

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

ACQIS LLC,
Patent Owner.

IPR2021-01108
Patent 9,529,768 B2

Before THU A. DANG, JONI Y. CHANG, and SCOTT A. DANIELS,
Administrative Patent Judges.

DANG, *Administrative Patent Judge.*

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 325(d)

I. INTRODUCTION

A. Background

Intel Corporation (“Petitioner”) filed a Petition requesting an *inter partes* review (“IPR”) of claims 1–3, 7–9, 13–17, 19, 20, 25, and 33–35 (“the challenged claims”) of U.S. Patent No. 9,529,768 B2 (Ex. 1001, “the ’768 patent”). Paper 3 (“Pet.”), 1. ACQIS LLC (“Patent Owner”) filed a Preliminary Response (Paper 8, “Prelim. Resp.”). Pursuant to our authorization, Petitioner filed a Reply to Patent Owner’s Preliminary Response (Paper 9, “Pet. Reply”) and Patent Owner filed a Sur-reply (Paper 10, “PO Sur-reply”), each directed to whether we should exercise our discretion to deny institution pursuant to 35 U.S.C. § 314(a).

Under 35 U.S.C. § 325(d), in determining whether to institute an *inter partes* review, “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.” Upon consideration of the Petition, the Preliminary Response, Petitioner’s Reply and Patent Owner’s Sur-reply, we exercise our discretion under § 325(d) not to institute an *inter partes* review of claims 1–3, 7–9, 13–17, 19, 20, 25, and 33–35 of the ’768 patent. Accordingly, no trial is instituted.

B. Related Matters

Petitioner indicates that the ’768 patent is involved in *ACQIS LLC v. MITAC Holding Corp. et al.*, No. 6:20-cv-00962 (W. D. Tex. 2020); *ACQIS LLC v. ASUSTek Computer Inc.*, No. 6:20-cv-00966 (W. D. Tex. 2020); *ACQIS LLC v. Lenovo Group Ltd., et al.*, No. 6:20-cv-00967 (W. D.

Tex. 2020); *ACQIS LLC v. Inventec Corp.*, No. 6:20-cv-00965 (W. D. Tex. 2020); *ACQIS LLC v. Wistron Corp. et al.*, No. 6:20-cv-00968 (W. D. Tex. 2020); and *ACQIS LLC v. Samsung Electronics Co., Ltd. et al.*, No. 2:20-cv-00295 (E. D. Tex. 2020). Pet. 1–2.

Petitioner also concurrently challenges claims of the '768 patent in IPR2021-01107 and IPR2021-01109.

C. The '768 Patent

The '768 patent, titled “Computer System Including CPU or Peripheral Bridge Directly Connected to a Low Voltage Differential Signal Channel that Communicates Serial Bits of a Peripheral Component Interconnect Bus Transaction in Opposite Directions,” issued on December 27, 2016, from Application No. 14/209,922 (“the '922 application”), filed on March 13, 2014, which is a continuation of Application No. 13/744,287 (“the '287 application”), filed on January 17, 2013, now U.S. Patent No. 8,756,359 (“the '359 patent”), which in turn is a continuation of Application No. 13/649,084 (“the '084 application”), filed on October 10, 2012, now U.S. Patent No. 8,977,797 (“the '797 patent”), which in turn is a continuation of Application No. 13/560,924 (“the '924 application”), filed on July 27, 2012, now U.S. Patent No. 8,626,977 (“the '977 patent”), which in turn is a continuation of Application No. 13/087,912 (“the '912 application”), filed on April 15, 2011, now U.S. Patent No. 8,234,436 (“the '436 patent”), which in turn is a continuation of Application No. 12/504,534 (“the '534 application”), filed on July 16, 2009, now U.S. Patent No. 8,041,873 (“the '873 patent”), which in turn is a continuation of Application

No. 12/077,503 (“the ’503 application”), filed on March 18, 2008, now U.S. Patent No. 7,676,624 (“the ’624 patent”), which in turn is a continuation of Application No. 11/166,656 (“the ’656 application”), filed on June 24, 2005, now U.S. Patent No. 7,376,779 (“the ’779 patent”), which in turn is a continuation of Application No. 11/097,694 (“the ’694 application”), filed on March 31, 2005, now U.S. Patent No. 7,363,415 (“the ’3415 patent”), which in turn is a continuation of Application No. 10/772,214 (“the ’214 application”), filed on February 3, 2004, now U.S. Patent No. 7,099,981 (“the ’981 patent”), which then in turn is a continuation of Application No. 09/569,758 (“the ’758 application”), filed on May 12, 2000, now U.S. Patent No. 6,718,415 (“the ’8415 patent”). Ex. 1001, codes (54), (45), (22), (63).

