

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

VLSI TECHNOLOGY LLC,
Patent Owner.

IPR2020-00141
IPR2020-00142
Patent 6,663,187 C1

Before THU A. DANG, BART A. GERSTENBLITH, and
KIMBERLY McGRAW, *Administrative Patent Judges*.

McGRAW, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Requests on Rehearing of the
Decisions Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Intel Corporation (“Petitioner”) filed a Request for Rehearing in IPR2020-00141 (Paper 17) and in IPR2020-00142 (Paper 18) (collectively “Rehearing Requests”) seeking “rehearing and Precedential Opinion Panel review” of our Decisions to deny institution (IPR2020-00141, Paper 16; IPR2020-00142, Paper 17, collectively “Decisions”) of two separate petitions challenging claims of U.S. Patent No. 6,663,187 C1. Petitioner also requested review by the Board’s Precedential Opinion Panel (“POP”) in each proceeding. *See* IPR2020-00141, Paper 18 (Notification of Receipt of POP Request); IPR2020-00142, Paper 19 (Notification of Receipt of POP Request). POP review was denied on October 26, 2020. IPR2020-00141, Paper 19 (Order); IPR2020-00142, Paper 20 (Order).

For the reasons provided below, Petitioner’s Rehearing Requests are *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).

Petitioner’s Rehearing Requests raise two primary arguments: (1) that the precedential Board decisions in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential), and *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential), were wrongly decided and should be reviewed by the POP;

and (2) that, even under the *Fintiv/NHK Spring* framework, the Board erred by failing to place sufficient weight on (a) the identity and prior conduct of VLSI Technology LLC (“Patent Owner”) and (b) Petitioner’s argument that only a subset of the claims challenged in the Petition will be presented and resolved in the related district court trial. *See, e.g.*, IPR2020-00141, Paper 17 at 1–2, 6–15.¹

Petitioner’s Requests do not persuade us that our Decisions to exercise our discretion to deny institution should be modified.

With respect to Petitioner’s first argument, that *Fintiv* and *NHK Spring* were wrongly decided and should be reviewed by the POP, the POP has considered and denied Petitioner’s requests. *See* IPR2020-00141, Paper 19; IPR2020-00142, Paper 20.

With respect to Petitioner’s second argument, we disagree with Petitioner that we incorrectly weighed either the identity and prior conduct of Patent Owner or the potential difference in claims challenged in the Petition and asserted in the related litigation in deciding whether to exercise our discretion to deny institution pursuant to 35 U.S.C. § 314(a).

Our Decisions addressed Petitioner’s allegations regarding Patent Owner’s identity and conduct under *Fintiv* factor 6 (other circumstances that impact the Board’s exercise of discretion, including the merits), and we noted Patent Owner’s position that Petitioner was improperly attempting to re-litigate issues that were the subject of an antitrust suit pending in the Northern District of California. *See, e.g.*, IPR2020-00141, Paper 16 at 14–15. We further noted that, “[e]ven if Petitioner’s contentions are true,

¹ For convenience, citations to the record are for papers filed in IPR2020-00141. Similar papers, however, may also be found in IPR2020-00142.

Petitioner has not shown these contentions will ‘avoid[] adjudication of Intel’s invalidity defenses” in the related Western District of Texas litigation. *Id.* at 15. In light of the record at the time, we found that Petitioner’s arguments in connection with *Fintiv* factor 6 did not weigh against exercising our discretion to deny institution. *Id.* at 16.

Additionally, we disagree with Petitioner’s assertions that we placed inadequate weight on Petitioner’s argument that only a portion of the claims challenged in the Petitions might be asserted at trial. *See, e.g.*, Paper 17, 2, 12–15. We considered Petitioner’s arguments, set forth in its Preliminary Replies, that “the limited duration of trial will inhibit Petitioner from presenting each invalidity ground to the jury” in addressing *Fintiv* factor 4 (overlap between issues raised in the petition and in the parallel proceeding). *See, e.g.*, IPR2020-00141, Paper 16 at 13 (citing IPR2020-00141, Paper 11 at 9). Petitioner’s contention that the claims challenged in the present proceedings may not be asserted at trial in the related litigation was not persuasive as it was based on speculation. We considered the overlap between the claims challenged in each Petition and those asserted in the related litigation on the record presented and determined that “there is a substantial overlap between the issues raised in the Petition and in the Western District of Texas litigation.” *Id.* Petitioner has not identified any differences among the claims that would warrant changing this analysis.

Accordingly, having considered Petitioner’s Rehearing Requests, Petitioner has not persuaded us, for the reasons discussed, that our Decisions should be modified.

III. ORDER

For the foregoing reasons, it is:

ORDERED that Petitioner's Rehearing Request in IPR2020-00141 (Paper 17) is *denied*, and;

FURTHER ORDERED that Petitioner's Rehearing Request in IPR2020-00142 (Paper 18) is *denied*.

IPR2020-00141, IPR2020-00142

Patent 6,663,187 C1

For PETITIONER:

Donald R. Steinberg

John V. Hobgood

WILMER, CUTLER, PICKERING, HALE AND DORR LLP

don.steinberg@wilmerhale.com

john.hobgood@wilmerhale.com

For PATENT OWNER:

Kenneth Weatherwax

Nathan Lowenstein

Bridget Smith

Flavio Rose

Edward Hsieh

Parham Hendifar

Patrick Maloney

Jason Linger

LOWENSTEIN & WEATHERWAX LLP

weatherwax@lowensteinweatherwax.com

lowenstein@lowensteinweatherwax.com

smith@lowensteinweatherwax.com

rose@lowensteinweatherwax.com

hseih@lowensteinweatherwax.com

hendifar@lowensteinweatherwax.com

maloney@lowensteinweatherwax.com

linger@lowensteinweatherwax.com