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 No. 7,834,605

PATENT OWNER POWER INTEGRATIONS, INC.'S REPLY TO PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO AMEND

TABLE OF CONTENTS

UPDATED EXHIBIT LIST

Exhibit No.	Description
PI 2001	Copy of Agreement and Plan of Merger as between Fairchild and ON Semiconductor filed with the SEC
PI 2002	Press release related to merger between Fairchild and ON Semiconductor
PI 2003	*Power Integrations, Inc., v. Fairchild Semiconductor International, Inc. et al.*, Case No. 08-309-LPS (D. Del.), Dkt. No. 401
PI 2004	RESERVED
PI 2005	Article about completion of merger between ON Semiconductor and Fairchild
PI 2006	*Power Integrations, Inc., v. Fairchild Semiconductor International, Inc. et al.*, Case No. 08-309-LPS (D. Del.), Dkt. No. 731
PI 2007	Confidentiality Agreement, dated September 14, 2015
PI 2008	"XYZs of Oscilloscopes," Tektronix, Inc., © 2000
PI 2009	"Oscilloscope Fundamentals," Tektronix, Inc., © 2009
PI 2010	Declaration of Arthur W. Kelley
PI 2011	U.S. Provisional Patent Application No. 60/325,642
PI 2012	File History for U.S. Patent No. 7,834,605
PI 2013	U.S. Patent No. 5,028,861 ("Pace")
PI 2014	U.S. Patent No. 5,680,034 ("Redl")
PI 2015	Reserved
PI 2016	Resume of Arthur W. Kelley, Ph.D.
PI 2017	Declaration of Howard G. Pollack in Support of Admission Pro Hac Vice
PI 2018	AN-5841 Application Note

I. INTRODUCTION

Most notable about Petitioner's opposition is that which is absent. First, Petitioner does not dispute that the proposed amendments distinguish all prior art of record. Second, Petitioner has provided *no evidence* to support any of its arguments regarding the claims or the claim scope as understood by a person of ordinary skill in the art. Petitioner offers no rebuttal testimony that contradicts anything Patent Owner's expert, Dr. Arthur Kelley, has testified to in this proceeding. Moreover, Petitioner chose not to cross-examine Dr. Kelley regarding his testimony. Thus, Dr. Kelley's testimony regarding the understanding of a person of ordinary skill in the art and the amended claim scope stands unrebutted. Absent actual evidence – the unsupported attorney argument Petitioner offers is not evidence – there is no basis to dispute Dr. Kelley's opinions.

As shown below, Petitioner's attorney argument also has no legal merit, makes little logical sense, and is not supported by admissible evidence. Patent Owner thus respectfully requests that its motion to amend be granted.

II. 35 U.S.C. § 316(d) ENTITLES PATENT OWNER TO CANCEL "ANY" CHALLENGED CLAIM AND THE BOARD ALREADY HELD THAT CLAIMS 1 AND 2 ARE "CHALLENGED CLAIMS AT ISSUE IN THIS PROCEEDING"

There is no legal basis for Petitioner's suggestion that claims 1 and 2 of the '605 patent "no longer exist and are no longer subject to this proceeding." Paper 18 at 1. In fact, Petitioner's argument is directly contradicted by the Board's finding

on March 31, 2017 that claims 1 and 2 are "challenged claims at issue in this proceeding." Paper 14 at 3. The procedural posture is the same now as on March 31st when the Board's ruling issued given that the Federal Circuit's opinion became final on March 12, 2017 after Patent Owner's time to seek *certiorari* expired. *See* Paper 18 at 4. Thus, Petitioner's arguments alleging Patent Owner cannot cancel claims 1 and 2 have no legal merit and, absent that argument, there is no reason that the substitution of claims 13 and 14 is unreasonable.

Under 35 U.S.C. § 316(d), Patent Owner is statutorily entitled to cancel "***any*** challenged patent claim," including claims 1 and 2:

> (1) In general.—During an inter partes review instituted under this chapter, the patent owner may file 1 motion to amend the patent in 1 or more of the following ways:
>
> (A) Cancel any challenged patent claim.
>
> (B) For each challenged claim, propose a reasonable number of substitute claims.

35 U.S.C. § 316(d). The statutory language of § 316(d)(1)(A) affirmatively allows for cancelation of "***any*** challenged patent claim," and nothing in the statutory language suggests that claims that were found invalid by a court are *per se* unavailable for amendment.

The Board's Order, Paper 14, confirms that claims 1 and 2 are presently challenged and are still at issue in this proceeding. That is, after the Board

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