

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Intel Corporation,
Petitioner

v.

Qualcomm, Inc.,
Patent Owner

Patent No. 8,698,558

Inter Partes Review No. IPR2018-01240

PATENT OWNER'S REQUEST FOR REHEARING

I. Introduction

The Final Written Decision (“Decision”) cancelled claim 11 with findings that directly contradict the Board’s findings regarding claim 10, from which claim 11 depends. The Decision found claim 10 patentable and claim 11 unpatentable. Further, the Decision cancelled claim 11 on obviousness grounds that were *never* advanced by the petitioner, *never* briefed by the Patent Owner, and *never* heard by the Board. Therefore, the Decision violates the Administrative Procedure Act (“APA”), Due Process, and fundamental fairness by refusing Patent Owner notice and the opportunity to be heard.

II. Standard For Rehearing Under 37 C.F.R. 42.71(d)

A request for rehearing must identify, specifically, all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply. 37 C.F.R. § 42.71(d). The Board misapprehended the Petitioner’s obviousness combination of Chu, Choi 2010, and Hanington presented on page 51 of the petition.

III. The Board Erred By Issuing A Decision On Inconsistent Findings, Ruling On Grounds Never Petitioned, And Denied Patent Owner The Opportunity To Be Heard

A. The Board Erred By Applying Findings In Claim 11 That Directly Contradict Findings In Claim 10

In confirming claim 10 over the combination of Chu, Choi, and Hanington, the Board concluded that “Petitioner fails to provide sufficient or persuasive

evidence that Chu, Choi 2010, and Hanington teach the claim 10 limitation for ‘a source that receives the boosted supply voltage or the first supply voltage.’” (Decision at 17). The Board therefore held that “Petitioner has not proven by a preponderance of the evidence that claim 10 of the ’558 patent is unpatentable under 35 U.S.C. § 103(a) as obvious over Chu, Choi 2010, and Hanington.” (*Id.*).

With reference to claim 11, which depends from claim 10, however, the Board inexplicably concluded (on the very next page) that “Petitioner provides sufficient and persuasive evidence mapping the structures and functions of Chu, Choi 2010, and Hanington to the apparatus and means-plus-function limitations of claim 10.” (*Id.*, at 18).

The Board further supported its decision on claim 11 on the incorrect finding that “Patent Owner does not contest the mapping of the limitation of claim 10 and 11 to the asserted prior art.” (*Id.*, at 19). Patent Owner certainly contested Intel’s mapping of claim 10 onto the asserted prior art (*see, e.g.*, PO Response, pp. 21-31); in fact, the Board agreed with Patent Owner’s arguments and found claim 10 to be patentable. The Board’s findings on claim 11 simply cannot be squared with its opposite findings on claim 10.

B. The Board Improperly Cancelled Claim 11 On Grounds Not Advanced By Petitioner

To the extent the Board’s analysis of claim 11 applied Myers to the claim 10 limitation of “a source that receives the boosted supply voltage or the first supply

voltage,” such analysis was *never* presented in the petition nor at any time during the proceedings, and is therefore in violation of the APA and Due Process. Intel challenged the limitations of claim 10 as obvious in view of Chu combined with Choi 2010 and Hanington. (Petition at 51). In the Decision, the Board acknowledged that “Petitioner’s arguments and evidence do not address whether claim 10 requires a selective boost,” and that the Petitioner alleges *only* that the limitation of “a source that receives the boosted supply voltage or the first supply voltage” is met by Choi 2010’s disclosure of a boost converter. (Decision at 16). In the analysis of claim 11, the Board states that “Chu and Choi 2010 combined with Myers discloses an ‘envelope amplifier [that] would be able to operate selectively. . . .’” (Decision at 19). To the extent that the Board is applying this analysis of the combination of Myers with Chu and Choi 2010 to the selective boost limitation of claim 10, this is a different legal theory that was *never* advanced by Petitioner.

Under 35 U.S.C. § 311(a), *a party* may seek inter partes review by filing “a petition to institute an inter partes review.” 35 U.S.C. § 311(a). The Supreme Court has explained that this language does not “contemplate a petition that asks the Director to initiate whatever kind of inter partes review he might choose.” *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1355, (2018). Further, the Board does not “enjoy[] a license to depart from the petition and institute a different inter partes review of his own design.” *Id.* at 1356.

The Federal Circuit recently reprimanded a Board’s decision to institute on grounds different than what the petitioner advanced: “it is the petition, not the Board’s ‘discretion,’ that defines the metes and bounds of an inter partes review.” *Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330, 1336 (Fed. Cir. 2020). In that case, the petitioner argued the Board’s consideration of the new grounds was proper “for clarity” and only on “the [same] arguments and evidence,” presented in the petition. *Id.* The Federal Circuit disagreed and found the Board erred by instituting based on obviousness because the petitioner “did not advance such a combination of references in its petition.” *Id.* at 1337. Here, Petitioner unequivocally advanced the position that “regarding claim 10, Chu combined with Choi 2010 and Hanington discloses the apparatus of claim 10.” (Petition at 72). Petitioner’s obviousness theory did not include Myers for the “means for generating the second supply voltage” limitation. Thus, to the extent the Board relied upon Myers for the “means for generating the second supply voltage” limitation, the Board misapprehended Petitioner’s obviousness theory..

C. The Board Denied Patent Owner Notice And The Opportunity to Address Non-obviousness Of The Elements Required By Claim 11

In addition, Patent Owner was never given notice of, or the opportunity to address, the Board’s obviousness over Myers theory as it related to the “source that receives the boosted supply voltage or the first supply voltage” limitation of claim 10. The Federal Circuit has interpreted Due Process and the APA in the context of

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