

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

THROUGHPUTER, INC.,
Patent Owner.

IPR2022-00758
Patent 10,430,242 B2

Before MICHAEL R. ZECHER, JOHN A. HUDALLA, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEYERS, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. *Background and Summary*

Microsoft Corporation (“Petitioner”) filed a Petition requesting to institute an *inter partes* review of claims 1–23 (the “challenged claims”) of U.S. Patent 10,430,242 B2 (Ex. 1001, the “’242 patent”). Paper 2 (“Petition” or “Pet.”). ThroughPuter, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Preliminary Response” or “Prelim. Resp.”). With our authorization, Petitioner filed a Reply (Paper 10) and Patent Owner filed a Sur-reply (Paper 11), each of which were limited to addressing whether we have authority to adjudicate the priority issue raised in the Petition and whether we should exercise our discretion to deny the Petition under 35 U.S.C. § 325(d).

An *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (2018). We have authority, acting on the designation of the Director, to determine whether to institute an *inter partes* review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). Having considered the arguments and evidence presented by Petitioner and Patent Owner, we determine that Petitioner has not demonstrated a reasonable likelihood of prevailing on at least one of the challenged claims of the ’242 patent. Accordingly, we do not institute an *inter partes* review of the challenged claims.

B. *Real Parties in Interest*

The parties identify themselves as the real parties in interest. Pet. 78; Paper 4, 2.

C. Related Proceedings

The parties identify, as matters involving or related to the '242 patent, *ThroughPuter, Inc. v. Microsoft Corporation*, No. 2:22-cv-00344-BJR (W.D. Wash.), which was transferred from the U.S. District Court for the Eastern District of Virginia. Pet. 78; Paper 4, 2. Patent Owner indicates that, “[a]s of August 18, 2022, the related district court litigation has been stayed pending resolution of the present *inter partes* review proceeding.” Paper 9, 2.

We also note that Petitioner has challenged other patents owned by Patent Owner in IPR2022-00527, IPR2022-00528, IPR2022-00574, and IPR2022-00757.

D. The '242 Patent

The '242 patent is titled “Task Switching and Inter-Task Communications for Coordination of Applications Executing on a Multi-User Parallel Processing Architecture.” Ex. 1001, code (54). The '242 patent describes “an extensible, multi-stage, application program load adaptive, parallel data processing architecture shared dynamically among a set of application software programs according to processing load variations of said programs.” *Id.* at 3:14–18. In particular, a processor with an array of processing cores hosts instances of programs where the array of cores may be allocated among the programs “in part based on volumes of input data packets at the input port buffers associated with individual programs,” and, based in part on this allocation, assigned “for executing specific instances of the programs.” *Id.* at 5:4–24.

In the embodiment shown in Figure 4, reproduced below, the '242 patent describes connecting input packets to processing cores “according to

at which core the destination app-task instance indicated for any given input may be executing at any given time.” *Id.* at 12:34–40.

