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571-272-7822

Paper 9
Date: December 2, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

ACQIS LLC,
Patent Owner.

IPR2021-01099
Patent 9,529,769 B2

Before THU A. DANG, PATRICK M. BOUCHER, and ROBERT J. WEINSCHENK, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

Intel Corporation ("Petitioner") filed a Petition pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 1–22 of U.S. Patent No. 9,529,769 B2 (Ex. 1001, "the '769 patent"). Paper 2 ("Pet."). ACQIS LLC ("Patent Owner") filed a Preliminary Response. Paper 6 ("Prelim.

Resp.”). With our authorization, Petitioner filed a Reply and Patent Owner filed a Sur-reply. Papers 7 (“Reply”), 8 (“Sur-reply”).

We have jurisdiction under 35 U.S.C. § 314 and 37 C.F.R. § 42.4. For the reasons set forth below, we exercise our discretion under 35 U.S.C. § 325(d) and decline to institute an *inter partes* review.

I. BACKGROUND

A. The ’769 Patent

The ’769 patent relates to computer interfaces, specifically an interface channel that “interfaces two computer interface buses that operate under protocols that are different from that used by the interface channel.” Ex. 1001, 3:24–27. Figure 6 of the ’769 patent is reproduced below.

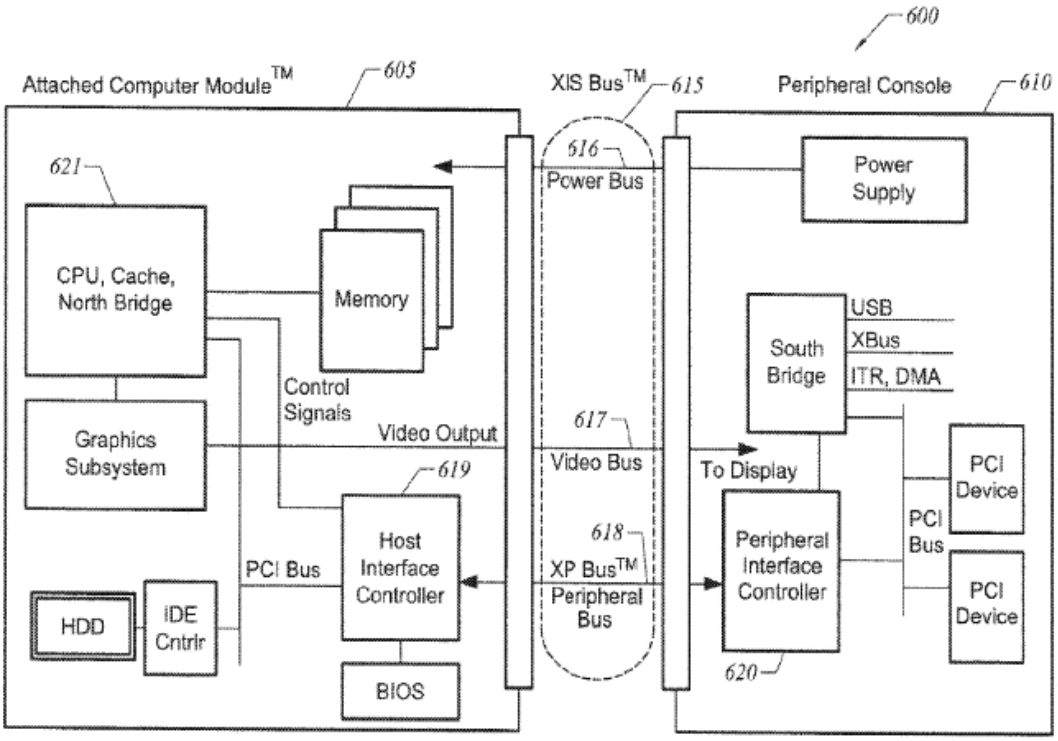


FIGURE 6

Figure 6 shows a block diagram of a computer system using an interface. *Id.* at 12:35–37. As shown, computer system 600 includes attached computer module ("ACM") 605 and peripheral 610, which are interfaced through exchange interface system ("XIS") bus 615. *Id.* at 12:37–45. XIS bus 615 includes power bus 616, video bus 617, and peripheral bus ("XPBus") 618, which is also referred to as an interface channel. *Id.* at 12:45–57.

B. Illustrative Claim

Independent claim 1 is illustrative of the challenged claims and is reproduced below.

> 1. A computer system, comprising:
> a computer with
> an integrated central processing unit and graphics subsystem in a single chip;
> wherein the graphics subsystem directly couples to a unidirectional differential signal channel to output digital video data; and
> a connector configurable for external peripheral communication;
> a first Low Voltage Differential Signal (LVDS) channel directly coupled to the connector, comprising two unidirectional, differential signal pairs transmitting data in opposite directions to convey Universal Serial Bus (USB) protocol data for external peripheral communication, and
> wherein the unidirectional different signal channel conveys Transition Minimized Differential Signaling (TMDS) signals as digital video data.

Ex. 1001, 37:14–31.

C. Evidence

Petitioner relies on the following references:

Chu '330	US 6,345,330 B2	Feb. 5, 2002	Ex. 1003

Cupps	US 2003/0135771 A1	July 17, 2003	Ex. 1004

In addition, Petitioner relies on a Declaration by John D. Kubiatowicz, Ph.D. Ex. 1002.

