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January 3, 2013

## **BY EDIS**

The Honorable Thomas B. Pender  
Administrative Law Judge  
U.S. International Trade Commission  
500 E Street SW, Room 317  
Washington, DC 20436

Re: 337-TA-825: *Certain Silicon Microphone Packages and Products Containing Same*

Dear Judge Pender:

I write on behalf of Complainant Knowles Electronics, LLC, in connection with the above-referenced investigation. I write to inform the Administrative Law Judge of newly-issued Federal Circuit authority that may bear upon issues to be addressed in the Administrative Law Judge's forthcoming Initial Determination. The opinion, a copy of which is enclosed, is *OSRAM Sylvania, Inc. v. Am. Induction Tech., Inc.*, \_\_ F.3d \_\_\_, No. 2012-1091, 2012 WL 6200181 (Fed. Cir. Dec. 13, 2012).

Knowles respectfully directs the Administrative Law Judge to the analysis set forth on pages 10-13 of the *OSRAM* opinion, as this portion of the decision is pertinent to the parties' dispute concerning whether the Halteren reference anticipates the asserted claims. In particular, *OSRAM* emphasizes the role of expert testimony (e.g., that presented by Knowles's expert, Dr. David Egolf, in this investigation) in the "critical[ly] importan[t]" inquiry of "[h]ow one of ordinary skill in the art would understand the scope of the disclosure" alleged to anticipate an asserted claim. *OSRAM*, slip op. at 13.

In addition, I write to notify the Administrative Law Judge that on Friday, December 28, 2012, Knowles discovered that it had inadvertently delayed making the required 3.5-year maintenance fee payment for U.S. Patent No. 7,439,616, one of the patents asserted in this investigation. The grace period to make this payment had ended on October 22, 2012. On Monday, December 31, 2012, Knowles promptly made the delayed payment and filed a petition to the United States Patent and Trademark Office to accept the unintentionally delayed payment under 37 C.F.R. 1.378(c). The United States Patent and Trademark Office granted the petition the same day. Therefore, the patent remains in effect and is considered as not having expired as a result of this unintentional delay. See 35 U.S.C. § 41(c)(1); *Fonar Corp. v. Gen. Elec. Co.*, 107 F.3d 1543, 1554 (Fed. Cir. 1997).

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Accordingly, this should have no impact on the investigation. Nevertheless, in the interests of candor, Knowles wanted to apprise the Administrative Law Judge of this development.

Sincerely,

/s/ Robert T. Haslam

Robert T. Haslam

Enclosure  
cc: Counsel of Record

# United States Court of Appeals for the Federal Circuit

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OSRAM SYLVANIA, INC.,  
*Plaintiff-Appellant,*

v.

AMERICAN INDUCTION TECHNOLOGIES, INC.,  
*Defendant-Cross Appellant.*

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2012-1091, -1135

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Appeals from the United States District Court for the Central District of California in case no. 09-CV-8748, Judge Manuel L. Real.

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Decided: December 13, 2012

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GREGG F. LOCASCIO, Kirkland & Ellis, LLP, of Washington, DC, argued for plaintiff-appellant. With him on the brief were NATHAN S. MAMMEN and LESLIE M. SCHMIDT. Of counsel on the brief was STEVEN M. COYLE, Cantor Colburn LLP, of Hartford, Connecticut.

GLENN W. TROST, Connolly Bove Lodge & Hutz, LLP, of Los Angeles, California, argued for defendant-cross appellant.

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Before O'MALLEY, PLAGER, and REYNA, *Circuit Judges*.

O'MALLEY, *Circuit Judge*.

OSRAM SYLVANIA, Inc., ("OSRAM") appeals the district court's grant of summary judgment of invalidity of claims 1, 17, 25, 27, and 32 of U.S. Patent No. 5,834,905 (the "905 patent"), issued to Valery A. Godyak et al., and assigned to OSRAM. Because we find genuine issues of material fact that preclude a finding of anticipation and obviousness on summary judgment, and because we find that the district court erred in failing to consider objective indicia of nonobviousness, we reverse and remand for proceedings in accordance with this ruling.

## BACKGROUND

### I. Technology at Issue

OSRAM is the assignee of the '905 patent, which claims a closed-loop tubular electrodeless lamp, having certain and specific discharge current and pressure parameters. Claim 1, which is representative, recites:

An electric lamp assembly comprising:

an electrodeless lamp including a closed-loop, tubular lamp envelope enclosing mercury vapor and a buffer gas at a pressure less than 0.5 torr;

a transformer core disposed so as to surround a portion of said closed-loop lamp envelope;

an input winding disposed on said transformer core; and

a radio frequency power source coupled to said input winding for supplying sufficient radio frequency energy to said mercury vapor and said buffer gas to produce in

said lamp envelope a discharge having a discharge current equal to or greater than about 2 amperes.

'905 patent col. 8 ll. 7–19.

This invention generally relates to “a low pressure, high intensity fluorescent light source that can produce considerably more light per unit length than conventional electroded fluorescent lamps.” Electrodeless fluorescent lamps were first disclosed in several patents issued to and articles authored by John Anderson of G.E. in the 1960s and 1970s. For example, as described in the '905 patent’s “Background of the Invention,” Anderson claimed in U.S. Patent No. 3,987,334 (the “Anderson '334 patent”) a lamp having a torodial discharge tube that forms a continuous closed electrical path that passes through a torodial ferrite core. Applying a voltage to the wire wrapped around the ferrite core creates a magnetic flux that in turn induces a discharge voltage along the tube. In effect, the wire around the ferrite core operates as the primary of a transformer with the lamp tube operating as the secondary of the transformer. Thus, “[t]he inner surface of the discharge tube is coated with a phosphor which emits visible light when irradiated by photons emitted by the excited mercury gas atoms.” '905 patent col. 2 ll. 14–16. The lamps described in the Anderson '334 patent operated with a buffer gas pressure of “approximately 1 torr or less.” The '905 patent specification describes Anderson’s lamp as inefficient and impractical, however.

The '905 patent also describes “a closed-loop, tubular lamp envelope enclosing mercury vapor . . . a transformer core disposed around the lamp envelope, an input winding disposed on the transformer core and a radio frequency power source coupled to the input winding” but it specifies a buffer gas pressure of “less than about 0.5 torr.” '905

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