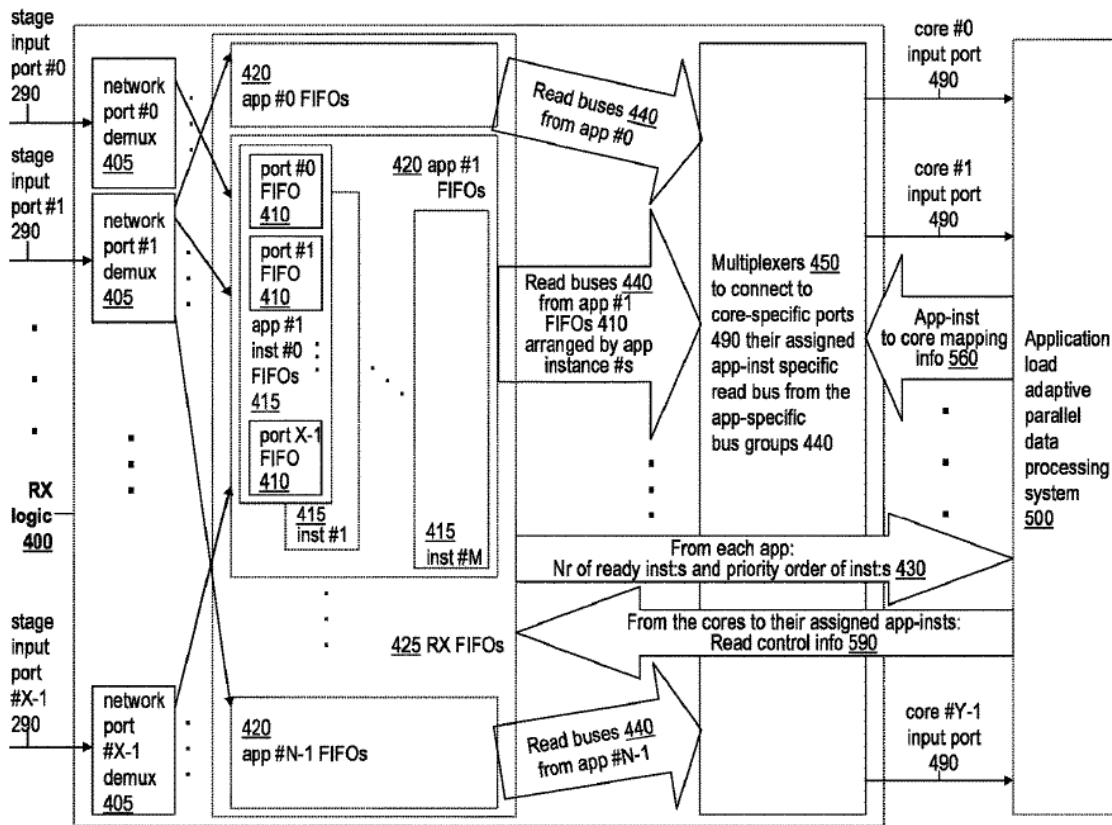


FIG. 4

Figure 4 shows RX (receive) logic subsystem 400 “connecting the input packets from the input ports 290 to the local processing cores” in “manycore processor 500.” *Id.* at 12:42–43. In operation, “input packets arriving over the network input ports 290 are grouped to a set of destination application specific FIFO [first in first out] modules 420, whose fill levels (in part) drives the allocation and assignment of cores at the local manycore processor 500 among instances of the app-tasks hosted on that processor.” *Id.* at 12:57–62. From application-instance specific buffers 415 within FIFO

modules 420, the input packets are connected through multiplexers 450 to specific cores in processor 500, where associated application-instances are executing at a given time. *Id.* at 12:65–13:2.

The '242 patent claims priority to the '473 application through a chain of applications (the “2012 line”), which extends back to several provisional applications, the earliest of which was filed on June 8, 2012. *See id.* at code (60). In addition, the '242 patent claims priority to a provisional application filed on November 4, 2011 through a different chain of applications (the “2011 line”) that does not include the '473 application. *See id.*

E. Illustrative Claim

Petitioner challenges claims 1–23 of the '242 patent. Pet. 1. Claims 1, 7, and 15 are independent. Claim 1, reproduced below, is representative.

1. A system for managing execution of a plurality of software applications on an array of processing units, the system comprising:

a core fabric comprising

the array of processing units, and

a plurality of input data buffers, each input data buffer being provided for buffering input data directed to a respective software application of the plurality of software applications and being dedicated to the respective software application, wherein

each buffer of the plurality of input data buffers is deployed in the core fabric apart from the array of processing units, and

each software application of the plurality of software applications is provided one or more input data buffers of the plurality of input data buffers; and

a controller comprising hardware logic and/or software logic for performing operations for repeatedly reconfiguring task assignment to the array of processing units, the

operations comprising, for each iteration of a plurality of iterations,

identifying, for each software application of at least a portion of the plurality of software applications, an amount of input data at one or more input data buffers of the plurality of input data buffers buffering data for the respective software application,

allocating, to each software application of the portion of the plurality of software applications, a number of processing units of the array of processing units based at least in part on the amount of input data buffered for the respective software application, and

for each software application of the portion,

- i) assigning one or more task instances of the respective software application for concurrent processing of the amount of input data to the number of processing units allocated to the respective software application by the allocating as one or more assigned instances, and
- ii) adjusting, based at least in part on a change in a count of units between the number of processing units allocated to the respective software application and a number of previously allocated processing units allocated to the respective software application during a previous iteration of the plurality of iterations, a relative portion of the amount of input data to be processed by at least one assigned instance of the one or more assigned instances;

wherein, for one or more iterations of the plurality of iterations where a current number of the one or more processing units allocated to any given software application of the portion of the plurality of software applications is increased by the allocating, adjusting comprises relatively decreasing the portion of the amount of input data to be processed by at least one instance of the

one or more assigned instances of the respective software application; and

wherein for one or more other iterations of the plurality of iterations where a present number of the one or more processing units allocated to any given software application of the portion of the plurality of software applications is decreased by the allocating, adjusting comprises relatively increasing the portion of the amount of input data to be processed by at least one instance of the one or more assigned instances of the respective software application.

Ex. 1001, 28:37–29:35.

F. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–23 of the '242 patent are unpatentable on the following grounds (Pet. 1):

Claims Challenged	35 U.S.C. §	References
1–23	102(a)(1) ¹	Sandstrom-1 ²
1–23	103	Sandstrom-1

Petitioner also relies on the Declaration of Dr. Henry H. Houh (Ex. 1003) in support of its arguments.

