

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 EXCLUDE EVIDENCE

Pursuant to the Scheduling Order and 37 C.F.R. §§ 42.61(a) and 42.64(c), Aptiv moves to exclude the redirect testimony of Dr. Greg Taylor as reflected in EX1029, transcript pages 113:1-118:21. In this portion of the redirect examination, Patent Owner improperly elicited testimony going beyond the scope of the cross-examination. Aptiv timely objected to this testimony. (EX1029, 113:6, 113:21, 114:15, 115:6, 115:14, 116:2-3, 116:16, 117:8, 117:21, 118:16.) If admitted, this evidence would prejudice Aptiv because it is the sole basis for a new argument raised by Patent Owner on sur-reply. (*See* Paper 33 (Petitioner’s Motion to Strike).) As the prejudicial nature of Patent Owner’s improper questioning would outweigh any probative value, exclusion is appropriate.

In its redirect examination of its expert, Patent Owner elicited testimony about how advancements in manufacturing technology would allegedly have impacted a POSITA’s “motivation to add enable or disable functionality to” the designs of either Rincon-Mora or Al-Shyoukh (Aptiv’s primary prior art references). (*See* EX1029, 118:11-21; *see also id.*, 113:2-118:9.) Thus, Dr. Taylor testified that advancements in manufacturing technology between the time those references were published and the ’074 patent’s claimed priority date of 2013 would have allowed the Rincon-Mora and Al-Shyoukh circuits to be implemented with “lower leakage [current] and higher performance.” (*Id.*, 115:10-116:12.) According to Dr. Taylor, this would “reduce the motivation” to add an enable/disable function to the prior art. (*Id.*, 118:11-21.)

This testimony improperly exceeded the scope of cross-examination. *See Sony Interactive Ent. LLC v. Quantum Imaging LLC*, No. IPR2023-00954, Paper 22 at 5 (P.T.A.B. Mar. 13, 2024) (following “[t]he tradition in the federal courts” as set forth in *United States v. Riggi*, 951 F.2d 1368, 1375 (3d Cir. 1991) “to limit the scope of redirect examination to the subject matter brought out on cross-examination”). In particular, Patent Owner’s line of questioning neither responded nor related to the substance of the cross-examination. Searching for a hook, Patent Owner began by asking Dr. Taylor whether he recalled “being asked some questions that related to the amount of leakage in transistors and how that contributes to quiescent current.” (*Id.*, 113:2-5.) Dr. Taylor correctly answered, “In *one of these data sheets*, yes.” (*Id.*, 113:7.) He was referencing what Patent Owner submitted as EX2012; during the cross-examination, Dr. Taylor discussed how the circuit components shown in Figure 3 of that document would contribute to the quiescent current of the underlying device. (*Id.*, 90:9-93:16.) In one of his answers, Dr. Taylor mentioned “the leakage in the transistors” along with “[t]he precise values of the resistors” and “operating points” like temperature and “ $V_{[IN]}$ ” among the “[m]any things [that] contribute to” the device’s quiescent current.” (*Id.*, 91:25-92:10.)

Notably, Dr. Taylor’s cross-examination testimony did *not* touch on (1) the quiescent currents of any other devices besides the regulator described in EX2012, including those of Rincon-Mora and Al-Shyoukh; (2) the impact of manufacturing

technology on quiescent current; or (3) the state of manufacturing technology at any time, including 2013. Rather, his one passing mention of “leakage” related to a set of specific transistors in the specific device shown in EX2012. This was clearly also Dr. Taylor’s understanding of what he had been asked and what he had testified on cross-examination. (*Id.*, 113:7.) Patent Owner’s questioning therefore went far beyond the proper scope of redirect examination.

In fact, Patent Owner’s questioning of Dr. Taylor on redirect was the first time any witness or party to this proceeding discussed or introduced evidence regarding the state of manufacturing technology in 2013. If Patent Owner wished to submit such evidence, it should have done so “in the form of an affidavit,” as it did for the opinions contained in Dr. Taylor’s declaration that was filed with the POR. *See* 37 C.F.R. § 42.53(a) (“Uncompelled direct testimony must be submitted in the form of an affidavit.”). Had Patent Owner done so, Aptiv would have had an opportunity to review and assess the evidence in order to question Dr. Taylor about it. But instead, Patent Owner ambushed Aptiv by forcing it into the redirect examination.

Indeed, Patent Owner has since incorporated Dr. Taylor’s improperly elicited testimony into its Sur-Reply, raising a new argument against motivation to combine in view of alleged manufacturing improvements between the date Aptiv’s prior art and 2013. (*See* Paper 29, 27-28.) Thus, Patent Owner’s redirect tactic appears to be part of its strategy of injecting new theories of patentability late in this proceeding.

(See Paper 33.)

The Board in *Sony Interactive* denied a party's attempt at a similar strategy. See No. IPR2023-00954, Paper 22 at 5. There, petitioner sought to ask a deponent about another witness's declaration on redirect, even though patent owner's cross-examination did not include any substantive questions about the declaration. *Id.* Although the deponent raised the declaration in response to his preparation for the deposition, this did not "open the door to redirect testimony" on the declaration. *Id.*

Likewise, here, Dr. Taylor's single mention of "leakage," without any further elaboration, in response to questions about components in a particular device did not "open the door" to testimony about general advances in transistor manufacturing technology up to the claimed priority date in 2013. Thus, the Board should exclude Dr. Taylor's testimony on leakage currents and manufacturing technology at pages 113:1-118:21 of EX1029.

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

I hereby certify that the attached PETITIONER’S MOTION TO EXCLUDE EVIDENCE 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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