

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 MOTION TO STRIKE

Pursuant to the Board’s email authorization dated May 22, 2025, Petitioner submits this motion to strike the paragraph spanning pages 27-28 of Patent Owner’s Sur-Reply. That paragraph raises a new argument as to why a POSITA allegedly would have lacked motivation to modify the petitioned prior art. It does not “only respond to arguments raised in” the Reply. *See* 37 C.F.R. § 42.23(b).

I. BACKGROUND

The Petition explains why a POSITA would have been motivated to modify the circuits of Al-Shyoukh and Rincon-Mora based on Ivanov, which teaches a well-known technique of enabling/disabling bias circuitry to save power. (Paper 1, 21-26, 62-66.) In its POR, Patent Owner argued that the circuits of Al-Shyoukh and Rincon-Mora were “already ‘power efficient,’” and thus taught away from trying to improve their efficiency further in view of Ivanov. (Paper 19, 58-65.) Patent Owner based this argument on specific quiescent current values reported by the Al-Shyoukh and Rincon-Mora references: 20 μ A and 23 μ A, respectively. (*See id.*, 62.) In addition, Patent Owner argued that a POSITA would not have found the reduction from 20/23 μ A to an alleged 5 μ A trickle current of Ivanov to be worthwhile. (*Id.*, 67-68.) On Reply, Aptiv duly responded to this 20/23 μ A-based argument. (Paper 25, 18-23, 24-25.) But in its Sur-Reply, Patent Owner changed its argument, now contending that by the ’074 patent’s claimed 2013 priority date, “manufacturing advancements” would have made the prior art’s quiescent currents “much smaller

than the amount considered *de minimis* when those references [Al-Shyoukh and Rincon-Mora] first published.” (Paper 29, 27-28.)

II. ARGUMENT

Patent Owner’s new sur-reply argument is improper. At no point did the POR disclose a motivation-to-combine analysis that accounts for alleged manufacturing advancements between the time of the prior art and the ’074 patent’s priority date. Nor does the new argument respond to any argument in Aptiv’s Reply. Rather, the Sur-Reply impermissibly “proceed[s] in a new direction with a new approach.” *See* PTAB Consolidated Trial Practice Guide at 74 (Nov. 2019).

The Federal Circuit rejected a similar strategy in *ParkerVision, Inc. v. Vidal*, 88 F.4th 969 (Fed. Cir. 2023). There, ParkerVision argued in its POR that the prior art’s capacitors were not “storage elements” because they were not part of “an energy transfer system.” *Id.* at 980. But, on sur-reply, ParkerVision improperly pivoted, arguing that the capacitors were not “storage elements” because they stored “negligible amounts of energy.” *Id.* at 981.

Likewise, here, the POR presents one theory (based on the prior art’s reported 20/23 μ A currents) and the Sur-Reply another (relying on an allegedly smaller set of currents based on manufacturing improvements not reflected in the prior art). That the two theories have the same conclusion—teaching away—does not make the new one proper, as *ParkerVision* shows. *See id.* (ParkerVision’s improper new theory,

like its old one, supported an argument that capacitors were not “storage elements”).

The Sur-Reply disguises its new argument as a purported response to Aptiv’s discussion of the MIC3385 datasheet. (*See* Paper 29, 27.) Aptiv’s Reply cites the datasheet—which describes a device that reduces a 29 μA quiescent current to a 5 μA “shutdown” current—as evidence that the 20/23 μA to 5 μA reduction criticized in the POR would have been entirely reasonable to a POSITA. (Paper 25, 24.) That is, Aptiv was responding specifically to the POR’s **20/23 μA** argument. Aptiv was not invoking the state of manufacturing technology.

It likewise makes no difference that the evidence supporting the Sur-Reply’s new argument (Dr. Taylor’s redirect testimony) was available to Aptiv when it filed its Reply. *See Netflix, Inc. v. Avago Techs. Int’l Sales Pte. Ltd.*, No. IPR2021-01298, 2023 WL 1779866, at *16 n.19 (P.T.A.B. Feb. 6, 2023) (patent owner’s reliance on previously uncited prior art passage was improper “attempt to change its argument” on sur-reply). Again, the POR presents a distinct teaching away argument based on the prior art’s reported 20/23 μA currents. Patent Owner provided no notice that it was also invoking different values based on manufacturing advancements. Indeed, the POR’s one mention of manufacturing technology concerns differences between Al-Shyoukh and Rincon-Mora, not between those references and 2013 technology.

The Board should not permit Patent Owner to present one theory in its POR and then pivot to a different theory on sur-reply after reading Aptiv’s Reply.

Dated: May 30, 2025

By: /Stephen Liu/
Stephen Liu
Admitted *Pro Hac Vice*
MORRISON & FOERSTER LLP
755 Page Mill Road
Palo Alto, CA 94304-1018
Email: SLiu@mofo.com
Tel: (650) 813-6493

Counsel for Petitioner

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

I hereby certify that the attached PETITIONER'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:

Travis Jensen (Registration No. 60,087)
tjensen@orrick.com
T61PTABDocket@orrick.com
Jeremy Jason Lang (Registration No. 73,604)
jlang@orrick.com
PTABDocketJJL2@orrick.com
Orrick, Herrington & Sutcliffe LLP
1000 Marsh Road
Menlo Park, CA 94025-1015

Dated: May 30, 2025

/Stephen Liu/
Stephen Liu