D. Asserted Ground of Unpatentability

Petitioner challenges claims 1–22 on the following ground. Pet. 36.

Claim(s) Challenged	35 U.S.C. §[1]	References
1–22	103	Chu '330, Cupps

E. Real Parties in Interest

In addition to itself, Petitioner identifies the following entities as real parties in interest: Lenovo Group Ltd.; Lenovo PC HK Limited; LCFC (HEFEI) Electronics Technology Co., Ltd.; Lenovo Information Products (Shenzhen) Co., Ltd.; Lenovo (Beijing) Information Technology Ltd.; and Lenovo Centro Tecnológico S. de R.L. de C.V. Pet. 7–8.

Patent Owner identifies only itself as a real party in interest. Paper 5, 2.

F. Related Matters

Both parties identify the following district court matters, each of which involves the '769 patent: (1) *ACQIS LLC v. MITAC Holdings Corp.*, No. 6:20-cv-00962 (W.D. Tex.); (2) *ACQIS LLC v. ASUSTek Computer Inc.*,

[1] For purposes of this Decision, we assume the challenged claims have an effective filing date prior to March 16, 2013, the effective date of the Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), such that the pre-AIA version of 35 U.S.C. § 103 applies.

No. 6:20-00966 (W.D. Tex.); and (3) *ACQIS LLC v. Lenovo Group Ltd.*, No. 6:20-cv-00967 (W.D. Tex.). Pet. 1; Paper 5, 2. Both parties also identify the following district court matters that involve patents related to the '769 patent: (1) *ACQIS LLC v. International Business Machines Corp.*, No. 6:09-cv-00148 (E.D. Tex.); (2) *ACQIS LLC v. International Business Machines Corp.*, No. 6:11-cv-00546 (E.D. Tex.); (3) *ACQIS LLC v. Alcatel-Lucent USA Inc.*, No. 6:13-cv-00638 (E.D. Tex.); (4) *ACQIS LLC v. EMC Corp.*, No. 6:13-cv-00639 (E.D. Tex.); (5) *ACQIS LLC v. Ericsson, Inc.*, No. 6:13-cv-00640 (E.D. Tex.); *ACQIS LLC v. Huawei Technologies Co., Ltd.*, 6:13-cv-00641 (E.D. Tex.); (6) *ACQIS LLC v. EMC Corp.*, No. 1:14-cv-13560 (D. Mass.); (7) *ACQIS LLC v. Samsung Electronics Co., Ltd.*, No. 2:20-cv-00295 (E.D. Tex.); (8) *ACQIS LLC v. Inventec Corp.*, No. 6:20-cv-00965 (W.D. Tex.); and (9) *ACQIS LLC v. Wistron Corp.*, No. 6:20-cv-00968 (W.D. Tex.). Pet. 1–6; Paper 5, 2–3, 5–6. Patent Owner further identifies *International Business Machines Corp. v. ACQIS LLC*, 4:11-cv-04896 (N.D. Cal.) as an additional district court matter. Paper 5, 6.

Both parties identify the following *inter partes* reviews as involving patents related to the '769 patent: IPR2014-01452, IPR2014-01462, IPR2014-01469, IPR2021-00604, IPR2021-00605, IPR2021-00606, IPR2021-00607, IPR2021-00608, IPR2021-00666, IPR2021-00667, IPR2021-00668, IPR2021-00669, IPR2021-00670, IPR2021-01093, IPR2021-01102, IPR2021-01103, IPR2021-01104, IPR2021-01105, IPR2021-01107, IPR2021-01108, IPR2021-01109, IPR2021-01110, IPR2021-01111, IPR2021-01112, IPR2021-01113, IPR2021-01114. Pet. 6–7; Paper 5, 3–6. Patent Owner additionally identifies IPR2021-01094 and IPR2021-01095 as involving a patent related to the '769 patent. Paper 5, 4.

II. DISCRETION UNDER 35 U.S.C. § 325(d)

Petitioner relies on Chu '330 in its only asserted challenge to claims of the '769 patent. Pet. 36. Petitioner argues that, while Chu '330 "appears on the voluminous list of references considered by the Patent Office" during prosecution, no Examiner cited Chu '330 against any claims of the '769 patent or any of its related applications. *Id.* at 131. Petitioner also argues that "the Examiner did not determine the proper priority date of any of the challenged claims during prosecution." *Id.* According to Petitioner, "[t]he Examiner simply accepted the applicant's representation that the '769 Patent properly incorporated by reference the materials found only in" U.S. Provisional Patent Application No. 60/083,886 ("Chu '886"). *Id.* Petitioner further argues that, "even wrongly assuming the Examiner made an implicit determination regarding the priority date, such determination would have been materially erroneous." *Id.* at 131–132.

Patent Owner counters that the Office has already considered and rejected Petitioner's argument regarding the incorporation by reference of Chu '330 and Chu '886. Prelim. Resp. 11–31. Patent Owner argues that the Board should exercise its discretion under 35 U.S.C. § 325(d) to deny institution because the Examiner previously considered and affirmed the efficacy of an incorporation by reference in the context of a priority claim. *Id.* at 12 (citing *SMR Auto. Sys. USA, Inc. v. Magna Mirrors of Am., Inc.*, IPR2018-00931, Paper 7 at 14 (PTAB Sept. 14, 2018)). For the reasons set forth below, we are persuaded by Patent Owner's arguments to exercise our discretion to deny institution of an *inter partes* review under § 325(d).

