

Filed on behalf of: Nichia Corp.

Paper \_\_\_\_\_

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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VIZIO, INC.,  
Petitioner,

v.

NICHIA CORPORATION,  
Patent Owner.

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Case IPR2018-00437  
Patent 9,537,071

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**REPLY TO PETITIONER'S OPPOSITION TO PATENT OWNER'S  
CONTINGENT MOTION TO AMEND CLAIMS**

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Petitioner's opposition fails to provide any basis that would warrant denial of Patent Owner's contingent motion to amend.

**I. The Proposed Claims Have § 112 Written Description Support**

**Claims 27, 28:** Petitioner's argument is that the patent's fifth embodiment requires devices having two leads and an additional, non-lead third metal structure. Op. at 2. That is wrong. Ex. 2030, §VI(A), (B).

To support its argument, Petitioner has to rely on extrinsic evidence (lab notebooks and draft patent drawings) not part of the specification and thus not part of the § 112 analysis. Op. at 3-4. It is black letter law that the § 112 inquiry is an "objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art." *Streck, Inc. v. Research & Diagnostic Sys.*, 665 F.3d 1269, 1285 (Fed. Cir. 2012); *Trading Techs. Int'l, Inc. v. Open E Cry, LLC*, 728 F.3d 1309, 1319 (Fed. Cir. 2013) (contrasting the use of extrinsic evidence in claim construction versus § 112 which looks at the "specification itself"). Using extrinsic evidence to argue the existence of a third non-lead metal structure not shown or described is therefore improper. *Id.*

Looking at Fig. 12 of the patent, even as the Petitioner has annotated it, it is clear that the shape and configuration of the leads at the interior of the resin package is not expressly illustrated. Even so, Petitioner asserts that Fig. 12 "shows the metal of the resin package is divided into *three* separate structures." Op. at 2. It

doesn't. Rather, Fig. 12 illustrates the division of the metal leads on the outer side surface (each of the positive and negative leads is divided into three portions), but the figure does not show any (internal) division of the metal into three separate structures. Ex. 2030, ¶¶11-12. This is because the underlying arrangement of the leads is obscured by the resin. *Id.*

It was therefore unsurprising that, when pressed on cross examination, Dr. Shanfield admitted he had not opined on the shape of the electrode structure under the resin in Fig. 12, and that he was not comfortable doing so during his deposition. Ex. 2033 at 46:21-49:7. Rather than consider the specification to figure this out, Dr. Shanfield looked to an inventor's notebook and drafts of figures made more than five months before the priority application was filed and *not included in the patent*. This is improper.

Instead, Petitioner should have looked (as a POSA would have) to the description of the fifth embodiment found in the specification. Ex. 2030, ¶13. In introducing the fifth embodiment, the patent states that a “[d]escription of some configurations employing the substantially same configuration as the light emitting device according to the first embodiment will be omitted where necessary.” Ex. 2023, ¶98; Ex. 2022, ¶98. In the fifth embodiment, and unlike the first through third embodiments, the '071 patent omits a lead frame illustration that would illustrate the specific shape of the leads in the interior of the resin package. *Cf.*

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