

1 UNITED STATES PATENT AND TRADEMARK OFFICE

2  
3 BEFORE THE PATENT TRIAL AND APPEAL BOARD

4  
5 INNOSCIENCE (ZHUHAI) TECHNOLOGY COMPANY, LTD

6 and

7 INNOSCIENCE AMERICA, INC., Petitioner,  
8 v.

9  
10 EFFICIENT POWER CONVERSION CORPORATION,

11 Patent Owner.

12  
13 IPR2023-01381

14 Patent 8,350,294B2

15  
16 CONFERENCE CALL

17  
18 THURSDAY, NOVEMBER 14, 2024

19 2:30 p.m.  
20  
21  
22

A P P E A R A N C E S:

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ADMINISTRATIVE PATENT JUDGES:

Jon B. Tornquist

Kimberly McGraw

Transcript of Conference Call

1 Conducted on November 14, 2024

2 P R O C E E D I N G S

3 JUDGE TORQUIST: This is conference  
4 call regarding IPR2023-01381. I'm Judge Tornquist  
5 and with me is Judge McGraw. Who do we have from  
6 petitioner?

7 MR. DUARTE-GUEVARA: Hello, Your Honor.  
8 This is Carlos Duarte-Guevara for petitioner.  
9 Here with me is Lionel Lavanue.

10 JUDGE TORNQUIST: Okay. And patent  
11 owner?

12 MR. DAVIS: Your Honor, this is Walter  
13 Davis from Blank Rome on behalf of patent owner,  
14 and with me on the line is John England.

15 JUDGE TORNQUIST: Okay, and did either  
16 party bring a court reporter today?

17 MR. DUARTE-GUEVARA: Yes, Your Honor,  
18 petitioner has a court reporter and she's on the  
19 line. Her name is Lisa Barrett.

20 COURT REPORTER: Hello.

21 JUDGE TORNQUIST: Great. What we'd ask  
22 you to do after the call in a reasonable period of

1 time, please put the transcript of this call into  
2 the record for the public.

3 With that, this call was requested by  
4 the petitioner to seek authorization to file its  
5 declaration with a sur-reply, in this case  
6 addressing motion to amend.

7 Petitioner, do you want to explain your  
8 request and why you think it should be approved?

9 MR. DUARTE-GUEVARA: Of course, Your  
10 Honor. So, first thank you very much for taking  
11 this time to discuss with us.

12 I think it may be beneficial to give  
13 you a quick background for context on different  
14 papers.

15 So, first, patent holder filed a motion  
16 to amend. That's on June 12th, and that's Paper  
17 17.

18 Then we filed an opposition, and we  
19 included a argument of lack of enablement and  
20 that's Paper 27.

21 Then the Board issued preliminary  
22 guidance. That's Paper 29, and the date

1 was October 1st.

2 Then the patent owner filed a reply in  
3 support of their motion to amend; that's Paper 31.

4 Now our petitioner's sur-reply will be  
5 due November 27th.

6 So with that background, the issue here  
7 is that in the reply, so paper 31, patent owner  
8 argued, of course that the claim, that the new  
9 claims will be enabled and they introduced new  
10 exhibits and a new argument that we think are best  
11 addressed with a supplemental expert report to go  
12 with our sur-reply.

13 So the new exhibit that we're talking  
14 about is Exhibit 2026, 2027, 2028.

15 All of these are -- papers and the  
16 patent owner of course has the expert, of opining  
17 about them in the declaration.

18 Now, the new argument that we're  
19 referring to, it's an argument that is in pages 6  
20 to 8 of Paper 27, where patent owner argues for  
21 enablement based on a theory that they have with  
22 different -- we call it "the energy gains theory"

1 and different electron levels in the semiconductor  
2 devices.

3 Now that theory is not in the patent.  
4 It's a new argument. It's not in the patent or  
5 the patent record. Of course the exhibits that  
6 I just mentioned are not part of the patent. It's  
7 extrinsic evidence.

8 So because patent owners introduced  
9 this new technical exhibit and new argument, we  
10 believe it will be appropriate to have  
11 a supplemental expert report to address those  
12 exhibits and the new argument in our sur-reply.