¹ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. §§ 102 and 103. Petitioner contends that the post-AIA versions of 35 U.S.C. §§ 102 and 103 apply based on its allegation that the earliest effective filing date for the '242 patent is after the effective date of the applicable AIA amendments (March 16, 2013). *See* Pet. 1, 7, 28. As discussed below, we determine that the '242 patent is entitled to a priority date that pre-dates the AIA amendments. Thus, contrary to Petitioner’s articulation of the grounds, the pre-AIA versions of 35 U.S.C. §§ 102 and 103 apply to the '242 patent.

² US 2014/0149993 A1, published May 29, 2014 (Ex. 1004, “Sandstrom-1”).

II. ANALYSIS

A. *Legal Standards*

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (2012) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). Except in limited circumstances not present here, this burden of persuasion does not shift to the patent owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (discussing the burden of proof in *inter partes* review).

B. *Anticipation and Obviousness Based on Sandstrom-1*

Sandstrom-1 is a pre-grant publication of U.S. Patent Application No. 13/684,473 (“the ’473 application”), filed on November 23, 2012, and published on May 29, 2014. *See* Ex. 1004, codes (21), (22), (43). Petitioner contends that Sandstrom-1 qualifies as prior art under post-AIA 35 U.S.C. § 102(a)(1) based on its publication date. Pet. 1, 28. Petitioner’s contention hinges on its assertion that the earliest possible priority date for the ’242 patent is February 16, 2016. *Id.* at 28. Specifically, Petitioner asserts that there was a break in the priority chain of the 2012 line for failing to comply with the governing priority claim provisions, and that there is a lack of written description support for the challenged claims of the ’242 patent in the 2011 line. *See* Pet. 6–25. We determine that Petitioner has not demonstrated a reasonable likelihood of prevailing on its asserted grounds for the reasons discussed below.

1. Alleged Defective Priority Chain of the 2012 Line

a) The '242 Patent Priority Claims

In the 2012 line, the '242 patent claims priority to U.S. Patent Application No. 16/145,632 (the "'632 application"), which was filed on September 28, 2018 and issued as U.S. Patent No. 10,310,901 B2. Ex. 1001, code (60). The '632 application claims priority to U.S. Patent Application No. 16/014,674 (the "'674 application"), which was filed on June 21, 2018 and issued as U.S. Patent No. 10,133,600 B2. *Id.* The '674 application claims priority to U.S. Patent Application No. 15/933,724 (the "'724 application"), which was filed on March 23, 2018 and issued as U.S. Patent No. 10,061,615 B2. *Id.* The '724 application claims priority to U.S. Patent Application No. 15/273,731 (the "'731 application"), which was filed on September 23, 2016 and issued as U.S. Patent No. 10,514,953 B2 (the "'953 patent"). *Id.*; Ex. 1008, 34.³

