UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE PATENT TRIAL AND APPEAL BOARD

_____

INTEL CORPORATION
Petitioner

v.

ALACRITECH, INC.
Patent Owner

_____

Case IPR. No. **IPR2017-01395**
U.S. Patent No. 8,805,948

_____

Petitioner's Request For Rehearing Under 37 C.F.R. § 42.71(d)

1.   INTRODUCTION

On November 22, 2017, the Board issued a decision denying institution of *Inter Partes* Review of U.S. Patent No. 8,805,948. Specifically, the Board denied institution on the basis that the secondary reference in Petitioner's petition, the reference book Stevens, TCP/IP Illustrated, Vol.2 ("Stevens2") (Ex.1013), was not shown to be a prior art printed publication. IPR2017-01395, Paper 8 at 8. The Board found that Exhibit 1063, a sworn affidavit from Pamela Stansbury (an employee of the Original Cataloging Unit of the Cornell University Library) stating that Stevens2 "was publicly available at the Cornell University Library as of April 7, 1995," to be insufficient to support the public availability of Stevens2 "because it lacks any acknowledgement by Ms. Stansbury that willful false statements are punishable by fine, imprisonment, or both, or that the statements are true under penalty of perjury." *Id.* at 6-7; *see* Exhibit 1063.

Petitioner respectfully submits that the Board misapplied laws that require an *unsworn declaration* to include an acknowledgement of the penalty of perjury to the *sworn affidavit* of Ms. Stansbury. *See* Exhibit 1063. ("Pamela Stansbury being of full age and duly sworn, deposes and says as follows", "Sworn to before me"). Unlike an unsworn declaration, a sworn affidavit is not required to include such an acknowledgment. *See Home Sav. of America F.A. v. Einhorn,* No. 87 C 7390, 1990 WL 114643 at *4 (N.D. Ill. July 24, 1990) ("If a statement does not

satisfy § 1746 by evidencing that the declarant signed under penalty of perjury, then the other alternative under federal law is for the declarant to swear before an official authorized to administer an oath. This is generally what is meant by the term 'affidavit'").

As the Board noted, 37 C.F.R. § 42.63(a) permits the use of affidavits as evidence. As the Board also noted, 37 C.F.R. § 42.2 states that "Affidavit means affidavit _or_ declaration under § 1.68 of this chapter. A transcript of an ex parte deposition or a declaration under 28 U.S.C. 1746 may be used as an affidavit." (emphasis added). While §42.2 permits the use of unsworn declarations under §1.68 or 28 U.S.C. § 1746 in lieu of a sworn affidavit, none of these sections extends the acknowledgement requirements for such an unsworn declaration to a sworn affidavit. Yet the Board mistakenly applied the requirements of 37 C.F.R. § 1.68 and 28 U.S.C. § 1746 for unsworn declarations to the sworn Stansbury Affidavit.

Ms. Stansbury executed a sworn affidavit in the presence of a notary public stating that Stevens2 was, in her best determination, publicly available as of April 7, 1995 at the Cornell University Library – more than two years before the priority date of the 948 Patent. The Stansbury Affidavit, sworn before a notary public, is "a sworn statement [ ] made under penalty of perjury" (*see* N.Y. Penal Law §§ 210.00-.50) and is not subject to the acknowledgment requirements for unsworn

declarations of either 37 C.F.R. § 1.68 or 28 U.S.C. 1746. *See Home Sav. of America F.A.*, 1990 WL 114643 at *4 ("If a statement does not satisfy § 1746 by evidencing that the declarant signed under penalty of perjury, then the other alternative under federal law is for the declarant to swear before an official authorized to administer an oath. This is generally what is meant by the term 'affidavit'"). As a result, the Board erred in giving Ms. Stansbury's sworn affidavit no weight.

The Board also found that "Petitioner provides no evidence that the 24th printing generated in 2010 (long after the 1997 priority date of the '948 patent) discloses the same material as earlier printings that may antedate the '948 patent." IPR2017-01395, Paper 8 at 7. Respectfully, this is also error. Each "printing" of a book is exactly what it says it is – the creation of additional printed copies of the same book. In contrast, revisions are signified by a new "edition."[1] The same page relied upon by the Board to show that Stevens2 submitted by Petitioner is the 24th printing shows that it is a reprint of the 1995 edition, because it identifies only the

---

[1] For corroboration of the plain meaning of printing and edition *see* Ex.1095 ("A reprint means more copies are being printed with no substantial changes. Perhaps a few typos are being fixed. A new edition means that there has been a substantial change").

1995 copyright date and no later edition. Ex.1013.010.

Petitioner further respectfully submits that the Board misapplied the legal standard for institution and instead applied a post-institution, trial standard. Petitioner clearly demonstrated that there is at least a reasonable likelihood that all challenged claims of the 948 Patent are invalid, including specifically at least a *reasonable likelihood* that Stevens2 is prior art, since, in addition to the Stansbury Affidavit, it is described as widely-cited prior art in Petitioner's expert declaration and effectively acknowledged as such in the earliest-filed priority application for the '948 Patent. *See* Petition at 15 (citing Ex.1003 at ¶¶21-88, including ¶¶27, 60, and FN3), 45 (citing Ex.1003 at ¶121[2]), FN9; *see also* Ex.1031.009 ("According to W. Richard Stevens and Gary Write in their book 'TCP/IP Illustrated Volume 2', TCP operated without experiencing any exceptions between 97 and 100 percent of the time in local area networks")).

Petitioner, pre-institution, need only demonstrate a reasonable likelihood of

---

[2] On page 45 of the Petition, Petitioner mistakenly cited to ¶121 of Ex.1003 in support of the statement that "Stevens2 is one of the most widely-read and referenced books on the implementation of TCP/IP." Petitioner intended to cite to Ex.1003 at ¶123, which is the beginning of the section concerning Stevens2, rather than ¶121, which concerns the Tanenbaum96 reference.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.

WHAT WILL YOU BUILD? | sales@docketalarm.com | 1-866-77-FASTCASE

fastcase®
Smarter legal research.