three-reference ground based on Cusani 1992, Cusani 1997, and Kavehrad. *See* Dec. 12–13. The real issue here is not whether Petitioner can now point to multiple possible “alternative” constructions, but whether the Petition identified adequately, under the circumstances, how XPIC is to be constructed for purposes of Petitioner’s challenges. 37 C.F.R. § 42.104(b)(3), (4). On the facts of this case, Petitioner’s strategic decision to not take a definitive position on the meaning of XPIC and to not provide complete claim construction briefing for any “alternative” meaning of the term constitutes a failure of Petitioner to identify how the claim term should be construed. We are not persuaded that, as Petitioner alleges (Req. Reh’g 4) we “misapprehended Petitioner’s

alternative claim construction proposals and [any purported] explanation of the district court’s claim construction order.”

Petitioner argues:

As the Board stated, Petitioner was not prohibited from submitting more than one construction for consideration and analyzing its grounds for review under each of its proposals. Decision at 13 n.6. However, the relevant authority further notes that a Petitioner may argue in the alternative assuming that the Board does not agree with Petitioner’s proposed constructions. . . . That is precisely what Petitioner did: while it advocated for a construction under the BRI standard where XPI did not require loss of orthogonality and no construction was necessary for XPIC, it also argued under the alternatives theories that the Board may disagree with its proposed construction under BRI, or disagree that BRI should apply and construe the terms under *Phillips* in accordance with the district court’s analysis.

Req. Reh’g 8–9 (citations omitted). Even if we accepted as correct Petitioner’s characterizations of its arguments in the Petition, the references to “relevant authority” are not on point or contradict Petitioner’s position. This is not a case where a petitioner articulated separate grounds, each under an alternative claim construction position or even a single ground involving clearly articulated positons based on a relatively limited number of alternative claim constructions. Rather, Petitioner, in this case, did not take a clear, definitive position on any claim construction for “XPIC” (other than asserting that “no specific construction is necessary under the BRI,” Pet. 20), yet we discerned at least five possible constructions implicated in a single ground—that of the Cusani 1992, Cusani 1997, and Kavehrad ground. Petitioner, due to the lack of clarity, did not demonstrate a reasonable likelihood of prevailing in its challenges. Our determination is not contrary to the cited authorities, but rather is consistent with them. For example,

Petitioner cites a Federal Register notice issued during rulemaking, which provides:

The Office believes that the petitioner's claim construction requirement will improve the efficiency of the proceeding. As discussed previously, the petitioner's claim construction will help to provide sufficient notice to patent owner on the proposed grounds of unpatentability, and assist the Board in analyzing how a cited prior art meets the claim limitation.

77 Fed. Reg. 48,700 (Aug. 14, 2012); *see* Req. Reh'g 9 (citing the same).

The Petition failed to provide the necessary notice and assistance.

In the Decision, we contrasted Petitioner's failure to advocate for the adoption of the District Court's means-plus-function construction with Patent Owner's lengthy argument that the term is not governed by 35 U.S.C. §116 ¶ 6 and that the District Court's construction is erroneous. Dec. 12 (citing Prelim. Resp. 26–32). Petitioner accuses us of overlooking and disregarding the District Court's construction and analysis. Req. Reh'g 9–10. Petitioner contends that we “could have addressed Patent Owner's arguments by simply considering the district court's reasoned analysis and rulings on the proper construction of the terms.” *Id.* at 10 (footnote omitted). We decline the invitation to advocate against Patent Owner on Petitioner's behalf. We did not overlook or disregard the District Court's construction.

B. The Proposed Combinations of Prior Art

In the Decision, we noted that Petitioner—in the same, single ground based on Cusani 1992, Cusani 1997, and Kavehrad—cited purported teachings from multiple references for each of several small phrases in a claim, yielding multiple possible combinations of teachings, and that

Petitioner did not “not identify clearly and adequately the specific teaching that is utilized in Petitioner’s proposed overall combination.” Dec. 16–17 (citing Pet. 36–45). We further noted that “[t]he number of possible asserted combinations is further multiplied by the overlay of the multiple potential claim constructions discussed above.” *Id.* at 17. As an example, we observed that the ground Petitioner characterized as a three-reference combination contained what appeared to be two separate two-reference combinations. *Id.* We determined that, “[b]ecause Petitioner has failed to articulate adequately and specifically a proposed combination of references’ teachings, Petitioner has not demonstrated a reasonable likelihood of prevailing in its obviousness challenges.” *Id.* at 19.

Petitioner argues that we “misapprehended Petitioner’s arguments in support of its grounds for review, which were directed to multiple, alternative claim constructions,” and that we “misapprehended arguments in the Petition explaining how the prior art taught the claims limitations in each of the three likely claim construction outcomes that the Board could have adopted (two under BRI, one under Phillips).” Req. Reh’g 2, 11. Petitioner then catalogs the multiple combinations that purportedly were set out in the Petition, *id.* at 11–12, including a two-reference “combination of only Cusani 1992 and Cusani 1997” without the use the Kavehrad reference, *id.* at 11. Petitioner, thus, highlights one reason why denial of institution was appropriate; the listing of grounds does not identify a two-reference ground. *See generally* Pet. ii–iv (Table of Contents listing four “Ground[s],” all of which are three-or four-reference challenges); *id.* at 26–27 (Heading VI.A: “Ground 1 – Claims 15, 23, 30 and 32 are obvious over Cusani 1992, Cusani 1997 and Kavehrad,” followed by Heading VI.A.1: “A POSITA would have

combined Cusani 1992, Cusani 1997, and Kavehrad.”). We are not persuaded that we misapprehended Petitioner’s arguments.

