

Opposition to PO's Motion to Amend
Case IPR2016-01600
U.S. Patent No. 7,834,605

IN THE 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

**PETITIONER'S OPPOSITION TO PATENT OWNER'S
MOTION TO AMEND**

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I. INTRODUCTION

Power Integrations, Inc. (“PO”) has submitted a Motion to Amend (“MTA”) under 37 C.F.R. § 42.121. In the MTA, PO requests that the Board cancel claims 1, 2, 5, and 9—every claim in this proceeding—and substitute them with proposed substitute claims 13, 14, 15, and 16. MTA at 1. PO clearly states that the MTA “is not contingent on a determination that the original claims are unpatentable.” *Id.* For the reasons discussed below, Petitioner requests that the Board deny the MTA as moot with respect to the cancellation and proposed substitution of claims 1 and 2, grant the MTA with respect to the cancellation of claims 5 and 9, and deny the MTA with respect to the proposed substitution of claims 13-16.

First, the Federal Circuit has already held claims 1 and 2 to be invalid in a final, unappealable decision. Thus, these invalidated claims no longer exist and are no longer subject to this proceeding. For this reason alone, the Board should deny the MTA as moot with respect to the cancellation and proposed substitution of claims 1 and 2.

Second, PO proposes an unreasonable number of substitute claims. As noted above, claims 1 and 2 have been found invalid and thus are no longer subject to this proceeding. By requesting cancellation of the two remaining claims (i.e., claims 5 and 9) and proposing to substitute four claims (i.e., claims 13-16), PO has

proposed to add more new claims than it is able to cancel. The PO did not 1) confer with the Board regarding its intent to propose more than one substitute claim for each challenged claim still pending in this proceeding; or 2) point to any special circumstance that would demonstrate the need for more than one substitute claim for each challenged claim. Thus, the Board should deny the MTA with respect to the proposed substitution of claims 13-16 because PO has failed to rebut the presumption that only one substitute claim would be needed to replace each challenged claim.

Third, PO has failed to provide a claim construction of certain new claim terms sufficient to support the distinction of the proposed substitute claims over the prior art. PO proposes the addition of the claim term “first state” without proposing a claim construction that makes clear whether the PO intends this term to have the same or different meaning than “on time of the switch.” PO also proposes the addition of the claim term, “during at least a portion of the first state,” without proposing a claim construction that makes clear whether the PO intends this term to have the same or different meaning than the already-recited “during the on time of the switch” claim term. Thus, even in the event the Board determines it is appropriate to propose a substitute claim for a canceled claim, the Board should deny the MTA with respect to the substitution of claims 13-16 because the lack of claim construction proposals renders the motion defective.

Fourth, PO has failed to establish that the proposed amendment, including each limitation as well as the amendment as a whole, is supported by the original disclosure of the patent. The patent application contains no mention of “control signal cycles each having a first state and a second state” or “the variable current limit threshold increases during at least a portion of the first state.” More specifically, the patent application does not disclose a control signal having cycles and does not disclose that the control signal includes “states.” Even if the “first state” of the control signal cycle can be supported by the disclosure of an “on time of the switch,” the patent application does not disclose the intrinsic current limit threshold increasing for anything less than the entire on time. Thus, even in the event the Board determines it is appropriate to propose a substitute claim for an invalidated claim, the Board should deny the MTA with respect to the substitution of claims 13-16 because the amendment seeks to introduce new subject matter.

Finally, even if the Board determines that the original disclosure, including an “on time of the switch” supports a control signal having a “first state” and a “second state,” PO proposes substitute claim 13 that includes limitations that broaden the scope of challenged (and now invalidated) claim 1. Proposed substitute claim 13 includes a limitation reciting a generic “first state,” which is facially broader than a limitation of original claim 1 and proposed substitute claim 13 specifically requiring an “on time of the switch.” Proposed substitute claim 13

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