

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TOSHIBA CORPORATION, TOSHIBA MEMORY CORPORATION,  
TOSHIBA AMERICA ELECTRONIC COMPONENTS, INC.

Petitioners

v.

MACRONIX INTERNATIONAL CO., LTD.,  
Patent Owner

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Case IPR2017-01632  
Patent 8,035,417

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**PATENT OWNER'S MOTION TO STRIKE**

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## **I. STATEMENT OF THE PRECISE RELIEF REQUESTED**

Pursuant to 37 C.F.R. § 42.20 and the Board’s August 17, 2018 e-mail authorizing filing of this motion, Patent Owner Macronix International Co., Ltd. (“Macronix”) moves to strike Sections III.A (on pages 2-6), IV.A (on pages 8-11), and IV.B (on pages 11-14) of Petitioner’s Reply (Paper 13 (“Reply”)) because these sections advance new arguments in violation of 37 C.F.R. § 42.23(b). Macronix also moves to strike Exhibit 1007, which is an expert declaration supporting the new arguments in Section III.A of the Reply.

## **II. STATEMENT OF THE REASONS FOR THE RELIEF REQUESTED**

### **A. Background**

Petitioners Toshiba Corp., Toshiba Memory Corp. and Toshiba America Electronic Components, Inc. (collectively “Toshiba”) filed the Petition in this IPR on June 19, 2017, challenging claims 1-7, 11-16, and 18 of U.S. Patent No. 8,035,417 (“the ’417 patent”). [Paper 1 (“Pet.”) at 4, 69.] An expert declaration by Dr. Noel R. Strader II accompanied the petition. [Ex. 1005.] Macronix filed its patent owner response on May 4, 2018. [Paper 12 (“Resp.”).] Toshiba filed its Reply and Ex. 1007 on August 10, 2018. [Reply.]

### **B. The Board Should Strike Toshiba’s New Arguments and Expert Declaration**

#### **1. Toshiba’s New Argument that Figures 3 and 4 of Yen Allegedly Disclose the Same Embodiment**

The Reply and Ex. 1007 assert for the first time that Figures 3 and 4 of Yen

depict the same embodiment. [Reply at 2-6; Ex 1007.] Neither the petition nor Dr. Strader's initial declaration made that assertion. [See generally Pet.; Ex. 1005.]

This new argument is improper. “It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’” *Intelligent Bio-Sys., Inc. v. Illumina Cambridge, Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (quoting 35 U.S.C. § 312(a)(3), and affirming Board’s rejection of new arguments presented in a reply). The APA mandates this strict disclosure for petitioners because patent owners must receive notice of the “matters of fact and law asserted,” and have a meaningful opportunity to respond and “to submit rebuttal evidence.” 5 U.S.C. §§ 554(b)(3), 556(d); *Belden Inc. v. Bek-Tek LLC*, 805 F.3d 1064, 1080-82 (Fed. Cir. 2015). For this reason, the Board cannot “base [its] patentability decision on late-arising factual assertions or theories.” *Securus Techs. Inc. v. Global Tel\*Link Corp.*, IPR2016-00996, 2017 WL 4899298, at \*7 (PTAB Oct. 30, 2017).

Toshiba’s belated assertion that Figures 3 and 4 of Yen depict the same embodiment is such a “late-arising factual assertion[.]” *Id.* Although Dr. Strader now claims to have assumed that Figures 3 and 4 of Yen were a single embodiment all along, he tellingly does not identify anything in his previous declaration to support this assumption, much less justifying it. [Ex. 1007 ¶ 7.] If Dr. Strader

was relying on that assumption, he should have said so before now. Nor is it reasonable to assume that Figures 3 and 4 of Yen depict the same embodiment, since these two figures differ in numerous significant ways, such as different signal inputs, a different arrangement of transistors, and a missing set of OR gates. [Ex. 2001 ¶¶ 109-112, Ex. 1003 (Yen) at 5:8-6:3, 6:23-46, Figs. 3-4.] Given these significant differences, Toshiba and Dr. Strader cannot belatedly conflate these two figures for the first time in the Reply and thus deprive Macronix of a meaningful chance to respond. *Intelligent Bio-Sys.*, 821 F.3d at 1369.

Toshiba also cannot justify this late argument by couching it as a response to proof problems and deficiencies identified in Macronix's Response. *See Apple Inc. v. Andrea Elecs. Corp.*, 2018 WL 3414463, at \*6 (PTAB July 12, 2018) (refusing to consider new assertions made in a reply to overcome deficiencies identified in patent owner's response). Toshiba's new factual assertion simply "crosses the line from the responsive to the new." *See Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 168 (Fed. Cir. 2015). The Board should strike this late argument.

## **2. Toshiba's Two New Claim Constructions**

Toshiba's Reply also improperly relies on two claim construction arguments not made in its Petition. First, Toshiba advances a new antecedent basis theory under which it contends that the "combined output drive strength" limitation relates to the earlier "plurality of output buffer circuits" limitation. [Reply at 8-

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