

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

ACQIS LLC,
Patent Owner.

IPR2021-01114
Patent RE44,654 E

Before THU A. DANG, JONI Y. CHANG, and PATRICK M. BOUCHER,
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 17–19, 26–31, 35, and 36 (“the challenged claims”) of U.S. Patent No. RE44,654 E (Ex. 1001, “the ’654 patent”). Paper 2 (“Pet.”), 1. ACQIS LLC (“Patent Owner”) filed a Preliminary Response (Paper 7, “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 17–19, 26–31, 35, and 36 of the ’654 patent. Accordingly, no trial is instituted.

B. Related Matters

Petitioner indicates that the ’654 patent is involved in *ACQIS LLC v. MITAC Holding Corp. et al.*, No. 6:20-cv-00962 (W.D. Tex. 2020); *ACQIS LLC v. Inventec Corp.*, No. 6:20-cv-00965 (W.D. Tex. 2020); *ACQIS LLC v. ASUSTek Computer Inc.*, No. 6:20-cv-00966 (W.D. Tex. 2020); *ACQIS LLC*

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v. Lenovo Group Ltd., et al., No. 6:20-cv-00967 (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.

Petitioner also concurrently challenges claims of the '654 patent in IPR2021-01113.

C. The '654 Patent

The '654 patent, titled “Data Security Method and Device for Computer Modules,” issued on December 17, 2013, from Application No. 13/649,078 (“the '078 application”), filed on October 10, 2012, is a reissue of Application No. 09/312,199 (“the '199 application”), filed on May 14, 1999, now U.S. Patent No. 6,634,777 (“the '777 patent” or “Chu '777”), and which is a continuation of Application No. 13/562,210 (“the '210 application”), filed on July 30, 2012, which in turn is a continuation of Application No. 13/294,108 (“the '108 application”), filed on November 10, 2011, now U.S. Patent No. RE43,602 E (“the '602 patent”), which in turn is a continuation of Application No. 12/561,138 (“the '138 application”), filed on September 16, 2009, now U.S. Patent No. RE42,984 E (“the '984 patent”), which in turn is a continuation of Application No. 11/545,056 (“the '056 application”), filed on October 6, 2006, now U.S. Patent No. RE43,171 E (“the '171 patent”), which then in turn is a continuation of Application No. 11/056,604 (“the '604 application”), filed on February 10, 2005, now U.S. Patent No. RE41,092 E (“the '092 patent”). Ex. 1001, codes (54), (45), (22), (64), (63).

The '654 patent generally relates to a technique for securing a computer module in a computer system, which includes providing “a security system for an attached computer module (‘ACM’),” wherein the ACM is “insert[ed] into a computer module bay (CMB) within a peripheral console to form a functional computer.” Ex. 1001, 3:43–49. An illustration of one embodiment of the '654 patent's computer system is depicted in Figure 13, reproduced below.

