

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELPHI TECHNOLOGIES, LLC¹,
Petitioner,

v.

MICROCHIP TECHNOLOGY INC.,
Patent Owner.

Case IPR2017-00861
Patent 7,627,708 B2

Before BRIAN J. McNAMARA, DANIEL N. FISHMAN, and
MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

FISHMAN, *Administrative Patent Judge*.

DECISION
Denying Patent Owner's Request for Rehearing
37 C.F.R. § 42.71

¹ Petitioner filed a notice of its name change from "Delphi Technologies, Inc." to "Delphi Technologies, LLC." Paper 53, 1–2.

I. INTRODUCTION

Microchip Technology Inc. (“Patent Owner”) requests rehearing (“Req. Reh’g.” or “Request,” Paper 64) of our Final Written Decision (“Dec.” or “Decision,” Paper 63), which determined that Petitioner had shown, by a preponderance of the evidence, that claims 1, 3–5, 7–9, 11–15, 18–21, 23, and 25 of U.S. Patent No. 7,627,708 B2 (Ex. 1001, the “708 patent”) are unpatentable (Dec. 72).

For the reasons below, the request is *denied*.

II. LEGAL STANDARD

“The burden of showing a decision should be modified lies with the party challenging the decision,” and, “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed” in the record. 37 C.F.R. § 42.71(d).

III. DISCUSSION

Patent Owner’s Request does not identify *any* arguments that we “misapprehended or overlooked” let alone “specifically identify” all such matters. Thus, Patent Owner’s Request fails to comply with our rules. Despite this failure of Patent Owner’s Request, we address the substance of Patent Owner’s arguments below.

A. Claim 25 “ACR” Information

Patent Owner argues our analysis regarding claims 17, 22, and 24 regarding “dedicated address, configuration, and response [(‘ACR’)]

information” should have been applied equally to a similar recitation in claim 25 and, thus, we should find the Petition failed to establish unpatentability of claim 25 for the same reasons as claims 17, 22, and 24. Req. Reh’g. 1. Patent Owner acknowledges it “did not specifically argue this additional limitation of Claim 25.” *Id.* Regardless, Patent Owner contends our Decision should be modified to find claim 25 was *not* shown to be unpatentable for the same reasons as claims, 17, 22, and 24. *Id.*

First, we are not persuaded that our Decision misapprehended or overlooked an argument that Patent Owner acknowledges it did not make. We could not have overlooked or misapprehend arguments or evidence not presented and developed by Patent Owner in its papers.

Furthermore, even considering Patent Owner’s argument first presented in its Request, we remain unpersuaded that our Decision was in error regarding claim 25 because claim 25 has a different scope than claims 17, 22, and 24. Claim 17 further limits the multi-host device controller of the USB device of claim 7, from which it depends, such that it is “configured” to maintain the ACR information. Claim 22 further limits the method of claim 18, from which it depends, such that the method adds the step of maintaining ACR information. Claim 24 further limits the controller of the USB device of claim 23, from which it depends, such that the controller is “operable” to maintain the ACR information. Thus, claims 17, 22, and 24 arguably limit the structure or method to require certain functionality (i.e., a device “configured to” or “operable to”).

By contrast, claim 25 recites that the controller of claim 23, from which it depends, includes an endpoint buffer corresponding to each USB host “for storing respective dedicated address, configuration and response

information.” Unlike the limitations of claims 17, 22, and 24, claim 25’s recitation of the type of data stored in such a memory (buffer) does not limit the structure of the endpoint buffer, USB device, or the controller.

Arguably, such a recitation is merely non-functional descriptive material deserving of little or no weight.²

Therefore, we are unpersuaded by Patent Owner that our reasoning for *not* finding claims 17, 22, and 24 (*see* Dec. 56–58) unpatentable necessarily applies to the recitations of claim 25 (*see* Dec. 54–56).

B. Interpretation Of “Controller” In Claim 25

Patent Owner argues our Decision changed theories midstream by mapping Dickens to the “controller” of dependent claim 25 differently than we mapped Dickens to similar recitations in independent apparatus claims 1, 3, 7, and 23. Req. Reh’g. 2–6. Specifically, Patent Owner argues that our Decision on Institution (Paper 14) adopted Petitioner’s argument that identified the recited “controller” as controller 140 in Dickens. *Id.* at 2 (citing Paper 14, 27, 32, 33). Patent Owner argues that, based on that preliminary interpretation that the recited controller is disclosed in Dickens as controller 140, Patent Owner argued in its Response that “claim [25]

² Our reviewing court has held that nonfunctional descriptive material cannot lend patentability to an invention that would have otherwise been anticipated by the prior art. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004); *cf. In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (noting that when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability); *King Pharms., Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1279 (Fed. Cir. 2010) (“[T]he relevant question is whether ‘there exists any new and unobvious functional relationship between the printed matter and the substrate.’”) (citations omitted).

recites the controller comprises ‘USB interface circuits’ but, . . . , the identified USB interface circuits in Dickens (items 150/158) are NOT within the data router 140.” *Id.* (citing Paper 23, 38). Patent Owner contends that our Final Written Decision changed the interpretation on which Patent Owner’s Response relied by asserting “we can redraw the dashed line in Dickens’ Figure 2 to include host controllers 150 within controller 140.” *Id.* at 3 (citing Dec. 55). Patent Owner argues it was denied the opportunity to respond to this alleged change in our interpretation. *Id.* at 4–6. In particular, Patent Owner contends Dickens’ USB controllers 150 cannot be both inside the controller as required by claim 25 and “coupled between” the host and the controller as recited in claim 5. *Id.* at 5.

We disagree. Patent Owner addressed whether claim 25 requires the USB interface circuits to be in the controller (*see, e.g.*, Paper 23, 38) and our Final Written Decision addressed those arguments (Dec. 54–56). We were persuaded by Petitioner’s argument that the transition phrase “comprising” does not require that the USB interface circuits be physically within the controller that comprises those circuits. *Id.* Our Decision noted that Dickens’ Figure 2 depicts controller 140 as a dashed line box surrounding various components but expressly discloses that the components of its controller 140 may be distributed throughout device 130. Dec. 56. We determined,

Just as a dashed line may be drawn around distinct components of Dickens Figure 2 to identify the claimed “device” (*see* section II.A.4.b), we can redraw the dashed line in Dickens’ Figure 2 to include host controllers 150 within controller 140. An ordinarily skilled artisan would reasonably infer such a configuration from Dickens.

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