

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*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

ORDER ON MOTION TO AMEND
35 U.S.C. § 316(d) and 37 C.F.R. § 42.121

I. INTRODUCTION

Petitioner Power Integrations, Inc. requested an *inter partes* review of claims 1–15 of U.S. Patent No. 6,845,019 B2 (“the ’019 patent”). Paper 2 (“Petition” or “Pet.”). Patent Owner Semiconductor Components Industries, LLC¹ filed a Preliminary Response. Paper 7. Upon consideration of the Petition and Preliminary Response, we instituted an *inter partes* review of claims 14 and 15. Paper 8 (“Decision on Institution” or “Dec. on Inst.”), 19–21. Thereafter, Patent Owner filed a non-contingent Motion to Amend seeking cancellation of claims 14 and 15 and proposing substitute claims 16 and 17.

We have jurisdiction to conduct this *inter partes* review under 35 U.S.C. § 6. This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed below, Patent Owner’s Motion to Amend is *granted* with respect to cancellation of claims 14 and 15, and *denied* with respect to proposed substitute claims 16 and 17.

II. BACKGROUND

A. *Procedural History*

Petitioner challenged claims 1–15 of the ’019 patent as anticipated under 35 U.S.C. § 102(b) by Bonte *et al.*, U.S. Patent No. 5,305,192 (Ex. 1002, “Bonte”). Pet. 3. Petitioner supported its challenge with a declaration of Mr. William Bohannon (Ex. 1008). In its Preliminary

¹ Patent Owner identifies the following additional real parties in interest: (i) ON Semiconductor Corporation, (ii) Fairchild Semiconductor International, Inc., (iii) Fairchild Semiconductor Corporation, and (iv) Fairchild (Taiwan) Corporation. Paper 5, 1.

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Response, Patent Owner disputed Petitioner's challenges to claims 1–13 and offered in support of its positions a declaration of Dr. Douglas Holberg (Ex. 2001). Patent Owner and Dr. Holberg did not address claims 14 and 15. *See generally* Prelim. Resp. and Ex. 2001.

In our Decision on Institution, we instituted review of claims 14 and 15 as anticipated by Bonte. Dec. on Inst. 19–21. We, however, did not institute review of claims 1–13 because we determined that Petitioner's analysis failed to account for all the limitations of independent claims 1 and 5. *Id.* at 8. On April 24, 2018, the Supreme Court held that a decision to institute under 35 U.S.C. § 314 may not institute review on less than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348 (2018). In light of *SAS*, we modified our Decision on Institution to institute review of claims 1–15 as anticipated by Bonte, as presented in the Petition. Paper 21, 2. The parties subsequently filed, with our prior authorization, a Joint Motion to Limit the Petition under 37 C.F.R. § 42.71, seeking to “withdraw claims 1–13 of the '019 patent from this proceeding.” Paper 24, 1. We granted the parties' Joint Motion to Limit the Petition and removed from this proceeding the challenges to claims 1–13. Paper 25, 2.

Following institution, Patent Owner did not file a Response to the Petition pursuant to 37 C.F.R. § 42.120. Instead, pursuant to 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121, Patent Owner filed a Motion to Amend that was not contingent on a determination that the original claims are unpatentable. Paper 15 (“Mot.”). In its Motion to Amend, Patent Owner requested that we cancel claims 14 and 15 and replace them with proposed substitute claims 16 and 17. Mot. 1. Petitioner filed an Opposition to the Motion to Amend (Paper 18, “Opp.”). Patent Owner filed a Reply in

support of its Motion to Amend (Paper 22, “Reply”). Petitioner filed a Sur-Reply in support of its Opposition (Paper 26, “Sur-Reply”).

During the trial, Petitioner submitted additional declarations of Mr. Bohannon in support of its Opposition (Exs. 1015 and 1017). Mr. Bohannon further testified by depositions on March 1, 2017, January 11, 2018, and May 18, 2018, and transcripts of his testimony have been entered into evidence. Exs. 2008–2010.

Patent Owner submitted an additional declaration of Dr. Holberg (Ex. 2007). Patent Owner further moved to exclude the declarations of Mr. Bohannon (Exs. 1015 and 1017) offered in support of Petitioner’s Opposition. Paper 29. Petitioner filed an Opposition to the Motion to Exclude (Paper 32) and Patent Owner filed a Reply in support of the Motion to Exclude (Paper 34).