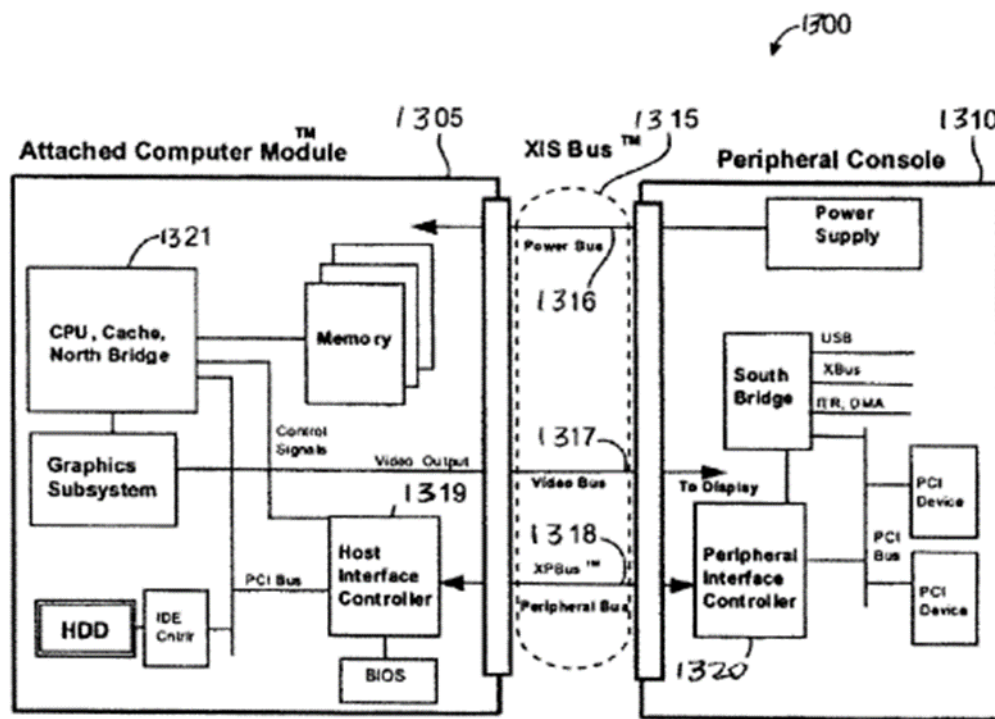


FIG. 13

Figure 13 shows a block diagram of a computer system using an interface. *Id.* at 18:35–36. As shown in Figure 13, computer system 1300 includes ACM 1305 and peripheral console 1310. *Id.* at 18:37–42. ACM

1305 and peripheral console 1310 are interfaced through exchange interface system (XIS) bus 1315. *Id.* at 18:42–44. XIS bus 1315, which is also referred to as an interface channel, includes power bus 1316, video bus 1317 and peripheral bus (XPBus) 1318. *Id.* at 18:44–47.

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 17:20–24. 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 17:24–26. 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 17:27–31. 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 17:33–35.

D. Illustrative Claim

Of the challenged claims, claims 17, 26, 29, and 35 are independent. Claims 18 and 19 depend from claim 17; claims 27 and 28 depend from claim 26; claims 30 and 31 depend from claim 29; and claim 36 depends from claim 35. Claim 17 is illustrative:

17. A method of increasing external peripheral data communication speed of a computer, comprising:

providing an integrated Central Processing Unit (CPU) and graphics controller in a single chip, on a printed circuit board of a computer;

providing digital video signals directly from the integrated CPU and graphics controller;

connecting a first Low Voltage Differential Signal (LVDS) channel directly to the peripheral bridge on the printed circuit board, the first LVDS channel comprising two unidirectional, serial channels that transmit data in opposite directions;

providing a connector for the computer for connection to a console;

providing a second LVDS channel to couple to the console through the connector, the second LVDS channel comprising two unidirectional, serial channels that transmit data in opposite directions;

enabling encoded address and data bits of a Peripheral Component Interconnect (PCI) bus transaction to be conveyed in serial form over the second LVDS channel to preserve the PCI bus transaction; and

enabling the PCI bus transaction to be conveyed serially through the second LVDS channel to the console to improve peripheral data communication speed between the computer and the console.

Ex. 1001, 23:4–29.

E. Prior Art Relied Upon

Petitioner relies upon the references listed below (Pet. 10):

Name	Reference	Date	Exhibit No.
Chu ("Chu '330")	U.S. Patent No. 6,345,330 B2	Feb. 5, 2002	1003
Peleg et al. ("Peleg")	U.S. Patent No. 6,557,065 B1	Apr. 29, 2003	1034
Chu '777	U.S. Patent No. 6,643,777 B1	Nov. 4, 2003	1007
Helms et al. ("Helms")	U.S. Patent No. 7,146,510 B1	Dec. 5, 2006	1044

F. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability
(Pet. 36–37):

Claims Challenged	35 U.S.C. §¹	References
17–19, 26, 35	103(a)	Chu '330, Peleg, Helms

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, 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.

Claims Challenged	35 U.S.C. § ¹	References
27–31, 36	103(a)	Chu '330, Peleg, Helms, Chu '777

II. ANALYSIS

A. 35 U.S.C. § 325(d)

Petitioner relies upon Chu '330 in both of the asserted grounds, and Chu '777 in one of the asserted grounds. Pet. 37. Petitioner contends that “no Examiner cited Chu[']330 or Chu[']777 against any claims [of the '654 Patent].” *Id.* at 114.

According to Petitioner, Chu '330 and Chu '777 are prior art because the '654 patent “is, at best, entitled to a priority date when new matter was added into U.S. Reissued Patent No. 42,984 ([the '984 patent in the priority chain of the '654 patent, filed as the '138 application])—June 17, 2011.” Pet. 22. Petitioner contends that “the Examiner did not determine the proper priority date of any of the challenged claims during prosecution,” but instead “simply accepted the applicant’s representation that [the '654 patent] properly incorporated by reference the materials found only in [U.S. provisional application No. 60/083,886 ([the '886 [p]rovisional[])].” *Id.* at 114. Further, Petitioner contends that “even wrongly assuming the Examiner made an implicit determination regarding the priority date, such determination would have been materially erroneous.” *Id.* at 115. In particular, Petitioner argues that the challenged claims in the '654 patent recite “integrated CPU/graphics” and “CPU-PB” but the '654 patent’s

purported written description support for the limitations “was not disclosed in the parent applications that precede [the ’984 patent].” Pet. 23–28.