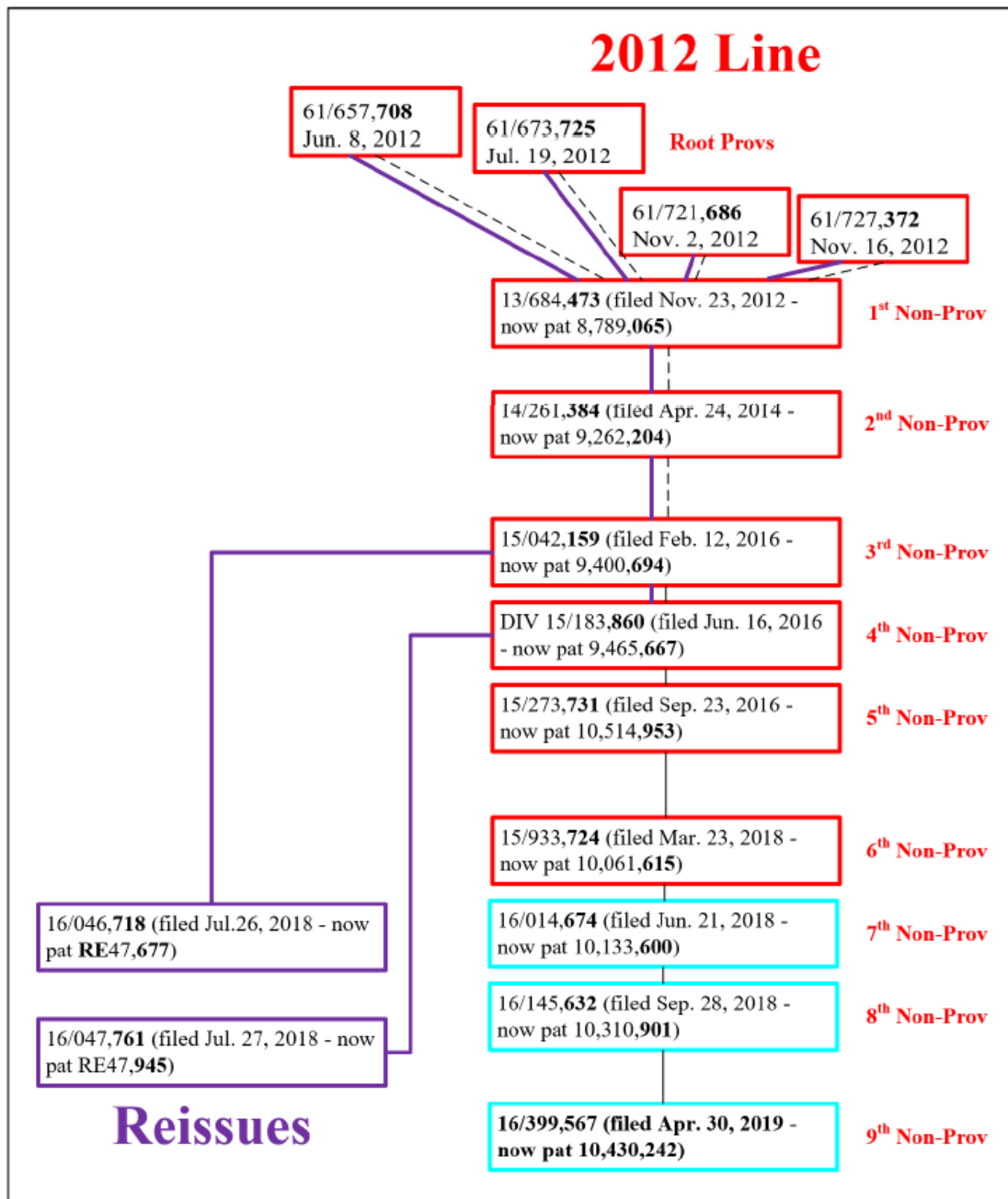
The '731 application, the prosecution history of which is discussed further below, claims priority to U.S. Patent Application No. 15/183,860 (the "'860 application"), which was filed on June 16, 2016 and issued as U.S. Patent No. 9,465,667 B1 (Ex. 1001, code (60)), a patent that was later reissued as U.S. Patent No. RE47,945 (the "RE'945 patent") (*see* Ex. 1008, 3). The '860 application claims priority to U.S. Patent Application No. 15/042,159 (the "'159 application"), which was filed on February 12, 2016 and issued as U.S. Patent No. 9,400,694 B2 (Ex. 1001, code (60)), a patent that was later reissued as U.S. Patent No. RE47,677 (the "RE'677 patent")

³ All references to the page numbers in the prosecution history of the '731 application refer to the page numbers inserted by Petitioner in the bottom, middle portion of each page in Exhibit 1008.

(*see* Ex. 1008, 3). The '159 application claims priority to U.S. Patent Application No. 14/261,384 (the "'384 application"), which was filed on April 24, 2014 and issued as U.S. Patent No. 9,262,204 B2. Ex. 1001, code (60). The '384 application claims priority to the '473 application, which was filed on November 23, 2012 and issued as U.S. Patent No. 8,789,065 B2. *Id.* The '473 application claims priority to several provisional applications filed in 2012. *See id.*

b) The Parties' Contentions

Petitioner contends that "[t]he '242 patent is not entitled to the priority it proclaims because Patent Owner truncated the ancestral line in each of two patents within the priority chain," and that the respective reissues of these patents did not remedy the defective priority chain of the 2012 line with respect to the '242 patent. Pet. 6–7. For ease of analysis of Petitioner's contentions, we reproduce below Petitioner's chart showing the 2012 line of applications. *Id.* at 10.



With reference to Petitioner's chart above showing the 2012 line of applications, Petitioner argues that the '159 and '860 applications included truncated priority claims because the '159 application only claims priority to the immediately preceding '384 application, and the '860 application only claims priority to the immediately preceding '159 application. *Id.* at 9.

Accordingly, Petitioner argues that “the ’159 application is the earliest ancestor to which the ’242 patent is entitled to priority” in the 2012 line. *Id.* at 13. Petitioner asserts that, during prosecution of the ’731 application, which followed the ’860 application in the 2012 line, “the Office confirmed that the ’860 application’s priority right is limited to the ’159 application’s filing date.” *Id.* at 16.

