

UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT TRIAL AND APPEAL BOARD

ADVANCED MICRO DEVICES, INC.,
Petitioner,

v.

REALTEK SEMICONDUCTOR CORPORATION,
Patent Owner.

Case IPR2023-00920
U.S. Patent No. 8,006,218

**PRELIMINARY PATENT OWNER'S REPLY
ADDRESSING ALJ ORDER FROM THE ITC**

Petitioner sought leave to submit Exhibit 1031, an order from an ITC ALJ denying Patent Owner's motion for summary determination. Ex.1031, Cover. The Board granted leave last week. The ITC ALJ made no finding of fact affecting the Petition or any argument advanced by PO. Instead, the ALJ simply concluded that Respondent AMD's argument was "sufficient to raise a genuine issue of material fact." Ex.1031 at 16.¹

The Order finds that because AMD's expert Dr. Subramanian offered opinions contrary to Realtek's expert, and all facts must be construed in AMD's favor, there was a genuine issue of material fact. Ex.1031 at 17 ("[AMD] presumably has its own expert who will opine on the subject"). Before the Board, the evidence is not construed in AMD's favor. 37 C.F.R. § 42.108(c); PTAB Rules of Practice for Instituting on All Challenged Patent Claims and All Grounds and Eliminating the Presumption at Institution Favoring Petitioner as to Testimonial Evidence, 85 Fed. Reg. 79120, 79125 (2020). In fact, unlike in the ITC where Dr. Subramanian repeating attorney argument may be sufficient to defeat a motion for summary determination, here, when Dr. Subramanian's testimony simply parrots the arguments of the Petition, Dr. Subramanian's testimony can, and should, be given no weight. *InfoBionic, Inc. v. Braemar Manufacturing, LLC*, IPR2015-01704, Paper

¹ Citations to Ex.1031 are made to the Word page number, not the PDF page number.

11 at 13 (P.T.A.B. Feb. 16, 2016) (denying institution over expert testimony that did not add to “Petitioner’s conclusory argument”). Because Dr. Subramanian’s testimony “does not disclose the underlying facts or data on which the opinion is based,” it is “too conclusory” and is “entitled to little or no weight.” *Id.* at 14-15 (citing 37 C.F.R. § 42.65(a). Based on the requisite weight to give Dr. Subramanian’s testimony, Petitioner is unable to meet its burden for the reasons outlined in PO’s preliminary response.

Exhibit 1031 also rests on an alleged claim construction argument surrounding “providing power...separately.” Ex.1031 at 15; *see also* Patent Owner’s Preliminary Response (Paper 7) at 31. This claim construction dispute is within the power of the Board to resolve at institution. Unlike the ITC’s election to hear additional evidence, the arguments and evidence identified in PO’s Preliminary Response are sufficient to defeat institution as Petitioner’s burden bearing paper is now fixed. *Id.* Petitioner cannot alter its theory. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016); 37 C.F.R. § 42.23(b).

The evidence Petitioner advances with its pre-institution paper does not undermine any argument in PO’s Preliminary Response and for the reasons set forth in the Preliminary Response, the Petition should be denied.

Dated: September 20, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on September 20, 2023, a true and correct copy of the foregoing was caused to be served on the following counsel for Petitioner by electronic mail to the following email addresses:

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