Patent Owner argues that the Board should exercise our discretion to 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 multiple times—during examination and, critically, by the Board just weeks ago.” *Id.* at 11.

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*, 579 U.S. 261, 273 (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*, Paper 6 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.

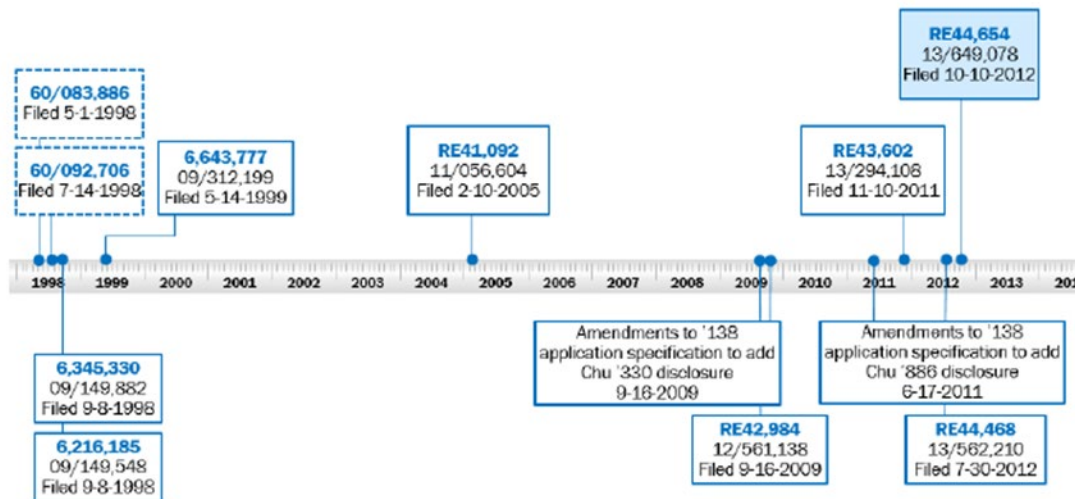
1. Part 1: Whether the art or arguments presented in the Petition are the same or substantially the same as those previously presented to the Office

We first determine whether the same or substantially the same arguments previously were presented to the Office. *Advanced Bionics*, Paper 6 at 8.

As discussed above, the ’654 patent is a reissue patent of the ’777 patent (also the ’199 application), and claims priority through a chain of

reissue continuation applications. Ex. 1001, code (64), (63). In particular, the '654 patent is a continuation of the '210 application, which in turn is a continuation of the '108 application, which in turn is a continuation of the '138 application, which in turn is a continuation of the '056 application, which then in turn is a continuation of the '604 application. *Id.*

Patent Owner's Figure provides a timeline of the priority chain and other related applications, which is reproduced below. Prelim. Resp. 7–8.



Patent Owner's Figure above shows the filing dates of the '777 patent, the reissue applications in the priority chain of the '654 patent, along with those of U.S. provisional application No. 60/083,886 (the '886 provisional) and Chu '330. *Id.* According to Patent Owner, each reissue application in the priority chain of the '654 patent identifies each preceding reissue application as required by 35 U.S.C. § 120 and incorporates the prior applications by reference. *Id.* at 8; *see also, e.g.*, Ex. 1001, 1:23–30; Ex. 1008, 1:18–21, 5:50–54 (the '138 application). Patent Owner also contends

that each reissue application in the '654 patent's priority chain also incorporates by reference U.S. Application No. 09/149,882 ("the '882 application"), which was issued as Chu '330. Prelim. Resp. 8; *see also, e.g.*, Ex. 1001, 15:49–54.

