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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

ALACRITECH, INC.,
Patent Owner.

Case IPR2017-01713
Patent 7,337,241 B2

Before STEPHEN C. SIU, DANIEL N. FISHMAN, and WILLIAM M. FINK, *Administrative Patent Judges*.

FISHMAN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Intel Corporation ("Petitioner") requests *inter partes* review of claims 9–15, 17, and 19–21 (the "challenged claims") of U.S. Patent No. 7,337,241

B2 ("the '241 patent," Ex. 1001) pursuant to 35 U.S.C. §§ 311 *et seq*. Paper 2 (Petition "Pet."). Alacritech, Inc. ("Patent Owner") filed a preliminary response. Paper 6 ("Prelim. Resp."). Institution of an *inter partes* review is authorized by statute when "the information presented in the petition . . . and any response . . . 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); *see* 37 C.F.R. § 42.108. Upon consideration of the Petition and Preliminary Response, we conclude the information presented is insufficient to show that there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of any of the challenged claims (9–15, 17, and 19–21) of the '241 patent.

A. Related Matters

We are informed that the '241 patent is presently related to the following: *Alacritech, Inc. v. CenturyLink, Inc.*, Case No. 2:16-cv-00693-JRG-RSP (E.D. Tex.); *Alacritech, Inc. v. Wistron Corp.*, Case No. 2:16-cv-00692-JRG-RSP (E.D. Tex.); and *Alacritech, Inc. v. Dell Inc.*, Case No. 2:16-cv-00695-RWS-RSP (E.D. Tex.). Pet. 3; Paper 4, 1. In addition, Petitioner filed a Petition in Case no. IPR2017-01392 challenging all claims of the '241 patent based on other references. *See* Pet. 3.

B. The '241 Patent

The '241 patent describes a system and method for accelerating data transfer between a network and storage unit. Ex. 1001, Abstract. In particular, the claimed invention of the '241 patent relates to a fast-path processing in which processing for headers of a layered network protocol (e.g., TCP/IP or UDP/IP) is offloaded from the host computer to an intelligent network interface. *See id.* at 5:18–38, Fig. 24. Specifically, the

intelligent network interface includes accelerated processing features, "[t]he accelerated processing includes employing representative control instructions for a given message that allow data from the message to be processed via a fast-path which accesses message data directly at its source [in the host computer] or delivers it directly to its intended destination [in the host computer]." *Id.* at 5:18–22.

C. Illustrative Claim

Claims 9 and 17 are the independent claims of the challenged claims of the '241 patent. Claim 9, reproduced below, is illustrative of the claimed subject matter:

> 9. A method for communicating information over a network, the method comprising:
>
> obtaining data from a source in memory allocated by a first processor;
>
> dividing the data into multiple segments;
>
> prepending a packet header to each of the segments by a second processor, thereby forming a packet corresponding to each segment, each packet header containing a media access control layer header, a network layer header and a transport layer header, wherein the network layer header is Internet Protocol (IP), the transport layer header is Transmission Control Protocol (TCP) and the media access control layer header, the network layer header and the transport layer header are prepended at one time as a sequence of bits during the prepending of each packet header; and
>
> transmitting the packets to the network.

Id. at 99:19–35.

D. Asserted Ground of Unpatentability

Petitioner asserts that the challenged claims (9–15, 17, and 19–21) are unpatentable under 35 U.S.C. § 103(a) as obvious over Connery et al. (U.S. Patent No. 5,937,169 (Ex. 1043, "Connery")). Pet. 14.

Petitioner relies on the testimony of Dr. Robert Horst (Ex. 1003) in support of its assertions. Patent Owner relies on the testimony of Dr. Paul Prucnal (Ex. 2001) in support of its assertions.

II. DISCUSSION

A. Claim Construction

In an *inter partes* review, we construe claim terms in an unexpired patent according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b). Consistent with the broadest reasonable construction, claim terms are presumed to have their ordinary and customary meaning as understood by a person of ordinary skill in the art in the context of the entire patent disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Only terms that are in controversy need to be construed and only to the extent necessary to resolve the controversy. *See Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011); *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

At this stage of the proceeding, we determine that it is not necessary to provide an express interpretation of any claim terms.

B. Overview of Connery

Connery is directed to improving performance of transmissions from a host computer to a network by generating, at a network interface device, a

plurality of smaller packets for transmission in response to receipt, at the network interface, of a larger datagram from the host computer. Ex. 1043, Abstract (.001).

C. Prior Art Status of Connery

Connery was filed on October 29, 1997. Ex. 1043, .001. The '241 patent was filed September 27, 2002 but claims priority, through U.S. Provisional Patent Application No. 60/061,809 (the "'809 application"), to an earlier priority date of October 14, 1997. Ex. 1043, .094 (1:35–36).

Petitioner argues the '241 patent is not entitled to the October 14, 1997 priority date and, thus, Connery qualifies as prior art by antedating the next earliest priority date claimed by the '241 patent. Pet. 35–37. Specifically, Petitioner contends, the '809 application lacks sufficient disclosure of certain limitations of the challenged claims and, thus, fails to provide sufficient written description under § 112(1). *Id.* at 35. In particular, Petitioner argues the '809 application fails to sufficiently describe *prepending* a header to a segment to form a packet and, instead, discloses *appending* the data to a header. *Id.* at 36. Petitioner further argues the '809 application fails to sufficiently describe that the network and transport headers are *prepended at one time as a sequence of bits* as recited in claim 9 of the '241 patent. *Id.* at 37. Lastly, Petitioner asserts the '809 application fails to sufficiently describe that the network and transport headers are *prepended* to the data *without interrupts*. *Id.*

Patent Owner contends Petitioner's position is merely conclusory attorney argument with no expert analysis. Prelim. Resp. 27. Patent Owner argues initially, "it was well known in the art that a 'header' comes before the payload in a packet." *Id.* at 28. Patent Owner cites with approval

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