

United States District Court  
Northern District of California

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**UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN JOSE DIVISION**

POWER INTEGRATIONS, INC.,

Plaintiff,

v.

ON SEMICONDUCTOR CORPORATION,  
et al.,

Defendants.

Case No. [16-cv-06371-BLF](#)

**ORDER GRANTING IN PART,  
DENYING IN PART, AND FINDING  
MOOT IN PART ON’S MOTION FOR  
SUMMARY JUDGMENT; GRANTING  
IN PART AND DENYING IN PART  
PI’S MOTION FOR SUMMARY  
JUDGMENT**

[Re: ECF 221, 224]

This case is just one of many in a long line of disputes between Power Integrations, Inc. (“PI”) on the one hand and ON Semiconductor Corporation and Semiconductor Components Industries, LLC (collectively, “ON”) (and their subsidiaries) on the other. In this consolidated action, each party sues the other for infringement of various patents. PI sues ON for infringement of seven patents: U.S. Patent Nos. 6,212,079 (“the ’079 Patent”); 8,115,457 (“the ’457 Patent”); 7,239,119 (“the ’119 Patent”); 7,538,533 (“the ’533 Patent”); 6,297,623 (“the ’623 Patent”); 6,414,471 (“the ’471 Patent”); and 6,249,876 (“the ’876 Patent”) (collectively, “PI’s Asserted Patents”). See PI Compl., ECF 1; PI Ans., ECF 100. ON sues PI for infringement of eight patents: U.S. Patent Nos. 6,333,624 (“the ’624 Patent”); 6,429,709 (“the ’709 Patent”); RE39,933 (“the ’933 Patent”); RE41,908 (“the ’908 Patent”); RE45,862 (“the ’862 Patent”); 6,597,221 (“the ’221 Patent”); 7,944,272 (“the ’272 Patent”); and 7,447,601 (“the ’601 Patent”) (collectively, “ON’s Asserted Patents”). ON Third Am. Compl., ECF 94. Each party also asserts declaratory judgment claims, counterclaims, or affirmative defenses of invalidity and non-infringement as to the other parties’ asserted patents. PI Ans.; ON Third Am. Compl.; ON Second Am. Ans., ECF

1 Presently before the Court are the parties' motions for summary judgment. ON Mot., ECF  
2 221; PI Mot., ECF 224. Each party seeks to summarily adjudicate several distinct issues in the  
3 case. The Court held a hearing on the motions on June 6, 2019. For the reasons set forth below,  
4 ON's motion is GRANTED IN PART, DENIED IN PART, AND FOUND MOOT IN PART and  
5 PI's motion is GRANTED IN PART AND DENIED IN PART.

## 6 I. LEGAL STANDARD

7 Federal Rule of Civil Procedure 56 governs motions for summary judgment. Summary  
8 judgment is appropriate "if the pleadings, depositions, answers to interrogatories, and admissions  
9 on file, together with the affidavits, if any, show that there is no genuine issue as to any material  
10 fact and that the moving party is entitled to a judgment as a matter of law." *Celotex Corp. v.*  
11 *Catrett*, 477 U.S. 317, 322 (1986) (citing Fed. R. Civ. P. 56(c)).

