

UNITED STATES PATENT AND TRADEMARK
OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

REED SEMICONDUCTOR CORP.,
Petitioner,

v.

MONOLITHIC POWER SYSTEMS, INC.,
Patent Owner,

Case No. IPR2024-01158
Patent No. 9,041,377

**PATENT OWNER'S MOTION TO STRIKE
PORTIONS OF PETITIONER'S REPLY**

Consistent with the Board's authorization, Monolithic Power Systems, Inc.

("Patent Owner") files this Motion to Strike portions of Reed Semiconductor Corp.'s ("Petitioner") Reply relying on Tateishi's Figure 1. (Reply at 17-19.)

Petitioner's Reply introduces a new anticipation theory based on an embodiment (Figure 1) that is different than the embodiment relied on in the Petition. The Petition relies on Figure 3, excerpting and annotating its circuits in detail to address the claim elements.¹ (See Petition at 35 (Limitation 1[A]), 36 (Limitation 1[B1]), 37 (Limitation 1[B2]), 40 (Limitation 1[B3]), 42 (Limitation 1[B4]), 43 (Limitation 1[C]), 45 (Limitation 1[D]), 46 (Limitation 1[E]).) The Board instituted based on Figure 3's teachings. (Paper 6 at 21-22.) The Reply now contains new arguments that Figure 1 anticipates the claims. (Reply at 17-19.)

The Petition never relied on Figure 1 for anticipation; it merely refers to Figure 1 via string citation. (Petition at 33, 39, 41, 42, 44, 46-47.) None of these citations are used to teach specific claim limitations, nor are they provided with the requisite anticipatory analysis to review in conjunction with the relied-upon embodiment of Figure 3, *e.g.*, detailing how a POSITA would "envisage" across multiple embodiments to reach anticipation.² The Petition also has zero citations

¹The preamble also excerpted Figure 3, but did not annotate. (Petition at 34.)

² See, *e.g.*, *NetMoneyIN Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed.Cir.2008)

to Figure 1 for Limitations 1[A], 1[B1], 1[B2] (the limitations dealing with the on-time generator.) (Petition at 33-39.) Petitioner never relied on Figure 1 to anticipate the claims.

Petitioner's new Figure 1 arguments should be stricken. A "reply may only respond to arguments raised in the corresponding opposition, patent owner preliminary response, patent owner response, or decision on institution" (37 C.F.R. § 42.23) where "[r]espond," in the context of C.F.R. § 42.23(b), does not mean proceed in a new direction with a new approach." Consolidated Trial Practice Guide at 80 (<https://www.uspto.gov/TrialPracticeGuideConsolidated/>). Here, Petitioner provides a different approach to anticipation; it relies on teachings from Figure 1. This is a new invalidity rationale, and the Board frequently refuses to consider new rationales in Reply. *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (holding that the Board did not err in refusing the reply brief as improper under 37 C.F.R. § 42.23(b) because petitioner relied on an entirely new rationale to explain why one of skill in the art would have combined the references at issue); *Yita LLC v. MacNeil IP LLC*, 69 F.4th 1356, 1367 (Fed. Cir.) (same); *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1329 (Fed. Cir. 2019) (same); *Ariosa Diagnostics v. Verinata Health*, *Microsoft Corp. v. Biscotti, Inc.*, 878 F.3d 1052, 1069 (Fed. Cir. 2017).

Inc., 805 F.3d 1359, 1367 (Fed. Cir. 2015) (stating that the Board properly refused to consider new teachings of a prior art in Reply); *see also Juniper Networks, Inc. v. Swarm Technology LLC*, IPR2021-01445 at 28-29 (Paper 62) (Feb. 7, 2023) (refusing to consider a new theory on a prior art disclosure in Reply); *MOM Enterprises, LLC d/b/a Mommy's Bliss v. R Vieth et al.* IPR2023-00726 at 9 (Paper 89) (May 9, 2024) (striking new anticipatory theories).

Furthermore, the Board's analysis of Figure 1 does not allow Petitioner to now rely on it for anticipation. The Board's reference to Figure 1 acknowledged that it was a separate embodiment, and it used Figure 1's discussion to describe how the DC-DC buck converter of Figure 3 would operate. (Paper 6 at 29.) Patent Owner has since provided a more robust discussion regarding how Figure 3 operates (without reference to Figure 1). (Paper 23 at 26-29; *see also* FN1.) Nonetheless, the issue of whether Figure 1 educates the operation of Figure 3 is a separate issue from whether Figure 1 itself anticipates the claims. Petitioner's new theory that Figure 1 anticipates the claims should be stricken.

Figures 1 and 3 are, moreover, distinctly different embodiments. Figure 3 is described as "one particular embodiment" (EX1005 at 9:13-15) and has different circuitry for the on-time timer, *e.g.*, "precharging transistor 150 ... as an error compensator." (EX1005 at 9:13-15.) Petitioner relies on the on-time timer for Limitations 1[A], 1[B2], 1[B3] and 1[B4]. (Petition at 34-42.) Additionally, the

“precharging transistor 150” is part of Petitioner’s other relied upon figure (Figure 4). (Petition at 38 (relying on Figure 4 for Limitation 1[B2]).) The precharging transistor is also used to charge Con 74 (which Petitioner relies on to set the input voltage sensing signal). (Petition at 39.) Figure 3 also has additional circuitry³ in the path Petitioner relies upon to connect the “second input terminal” and PWM latch 116. (Petition at 35 (green).) These Figures are different embodiments.

Finally, introducing Figure 1 at this stage prejudices Patent Owner. Petitioner argues waiver because the Patent Owner response did not address anticipation based on the embodiment of Figure 1. (Reply at 19-22.) But, this is a theory never described in the Petition, and allowing Petitioner to pivot to a new embodiment after the Patent Owner response is unfair.

The Board has discretion to determine “whether a [p]etition identified the specific evidence relied on in a [r]eply and when a [r]eply contention crosses the line from the responsive to the new.” *Ariosa*, 805 F.3d at 1368. It should exercise its discretion and strike those portions of the Reply relying on Figure 1 to anticipate the claims.

³ Figure 3 moreover has circuitry related to zero-crossing that Figure 1 does not have. (Compare Figures 1 and 3.)

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Patent Owner's Motion to Strike

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CERTIFICATE OF SERVICE

I hereby certify that on July 29, 2025, a true and correct copy of the foregoing PATENT OWNER'S MOTION TO STRIKE was served by electronic mail on the Petitioner via its attorneys of record:

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Respectfully submitted,

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