

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROCHIP TECHNOLOGY INC.,
Petitioner,

v.

APTIV TECHNOLOGIES AG AND APTIV TECHNOLOGIES LIMITED,
Patent Owners.

Case Nos. IPR2024-00495
U.S. Patent No. 9,619,420

**PETITIONER'S EXPLANATION FOR AND RANKING OF TWO
PETITIONS CHALLENGING U.S. PATENT NO. 9,619,420**

I. INTRODUCTION

Pursuant to the November 2019 Consolidated Trial Practice Guide (“Guide”), Petitioner, Microchip Technology Inc. (“Microchip”) provides this explanation of multiple petitions challenging U.S. Pat. 9,619,420 (the “’420 patent”). Microchip presents two petitions, each of which applies the same ground based on two prior art references: U.S. Pat. Pub. 2006/0206650 (EX1014, “Chang”); and U.S. Pat. Pub. 2009/0268743 (EX1015, “Chang II”). The petitions differ in respect to the particular claims challenged in each, and only a single ground is presented in each petition. The multiple petitions are justified by the number of claims Patent Owner has asserted in the related district court litigation (*i.e.*, all 20 claims of the ’420 patent), the depth of analysis presented in the petitions, Patent Owner’s belated disclosure to rewrite/correct certain claims, and the petition word limit.

II. EXPLANATION OF MATERIAL DIFFERENCES AND REASONS WHY MORE THAN ONE PETITION SHOULD BE INSTITUTED

Each of the petitions is materially distinguishable from the other by virtue of challenging a unique claim set. The petition in IPR2024-00228 challenges claims 1-12 and 15-17. The petition in IPR2024-00495 challenges claims 13-14 and 18-20. The ’420 patent has five independent claims (1, 7, 13, 15, and 18). There are no overlapping claims in these petitions. Therefore, the petitions present materially different challenges, each to a unique subset of ’420 patent claims.

Microchip notes that Patent Owner has asserted every claim from all six related patents in the district court litigation, for a total of 78 asserted claims. For four of the asserted patents, Microchip filed just one IPR each. But for two of the patents, including the '420 patent, the number of claims and issues necessitated two IPRs each. Challenging all claims in a single petition would significantly reduce the amount of analysis provided, prejudicing Microchip's ability to explain the basis of unpatentability in view of the subject matter at issue.

In addition, both petitions provide explanations why the Board should not exercise its discretion to deny institution under §325(d). This includes an analysis of the file histories for all six related patents in the same family, which limits the space available to address the merits of unpatentability. Accordingly, two petitions are necessary in order to address each of the challenged claims in sufficient detail. Guide, 59 (“[T]here may be circumstances in which more than one petition may be necessary, including, for example, when the patent owner has asserted a large number of claims in litigation.”).

The second petition has been filed due to the word count limit for petitions, the number of asserted claims, and the need to address each challenged claim in sufficient detail. The second petition is not submitted to present additional grounds or unpatentability theories for the same claims addressed in first petition.

Beyond the Guide, additional factors support institution of Microchip’s multiple petitions. Microchip filed the first ’420 petition in December, 2023. In November 2023, Patent Owner proposed substantial, non-clerical corrections to independent claims 13 and 18 of the ’420 patent in its supplemental infringement contentions. *See* EX1072, 118, 125, 186. An example is shown below:

[13.2]	connecting the consumer device via the second USB port to the USB ~~hub~~ <u>host</u> ¹ via the first USB port through the USB routing switch and the	Microchip practices this element literally and/or under the doctrine of equivalents (including through testing of the Microchip Accused Products); actively induces module makers, car manufacturers, and/or their customers to practice this element literally and/or under the doctrine of equivalents; and offers to sell, sells, and/or imports into the United States the Microchip Accused Products to be used in
¹ Although claim 13 states “connecting the consumer device via the second USB port to the USB <u>hub</u> via the first USB port” a POSA would understand the claim to be referring to “the USB <u>host</u> ,” which is defined in the preamble of the claim as being connected to the first USB port (“a first USB port connected to a USB <u>host</u> ”).		

