

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

INERGY TECHNOLOGY, INC.,
Petitioner,

v.

FORCE MOS TECHNOLOGY CO., LTD.,
Patent Owner.

IPR2024-00094
Patent 7,812,409 B2

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual
Property and Director of the United States Patent and Trademark Office.*

ORDER

Force MOS Technology Co., Ltd. (“Patent Owner”) filed a request for Director Review of the Final Written Decision (“Decision”) in the above-captioned case, and Inergy Technology, Inc. (“Petitioner”) filed an authorized response to the request. *See* Paper 38 (“DR Request”); Paper 39.

Patent Owner argued that Director Review should be granted to reverse the Board’s Final Written Decision (Paper 37, “Decision”) because the Board found the claims of the challenged patent unpatentable, while a district court and jury both determined that claim 1 of the challenged patent was not invalid when Petitioner’s real party in interest, ASUSTeK Computer, Inc. (“ASUSTeK”), presented the same prior art and invalidity grounds in the district court proceeding. DR Request 1, 9–10 (raising the February 2025 jury verdict and the district court’s June 2025 findings of fact and conclusions of law, neither of which the Board assessed). Petitioner disagreed. Paper 39, 4–5.

Because the Board did not have an opportunity to assess the jury’s determination or the district court’s relevant findings, the parties were authorized to file additional briefing and submit a joint exhibit of relevant excerpts from the related district court proceeding. Paper 41 (“Briefing Order”). The Briefing Order explained that this additional information was necessary to determine whether Director Review is appropriate. *Id.* at 3.

After considering the Director Review request, the response, and the parties’ additional briefs and joint exhibit, the Director Review request is denied.

It is important for the Board to consider a district court’s prior validity determination when adjudicating patentability of the same or substantially the same claims. Briefing Order 3. If the Board reaches a different outcome

than a district court, the Board must explain why the different outcome is warranted. *See* Memorandum entitled “PTAB consideration of prior findings of fact and conclusions of law,” (Sept. 16, 2025).¹ Here, although the Board reached a different outcome than the district court, the different outcome was warranted.

On October 27, 2023, Petitioner filed its Petition asserting that claims 1–6 of the challenged patent were unpatentable as anticipated by Kobayashi² and as obvious over Kobayashi and Hshieh.³ For its obviousness case, Petitioner presented motivation to combine arguments and evidence with the Petition, including that a person of ordinary skill in the art would have used a known technique (rounding corners) to address a known problem in semiconductor structure art (corner vulnerability) and that Hshieh expressly teaches benefits of rounding corners. *See* Paper 1, 58–62; Ex. 1003 ¶¶ 136–141 (Dr. Liu’s testimony regarding motivation to combine); *see also* Decision 25–26 (setting forth Petitioner’s obviousness rationales and citing Petitioner’s evidence supporting those rationales). The Board agreed with Petitioner that there would have been a motivation to combine Kobayashi’s and Hshieh’s teachings. *See* Decision 29–36.

Trial in the district court occurred in February 2025—more than a year after Petitioner filed its Petition. During trial, ASUSTeK presented arguments and evidence that claim 1 of the patent was invalid as obvious over the same Kobayashi and Hshieh references. *See* Ex. 2031, 15–17. But

¹ Available at https://www.uspto.gov/sites/default/files/documents/Memo_re_prior_findings_of_fact_and_conclusions_of_law_9_16_25.pdf.

² US 6,888,196 B2, issued May 3, 2005 (Ex. 1005).

³ US 5,763,914, issued June 9, 1998 (Ex. 1006).

in the district court, ASUSTeK failed to make the above arguments as to motivation to combine. *See id.* Instead, in the district court trial, “the only motivation to combine argument” ASUSTeK advanced was that Kobayashi and Hsieh “were the same subject matter, same kind of device, and trying to solve the same problem,” which was “inadequate to demonstrate a motivation to combine.” Ex. 2031, 175 (district court findings of fact, citing ASUSTeK’s expert testimony from the jury trial and finding that testimony conclusory).⁴

Additionally, a central dispute before the Board in this case was whether top view rounding of cell corners, as Hsieh discloses, was known in the art to prevent corner vulnerability and supported a motivation to combine. *See, e.g.*, Decision 28–30. As to top view rounding, the Board and the district court found the patent applicant did not dispute that the Pfirsch⁵ reference the examiner applied during examination discloses “substantially square-shaped cells with rounded corners,” (i.e. top view rounding). Ex. 2031, 173–74; *see* Decision 12, 29 (discussing Pfirsch). And both the Board and the district court found that Pfirsch is concerned with addressing corner vulnerability. Ex. 2031, 174; Decision 29, 35–36. The Board’s decision on this central dispute, therefore, is consistent with the district court’s findings of fact.

In view of the foregoing, it is:

ORDERED that the request for Director Review is denied.

⁴ Patent Owner’s argument that the Board’s subsidiary factual findings underlying its obviousness conclusion contradict the district court and jury’s implied and express findings is not persuasive. Paper 42, 7–10.

⁵ US 6,541,818 B2, issued Apr. 1, 2003 (Ex. 1011).

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