12 The moving party "bears the burden of showing there is no material factual dispute," *Hill*  
13 *v. R+L Carriers, Inc.*, 690 F. Supp. 2d 1001, 1004 (N.D. Cal. 2010), by "identifying for the court  
14 the portions of the materials on file that it believes demonstrate the absence of any genuine issue  
15 of material fact," *T.W. Elec. Serv. Inc. v. Pac. Elec. Contractors Ass'n*, 809 F.2d 626, 630 (9th Cir.  
16 1987). Once the moving party has satisfied this initial burden, the non-moving party must then  
17 "identify with reasonable particularity the evidence that precludes summary judgment." *Keenan v.*  
18 *Allan*, 91 F.3d 1275, 1279 (9th Cir. 1996); *see also Schneider v. TRW, Inc.*, 938 F.3d 986, 991 (9th  
19 Cir. 1990). It is not the duty of the district court to "to scour the record in search of a genuine  
20 issue of triable fact." *Keenan*, 91 F.3d at 1279 (quoting *Richards v. Combined Ins. Co.*, 55 F.3d  
21 247, 251 (7th Cir. 1995)). Moreover, the court makes no credibility determinations and does not  
22 weigh the evidence. "The evidence of the non-movant is to be believed, and all justifiable  
23 inferences are to be drawn in his favor." *Anderson*, 477 U.S. at 254; *see also Matsushita Elec.*  
24 *Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986). For a court to find that a genuine  
25 dispute of material fact exists, "there must be enough doubt for a reasonable trier of fact to find for  
26 the [non-moving party]." *Corales v. Bennett*, 567 F.3d 554, 562 (9th Cir. 2009). If the non-  
27 moving party fails to make this showing, the moving party is entitled to summary judgment.

1       **II.   DISCUSSION**

2           The Court first addresses ON’s motion and then turns to PI’s motion. The Court provides  
3 the facts relevant to each issue in the respective issue’s subsection.

4           **A.   ON’s Motion for Summary Judgment (ECF 221)**

5           ON moves for summary judgment of six issues: (1) whether the asserted claims of PI’s  
6 ’623 Patent, ’533 Patent, and ’457 Patent are invalid for indefiniteness; (2) whether PI’s damages  
7 period is limited to the time of filing of its claims for each asserted patent because PI failed to  
8 provide ON with pre-suit notice of its claims of infringement; (3) whether in *inter partes* review  
9 (“IPR”) PI disclaimed the claim scope of its ’079 Patent, such that ON’s accused products do not  
10 infringe the asserted claims; (4) whether ON’s accused products do not infringe the ’079 Patent  
11 because they do not meet the “fixed switching frequency” requirement of the asserted claims; (5)  
12 whether the asserted claims of PI’s ’471 Patent are invalid as anticipated by U.S. Patent No.  
13 4,413,224 (“the ’224 Patent”) to Krupka; and (6) whether PI can prove infringement of claim 1 of  
14 PI’s ’876 Patent even though its infringement contentions and expert reports do not address the  
15 version of the claim that was amended in reexamination during the pendency of this action. *See*  
16 ON Mot. at 1–2.

17           The Court addresses each issue in turn.

18                   **1.   Invalidity of PI’s ’623, ’533, and ’457 Patents for Indefiniteness**

19           ON first asks the Court to enter summary judgment on the asserted claims of the ’623  
20 Patent, the ’533 Patent, and the ’457 Patent because the Court held the asserted claims indefinite  
21 in its claim construction order. ON Mot. at 2 (citing ECF 196 at 19–21, 27–31, and 33–36; ECF  
22 198). PI does not oppose this request. PI Opp. at 1, ECF 238.

23           “A lack of definiteness renders invalid ‘the patent or any claim in suit.’” *Nautilus, Inc. v.*  
24 *Biosig Instruments, Inc.*, 572 U.S. 898, 902 (2014) (quoting 35 U.S.C. § 282, ¶ 2(3) (2006 ed.)).  
25 Because the Court has held that all asserted claims of these three patents are indefinite, the Court  
26 holds that the asserted claims are invalid and thus GRANTS ON’s motion for summary judgment  
27 on this issue.

## 2. PI's Damages Period and Pre-Suit Notice

ON asks the Court to hold that the damages periods for infringement by ON of PI's patents (the '079, '876, '471, and '119 Patents) began when PI first filed claims for infringement of each asserted patent. ON argues that 35 U.S.C. § 287 dictates this result because PI neither marked its products with the asserted patent numbers nor otherwise notified ON of any alleged infringement prior to PI's filing claims on each patent.

