

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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INTEL CORPORATION,  
Petitioner,

v.

ALACRITECH, INC.,  
Patent Owner.

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Case IPR2017-01395  
Patent 8,805,948 B2

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Before STEPHEN C. SIU, DANIEL N. FISHMAN, and  
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

FISHMAN, *Administrative Patent Judge*.

DECISION

Denying-in-Part and Granting-in-Part Petitioner's Request for Rehearing  
*37 C.F.R. § 42.71(d)*

Intel Corporation ("Petitioner") filed a Request for Rehearing (Paper 9, "Req. Reh'g") of the Decision Denying Institution (Paper 8, "Decision") of U.S. Patent No. 8,805,948 B2 (Ex. 1001, "the '948 patent") in the above-captioned proceeding. In the Request for Rehearing, Petitioner

argues that the Decision misapprehended or overlooked certain evidence in denying review of the challenged claims. For the reasons set forth below, the Request for Rehearing is *granted-in-part and denied-in-part*.

When considering a request for rehearing, we review the Decision for an abuse of discretion. 37 C.F.R. § 42.71(c). The party requesting rehearing bears the burden of showing that the Decision should be modified, and “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked.” 37 C.F.R. § 42.71(d). A request for rehearing is not an opportunity to present new arguments. *See id.* An abuse of discretion may arise if a decision is 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); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000).

Institution of an *inter partes* review is authorized by statute only when “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). In the Decision, the Board determined that the record before it was insufficient to show that Stevens<sup>1</sup> is a prior art printed publication under 35 U.S.C. §§ 102, 311(b) with respect to the ’948 patent. Stevens2 is one of the references relied upon in the sole asserted ground of unpatentability in the Petition. Accordingly, the Board concluded that Petitioner did not

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<sup>1</sup> W. Richard Stevens *et al.*, *TCP/IP Illustrated, Volume 2*, 1995 (“Stevens2,” Ex. 1013).

establish a reasonable likelihood of prevailing on its sole asserted ground of unpatentability because the Petition failed to provide a threshold showing that Stevens2 qualified as a printed publication prior art reference. Dec. 4–8.

Petitioner contends the Board overlooked or misapprehended the evidence of record that established the threshold showing that Stevens2 is a printed publication.

Initially we observe the Petition, *per se*, provides only a statement that “Stevens2 was published no later than April 7, 1995 and is prior art under 102(b).” Pet. 45 n.9 (citing Ex. 1063 in support thereof (the “Stansbury Declaration”)). The Petition, *per se*, provides no other evidence or argument to establish a threshold showing that Stevens2 is a printed publication—publicly accessible by an interested person of ordinary skill in the art before the critical date.

Thus, Petitioner’s assertion regarding printed publication status of Stevens2 relies primarily on the Stansbury Declaration. Petitioner is correct that we erroneously discounted the Stansbury Declaration as lacking acknowledgment of the potential penalty for perjury. Req. 8–10. Petitioner is correct that the Stansbury Declaration is a *sworn* affidavit and, thus, complies with our rules’ definition of an “affidavit.” *See* 37 C.F.R. § 42.2. Therefore, we grant Petitioner’s Request for Rehearing only to the extent that we recognize the Stansbury Declaration is a sworn affidavit compliant with our rules.

However, our Decision further determined that, even if accorded due weight as a sworn affidavit, the Stansbury Declaration is insufficient because it fails to describe any facts relating to indexing or cataloging procedures to support an assertion that Stevens2 would be locatable by an interested

person of ordinary skill. A reference is publicly accessible “upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” *SRI Int’l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1194 (Fed. Cir. 2008). We assess public accessibility on a case-by-case basis. *See Kyocera Wireless Corp. v. Int’l Trade Comm’n*, 545 F.3d 1340, 1350 (Fed. Cir. 2008). In instances of references stored in libraries, for example, “competent evidence of the general library practice may be relied upon to establish an approximate time when a thesis became accessible.” *In re Hall*, 781 F.2d 897, 899 (Fed. Cir. 1986). “In these cases, we generally inquire whether the reference was sufficiently indexed or cataloged.” *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1348 (Fed. Cir. 2016); *accord Voter Verified, Inc. v. Premier Election Sols., Inc.*, 698 F.3d 1374, 1380 (Fed. Cir. 2012) (“[I]ndexing is a relevant factor in determining accessibility of potential prior art, particularly library-based references.”). “Indexing by subject offers meaningful assurance that an ordinarily skilled artisan, exercising reasonable diligence, will be able to locate a particular reference among the many volumes stored in a library.” *Blue Calypso*, 815 F.3d at 1349. Petitioner correctly observes that Ms. Stansbury’s title is Administrative Supervisor in the Original Cataloging Unit. Req. 11; Ex. 1063 ¶ 2. Ms. Stansbury states she is “familiar with the policies and procedures of the Library as they relate to . . . cataloging.” Ex. 1063 ¶ 1. However, Ms. Stansbury does not disclose details of those procedures nor does she disclose how she determined that “as best [she] can determine, [Stevens2] was publicly available at the Cornell University Library as of

April 7, 1995.” *Id.* ¶ 4. Furthermore, Ms. Stansbury’s testimony indicates “as best [she] can determine,” suggesting some degree of uncertainty, with no explanation of degree of or reasons for such uncertainty. We further observe that Ms. Stansbury does not identify any particular, version, edition, or printing of Stevens2 that may have been accessible at the Cornell University Library.

