

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SEMICONDUCTOR COMPONENTS INDUSTRIES, LLC
(d/b/a ON SEMICONDUCTOR),
Petitioner,

v.

POWER INTEGRATIONS, INC.,
Patent Owner.

Case IPR2016-01600
Patent 7,834,605 B2

Before THOMAS L. GIANNETTI, BRIAN J. McNAMARA, and
LYNNE E. PETTIGREW, *Administrative Patent Judges*.

PETTIGREW, *Administrative Patent Judge*.

ORDER

Conduct of the Proceeding
37 C.F.R. §§ 42.5, 42.121

On March 30, 2017, a conference call was held among respective counsel for the parties and Judges McNamara and Pettigrew. Patent Owner requested the call to fulfill its requirement under 37 C.F.R. § 42.121(a) to

confer with the Board prior to filing a motion to amend the claims of U.S. Patent No. 7,834,605 (“the ’605 patent”). A court reporter was present on the call. Petitioner will arrange for the filing of a transcript.

On the call, we provided the parties with guidance as to the mechanics and substance of a motion to amend. The following information was discussed during the conference or is provided to clarify the requirements of the motion to amend.

A motion to amend may cancel claims or may be contingent on a determination that original claims are unpatentable. The motion to amend should make clear whether it is contingent. A proposed substitute claim should be responsive to the ground of unpatentability applicable to the original patent claim for which it is a substitute, and may not enlarge the scope of the claim or introduce new matter. 37 C.F.R. § 42.121(a)(2). The presumption is that only one substitute claim is needed for each challenged claim. *Id.* § 42.121(a)(3).

A claim listing is required by 37 C.F.R. § 42.121(b). Patent Owner must reproduce each proposed substitute claim in the claim listing and may append the claim listing to the motion. For each proposed substitute claim, the motion must show the changes of the proposed substitute claim with respect to the patent claim that it is intended to replace. Each proposed substitute claim should have a new claim number. The ’605 patent issued with 12 claims. Thus, new claim numbers starting with claim 13 should be used.

Dependent claims that are not amended will continue to have the same scope as before the amendment. If Patent Owner wants to amend a challenged dependent claim to depend from a proposed substitute claim

rather than the original claim, Patent Owner must propose another substitute claim that changes the dependency of that claim.

Patent Owner represented on the call that it does not plan to argue in a Patent Owner Response the patentability of the challenged claims at issue in this proceeding (claims 1, 2, 5, and 9). Patent Owner also represented that it plans to propose a substitute claim to replace independent claim 1. This claim should be numbered claim 13. Patent Owner further represented that it would like to propose substitute claims for dependent claims 2, 5, and 9 that depend from the replacement for claim 1. These claims may be numbered, for example, claims 14–16 and may be drafted in dependent form to depend directly or indirectly from claim 13.

In the motion to amend, Patent Owner must show patentability over the prior art that is relevant to the substitute claims, including prior art of record and prior art known to Patent Owner, which may include references beyond those applied by Petitioner against the original claims. Patent Owner also must show that the proposed claims comply with the written description, enablement, and definiteness requirements of 35 U.S.C. § 112. For written description support, citation should be made to the original disclosure of the application as filed (and any earlier priority application) rather than to the patent as issued. Patent Owner must show written description support for the entire proposed substitute claim, not just the feature added by the proposed substitute claim.

Patent Owner also should propose a claim construction, with supporting evidence, for any new term used in a proposed substitute claim where Patent Owner reasonably anticipates a dispute as to the meaning of such term.

ORDER

Accordingly, it is:

ORDERED that Patent Owner has satisfied the requirement to confer with the Board pursuant to 37 C.F.R. § 42.121(a); and

FURTHER ORDERED that the parties should direct their attention to the following for guidance regarding the mechanics and substance of the motion to amend:

- *Idle Free Sys., Inc. v. Bergstrom*, Case IPR2012-00027 (PTAB June 11, 2013) (Paper 26) (setting forth considerations the Board typically makes when considering the motion);
- *MasterImage 3D, Inc. v. RealD Inc.*, Case IPR2015-00040 (PTAB July 15, 2015) (Paper 42) (precedential) (clarifying the scope of prior art to be addressed in the motion);
- *Shinn Fu Co. v. The Tire Hanger Corp.*, IPR2015-00208 (PTAB Apr. 22, 2016) (Paper 24) (granting motion to amend);
- *Global Tel*Link Corp. v. Securus Techs., Inc.*, IPR2015-01225 (PTAB Dec. 14, 2016) (Paper 45) (granting-in-part motion to amend);
and
- *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,766–67 (Aug. 14, 2012) (Section II.G Motions to Amend).

IPR2016-01600
Patent 7,834,605 B2

PETITIONER:

Roger Fulghum

Brian W. Oaks

Brett J. Thompsen

BAKER BOTTS L.L.P.

roger.fulghum@bakerbotts.com

brian.oaks@bakerbotts.com

brett.thompsen@bakerbotts.com

PATENT OWNER:

Stephen R. Schaefer

Neil A. Warren

FISH & RICHARDSON P.C.

schaefer@fr.com

warren@fr.com