

Paper No. \_\_\_\_\_

UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE PATENT TRIAL AND APPEAL BOARD

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HUTCHINSON TECHNOLOGY INCORPORATED and  
HUTCHINSON TECHNOLOGY OPERATIONS (THAILAND) CO., LTD.

Petitioners

v.

NITTO DENKO CORPORATION

Patent Owner

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Case No. IPR2017-01421

Patent No. 8,895,870

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**PETITIONER'S OPPOSITION TO  
PATENT OWNER'S MOTION TO AMEND**

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## I. Introduction

Nitto's Motion to Amend ("Motion") does not come close to satisfying the legal requirements for the relief sought. Nitto no longer disputes that its own prior art anticipates Claim 2 – the only claim Nitto asserts in the New Jersey litigation. So Nitto now proposes Substitute Claim 5, adding a limitation requiring that the various layers to have edges "all flush with each other." Paper No. 16 at 3.

But nothing in the original disclosure explains the relationship between the "all flush" edges and the plating leads' resonant frequency, the problem allegedly overcome by the '870 patent. *See* Ex. 1001. In fact, the original disclosure never even mentions the terms "flush" or "edge." *Id.* According to Nitto, Substitute Claim 5 is supported by a "schematic" illustration intended to explain the **orientation** of the multiple layers -- not what occurs at their micron-scale edges.

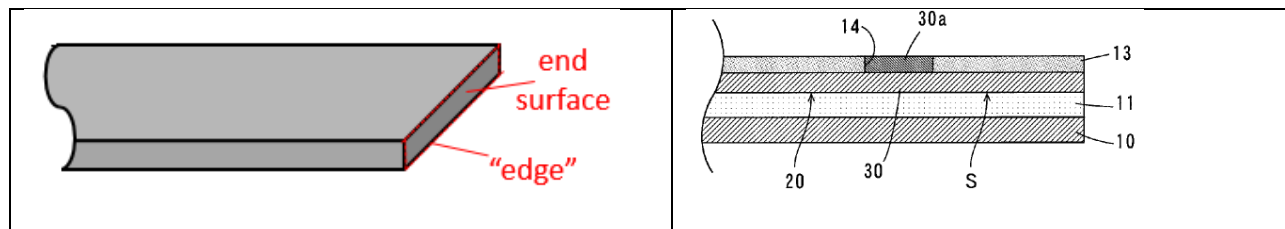
Contrary to Nitto's assertions, the record does not establish the inventors possessed the "all flush" limitation at the time Nitto filed for the '870 Patent – or even thought of it. Instead, the record establishes the opposite: that Nitto created the "all flush" concept from thin air in the midst of the present IPR proceeding in an act of desperation to breathe life into claim 2, the only claim it asserts in the New Jersey litigation. In doing so, Nitto has created a Section 112 quagmire for itself, implicating the written description, enablement, and indefiniteness

requirements on several fronts. In short, the “all flush” limitation presents a classic example of an “IPR Invention” the Board’s rules on amendment prohibit.

## II. Claim Construction for Substitute Claim 5

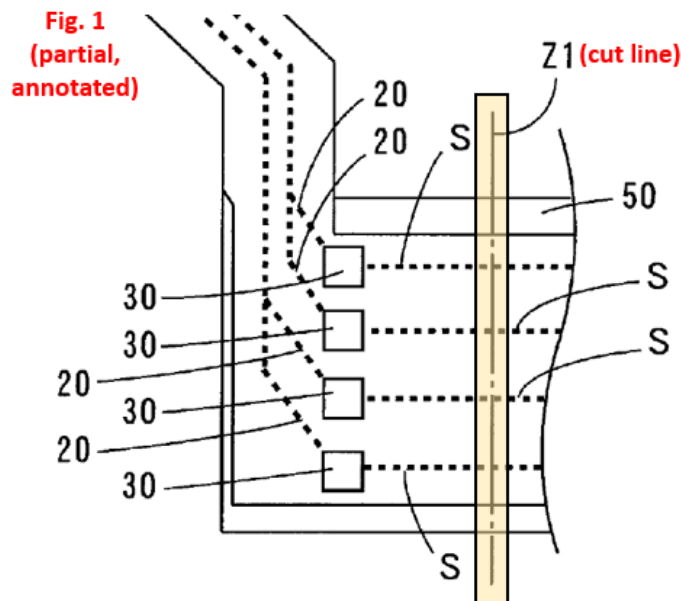
Nitto proposes no constructions. HTI proposes constructions for two terms in Claim 5 -- (1) “edge” and (2) “all flush with each other” – from the new limitation: “wherein **the edges** of the insulating layer, the lead wire for plating, and the cover insulating layer are **all flush with each other**.” Paper No. 16 at 3.

(1) “**the edges**”: The original disclosure from August 2009 does not use the word “edge” in relation to a layer or any physical components. Instead, it uses the word “edge” only in reference to the “rising edge” and “falling edge” of digital signal wave shapes. Ex. 2001 at 24, ¶ 78. In the absence of any specification guidance, a PHOSITA would understand a layer’s “edge” refers to the intersection of two surfaces, as illustrated in the red dotted line below, which is consistent with the ordinary meaning of the word “edge.” By relying on Fig. 2 (right), Nitto seems to be referring to the layers’ “end surfaces”– not the “edges” of the end surfaces:



If Nitto contends the “edges” refer instead to the end surfaces created when the layers are “cut off at the one-dot and dash line Z1” (Ex. 1001 at 8:19), then the

BRI of each “edge” refers to the end surface created along line Z1 of Fig. 1 for the entire width of the circuit board, which is what line Z1 of Fig. 1 depicts:



Ex. 1001, FIG. 1 (annotations added). For purposes of this paper, HTI will assume “edges” in Substitute Claim 5 are meant to be the “end surfaces.”

(2) “all flush with each other”: Based on the BRI of “the edges,” the phrase “all flush with each other” requires that the end surfaces of each of the claimed “cover insulating,” “lead wire for plating” and “insulating” layers be perfectly aligned on the same plane across the width of the circuit board. Or, if not “perfectly” aligned, then this limitation renders Substitute Claim 5 indefinite.

### III. Nitto’s Motion Should Be Denied On Section 112 Grounds

In moving to amend, Patent Owner carries the burden of establishing written description support under 35 U.S.C. § 112. 37 C.F.R. § 42.121(b) (“a motion to amend **must ... set forth ... support in the original disclosure** of the patent for

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