

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AVX CORPORATION
Petitioner
v.

SAMSUNG ELECTRO-MECHANICS CO., LTD.
Patent Owner

Case No. PGR2017-00010
Patent No. 9,326,381

PATENT OWNER'S RESPONSE TO PETITION

TABLE OF CONTENTS

TABLE OF EXHIBITS ii

I. INTRODUCTION 1

II. CLAIM CONSTRUCTION 3

 A. “a single dielectric layer” 4

 B. “the first and second electrode pads are offset to each other” 11

III. ARGUMENT 18

 A. Rutt Does Not Teach the “Average Number Of Dielectric Grains” Element of Claims 1 and 8..... 18

 1. *Rutt Fails as a Secondary Reference Based on SEM’s Proposed Claim Construction*..... 19

 2. *Rutt Fails as a Secondary Reference Even Under the Institution Decision* 22

 B. One of Ordinary Skill in the Art Would Have Had No Motivation to Combine Itamura with Rutt..... 24

 1. *Rutt’s IBLC Teachings are Inapplicable to Itamura’s MLCC* 24

 2. *One of Ordinary Skill in the Art Would Have Avoided the Disadvantages of Using Rutt’s Multiple-Strata Layers* 28

 C. Ahn Does Not Teach the “Offset” Electrode Pads Arrangement of Claim 18..... 31

IV. OTHER ARGUMENTS 35

V. CONCLUSION..... 35

CERTIFICATE OF WORD COUNT 37

CERTIFICATE OF SERVICE 38

TABLE OF EXHIBITS

Exhibit No.	Description
2008	Declaration of Michael Randall in Support of Patent Owner's Response to Petition ("Randall Declaration")

Patent Owner Samsung Electro-Mechanics Co., Ltd. (“SEM” or “Patent Owner”) respectfully submits this Response to the Petition for Post-Grant Review (“Petition”) of U.S. Patent No. 9,326,381 (the “381 Patent”) filed by Petitioner AVX Corporation (“AVX” or “Petitioner”).

I. INTRODUCTION

Most of the grounds asserted in the Petition were denied in the institution decision. The obviousness grounds that remain turn on specific questions of fact and claim construction regarding the teachings of two secondary references (Rutt and Ahn) and the alleged reasons for using them to modify the primary reference (Itamura). In order to properly evaluate Petitioner's obviousness allegations, SEM proposes formal claim constructions for two key terms at issue. SEM also provides a supporting declaration with the expert opinions of Dr. Michael Randall, who has over twenty-five years of experience in the field of multilayer ceramic capacitors, including as the Manager of Ceramic Capacitor Research and Development at AVX. (*See* Randall Declaration (Ex. 2008) at ¶¶ 6–11.)

SEM's proposed claim constructions materially depart from the preliminary interpretations used by the Board in applying prior art in its institution decision. Those preliminary interpretations were based on the partially developed record at that early stage. After a comprehensive claim construction analysis, the Board should again consider whether the claimed “single dielectric layer” can cover the

five strata shown in Rutt. The more granular analysis below demonstrates that such an interpretation conflicts with the intrinsic record and also impermissibly renders the claim term “single” mere surplusage. Similarly, the Board should again consider whether the “offset” electrode pads of claim 18 can be met by any two electrode pads that do not line up, in view of the more granular analysis presented below that exposes the fallacy of the Petition's position.

Finally, regardless of whether the Board adopts SEM's claim constructions the challenged claims should survive the prior art obviousness challenge. As Dr. Randall explains, Rutt has separate boundary layers between each of its five dielectric strata, which precludes reading Rutt on the claimed “single” layer under any reasonable construction. Dr. Randall also explains why one of ordinary skill in the art would not have incorporated Rutt's teachings directed to boundary layer concerns of “intergranular barrier layer capacitors” (IBLCs) to Itamura's entirely different type of capacitor where no such concerns exist. Finally, Dr. Randall explains why ordinary artisans would not have embraced the separated electrode pad approach shown in Ahn.

Accordingly, the Board should find all challenged claims of the '381 patentable over the instituted grounds.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.