In the Decision, we stated:

Petitioner’s analysis in many places is little more than an assertion that each particular element of a larger limitation was individually known in the prior art. Petitioner does not describe adequately a specific proposed combination of references. Because of this and in light of, at least, the massive number of possible proposed combinations, Petitioner has failed to identify adequately how each challenged claim is to be construed and how the construed claim is unpatentable. 37 C.F.R. § 42.104(b)(3), (4).

Dec. 18. Petitioner does not identify any portion of the Petition where a specific proposed combination of references is adequately described. *See* Req. Reh’g 13. Rather, Petitioner impliedly argues that it need not do so. *Id.* (quoting, but not explaining the relevance to this case, a bodily-incorporation proposition from *In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012)). Petitioner makes the conclusory argument that “[i]n providing demonstrative illustrations of a combined system, coupled with a thorough analysis of the teachings of the prior art, Petitioner’s obviousness arguments directly addressed that question” of “what the combined teachings of the references would have suggested to those having ordinary skill in the art.” *Id.* (citing *In re Mouttett*, 686 F.3d at 1333). Petitioner’s argument is, in effect, merely an assertion of disagreement with our determination that the Petition was not persuasive. Petitioner has not identified anything we misunderstood or overlooked.

C. Reason to Combine

In the Decision, we determined that “Petitioner has not articulated adequately a reason why one of ordinary skill in the art would have

combined the references’ teachings to arrive at the claimed subject matter” and that “Petitioner’s reasoning is an oversimplification and too conclusory to constitute the necessary articulated reasoning with rational underpinning.” Dec. 20, 21 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). That oversimplification was a reference to Petitioner’s arguments pertaining to the alleged similarity of signal *transmission* systems, whereas “the key issues involve the specific techniques used to cancel specific types of interference of *received* signals in optical systems versus radio frequency systems.” *Id.* at 23. In this regard, we stated: “Demonstrating obviousness in this case requires more than a showing that optical and RF [radio frequency] systems both utilize general techniques related to orthogonally polarized signals and had known interference problems.” *Id.*

Petitioner argues that, in concluding that Petitioner did not adequately articulate a reason to combine the teachings, we “failed to address,” “overlooked,” and “failed to consider” certain statements found in exhibits. *See* Req. Reh’g 3, 14.²

Petitioner’s argument that we allegedly failed to consider “key evidence” that purportedly would, in Petitioner’s words, demonstrate a

² Petitioner, by including twice the word “transmission,” appears to be incorrect in its characterization of our Decision as concluding that “Petitioner failed to provide sufficient bases for why a person of ordinary skill in the art would be motivated to combine the asserted references related to optical *transmission* systems with the asserted references related to radio *transmission* systems.” Req. Reh’g 14 (emphasis added) (citing Dec. 23). As mentioned, the Petition lacked adequate reasoning tied to the important aspect of signal processing of *received* signals. *See* Dec. 23.

motivation to combine the references misses the point. *See id.* at 14 (heading: “The Board Overlooked Key Evidence Demonstrating A Motivation To Combine The Asserted Prior Art References.”). An adequately articulated reason to combine must first be found in the Petition. It was Petitioner’s burden to synthesize the evidence and present to us a clearly articulated, adequate reason supported by that evidence. Petitioner, in its request, does not identify anything in that regard that we misapprehended or overlooked.

Even considering the arguments in the Request, we are not persuaded we incorrectly determined that Petitioner’s proffered reasoning to combine is based on oversimplifications and generalized propositions. For example, Petitioner impliedly argues that, had we done a more searching review of the exhibits, we would have discerned that “radio references were relevant.” *Id.* at 15 (citing Pet. 16–17 (the prosecution history subsection in the overview section, not the analysis section of the Petition), 32). Even if references are “relevant,” Petitioner does not identify where in the Petition that concept of relevance was articulated adequately as a reason why an artisan would have combined the relied-upon references’ teachings in a manner that would result in the claimed subject matter.

III. CONCLUSION

Having considered Petitioner’s Request, Petitioner has not persuaded us, for the reasons discussed, that our Decision should be modified.

IV. ORDER

For the foregoing reasons, it is

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

IPR2018-01259
Patent 6,782,211 B1

For PETITIONER:

James M. Glass
John McCauley
QUINN EMANUEL URQUHART & SULLIVAN LLP
jimglass@quinnemanuel.com
johnmccauley@quinnemannuel.com

For PATENT OWNER:

Jason Eisenberg
Jonathan Tuminaro
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
jasone-PTAB@sternekessler.com
jtuminar-PTAB@sternekessler.com

Yasser El-Gamal
MANATT, PHELPS & PHILLIPS, LLP
yelgamal@manatt.com