

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Hutchinson Technology Incorporated
Hutchinson Technology Operations (Thailand) Co., Ltd.
Petitioners

v.

Nitto Denko Corporation
Patent Owner

Patent No. 8,895,870
Issue Date: Nov. 25, 2014

Title: PRINTED CIRCUIT BOARD AND METHOD OF MANUFACTURING
THE SAME

Inter Partes Review No. IPR2017-01421

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

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I. Introduction

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

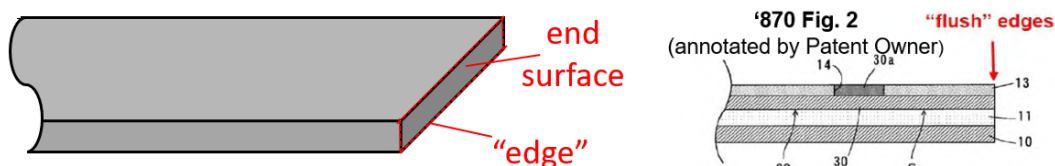
But nothing in the original disclosure explains the relationship between the "all flush" edges and the plating leads' resonant frequency, the problem allegedly overcome by the '870 patent. *See* 1001. In fact, the original disclosure never even mentions the terms "flush" or "edge." According to Nitto, 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 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.” Paper No. 16 at 3.

“**the edges**”: Nitto’s briefing and reliance on Fig. 2 shown below (for example) indicate Nitto uses the term “edges” to refer to what are actually end surfaces.



Paper 16 at 9. While much of HTI’s briefing assumes the same, HTI does not agree “edges” can properly be construed as referring to end surfaces. Instead the ordinary meaning and proper construction of “edge” refers to the intersection of two surfaces, as illustrated in the red dotted line above 1014 ¶ 21.¹

“**all flush with each other**”: 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. Or, if not “perfectly” aligned, then this limitation renders Substitute Claim 5 indefinite. See Section III(E) below.

¹ The original disclosure from August 2009 does not use the word “edge” in relation to a layer or any physical components. 2001.

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