

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

REVVO TECHNOLOGIES, INC.,
Petitioner,

v.

CEREBRUM SENSOR TECHNOLOGIES, INC.,
Patent Owner.

IPR2025-00632
Patent 11,835,421 B2

Before MITCHELL G. WEATHERLY, KEVIN W. CHERRY, and
BRIAN D. RANGE, *Administrative Patent Judges*.

WEATHERLY, *Administrative Patent Judge*.

DECISION

Granting Institution of *Inter Partes* Review on Remand from the Director
35 U.S.C. § 314

I. INTRODUCTION

A. Background

Revvo Technologies, Inc. (“Petitioner”) filed a petition (Paper 1, “Pet.”) to institute an *inter partes* review of claims 1, 2, 5, 7–12, 20–24, 28, 31–34, 41, 43, 44, 48, and 50–53 (the “challenged claims”) of U.S. Patent No. 11,835,421 B2 (Ex. 1001, “the ’421 patent”). 35 U.S.C. § 311.

Cerebrum Sensor Technologies, Inc. (“Patent Owner”) timely filed a Preliminary Response. Paper 9 (“Prelim. Resp.”).¹ Institution of an *inter partes* review is authorized by statute when “the information presented in the petition filed under section 311 and any response filed under section 313 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).

Petitioner challenges the patentability of claims as follows:

Claims challenged	35 U.S.C. §²	Reference(s)
1, 2, 7–9, 11, 12, 20–24	103	Yamaguchi-727 ³
5, 28, 31–33, 41, 43, 44, 48, 50–52	103	Yamaguchi-727, Yamaguchi-566 ⁴
34, 53	103	Yamaguchi-727, Yamaguchi-566, Dodani ⁵
10	103	Yamaguchi-727, McDonald ⁶

¹ Paper 9 is a corrected Patent Owner Preliminary Response.

² The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. §§ 102 and 103 that became effective March 16, 2013. The application for the ’421 patent was filed on October 20, 2020, and claims priority as a continuation-in-part of an application filed October 31, 2019. Therefore, we apply the post-AIA versions of 35 U.S.C. §§ 102 and 103.

³ U.S. Pat. App. Pub. No. 2021/0370727 A1 (Ex. 1006, “Yamaguchi-727”).

⁴ U.S. Pat. App. Pub. No. 2021/0394566 A1 (Ex. 1007, “Yamaguchi-566”).

⁵ WIPO Pub. No. WO 2020/036859 A1 (Ex. 1009, “Dodani”).

⁶ U.S. Patent No. 6,769,319 B2 (Ex. 1008, “McDonald”).

B. Related Proceedings

Petitioner identified as a related proceeding the co-pending district court proceeding of *Cerebrum Sensors Technologies Inc. v. Revvo Technologies, Inc.*, Case No. 1:24-cv-00245-JLH (D. Del. Feb. 23, 2024) (the “Litigation”). Pet. 1; Paper 4, 1.

C. Prior Decision Instituting Review

In the Petition, Petitioner identified certain claim terms on which a dispute existed in the Litigation over the meaning of those terms, and it adopted Patent Owner’s positions for purposes of its Petition seeking *inter partes* review. Pet. 9–10.

Patent Owner did not contest Petitioner’s proposed interpretations of these disputed claim terms. Prelim. Resp. 13–15. Patent Owner argued, however, that 37 C.F.R. § 42.104(b)(3) (“Rule 104(b)(3)”) precludes Petitioner from taking positions on the meaning of claim terms in its Petition that differed from those advanced in the Litigation. *Id.* at 15. Patent Owner argued that Petitioner’s alleged failure to adhere to Rule 104(b)(3) “warrant[ed] denying institution.” *Id.* at 15.

Rule 104(b)(3) sets forth requirements for a petition that include:

(b) Identification of challenge. Provide a statement of the precise relief requested for each claim challenged. The statement must identify the following:

* * *

(3) How the challenged claim is to be construed. Where the claim to be construed contains a means-plus-function or step-plus-function limitation as permitted under 35 U.S.C. 112(f), the construction of the claim must identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function.

37 C.F.R. § 42.104(b)(3).

Because Petitioner had indisputably identified “how the challenged claim is to be construed” by providing express interpretations of disputed terms, we found that Petitioner had met the requirements of Rule 104(b)(3). Paper 13, 9 (“Decision” or “Dec.”). Dec. 9. We also found that Petitioner had demonstrated a reasonable likelihood of demonstrating that claims 1, 2, 7–9, 11, 12, and 20–24, as interpreted by Petitioner and agreed upon by Patent Owner, were unpatentable. *Id.* at 13–14. Based on that determination, we instituted review of all challenged claims on all grounds alleged by Petitioner. *Id.* at 14.