The ’768 patent generally relates to computer interfaces, and particularly, to “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, 3:18–22. An illustration of one embodiment of the ’768 patent’s computer system is depicted in Figure 6, reproduced below.

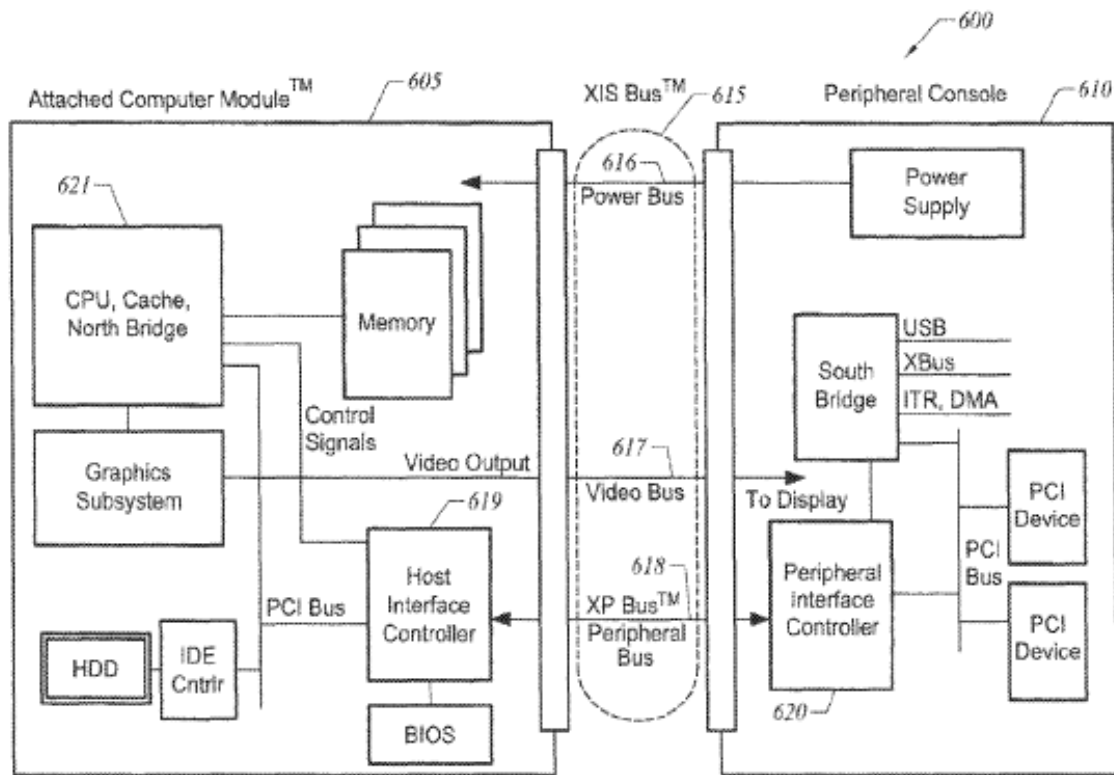


FIGURE 6

Figure 6 shows a block diagram of a computer system using an interface. *Id.* at 15:57–59. As shown in Figure 6, “computer system 600 includes attached computer module (ACM) 605 and peripheral console 610.” *Id.* at 15:59–65. “ACM 605 and [] peripheral console 610 are interfaced through an exchange interface system (XIS) bus 615.” *Id.* at 15:65–67. XIS bus 615, which is also referred to as an interface channel, includes power bus 616, video bus 617 and peripheral bus (XPBus) 618. *Id.* at 15:67–16:2.