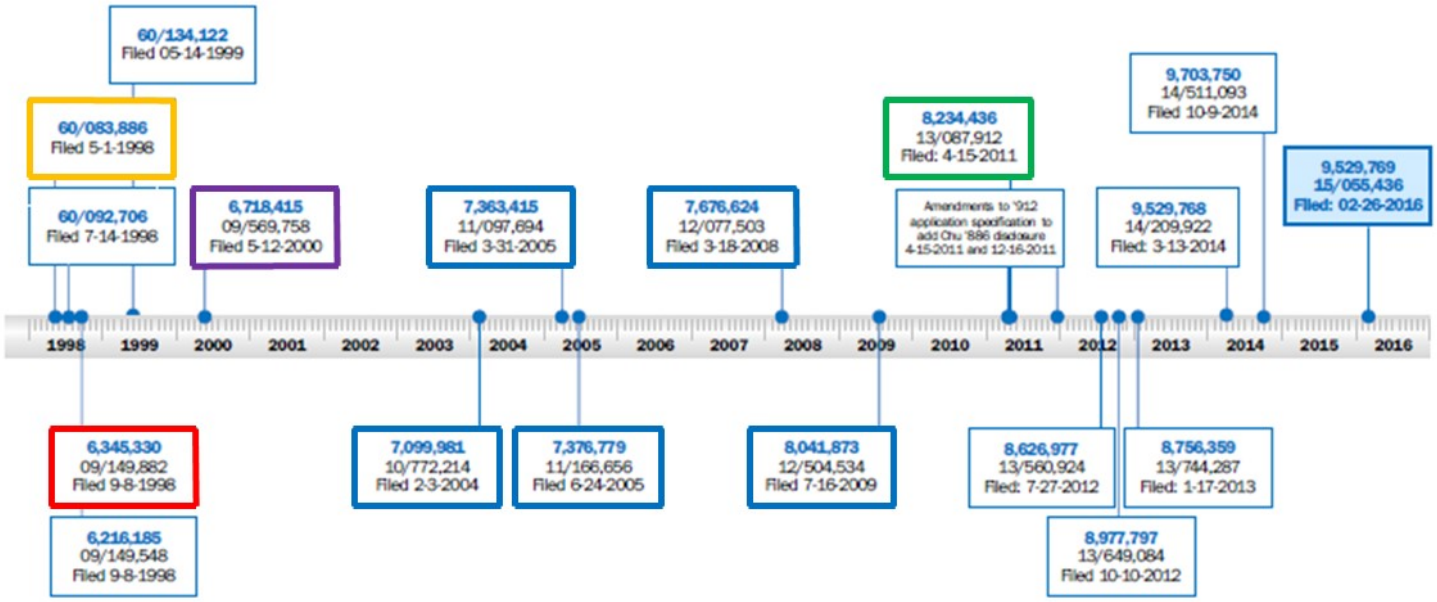
Institution of an *inter partes* review is discretionary. The U.S. Supreme Court has explained that, because § 314 includes no mandate to

institute review, "the agency's decision to deny a petition is a matter committed to the Patent Office's discretion." *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016); *see also Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (explaining that under § 314(a), "the PTO is permitted, but never compelled, to institute an IPR proceeding"). Moreover, 35 U.S.C. § 325(d) states, in relevant part, that "[i]n determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office." 35 U.S.C. § 325(d); *see also Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte Gmbh*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential); *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17−18 (PTAB Dec. 15, 2017) (precedential as to Section III.C.5, first paragraph).

"Under § 325(d), the Board uses the following two-part framework: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of the first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims." *Advanced Bionics*, Paper 6 at 8. If the petitioner fails to show that the Office erred, the Director may exercise his or her discretion not to institute *inter partes* review. *Id.*; *see also Becton, Dickinson*, Paper 8, 24 (exercising discretion where "Petitioner has not pointed to error by the Examiner").

A. Advanced Bionics Part I:
Previous Presentation of Arguments to the Office

We first determine whether the same or substantially the same arguments previously were presented to the Office. *Advanced Bionics*, Paper 6 at 8. Patent Owner's drawing, reproduced below with color annotations added by the Board, provides a timeline of the priority chain of the '769 patent (light-blue filled box) and other related applications, including Chu '886 (orange) and U.S. Patent Application No. 09/149,882 ("the '882 application"), which issued as Chu '330 (red). Prelim. Resp. 7.



The annotated version of Patent Owner's drawing above shows the filing dates of the applications in the priority chain of the '769 patent and other

related applications. *Id.* The '769 patent issued from U.S. Patent Application No. 15/055,436 ("the '436 application"), which claims priority to U.S. Patent Application No. 09/569,758 ("the '758 application") (dark purple), filed on **May 12, 2000**, through a chain of continuation applications. Ex. 1001, codes (21), (63), 1:14–39.[2] The '758 application (i.e., the initial ancestor application) incorporated by reference the '882 application (i.e., Chu '330), which claimed priority to, and incorporated by reference, Chu '886. Ex. 1013, 4:50–53; Ex. 1011, 78, 81, 83 (prosecution history of Chu '330). Each subsequent application in the priority chain both identified each preceding application as required by 35 U.S.C. § 120 and incorporated by reference the prior applications and the '882 application. *See, e.g.*, Ex. 1001, 1:14–39, 6:46–49; Ex. 1008, 1:12–27, 9:27–29.