13 Now that, of course, will be an  
14 exception for the rule, but we think that this is  
15 a situation where an exception will be  
16 appropriate. And there are three reasons why we  
17 think it will be appropriate.

18 So the first one is that the enablement  
19 argument that patent owner advanced is going  
20 beyond patent record or any evidential record.

21 They are relying on these new exhibits.  
22 You know, just to identify, those were exhibits

1 that we haven't seen before, they were new with  
2 the patent owner response.

3 And because patent owner 's enablement  
4 argument relied on extrinsic evidence not related  
5 to the patent, we need to respond with extrinsic  
6 evidence.

7 We think that the best responses will  
8 be in the form of the supplemental expert report  
9 to directly address the same two exhibits that  
10 they put new on the record.

11 We are not trying to make new arguments  
12 on enablement. We just want to have our expert  
13 give an opportunity to opine about the same new  
14 exhibits that patent owner put with their reply.

15 The second issue or better, the second  
16 reason has to do with the fact intensiveness of  
17 these issues. So in the preliminary guidance  
18 which is Paper 29, you know, the Board correctly  
19 pointed out that the issue on enablement for this  
20 case is very fact dependent and patent owner's new  
21 exhibits is putting real facts. They are arguing  
22 new facts about twice the energy and things like

1       that.

2                       And for a complete trial record, we  
3       think it's best addressed with testimony from both  
4       parties' declarants, so the patent owners already  
5       have his expert opine about these facts.

6                       We believe it's the best for the trial  
7       record to have petitioner 's expert also opine  
8       that and then the final reason and this is  
9       actually that we put in our email because we think  
10      it was instructive, is the case of Axonics versus  
11      Medtronic.

12                      You know, the full case cite it's in  
13      the email, but we think that's helpful here  
14      because that case also dealt with evidential  
15      sur-reply. And we felt it should be noted that  
16      the Board has its discretion to waive the rule and  
17      give an example that, similar to us, that, you  
18      know, where it would be possible to have an expert  
19      report for sur-reply. What is key though and  
20      pretty clear, in that case it there was no expert  
21      report with the sur-reply, but what is key is that  
22      the Federal Circuit told people that they need to

1 ask for it. You don't need to -- you know, the  
2 Board had discretion, but you need to ask for it.

3 So following the Federal Circuit  
4 guidance in that case, that's why we requested  
5 this call for -- to request the new declaration or  
6 the supplemental declaration with the sur-reply.

7 So that's a high-level of what we're  
8 asking for, Your Honors. I'll be happy to address  
9 any questions. As noted in our email, the parties  
10 may met and conferred on November 1st and patent  
11 holder stated that it will oppose a request.

12 Patent owner has some concerns about  
13 prejudice, about -- that a similar argument was  
14 presented on the ITC.

15 We think that's wrong because the ITC  
16 didn't have any issues on the enablement. And the  
17 final thing that patent owner expressed during the  
18 meet and confer was that we should just address  
19 these on a cross-examination, you know, in  
20 a deposition for further experts, but we don't  
21 think that's right.

22 For the first issue on prejudice, we

1 think this will be prejudicial because what we are  
2 asking is the opportunity to have our expert  
3 address the new exhibits.

4 So this is, again, we are not trying to  
5 come up with new arguments that the patent owner  
6 will not be able to respond. We just want to have  
7 a balanced record on new facts that patent owner  
8 entered with the reply.

9 For the issue in the ITC, I already  
10 previewed it, they address these in a different  
11 context, specifically for infringement, but the  
12 infringement and the validity -- excuse me,  
13 infringement and enablement question are very  
14 different and we couldn't have anticipated that  
15 they are going to argue the same thing in  
16 a different context and, particularly, using new  
17 exhibits.

18 There is no question that the exhibits  
19 are new. They were not using the ITC.

20 And then the final issue on, we can  
21 just do this in cross-examination, we think that's  
22 trite because we already know what the patent

1 owner expert is going to argue.

2 What we think is best for the record is  
3 to have the opposite side 's opinion.

4 JUDGE TORNQUIST: Okay, I will let the  
5 petitioner respond in just a second, but I'd like  
6 to just ask a couple of questions before the  
7 patent owner jumps in and, specifically, why is  
8 this a unique situation here?

9 In Axonics there was a new issue on  
10 a new claim construction that popped up that one  
11 side had never been able to address.