Peripheral controller interconnect (PCI) “signals are encoded into control bits and the control bits, rather than the control signals that they represent, are transmitted on the interface channel. *Id.* at 5:49–53. “At the receiving end, the control bits representing control signals are decoded back into PCI control signals prior to being transmitted to the intended PCI bus.” *Id.* at 5:53–55. “The fact that control bits rather than control signals are transmitted on the interface channel allows using a smaller number of signal channels and a correspondingly small number of conductive lines in the interface channel than would otherwise be possible.” *Id.* at 5:56–60. “This relatively small number of signal channels used in the interface channel allows using (low voltage differential signal) LVDS channels for the interface.” *Id.* at 5:63–65.

A. Illustrative Claim

Of the challenged claims, claims 1, 7, 13, and 33 are independent. Claims 2 and 3 depend from claim 1, claims 8 and 9 depend from claim 7, claims 14–17 depend from claim 13, and claims 34 and 35 depend from claim 33. Claim 1 is illustrative:

1. A computer, comprising:
 - an integrated central processing unit, interface controller and Phase-Locked Loop (PLL) clock circuitry in a single chip;
 - a Low Voltage Differential Signal (LVDS) channel directly extending from the interface controller to convey address and data bits of a Peripheral Component Interconnect (PCI) bus transaction in a serial form, wherein the first LVDS channel comprises a first unidirectional, differential signal pair to convey data in a first direction and a second

unidirectional, differential signal pair to convey data in a second, opposite direction; and

wherein the PLL clock circuitry generates different clock frequencies, and the interface controller conveys the PCI bus transaction through the LVDS channel based on the different clock frequencies.

Ex. 1001, 40:37–53.

B. Prior Art Relied Upon

Petitioner relies upon the references listed below (Pet. 34):

Name	Reference	Date	Exhibit No.
Chu (“Chu ’330”)	U.S. Patent No. 6,345,330 B2	Feb. 5, 2002	1003
Cupps	U.S. Patent Publication No. 2003/0135771 A1	July 17, 2003	1004
Helms et al. (“Helms”)	U.S. Patent No. 7,146,510 B1	Dec. 5, 2006	1044

C. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability (Pet. 34):

Claims Challenged	35 U.S.C. §¹	References
13–16, 33, 34	103(a)	Chu ’330, Cupps

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

Claims Challenged	35 U.S.C. § ¹	References
1–3, 7–9, 17, 19, 20, 25, 35	103(a)	Chu ’330, Cupps, Helms

II. ANALYSIS

35 U.S.C. § 325(d)

Petitioner relies upon Chu ’330 in both of the asserted grounds. Pet. 34. While Petitioner acknowledges that Chu ’330 “appears on the voluminous list of references considered by the Patent Office,” Petitioner contends that “no Examiner cited [Chu ’330] against any claims of the ’768 Patent or any of its related applications.” *Id.* at 132.

According to Petitioner, Chu ’330 is prior art because it “issued on February 5, 2002.” Pet. 10. Petitioner contends that “[t]he ’768 patent is not entitled to a priority date before April 15, 2011” (Pet. 18), but rather, “the ’768 Patent is, at best, entitled to a priority date only as to the filing date of [the ’436 patent in the priority chain, filed as the ’912 application on April 15, 2011].” *Id.* at 19; *see* Ex. 1001, code (63). Petitioner contends that “the Examiner did not determine the proper priority date of any of the challenged claims during prosecution,” and that “even wrongly assuming the Examiner made an implicit determination regarding the priority date, such determination would have been materially erroneous.” *Id.* at 132–133. In

Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), and we apply the pre-AIA versions of 35 U.S.C. §§ 102, 103 and 112.

particular, Petitioner argues that the challenged claims in the '768 patent recite an “integrated CPU-controller” and a “CPU_LVDS,” but the '768 patent’s purported written description support for the limitation was not disclosed in the provisional or any of the non-provisional applications preceding the '436 patent. Pet. 20–22 (citing generally Exs. 1007, 1013–1018).

Patent Owner argues that the Board should deny institution under § 325(d) because “the examiner previously considered and affirmed the efficacy of an incorporation by reference in the context of a priority claim.” Prelim. Resp. 11–12 (citing *SMR Auto. Sys. USA, Inc. v. Magna Mirrors of Am., Inc.*, IPR2018-00931, Paper 7 at 14 (PTAB Sept. 14, 2018)). According to Patent Owner, “[t]he USPTO has already considered and rejected Petitioner’s argument five times—twice during examination and, critically, three times by the Board just weeks ago.” *Id.*

For the reasons set forth below, we are persuaded by Patent Owner’s arguments to exercise our discretion to deny institution of *inter partes* review under 35 U.S.C. § 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”).

