

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INNOSCIENCE (ZHUHAI) TECHNOLOGY COMPANY, LTD.,
AND
INNOSCIENCE AMERICA, INC.
Petitioner,

v.

EFFICIENT POWER CONVERSION CORPORATION,
Patent Owner

Case IPR2023-01382
U.S. Patent No. 9,748,347

AUTHORIZED RESPONSE TO DIRECTOR'S REVIEW REQUEST

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I. INTRODUCTION

Petitioner's Request for Director Review (Paper 32, "the Request") incorrectly argues that the Board made three errors: (1) that the Board adopted an "implausible reading" of Saxler because, according to Petitioner, Saxler "unambiguously" and "expressly discloses" a non-recessed version of Figure 1A (*i.e.*, "Modified Figure 1A"); (2) that the Board improperly required a reason to modify Figure 1A "beyond Saxler's express teaching to do so"; and (3) that the Board overlooked the reason Petitioner identified for modifying Figure 1A. Paper 32, 1. But Petitioner expressly abandoned its argument about Saxler's disclosure, as recognized in the FWD. Paper 31, 27 (Petitioner "clarified that it is not asserting that Saxler discloses . . . Modified Figure 1A, but rather is relying on 'an obviousness theory . . . because you need to make that modification.'"). Because there was no express disclosure in Saxler, Petitioner needed to identify a motivation to make such a modification, which, as the Board recognized, it did not. *Id.*, 27-31.

II. PETITIONER ABANDONED ITS POSITION THAT SAXLER DISCLOSES "MODIFIED FIGURE A"

Although Ground III in the Petition relied on Saxler's purported disclosure of "Modified Figure 1A," Paper 21, 3-4, Petitioner abandoned that argument, as the Board correctly found, Paper 31, 27. The parties coalesced around Patent Owner's explanation that Saxler discloses two separate and distinct structures (a recessed embodiment and a non-recessed embodiment), and Petitioner argued that a skilled

artisan would need to modify Saxler to reach Petitioner’s “Modified Figure 1A.” Paper 21, 4-5.

This change in Petitioner’s argument was likely due, at least in part, to testimony from its expert, Dr. Shealy, who undermined Petitioner’s argument that Modified Figure 1A is expressly disclosed in Saxler—the same argument it raises here. Dr. Shealy explained that the basis for his opinion was Saxler ¶ 52—the same disclosure Petitioner relies on here—and explained that, to reach Modified Figure 1A, “you can take what’s in the embodiments, and mix and match ... none of these embodiments are limiting” and “take all the embodiments and bring in which ones you want, depending on what you’re trying to accomplish.”¹ EX2004, 39:3-5, 39:12-40:8, 41:24-42:1. In other words, no embodiment in Saxler expressly discloses Modified Figure 1A of the challenged patent—a skilled artisan would need to modify Saxler by mixing and matching its various unconnected disclosures. Unsurprisingly, Petitioner changed course to argue that “Dr. Shealy’s testimony accurately reflects *obviousness law*.” Paper 21, 4 (emphasis added). Put another way, after the Petition was filed, Dr. Shealy, Petitioner, Patent Owner, and the Board all agreed that “Saxler does not disclose an embodiment with a non-recessed gate and

¹ Petitioner’s new position that ¶ 52 “discloses a single, narrow modification: adding or removing a gate recess from *Saxler*’s figures” (Paper 32, 5) is pure attorney argument and directly contradicted by Dr. Shealy’s mixing and matching of “dopants, different types of dopants, different distributions.” EX2004, 39:15-19.

sloped sidewalls.” Paper 31, 27.

Petitioner now seeks to resurrect the same argument that it expressly and unequivocally abandoned. Its argument should not be considered for that reason alone. Even if it were reconsidered, however, the argument should also be rejected on its merits. As Patent Owner established and the Board agreed, Saxler discloses only two distinct embodiments: one recessed, and one non-recessed. Saxler does not disclose or suggest removing the recess from the recessed embodiment. *Id.*, 27-28.

