

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

POWER INTEGRATIONS, INC.,
Petitioner,

v.

SEMICONDUCTOR COMPONENTS INDUSTRIES, LLC,
Patent Owner.

Case IPR2017-01328
Patent 6,845,019 B2

Before BRIAN J. McNAMARA, JOHN F. HORVATH, and
KAMRAN JIVANI, *Administrative Patent Judges*.

JIVANI, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5(a)

The parties to this proceeding have filed, with our prior authorization, a Joint Motion to Limit the Petition under 37 C.F.R. § 42.71. Paper 24. The Joint Motion seeks that we “withdraw claims 1–13 of the ’019 patent from this proceeding.” *Id.* at 1. Originally, we instituted review of only claims 14 and 15 in this proceeding, declining to review claims 1–13 because we determined that Petitioner had not shown a reasonable likelihood of success on its challenges to those claims. Paper 8 (“Decision on Institution”), 17. Thereafter, the Supreme Court issued its decision in *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348 (2018), and in light thereof, we modified our Decision on Institution to institute review of claims 1–15. Paper 21.

The parties argue in their Joint Motion that we should limit the Petition “to remove previously denied claims 1–13 for at least the following three reasons,” namely: (i) the Joint Motion is agreed to by both parties; (ii) “removing claims 1-13 promotes efficient use of the resources of the Board, streamlines the issues for appeal, and saves expense, time, and resources for the parties and Board;” and (iii) the Board similarly has limited petitions in at least IPR2017-00782, Paper 27; IPR2017-00701, Paper 65; and IPR2017-01355, Paper 22.

We agree with the parties’ arguments. Removing grounds from dispute, pursuant to a joint request of the parties, serves our overarching goal of resolving this proceeding in a just, speedy, and inexpensive manner. *See* 37 C.F.R. § 42.1(b); *Apotex*, Case IPR2016-01284 (PTAB Apr. 3, 2017) (Paper 19); *SAS*, 138 S. Ct. at 1357. Accordingly, we grant the parties’ Joint Motion to Limit the Petition under 37 C.F.R. § 42.71. The challenges to claims 1–13 are removed from this proceeding, and the Petition is limited to review of claims 14 and 15 as well as proposed substitute claims 16 and 17.

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ORDER

In consideration of the foregoing, it is, therefore,
ORDERED that the Joint Motion to Limit the Petition under
37 C.F.R. § 42.71 is *granted*;

FURTHER ORDERED that the Petition is limited to review of claims
14 and 15 as well as proposed substitute claims 16 and 17.

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