

## PTAB Probes Broadcom On Whether New Claims Pass Muster

By **Britain Eakin**

*Law360 (August 19, 2020, 9:39 PM EDT)* -- A Patent Trial and Appeal Board judge expressed discomfort Wednesday with amendments Broadcom Corp. wants to make to claims in a video decoding patent, suggesting that a new claim doesn't appear to meet all the legal requirements for substitute claims.

The issue is whether that claim responds to challenger Renesas Electronics Corp.'s invalidity argument, which would be required for an amended claim to pass muster. Broadcom argued that it does so indirectly because of its dependency on another proposed amended claim, 15, which the company argued responds to one of Renesas' invalidity theories.

But Administrative Patent Judge Patrick M. Boucher called that position "very sweeping," adding that he has "some discomfort with it."

"So your position then, is that as long as the amendment to Claim 15 responded to a ground of unpatentability, you have license to make any amendment whatsoever to claims that depend from it without restriction?" Judge Boucher asked.

Broadcom attorney Katherine D. Cappaert of Steptoe & Johnson said she wouldn't go that far, but told the board that it has, in some instances, allowed similar amendments. Here, she said since Claim 15 was amended to overcome prior art, the dependent claim should also pass muster because they are tied together.

"It is through its dependency on Claim 15 that it relates to a ground of unpatentability ... Claim 15 has been narrowed to overcome the prior art," Cappaert said. "The amendments to Claim 16 relate."

In case filings, Renesas argued that Broadcom is trying to broaden the scope of the claims to "remedy its failed infringement case" at the International Trade Commission, an allegation that Broadcom denied during Wednesday's remote hearing.

The ITC launched an investigation in June 2018 into imports of certain vehicle infotainment systems after Broadcom accused Toyota, Panasonic and other Japanese companies — including Renesas — of infringing six of its patents.

But the commission cleared the companies in November after finding there was no violation of the Tariff Act of 1930.

Renesas meanwhile contends that the proposed amended claims are invalid not only in light of prior art, but also because they lack written description support, which requires patent owners to show possession of the claimed invention. Renesas attorney Shouvik Biswas of Morrison & Foerster LLP told the board that was the case here because a skilled artisan "wouldn't understand that an inventor invented what is claimed in Claim 15."

Renesas argued that Broadcom added impermissible new material to the amended claims that is not supported by the patent's written description. But Broadcom contends that both Renesas and the PTAB are applying a higher written-description standard that doesn't apply to negative limitations, or the claimed absence of an element — in this case the exclusion of programmable processors.

Broadcom sought to amend the claims as part of the PTAB's pilot amendment program that allows patent owners to get feedback from the board on the proposed substitute claims, after which they can submit a revised motion to amend.

The patent-in-suit is U.S. Patent No. 8,284,844 B2.

Renesas is represented by Shouvik Biswas of Morrison & Foerster LLP.

Broadcom is represented by Katherine D. Cappaert of Steptoe & Johnson LLP.

The case is Renesas Electronics Corp. v. Broadcom Corp., case number IPR2019-01040, before the Patent Trial and Appeal Board.

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