

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APTIV SERVICES US, LLC,
Petitioner,

v.

MICROCHIP TECHNOLOGY INC,
Patent Owner.

Case No. IPR2024-00646
U.S. Patent No. 9,471,074

**PATENT OWNER'S MOTION TO STRIKE PETITIONER'S
NEW AND UNTIMELY INVALIDITY THEORY**

As authorized via Board email on April 25, 2025, Patent Owner (“PO”) respectfully submits this Motion to Strike Petitioner’s New and Untimely Invalidity Theory. In particular, PO requests that the Board strike §II.E of Petitioner’s Reply (Paper 25) and ¶¶12-15 in EX1028 (the corresponding section in the Second Supplemental Declaration of Dr. Michael S. Chen, “Reply Dec.”).

I. BACKGROUND

Claim element 1[b] requires ***a gm enhanced current buffer driver***. Claim element 1[c] separately requires ***a biasing circuit ... to set a biasing ratio for gm-boost of the current buffer driver***. The terms ***gm-boost*** and ***gm-enhance[ment]*** are distinct claim limitations which must both be satisfied. See POR (Paper, 19), §§V, IV.A. Not only are the terms ***gm-boost*** and ***gm-enhance[ment]*** different on their face (and thus presumed to connote different meanings, *id.*, 20-21 (citing cases)), but the ’074 specification confirms they are distinct requirements achieved through different circuit techniques (*id.*, 16-18 (analyzing specification and showing different transistors/techniques for each), 21-23; EX2021 (Taylor), ¶¶84-87, 66-71).

The Petition ignored the fundamental claim construction canon that different terms are presumed to connote different requirements. *E.g.*, *CAE Screenplates, Inc. v. Heinrich Fiedler Gmbh & Co. Kg*, 224 F.3d 1308, 1317 (Fed. Cir. 2000). The Petition conflated the distinct ***gm-boost*** and ***gm-enhance[ment]*** claim terms. While the Petition recites the elements under separate headings, the analysis (and the

underlying circuitry it points to) is substantially the same, collapsing the two requirements into one. This is true for both the Rincon-Mora and Al-Shyoukh grounds. See Pet., 16-21 (for Al-Shyoukh) and 58-62 (for Rincon-Mora).

The POR pointed out what was self-apparent all along—that **gm-boost** and **gm-enhance[ment]** are different terms with different meanings (POR, §§V, IV.A) and that the Petition failed to show that Rincon-Mora or Al-Shyoukh disclose **gm enhance[ment]** (*id.*, §VII.A). Seeking to fill the Petition’s gap, the Reply introduced—for the first time—a new theory mapping Al-Shyoukh transistor Q20 to the **gm-enhance[ment]** limitation. Reply, §II.E; *see also* Reply Dec., ¶¶12-15.

II. ARGUMENT

It is well established a Petitioner must make out its case in the Petition, and is prohibited from introducing new invalidity theories in reply. See 2019 Consolidated Trial Practice Guide, 74. There is no dispute the Petition never pointed to Al-Shyoukh transistor Q20 for the **gm-enhance[ment]** limitation. Nevertheless, Petitioner’s Reply (§II.E) introduces a new invalidity theory—pointing to transistor Q20 for the first time—for why Al-Shyoukh satisfies the **gm-enhance[ment]** limitation. This is improper.

Petitioner seeks to justify its new Reply theory by citing *Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374 (Fed. Cir. 2023), which allowed a reply brief to map the prior art under a patent owner’s construction. Reply, 9. But *Axonics* is readily

distinguishable because “[t]he Board made no finding that [petitioner] clearly anticipated the two-input construction.” *Axonics*, 1374 F.4th at 1383 (n.10). Here, by contrast, the Board can—and should—make such a finding (*viz.*, Petitioner should have known different claim terms connote different meanings). *See* §I.

The Federal Circuit’s reasoning in *Axonics* favors PO here. The Federal Circuit was concerned that “[b]arring argument and evidence in a reply directed to a new claim construction proposed by the patent owner would create opportunities for sandbagging by the patent owner.” *Axonics*, 1374 F.4th at 1384. Here, it is Petitioner—not PO—that sought a tactical advantage by sandbagging (*viz.*, avoiding claim construction in a manner contrary to well-established claim construction principles to shift the burden to PO to explain the terms and disclose its position first, and only then introduce Petitioner’s invalidity theory). 37 CFR §42.104(b)(3); *CAE Screenplates*, 224 F.3d at 1317.

The Reply asserts “it is sufficient for the Board to reject PO’s proposed construction and apply a meaning of ‘gm enhanced’ that does not require a separate technique for increasing gm from ‘gm-boost.’” Reply, 6. But this improperly shifts the burden onto PO to prove *gm-boost* and *gm enhanced* mean different things when it was Petitioner’s burden in the Petition to explain why they mean the same thing. ID, 12-13 (Dr. Chen did “not [] interpret the claim language”). The Board should reject Petitioner’s gamesmanship and strike the new theory in §II.E of the Reply.

Respectfully submitted,

Dated: May 9, 2025

/Travis Jensen/

Travis Jensen, Reg. No. 60,087
Orrick, Herrington & Sutcliffe LLP
1000 Marsh Road
Menlo Park, CA 94025-1015

Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned certifies that on May 9, 2025, a copy of the following was served in its entirety via electronic mail, upon the following attorneys of record for Petitioner:

Alex S. Yap Mehran Arjomand Bryan Blumenkopf Stephen Liu MORRISON & FOERSTER LLP 707 Wilshire Boulevard, Suite 6000 Los Angeles, CA 90017	ayap@mofo.com marjomand@mofo.com bblumen@mofo.com sliu@mofo.com Aptiv-Microchip-PTAB@mofo.com
---	--

/Karen Johnson/
Karen Johnson