

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APTIV SERVICES US, LLC,
Petitioner,

v.

MICROCHIP TECHNOLOGY INC.,
Patent Owner.

Patent No. 9,471,074

Inter Partes Review No. IPR2024-00646

**PETITIONER'S OPPOSITION TO
PATENT OWNER'S MOTION TO STRIKE**

Aptiv presents an argument in the alternative that applies a claim construction that was raised for the first time in the Patent Owner's Response. The Federal Circuit approved of this exact approach in *Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374 (Fed. Cir. 2023). Thus, the Board should deny Patent Owner's motion to strike.

I. BACKGROUND

The Petition stated clearly that a current buffer driver under claim 1 of the '074 patent is "gm enhanced" if it receives a gm boost. (*See* Paper 1 (Petition), 16, 58.) Patent Owner did not dispute this in its Preliminary Response, despite raising other claim construction issues. (*See* Paper 7 (POPR), 41-57.) Thus, in its Decision on Institution, the Board accepted Aptiv's position that the prior art discloses a buffer driver that "is 'gm enhanced' because it receives a gm boost." (Paper 11, 19.)

Only in the POR did Patent Owner first dispute whether a buffer driver is "gm enhanced" if it receives a gm boost. (Paper 19, 20-23.) To try to show that the claims require two distinct methods of increasing gm, Patent Owner pointed to an alleged "gm enhancement" mechanism it had never previously identified. (*Id.*)

As shown in Aptiv's Reply, Patent Owner's construction is wrong. (*See* Paper 25 (Reply), 2-8.) Nevertheless, as Aptiv was previously unaware of the construction, the Reply presented an argument in the alternative, demonstrating that the prior art would still meet the new construction. (*Id.*, 9-11.)

II. ARGUMENT

In *Axonics*, the Federal Circuit held:

where a patent owner in an IPR first proposes a claim construction in a patent owner response, a petitioner must be given the opportunity in its reply to argue and present evidence of anticipation or obviousness under the new construction, at least where it relies on the same embodiments for each invalidity ground as were relied on in the petition.

75 F.4th at 1384. That is precisely the situation here. For the first time in its POR, Patent Owner disputed the Petition’s interpretation of a “gm enhanced” buffer driver being a buffer driver that receives a gm boost. On Reply, Aptiv raised an argument in the alternative that applies Patent Owner’s construction of “gm enhanced” to the same Al-Shyoukh embodiment on which the Petition relies. (*Compare* Paper 25 (Reply), 9-11 *with* Paper 1 (Petition), 15-52.)

Patent Owner makes the same argument that *Axonics* rejected. There, patent owner Medtronic argued that Axonics had “anticipated” Medtronic’s construction and thus should have addressed it in the petition. 75 F.4th at 1383 n.10. The Federal Circuit rejected this argument’s legal premise because “the regulation that governs the content of a petition . . . ***does not direct a petitioner to raise, address, and apply alternative possible constructions***, but instead requires a petitioner affirmatively to state ‘[h]ow the challenged claim is to be construed.’” *Id.* (emphasis added) (quoting 37 C.F.R. § 42.104(b)(3)). Separately, it rejected the argument’s factual premise, as

the Board never found that Axonics had anticipated the construction. *Id.*

Focusing only on the latter, Patent Owner asks the Board to strike based on a finding that Aptiv anticipated its construction. Of course, Aptiv did not and had no reason to anticipate a construction that is incorrect and divorced from the intrinsic evidence. (*See* Paper 25 (Reply), 2-8.) But more importantly, *Axonics* rejects Patent Owner's premise that, even if Aptiv could have anticipated the construction, it was required to address it in the Petition. The Petition explained clearly and affirmatively that the claimed current buffer driver "is 'gm enhanced' because it receives a gm boost." (Paper 1 (Petition), 16). That is all that *Axonics* requires. *See* 75 F.4th 1383, n.10. Patent Owner cites no contrary authority.

Patent Owner's accusations of sandbagging are not well taken. Aptiv did not wait to "introduce [its] invalidity theory." (Paper 27 (Motion), 3.) Aptiv laid out its position on the "gm enhanced" term in the Petition and maintains it now. Moreover, "*Axonics* was decided based on concerns of **patent owners** sandbagging petitioners." *Apple Inc. v. Omni MedSci, Inc.*, No. 2023-1034, 2024 WL 3084509, at *6 (Fed. Cir. June 21, 2024) (emphasis added) (patent owner had failed to raise its construction in POPR). Here, the only gamesmanship is by Patent Owner. It would be manifestly unfair to IPR petitioners if patentees could withhold constructions, as Patent Owner has done, until after institution and then deny petitioners an opportunity to apply those constructions by insisting that they should have been anticipated.

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Certificate of Service (37 C.F.R. § 42.6(e)(4))

I hereby certify that the attached PETITIONER'S OPPOSITION TO
PATENT OWNER'S MOTION TO STRIKE was served as of the below date via
e-mail (by agreement) to the following counsel of record for the Patent Owner:

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