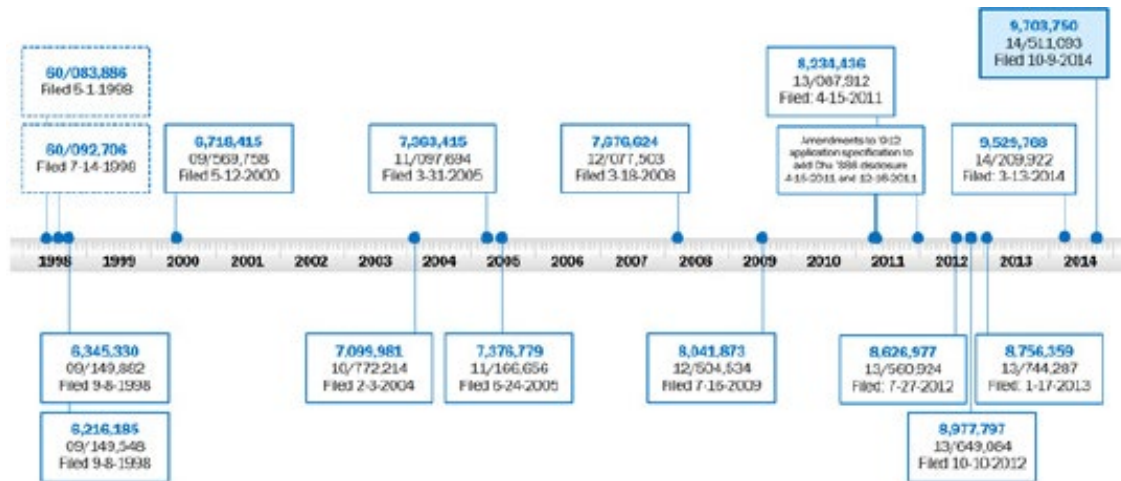
Under § 325(d), in “determining whether to institute [an *inter partes* review], the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” We determine whether to exercise our discretion to deny institution under 35 U.S.C. § 325(d) based on the framework set forth in *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GMBH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential). In *Advanced Bionics*, the Board applied a two-part framework in considering whether to exercise discretion to deny institution under § 325(d): “(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* at 8. Only if the same or substantially the same art or arguments were previously presented to the Office do we then consider whether petitioner has demonstrated a material error by the Office. *Id.* at 10. “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.

1. Part 1: Whether the art or arguments presented in the Petition are the same or substantially the same as those previously presented to the Office

We first determine whether the same or substantially the same arguments previously were presented to the Office. *Advanced Bionics* at 8.

The '768 patent was issued from the '922 application, which claims priority to the '758 application, filed May 12, 2000, through a chain of continuation applications. Ex. 1001, codes (21)(63). In particular, the '922 application is a continuation of the '287 application, which in turn is a continuation of the '084 application, which in turn is a continuation of the '924 application, which in turn is a continuation of the '912 application, which in turn is a continuation of the '534 application, which in turn is a continuation of the '503 application, which in turn is a continuation of the '656 application, which in turn is a continuation of the '694 application, which in turn is a continuation of the '214 application, which then in turn is a continuation of the '758 application. *Id.*

Patent Owner's Figure provides a timeline of the priority chain for the '768 patent, up to child patent, U.S. Patent No. 9,703,750 ("the '750 child patent"), which is reproduced below. Prelim. Resp. 7.



Patent Owner's Figure above shows the filing dates of the applications in the priority chain of the '768 patent (and the '750 child patent), along with other related applications, including provisional U.S. Application No. 60/083,886 ("the '886 provisional"), and U.S. Application No. 09/149,882 ("the '882 application") which was issued as Chu '330. Prelim. Resp. 7. Patent Owner asserts that each application in the priority chain of the '768 patent identifies each preceding application as required by 35 U.S.C. § 120, and incorporates the prior applications by reference. *Id.*; *see also, e.g.*, Ex. 1001, 1:13–35.

