

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

INTEL CORPORATION,  
Petitioner,

v.

VLSI TECHNOLOGY LLC,  
Patent Owner.

---

IPR2019-01198  
IPR2019-01199  
IPR2019-01200  
Patent 7,247,552 B2

---

Before THU A. DANG, LYNNE E. PETTIGREW, and  
KIMBERLY McGRAW, *Administrative Patent Judges*.

McGRAW, *Administrative Patent Judge*.

DECISION  
Denying Patent Owner's Requests for Rehearing of Decisions  
Instituting *Inter Partes* Review  
*37 C.F.R. § 42.71(d)*

## I. INTRODUCTION

Petitioner filed a Request for Rehearing in each of IPR2019-01198, IPR2019-01199, and IPR2019-01200 (Paper 21<sup>1</sup> (Rehearing Request” or “Req. Reh’g’)) seeking “rehearing and Precedential Opinion Panel review” of our Decisions (Paper 19) to grant institution of three separate petitions challenging claims of U.S. Patent No. 7,247,552 B2 (“the ’552 patent”). *See* Req. Reh’g 1. Patent Owner also requested review by the Precedential Opinion Panel (“POP”) in each proceeding (*see* Req. Reh’g 1; Paper 23 (Notification of Receipt of POP Request)). POP review was denied on April 6, 2020. Paper 25.

For the reasons set forth below, Petitioner’s Requests for Rehearing are *denied*.

## II. ANALYSIS

The party challenging a decision in a request for rehearing bears the burden of showing the decision should be modified. 37 C.F.R. § 42.71(d). The request for rehearing “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed.” *Id.* We review our Decision granting institution under an abuse of discretion standard. *See* 37 C.F.R. § 42.71(c). An abuse of discretion may arise if based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005).

---

<sup>1</sup> Unless otherwise indicated, citations to the record are for papers filed in IPR2019-01198. Similar papers, however, were filed in each proceeding.

In our Decisions, we considered, and rejected, Patent Owner’s argument that because Petitioner challenges claims of the ’552 patent in three separate Petitions, we should deny the Petitions under 35 U.S.C. § 314(a) as improper multiple parallel petitions. *See* Dec. 11–13 (citing Office Trial Practice Guide, July 2019 Update (“July 2019 TPG Update” or “Update”)<sup>2</sup>).

In its Requests for Rehearing, Patent Owner states that our Decisions instituting three petitions “overlooks or misapprehends the [July] 2019 TPG Update’s own express guidance indicating that it should apply to all parallel petitions that were filed both before and after the Update issued.” *See* Req. Reh’g 3; *see also id.* at 2 (stating “the Board disregarded the instructions in the July 2019 TPG Update providing that its guidance applies to parallel petitions filed both before and after the Update issued”). Specifically, Patent Owner points to language in the July 2019 TPG Update which states that “based on prior experience, the Board finds it *unlikely that circumstances will arise where three or more petitions by a petitioner with respect to a particular patent will be appropriate.*” Req. Reh’g 5 (quoting July 2019 TPG Update 26) (emphasis altered). Patent Owner contends that “Board’s institution of review of Petitioner’s three petitions did exactly what the July 2019 TPG Update states is ‘unlikely’ to be ‘appropriate’ in *any* ‘circumstances.’” Req. Reh’g 5 (citing July 2019 TPG Update 26) (emphasis altered).

---

<sup>2</sup> The July 2019 Update is available at <https://www.uspto.gov/TrialPracticeGuide3>. The July 2019 Update, along with the original August 2012 Practice Guide and another update from August 2018, have been consolidated into the Board’s Consolidated Trial Practice Guide, which is available at [www.uspto.gov/TrialPracticeGuideConsolidated](http://www.uspto.gov/TrialPracticeGuideConsolidated).

Contrary to Patent Owner’s argument, however, we did not overlook or misapprehend the guidance set forth in the July 2019 TPG Update. Rather, we considered the guidance and determined that, under the particular circumstances presented here, institution of three petitions was appropriate. Dec. 11–13. Significantly, the July 2019 TPG Update does not state that institution of review of three petitions is inappropriate in *any* circumstance. Patent Owner does not present any particularized argument to show that it was inappropriate to institute under these particular circumstances presented here or that our decision to institute on all three Petitions was an abuse of discretion. *See* Req. Reh’g 3–7.

