

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SILICON LABORATORIES, INC.,
Petitioner,

v.

CRESTA TECHNOLOGY CORPORATION,
Patent Owner.

Case IPR2014-00809
Patent 7,265,792 B2

Before PHILLIP J. KAUFFMAN, GREGG I. ANDERSON, and
PATRICK M. BOUCHER, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

DECISION
Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

On May 23, 2014, Silicon Laboratories, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) seeking *inter partes* review of claims 1–17, 26, and 27 of US Patent No. 7,265,792 B2 (“the ’792 patent”). In our Decision dated October 24, 2014 (Paper 10, “Dec.”), we instituted review of claims 1, 2, and 4–17, but did not institute review of claims 3, 26, and 27. Petitioner now requests rehearing of our decision not to institute review of claims 3, 26, and 27. Paper 16 (“Req. Reh’g”).

When rehearing a decision on petition, a panel reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). Further, 37 C.F.R. § 42.71(d), provides in relevant part:

A party dissatisfied with a decision may file a request for rehearing, without prior authorization from the Board. 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.

II. ANALYSIS

Petitioner argues that in not instituting review of claims 26 and 27, we misapprehended its obviousness argument based on the combination of

Thomson, Harris, and Balaban.¹ Req. Reh’g. 3. Petitioner argues we should reconsider our refusal to institute review of claim 3 because we abused our discretion. *Id.* at 4.

A. *Claims 26 and 27*

Claim 26, which depends from claim 1, recites, *inter alia*, “a format/standard selection circuit coupled to the signal processor, the format/standard selection circuit generating a select signal indicative of a format of said input RF signal.” Claim 27 depends from claim 26.

As Petitioner notes, its Petition included a ground challenging claim 26 as obvious over Thomson and Harris that contended Thomson “inherently” discloses a “standard selection circuit.” Req. Reh’g. 5; *see* Pet. 25–26. We determined that “Petitioner’s argument and evidence rely on Thomson in combination with Scarpa or Balaban.” *See* Ex. 1009 ¶ 35. The additional statement by Petitioner’s declarant, Dr. Holberg, that “[i]n my opinion, Thomson teaches this element” (Ex. 1009 ¶ 35) is both conclusory and at odds with one of his prior statements. Dec. 26; *see* Req. Reh’g. 6. Accordingly, we concluded that Petitioner did not demonstrate a reasonable likelihood of prevailing on the challenge based on Thomson and Harris. Dec. 26. While it acknowledges precisely what we decided, the Request for

¹ Petitioner has concurrently requested rehearing in IPR2014-00728 on claims 13 and 14. Req. Reh’g. 3. Petitioner notes that claims 26 and 27 are mirror images of claims 13 and 14 and present “essentially the same issue.” *Id.*

Rehearing does not contend the basis for our decision on this ground was a mistake or otherwise forms a basis for rehearing.

Petitioner next addresses its ground asserting claims 26 and 27 would have been obvious over Thomson, Harris, and Balaban. Req. Reh'g. 6–9. Claim 27 recites “the format/standard selection circuit generates the select signal in response to an input signal from a user.” The argument in the Petition concerning the challenge does not specifically mention claim 26 in connection with this ground. *See* Pet. 48–49. Neither is claim 26 mentioned by Dr. Holberg in his discussion of this ground. Ex. 1009 ¶¶ 69–70. Accordingly, in our analysis of this ground, we determined that Petitioner’s challenge including Balaban was *only* directed to claim 27. Dec. 26. We declined to institute on the proposed ground because Petitioner had failed to meet its burden with respect to claim 26, from which claim 27 depends. Dec. 26–27.

In its Request for Rehearing, Petitioner does not allege we were mistaken in concluding that Balaban was asserted only in connection with the challenge to claim 27. To the extent Petitioner’s argument implies a mistake was made and Balaban was directed to claim 26, the argument was either not made in the Petition or was so unclear that it failed to “specify where each element of the claim is found in the prior art patents or printed publications relied upon.” Dec. 27 (citing 37 C.F.R. § 42.104(b)(4)). In either event, there is insufficient basis presented for granting rehearing.

