

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 OPPOSITION TO PETITIONER'S
MOTION TO STRIKE**

Patent Owner (“PO”) respectfully submits this Opposition to Petitioner’s Motion to Strike (Paper 33, the “Motion” or “Mot.”). The Board should deny Petitioner’s Motion for at least three reasons. *First*, Petitioner opened the door to the line of argument it complains about at Dr. Taylor’s deposition and then elected not to ask follow-up questions on re-cross. §I. *Second*, the Sur-reply properly responds to arguments raised in the Reply. §II. *Third*, Petitioner applies the wrong temporal reference point (and thus engages in legal error) by ignoring that obviousness is assessed as of the priority date ***of the challenged patent***. §III.

I. PETITIONER INVITED THE LEAKAGE/QUIESCENT CURRENT DISCUSSION IT COMPLAINS OF AT THE TAYLOR DEPOSITION

Petitioner deposed Dr. Taylor ***before*** filing its Reply, where Petitioner invited the very discussion it complains of by asking what “component characteristics or parameters [] would affect quiescent current?” EX1029, 91:25-92:10. Dr. Taylor explained one factor was “leakage in the transistors.” *Id.* Petitioner then asked: “Do[es transistor size] affect quiescent current?” *Id.*, 92:20-22. Dr. Taylor responded “Yes.” *Id.* On redirect, PO simply asked follow-up questions about how transistor size impacts leakage/quiescent current when the ’074 patent was filed in 2013. *Id.*, 113:2-118:21. The redirect at issue lasted less than ten minutes (EX1029, 113:2-118:21), even though the rules provide 4-hours (37 CFR §42.53(c)(2)).

Moreover, Petitioner had the opportunity to ask Dr. Taylor follow-up questions. EX1029, 119:4-20. But Petitioner chose not to do so on the basis that it

was “past 5:00 p.m. Eastern [time],” which is irrelevant since it was only 2:17pm in the pacific time zone where the deposition was taking place. *Id.*, 118:25-119:1 (“VIDEOGRAPHER: ... The time is 2:17 p.m.”). And the total record time was only a few hours, well short of the 7-hour limit. *See generally* EX1029. Petitioner should not be heard to complain about a topic it elicited and cannot complain of prejudice when it had the opportunity to depose Dr. Taylor on the topic.

II. THE SUR-REPLY PROPERLY (AND DIRECTLY) RESPONDS TO PETITIONER’S ARGUMENTS RAISED IN THE REPLY BRIEF

Petitioner invited elaboration on Rincon-Mora and Al-Shyoukh’s leakage/quiescent by addressing it in Reply. Reply, §IV (especially §IV.A). Yet Petitioner now wishes to cabin the topic to a time period many years before the challenged patent’s priority date. This misapplies the law (*see infra* §III). But sur-reply briefs are allowed to “respond to arguments” in the Reply, which is the case here. 37 C.F.R. §42.23(b); *Cisco Sys., Inc. v. K.Mizra LLC*, U.S. App. LEXIS 20720, at *11-12 (Fed. Cir. Aug. 16, 2024) (proper to consider sur-reply introducing “[no] new evidence” and that is a “direct response” to reply).

This distinguishes *Netflix* (Mot. at 3). Unlike the *Netflix* patent owner which “attempt[ed] to change its argument” in sur-reply (IPR2021-01298, Paper 44 at 39, fn. 19), PO here did no such thing. Rather, the Sur-reply directly responded to the Reply’s assertion that Al-Shyoukh and Rincon-Mora’s low stated current still provided a motivation to combine (*e.g.*, Reply, 17-18, 21-22) by noting the current

would be even lower in 2013 (Sur-reply, 27-28). Moreover, the *Netflix* footnote Petitioner cites is dicta. The Board held it “need not (and do[es] not) rely on the [reply arguments] to which [PO responds].” *Id.*, 40. Here, if the Board does not rely on Petitioner’s Reply arguments, it need not consider PO’s responsive Sur-reply.

ParkerVision (Mot. at 2) is also easily distinguished. There, “[the POR] made no mention of whether [prior art] capacitors store non-negligible amounts of energy.” *ParkerVision, Inc. v. Vidal*, 88 F.4th 969, 980 (Fed. Cir. 2023). Here, the POR repeatedly argued that Rincon-Mora and Al-Shyoukh consumed little/no quiescent current. POR, 58-65. Thus, unlike *ParkerVision*, PO’s Sur-reply does not “proceed[] in a new direction relative to [the POR].” *ParkerVision*, 88 F.4th at 980.

III. PETITIONER INVITES LEGAL ERROR ASSESSING OVBIOUSNESS AT THE WRONG POINT IN TIME

The Sur-reply must be able to point out the legal error in Petitioner’s Reply. It is black-letter law that validity is assessed as of the priority date of the challenged patent. *Siemens Med. Sols. USA, Inc. v. Saint-Gobain Ceramics & Plastics, Inc.*, 637 F.3d 1269, 1282 (Fed. Cir. 2011) (“obviousness asks whether a claimed invention ‘would have been obvious at the time the invention was made’”) (quoting 35 U.S.C. § 103(a)). Here, Aptiv admits that ’074 patent’s priority date is no earlier than March 14, 2013. Pet., 1. It would be legal error to assess obviousness in view of 1996 or 2007 manufacturing technology (when Rincon-Mora and Al-Shyoukh were first filed/published), but that is precisely what Petitioner does.

Respectfully submitted,

Dated: June 6, 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 June 6, 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
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/Karen Johnson/
Karen Johnson