U.S. Patent Application No. 13/087,912 ("the '912 application") (green), filed April 15, 2011, now U.S. Patent No. 8,234,436 ("the '436 patent"), is an intervening application, claiming the benefit of the '758 application through several other prior applications (dark blue). Ex. 1008, code (63). The '912 application was filed with a preliminary amendment, adding Figures 8 and 9 and corresponding disclosure from Chu '886 as Figures 8A and 8B and corresponding disclosure in the '912 application. Ex. 1009, 12–26 (prosecution history of the '912 application). The applicant also filed another amendment in the '912 application, adding Figures 10 and

[2] Although the body of the '769 patent identifies the complete chain of continuation applications back to May 12, 2000, Ex. 1001, 1:14–39, the face of the '769 patent identifies only the portion of the chain back to U.S. Patent Application No. 11/097,695, filed on March 31, 2005, *id.* at code (63). Petitioner nevertheless acknowledges that the full chain extends back to the '758 application. Pet. 19 (drawing of patent family tree).

16 and corresponding disclosure from Chu ’886 as Figures 8C and 24 and corresponding disclosure in the ’912 application. *Id.* at 379–395.

In its Petition, Petitioner argues that the ’750 patent is not entitled to a priority date before April 15, 2011, because the ’436 patent’s ancestor applications did not properly incorporate by reference Chu ’886, and that the amendments adding the subject matter from Chu ’886 thereby improperly introduced new matter. Pet. 18–32. But during prosecution of the ’912 application (issued as the ’436 patent), the applicant argued that these amendments were proper because the ’758 application (the initial ancestor application) incorporated by reference the ’882 application, which in turn incorporated Chu ’886 by reference. Ex. 1009, 26, 392. “[W]hen a patentee argues that its claims are entitled to the priority date of an earlier filed application, the examiner must undertake a priority analysis to determine if the patentee meets the requirements of § 120.” *In re NTP, Inc.*, 654 F.3d 1268, 1277 (Fed. Cir. 2011).

Indeed, the prosecution history of the ’912 application shows that, when the subject matter from Chu ’886 was added to the ’912 application, the applicant specifically directed the Examiner to the incorporation-by-reference statement in the transmittal form of the ’882 application as support for the amendments. Ex. 1009, 26, 392. In the “Remarks” section of the amendments, the applicant also argued that “[t]he original ’758 patent application incorporated by reference U.S. Application No. 09/149,882 (now issued as U.S. Patent No. 6,345,330), which in turn, claimed the benefit of and incorporated by reference U.S. Provisional Application No. 60/083,886 . . . (*See* checked incorporation by reference box in utility patent application transmittal of U.S. Application No. 09/149,882 filed on September 8,

1998)." *Id.* The Examiner did not object to the inclusion of the amendments as new matter or issue a rejection under 35 U.S.C. § 112, ¶ 1. Nor did the Examiner require the applicant to change the benefit claim from "continuation" to "continuation-in-part." Instead, the Examiner entered the amendments and subsequently allowed the '912 application with the subject matter added from Chu '886. *Id.* at 430 (Notice of Allowance and Fee(s) Due).

In addition, another petitioner (Samsung) previously presented to the Office substantially the same arguments that the amendments adding the subject matter from Chu '886 to an intervening application in the challenged patent's priority chain improperly introduced new matter and that "Chu '330 did not properly incorporate the subject matter of Chu '886" in the following five IPR proceedings:

(1) *Samsung Electronics Co., LTD. v. ACQIS LLC*, IPR2021-00604, Paper 1 at 9−18 (PTAB March 8, 2021) (Petition filed by Samsung);

(2) *Samsung Electronics Co., LTD. v. ACQIS LLC*, IPR2021-00605, Paper 1 at 9−17 (PTAB March 8, 2021) (Petition filed by Samsung);

(3) *Samsung Electronics Co., LTD. v. ACQIS LLC*, IPR2021-00606, Paper 1 at 8−17 (PTAB March 8, 2021) (Petition filed by Samsung);

(4) *Samsung Electronics Co., LTD. v. ACQIS LLC*, IPR2021-00607, Paper 1 at 9−17 (PTAB March 8, 2021) (Petition filed by Samsung); and

(5) *Samsung Electronics Co., LTD. v. ACQIS LLC*, IPR2021-00608, Paper 1 at 10−17 (PTAB March 8, 2021) (Petition filed by Samsung).

Upon consideration of Samsung's arguments, the panel in each of these five IPR proceedings denied Samsung's petition under 35 U.S.C. § 325(d) because the same or substantially the same arguments previously

were presented to the Office and Samsung failed to show that the Examiner erred in entering the amendments or in determining that Chu '330 incorporated by reference Chu '886. *See, e.g.*, IPR2021-00604, Paper 7 at 6−21 (Decision Denying Institution).

For the foregoing reasons, we determine that the Petition presents the same or substantially the same arguments that were previously presented to the Office. *See* Pet. 18–32.

B. Advanced Bionics Part II: Office Error

Because the first part of the *Advanced Bionics* framework is satisfied, we next determine whether Petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. *Advanced Bionics*, Paper 6 at 8. "If reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability. At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown." *Id.* at 9.