An oral hearing was held on July 19, 2018, and an official transcript has been entered into the record. Paper 38 (“Tr.”).

B. Related Proceedings

The ’019 patent is asserted in a counterclaim against Petitioner in *Power Integrations, Inc. v. Fairchild Semiconductor International, Inc. et al.*, 3:15-cv-04854-MMC (N.D. Cal.). Pet. 2; Ex. 1009 ¶¶ 63–86.

C. The ’019 patent (Ex. 1001)

The ’019 patent, issued from U.S. Patent Application No. 10/346,807 (Ex. 1005, 95–124, “the ’807 application”), relates to power conversion using a flyback converter. Ex. 1001, 1:13–15. A flyback converter is one type of DC-to-DC converter, utilizing both direct current (DC) and alternating current (AC). *See id.* at 1:21–28. A DC-to-DC converter transforms a “DC input voltage to an AC voltage, and after boosting or

reducing the voltage with a transformer, rectifies the AC voltage to produce a DC output voltage.” *Id.* at 1:21–26. The particular DC-to-DC converter described by the ’019 patent is “a flyback converter that detects an output voltage at the primary coil without using a photo coupler and provides an essentially constant output voltage independent of the size of a load, thereby minimizing the number of additional coils used in the transformer circuit.” *Id.* at 1:15–19. Figure 5 of the ’019 patent is reproduced below.

FIG. 5

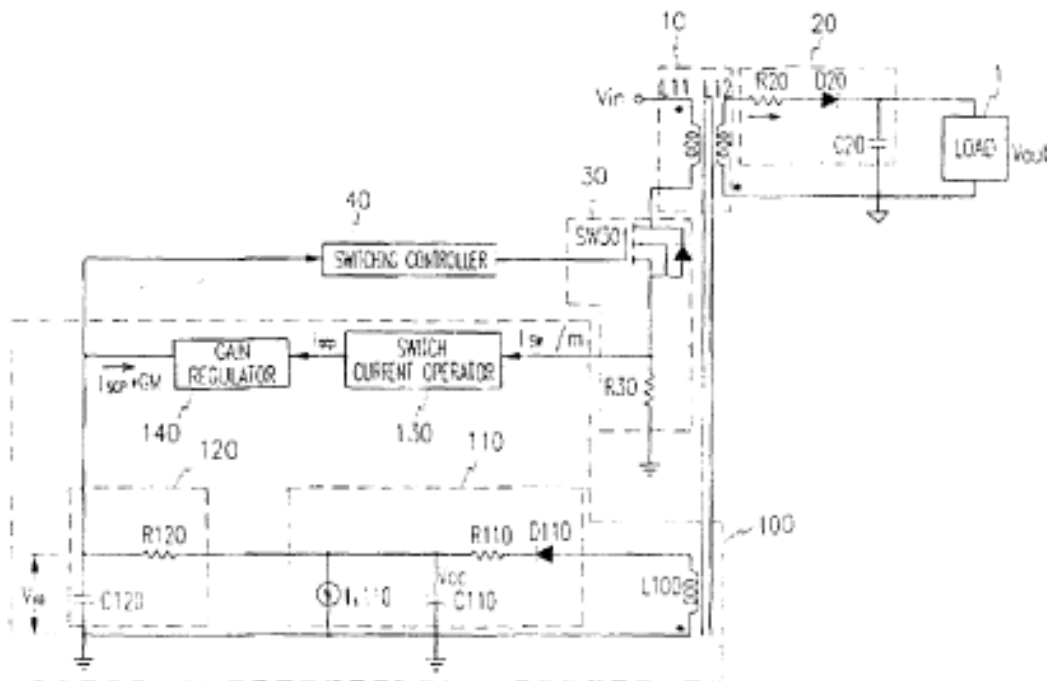


Figure 5 “illustrates an exemplary implementation of a flyback converter according to an embodiment of the invention.” *Id.* at 6:64–66. As described in the ’019 patent, Figure 5 depicts a flyback converter including, *inter alia*, the following components. Primary coil L11 is coupled to an input power V_{in} and to switch 30. *Id.* at 7:16–18. Secondary coil L12 is

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