VICOR CORPORATION v. SYNQOR, INC., Appeal Nos. 2016-2283, 2288 (Fed. Cir. August 30, 2017). Before Lourie, Taranto, and Chen. Appealed from PTAB.

Background:

SynQor owned several patents directed to a particular architecture for DC-DC power converters, including U.S. Patent Nos. 8,023,290 and 7,272,021, which were the subject of *inter partes* reexaminations initiated by Vicor. The claims of both patents were directed to a two-stage Intermediate Bus Architecture (IBA) that used a single isolation stage to drive multiple regulation stages. Both reexaminations were heard by the same panel and decided on the same date. The Board found certain claims of the '290 patent patentable over prior art combinations proposed by Vicor and certain claims of the '021 patent unpatentable as anticipated or obvious. Vicor appealed the decision in the reexamination of the '290 patent and SynQor appealed the decision in the reexamination of the '021 patent.

Issue/Holding:

Did the Board err in reaching its conclusions in the reexaminations? Yes, affirmed-in-part, vacated-in-part, and remanded.

Discussion:

The Federal Circuit found that despite sharing a common panel and having opinions issued on the same date, the decisions in the respective reexaminations contained inconsistent findings on identical issues and on essentially the same record. In reaching this conclusion, the Federal Circuit relied heavily on its previous decision (*SynQor II*) involving another SynQor patent with similar claims facing similar issues on appeal from another decision by the Board in a separate *inter partes* reexamination. In *SynQor II*, the Federal Circuit found the claims anticipated over a prior art embodiment of a power converting system having a non-regulating isolation stage and a plurality of non-isolating regulation stages.

The Federal Circuit found that the Board reached inconsistent conclusions on several rejections issued by the examiner in the reexaminations of the '290 patent and the '021 patent. For example, in the reexamination of the '290 patent, the Board found the objective evidence of secondary considerations presented by SynQor to be so persuasive that it approved of the examiner's decision to withdraw rejections without analyzing all of the *Graham* factors and without considering the *SynQor II* holding that claims covering the IBA's basic concept were anticipated. In contrast, in the reexamination of the '021 patent, the Board determined that the same objective evidence principally related to features of the claims that were found to be anticipated in *SynQor II* and, therefore, found that there was no nexus between the objective evidence and the claims of the '021 patent.

The Federal Circuit also found inconsistency in the Board's finding in the reexamination of the '290 patent that it would not have been obvious to use a secondary reference's switching regulator for a primary reference's regulation stage, in view of an opposite conclusion reached in the reexamination of the '021 patent on the same record. The Federal Circuit emphasized that evidence relating to all four *Graham* factors—including objective evidence of secondary considerations—must be considered before determining obviousness.

Thus, the Federal Circuit vacated and remanded the Board's findings that relied on its analysis of the secondary considerations.