

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 EXCLUDE EVIDENCE**

Patent Owner respectfully submits this Opposition to Petitioner’s Motion to Exclude Evidence (Paper 35, the “Motion” or “Mot.”). Petitioner previously filed a Motion to Strike (Paper 33) which raises substantively similar arguments. Indeed, Petitioner’s Motion to Exclude Evidence is largely a copycat filing of its Motion to Strike.¹ But Petitioner’s Motion to Exclude fares no better than its Motion to Strike, and the Board should deny both motions for substantially similar reasons. Patent Owner here focuses on just two of those reasons. *First*, as explained in Patent Owner’s Opposition to Petitioner’s Motion to Strike (Paper 37), Petitioner opened the door to the testimony it complains about at Dr. Taylor’s deposition (and then elected not to ask follow-up questions on re-cross). §I. *Second*, Petitioner would have the Board apply the wrong temporal reference point (and thus engage in legal error) by ignoring that obviousness is assessed as of the priority date of the challenged patent (and taking into account a POSITA’s knowledge). §II.

¹ Patent Owner submits that Petitioner’s duplicative motion is wasteful of the parties’ and Board’s limited time and resources. If the Board were to grant Petitioner’s Motion to Strike (it should not), then the evidence Petitioner now seeks to exclude would be irrelevant. And if the Board denies Petitioner’s Motion to Strike (which it should), then it follows that the Board should also deny Petitioner’s Motion to Exclude the supporting evidence.

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

It is telling that Petitioner's Motion jumps immediately to Dr. Taylor's redirect testimony, glossing over the context/background of the proceeding and giving only lip-service to the underlying cross-examination that gave rise to the redirect testimony. Mot., 1. The reason for Petitioner's shortcut is plain—*Petitioner opened the door to the very discussion and testimony it complains about.*

Petitioner invited the discussion it seeks to exclude 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, including in 2013 when the Challenged Patent was filed (which, as discussed *infra*, is the relevant date for the invalidity analysis). *Id.*, 113:2-118:21. The redirect testimony at issue lasted less than ten minutes. EX1029, 113:2-118:21. The Board's rules would not provide for 4-hours of redirect testimony (*see* 37 CFR §42.53(c)(2)) if such testimony had to be cabined in the way Petitioner proposes.

The *Sony* case Petitioner relies on (cited in Mot. at 2, 4) is easily distinguished and, if anything, supports Patent Owner. Indeed, it brings to the fore the very reason Dr. Taylor's testimony should **not** be excluded. In *Sony*, the petitioner (who was

defending its expert's deposition) sought to introduce a ***totally new declaration from a different individual*** on redirect. *Sony Interactive Ent. LLC v. Quantum Imaging LLC*, IPR2023-00954, Paper 22 at 3-4 (PTAB Mar. 13, 2024) (“The Sakuta declaration, which apparently originated in related district court litigation, is not currently in the record of these proceedings.). When the patent owner halted the deposition, the petitioner sought relief from the Board and requested 2-hours to question its own expert about the new declaration. *Id.* (“[Petitioner] requested the Board’s authorization to continue the deposition of Mr. Crane for an additional two hours to question Mr. Crane regarding the Sakuta declaration”).

Unsurprisingly, the Board denied petitioner’s request. *Id.*, 6 (“Petitioner’s request to continue the deposition of Mr. Crane is denied.”). In doing so, the Board explained that “Petitioner had not even identified the Sakuta declaration to Patent Owner before the deposition.” *Id.* The Board also noted that “Patent Owner has not had an opportunity to depose Mr. Sakuta,” and that the petitioner balked when asked to present the declarant (Mr. Sakuta) for deposition. *Id.*, 4. None of these factors are it issue in the instant case. To the contrary, Patent Owner here did not introduce any exhibits at all (let alone any new exhibits) during Dr. Taylor’s short redirect testimony. And unlike the petitioner in *Sony* which refused to make the declarant available for deposition, the Petitioner here had every opportunity to ask Dr. Taylor any questions it wished (including follow-up questions), but Petitioner declined to

do so on the basis that it was “past 5:00 p.m. Eastern [time].” EX1029, 118:25-119:20. This excuse was pretextual because 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.