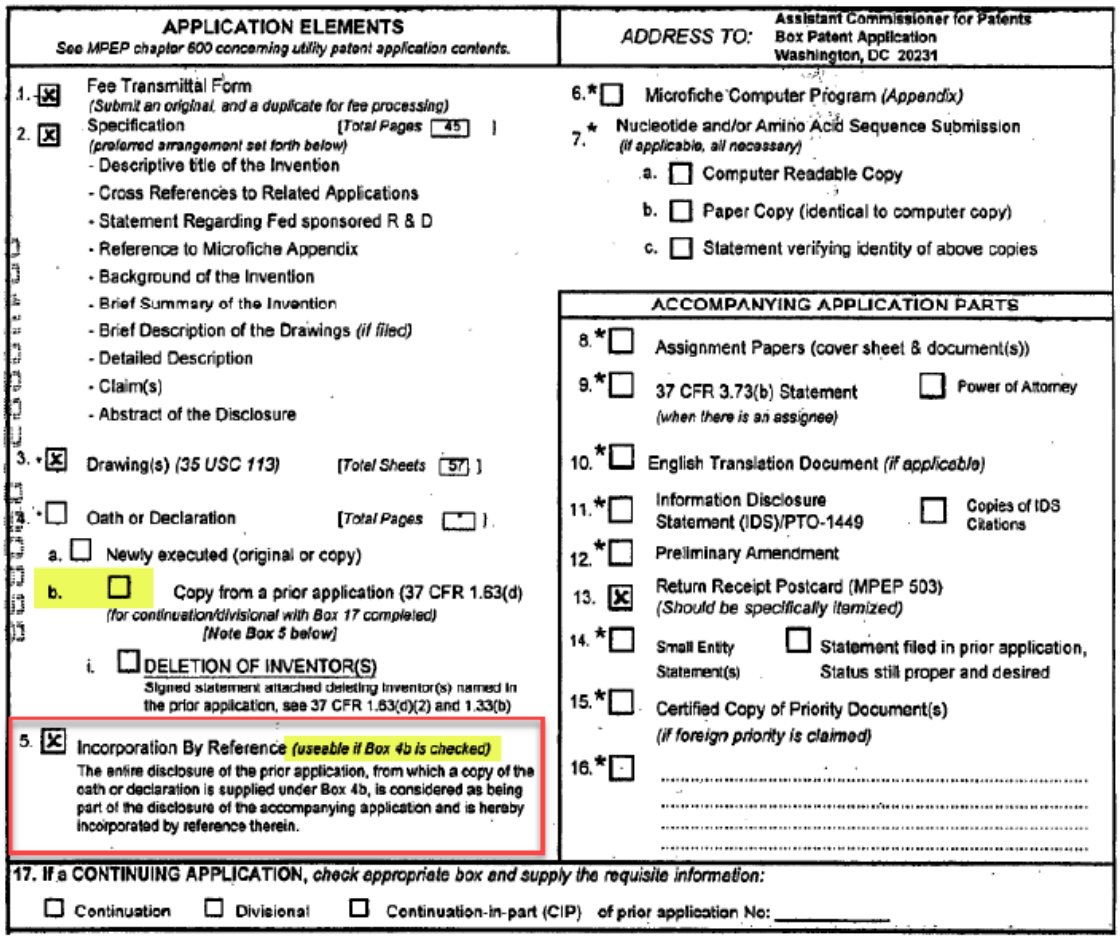
As discussed above, Petitioner argues that the '769 patent is not entitled to a priority date before April 15, 2011, because the '436 patent's ancestor applications did not properly incorporate by reference Chu '886, and that the amendments adding the subject matter from Chu '886 thereby improperly introduced new matter. Pet. 18–32. Petitioner admits that the '758 application (the initial ancestor application) incorporated by reference the '882 application. *Id.* at 25–26; *see also* Ex. 1013, 4:50–53. It is also undisputed that each subsequent application in the priority chain both identified each preceding application as required by 35 U.S.C. § 120 and

incorporated by reference the prior applications and the '882 application. *See, e.g.*, Ex. 1001, 1:14–39, 6:46–49; Ex. 1008, 1:12–27, 9:27–29. Nonetheless, Petitioner argues that "[Chu '330] never incorporated by reference [Chu '886]." Pet. 26–32.

In short, under Part II of the *Advanced Bionics* framework, Petitioner has the burden to show that the Examiner erred in determining that Chu '330 incorporated by reference Chu '886. *Advanced Bionics*, Paper 6 at 8. We address below each of Petitioner's arguments in turn.

1. Incorporation by Reference Statement in a Transmittal Form

To support its argument that Chu '330 never incorporated by reference Chu '886, Petitioner contends that the transmittal form filed in Chu '330 does not identify Chu '886. Pet. 28–29. A portion of the transmittal form is reproduced below with Petitioner's annotations. *Id.* at 29 (reproducing and annotating a portion of Ex. 1011, 81).



APPLICATION ELEMENTS
See MPEP chapter 600 concerning utility patent application contents.

