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'S REPLY TO PETITIONER'S SUPPLEMENTAL RESPONSE TO PATENT OWNER'S MOTION TO AMEND

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TABLE OF CONTENTS

I. PETITIONER'S PROPOSED CLAIM CONSTRUCTION IS NOT REQUIRED AS A MATTER OF LAW AND IS NOT HELPFUL IN RESOLVING THE ISSUES BEFORE THE BOARD 1

II. SUBSTITUTE CLAIMS 13-16 DO NOT INCLUDE NEW MATTER 1

III. THE AMENDMENT DOES NOT BROADEN THE CLAIMS 8

IV. PETITIONER'S FINAL ARGUMENT LACKS EVIDENTIARY SUPPORT AND SHOULD BE REJECTED 10

V. CONCLUSION...10

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The issue before the Board is the patentability of the amended claims, and in particular, whether the amendments enlarge the scope of the claims or introduce new matter. *See* 35 U.S.C. § 316(d). Under 35 U.S.C. § 316(e), Petitioner is required to prove all propositions of unpatentability, including for amended claims. *Aqua Prod., Inc. v. Matal*, 872 F.3d 1290, 1296 (Fed. Cir. 2017) (*en banc*). The arguments in Petitioner's Supplemental Response (Paper 29) should be rejected.

I. PETITIONER'S PROPOSED CLAIM CONSTRUCTION IS NOT REQUIRED AS A MATTER OF LAW AND IS NOT HELPFUL IN RESOLVING THE ISSUES BEFORE THE BOARD

The term "first state" has a well-understood plain and ordinary meaning and does not require special construction. (Ex. 2010 at ¶ 49.) That said, Patent Owner has never disputed that, in the preferred embodiment, the period of the "first state" of the control signal corresponds to the "on time of the switch." Thus, while Patent Owner contends it is not proper as a matter of law to limit the new "first state" claim element to the scope of the original "on time of the switch" language, any difference is not material to the arguments presented regarding the alleged inclusion of new matter and/or the broadening the claims.

II. SUBSTITUTE CLAIMS 13-16 DO NOT INCLUDE NEW MATTER

Even accepting Petitioner's proposed claim construction, *arguendo*, the amendment to new claim 13 does not introduce new matter. Petitioner alleges that the original '642 Application discloses a variable current limit threshold that

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increases during *the entire* on time of the switch, and therefore supposedly a claim drawn to "a variable current limit threshold that increases *for less than* the entire on time of the switch" recites new matter. (Paper 29 at 5 (emphasis in original).) This argument is legally erroneous and misstates what is claimed.

First, contrary to Petitioner's arguments, the new element is not limited to a "threshold that increases *for less than* the entire on time of the switch." (*Id.*) Rather, the amended language requires that the variable current limit threshold increases "during ***at least*** a portion" of the first state of the control signal. This language expressly covers a threshold that increases during the entire period of the first state, just as Petitioner concedes is disclosed in the '642 Application. Petitioner's arguments fail for several additional reasons as well.

Whether a claim element includes new matter turns on the written description inquiry and is a question of fact queried through the eyes of a person of ordinary skill in the art. *Vas-Cath Inc. v. Mahurkar,* 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). The requirement is intended to ensure that the patent applicant had possession of the claimed subject matter at the time he filed his application. *In re Wertheim*, 541 F.2d 257, 262 (CCPA 1976). The manner in which the specification meets the requirement is not material; the requirement may be met by either an express or an implicit disclosure. *Id.* Important here, "[t]he primary consideration

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is factual and depends on the nature of the invention and the amount of knowledge imparted to those skilled in the art by the disclosure." *Id.*

Based on the law, the issue here is: would ***a person of ordinary skill art*** at the time of invention recognize that the '605 patent inventor had possession of a "variable current limit threshold [that] increases during at least a portion of the first state of each control signal cycle"? Petitioner bears the burden of proof under *Aqua Products* to demonstrate that a skilled artisan would answer "no" to this question. Yet, Petitioner has introduced ***no evidence*** to suggest that a person of ordinary skill in art (rather than Petitioner's attorneys) would draw the conclusion Petitioner argues for here. Petitioner could have, but chose not to, introduce its own expert testimony, or other evidence, to support its positions. Petitioner did not even cross-examine Patent Owner's expert. Having failed to introduce any evidence at all (or to attempt to impugn Patent Owner's proffered evidence), under *Aqua Products*, the absence of evidence alone compels a finding that Petitioner cannot meet its burden to demonstrate the unpatentability of the claims.

Patent Owner, on the other hand, has presented evidence in the form of expert testimony from Dr. Kelley, demonstrating the proper meaning of the amended limitation, the level of ordinary skill in this field, and that a person of ordinary skill in the art would find sufficient support in the '642 Application for the amended claims. (Paper 16 at 10-13; Ex. 2010 at ¶¶ 63-65.) There is no

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