B. Claim 3

Petitioner asserts we abused our discretion in not instituting on claim 3. Req. Reh’g. 4. Claim 3, which depends from claim 1, recites “wherein the television receiver is formed as a monolithic integrated circuit.” Petitioner cites to Gunter (Ex. 1022), along with Thomson and Harris for the claim 1 limitations, as expressly teaching the recited limitation of claim 3. *Id.* at 11 (citing Ex. 1022, 3:50–55). We agree with Petitioner’s characterization of what Gunter discloses. However, both the Petition and Dr. Holberg’s Declaration cited to Exhibit 1021 (Arambepola) and not to Exhibit 1022 (Gunter). Arambepola, which also teaches monolithic integrated circuits (Ex. 1021, 4:2–5), was not asserted as part of any challenge to the ’792 patent. Pet. 4–6. Petitioner acknowledges the citation was wrong and asserts that it resulted from a typographical error that was not discovered until after the Decision was filed. Req. Reh’g. 11–12.

An abuse of discretion occurs when a “decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus. Inc. v. Celanese Polymer Specialties Co. Inc.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988). Our decision was based on Petitioner’s mistake, not on any error in law or fact by the Board. Nothing in this record supports Petitioner’s claim that we abused our discretion.

Petitioner seeks to correct its own mistake through the Request for Rehearing. There is no authority under our rules for using the request for rehearing process to correct a party’s mistake. *Microsoft Corp. v. VirnetX*

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Inc., IPR2014-00614, Paper No. 12 at 3 (Oct. 30, 2014), cited by Petitioner (Req. Reh'g. 4), does not support a contrary view. In *Microsoft*, the Board used a request for rehearing to correct its own mistake in instituting on certain claims on obviousness grounds but not on anticipation grounds. *Microsoft*, at 2.

Facebook, Inc. et al. v. Software Rights Archive, LLC, IPR2013-00478, Paper 31 at 3–4 (Apr. 14, 2014), did involve a typographical error by the Petitioner in omitting claim 32 from a heading. However, claim 32 was discussed in the body of the Petition and *inter partes* review was instituted on claim 32. Claim 32 was not identified in the Order portion of the Decision to Institute, which mistake the Board corrected. *Id.*

Both *Microsoft* and *Facebook* involve correction of errors made by the Board. The error in *Facebook* appears to have had its genesis in the first instance from a mistake by Petitioner, but the error did not result in a substantive change in result and was ministerial. The mistake made here is not correctable by a request for rehearing.

We determine that the proper course of conduct for correction in this instance is a motion to correct the Petition under 37 C.F.R. § 42.104(c) that includes a request to modify the Decision to Institute based on the corrected Petition. *See* 37 C.F.R. § 42.5(a). If Petitioner files a motion under 37 C.F.R. § 42.104(c), Patent Owner will be afforded an opportunity to respond.

III. ORDER

IT IS THEREFORE ORDERED, Petitioner's Request for Rehearing as to claims 3, 26, and 27 is denied;

FURTHER ORDERED, within five business days² of the date of this order, Petitioner is authorized to file a motion, not to exceed five (5) pages in length, to correct the Petition under 37 C.F.R. § 42.104(c) as described *supra*, which corrected Petition is expressly limited to the typographical error concerning claim 3, including the Declaration of Dr. Holberg, all as identified in the Request for Rehearing (Paper 16);

FURTHER ORDERED, the motion to correct may include a request to modify the Decision to Institute based on the corrected Petition under 37 C.F.R. § 42.5(a);

and

FURTHER ORDERED, within five business days of the filing of Petitioner's motion to correct, Patent Owner may file a response, again not to exceed five (5) pages in length, to the motion to correct.

² Exclusive of weekends and U.S. government recognized holidays.

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