Perhaps the most significant point of contrast between *Sony* and the instant case is the nature of the question that was asked which elicited the redirect testimony. In *Sony*, the cross-examination question posed to the witness was “[w]hat did you do to prepare for your cross-examination today?” *Sony*, Paper 22 at 6. In response, the witness said he reviewed the Sakuta declaration. *Id.* Thus, it was an easy call for the Board to conclude that “[t]his does not reasonably open the door to [2 hours of] redirect testimony by Mr. Crane regarding the Sakuta declaration.” *Id.* By contrast, Petitioner here asked far more specific questions intended to elicit substantive testimony (which it incorrectly thought would be helpful) about what “component characteristics or parameters [] would affect quiescent current” (EX1029, 91:25-92:10) and whether “[transistor size] affect[s] quiescent current?” (*id.*, 92:20-22). Patent Owner was plainly entitled to conduct a limited (less than 10-minute) redirect on this subject.

Indeed, *Sony* cites to *U.S. v. Carter* whose approach to redirect goes even further than what is at issue here, stating that “[w]hen a party opens up a subject,

even though it may not be strictly relevant to the case, he cannot complain ... if the opposing party introduces evidence on the same subject.” *Sony*, Paper 22 at 5 (quoting *U.S. v. Carter*, 720 F.2d 941, 948 (7th Cir. 1983)). Here, the subject of quiescent current and leakage was front and center in Patent Owner’s Response brief. *E.g.*, Paper 19 (POR), 58-65 (explaining why Rincon-Mora and Al-Shyoukh’s zero/*de minimus* quiescent current provide no motivation to combine). Certainly, if redirect testimony on a subject that “may not be strictly relevant to the case” is appropriate as in *U.S. v. Carter* because a party “open[ed] up” the subject, the redirect testimony here (the factors contributing to quiescent/leakage current circa 2013 when the challenged patent was filed) is appropriate and should not be excluded.

Petitioner’s “data sheet” argument is a red herring. Mot., 2. Stuck with the fact that it opened the door to a line of questioning it now regrets, Petitioner seeks to cabin that testimony to a particular data sheet. *Id.* But the effects of transistor channel length/size on quiescent current and leakage (*viz.* reduced leakage current) due to advances in manufacturing processes/tolerances are universal. The improvements are not limited to any particular data sheet or design, but are generally applicable to any circuit manufactured using such a fabrication process. More generally, Petitioner asked Dr. Taylor numerous questions about quiescent current. *E.g.*, EX1029, 80:4-81:15, 86:1-87:9. This included discussion of quiescent current

in multiple datasheets and how it was the same/different as the Rincon-Mora and Al-Shyoukh references. *Id.*, 86:25-87:9. Especially considering that (after opening the door) Petitioner was afforded the opportunity to follow-up on re-cross, it should not be heard to complain of any prejudice.

Further, Petitioner's assertion that "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" (Mot. at 3) is, at best, an overstatement. The prior art references themselves disclose the manufacturing technology used. *E.g.*, EX1004 (Al-Shyoukh), Table II (identifying the manufacturing technology nodes (*e.g.*, 2.0 μ m, 1.0 μ m, 0.36 μ m, etc.) for all six voltage regulators discussed in Al-Shyoukh, including the Rincon-Mora regulator (*viz.*, refence [1] in Al-Shyoukh)). Moreover, Dr. Taylor's declaration (and Patent Owner's Response expressly noted the "5 generations of technology" manufacturing difference between the "2 μ m technology used by Rincon-Mora" and the "0.35 μ m technology used by Al-Shyoukh." EX2021 ("Taylor Dec."), ¶95. Similarly, Patent Owner's Response brief explained that "[m]uch of Al-Shyoukh's improved output current is attributable to a 0.35 μ m technology process instead of 2 μ m technology used by Rincon-Mora." Paper 19, ("POR"), 32. Petitioner's assertion that it was "ambushed" (Mot., 3) by testimony about quiescent current or manufacturing technology is hyperbole.

In summary, Petitioner should not be heard to complain about testimony on a topic it elicited (relating to quiescent/leakage current issues squarely in the case), particularly where Petitioner had the opportunity to depose Dr. Taylor further on the topic but declined to do so on a plainly pretextual basis.

II. PETITIONER INVITES THE BOARD TO COMMIT LEGAL ERROR BY ASSESSING OVBIOUSNESS AT THE WRONG POINT IN TIME

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, Petitioner 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) when the relevant date is 2013, but that is precisely what Petitioner invites the Board to do by excluding evidence of the state of the art at the effective filing date of the ’074 patent.

III. CONCLUSION

Patent Owner respectfully requests that the Board deny Petitioner’s Motion to Exclude Evidence.

Respectfully submitted,

Dated: June 11, 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 11, 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