Petitioner’s other argument—that Patent Owner and the Board “ignored” key evidence (namely, Saxler ¶ 52)—fares no better. *See* Paper 32, 5 and 8. Patent Owner and the Board expressly addressed Saxler ¶ 52 and agreed that the passing mention of “other embodiments of the present invention [that] may include or not include a gate recess” does not support Petitioner’s purported “disclosure” of the recess being optional in all of the embodiments. Paper 17, 23-28. Indeed, the “other embodiments” are neither disclosed nor illustrated. *See id.*

III. PETITIONER DID NOT PROVIDE A REASON WHY POSITA WOULD HAVE REMOVED SAXLER’S GATE RECESS

As the Board noted, the Petition did not provide a valid *prima facie* case of obviousness because “the Petition does not provide a *reason* why a POSITA would have removed Saxler’s gate recess.” Paper 31, 29.

In the Request, Petitioner’s argument is based on little more than its own ipse dixit. Paper 32, 7-8. For example, Petitioner states that “Paragraph [0052] of *Saxler*

provides [] a motivation” without identifying the alleged “motivation” at all—it does not identify a motivation in *Saxler* or in Ground III of the Petition. Paper 32, 7-8.

Here, too, Petitioner repeats its previously abandoned argument that Saxler expressly *discloses* that the recess in Saxler’s recessed embodiment as being “optional.” Paper 32, 8. But, again, there is no disclosure of such a non-recessed, recessed gate embodiment. Paper 21, 1. Obviousness concerns whether a skilled artisan not only *could have made* but *would have been motivated to make* the modifications of prior art to arrive at the claimed inventions. *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1074 (Fed. Cir. 2015) (emphasis in original). Thus, even assuming that removing the recess from the recessed gate was an “option,” that does not provide *a reason* to do so and Petitioner has not articulated one.

IV. THE BOARD ADDRESSED THE PETITIONER’S “ADDITIONAL REASON” TO MODIFY BY POINTING OUT THAT IT WAS NOT IN THE PETITION FOR GROUND III

In addressing Ground III, the Board highlighted that “contrary to Petitioner’s assertions in its Reply and at the hearing, *the Petition makes no argument* that a POSITA would have removed the recess from Saxler Figure 1A *to realize the benefits of an enhancement mode transistor.*” Paper 31, 28 (emphasis in original).

Indeed, such an argument—that a skilled artisan would have been motivated to modify Saxler “to realize the benefits of an enhancement mode transistor” (Paper 32, 8-9)—does not appear in Ground III of the Petition. Paper 21, 6-7. Rather the

quoted language is from Ground II, where the Petition attempted to modify Saxler in view of Yoshida—an argument clearly inconsistent with Ground III that relied on Saxler’s transistors *already* being enhancement-mode. *Id.*

It was not until its Reply and the hearing that Petitioner improperly attempted to apply the motivation from Ground II to Ground III. Paper 31, 28. But a petitioner cannot argue in a reply that it would have been obvious to modify the prior art where the petition argued only that the prior art disclosed a particular claim limitation. *Yita LLC v. MacNeil IP LLC*, 69 F.4th 1356, 1365-67 (Fed. Cir. 2023).

Thus, there is no “oversight” and no need for remand. Petitioner’s cited cases are inapposite because the Board did not overlook an argument made in the Petition.

V. THE REQUEST DOES NOT MEET THE STANDARD FOR DIRECTOR REVIEW

The Request fails to meet the standard for Director Review because it merely seeks reconsideration of the merits without presenting any factual or legal error and attempts to raise arguments it abandoned or never raised to the Board. Nor does the Request present any important issues of law or policy. As such, the Request should be denied for this additional and independent reason.

VI. CONCLUSION

For the foregoing reasons, the Request should be denied.

Dated: May 2, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the foregoing Authorized Response to Director's Review Request is being served on counsel of record by filing this document through the Patent Review Processing System, with a copy served via electronic mail to the following email address, as authorized in the Petition:

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Dated: May 2, 2025

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