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Paper 65
Date: June 3, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ANALOG DEVICES, INC.,
Petitioner,

v.

XILINX, INC. and XILINX ASIA PACIFIC PTE. LTD.,
Patent Owner.

IPR2020-01606
Patent 7,280,590 B1

Before JOHN F. HORVATH, DANIEL J. GALLIGAN, and
RUSSELL E. CASS, *Administrative Patent Judges*.

GALLIGAN, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request on Rehearing of Final Written Decision
37 C.F.R. § 42.71(d)

I. DISCUSSION

Petitioner Analog Devices, Inc. requests reconsideration of our Final Written Decision (Paper 63, “Final Dec.”) regarding U.S. Patent No. 7,280,590 B1 (Ex. 1001, the “‘590 patent”). Paper 64 (“Req. Reh’g”).

The standard for a request for rehearing of a Final Written Decision is set forth in 37 C.F.R. § 42.71(d), which provides in relevant part:

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.

A rehearing request is not an opportunity for the requesting party to reargue its case or merely to express disagreement with the Final Written Decision. Nor is it an opportunity for the moving party to present new arguments that were not in its original submissions.

In the Final Written Decision, we determined that Petitioner had not shown that proposed substitute claim 39 is unpatentable, and we granted Patent Owner’s motion to amend as to that proposed substitute claim. Final Dec. 104–106, 108. On rehearing, Petitioner argues that, for proposed substitute claim 39, we should have considered a ground of unpatentability based on five references “[e]ven though this combination was not specifically presented to oppose substitute claim 39.” Req. Reh’g 3; *see also* Req. Reh’g 3 n.2 (identifying the five references as Ex. 1008 (“DS_ORT8850”), Ex. 1005 (“HFAN-1.0”), Ex. 1034 (“Lee”), Ex. 1039 (“Madhavan”), and Ex. 1004 (“IEEE 1149.6”)). Because this ground was not presented for proposed substitute claim 39, we did not misapprehend or overlook anything in this regard. *See* 37 C.F.R. § 42.71(d).

Furthermore, Petitioner’s arguments on rehearing at most show that, under our Rules, we had discretion to consider this ground when rendering the Final Written Decision as to proposed substitute claim 39. More particularly, Petitioner argues on rehearing that this ground was presented for another claim such that there was “readily identifiable and persuasive evidence of record,” that Patent Owner had an opportunity to respond, and that considering this ground is in the “interest of supporting the integrity of the patent system.” Req. Reh’g 4–12. But, as Petitioner acknowledges, such a situation still involves a matter of Board “discretion.” Req. Reh’g 2; *see* 37 C.F.R. § 42.121(d)(3) (“Irrespective of paragraphs (d)(1) and (2) of this section, the Board may, in the interests of justice, exercise its discretion to grant or deny a motion to amend only for reasons supported by readily identifiable and persuasive evidence of record.”); *see also Hunting Titan, Inc. v. DynaEnergetics Europe GmbH*, 28 F.4th 1371, 1381 (Fed. Cir. 2022) (“Neither *Aqua Products[, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017) (en banc)] nor *Nike[, Inc. v. Adidas AG*, 955 F.3d 45 (Fed. Cir. 2020)] established that the Board maintains an affirmative duty without limitation or exception, to sua sponte raise patentability challenges to a proposed substitute claim.”). Thus, although our Rules permit us, under certain circumstances, to consider a ground that was not asserted specifically against a proposed substitute claim, the Rules do not require us to do so.

Petitioner also argues that “all of the arguments underlying the conclusion that substitute claim 39 was unpatentable were accepted by the Board in its Final Written Decision.” Req. Reh’g 7–8. We disagree. Our Final Written Decision did not specifically include findings directed to a reason to combine for any combination involving both HFAN-1.0 and IEEE 1149.6. Petitioner asserted these two references in the same

combination only as to proposed substitute claim 29, and we did not reach this ground of unpatentability because we denied the motion to amend as to proposed substitute claim 29 for lack of adequate written description support. *See* Final Dec. 68–75.¹

Petitioner also argues that proposed substitute claim 39 should be rejected because it “improperly broadened original claim 22.” Req. Reh’g 12–15. In particular, Petitioner points out that claim 22 depends from claim 21, which depends from claim 16, which in turn depends from independent claim 15. *See* Req. Reh’g 12–14. Petitioner points out that, by contrast, proposed substitute claim 39 depends from proposed substitute claim 38 (substitute for claim 21), which depends from proposed substitute claim 33 (substitute for claim 15). *See* Req. Reh’g 12–14. Thus, claim 22 incorporates all of the subject matter recited in claims 15, 16, and 21, but proposed substitute claim 39 does not incorporate the subject matter of proposed substitute claim 34, which is a substitute for claim 16.

As an initial matter, we note that the Rehearing Request does not identify where this issue was previously raised, as required by 37 C.F.R. § 42.71(d). Req. Reh’g 12–15. We have reviewed the papers, and this issue was not raised by Petitioner during the trial. Petitioner’s argument on rehearing is improper for this reason.

In any event, we do not agree with Petitioner’s rehearing argument. The relevant statute states that “[a]n amendment under this subsection may not enlarge the scope of the claims of the patent or introduce new matter.”

¹ The table on page 75 of our Final Written Decision incorrectly states that Petitioner challenged proposed substitute claims 27 and 37 based on a combination including both IEEE 1149.6 and HFAN-1.0. The inclusion of HFAN-1.0 is a typographical error.

35 U.S.C. § 316(d)(3). Board precedent states that “[a] patent owner may not seek to broaden a challenged claim in any respect that enlarges the scope of the claims of the patent.” *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 at 6 (PTAB Feb. 25, 2019) (precedential). Proposed substitute claim 39 is narrower than proposed substitute claim 33, from which it ultimately depends, and proposed substitute claim 33 contains amendments that narrow its scope from that of original claim 15. See Paper 36 at 34. Thus, proposed substitute claim 39 is narrower than original claim 15 and does not “enlarge the scope of the claims of the patent.” 35 U.S.C. § 316(d)(3).

Petitioner’s focus on whether proposed substitute claim 39 is broader than original dependent claim 22 itself is misplaced. Petitioner asserts that, “[e]ven though claim 39 is a dependent claim, it nevertheless broadens the claims in all respects to encompass something that would not have infringed the original patent because it lacks the limitations from original claim 16.” Req. Reh’g 15. We disagree with this argument for the simple reason that removing the limitations of original claim 16 still would not create a broader claim than original claim 15, from which claim 16 depends.

We find that proposed substitute claim 39 complies with the requirement of § 316(d)(3) to “not enlarge the scope of the claims.”

Nothing on rehearing persuades us that we misapprehended or overlooked any matters or that we abused our discretion as to proposed substitute claim 39. Accordingly, we deny Petitioner’s rehearing request.

Outcome of Decision on Rehearing:

Claims	35 U.S.C §	Reference(s)/Basis	Denied	Granted
39	103(a)	DS_ORT8850, IEEE 1149.6, Lee, Madhavan, HFAN-1.0	39	
39	316(d)(3)	Enlargement of claim scope	39	
Overall Outcome			39	

Final Outcome of Motion to Amend after Rehearing:

Motion to Amend Outcome	Claim(s)
Substitute Claims: Motion to Amend Granted	39

II. ORDER

In view of the foregoing, it is:

ORDERED THAT Petitioner's Request for Rehearing of the Board's Final Written Decision is *denied*.

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