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Paper 54
Entered: November 30, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MARVELL SEMICONDUCTOR, INC.,
Petitioner,

v.

INTELLECTUAL VENTURES I LLC,
Patent Owner.

Case IPR2014-00548
Patent 5,712,870

Before THOMAS L. GIANNETTI, JAMES A. TARTAL, and PATRICK M. BOUCHER, *Administrative Patent Judges*.

TARTAL, *Administrative Patent Judge*.

ORDER

37 C.F.R. § 42.5(a) and § 42.71(a)

Petitioner, Marvell Semiconductor, Inc., filed a corrected Petition requesting an *inter partes* review of claims 1–20 of U.S. Patent No. 5,712,870 ("the '870 patent"). Paper 6 ("Pet."). Based on the information provided in the Petition, we instituted a trial pursuant to 35 U.S.C. § 314(a) of: (1) claims 1, 2, 4–6, 8, 10, 11, 13, 14, and 16–20 as obvious over Fischer[1] and Nakamura[2] under 35 U.S.C. § 103(a); and, (2) claims 9 and 15 as obvious over Fischer, Nakamura, and Tsuda.[3] Paper 16 ("Institution Decision, or "Inst. Dec."). We did not institute trial on claims 3, 7, or 12. *Id*.

After institution of trial, Patent Owner, Intellectual Ventures I LLC, filed a Patent Owner's Response (Paper 30, "Response" or "PO Resp.") and Petitioner filed a Reply (Paper 35, "Reply"). In its Response, Patent Owner raised for the first time an issue with our decision to institute trial on claims 8 and 9, which depend from claim 7. PO Resp. 37–38, 40. In our Institution Decision, we denied institution on claim 7 because Petitioner had not shown a reasonable likelihood of prevailing. In particular, Petitioner failed to identify in the Petition, as required by 37 C.F.R. § 42.104(b)(3), the specific portions of the specification that describe the structure corresponding to the claimed "means to evaluate . . . and to select" recited in claim 7. Inst. Dec. 18–19.

Claim 8 recites "[t]he circuit of claim 7 wherein the circuit is contained on a single monolithic device." Ex. 1001, 10:45-49. Claim 9

[1] U.S. Patent No. 5,371,734, issued Dec. 6, 1994 (Ex. 1004, "Fischer")
[2] U.S. Patent No. 4,856,027, issued Aug. 8, 1989 (Ex. 1005, "Nakamura")
[3] U.S. Patent No. 5,619,507, issued Apr. 8, 1997 (Ex. 1009, "Tsuda") from U.S. Application Number 08/268,454 filed June 30, 1994.

recites "[t]he circuit of claim 8 wherein said circuit acquires a unique word within a message header and if no unique word is acquired within a predetermined period of time resets the circuit." *Id*. at 10:50–51. Thus, the additional limitations of claims 8 and 9 do not limit the means recited in claim 7 to any specific structure. Accordingly, having failed to show a reasonable likelihood of prevailing on claim 7, Petitioner necessarily failed to show a reasonable likelihood of prevailing on dependent claims 8 and 9.

Patent Owner argues that, "[b]ecause claim 8 includes all of the limitations of parent claim 7, and the Petition relies on the asserted unpatentability of claim 7 as supporting the unpatentability of claim 8, Petitioner has not shown that claim 8 is obvious over Fischer and Nakamura." PO Resp. 38. Patent Owner makes essentially the same argument with respect to claim 9. *Id*. at 40. Thus, while neglecting to raise the issue earlier in the proceeding through a request for rehearing at the appropriate time, Patent Owner now seeks to benefit from our decision instituting on claim 8 and 9 by arguing for a final decision in its favor by virtue of our decision not to institute on claim 7.

Petitioner argues in reply that the record developed by the parties since the Institution Decision includes the requisite identification of structure, and that the decision not to institute on claim 7 "no longer has any bearing on the Board's ability to evaluate claim 8" or claim 9. Reply 19–20, 25. Petitioner further asserts that Patent Owner waived its objection to institution of trial on claims 8 and 9 by failing to request reconsideration of the Institution Decision, and asserts that it would be unfairly prejudiced

should a final written decision on the patentability of claims 8 and 9 be issued based on the non-institution of review for claim 7. *Id*. at 18–19, 25.

We have considered all of the arguments of both parties in regard to claims 8 and 9. Because our decision to institute trial on claims 8 and 9 was improvidently granted based on our misapprehension of their dependency, we vacate the Institution Decision and dismiss *inter partes* review solely with respect to claims 8 and 9 and of claims 8 and 9, and do not issue a final written decision under 35 U.S.C. § 318(a) with respect to the patentability of claim 8 or claim 9. *See* 37 C.F.R. § 42.5(a) and § 42.71(a).

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the decision to institute *inter partes* review of claim 8 and claim 9 of the ’870 patent in the Institution Decision is vacated;

FURTHER ORDERED that *inter partes* review of claim 8 and claim 9 of the ’870 patent is dismissed;

FURTHER ORDERED that no other change is made to the Institution Decision; and

FURTHER ORDERED that no final written decision shall be issued in this proceeding with regard to the patentability of claim 8 or claim 9 of the ’870 patent.

IPR2014-00548
Patent 5,712,870

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