12 In that situation you needed the two  
13 expert reports, but this seems much closer to  
14 a standard case where you get an expert report  
15 from one side. You get an expert report  
16 responding to it and that's usually enough.

17 And here you raised enablement and they  
18 responded to it, so why is this a unique situation  
19 closer to Axonics than our standard situation?

20 MR. DUARTE-GUEVARA: We think it's  
21 unique, Your Honor, because the patent owner is  
22 giving extrinsic evidence for the enablement

1 argument.

2 So in our enablement challenge I will  
3 give you the (indiscernible) on the patent record  
4 and what's evidential record, like the level of  
5 skill in the art and those issues.

6 Here it's only different than the  
7 normal case because the patent owner is bringing  
8 new things and new facts that we couldn't have  
9 responded to because they didn't exist before the  
10 patent owner put them in their reply.

11 JUDGE TORNQUIST: Okay, the next  
12 question is: Is there a middle ground here that  
13 would work where you can use papers and exhibits,  
14 but don't go to an actual declaration that's going  
15 to require a deposition?

16 For example, you bring in your own  
17 extrinsic evidence as you can present them  
18 as sur-reply, and then you could have some  
19 responsive brief from patent owner?

20 MR. DUARTE-GUEVARA: So, sorry, Your  
21 Honor, I'm (indiscernible) quickly.

22 JUDGE TORNQUIST: No, that's fine.

1 Take a second to address that. I just want to see  
2 if: Does that middle ground exist?

3 MR. DUARTE-GUEVARA: Your Honour, it  
4 could exist. We could put additional exhibits on  
5 the record, but we think the most effective way to  
6 address the issue will be to have the expert opine  
7 about the same papers.

8 JUDGE TORNQUIST: Okay, and do you  
9 believe that we can -- if you put in a declaration  
10 we're going to have to allow a deposition. Is  
11 there time to get that done, to get your sur-reply  
12 on file?

13 MR. DUARTE-GUEVARA: We think it will  
14 be possible, Your Honor. The sur-reply is  
15 due November 27th. This case is scheduled to go  
16 to oral hearing December 18th, so that gives a few  
17 weeks for deposition. And, again, we think this  
18 can be a very narrow declaration on the specific  
19 issues called the new exhibits, so it shouldn't  
20 take too long to prepare for the deposition and to  
21 take it.

22 JUDGE TORNQUIST: Okay, so you agree

1 that any declaration, if it's allowed, would be  
2 limited to this preferential depletion of the 2DEG  
3 by magnesium acceptors?

4 MR. DUARTE-GUEVARA: Correct, Your  
5 Honor, yes. So it would be on that issue and the  
6 new exhibits.

7 JUDGE TORNQUIST: Okay, with that,  
8 let's go ahead and hear from patent owner then.  
9 Tell me when you're ready.

10 MR. DAVIS: Thank you, Your Honor.  
11 I'll address the last point first. The last point  
12 just discussed having to do with prejudice and the  
13 amount of time between the due date for the  
14 sur-reply and the oral argument.

15 Petitioner suggests that three weeks is  
16 plenty of time, plenty of time to do a deposition,  
17 but the petitioner leaves out -- first of all,  
18 patent owner strongly disagrees that three weeks  
19 is enough time. But the sur-reply is due the day  
20 before Thanksgiving, so you have the Thanksgiving  
21 holiday in there and everybody, of course, has  
22 plans for that.

1           It's also, as noted, the oral argument  
2     is scheduled for December 18th per the schedule,  
3     so now you're looking at only two and a half  
4     weeks, essentially, to deal with absorbing the new  
5     declaration, scheduling a deposition, assuming  
6     that the expert is available in that timeframe, as  
7     well and get ready for the oral argument, and that  
8     type of tight timeframe is extremely prejudicial  
9     to patent owner.

10           I'll also note, petitioner mentioned,  
11    certainly in petitioner's email to the Board,  
12    teeing up this call and, as well as alluded to the  
13    preliminary guidance provided by the Board,  
14    mentioning that the enablement issue is highly  
15    technical and fact dependent, and best resolved on  
16    a complete trial record with testimony from both  
17    parties' declarants.