The '758 application, issued as the '8415 patent, is the first non-provisional application in the priority chain of the '768 patent. *See* Ex. 1001, code (63). The '758 application incorporates by reference the '882 application (i.e., Chu '330). Ex. 1013, 4:50–53. Chu '330 claims priority to

the '886 provisional and incorporates by reference the '886 provisional. Ex. 1003, code (60), 1:7–10.

The '912 application, now the '436 patent, filed on April 15, 2011, is one of the intermediate applications in the priority chain of the '768 patent. *See* Ex. 1001, code (63). The '912 application was filed with a preliminary amendment (Ex. 1009, 12–28 (prosecution history of the '436 patent)), adding Figures 8 and 9 and corresponding disclosure from the '886 provisional as Figures 8A and 8B and corresponding disclosure in the '912 application. *See id.* at 15, 16, 26–28. The applicant also filed another amendment in the '912 application (*id.* at 379–395, 401–402), adding Figures 10 and 16 and corresponding disclosure from the '886 provisional as Figures 8C and 24 and corresponding disclosure in the '912 application. *See id.* at 382, 392, 401–402.

In its Petition, Petitioner argues the '886 provisional was not properly incorporated by reference into the '768 patent family, and thus, the amendments adding the subject matter from the '886 provisional into the '768 patent family via the '912 application improperly introduced new matter. Pet. 18–30. Accordingly, Petitioner contends that the earliest possible priority date to which the claims of the '768 patent could be entitled is April 15, 2011, the filing date (the date of the preliminary amendment “introduced” the matter) in the '912 application issued as the '436 patent. *Id.* at 30.

However, during the prosecution of the '912 application (i.e., the '436 patent), the applicant argued that these amendments were proper because the '758 application incorporated by reference the '882 application (Chu '330), and the '882 application incorporated the '886 provisional by reference. Ex. 1009, 26, 392. “When 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). In fact, the prosecution history of the '912 application shows that when the subject matter from the '886 provisional was added to the '912 application, the applicant specifically directed the Examiner to the incorporation by reference statement in the transmittal form filed in the '882 application (Chu '330) as support for the amendments. Ex. 1009, 26, 392 (“*See checked incorporation by reference box in utility patent application transmittal of U.S. Application No. 09/149,882 filed on September 8, 1998*”). Further, in the “Remarks” sections of the amendments, the applicant in the '912 application 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.” *Id.* The Examiner in the '912 application also did not require the applicant to change the benefit claim from “continuation” to “continuation-in-part.” *See generally* Ex. 1009. Nor did the Examiner require the applicant to change the benefit claim from “continuation” to “continuation in-part.” *Id.* Instead, the

Examiner entered the amendments and subsequently allowed the '912 application with the subject matter added from the '886 provisional. *Id.* at 430–432 (Notice of Allowance and Fee(s) Due), 434 (Notice of Allowability).

In addition, another petitioner (Samsung Electronics Co., LTD. (“Samsung”)) previously presented to the Office substantially the same arguments that the amendments adding the subject matter from the '886 provisional 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 [the] '886 [provisional]” 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 the '886 provisional. *See, e.g.*, IPR2021-00604, Paper 7, 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 Advanced Bionics* at 10. Consequently, part one of the *Advanced Bionics* framework is satisfied and we proceed to part two of *Advanced Bionics* framework to determine whether the Office committed a material error.

2. Part 2: Whether the Office erred in a manner material to the patentability of challenged claims

We next determine whether the petitioner has demonstrated that the Office “erred in a manner material to the patentability of challenged claims.” *Advanced Bionics* at 8. If “reasonable minds can disagree,” the Office did not materially err. *Id.* at 9. That is, under Part II of the *Advanced Bionics* framework, Petitioner has the burden to show that the Examiner erred. *Id.*

As discussed above, Petitioner argues that the '768 patent is not entitled to a priority date before April 15, 2011, the filing date of the '436 patent. Pet. 30. In particular, Petitioner contends that the '886 provisional was not properly incorporated by reference into the '768 patent family, and thus, the amendments adding the subject matter from the '886 provisional into the '768 patent family via the '436 patent improperly introduced new matter. Pet. 18–30.

