

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

REED SEMICONDUCTOR CORP.,
Petitioner,

v.

MONOLITHIC POWER SYSTEMS, INC.,
Patent Owner.

IPR2024-01158
Patent 9,041,377 B2

Before JEAN R. HOMERE, KARL D. EASTHOM, and
KEN B. BARRETT, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

ORDER
Granting Petitioner's Motion to Submit Supplemental Information
37 C.F.R. § 42.123(b)

Petitioner Reed Semiconductor Corp. filed a motion to submit supplemental information under 37 C.F.R. § 42.123(b). Paper 37 (“Motion” or “Mot.”). Patent Owner Monolithic Power Systems, Inc. filed an opposition. Paper 40 (“Opposition” or “Opp.”).

Under 37 C.F.R. § 42.123(a), supplemental information may be submitted if the information is “relevant to a claim for which trial has been instituted” and if the party seeking to submit it requests authorization “within one month of the date the trial is instituted.” That rule further provides:

(b) Late submission of supplemental information. A party seeking to submit supplemental information more than one month after the date the trial is instituted, must request authorization to file a motion to submit the information. The motion to submit supplemental information must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice.

37 C.F.R. § 42.123(b).

A disputed issue in this case pertains to the “control signal” recited in the challenged claims. Claim 1, for example, recites, in limitation 1B2, “an input voltage sensing circuit having . . . a second input terminal . . . [that] is configured to receive *a control signal* provided by the pseudo constant on time control circuit,” and, in limitation 1D, “a logic control circuit . . . wherein . . . the logic control circuit generates *the control signal*.” Ex. 1001, 9:40–46, 10:5–9 (emphasis added).

Patent Owner, in this *inter partes* review, relies on the opinion testimony of its proffered expert witness, Mr. McAlexander, in support of its contention that the prior art does not disclose a single “control signal” between the two components. *See, e.g.*, PO Response (Paper 23) 22

("[T]hese two signals are separated by two logic gates, an OR gate and an inverting AND gate . . . (EX2005 [Mr. McAlexander's second declaration], ¶¶ 70–72.) These two signals are not the same signal; a POSITA would understand that the separating logic makes them different logical signals. (EX2005, ¶¶ 70–72.)). The testimony of Mr. McAlexander, *inter alia*, goes to how a person of ordinary skill in the art would have understood the term "control signal."

Petitioner contends that Mr. McAlexander has taken, in the District Court action, a contradictory position for infringement purposes. Specifically, Petitioner asserts:

In the IPR proceedings, Patent Owner and its expert, Mr. McAlexander, have asserted as their central argument that intervening logic separates the flip-flop [mapped to the "logic control circuit"] from the on-time generator [a portion of which is mapped to the "input voltage sensing circuit"] and changes the signal output by the flip-flop into different logical signals such that it cannot be the claimed "control signal." This directly contradicts Mr. McAlexander's opinions in a parallel district court case. Petitioner seeks to supplement the record with these opinions of Mr. McAlexander from the district court case involving the same patent, same parties, same expert, and same issues as in this IPR. These opinions are important to enable the Board to fully evaluate Patent Owner's positions and Mr. McAlexander's credibility.

Mot. 1; *see also id.* at 2–3 (Petitioner discussing the purported inconsistency).

Petitioner seeks to file as supplement information excerpts from Mr. McAlexander's expert report in the District Court and excerpts from the transcript of the deposition of Mr. McAlexander taken in the District Court action, and Petitioner filed those as Proposed Exhibits (Exhibits 1019

and 1020, respectively). Patent Owner filed its infringements contentions from the District Court action. Ex. 2008.

Patent Owner argues that the motion should fail because it is untimely and not in the interest of justice. Opp. 1.

Timeliness

Petitioner contends that “[t]he testimony provided by Mr. McAlexander during his recent deposition (September 18, 2025) in [the District Court action] and the opinions that he has offered in that case, occurred after the Petition’s July 23, 2024 filing, and thus could not have been obtained earlier.” Mot. 1.