18           Well, we have that. The petitioner has  
19    a declaration. Patent owner has a declaration.

20           Your Honor alluded to the fact that  
21    this seems to be the case where patent owner  
22    replied, responded to an argument raised by

1 petitioner and now both experts have spoken on it.

2 Patent owner believes, as indicated by  
3 the petitioner, that the proper thing to do to  
4 address the so-called new argument and new  
5 exhibits, would be to cross-examine Dr. Schubert,  
6 and that that is patent owner's expert, the one  
7 that provided the declaration.

8 And, of course, there is nothing that  
9 is stopping patent owner -- sorry, petitioner from  
10 providing argument in response to the so-called  
11 new arguments and exhibits in its sur-reply.

12 Moreover, patent owner's arguments in  
13 response to this enablement argument was  
14 foreseeable. This was, and by "this" I mean the  
15 idea that it's energetically more favorable for an  
16 acceptor to accept an electron from the conduction  
17 band than to bind to a hydrogen atom. That  
18 concept was hotly contested in the corresponding  
19 ITC case.

20 In other words, it was hotly contested  
21 as to how the invention works. That sounds an  
22 awful lot like enablement to me, although it

1 wasn't raised in the enablement context per se, it  
2 did have to do with how the invention works.

3 Indeed, Dr. Schubert, patent owner's  
4 expert in the ITC trial, during the hearing for  
5 the ITC case provided very relevant and  
6 familiar-sounding testimony.

7 I can read from the publicly-available  
8 transcript of a portion of that hearing. It's on  
9 page 526, lines 3 through 19.

10 And the question is:

11 "With regard to the diagram to the  
12 right, let's say we have one hydrogen with an  
13 electron. We have one 2DEG electron available and  
14 we have one magnesium acceptor in the p GaN. Is  
15 it the 2DEG electron or the hydrogen electron that  
16 would be accepted by the magnesium."

17 The answer from Dr. Schubert:

18 "Accepting the 2DEG electron is  
19 energetically more favorable because the energy  
20 difference between the 2DEG electron and the  
21 hydrogen into the magnesium level is on the order  
22 of two to three electron volts. The energy gained

1 by accepting a hydrogen atom is about one electron  
2 volt, so the more favorable process is the  
3 acceptance of a 2DEG electron." [as read]

4 Next question, and bear with me, it is  
5 just one more question and answer.

6 Next question:

7 "So on a macro scale, what you're  
8 saying is that -- and correct me if I'm wrong,  
9 what you are saying is that 2DEG electrons would  
10 be accepted by the magnesium, depleting the 2DEG  
11 first?

12 "A. Yes, it could be expressed in this  
13 manner." [as read]

14 And that's all I have from the ITC  
15 hearing transcript, the public version of it, that  
16 is.

17 And that really highlights that this  
18 argument that patent owner has included in this  
19 IPR proceeding, related to petitioner's enablement  
20 was something that petitioner should have  
21 foreseen. They could have addressed this, right  
22 in its opposition.

1           The Axonics case is inapposite as -- at  
2     least to me it seemed Your Honor was alluding.  
3     That related to a claim construction and  
4     completely different situation.

5           I think, looking at my notes, I jot  
6     down beforehand, yeah, those are my main  
7     responses, Your Honor. I'll take any questions  
8     you have.

9           JUDGE TORQUIST: Okay, and what about  
10    that middle ground I mentioned before about them  
11    at least bringing in a few external extrinsic  
12    exhibits, if they're going to make a scientific  
13    argument that it's incorrect that there's  
14    a preferential depletion of a 2DEG?

15          MR. DAVIS: Yeah, that's an interesting  
16    proposition.

17          I'm inclined to say that patent owner  
18    is okay with such a middle ground.

19          The only thing that holds me back is  
20    I just -- I have no idea what they have come back  
21    with and the scale and scope of it, and I'm not  
22    sure if there is a way to place to police that

1 ahead of time but generally speaking, I believe  
2 patent owner would be amenable to that middle  
3 ground.

4 JUDGE TORNQUIST: Okay, and then we  
5 also -- this is going to be a long -- I think you  
6 have an extended hearing for this case, so then  
7 both parties would have a chance in oral argument  
8 to address the evidence of record, correct?