Petitioner acknowledges, however, that during prosecution of the ’731 patent “Patent Owner filed two new reissue applications—one for the ’694 patent derived from the ’159 application and another for the ’667 patent derived from the ’860 application—each seeking to extend its earlier limited priority claim back to the root of the 2012 Line.” *Id.* at 9–10. Petitioner also notes that, after issuance of the reissue applications as the RE’677 and RE’945 patents, “Patent Owner renewed its previously denied petition to update the truncated priority claim of the offspring ’731 application” and the Office granted this renewed petition. *Id.* at 17 (citing Ex. 1008, 1–4, 25–27). But Petitioner points out that “[t]he RE’677 and RE’945 patents are not identified in the ’242 patent’s priority claim,” as illustrated in the chart reproduced above for the 2012 line. *Id.* at 10.

Further, Petitioner argues that, even if Patent Owner had attempted to claim priority through the reissue application that issued as the RE’945 patent (the “’761 reissue application”), the ’242 patent could not benefit from a priority date earlier than that of the filing date of the ’761 reissue application, because “[t]he Office treats a regular continuation application claiming priority to a reissue application as a ‘Bauman type continuation application’ entitled to a priority date no earlier than the filing date of the parent reissue application.” *Id.* at 19 (citing *In re Bauman*, 683 F.2d 405

(CCPA 1982)). If, on the other hand, Patent Owner had attempted to file continuation *reissue* applications to achieve an earlier effective filing date than that allowed for in Bauman type continuation applications, Petitioner argues Patent Owner would have fared no better. *See id.* at 21–23. Specifically, Petitioner argues that the claims of the '242 patent are broader than those of the patent that issued from the '860 application, and so any continuation reissue application to obtain the '242 patent claims would have amounted to an improper broadening reissue. *See id.* at 21–22.

Patent Owner contends that the Board “does not have the authority to reconsider procedural questions pertaining to priority claims or certificates of corrections as part of *inter partes* review.” Prelim. Resp. 2. To support this argument, Patent Owner points to *Early Warning Services, LLC v. Grecia*, IPR2020-00763, Paper 10 (PTAB Oct. 1, 2020) (Decision on Institution), as an instructive case in which “the petitioner challenged a downstream application’s priority claim, arguing that an alleged ADS [application data sheet] defect in the upstream application severed the patent family’s priority chain.” Prelim. Resp. 3. Patent Owner asserts that, in *Early Warning*, “[t]he Board explained that ‘[i]n effect, Petitioner is asking us to review the propriety of the granting by the Patent Office of [a] Request for Certificate of Correction,’ noting that the petitioner did not ‘indicate the source of any authority for such review.’” *Id.* (quoting IPR2020-00763, Paper 10, at 21–22). Patent Owner argues that, “as was the case in *Early Warning*, Petitioner is asking the Board to reconsider the propriety of a USPTO Decision . . . allowing Patent Owner, in the case of [the '731 application], to claim priority to the root disclosures of the 2012 Line.” *Id.* at 4. The Board should decline to do so, Patent Owner argues, because

“decisions on priority claims are the province of the Petitions Branch and Corrections Branch, not the Board.” *Id.* According to Patent Owner, “[e]ven if this question of pure examinational procedure could be reached here, and it cannot, the [P]etition would fail under 35 U.S.C. § 325(d) as not only was it previously and explicitly considered in prosecution, indeed, the matter was addressed at the direction of the USPTO.” *Id.* at 1.

In reply, Petitioner disagrees with Patent Owner’s “attempt[] to rebrand this case as an unauthorized review of a decision by the Office of Petitions.” Reply 1. “Petitioner does not dispute that the Office of Petitions appropriately allowed Patent Owner to revise its priority claim in the intermediate ’731 application.” *Id.* Petitioner asserts that it is requesting “the Board to decide a different issue—the impact of the ’860 application’s truncated priority claim on the priority benefit sought by the ’242 patent.” *Id.* at 2. In particular, Petitioner argues that, in the ’731 application, the Office of Petitions did not review “the **legal** impact of Patent Owner’s choice to pursue a priority claim correction via reissue of the patent that matured from the ’860 application without integrating that reissue into the 2012 Line.” *Id.* at 3. Rather, Petitioner argues, the Office of Petition’s “focus was solely on **procedure**.” *Id.* To support this argument, Petitioner points to language in the relevant decision from the Office of Petitions stating that “the **formal requirements for claiming domestic benefit . . .** have been met,” but that “[t]his acceptance should **not** be construed as meaning that this application is entitled to the benefit of the prior-filed application(s).” *Id.* at 2–3 (citing Ex. 1008, 4).