Patent Owner argues that, seventy-three days before the filing of Petitioner’s Reply, Petitioner had the *content* of the supplemental information in the form of Patent Owner’s litigation infringement contentions. Opp. 1. We do not find this argument to be on point. The infringement contentions represent the positions of Plaintiff/Patent Owner. However, the two District Court documents sought to be entered as supplemental information are the expert report and deposition testimony of Mr. McAlexander. Arguments in the form of a party’s contentions and evidence in the form of expert testimony are two different things. *See Icon Health & Fitness, Inc. v. Strava Inc.*, 849 F.3d 1034, 1046 (Fed. Cir. 2017) (“Attorney argument is not evidence or explanation in support of a conclusion.”). Petitioner contends that the supplemental information is evidence that will show that Mr. McAlexander has taken inconsistent positions and goes to his credibility. *See* Mot. 1. An assessment of that credibility will involve a comparison of Mr. McAlexander’s testimony in this IPR proceeding against Mr. McAlexander’s testimony in the District

Court action, not against Plaintiff’s contentions. Thus, we do not agree with Patent Owner’s implied argument that Petitioner had the supplemental information—the report and testimonial evidence—long ago.

Mr. McAlexander’s expert report is dated August 1, 2025, and the deposition in the District Court action, where Petitioner explored Mr. McAlexander’s opinions, occurred on September 18, 2025. Petitioner contacted the Board on October 6, 2025, to request authorization to file the motion to submit the supplemental information.¹ We determine, on the specific facts of this case, that Petitioner has made an adequate showing that the supplemental information reasonably could not have been obtained earlier.

Interest of Justice

Petitioner contends that allowing the submission of the supplemental information is appropriate because “[c]ontradictory testimony on identical issues is ‘highly relevant,’ and its consideration is in the interest of justice.” Mot. 2. Patent Owner argues that the submission of supplemental information is not in the interest of justice because “(1) it is, in effect, a do-over of what Petitioner chose not to do in its Reply; and (2) Mr. McAlexander’s report and testimony provides no contradiction to the issues in this proceeding.” Opp. 2; *see also id.* at 3 (Patent Owner arguing that there is no inconsistency because “[t]he intervening circuitry accused of

¹ Patent Owner asserts that “Petitioner, moreover, delayed in bringing its motion” and “[t]he report and deposition are dated Aug. 1 and Sept. 18, respectively,” but not offers no persuasive explanation as to why this indicates an unreasonable delay. Opp. 2.

infringement in the litigation is a buffer, whereas the intervening circuitry in Petitioner's art results in distinctly different states.”).

As to the first argument, Patent Owner asserts that Petitioner could have pointed out any purported contradictions in Petitioner's Reply. Patent Owner's argument is not persuasive because it is based on the assertion that Plaintiff's/Patent Owner's infringement contentions are the equivalent of evidence in the form of expert testimony in the District Court action (the supplemental evidence). *See, e.g., id.* at 2 (Patent Owner arguing that “the substance of the supplemental information is identical to Patent Owner's infringement contentions.”). An assessment of Mr. McAlexander's credibility will be based on an evaluation as to whether his testimony on patentability in this forum is inconsistent with his testimony on infringement in another forum. A comparison of his patentability testimony against Plaintiff's/Patent Owner's infringement contentions is not the equivalent analysis.

Patent Owner's second argument—that it is not in the interest of justice for us to consider the expert's positions in the District Court because there are no inconsistencies—also is not persuasive. In order for us to determine whether Mr. McAlexander's positions are inconsistent and whether his testimony in this forum is credible, we need to consider the purportedly inconsistent testimony in the other forum. *Cf. Opp.* 3 (Patent Owner quoting the supplemental information in arguing that it shows that there is no inconsistency). We determine that it is in the interest of justice for Petitioner to submit the purportedly inconsistent opinions so that we can better assess the credibility of Mr. McAlexander.

The parties may address the purported inconsistencies at the oral argument scheduled for October 23, 2025.

ORDER

For the foregoing reasons, it is

ORDERED that Petitioner's Motion to Submit Supplemental Information is *granted*;

FURTHER ORDERED that, because the supplemental evidence already has been filed as Exhibits 1019 and 1020, Petitioner shall not file another copy of either document.

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FOR PETITIONER:

Andrew Gray
Calvin Brien
Phillip Wolfe
Avery Welker
Andrew Devkar
MORGAN LEWIS
andrew.gray@morganlewis.com
calvin.brien@morganlewis.com
phillip.wolfe@morganlewis.com
avery.welker@morganlewis.com
andrew.devkar@morganlewis.com

FOR PATENT OWNER:

John Schnurer
Miguel Bombach
John Esterhay
PERKINS COIE LLP
jesterhay@perkinscoie.com
jschnurer@perkinscoie.com
mbombach@perkinscoie.com
miguel.bombach@foley.com