ADDRESS TO: Assistant Commissioner for Patents
Box Patent Application
Washington, DC 20231

1. [X] Fee Transmittal Form
(Submit an original, and a duplicate for fee processing)
2. [X] Specification [Total Pages 45]
(preferred arrangement set forth below)
- Descriptive title of the Invention
- Cross References to Related Applications
- Statement Regarding Fed sponsored R & D
- Reference to Microfiche Appendix
- Background of the Invention
- Brief Summary of the Invention
- Brief Description of the Drawings (if filed)
- Detailed Description
- Claim(s)
- Abstract of the Disclosure
3. * [X] Drawing(s) (35 USC 113) [Total Sheets 57]
4. * [ ] Oath or Declaration [Total Pages]
a. [ ] Newly executed (original or copy)
b. [ ] Copy from a prior application (37 CFR 1.63(d))
(for continuation/divisional with Box 17 completed)
[Note Box 5 below]
i. [ ] DELETION OF INVENTOR(S)
Signed statement attached deleting inventor(s) named in the prior application, see 37 CFR 1.63(d)(2) and 1.33(b)
5. [X] Incorporation By Reference (useable if Box 4b is checked)
The entire disclosure of the prior application, from which a copy of the oath or declaration is supplied under Box 4b, is considered as being part of the disclosure of the accompanying application and is hereby incorporated by reference therein.
6. * [ ] Microfiche Computer Program (Appendix)
7. * Nucleotide and/or Amino Acid Sequence Submission
(if applicable, all necessary)
a. [ ] Computer Readable Copy
b. [ ] Paper Copy (identical to computer copy)
c. [ ] Statement verifying identity of above copies

ACCOMPANYING APPLICATION PARTS
8. * [ ] Assignment Papers (cover sheet & document(s))
9. * [ ] 37 CFR 3.73(b) Statement [ ] Power of Attorney
(when there is an assignee)
10. * [ ] English Translation Document (if applicable)
11. * [ ] Information Disclosure Statement (IDS)/PTO-1449 [ ] Copies of IDS Citations
12. * [ ] Preliminary Amendment
13. [X] Return Receipt Postcard (MPEP 503)
(Should be specifically itemized)
14. * [ ] Small Entity Statement(s) [ ] Statement filed in prior application, Status still proper and desired
15. * [ ] Certified Copy of Priority Document(s)
(if foreign priority is claimed)
16. * [ ]

17. If a CONTINUING APPLICATION, check appropriate box and supply the requisite information:
[ ] Continuation [ ] Divisional [ ] Continuation-in-part (CIP) of prior application No: _____

Citing Dr. Kubiatowicz's testimony for support, Petitioner argues that nothing in the transmittal form, a portion of which is reproduced above as annotated by Petitioner, identifies "with *detailed particularity* what specific material" Chu '330 incorporates. *Id*. (quoting *Hollmer v. Harari*, 681 F.3d, 1351, 1357 (Fed. Cir. 2012); citing Ex. 1002 ¶ 95). Petitioner also avers that (1) "box 5 titled 'Incorporation by Reference' states that it is only 'useable if Box 4b is checked[,]' . . . but . . . Box 4b is not even checked"; and (2) "[e]ven if Box 4b were checked, Box 4b would have been inoperative because its use was limited 'for continuation/divisional with Box 17 completed,'" and "none of the options for Box 17 includes a check mark—

let alone that [Chu '330] cannot be a 'continuation/divisional' of [Chu '886]." *Id.* at 29–30 n.5.

Petitioner's arguments and Dr. Kubiatowicz's testimony narrowly focus on the transmittal form alone. *Id.* at 28–30; Ex. 1002 ¶ 95. But the Federal Circuit has explained that an incorporation-by-reference analysis includes "the four corners of the application." *Hollmer*, 681 F.3d at 1358.

It is instructive to review the facts in *Hollmer*. In that case, the intervening applications merely identified the referenced application with the title of the invention and the language "*filed on the same day as the present application*," but the intervening applications were not "filed on the same day" as that referenced application and at least two other applications by the same inventors that had the same title as that referenced application. *Hollmer*, 681 F.3d at 1353, 1358. Therefore, the Federal Circuit held that the incorporation language in *Hollmer* did not directly lead one of ordinary skill in the art to that referenced application, but rather presented several potential documents for incorporation. *Id.* at 1358.

Unlike *Hollmer*, the '882 application (issued as Chu '330) here provided an incorporation-by-reference statement of the applicant's prior applications in the transmittal form and clearly identified the applicant's prior applications (including Chu '886) in the first sentence of the Specification on filing. In particular, the '882 application was filed with a transmittal form with the "incorporation by reference" box checked:

> Incorporation by Reference (useable if Box 4b is checked)
> *The entire disclosure of the prior application*, from which a copy of the oath or declaration is supplied under Box 4b, is considered as being part of the disclosure of the accompanying application and *is hereby incorporated by reference therein*.

Ex. 1011, 81 (emphases added). This checked box on an Office transmittal form shows that the applicant intended to incorporate by reference his prior applications, in their entirety, when he was filing the '882 application.

The applicant also clearly identified his prior applications in the '882 application on filing. Notably, the first sentence of the Specification of the '882 application states that "[t]his application claims any and all benefits as provided by law of U.S. Provisional Application No. 60/083,886" (i.e., Chu '886) "and of U.S. Provisional Application No. 60/092,706 filed on July 14, 1998." *Id.* at 83. The Office accepted the benefit claims to these two prior applications (including Chu '886) by placing them on the File Wrapper Cover of the '882 application, and the Examiner verified them by placing his or her initials on the File Wrapper Cover. *Id.* at 78. Moreover, the Cross-Reference to Related Applications Section of the '882 application listed only these two prior applications and another concurrently filed application. *Id.* at 83.

A reasonably skilled artisan would have recognized that the applicant intended to incorporate his prior applications (including Chu '886) at the time of filing the '882 application. The incorporation-by-reference language, together with the benefit claims in the first sentence of the Specification of the '882 application, sufficiently identified the applicant's prior applications (including Chu '886) as the referenced prior applications, distinguishing them from all other documents.