Id., 118 (redlines in original). Patent Owner subsequently proposed the same changes in the parties’ Joint Claim Construction Chart. EX1075, 3-5. Patent Owner’s constructions are below, with revised claim language emphasized.

Claim Element	Claim Language	Patent Owner’s Construction
13[b]	connecting the consumer device via the second USB port to the USB <u>hub</u> via the first USB port through the USB routing switch and the USB bridge	connecting the consumer device via the second USB port to the USB <u>host</u> via the first USB port through the USB routing switch and the USB bridge
13[c]	connecting the consumer device via the second USB port to the USB <u>hub</u> via the first USB port	connecting the consumer device via the second USB port to the USB <u>host</u> via the first USB port

Claim Element	Claim Language	Patent Owner's Construction
	through the USB routing switch and the USB hub	through the USB routing switch and the USB hub
18[a]	a USB hub <i>including</i> a first USB port and a second USB port	a USB hub <i>interconnected to</i> a first USB port and a second USB port

In each instance, Patent Owner's revisions result in substantial architectural changes and significantly broaden the claim. *See* EX1072, 118, 125, 186. Patent Owner maintained these rewrites in district court *Markman* briefing. *See* EX1076, 5-8. Petitioner disagrees with Patent Owner's constructions and believes the plain and ordinary meaning applies. EX1077, 7-10; EX1075, 3-5.

Patent Owner's belated disclosure of its proposed corrections to independent claims 13 and 18 necessitated filing an IPR petition on these claims (and their dependent claims). Patent Owner also proposed rewriting the claims of two other related patents. *See* EX1072, 339, 408-409. Thus, Microchip filed the second petition on the '420 patent (together with three other IPR petitions on related patents, all of which Patent Owner was trying to correct). *See* IPR2024-00494, IPR2024-00558, IPR2024-00495, and IPR2024-00496 (the "Wave 2 Petitions"). The Wave 2 Petitions all rely on substantially similar prior art and arguments. Thus, the Wave 2 Petitions will be able to track the same schedule post-institution, maximizing the efficiency of depositions, briefing, and oral argument. In addition,

Microchip uses the same expert witness to support all petitions, which should avoid the necessity of separate depositions for each petition.

III. ORDERING OF PETITIONS

For the reasons discussed above, the Board should grant institution for both petitions. Under the circumstances, a ranking of petitions is not appropriate given that they challenge unique claim sets with no overlap. However, in view of the guidance in the consolidated trial practice guide (Guide, 60), Microchip requests that the Board consider the petitions in the following order.

Order	IPR Case No.	Challenged Claims
1	IPR2024-00228	1-12 and 15-17
2	IPR2024-00495	13-14 and 18-20

Petitioner notes that IPR2024-00495 demonstrates how the prior art renders '420 patent claims 13-14 and 18-20 unpatentable under Patent Owner's constructions. Petitioner does not contend the Ground herein renders the Challenged Claims unpatentable under the plain and ordinary meaning. The district court *Markman* hearing is scheduled for June 4, 2024. *Aptiv Technologies AG v. Microchip Technology Inc.*, Case No. 1:23-cv-00307-JDW, Dkt. 67 (D. Del., March 20, 2023). Thus, the Board should have the benefit of the district court's *Markman* ruling before making its Institution Decisions.

IV. CONCLUSION

Microchip requests that the Board grant institution for both petitions.

Respectfully submitted,

Dated: February 27, 2024

/Travis Jensen/

Travis Jensen, Reg. No. 60,087

CERTIFICATE OF SERVICE

The undersigned hereby confirms that the foregoing PETITIONER'S EXPLANATION FOR AND RANKING OF TWO PETITIONS CHALLENGING U.S. PATENT NO. 9,619,420 was caused to be served on February 27, 2024 via overnight courier on the Patent Owner at the correspondence address of record for U.S. Pat. No. 9,619,420:

David Ford
Daniel Brock
22851 - Aptiv
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Courtesy copies were also served via email on Patent Owner's counsel of record in a related district court action styled *Aptiv Technologies AG v. Microchip Technology Inc.*, Case No. 1:23-cv-00307-JDW (D. Del., March 20, 2023):

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