

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RENESAS ELECTRONICS CORPORATION,
Petitioner,

v.

BROADCOM CORPORATION,
Patent Owner.

Case IPR2019-01040
Patent 8,284,844 B2

Before THOMAS L. GIANNETTI, PATRICK M. BOUCHER, and
NORMAN H. BEAMER, *Administrative Patent Judges*.

BEAMER, *Administrative Patent Judge*.

DECISION

Denying Patent Owner's Request for Rehearing of Final Decision
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Renesas Electronics Corporation (“Petitioner”) has filed a Request for Rehearing (Paper 36, “Request”) of the Final Written Decision (Paper 35, “Final Decision”), which determined Petitioner had shown that claims 1 and 9–14 of U.S. Patent No. 8,284,844 B2 (“the ’844 patent”) were unpatentable, denied Broadcom Corporation’s (“Patent Owner’s”) Motion to Amend as to proposed substitute claim 15, and granted the Motion to Amend as to proposed substitute claims 16–19. The Request seeks “rehearing to . . . deny Patent Owner Broadcom Corporation’s motion to amend” as to proposed substitute claims 16–19. Request 1. In particular, Petitioner asserts “Patent Owner’s amendments did not address unpatentability, but just attempted to improve its infringement position in district court,” and the Board “misapprehended 37 C.F.R. § 42.121(a)(2)’s requirements for a motion to amend [and] overlooked the precedential standards for applying those requirements in *Lectrosonics*”¹ *Id.* For the reasons that follow, Petitioner’s Request for Rehearing is denied.

II. THE REQUEST FOR REHEARING

In pertinent part, 37 C.F.R. § 42.71(d) states:

The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify 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.

¹ *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019) (precedential).

Thus, a request for rehearing is not an opportunity merely to disagree with the Board’s assessment of the arguments or weighing of the evidence, or to present new arguments or evidence.

Petitioner argues that reconsideration is appropriate because, but for the Board’s misapprehension, Patent Owner’s proposed substitute claims 16–19 should have been denied pursuant to 37 C.F.R. § 42.121(a)(2), providing that “[a] motion to amend may be denied where: (i) [t]he amendment does not respond to a ground of unpatentability involved in the trial; or (ii) [t]he amendment seeks to enlarge the scope of the claims of the patent” Request 1.

We have reviewed Petitioner’s Request and carefully considered all of the arguments presented. For the following reasons, we are not persuaded that we misapprehended or overlooked any arguments or evidence. We, therefore, deny the Request.

III. DISCUSSION

Petitioner starts with the fact that challenged claim 11 required “all five recited hardware accelerators,” whereas proposed substitute claim 16 would “require only ‘at least four of’ the five.” Request 3 (citing Paper 19, 4–5). Petitioner further argues that this “broadening modification” did not respond to a ground of unpatentability involved in the trial, as required by 37 C.F.R. § 42.121(a)(2)(i).² *Id.*

² Petitioner does not dispute that all the proposed substitute claims are narrower than challenged claim 1, and therefore, as we determined in the Final Decision, those claims comply with the requirement to not enlarge the scope of the claims. Final Decision 62 (citing *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 at 6–7 (PTAB Feb. 25, 2019) (Precedential) (“A substitute claim will meet the requirements of § 42.121(a)(2)(i) and (ii)

A. Alleged Broadening of Claim 16

Petitioner asserts that the amendment to proposed substitute claim 16 broadened the claim “to try to improve its infringement position in a pending district court matter.” *Id.* at 4. Petitioner argues “allowing patent owners to add claims and use amendments in an *inter partes* review to improve their infringement positions serves only patent owners’ private interests, not any public ones.” *Id.* at 6. Therefore, argues Petitioner, we should have denied the motion to amend as to proposed substitute claim 16, as well as proposed substitute claims 17–19, which depend therefrom. *Id.* at 9.

We disagree. As stated in our Final Decision, proposed substitute claim 16 depends from proposed substitute claim 15, which narrows challenged claim 10 to require, “wherein the plurality of hardware accelerators do not comprise programmable processors which are configured to operate according to different encoding/decoding formats by changing the software executed by those processors.” Final Decision 60.

B. Alleged Failure to Respond to a Ground of Unpatentability

This amendment to claim 15 attempted to further distinguish the claim as patentable over the references asserted in the instituted grounds. *Id.* In particular, because Patent Owner expressly addressed the Fandrianto ’459, Fandrianto ’351, and Reader references, which underlay our Institution Decision, the amendment to proposed substitute claim 15 responded to the grounds of unpatentability involved in the trial. *Id.*

Thus, as we determined in the Final Decision, we disagree with Petitioner’s contention that proposed substitute claim 16 does not respond to

if it narrows the scope of at least one claim of the patent . . .”).

any ground of unpatentability, because the claim includes the responsive features in the claim 15 amendment, based on claim 16's dependence on claim 15. Final Decision 61. Claims 17–19 also include the responsive features, based on their dependence on claim 16. Final Decision 61.