A reasonably skilled artisan would not have ignored the applicant's incorporation-by-reference statement merely because Box 4b was not checked or because the applicant was not filing a continuation or divisional application. As the Federal Circuit has explained, "[t]he incorporation

standard relies only on the reasonably skilled artisan and his or her ability to deduce from language, however, imprecise, what a host document aims to incorporate." *Husky Injection Molding Systems Ltd. v. Athena Automation Ltd.*, 838 F.3d 1236, 1248 (Fed. Cir. 2016) (citing *Harari v. Lee*, 656 F.3d 1331 (Fed. Cir. 2011); *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1283 (Fed. Cir. 2000)); *cf. In re Fouche*, 439 F.2d 1237, 1239−1240 (CCPA 1971) ("It seems amply clear that an applicant should be permitted to incorporate the disclosure of a copending application . . . so long as the reference application is sufficiently well identified to distinguish it from all others.").

The evidence before us shows that two different Examiners on three separate occasions considered the transmittal form together with the benefit claims and recognized that the applicant incorporated by reference Chu '886, including:

(1) when the applicant filed a preliminary amendment that added Figures 8 and 9 and corresponding disclosure from Chu '886 as Figures 8A and 8B and corresponding disclosure in the '912 application, in which the applicant directed the Examiner to the transmittal form as support for the amendment, Ex. 1009, 26;

(2) when the applicant filed another amendment on December 16, 2011, in the '912 application that added Figures 10 and 16 and corresponding disclosure from Chu '886 as Figures 8C and 24 and corresponding disclosure in the '912 application, in which the applicant also directed the Examiner to the transmittal form as support for this amendment, *id.* at 392; and

(3) when the applicant filed a similar amendment in U.S. Patent Application No. 12/561,138, as part of a separate priority chain of six reissue applications of U.S. Patent No. 6,643,777 B1 ("the '777 patent"), directing the Examiner to the transmittal form submitted in the '882 application as support for the amendment, Ex. 2003, 363, 446 (Notice of Allowance and Fee(s) Due issued after entry of amendment adding figures and disclosure from Chu '886).

The Examiner in each of these cases did not object to the amendments as new matter or issue a rejection under 35 U.S.C. § 112, ¶ 1, for lack of written description support for the claims. *NTP*, 654 at 1277. Instead, the Examiner entered the amendments and subsequently allowed the '912 application with the subject matter added from Chu '886. Ex. 1009, 430 (Notice of Allowance and Fee(s) Due).

The incorporation-by-reference statement in the transmittal form also was never objected to by any Examiner during prosecution of the '882 application (Chu '330), the '758 application (initial ancestor application), and all eleven continuation applications in the priority chain of the '750 patent, as well as the '777 patent and all six reissue applications in the priority chain of the '777 patent, as noted in the Decision Denying Institution in IPR2021-00607, Paper 7 at 20. Moreover, none of the Examiners required the applicant to change the benefit claims from "continuation" to "continuation-in-part" in those continuation applications.

For the foregoing reasons, the '882 application identified Chu '886 with particularity and would have directly led a reasonably skilled artisan to the document intended to be incorporated. Accordingly, we determine that

Petitioner fails to show that the Examiner erred in determining that the '882 application (Chu '330) incorporated Chu '886 by reference.

In addition, as discussed above, Petitioner admits that the '758 application (initial ancestor application) incorporated by reference the '882 application. Pet. 25−26; *see also* Ex. 1013, 4:50−53. It also is undisputed that each subsequent application in the priority chain identified each preceding application as required by 35 U.S.C. § 120 and incorporated by reference the prior applications and the '882 application. *See, e.g.*, Ex. 1001, 1:14–39, 6:46–49; Ex. 1008, 1:12–27, 9:27–29. As such, we also find that Petitioner has failed to show that (1) the '769 patent is not entitled to a priority date before April 15, 2011, (2) the '436 patent's ancestor applications did not properly incorporate by reference Chu '886, and (3) the amendments adding the subject matter from Chu '886 improperly introduced new matter. Pet. 18−32.

2. Transmittal Form is Part of the Application

Petitioner argues that "[e]ven if the transmittal form of [Chu '330] included a statement that purportedly incorporated by reference [Chu '886,] . . . that statement would be inoperative because a person of ordinary skill's analysis of what a patent incorporates is limited to the four corners of *the patent itself*." Pet. 30 (citing *Advanced Display*, 212 F.3d at 1282) (emphasis added). According to Petitioner, a person of ordinary skill in the art "would not have known if a patent incorporates another document based on *a statement buried in a transmittal form*." *Id.* (emphasis added). Petitioner contends that "any incorporation by reference statement must have appeared in [Chu '330] itself." *Id.* (citing MPEP 608.01(p)).

We are not persuaded by Petitioner's arguments. The Federal Circuit has explained that the incorporation-by-reference analysis includes "the four corners of the *application*." *Hollmer*, 681 F.3d at 1358 (emphasis added). A transmittal form is a part of the application. *See* 37 C.F.R. § 1.77(a) (1998) ("The elements of the application, if applicable, should appear in the following order: (1) Utility Application Transmittal Form . . . ."). Courts have repeatedly considered application transmittals in their incorporation-by-reference analyses. *See, e.g.*, *Harari v. Hollmer*, 602 F.3d 1348, 1352−53 (Fed. Cir. 2010) ("*Harari I*"); *Hollmer*, 681 F.3d at 1353−54; *Pregis Corp. v. Doll*, 698 F.Supp.2d 584, 598−599 (E.D. Va. 2010) (The court in its analysis considered the incorporation by reference of a prior provisional application and a patent submitted in a transmittal letter.). Moreover, Petitioner admits that an applicant filing a continuation or divisional application could have used the USPTO transmittal form, which includes a check box for incorporating by reference a prior application. Pet. 29−30 n.5.