D. Vacatur and Remand by the Director

Five weeks after institution, the Director initiated a *sua sponte* review of our Decision. Paper 19. Two weeks later, the Director vacated our institution of *inter partes* review and remanded the case to us with instructions. Paper 20 (“Remand”).

The Director found that, when instituting review, we erred in two ways. First, we erred when we “determined that Petitioner complied with Rule 42.104(b)(3) by proposing Patent Owner’s district court constructions.” Remand 5. Second, we erred when we “found that a petitioner is only required to explain its different positions when Section 112(f) is implicated.” *Id.*

The Director instructed us on remand to “determine whether Petitioner has provided a sufficient reason why different claim construction positions are warranted.” *Id.* The Director also provided the following guidance for that determination:

Allowing petitioners to continue this practice does not further the Office’s goal of “providing greater predictability and certainty in the patent system.” 83 Fed. Reg. at 51,342–43. This

is true even where, as here, the claim terms do not implicate Section 112(f). Thus, although a petitioner is not necessarily precluded from arguing different claim construction positions before a district court and the Board, the petitioner should explain sufficiently why the different positions are warranted, even in instances that do not implicate Section 112(f). *See Sun Pharm.*, IPR2025-00893, Paper 18 at 3. “For example, if a party advances a narrow construction in the district court and the district court declines to adopt the narrow construction, the party would have sufficient reason for advancing the broader, court-adopted construction in a proceeding before the Board.” *Id.* Simply noting that the petitioner is adopting a patent owner’s claim construction proposals from district court, however, is not a sufficient reason for advancing different positions in the two forums.

Id. The Director neither addressed the merits of Petitioner’s challenges nor found that our prior consideration of those merits was faulty. Accordingly, we understand that we need not reconsider our conclusion that Petitioner had demonstrated a reasonable likelihood of proving that claims 1, 2, 7–9, 11, 12, and 20–24 were unpatentable or that the merits of patentability set forth in the Petition warranted institution of *inter partes* review.

Soon after the Remand and after conducting a conference call with the parties, we authorized briefing from each party to allow them to be heard on the issues presented by the Director’s Remand. Paper 22. Petitioner submitted a brief, Paper 23 (“Remand Br.”), and Patent Owner responded, Paper 25 (“PO Remand Br.”).

II. ANALYSIS

To address the issues before us, we focus on adherence to all statutes, regulations, precedent, and Director decisions. Rule 42.1(b) guides our interpretation of Rule 104(b)(3) by requiring that “This part shall be construed to secure the just, speedy, and inexpensive resolution of every

proceeding.” 37 C.F.R. § 42.1(b). Thus, the goal of securing a just, speedy, and inexpensive resolution must inform our judgment when considering whether, under Rule 104(b)(3), Petitioner has sufficiently explained why it proffers different claim interpretations in this proceeding from those it proffers in the Litigation. This approach is also consistent with congressional intent of the AIA as endorsed by the Director that “[The AIA] is designed to establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs.” Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340, 51,346 (Oct. 11, 2018) (the “Rule Notice”).⁷

Petitioner explains that it has proffered broader interpretations of the claim terms because, as the Director recognizes, the district court may “decline[] to adopt the narrow construction” that it has advocated in the Litigation. Remand Br. 7 (quoting Remand 5). Petitioner further explains that because claim construction in the Litigation “is not scheduled to occur for several months,” it could not file a timely petition if it were to wait for the District Court to construe the claims. *Id.* Petitioner points out that its explanation follows the Director’s example of a sufficient reason for proposing a different claim interpretation. *Id.* (quoting Remand 5 (“if a party advances a narrow construction in the district court and the district court *declines to adopt the narrow construction*, the party would have

⁷ We look to the Rule Notice for guidance on the meaning and effect of Rule 104(b)(3) as interpreted by the Director because the Director quotes or cites numerous passages from it for that purpose. Remand 4 (citing Rule Notice at 51,342–43, 51,349, 51,350).

sufficient reason for advancing the broader, court-adopted construction in a proceeding before the Board.” (emphasis added))).