The '138 application, now the '984 patent, filed on September 16, 2009, is one of the intermediate applications in the priority chain of the '654 patent. *See* Ex. 1001, code (63). The '138 application was filed with a preliminary amendment (Ex. 1009, 13, 49–74 (prosecution history of the '984 patent)), adding Figures 2b, 3, 4, and 7 and corresponding disclosure from U.S. Patent No. 6,216,185 ("the '185 patent") and Figures 2, 6, 11, and 23 and the corresponding description from Chu '330, as Figures 9 through 16 and corresponding disclosure in the '138 application. *See id.* at 73. The applicant also filed another amendment in the '138 application (*id.* at 341, 344–377) on June 17, 2011 ("the June 17, 2011 amendment"), adding Figures 3 and 4 and corresponding disclosure from Chu '330 and Figures 8 and 9 and the corresponding description from the '886 provisional, as Figures 17 through 20 and corresponding disclosure in the '138 application. *See id.* at 363 ("the subject application is amended to add new FIG. 17 through FIG. 20, as well as accompanying text" which "corresponds to: (a) FIG. 3 and FIG. 4 of the '330 patent; (b) the text of the '330 patent . . . ; (c) figure 8 and figure 9 of the '886 provisional []; and (d) the text of the '886 provisional").

In its Petition, Petitioner argues the '886 provisional was not properly incorporated by reference into the '654 patent family, and thus, the

amendments adding the subject matter from the '886 provisional into the '654 patent family via the '138 application that issued as the '984 patent improperly introduced new matter. Pet. 28–32. Accordingly, Petitioner contends that the earliest possible priority date to which the claims of the '654 patent could be entitled is June 17, 2011, the filing date (the date of the preliminary amendment which “introduced” the matter) in the '138 application. *Id.* at 32–36.

However, during the prosecution of the '138 application (i.e., the '984 patent), the applicant argued that these amendments were proper because the '199 application (now the '777 patent) incorporated by reference the '882 application (Chu '330), and the '882 application in turn claimed the benefit of and incorporated by reference the '886 provisional. Ex. 1009, 363.

“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 '138 application shows that when the subject matter from the '886 provisional was added to the '138 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, 363 (“*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 '138 application argued that “the '777 patent application incorporated by reference U.S. Application No. 09/149,882, now issued as U.S. Patent No. 6,345,330 (the “'330 patent”), which, in turn, claimed the benefit of and incorporated by reference U.S. Provisional Application No. 60/083,886.” *Id.*

The Examiner in the '138 application also did not object to the inclusion of the amendment as new matter or issue a rejection under 35 U.S.C. § 112, ¶ 1. *See generally* Ex. 1009. Instead, the Examiner entered the amendments and subsequently allowed the '138 application with the subject matter added from the '886 provisional. *Id.* at 446–448 (Notice of Allowance and Fee(s) Due), 450–452 (Notice of Allowability).

As Patent Owner also points out (Prelim. Resp. 10), each subsequent application in the '654 patent's priority chain, including the '078 application (issued as the '654 patent), was amended to include the same figures and disclosure from the '886 provisional and, in each application, the amendment was approved and entered by the Examiner. *See, e.g.*, Ex. 1006 (Prosecution History of the '654 patent), 154, 203–206 (Non-Final Rejection containing no new matter rejection).

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.*, IPR2021-00608, Paper 8, 7–26 (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*, Paper 6 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*, Paper 6 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 ’654 patent is not entitled to a priority date before June 17, 2011, the filing date of the ’138 application (issued as the ’984 patent). Pet. 32. In particular, Petitioner contends that the ’886 provisional was not properly incorporated by reference into the ’654 patent family, and thus, the amendments adding the subject matter from the ’886 provisional into the ’654 patent family via the ’138 application improperly introduced new matter. Pet. 32–36.

Petitioner admits that the ’777 patent, i.e., the ’199 application, incorporated by reference the ’882 application, i.e., Chu ’330. *Id.* at 26; *see also* Ex. 1007, 5:9–13. It also is undisputed that the ’604 application (the first parent application in the ’654 patent priority chain and a reissue application of the ’777 patent) incorporated by reference the ’882 application (Ex. 1013, code (64), 5:19–23), and 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, code (63), 1:23–29, 5:62–67; Ex. 1008, code (63), 1:18–21, 5:50–54. Nonetheless, Petitioner argues that “Chu '330 never incorporated by reference the '886 Provisional.” Pet. 26–36.