Therefore, we are not persuaded by Petitioner's arguments that (1) an incorporation-by-reference statement appearing in a transmittal form "would be inoperative," (2) a person of ordinary skill in the art "would not have known if a patent incorporates another document based on a statement buried in a transmittal form," and (3) "any incorporation by reference statement must have appeared in [Chu '330] itself." Pet. 30.

3. Benefit Claims

Petitioner argues that the statement "[t]his application claims any and all benefits as provided by law of U.S. Provisional Application No.

60/083,886 filed May 1, 1998," which appears in the first paragraph of Chu '330 "is at best a priority claim to [Chu '886] that is distinct from an incorporation by reference." Pet. 31 (citing *In re de Seversky*, 474 F.2d 671, 674 (CCPA 1973)). Petitioner's reliance on *de Seversky* is misplaced. In *de Seversky*, "the parent application . . . contains no 'incorporation-by-reference' language whatsoever." *de Seversky*, 474 F.2d at 674. In contrast, the applicant here filed a transmittal form in the '882 application that includes an incorporation-by-reference statement of his prior applications. Ex. 1011, 81.

Petitioner fails to consider the incorporation by reference statement together with the benefit claims in the first sentence of the Specification that clearly identifies the applicant's prior applications (including Chu '886). As discussed above, the incorporation-by-reference language, together with the benefit claims in the first sentence of the Specification of the '882 application, would have sufficiently identified the applicant's prior applications (including Chu '886) as the referenced prior applications, distinguishing them from all other documents. In short, the '882 application identified Chu '886 with particularity and would have directly led a reasonable skilled artisan to the document intended to be incorporated.

Therefore, Petitioner has not shown that the Examiner erred in determining that the '882 application (Chu '330) incorporated Chu '886 by reference or in entering the amendments that added the subject matter of Chu '886 in the '912 application.

4. Incorporation-by-Reference Standard

Petitioner argues that "[t]he reasonable Examiner standard does not apply to the analysis of the '769 Patent's priority chain because these patents have issued." Pet. 27 n.4 (citing *Harari I*, 602 F.3d at 1348; *Hollmer*, 681 F.3d at 1357). According to Petitioner, "[t]he incorporation by reference is proper only if the host document 'identif[ies] ***with detailed particularity*** what specific material it incorporates ***to a person of ordinary skill***' and 'directly lead[s] one of ordinary skill' to the document . . . intended to be incorporated." *Id.* at 27 (quoting *Hollmer*, 681 F.3d at 1357).

We are not persuaded by Petitioner's arguments. As discussed above, Petitioner has the burden to show that the Examiner erred in determining that the '882 application (issued as Chu '330) incorporated by reference Chu '886. In *Advanced Bionics*, the Board stated that "[i]f reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability. At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown." *Advanced Bionics*, Paper 6 at 9.

Here, Petitioner does not explain why the Examiner erred if a reasonable examiner would have found that the identification in the '882 application was reasonably precise to incorporate Chu '886 by reference. Nor does Petitioner provide any meaningful differences between applying the "reasonable examiner" standard and applying the "person of ordinary skill" standard to the particular facts in this proceeding under the *Advanced Bionics* framework.

In any event, even applying the "person of ordinary skill" standard here, we find that Petitioner fails to show that the Examiner erred in determining that the '882 application (issued as Chu '330) incorporated Chu '886 by reference. As discussed above in Section II.B.1., unlike *Hollmer* where the incorporation language did not directly lead one of ordinary skill in the art to the referenced application because it presented several potential documents for incorporation, the '882 application here provided an incorporation-by-reference statement of the applicant's prior applications and clearly identified the applicant's prior applications (including Chu '886) in the first sentence of the Specification on filing, thereby distinguishing them from all other documents. *Husky Injection*, 838 F.3d at 1248. In short, the '882 application identified Chu '886 with particularity and would have directly led a reasonable skilled artisan to the document intended to be incorporated. *Hollmer*, 681 F.3d at 1357−58.

Accordingly, even under the "person of ordinary skill" standard, we find that Petitioner fails to show that the Examiner erred in determining that the '882 application (issued as Chu '330) incorporated Chu '886 by reference.

C. Conclusion on Discretionary Denial Under § 325(d)

For the foregoing reasons, we determine that the same or substantially the same arguments previously were presented to the Office and that Petitioner fails to show that the Examiner erred in determining that the '882 application (issued as Chu '330) incorporated Chu '886 by reference or in entering the amendments that added the subject matter from Chu '886 in the '912 application. Accordingly, we exercise our discretion not to institute

inter partes review. *Advanced Bionics*, Paper 6 at 8; *see also Becton, Dickinson*, Paper 8, 24.

III. CONCLUSION

For the foregoing reasons, we exercise our discretion under 35 U.S.C. § 325(d) to deny institution of an *inter partes* review.

IV. ORDER

In consideration of the foregoing, it is

ORDERED that the Petition is *denied*, and no trial is instituted.

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