Petitioner admits that the '758 application (, i.e., the first non-provisional application in the priority chain that issued as the '8415 patent,) incorporated by reference the '882 application, *i.e.*, Chu '330. *Id.* at 23; *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, 1:13–35, 9:66–10:2; Ex. 1008, 1:12–27, 9:27–29. Nonetheless, Petitioner argues that “Chu '330 never incorporated by reference the '886 Provisional.” Pet. 26–30.

In particular, Petitioner argues that: a) the transmittal form filed in Chu '330 does not identify the '886 provisional (Pet. 26); that b) any incorporation by reference statement must have appeared in Chu '330 itself (*id.* at 28–29); that c) a priority claim to the '886 provisional is distinct from an incorporation by reference (*id.* at 29–30); and that d) the reasonable examiner standard does not apply to the analysis of the '768 patent's priority chain because these patents have issued. *Id.* at 25, fn. 3.

Here, Petitioner has the burden to show that the Examiner erred in determining that Chu '330 incorporated by reference the '886 provisional. *Advanced Bionics*, Paper 6 at 8.

We address below Petitioner's arguments in turn.

a. The Application Transmittal Form Does Not Identify The
'886 Provisional

To support its argument that Chu '330 never incorporated by reference the '886 provisional, Petitioner contends that “[t]he checked box in the transmittal form [filed in the '882 application (later issued as Chu '330)] does not identify the '886 Provisional.” Pet. 26. Petitioner provides an annotated figure showing a copy of the application transmittal form submitted with the '882 application, reproduced below, to illustrate its contentions.

APPLICATION ELEMENTS See MPEP chapter 600 concerning utility patent application contents.		ADDRESS TO: Assistant Commissioner for Patents Box Patent Application Washington, DC 20231	
1. ☒ Fee Transmittal Form (Submit an original, and a duplicate for fee processing)		6. ☐ Microfiche Computer Program (Appendix)	
2. ☒ Specification (preferred arrangement set forth below) [Total Pages 45]		7. ☒ Nucleotide and/or Amino Acid Sequence Submission (if applicable, all necessary)	
- 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		a. ☐ Computer Readable Copy b. ☐ Paper Copy (identical to computer copy) c. ☐ Statement verifying identity of above copies	
3. ☒ Drawing(s) (35 USC 113) [Total Sheets 57]		ACCOMPANYING APPLICATION PARTS	
4. ☐ Oath or Declaration [Total Pages 1]		8. ☐ Assignment Papers (cover sheet & document(s))	
a. ☐ Newly executed (original or copy)		9. ☐ 37 CFR 3.73(b) Statement ☐ Power of Attorney (when there is an assignee)	
b. ☐ Copy from a prior application (37 CFR 1.63(d) (for continuation/divisional with Box 17 completed) (Note Box 5 below)		10. ☐ English Translation Document (if applicable)	
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)		11. ☐ Information Disclosure Statement (IDS)/PTO-1449 ☐ Copies of IDS Citations	
5. ☒ 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.		12. ☐ Preliminary Amendment	
		13. ☒ Return Receipt Postcard (MPEP 503) (Should be specifically itemized)	
		14. ☐ Small Entity ☐ 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: _____			

Id. at 27; *see also* Ex. 1011, 81. The annotated figure above shows a copy of the application transmittal form submitted with the '882 application, wherein Petitioner highlights Box “4b” and the description “(useable if Box 4b is

checked)” in Box “5 Incorporation By Reference” to illustrate its contentions.

Petitioner argues that nothing in the transmittal form above identifies “with *detailed particularity* what specific material” Chu ’330 incorporates. Pet. 27 (quoting *Hollmer v. Harari*, 681 F.3d, 1351, 1357 (Fed. Cir. 2012) (“*Hollmer*”). Petitioner also avers that “the 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 that “[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.’” *Id.* at 27–28, fn. 4.

However, Petitioner’s arguments narrowly focus on the application transmittal form alone. Pet. 26–28. As the U.S. Court of Appeals for the Federal Circuit (“the Federal Circuit”) has explained, the incorporation by reference analysis includes “the four corners of the application.” *Hollmer*, 681 F.3d at 1358.