As explained in our Decisions, “each petition is necessary to challenge the ’552 patent because each petition is directed to a *different independent claim*.” Dec. 12 (emphasis added). If we had exercised our discretion to dismiss any of the petitions, some independent claims of the ’552 patent would be left uncovered by any ground alleged by Petitioner. We noted that given the guidance set forth in the July 2019 TPG Update, petitioners in the future might not choose to prepare parallel petitions as was done here. *Id.*

Patent Owner’s Request also contends that our Decisions are inconsistent with other panel decisions that have found that the July 2019 TPG Update’s guidance applies to petitions filed before the Update issued. *See* Req. Reh’g 7 (also contending that POP review is required to resolve a “sharp split amongst various Board panels” as to whether the July 2019 TPG Update applies to petitions filed before the Update issued).

We disagree with Patent Owner’s argument because, as described above, we did not determine that the July 2019 TPG Update’s guidance does not apply to petitions filed before the Update issued. Rather, we determined

that under the particular facts presented, in view of the guidance set forth in the July 2019 TPG Update, it was appropriate to institute *inter partes* review. Patent Owner has not shown that any of the cited decisions present circumstances similar to those presented here, and as such, has not shown that any of the decisions are inconsistent.

In each of the decisions cited by Patent Owner in which institution was denied, either the same claims were challenged in multiple proceedings, or if different claims were challenged, there was no showing of any prejudice associated with not instituting trial on the non-overlapping claims. *See Intel Corp. v. Tela Innovations, Inc.*, IPR2019-01220, Paper 19 at 4 (PTAB Jan. 30, 2020) (denying institution of one petition that challenges the same claims challenged in another petition); *Volkswagen Group of Am. v. Carucel Invs. L.P.*, IPR2019-01106, Paper 8 at 10 (PTAB Dec. 2, 2019) (denying institution of one petition “challenging same claims of the [challenged] patent on similar grounds” in another petition); *Pfenex Inc. v. GlaxoSmithKline Biologicals SA*, IPR2019-01027, Paper 12 at 12 (PTAB Nov. 13, 2019) (denying second petition “challeng[ing] the *same* claims of the *same* patent”) (emphasis in original); *Dropbox, Inc. v. Whitserve LLC*, IPR2019-01018, Paper 13, 9–10 (PTAB Nov. 1, 2019) (denying petition when the same claims and same art are challenged in another petition); *PayPal, Inc. v. IOENGINE, LLC*, IPR2019-00886, Paper 21 at 12, 18–19 (PTAB Oct. 3, 2019) (denying institution of petition that challenges overlapping claims challenged in another petition when petitioner has not identified any prejudice associated with not instituting trial on the non-overlapping claims); *Nalox-1 Pharms., LLC v. Opiant Pharms., Inc.*, IPR2019-00696, Paper 10 at 8–14 (PTAB Oct. 1, 2019) (denying petition that challenges same claims in another petition); *Flex Logix Techs. Inc. v.*

IPR2019-01198, IPR2019-01199, IPR2019-01200  
Patent 7,247,552 B2

*Venkat Konda*, PGR2019-00040, Paper 13 at 12–13 (PTAB Sept. 19, 2019) (denying petition that challenges same claims challenged in another petition). Here, different independent claims were challenged in each of the petitions. Thus, we see no inconsistency between those decisions and our Decisions.

### III. CONCLUSION

Having considered Patent Owner’s Requests, Patent Owner has not persuaded us, for the reasons discussed, that we abused our discretion in declining to exercise our discretion to deny institution under 35 U.S.C. § 314(a).

### IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner’s Requests for Rehearing are *denied*.

IPR2019-01198, IPR2019-01199, IPR2019-01200  
Patent 7,247,552 B2

FOR PETITIONER:

Yung-Hoon Ha  
Taeg Sang Cho  
WILMER CUTLERPICKERING HALE AND DORR, LLP  
Yung-Hoon.Ha@wilmerhale.com  
Tim.Cho@wilmerhale.com

FOR PATENT OWNER:

Kenneth J. Weatherwax  
Bridget Smith  
Flavio Rose  
Edward Hsieh  
Parham Hendifar  
Patrick Maloney  
Jason C. Linger  
LOWENSTEIN AND WEATHERWAX  
weatherwax@lowensteinweatherwax.com  
smith@lowensteinweatherwax.com  
rose@lowensteinweatherwax.com  
hsieh@lowensteinweatherwax.com  
hendifar@lowensteinweatherwax.com  
maloney@lowensteinweatherwax.com  
linger@lowensteinweatherwax.com