Patent Owner responds that “The narrow exception laid out by the Director is reserved for situations where ‘the district court *declines to adopt the narrow construction*’ and only then the party would ‘have sufficient reason for advancing the broader, court adopted construction in a proceeding before the Board.’” PO Remand Br. 4 (citing Remand 5). Patent Owner thus argues that the Director’s exemplary explanation is not only “narrow” but also the only explanation that can suffice to justify taking different claim interpretation positions here and in the Litigation. *Id.* Patent Owner further argues that proceeding with inter partes review would have both the District Court and the Board concurrently engaging claim interpretation and “on a crash course.” *Id.* Patent Owner explains that the “narrow exception identified by the Director does not exist here because there has been no District Court claim construction.” *Id.* n.1. Patent Owner contends that because Petitioner’s explanation for its differing claim interpretations does not fall within the exclusive “narrow exception” set forth by the Director, we must find that Petitioner’s explanation is insufficient and that the Petition is defective under Rule 104(b)(3). *Id.* at 5.

We reject Patent Owner’s narrow reading of the Director’s Remand as stating that the only sufficient reason justifying a petitioner taking different claim interpretation positions before the Board and the District Court is that Petitioner has already lost before the District Court. Here, the District Court has not yet construed any claim. If the only possible reason for taking different claim construction positions were to require the District Court to have already construed the claims, the Director would have had no reason to

remand the case to the panel to “determine whether Petitioner has provided a sufficient reason why different claim construction positions are warranted.”

Remand 5. Additionally, the Director characterizes his sufficient reason as an “example,” which strongly implies that other reasons are also sufficient.

The question before us, therefore, is whether the Petitioner’s proffered explanation that it has proposed a different claim interpretation before the Board because the District Court may decline to adopt the narrower claim interpretations it advocates there is sufficient. We find that Petitioner’s explanation is sufficient because it follows the Director’s exemplary logic. Whether a district court has already or might in the future decline to adopt constructions that a petitioner proposes in related district court litigation merely reflects the timing of when a dispute over claim interpretation will be resolved. The Director and Patent Owner both recognize that, to resolve the dispute over claim interpretation that exists here, a decision-maker must determine “a single claim construction that best captures the true meaning of the patent claim.” Remand 4; PO Remand Br. 3.

Based on the record presented by the parties to date in this proceeding, no dispute exists that the disputed claim terms mean what Patent Owner says they mean in the Litigation. Accordingly, we find that, at this stage of the proceeding, it is undisputed that Patent Owner’s interpretations of the claim terms represent the “single claim construction that best captures the true meaning of the patent claim.”⁸ Under that claim interpretation, we

⁸ Given current the lack of a dispute over claim interpretation in this proceeding, it would be imprudent to speculate on how the District Court might resolve the dispute that is currently presented in that proceeding. *Cf. Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy,

have already found that Petitioner has demonstrated a reasonable likelihood of proving that at least one claim is unpatentable, and the Director has not disturbed that finding or instructed us to revisit that finding on remand. Accordingly, we reinstitute the *inter partes* review.

Both parties will have every opportunity to present additional argument and cite other evidence to support a different claim interpretation during the *inter partes* review. If the District Court reaches and resolves any element of the dispute over claim interpretation, the parties must promptly inform the panel of that ruling, and the panel will consider the effect of that ruling here. Order regarding Related Matters Updates, Paper 15.

We emphasize that trial in the Litigation is currently set for August 23, 2027. Thus, even if the schedule in the Litigation were not extended, the panel will render a Final Written Decision in this proceeding many months before trial in the Litigation. Under these circumstances, addressing the claim interpretation dispute in this proceeding and issuing a ruling on Petitioner's challenges to the patentability of the disputed claims will represent the quickest and least expensive way to resolve the issue of patentability.

III. CONCLUSION

For the reasons expressed above, we determine that Petitioner has demonstrated a reasonable likelihood of showing that claims 1, 2, 7–9, 11, 12, and 20–24 of the '421 patent are unpatentable as obvious. In accordance with the Court's decision in *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018) and 37 C.F.R. § 42.108(a), we institute an *inter partes*

and only to the extent necessary to resolve the controversy.”)(quoting *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

review of all challenged claims of the '421 patent on all grounds alleged by Petitioner.

This Decision does not reflect a final determination on the patentability of any claim. We further note that the burden remains on Petitioner to prove unpatentability of each challenged claim. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

IV. ORDER

For the reasons given, it is:

ORDERED that *inter partes* review of claims 1, 2, 5, 7–12, 20–24, 28, 31–34, 41, 43, 44, 48, and 50–53 of U.S. Patent No. 11,835,421 B2 is *instituted* with respect to all grounds of unpatentability set forth in the Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of U.S. Patent No. 11,835,421 B2 is instituted commencing on the entry date of this Order, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is given of the institution of a trial.

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