In *Hollmer*, 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 the referenced application and at least two other applications by the same inventors that had the same title as the 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.*

Unlike *Hollmer*, here, the '882 application that issued as Chu '330 provided an incorporation by reference statement of the applicant's prior applications in the application transmittal form and clearly identified the applicant's prior applications, which included the '886 provisional, in the first sentence (in the "Cross Reference to Related Applications" section) of the Specification on filing. *See* Ex. 1011, 83.

As shown by its prosecution history, the '882 application was filed with an application transmittal form with the "Incorporation By Reference" box "5" 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.

See Ex. 1011, 79 (emphases added).

The applicant also clearly identified his prior applications in the Specification of the '882 application on filing. The first sentence in the "Cross Reference to Related Applications" section of the '882 application, for example, states that "[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" (the '886 provisional) and of U.S. Provisional Application No. 60/092,706 filed on July 14, 1998. *Id.* at 83. The USPTO accepted the benefit claims to these prior applications 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.

A reasonably skilled artisan would have recognized that the applicant intended to incorporate his prior applications, including the '886 provisional, 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 would have sufficiently identified the applicant's prior applications, including the '886 provisional, as the referenced prior applications, distinguishing them from all other documents for incorporation.

A reasonably skilled artisan would not have ignored the applicant's incorporation by reference statement just because Box 4b on the application transmittal form 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 Fouché*, 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, in light of the benefit

claims to the prior applications, which included the '886 provisional, and recognized that the applicant incorporated by reference those prior applications:

(1) when the applicant filed the preliminary amendment that added Figures 8 and 9 and corresponding disclosure from the '886 provisional as Figures 8A and 8B and corresponding disclosure in the '912 application in the priority chain, in which the applicant directed the Examiner to the application transmittal form as support for the amendment (Ex. 1009, 15, 16, 26–28);

(2) when the applicant filed another amendment on December 16, 2011, that added Figures 10 and 16 and corresponding disclosure from the '886 provisional as Figures 8C and 24 and corresponding disclosure of the '912 application, in which the applicant similarly directed the Examiner to the application transmittal form as support for this amendment (*id.* at 380–382, 392, 401–402); and

(3) when the applicant filed a similar amendment in U.S. Application No. 12/561,138, as part of a separate priority chain, directing the Examiner to the application transmittal form submitted in the '882 application as support for the amendment. Ex. 2003, 363.

The Examiner in each of these cases did not object to the amendments as new matter or issue a rejection under § 112, ¶ 1, for lack of written description support for the claims. The incorporation by reference statement in the application transmittal form also was never objected to by any examiner during prosecution of the '882 application, and all ten continuation

applications in the priority chain of the '768 patent, including the '758 application. Moreover, none of the Examiners required the applicant to change its benefit claims from “continuation” to “continuation-in-part” in those ten continuation applications.

For the foregoing reasons, we are not persuaded by Petitioner’s argument that Chu ’330 did not properly incorporate the subject matter of the ’886 provisional.

In addition, as discussed above, Petitioner admits that the ’758 application (the first non-provisional application in the priority chain), incorporated by reference the ’882 application. Pet. 23; *see also* Ex. 1013, 4:50–53. Further, it 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, 1:13–35, 9:66–10:2; Ex. 1008, 1:12–27, 9:27–29.

As such, we find that Petitioner has failed to show (1) the ’768 patent is not entitled to a priority date before April 15, 2011, (2) the ’436 patent’s parent applications in the ’768 patent family did not properly incorporate by reference the ’886 provisional, and (3) the amendments adding the subject matter from the ’886 provisional improperly introduced new matter. Pet. 18–30.

b. Incorporation By Reference Statement Must Have Appeared
In Chu '330 Itself

Petitioner further argues that, even if the application transmittal form of Chu '330 included a statement that purportedly incorporated by reference the '886 provisional, “that statement would be inoperative because a [person of ordinary skill in the art]’s analysis of what a patent incorporates is limited to the four corners of the patent itself.” Pet. 28. According to Petitioner, a person of ordinary skill in the art (“POSITA”) “would not have known if a patent incorporates another document based on a statement buried in a transmittal form.” *Id.* at 28. Accordingly, Petitioner contends that “any incorporation by reference statement must have appeared in Chu[']330 itself.” *Id.* at 28–29.

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. Here, the application transmittal form is a part of the application, i.e., included in the four corners 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 acknowledges that an applicant filing a continuation or divisional application could have used the USPTO application transmittal form, which includes check box “5” titled “Incorporating By Reference” for incorporating a prior application. Pet. 27–28, fn. 4.

