Filed on behalf of: Nichia Corporation Paper ____

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIZIO, INC.,
Petitioner,

v.

NICHIA CORPORATION,
Patent Owner.

Case IPR2018-00437
Patent 9,537,071

PATENT OWNER'S SUR-REPLY

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Rules

When properly construed, the claims are not unpatentable over the grounds.

I. CLAIM CONSTRUCTION

A. The Express Lexicography in the Specification Should Be Used

The specification "explicitly redefines" (Reply, 3) the terms it uses: "In this description, terms such as leads, a resin part, and resin package are used for a singulated light emitting device…." Ex. 1001, 3:33-36. Petitioner contends that this "merely provides context for the specification's discussion of the terms by introducing the concept of singulation." Reply, 5-6. Despite "the language used [being] unequivocal" (Ex. 2008, ¶ 37), Petitioner fails to explain why the context admittedly provided by the specification should be ignored. It should not be: under BRI, the claims *must be* interpreted *in light of the specification*.

Moreover, Petitioner improperly dismisses the cases cited by Patent Owner because they "involved express definitions." *See* Reply, 6. Petitioner does not explain how *are used for* (the '071 phrase) is meaningfully different from, or less definitional than *is* or *means* (phrases from cited cases). Likewise, Petitioner's citation to *Acumed* is misplaced; there, the court found that the term "each defining a hole axis" introduced a useful abstract concept of a "hole axis." There is nothing like that here. Instead, the specification's discussion of singulation expressly limits (by its own language) how the terms "leads, a resin part, and resin package are used." That is, the terms *are used* to refer to a *singulated* light emitting device.

Extrinsic evidence is less significant than the specification, especially where the specification redefines a term. Notwithstanding this, Petitioner introduced a definition from a specialized technical dictionary that is related to a *different* field than the claimed invention, but never explained the relevance of the different field the dictionary relates to. Reply, 5; Ex. 1039 (IEEE Standard Glossary of Computer Hardware Terminology). The Board should not give any weight to the dictionary.

Petitioner also purports to find the proposed construction inconsistent with claiming a single device. Reply, 6. In a related IPR proceeding, a different panel rejected a similar argument about a method directed to manufacturing a single device: "Thus, we understand the '250 patent to describe and claim singulating a resin-molded body into individual resin packages." IPR2017-01608, Paper 72, 26 (PTAB Jan. 9, 2019). Construing resin package, resin part, and metal part to refer to a singulated light emitting device is consistent with claiming a single device.

B. Petitioner Misconstrues the Intrinsic Record

Petitioner asserts that Patent Owner's identification of certain references during prosecution constitute an admission regarding the scope of the claims. Reply, 5. The Office's rules flatly dismiss this argument. 37 CFR § 1.97(h) (filing an IDS "shall not be construed to be an admission that the information cited … is considered to be, material to patentability"); Ex. 1002, 85-86 (submitting "in accordance with 37 CFR §§ 1.56, 1.97, [etc.]" and submission "not an admission").

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