

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VICOR CORPORATION,
Petitioner,

v.

DELTA ELECTRONICS, INC.,
Patent Owner.

IPR2024-00705
Patent 9,819,263 B2

Before THU A. DANG, NATHAN A. ENGELS, and
SHEILA F. McSHANE, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

BACKGROUND

Petitioner e-mailed the Board to request authorization to file preliminary replies to the Patent Owner Preliminary Responses in the above case, and Patent Owner emailed the Board expressing its oppositions to Petitioner's requests. Ex. 3001. The Board conducted a conference call with counsel for the parties to discuss Petitioner's requests and Patent Owner's oppositions. A transcript of the call has been filed. Ex. 1014 ("Tr.").

DISCUSSION

Petitioner requests authorization to file a preliminary reply to Patent Owner's Preliminary Response of up to three pages to address what Petitioner characterizes as (1) "Patent Owner's implicit claim construction for the limitation 'disposed at 1/3 or 2/3 of the height' and Patent Owner's incorrect assertion that the prior art fails to disclose this limitation under Patent Owner's implicit construction"; and (2) "Patent Owner's argument that the petition fails to identify the structure resulting from the 'product by process' limitation." Ex. 3001, 2. According to Petitioner, good cause for additional briefing exists because "Petitioner could not have foreseen Patent Owner's arguments" regarding those issues. *Id.*

Patent Owner opposes Petitioner's request "in part." Ex. 3001, 1. Regarding (1), Patent Owner states that it "never provided any construction" but instead "provided an argument based on the limitation and Petitioner's failure to identify it as presented in the prior art," wherein "Petitioner should not now be able to provide a curative construction that it failed to provide in the Petition." *Id.* Regarding (2), Patent Owner states that it "argued failure of Petition to identify structure" wherein "[t]his Petitioner analysis should

have been in the Petition.” *Id.* Nevertheless, Patent Owner contends that, “[i]f the Board disagrees and believes that good cause is warranted,” it requests a preliminary sur-reply of equal length. *Id.*

As to issue (1), we are unpersuaded that further briefing is necessary to assist us in deciding whether to grant institution. We agree with Patent Owner’s contention that its argument that the prior art fails to disclose the limitation “disposed at 1/3 or 2/3 of the height” only presents an argument regarding Petitioner’s alleged failure to identify a claim limitation as presented in the prior art. Ex. 3001, 1. And Petitioner acknowledges that “the petition [] does contain sufficient information to institute and prevail.” Tr. 18:12–13. Accordingly, as to issue (1), the Board does not require any additional briefing to assess the issues before us.

As to issue (2), we are mindful that a preliminary reply is not a vehicle to cure deficiencies in a petition. However, under the circumstances of this case, upon hearing the parties’ arguments for and against additional preliminary briefing, we determine the requested briefing as to issue (2) will assist us in deciding whether to grant institution in this proceeding. Accordingly, Petitioner’s request for additional briefing is granted as to issue (2).

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner may file, on or before August 20, a two (2)-page preliminary reply to the Patent Owner’s Preliminary Response, addressing issue (2) outlined in Petitioner’s email request (Ex. 3001, 2);

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FURTHER ORDERED that Patent Owner may file a two-page preliminary sur-reply in response to Petitioner's preliminary reply, on or before August 27.

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FOR PETITIONER:

Steven Katz
Lawrence Kolodney
Ryan O'connor
FISH & RICHARDSON P.C.
katz@fr.com
kolodney@fr.com
oconnor@fr.com

FOR PATENT OWNER:

John Schnurer
Miguel Bombach
Yun Lu
PERKINS COIE LLP
Schnurer-ptab@perkinscoie.com
Bombach-ptab@perkinscoie.com
Lu-ptab@perkinscoie.com