

Inconsistent PTAB Findings Lead to Error

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The US Court of Appeals for the Federal Circuit affirmed in part, vacated in part and remanded the decisions in two re-examinations after finding that they contained inconsistent holdings on identical issues on essentially the same record. While finding error in this case, the Court emphasized that error does not necessarily exist when an agency reaches inconsistent outcomes in similar and related cases. *Vicor Corp. v. SynQor, Inc.*, Case Nos. 16-2283; -2288 (Fed. Cir., Aug. 30, 2017) (Chen, J).

Vicor requested *inter partes* re-examinations of two SynQor patents: US Patent Nos. 8,023,290 ('290 patent) and 7,272,021 ('021 patent). Both patents are directed to a DC-DC power converter system that uses a two-stage architecture to separate the isolation and regulation functionality of DC-DC converters into two steps, and uses a single isolation stage to drive multiple regulation stages. According to SynQor, this two-stage architecture ultimately came to be known as Intermediate Bus Architecture.

Both requests for re-examination were granted. Ultimately, the PTAB found that all disputed claims in the '290 patent were patentable and all disputed claims in the '021 patent were unpatentable.

Regarding the '290 patent, *inter partes* re-examination was originally granted based on five separate obviousness grounds. During the proceeding, the Examiner found that rejections for two of the grounds urged were improper because the two cited references could not be combined because of frequency incompatibilities between the circuits disclosed in each of the references. The Examiner withdrew two other rejections based on secondary considerations of non-obviousness and found there was no motivation to combine the references cited in two other rejections. The PTAB affirmed the Examiner's findings.

With respect the '021 patent re-examination, the PTAB reached opposite conclusions despite reliance on the same objective evidence and references. The PTAB found that the objective evidence was related to the claimed features that were known in the art, and therefore was insufficient to outweigh the obviousness finding. Regarding the obviousness rejections over the same references involved in the '290 patent re-examination, the PTAB held that the references could be combined despite statements on the record discouraging the combination.

Vicor appealed the PTAB's decision in the '290 re-examination, and SynQor appealed the PTAB's decision in the '021 re-examination.

On appeal, the Federal Circuit found the PTAB's treatment of proposed rejections in the '290 patent re-examination to be erroneous for two reasons. First, by relying solely on the objective evidence, the PTAB ignored three of the four *Graham* factors when conducting the obviousness analysis. According to the Federal Circuit, that legal error was underscored by the opinion issued on the same day in the '021 patent reexamination, where the PTAB considered all four *Graham* factors in analyzing the obviousness issues.

Second, the PTAB reached inconsistent conclusions with respect to the evidentiary weight of the same objective evidence presented in the two re-examinations, without providing any explanation to justify the inconsistency. The Court also found direct conflict between the PTAB's analyses in the two re-examinations as to whether the same two references can be combined. The Court faulted the PTAB for not providing any reasoned explanation for the inconsistent results.

Noting that it is not always erroneous when an agency reaches opposite findings in related cases, the Federal Circuit found that "under the circumstances here, where a panel simultaneously issues opinions on the technical issue between the same parties on the same record, and reaches opposite results without explanation, we think the best course is to vacate and remand these findings for further consideration."

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