Thus, even granting Petitioner’s request to the extent that we accord some weight to the Stansbury Declaration, we stand by our determination in the Decision that the evidence of record is insufficient to demonstrate a reasonable likelihood that Stevens2 qualifies as a printed publication prior art reference.

Petitioner further argues, “Consistent with this, Petitioner’s expert attested that Stevens2 was ‘standard reference book on TCP/IP’ that was ‘widely cited and relied upon,’ ‘well known resources to a [person of ordinary skill in the art]’ (Petition at 15 (citing Ex.1003 at ¶¶21-88, including ¶¶27, 60, and FN3), 45 (citing Ex.1003 at ¶121<sup>2</sup>), FN9).” Req. 12. Initially we observe the Petition cites these paragraphs of Dr. Horst’s Declaration as part of the “Background Of Technology” discussion rather than as support for public accessibility of Stevens2. *See* Pet. 15–24. Furthermore, incorporating by reference such a substantial portion of Dr. Horst’s Declaration (paragraphs 21–88) is improper under our rules. *See* 37 C.F.R. § 42.6(a)(3). Regardless, even if we consider Dr. Horst’s description of well-known background material (including Stevens2) as support for public accessibility of Stevens2, his testimony does not indicate

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<sup>2</sup> We observe paragraph 121 of Exhibit 1003 makes no reference to Stevens2.

any personal knowledge that Stevens2 was publicly accessible on any particular date. In particular, none of paragraphs 27, 60, and 121 of Exhibit 1003 testify to any personal knowledge of Dr. Horst regarding any particular date of public accessibility of Stevens2.

Thus, even considering Dr. Horst's expert testimony, we still find the evidence of record insufficient to demonstrate a reasonable likelihood that Stevens2 qualifies as a printed publication prior art reference.

Lastly, Petitioner also contends Stevens2, *per se*, corroborates its prior art status in that "the copy relied upon by the Petitioner recites that it is the '24th Printing 2010' and bears a 1995 copyright date." Req. 11. Our Decision noted this indication on the face of Stevens2 and concluded it contradicted Petitioner's assertion of public accessibility as of 1995. Dec. 7. Petitioner argues Exhibit 1095, a web page printout from the URL "[https://www.isbn.org/faqs\\_formats\\_reprints\\_editions](https://www.isbn.org/faqs_formats_reprints_editions)," filed with its Request, is evidence that our Decision misunderstood the meaning of "24th printing," confusing a "printing" (a reprint with "no substantial changes") with an "edition" (with "substantial change"). Req. 11–12. Petitioner also argues that Exhibit 1096, filed with its Request, is evidence that the first printing in 1995 (Ex. 1096, 3) and the 24th printing in 2010 (Ex. 1013, 10) were identical printings of the same edition. Had such evidence or argument been included with or in the Petition, it may have been accorded some weight as evidence contrary to our perception that the 2010 date of the 24th printing contradicted Petitioner's assertion that Stevens2 was publicly accessible in 1995. As noted above, a request for rehearing is not an opportunity to present new arguments. Regardless, even accepting Petitioner's new evidence that the 24th printing in 2010 is the same as the

1st printing in 1995, this new evidence provide no further proof that Stevens2 qualifies as a printed publication publicly accessible prior to the '948 patent.

Thus, even considering Petitioner's new arguments and evidence (Exs. 1095 and 1096), we still find the evidence of record insufficient to demonstrate a reasonable likelihood that Stevens2 qualifies as a printed publication prior art reference.

We have considered Petitioner's remaining arguments presented in the Request for Rehearing and likewise conclude that they are unpersuasive of error.

In conclusion, we grant Petitioner's request only to the extent we recognize the Stansbury Declaration as a sworn affidavit compliant with our rules. Otherwise, we deny Petitioner's Request for Rehearing. Specifically, we determine that the Request for Rehearing does not demonstrate that the Board misapprehended or overlooked any matters raised in the Petition by declining to institute the requested review of the '948 patent. More specifically, we determined the Petition failed to establish a reasonable likelihood that Stevens2 is a prior art printed publication.

ORDER

Accordingly, it is:

ORDERED that we *grant* Petitioner's Request for Rehearing to the extent that we modify our Decision to recognize the Stansbury Declaration (Ex. 1063) is a sworn affidavit compliant with our rules; and

FURTHER ORDERED that we otherwise *deny* Petitioner's Request for Rehearing.

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