Therefore, we are not persuaded by Petitioner’s arguments that (1) an incorporation by reference statement appeared in an application transmittal form “would be inoperative,” (2) a POSITA “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.”

c. A Priority Claim to the ’886 Provisional Is Distinct from an Incorporation by Reference

Petitioner contends that, although Chu’330 states that “[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” in the first sentence of the Specification, this statement in Chu ’330 “is at best a priority claim to the ’886 Provisional that is distinct from an incorporation by reference.” Pet. 29 (citing *In re de Seversky*, 474 F.2d 671, 674 (CCPA 1973) (“a mere reference to another application, or patent, or publication is not an incorporation of anything therein into the application.”)).

Petitioner’s reliance on *de Seversky* is misplaced here. In *de Seversky*, “the parent application . . . contains no ‘incorporation-by-reference’ language whatsoever.” *de Seversky*, 474 F.2d at 674. In contrast, the

applicant in the '882 application filed an application transmittal form that includes an incorporation by reference statement of its 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 clearly identifying the applicant's prior applications (including the '886 provisional), which would have sufficiently identified the '886 provisional and the other of applicant's prior applications as the referenced prior applications, distinguishing them from all other documents. In short, the '882 application identified the '886 provisional with particularity and would have directly led a reasonably skilled artisan to the document intended to be incorporated.

On this record, Petitioner has not shown that the Examiner erred in determining that the '882 application (Chu '330) incorporated the '886 provisional by reference. Accordingly, Petitioner also has not shown that the Examiner erred in entering the amendments that added the subject matter of the '886 provisional, that has been incorporated by reference, in the '912 application.

d. The Reasonable Examiner Standard Does Not Apply to the Analysis of the '768 Patent's Priority Chain

Petitioner further argues that "[t]he reasonable Examiner standard does not apply to the analysis of the '768 Patent's priority chain because these patents have issued." Pet. 25, fn. 3 (citing *Harari I*, 602 F.3d at 1348; *Hollmer*, 681 F.3d at 1356). 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 that the patent-drafter intended to be incorporated.” *Id.* at 25 (quoting *Hollmer*, 681 F.3d at 1357).

We are not persuaded by Petitioner’s arguments. Here, the question is, and it is Petitioner’s burden to show, whether the Examiner erred in determining that the Chu ’330 incorporated by reference the ’886 provisional. As the Board stated in *Advanced Bionics*, “[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.

In this case, Petitioner does not explain why the Examiner’s determination that the ’882 application (later issued as Chu ’330) incorporated by reference the ’886 provisional was in error if a reasonable examiner would have found that the identification in the ’882 application was reasonably precise to incorporate the ’886 provisional by reference. Petitioner does not provide any meaningful differences between applying the “reasonable examiner” standard and applying the “POSITA” standard to the particular facts in this proceeding under the *Advanced Bionics* framework.

Nevertheless, even applying the POSITA standard here, we find that Petitioner fails to show that the Examiner erred in determining that the ’882 application incorporated the ’886 provisional by reference. As discussed

above in Section II.A.2.a, unlike *Hollmer* where the incorporation language 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 '886 provisional and the applicant's other prior applications in the first sentence of the Specification on filing.

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 '886 provisional and the applicant's other prior provisional applications as the referenced prior applications, distinguishing them from all other documents. *Husky Injection*, 838 F.3d at 1248. In short, the '882 application identified the '886 provisional with particularity and would have directly led a reasonably skilled artisan to the document intended to be incorporated. *Hollmer*, 681 F.3d at 1357–58.

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

3. § 325(d) Conclusion

For the foregoing reasons, we determine that (a) the same or substantially the same arguments previously were presented to the Office, and (b) Petitioner fails to show that the Examiner erred in determining that the '882 application (issued as Chu '330) incorporated by reference the '886 provisional or in entering the amendments that added the subject matter from

the '886 provisional in the '912 application. Accordingly, we exercise our discretion not to institute *inter partes* review. *Advanced Bionics* at 8; *see also Becton, Dickinson*, Paper 8, 24.

III. CONCLUSION

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

IV. ORDER

Accordingly, it is

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

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