9 MR. DAVIS: Correct, in argument.

10 JUDGE TORNQUIST: Okay, okay. Let  
11 me -- let's hear from petitioner. Do you want to  
12 respond?

13 MR. DUARTE-GUEVARA: Thank you, Your  
14 Honor. Just a couple of quick points: All that  
15 information that patent owner counsel was reading,  
16 is not in the patent. So on the question of  
17 enablement, they couldn't have anticipated that  
18 they were going to rely on this theory for the  
19 enablement portion.

20 That theory came up in a different  
21 issue. As patent owner was mentioning, it was  
22 hotly contested but none of that information is in

1 the patent and we just did not discuss that during  
2 the ITC case because there was no enablement issue  
3 at the ITC.

4 And at least for certain, the new  
5 exhibits are completely new. The new exhibits  
6 that he raised in 2026, 2027, 2028 those are  
7 completely new and, again, that makes sense  
8 because enablement was not an issue in the ITC.

9 And then the other -- the other point  
10 that patent owner made that I would like to  
11 respond is that we already have a complete record,  
12 with both experts opining on enablement.

13 In our opinion, that is not the case  
14 because patent owner introduced new facts and new  
15 exhibits with their reply, so if we want to have  
16 a complete record then the -- you know, having our  
17 experts, having petitioner's experts opine about  
18 those new facts and exhibits is what will create  
19 a complete record and that's it, Your Honor.

20 Thank you.

21 JUDGE TORNQUIST: Okay, so obviously  
22 a declaration without supporting evidence is not

1 very precise, so what level of extrinsic evidence  
2 are you intending to bring in? How much and how  
3 extensive?

4 MR. DUARTE-GUEVARA: Your Honor, I --  
5 I cannot give you a straight answer, Your Honor,  
6 because we will need to identify what type of  
7 evidence will be sufficient to counter the  
8 arguments or the interpretation that patent owner  
9 is giving.

10 On top of my head, maybe a few papers,  
11 like what they did, maybe books, something along  
12 those lines is what we could do. But maybe -- and  
13 I'm sorry to go back to this, but maybe the  
14 easiest thing, we'll be fine limiting our expert  
15 report only on the exhibits, on the new exhibits  
16 that were introduced.

17 So instead of adding more stuff on the  
18 record that will be new, and then, you know, the  
19 patent owner will see for the first time, for  
20 example, the easiest and more complete and the  
21 most fair thing will be to have limit testimony by  
22 our experts on the same exhibits that patent owner

1 introduced in reply.

2 JUDGE TORNQUIST: Okay, patent owner,  
3 do you want to briefly -- before the panel  
4 discusses, do you want to just briefly respond to  
5 any issues or arguments then?

6 MR. DAVIS: Sure, Your Honor. It's  
7 rehashing of what I said before, but I'll  
8 reconfirm that the petitioner's last suggestion  
9 about the limiting the expert declaration, that  
10 does not help at all.

11 Patent owner would still be extremely  
12 prejudiced, given the short amount of time between  
13 the sur-reply and the oral arguments, the  
14 interjection of the Thanksgiving holiday and  
15 everything they'll need to do to spin up to get  
16 ready, so the patent owner does not see that as  
17 a viable alternative. That's all, Your Honor.

18 JUDGE TORNQUIST: Okay. Okay, with  
19 that, I'm going to put you on hold and the panel  
20 will discuss and then we'll come back with our  
21 resolution. Thank you.

22 (Pause)

1 JUDGE TORNQUIST: The panel is back  
2 online. Do we still have petitioner online?

3 MR. DUARTE-GUEVARA: Yes, Your Honor.

4 JUDGE TORNQUIST: And patent owner?

5 MR. DAVIS: Yes, Your Honor.

6 JUDGE TORNQUIST: Okay, and the court  
7 reporter.

8 COURT REPORTER: Yes, Your Honor.

9 JUDGE TORNQUIST: Okay, the panel has  
10 considered this and what we're going to do is we  
11 are not going to waive our rules regarding  
12 declaration testimony coming in with the  
13 sur-reply.

14 We are willing to waive the rules and  
15 we will waive the rules allowing documents to come  
16 in in the sur-reply addressing this specific issue  
17 that was raised in the email from petitioner,  
18 regarding the preferential depletion of the 2DEG  
19 by magnesium acceptors.