In its sur-reply, Patent Owner argues that Petitioner’s position that the Office of Petitions “did not address ‘legal issues’” “requires one to accept

that the USPTO guided [Patent Owner] to follow a specific course to amend its ADSs via reissue without regard to whether that course was legally appropriate.” Sur-reply 4. Patent Owner asserts that “[s]uch an argument is both incredible and inconsistent with the prosecution history.” *Id.* Further, regarding the language in the relevant decision from the Office of Petitions that the ’731 application was not necessarily “entitled to the benefit of the prior-filed application(s)” (Ex. 1008, 4), Patent Owner argues this “merely refers to the practical reality that examiners must determine whether particular claim language is supported by earlier applications,” and that “[w]ritten descriptive support is not at issue here.” Sur-reply 3.

c) Analysis

The ’731 application was filed on September 23, 2016, with a preliminary amendment that included a statement in the Specification referencing all the relevant applications in the priority chain of the 2012 line, including the ’473 application. *See* Ex. 1008, 815–16. The Application Data Sheet submitted with the ’731 application, however, only referenced the ’860 application in the relevant priority claim section. *See id.* at 757. The applicant filed a first corrected ADS on January 6, 2017, to include the other non-provisional applications in the 2012 line. *See id.* at 735–37. The applicant further filed a second corrected ADS on March 19, 2018, along with a Request for Corrected Official Filing Receipt, to correct the respective relationships of the non-provisional applications as identified in the first corrected ADS, as well as to include priority claims to the provisional applications in the 2012 line. *See id.* at 706–07, 714.

In a Response to Request for Corrected Filing Receipt mailed on March 21, 2018, the Office stated that “[t]he priority or continuity claim has

not been entered because it was not filed during the required time period,” and indicated that a “petition to accept an unintentionally delayed claim for priority” may be appropriate. *Id.* at 693. The applicant subsequently filed a Petition to Accept an Unintentionally Delayed Domestic Benefit Claim Under 37 C.F.R. § 1.78(c)(e) on May 4, 2018. *Id.* at 692–94. The Office dismissed the petition in a decision mailed on June 15, 2018, because “it appears that [U.S. Patent] Application Nos. 14/261,384; 15/042,159; 15/183,860 do not each reference a claim of benefit to” the provisional applications in the 2012 line, and because “[U.S. Patent] Application No. 15/183,[8]60 does not include claims of benefit to any applications other than [U.S. Patent] Application No. 15/042,159.” *Id.* at 659. The Office stated that, in order for an application to claim the benefit of a chain of applications, “every intermediate application must also make a reference to the first (earliest) application and every application after the first application and before such intermediate application.” *Id.* (citing *Droplets, Inc. v. E*TRADE Bank*, 887 F.3d 1309 (Fed. Cir. 2018)). The Office then advised the applicant to file a petition and certificate of correction relating to the ’384 application’s priority defects, and to file reissue applications for the priority defects in the ’159 and ’860 applications. *Id.*

On June 15, 2020, after issuance of the ’731 application, the applicant filed a Renewed Petition to Accept an Unintentionally Delayed Domestic Benefit Claim Under 37 C.F.R. § 1.78(c)(e) along with a Request for Certification of Correction. *Id.* at 25–29. In the Renewed Petition, the applicant averred that a petition was granted and a certificate of correction was mailed to correct the priority defects of the ’384 application, and that the RE’677 and RE’945 patents were issued to correct the priority defects of

the '159 and '860 applications, respectively. *Id.* at 26–27. In a decision mailed on January 26, 2021 (the “January 2021 Decision”), the Office granted the Renewed Petition, stating that “[a] review of the record reveals that in accordance with the requirements as detailed in the decision mailed June 15, 2018, the reference as set forth in the [second corrected ADS] filed March 19, 2018 complies with 35 U.S.C. §§ 120 and 119(e) and 37 [C.F.R.] §§ 1.78(d)(2) and 1.78(a)(3).” *Id.* at 4. The Office further noted that “[a] certificate of correction noting the benefit claims of the prior applications was issued September 29, 2020,” and so “no further action is necessary.” *Id.*

Accordingly, by the time it mailed the January 2021 Decision, the Office was satisfied that the '731 application, which had issued as the '953 patent, properly claimed priority to the preceding applications in the 2012 line, and that all intermediate applications also included proper priority claims. It thus follows that, absent any defects in the priority claims of the subsequent applications, including the application that issued as the '242 patent, the remedial steps taken by the applicant and approved by the Office during prosecution and post-issuance of the '953 patent also render proper the priority claims of the subsequent applications. Petitioner has not persuasively pointed us to any additional defects not addressed previously by the Office in the priority chain of the '242 patent in the 2012 line. Nor has Petitioner identified legal authority for the Board to revisit the January 2021 Decision’s finding that the priority claims of the '731 application met the relevant statutory and regulatory criteria. *See* Ex. 1008, 4 (“[T]he reference as set forth in the [second corrected ADS] filed March 19, 2018 complies with 35 U.S.C. §§ 120 and 119(e) and 37 [C.F.R.] §§ 1.78(d)(2) and 1.78(a)(3).”).

