

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 IPR2016-01589 (Patent 6,249,876 B1)
Case IPR2016-01600 (Patent 7,834,605 B2)¹

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

McNAMARA, *Administrative Patent Judge*.

ORDER AUTHORIZING ADDITIONAL BRIEFING
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ This Order addresses issues that are the same in all identified cases. We exercise our discretion to issue one Order to be filed in each case. The parties, however, are not authorized to use this style heading in subsequent papers.

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Case IPR2016-01600 (Patent 7,834,605 B2)

In IPR2016-01589 (“the 1589 IPR”), on May 15, 2017, Patent Owner filed a contingent Motion to Amend. Paper 21. In IPR2016-01600 (“the 1600 IPR”), on May 15, 2017, Patent Owner filed a Motion to Amend. Paper 16. In each proceeding Petitioner filed an Opposition to Patent Owner’s Motion to Amend (Paper 32 in the 1589 IPR, Paper 18 in the 1600 IPR). In each proceeding Patent Owner filed a Reply to Petitioner’s Opposition to Patent Owner’s Motion to Amend (Paper 34 in the 1589 IPR, Paper 21 in the 1600 IPR). All briefing was completed September 18, 2017. Oral hearing is scheduled for November 15, 2017.

On October 4, 2017 the U.S. Court of Appeals for the Federal Circuit issued an *en banc* decision in *Aqua Products v. Matal*, No. 2015-1177, 2017 WL 4399000, at *1 (Fed. Cir. Oct. 4, 2017), in which it instructed that in all pending IPRs, the Board “assess[] the patentability of proposed substitute claims without placing the burden of persuasion on the patent owner.”

On October 16, 2017, by email, Petitioner contacted the Board and requested a conference to discuss the impact of *Aqua Products* on the pending motions to amend. On October 18, 2017, in response to Petitioner’s October 16, 2017 e-mail request, we conducted a teleconference with the parties during which we heard their views on additional briefing on the motions in light of the *Aqua Products* decision. As a result of that conference, we authorize Petitioner to file a Supplemental Brief not to exceed 10 pages by October 25, 2017. Patent Owner is authorized to file a Response to Petitioner’s Supplemental Brief not to exceed 10 pages by November 1, 2017. As discussed during the conference, the briefs may not

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introduce new evidence or include additional declarations.

In consideration of the above it is

ORDERED that Petitioner is authorized to file a Supplemental Brief on the pending motions to amend, not to exceed 10 pages, by October 25, 2017;

FURTHER ORDERED that Patent Owner is authorized to file a Response to Petitioner's Supplemental Brief, not to exceed 10 pages, by November 1, 2017; and

FURTHER ORDERED that the briefs authorized herein may not introduce new evidence or declarations.

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FOR PETITIONER:

Roger Fulghum
Brett Thompsen
Brian Oaks
BAKER BOTTS L.L.P.
roger.fulghum@bakerbotts.com
brett.thompsen@bakerbotts.com
brian.oaks@bakerbotts.com

FOR PATENT OWNER:

John Phillips
Neil Warren
Howard Pollack
Stephen Schaefer
FISH & RICHARDSON P.C.
phillips@fr.com
warren@fr.com
pollack@fr.com
schaefer@fr.com