

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIZIO, INC.,
Petitioner

v.

NICHIA CORPORATION,
Patent Owner

Case No. IPR2018-00437
Patent 9,537,071

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

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GLOSSARY OF ABBREVIATIONS

Shorthand	Description
Claims	Claims 1, 2, 4-9, 11-12, 15-19, 21-23, and 25 of U.S. Patent 9,537,071
Proposed Claims	Patent Owner's Proposed Amended Claims 27-34
IPR	<i>Inter Partes</i> Review
PO	Patent Owner
POSA	Person of Ordinary Skill in the Art
POR	IPR2018-00437, Paper 22, Patent Owner's Response
Mot./Motion	IPR2018-00437, Paper 24, Patent Owner's Contingent Motion to Amend Claims
Opp.	IPR2018-00437, Paper 32, Petitioner's Opposition to Patent Owner's Contingent Motion to Amend Claims
R	IPR2018-00437, Paper 34, Reply to Petitioner's Opposition to Patent Owner's Contingent Motion to Amend Claims
Hsu	U.S. Patent No. 6,770,498, issued August 3, 2004 (Ex. 1030)
Koung	U.S. Patent Publication No. 2008/0261339, published October 23, 2008 (Ex. 1008)
Glenn	U.S. Patent No. 6,433,277, issued August 13, 2002 (Ex. 1034)

Note: All emphasis herein added unless otherwise stated.

I. THE PROPOSED CLAIMS ARE INVALID UNDER §112

There is no written description support for the Proposed Claims, which require exactly two metal structures and a specific arrangement of metal and resin. PO ignores Fig. 12, attempts to improperly cobble together unrelated disclosures, and rewrites and contradicts the specification. For this reason alone, PO's motion fails.

PO first argues that Petitioner had to rely on extrinsic evidence (PO Reply at 1 ("R1")), but this is incorrect. As Dr. Shanfield explained, "[a] POSITA would have understood *from the disclosures of the '940 and JP '408 applications* that the resin package of Figure 12 does not 'consist' of 'a resin part and first and second metal leads'" because "*Figure 12...shows* that the metal of the resin package of the fifth embodiment is divided into three separate structures." Ex. 1017 ¶45. The figure itself shows a central metal structure having a square mounting plate with legs extending to each corner, and wires coming off the central metal structure and going to separate front and rear electrodes. *Id.*; Ex. 2033, 17:5-19:14. PO argues that resin obscures the leads (R2), but PO ignores the visible portions in Fig. 12. The precise dimensions of the metal under resin are irrelevant; what matters is that three metal structures are disclosed, not two. Ex. 2033, 37:11-39:25, 42:25-43:2. Ichikawa's notebook merely *confirms* what is already apparent from Fig. 12. Opp. 3-4; Ex. 1017 ¶¶46-49.

PO argues a POSA "would consider the description of the first embodiment when understanding the scope of the fifth embodiment" (R3), but the specification

states only that “configurations employing the *substantially same configuration*” pertain to the fifth embodiment (Ex. 2023 ¶98), and the lead frames of the first and fifth embodiments are *different*. Ex. 1017 ¶63. This is readily apparent from a comparison of Figs. 1 and 12. Tellingly, PO does not attempt to show that the metal structures of the first and fifth embodiments are substantially the same. Combining piecemeal disclosures of different embodiments in a manner disclosed nowhere in the specification is an obviousness analysis insufficient to show written description support. *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1352 (Fed. Cir. 2010).

Finally, PO attempts to rely on a disclosure of “jointed” from the specification (R3-4), but rewrites and contradicts that disclosure. PO first admits that the specification discloses “two alternative designs” (R3) in which “[t]he leads 422 may be separated respectively, or jointed” (Ex. 2022 ¶99; Ex. 2023 ¶99). But then PO contradicts the specification by proposing a device where “the leads are separated at the ‘outer side surface 420b,’ but also ‘jointed’ at the package interior.” R3. Likewise, Dr. Schubert improperly rewrites the specification’s disclosure of “[t]he leads 422 may be separated respectively, or jointed” to “a configuration where the leads are separated into six...and...jointed.” Ex. 2030 ¶18. Moreover, the “jointed” disclosure appears only in the patent’s description of the *fifth* embodiment, and PO improperly applies its interpretation of that disclosure to the lead frame of the *first* embodiment. Indeed, Dr. Schubert’s illustration of PO’s hypothetical lead frame

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