

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

INTEL CORPORATION and LENOVO (UNITED STATES) INC.,
Petitioner,

v.

USTA TECHNOLOGY, LLC,
Patent Owner.

IPR2025-00838
Patent RE47,720 E

Before COKE MORGAN STEWART, *Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.*

DECISION
Denying Institution of *Inter Partes* Review

USTA Technology, LLC (“Patent Owner”) filed a request for discretionary denial (Paper 7, “DD Req.”) in the above-captioned case, and Intel Corporation and Lenovo (United States) Inc. (collectively “Petitioner”) filed an opposition (Paper 8, “DD Opp.”).

After considering the parties’ arguments and the record, and in view of all relevant considerations, discretionary denial of institution is appropriate in this proceeding. This determination is based on the totality of the evidence and arguments the parties have presented.

In particular, challenged claim 53 was subject to an *ex parte* reexamination (Reexamination Control No. 90/019,702) at the time the Petition was filed.¹ DD Opp. 3–5. During the reexamination proceeding, Patent Owner submitted the Petition and Walton² on an Information Disclosure Statement (IDS). *Id.* at 5–7. Petitioner presents evidence demonstrating that the patent examiner did not consider Walton during the reexamination proceeding. *Id.* at 7–11. Petitioner, however, also presents evidence that Walton is material to the patentability of the challenged claim because Walton teaches the claimed feature the patent examiner identified as missing from the prior art during the reexamination. *Id.* Under these circumstances, the most efficient process for the Office is not to refer the Petition to the Board, but instead for Petitioner to file a reexamination request that includes Walton.

Although certain arguments are highlighted above, the determination to exercise discretion to deny institution is based on a holistic assessment of

¹ Of the two claims challenged in the Petition, only claim 53 was subject to reexamination. Ex. 1039.

² US 2003/0043732 A1 (Ex. 1005).

all of the evidence and arguments presented. Accordingly, the Petition is denied under 35 U.S.C. § 314(a).

In consideration of the foregoing, it is:

ORDERED that Patent Owner's request for discretionary denial is *granted*; and

FURTHER ORDERED that the Petition is *denied*, and no trial is instituted.

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