20 Then what we'll do is if there are any  
21 issues from those documents regarding that  
22 interpretation we will hear those arguments at

1 oral argument in this case and that will be the  
2 record. Any questions, petitioner?

3 MR. DUARTE-GUEVARA: Your Honor, thank  
4 you very much. So we have a 12-page limit for  
5 this sur-reply. Would it be possible to increase  
6 that page count so we can address the new --  
7 potentially the new exhibits that we are going to  
8 use to rebut this issue?

9 JUDGE TORNQUIST: And how many pages do  
10 you think you need?

11 MR. DUARTE-GUEVARA: Maybe 16.

12 JUDGE TORNQUIST: So you are asking to  
13 go from 12 to 16?

14 MR. DUARTE-GUEVARA: Yes, Your Honor.

15 JUDGE TORNQUIST: Okay. Any other  
16 questions before we go to patent owner?

17 MR. DUARTE-GUEVARA: No, that's it.  
18 thank you.

19 JUDGE TORNQUIST: Okay, and patent  
20 owner, any questions?

21 MR. DAVIS: No questions, Your Honor.  
22 I would just -- well, say that going

1 from 12 to 16 to address what, in the email is  
2 a two-sentence argument, two or three tops, feels  
3 quite extreme and we would certainly object to  
4 that.

5 JUDGE TORNQUIST: Okay, what we're  
6 going to do is we are going to -- I think it's  
7 reasonable, petitioner, we will let you have  
8 16 pages, but we would expect at least four of  
9 those pages to be highly focused on this issue.

10 MR. DUARTE-GUEVARA: Yes, Your Honor.

11 JUDGE TORNQUIST: Not to use that for  
12 other issues in this case. Okay, with that,  
13 petitioner any questions?

14 MR. DUARTE-GUEVARA: No, Your Honor,  
15 that's it.

16 Thank you very much.

17 JUDGE TORQUIST: And patent owner?

18 MR. DAVIS: No, Your Honor. Appreciate  
19 your time.

20 JUDGE TORNQUIST: Okay, and thank you  
21 to both parties.

22 We will let the transcript be the

1 record for this call. And with that, this call is  
2 adjourned.

3 Thank you.

4 MR. DUARTE-GUEVARA: Thank you.

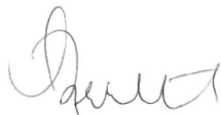
5 MR. DAVIS: Thank you, your Honor.

6 (Conference call concluded at 3:02 p.m.)  
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CERTIFICATE OF SHORTHAND REPORTER

I, Lisa M. Barrett, Registered Professional Reporter (Washington License 24011246), the officer before whom the foregoing proceedings were taken, do hereby certify that the foregoing transcript is a true and correct record of the proceedings; that said proceedings were taken by me, stenographically and thereafter reduced to typewriting under my supervision; and that I am neither counsel for, related to, nor employed by any of the parties to this case and have no interest financial or otherwise, in its outcome.

IN WITNESS WHEREOF, I have hereunto set my hand this 14th day of November, 2024.



Lisa M. Barrett, RPR, CRR, CRC, CSR  
Certified Realtime Court Reporter

Transcript of Conference Call  
Conducted on November 14, 2024

29

| A                     |                    |                    |                      |
|-----------------------|--------------------|--------------------|----------------------|
| <b>able</b>           | <b>advanced</b>    | 22:5               | <b>assuming</b>      |
| 10:6, 11:11           | 6:19               | <b>anticipated</b> | 15:5                 |
| <b>about</b>          | <b>after</b>       | 10:14, 20:17       | <b>atom</b>          |
| 5:14, 5:17,           | 3:22               | <b>any</b>         | 16:17, 18:1          |
| 7:13, 7:22, 8:5,      | <b>again</b>       | 6:20, 9:9,         | <b>attorney</b>      |
| 9:12, 9:13,           | 10:4, 13:17,       | 9:16, 14:1,        | 2:10                 |
| 13:7, 18:1,           | 21:7               | 19:7, 23:5,        | <b>attorneys</b>     |
| 19:9, 19:10,          | <b>agree</b>       | 24:20, 25:2,       | 2:2                  |
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Transcript of Conference Call  
Conducted on November 14, 2024

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