We also do not agree with Petitioner’s characterization that it “accepts the earlier [January 2021] Decision to grant a delayed revision of the ’731 application’s priority claim and asks the Board to decide a different issue—the impact of the ’860 application’s truncated priority claim on the priority benefit sought by the ’242 patent.” Reply 2. Here, Petitioner attempts to have it both ways—concede the Office approved the priority claims of the ’731 application, yet still argue that the priority chain of the ’242 patent is defective based on priority claims in the ’860 application, even though the correction of the priority claims of the ’860 application was partly the basis for the January 2021 Decision on the priority claims of the ’731 application.

Petitioner attempts to resolve this inconsistency by arguing for a distinction between (1) the alleged procedural nature of the January 2021 Decision, and (2) what Petitioner now considers a legal adjudication of the merits of the priority claims made in the ’242 patent. *See* Reply, 2–4. This argument rests on what appears to be boilerplate language in the January 2021 Decision, which we reproduce below:

Petitioner is advised that this decision grants the petition to accept the unintentionally delayed domestic benefit claim to the prior filed application(s) because the petition requirements of 37 [C.F.R.] 1.78(c) and (e) and the formal requirements for claiming domestic benefit (see MPEP [Manual of Patent Examining Procedure] 211.01 et. seq.) have been met. This acceptance should not be construed as meaning that this application is entitled to the benefit of the prior-filed application(s). Whether a claimed invention in a nonprovisional application is entitled to the benefit of a prior-filed application on the basis of the disclosure thereof is determined during examination if it becomes necessary to do so (e.g., intervening reference and interference proceeding). *See* MPEP 211.05.

Ex. 1008, 4. This language indicates only that no decision has been made as to whether the disclosures of the prior applications in the 2012 line provide

written description support for the '731 application. To the extent Petitioner suggests this language leaves open some other legal basis on which to challenge the priority chain of the '731 application and its progeny (*see* Reply 3 (asserting that Patent Owner's position on the scope of the January 2021 Decision requires "that the Office of Petitions approved every aspect of priority in the 2012 Line besides written description")), we see no such basis.

We disagree with Petitioner that the January 2021 Decision "reveals that the Office of Petitions did not review the crux of the Petition, namely, the **legal** impact of Patent Owner's choice to pursue a priority claim correction via reissue of the patent that matured from the '860 application without integrating that reissue into the 2012 Line." Reply 3. The issuance of the RE'945 patent was part and parcel of granting the Renewed Petition in the '731 application: "The renewed petition has been submitted with the required statement of unintentional delay and an explanation that the reissue application based on 15/183,860 (Application No. 16047761[])] issued as RE 47945 on 4/14/2020. A decision in the instant matter could not be granted until that reissue application matured into a patent." Ex. 1008, 4. As such, the Office of Petitions was in a position to consider and analyze the entire priority chain of the '731 application. Based on its review, the Office of Petitions advised the applicant to file the '761 reissue application, but did not require a specific priority claim to the '761 reissue application in the

'731 application or the '953 patent that issued therefrom to meet the requirements of any governing provisions.⁴ *See id.* at 2–4, 658–659.

In essence, Petitioner presents us with the same issue that was before the Office of Petitions: whether the '731 application, or the '953 patent that issued therefrom, and by extension the applications claiming priority thereto, including the application that issued as the '242 patent, must claim priority to the '761 reissue application filed to correct the priority claim defect in the '860 application.⁵ Accordingly, as in *Early Warning*, Petitioner is asking us, in effect, to review the propriety of a prior decision of the Office for which we have no authority, and we decline to do so. *See* IPR2020-00763, Paper 10, at 21–22. The Office of Petitions did not see fit to require a reference to the '761 reissue application in the '953 patent, which would therefore also have been required in subsequent applications in the priority chain (*see Droplets, Inc. v. E*TRADE Bank*, 887 F.3d at 1317 (“[T]he ‘specific reference’ requirement in [35 U.S.C.] § 120 ‘mandates each [intermediate] application in the chain of priority to refer to the prior applications.’”)) (quoting *Medtronic CoreValve, LLC v. Edwards Lifesciences Corp.*, 741 F.3d 1359, 1363 (Fed. Cir. 2014))), and we decline to second-guess that decision.

Although Petitioner cites several Board decisions in *inter partes* reviews where panels addressed priority claim issues, those cases are

⁴ The Certificate of Correction to the '953 patent, which corrected the “section entitled ‘Related U.S. Application Data’ at (60),” indicates that the '953 patent is a “Continuation of [U.S. Patent] [A]pplication No. 15/183,860,” with no mention of the '761 reissue application. Ex. 1008, 22.