In particular, Petitioner argues that: a) the transmittal form filed in Chu '330 does not identify the '886 provisional (Pet. 28–29); that b) any incorporation by reference statement must have appeared in Chu '330 itself (*id.* at 30–31); that c) a priority claim to the '886 provisional is distinct from an incorporation by reference (*id.* at 31); and that d) the reasonable Examiner standard does not apply to the analysis of the '654 patent's priority chain because these patents have issued. *Id.* at 27–28, n.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 the checked box in the transmittal form filed in the '882 application (later issued as Chu '330) does not identify the '886 provisional. Pet. 28. 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) - 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	(Total Pages 45)	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	
3. ☒ Drawing(s) (35 USC 113)	(Total Sheets 37)	ACCOMPANYING APPLICATION PARTS	
4. ☐ Oath or Declaration (Total Pages 1) 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)		8. ☐ Assignment Papers (cover sheet & document(s))	
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.		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. ☒ Return Receipt Postcard (MPEP 503) (Should be specifically itemized)	
		14. ☐ Small Entity ☐ Statement filed in prior application, Statement(s) 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 29; *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. 29 (quoting *Hollmer v. Harari*, 681 F.3d 1351, 1357 (Fed. Cir. 2012) (“*Hollmer*”)). Petitioner also avers that “Box 5 [titled ‘Incorporation By Reference’] is only ‘useable if Box 4b is checked[,]’” but “Box 4b is not

checked,” and that, even 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 29–30, n.4.

However, Petitioner’s arguments narrowly focus on the application transmittal form alone. Pet. 29–30. 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 Chu ’886, 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). This checked box on a USPTO application 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 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.")).

As we pointed out in our Decision Denying Institution in IPR2021-00608, Paper 8 at 22–23, 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 the '886 provisional:

(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 U.S. Application No. 13/087,912 ("the '912 application"), in which the applicant directed the Examiner to the application transmittal form as support for the amendment (IPR2021-00605, Ex. 1011, 15, 16, 26–28);

(2) when the applicant filed another amendment in the '912 application 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 the '138 application, directing the Examiner to the application transmittal form submitted in the '882 application as support for the amendment (Ex. 1009, 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. *NTP*, 654 F.3d at 1277. Instead, the Examiner entered the amendments and subsequently allowed the applications with the subject matter added from the '886 provisional. *See, e.g.*, Ex. 1009, 446 (Notice of Allowance and Fee(s) Due).

The incorporation by reference statement in the application transmittal form also was never objected to by any Examiner during prosecution of the

'882 application (Chu '330), the '199 application (the '777 patent), and all five reissue applications in the priority chain of the '654 patent, including the '138 application, as well as all ten continuation applications in the priority chain of U.S. Patent No. 9,529,768 ("the '768 patent") as we noted in our Decision Denying Institution in IPR2021-00608, Paper 8 at 23. 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, the '882 application identified the '886 provisional with particularity and would have directly led an ordinarily 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 the '886 provisional by reference.

In addition, as discussed above, Petitioner admits that the '777 patent (the '199 application), incorporated by reference the '882 application, i.e., Chu '330. Pet. 26–27; *see also* Ex. 1007, 5:9–13. As discussed above, it also is undisputed that the first parent application, the '604 application, incorporated by reference the '882 application (Ex. 1013, code (64), 5:19–23), and 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, code (63), 1:23–29, 5:62–67; Ex. 1008, code (63), 1:18–21, 5:50–54.

As such, we find that Petitioner has failed to show (1) the '654 patent is not entitled to a priority date before June 17, 2011, the filing date of the '138 application that issued as the '984 patent, (2) the '138 application's parent applications in the '654 patent family did not properly incorporate by reference the '886 provisional, and (3) the amendments adding the subject matter from the '886 provisional in the '138 application improperly introduced new matter.

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. 30. 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.* Accordingly, Petitioner contends that “any incorporation by reference statement must have appeared in Chu[']330 itself.” *Id.* at 30–31.

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. 29–30, n.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 Chu ’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 [the ’886 Provisional]” in the first paragraph 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. 31 (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. That is, 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 ’138 application.

d. The Reasonable Examiner Standard Does Not Apply to the Analysis of the '654 Patent's Priority Chain

Petitioner further argues that the reasonable Examiner standard does not apply to the analysis of the '654 Patent's priority chain because "these patents have issued." Pet. 27–28, n.3 (citing *Hollmer*, 681 F.3d at 1357–1358). 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]*' a POSITA to the document that the patent-drafter intended to be incorporated." *Id.* at 27–28 (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. That is, 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 '138 application. Accordingly, we exercise our discretion not to institute *inter partes* review. *Advanced Bionics*, Paper 6 at 8; *see also Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 24 (Dec. 15, 2017) (precedential as to § III.C.5, first paragraph).

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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