Section 287 requires patentees and those selling patented products in the United States to mark their products in specific ways in order to provide notice that the products are patented. If a patentee or seller does not comply with this requirement, Section 287(a) limits his or her rights in certain ways:

In the event of failure so to mark, no damages shall be recovered by the patentee in any action for infringement, except on proof that the infringer was notified of the infringement and continued to infringe thereafter, in which event damages may be recovered only for infringement occurring after such notice. Filing of an action for infringement shall constitute such notice.

35 U.S.C. § 287(a). Under this subsection, "notice" means actual notice, which "requires the affirmative communication of a specific charge of infringement by a specific accused product or device." *Amsted Indus. Inc. v. Buckeye Steel Castings Co.*, 24 F.3d 178, 187 (Fed. Cir. 1994).

PI does not dispute that it did not mark its products. *See* PI Opp. at 1–4; ON Mot., Ex. B at 241, ECF 221-3 (testimony by PI's president and CEO stating that he does not believe PI marked its products). And PI does not present any evidence with respect to any other notice of ON's infringement of the '119 Patent. As such ON's motion is GRANTED with respect to the notice date of the '119 Patent, which is the first date on which PI filed a claim for infringement of this patent against ON.<sup>1</sup>

However, PI argues that the damages periods for the '079, '876, and '471 Patents are not limited to the date of filing of the relevant claims. PI's arguments as to the '079 and '876 Patents differ from its arguments as to the '471 Patent. The Court discusses each set of arguments in turn.

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<sup>1</sup> Neither ON nor PI provides the relevant date to the Court, but the Court believes this date is November 1, 2016, when PI filed its Complaint in this case. *See* ON Mot., Ex. C at 10, ECF 221-

1                                    a. '079 and '876 Patents

2                    PI argues that the damages periods for the '079 and '876 Patents began on June 16, 2014  
3 (before PI's filing of the relevant claims). On June 16, 2014, PI's CEO Balu Balakrishnan sent an  
4 email to ON's CEO Keith Jackson which stated in relevant part that PI's "initial review of [ON's  
5 product] NCP1246 data sheet indicates that patent numbers ending in 079, 457 and[] 851 and/or  
6 876 are infringed." ON Mot., Ex. D, ECF 221-5; *see* PI. Opp. at 1–4.

7                    ON makes two arguments as to why the June 2014 email, as well as other similar  
8 communications in 2014, do not constitute actual notice under Section 287: (1) PI's own  
9 employees "affirmatively disclaimed" that the communications constitute actual notice; and (2)  
10 the communications are settlement communications protected by Federal Rule of Evidence 408  
11 and thus "not usable for any purpose in this litigation." ON Mot. at 3. Neither argument is  
12 persuasive.

13                    First, genuine disputes of material fact exist as to ON's affirmative disclaimer argument.  
14 ON presents evidence that PI's 30(b)(6) witness Mr. Clifford Walker testified in his deposition  
15 that it is PI's position that the communications in 2014 do not constitute actual notice because at  
16 the time of the communications and on the day of his deposition (on April 16, 2019) he intended  
17 that the communications would be protected settlement communications under Rule 408. *See* ON  
18 Mot. at 4 (citing Ex. G at 263:12–17; 267:24–268:10, ECF 221-8). But PI cites additional  
19 testimony from Mr. Walker in that same deposition which shows that his intent is not so definite.  
20 *See* PI Opp. at 2–3. When Mr. Walker was asked whether it was PI's position that the 2014  
21 communications were not actual notice, he responded saying, "[w]ell, that was our original intent.  
22 I'm not sure exactly how it has developed, but that was our intent that it not [sic] to be notice but  
23 maybe it actually was depending on if someone says, [w]ell, those were not settlement discussions  
24 and, therefore, not protected and, therefore, obviously the communications were notice." ON  
25 Mot., Ex. G at 262:24–263:6. He also clarified that his "answer is qualified to the extent that ON  
26 agrees that these were settlement discussions," saying, "To me, it goes both ways. If we say it's  
27 settlement, then I agree that neither party received notice. If we decide, well, it actually wasn't  
28 settlement discussions, protected discussions, despite the parties' intent and there was a

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