⁵ Petitioner focuses its arguments on the '761 reissue application that issued as the RE'945 patent, and does not specifically discuss the reissue application that issued as the RE'677 patent. *See* Pet. 17–24.

inapplicable here because none of them involved a petitioner seeking reconsideration of a prior Office decision relating to priority. *See* Reply 5 (citing *Juniper Networks, Inc. v. Finjan, Inc.*, IPR2019-00026, Paper 46 (PTAB Apr. 7, 2020) (Final Written Decision); *E*TRADE Financial Corp. v. Droplets, Inc.*, IPR2015-00470, Paper 35 (PTAB Jun. 23, 2016) (Final Written Decision); *Apple Inc. v. e-Watch, Inc.*, IPR2015-00414, Paper 34 (PTAB Jun. 22, 2016) (Final Written Decision)); Sur-reply 3 (“The cases cited by Petitioner [] in no way suggest that the Board has authority to review the USPTO petition decisions.”).

Even if we were to consider the merits of Petitioner’s argument that the ’860 application retained its priority flaws and, therefore, “any valid attempt to obtain additional patent claims in downstream applications entitled to the purportedly restored benefit of priority must involve the ’761 reissue application” (Pet. 17–18), Petitioner points us to no specific authority establishing such a requirement.

Petitioner quotes *Encyclopaedia Britannica, Inc. v. Alpine Electronics of America, Inc.*, 609 F.3d 1345, 1351 (Fed. Cir. 2010), for the proposition that “[l]ater applications cannot amend [an earlier] application and restore its entitlement to priority.” Pet. 23. But the *Encyclopaedia Britannica* case did not relate to the situation where a reissue application is used to correct the priority claims of an intermediate application in a priority chain. Petitioner also relies on *Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.*, 672 F.3d 1335 (Fed. Cir. 2012), and *Intel Corp. v. Negotiated Data Solutions, Inc.*, 703 F.3d 1360 (Fed. Cir. 2012) (Pet. 24), but neither of those cases relates specifically to priority defects corrected through reissue applications.

Additionally, because Petitioner does not provide specific authority requiring a priority claim to the '761 reissue application in the applications subsequent to the '860 application in the priority chain of the 2012 line, Petitioner's arguments that are contingent on such alleged requirement—whether there are certain restrictions on the earliest effective filing date for Bauman type continuation applications or whether Patent Owner would have been able to file proper continuation reissue applications to obtain the claims of the '242 patent (*see* Pet. 19–23)—are moot.

For these reasons, Petitioner has not persuaded us that there is a break in the priority chain of the '242 patent in the 2012 line. As such, we find that the '242 patent is entitled to a priority date at least as early as June 8, 2012. *See* Ex. 1001, code (60). Accordingly, we determine that Sandstrom-1 does not qualify prior art under pre-AIA 35 U.S.C. § 102(a) or (b) because Sandstrom-1's publication date of May 29, 2014, is after the June 8, 2012, priority date from the 2012 line.⁶ Ex. 1001, code (60); Ex. 1004, code (43).

2. Alleged Lack of Written Description Support in the 2011 Line

Because we determine that Sandstrom-1 is not available as prior art based on the above discussion regarding the priority chain of the 2012 line, we need not address whether there is written description support for the challenged claims of the '242 patent in the 2011 line.

⁶ As discussed above (*see supra* note 1), we determine that the pre-AIA versions of 35 U.S.C. §§ 102 and 103 apply to the '242 patent based on its priority to at least the 2012 line. Thus, despite Petitioner's articulation of the grounds based on post-AIA 35 U.S.C. §§ 102 and 103, we have applied the pre-AIA version of § 102 in determining that Sandstrom-1 does not qualify as prior art. Notwithstanding, our disposition would be the same under the post-AIA version of § 102.

3. *Summary*

For the foregoing reasons, we are not persuaded that there is a break in the '242 patent's priority chain the 2012 line. Accordingly, we find that Sandstrom-1 does not qualify as prior art against the challenged claims of the '242 patent, and we determine that Petitioner has not demonstrated a reasonable likelihood of showing that Sandstrom-1 either anticipates or renders obvious the challenged claims.

III. DISCRETIONARY DENIAL

Patent Owner also argues that we should exercise our discretion to deny institution of *inter partes* review in this case under 35 U.S.C. § 325(d) because “the Petition advances the same argument already addressed in the January 2021 Petition Decision” and there is no “‘material error’ in the January 2021 Petition Decision.” Prelim. Resp. 7–8. Although we find this argument to have merit, we will not be instituting an *inter partes* review based on Sandstrom-1's unavailability as prior art. Thus, we need not determine whether it would be appropriate to discretionarily deny the Petition under § 325(d).

IV. CONCLUSION

For the foregoing reasons, we are not persuaded that the Petition establishes a reasonable likelihood that Petitioner would prevail on its challenges to any one of claims 1–23 of the '242 patent.

V. ORDER

In consideration of the foregoing, it is hereby ordered that the Petition is *denied*, and no trial is instituted.

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