Petitioner asserts that, in determining whether proposed substitute claim 16 responds to a ground of unpatentability, it was error to take into account the above amendment of proposed substitute claim 15. Request 3–4. There is no basis for Petitioner's argument. Petitioner cites *Lectrosonics* as requiring that the responsiveness analysis must be “made on a claim-by-claim basis.” *Id.* at 2. Actually, the quotation from *Lectrosonics* that Petitioner refers to deals with the requirement that the Motion to Amend propose a reasonable number of substitute claims, not whether the proposed substitute claims respond to a ground of unpatentability. *Lectrosonics*, Paper 15 at 5. *Lectrosonics* requires “review[ing] the entirety of the record to determine whether a patent owner's amendments respond to a ground of unpatentability involved in the trial.” *Id.* Nonetheless, our analysis is made on a claim-by-claim basis — as is the case with any dependent claim, proposed substitute claim 16 includes all the limitations of the claim from which it depends, including the limitation that unquestionably is in response to Petitioner's original invalidity grounds. *See* 35 U.S.C. § 112(d) (“A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.”).

Petitioner also relies on the statement in *Lectrosonics* that “once a proposed claim includes amendments to address a prior art ground in the trial, a patent owner also may include additional limitations.” Request 4 (citing *Lectrosonics*, Paper 15 at 6). From this statement, Petitioner would

draw the inference that only the language in proposed substitute claim 16 itself can include the responsive amendment before a non-responsive amendment would be permitted. *Id.* at 4–5. Again, there is no basis for this, because by definition a dependent claim includes the limitations of the claim it refers to.³

Petitioner further argues in the alternative, that even if it were proper to consider the responsive amendment of proposed substitute claim 15 (and, as we have determined, it is proper), the additional amendment to proposed substitute claim 16 requiring only four out of five accelerators still should not be permitted. Request 5–6. Petitioner cites the statement in *Lectrosonics* that, once a responsive amendment is proposed, additional non-responsive “modifications that address potential 35 U.S.C. § 101 or § 112 issues, for example, are not precluded by rule or statute.” *Id.* at 5 (citing *Lectrosonics*, Paper 15 at 6). Petitioner interprets this statement to mean that additional non-responsive amendments are *limited* to those that address Section 101 or 112 issues. *Id.* at 6. However, as the quoted statement indicates, addressing Section 101 or 112 issues are examples of permitted non-responsive amendments, not an exclusive list. *See, e.g., SZ DJI Tech. Co., Ltd. v. Drone-Control LLC*, IPR2018-00207, Paper 44 at 38 (PTAB June 11, 2019). There is no *per se* rule that would deny such additional

³ Petitioner relies on the non-precedential opinion in *Apple Inc. v. Valencell, Inc.*, IPR2017-00317, Paper 46 at 54–55 (PTAB June 1, 2018), which, it argues, supports its position that a dependent claim must include a responsive amendment in the four corners of the claim itself, rather than in the claim it refers to. Request 8. Our decision, however, applies the precedential *Lectrosonics* decision and 35 U.S.C. § 112.

amendments based on speculation as to the motives of Patent Owner that led to the amendment.

In sum, we are not persuaded that the Final Decision overlooked or misapprehended the arguments with respect to the Panel’s grant of the Motion to Amend as to proposed substitute claims 16–19.

IV. CONCLUSION

We have reviewed and considered the arguments in Petitioner’s Rehearing Request and conclude that Petitioner has not carried its burden of demonstrating that the Board misapprehended or overlooked any matters in rendering the Final Written Decision. 37 C.F.R. § 42.71(d).

Thus, Petitioner’s challenge does not meet the standard set forth for a request for rehearing.

The Request for Rehearing is *denied*.

Outcome of Decision on Rehearing:

Claims	35 U.S.C. §	References	Claims Shown Unpatentable	Claims Not shown Unpatentable
1, 9, 10	103(a)	Fandrianto ’459	1, 9, 10	
11–13	103(a)	Fandrianto ’459, Fandrianto ’351, Reader	11–13	
14	103(a)	Fandrianto ’459, Fandrianto ’351, Reader, Harrand	14	
Overall Outcome			1, 9–14	

Motion to Amend Outcome	Claim(s)
Original Claims Cancelled by Amendment	
Substitute Claims Proposed in the Amendment	15–19
Substitute Claims: Motion to Amend Granted	16–19
Substitute Claims: Motion to Amend Denied	15
Substitute Claims: Not Reached	

Final Outcome of Final Written Decision after Rehearing:

Claims	35 U.S.C. §	References	Claims Shown Unpatentable	Claims Not shown Unpatentable
1, 9, 10	103(a)	Fandrianto '459	1, 9, 10	
11–13	103(a)	Fandrianto '459, Fandrianto '351, Reader	11–13	
14	103(a)	Fandrianto '459, Fandrianto '351, Reader, Harrand	14	
Overall Outcome			1, 9–14	

Motion to Amend Outcome	Claim(s)
Original Claims Cancelled by Amendment	
Substitute Claims Proposed in the Amendment	15–19
Substitute Claims: Motion to Amend Granted	16–19
Substitute Claims: Motion to Amend Denied	15
Substitute Claims: Not Reached	

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