

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 IPR2017-01904
Patent RE39,933 E

Before BRYAN F. MOORE, JAMES B. ARPIN, and KAMRAN JIVANI,
Administrative Patent Judges.

ARPIN, *Administrative Patent Judge.*

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71

I. BACKGROUND

Power Integrations, Inc. (“Petitioner”) filed a Petition (Paper 2 (“Pet.”)) to institute an *inter partes* review of claims 1–4, 6, 8–17, 19–43, 45, and 46 (the “challenged claims”) of U.S. Patent No. RE39,933 E to Hall *et al.* (Ex. 1001 (“the ’933 patent”), pursuant to 35 U.S.C. §§ 311–319. Pet. 4. Semiconductor Components Industries, LLC (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”). Having considered the Petition, the Preliminary Response, and the evidence of record, and applying the standard set forth in 35 U.S.C. § 314(a), which requires that Petitioner demonstrate a reasonable likelihood that it would prevail with respect to at least one challenged claim; we *denied* Petitioner’s request and did not institute an *inter partes* review of any of the challenged claims of the ’933 patent. Paper 9, 3 (“Inst. Dec.”).

Petitioner filed a Request for Rehearing (Paper 10 (“Reh’g Req.”)), requesting reconsideration of our decision denying institution of *inter partes* review.¹ Petitioner argues that we erred (1) in concluding that Mammano (Ex. 1004) was not a “printed publication” as of the critical date of the ’933 patent (Reh’g Req. 4–11), (2) by holding Petitioner to an unreasonably high standard of proof for the public accessibility of Mammano (*id.* at 11–12), and (3) by failing to allow Petitioner the opportunity to submit a reply to Patent Owner’s Preliminary Response (*id.* at 12–13).

We have considered Petitioner’s Request for Rehearing, and, for the reasons set forth below, Petitioner’s Request is *denied*.

¹ Petitioner notes an error in the identification of the challenged claims in our Institution Decision. Reh’g Req. 1 n.1. We have corrected this error by an Errata (Paper 11), entered concurrently with this paper.

II. STANDARD OF REVIEW

37 C.F.R. § 42.71(d) provides that:

A party dissatisfied with a decision may file a request for rehearing, without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. *The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, opposition, or a reply.*

(Emphasis added.) See Office Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). Under 37 C.F.R. § 42.71(c), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” An abuse of discretion occurs when a “decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus. Inc. v. Celanese Polymer Specialties Co. Inc.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted).

III. DISCUSSION

A. *Mammano Not a “Printed Publication” as of the Critical Date of the ‘933 Patent*

As we noted in the Institution Decision, “[a] petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and *only on the basis of prior art consisting of patents or printed publications.*” Inst. Dec. 8 (quoting 35 U.S.C. § 311(b) (emphasis added)); see 37 C.F.R. § 42.104(b)(2). Petitioner had the burden to establish in its Petition a reasonable likelihood of success, including, among other things, making a threshold showing that Mammano is a “printed publication” within the meaning of 35 U.S.C. §§ 102(b) and 311(b). Inst. Dec. 9 (citing 35 U.S.C. § 314(a)); see 37 C.F.R. § 42.108(c); *Apple, Inc. v. DSS Tech. Mgmt., Inc.*,

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Case IPR2015-00369, slip op. at 4–5, 9–11 (PTAB Aug. 12, 2015) (Paper 14)).

As we explained in the Institution Decision, “[p]ublic accessibility’ is the touchstone in determining whether a reference is a ‘printed publication.’” Inst. Dec. 10 (citing *In re Hall*, 781 F.2d 897, 898–99 (Fed. Cir. 1986)); *see, e.g., L-3 Commc’n. Holdings, Inc. v. Power Survey, LLC*, Case IPR2014-00832, slip op. at 11–12 (PTAB Nov. 14, 2014) (Paper 9) (applied reference not shown to be publicly accessible); *C&D Zodiac, Inc. v. B/E Aerospace, Inc.*, Case IPR2014-00727, slip op. at 20–22 (PTAB Oct. 29, 2014) (Paper 15) (applied reference shown to be publicly accessible). Consequently, “[a] reference will be considered publicly accessible if it was ‘disseminated or otherwise made available to the extent that *persons interested and ordinarily skilled in the subject matter or art* exercising reasonable diligence, can locate it.” Inst. Dec. 10–11 (emphasis added) (citing *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1348 (Fed. Cir. 2016) (quoting *Kyocera Wireless Corp. v. Int’l Trade Comm’n*, 545 F.3d 1340, 1350 (Fed. Cir. 2008) (quoting *SRI Int’l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1194 (Fed. Cir. 2008))). The status of a reference as a printed publication is a legal conclusion “based on underlying factual determinations.” *Blue Calypso*, 815 F.3d at 1348 (citing *In re Lister*, 583 F.3d 1307, 1311 (Fed. Cir. 2009)).

In its Petition, Petitioner asserts that “Mammano was published in May 1993, more than one year prior to the ’933 patent’s earliest priority date, and thus is prior art under 35 U.S.C. § 102(b).” Pet. 4 (citing Ex. 1003 ¶ 57). “This single sentence is the sum total of Petitioner’s *argument* in the Petition for the public accessibility of Mammano.” Inst. Dec. 12 (emphasis added); *see* Prelim. Resp. 7.

Despite the lack of argument, we fully considered the Petitioner’s

evidence regarding the public accessibility of Mammano. Inst. Dec. 12–17. On that record, we were not persuaded that Petitioner made the necessary threshold showing that Mammano (Ex. 1004) was a printed publication more than one year before the earliest filing date (i.e., June 4, 1997) of the '933 patent. *Id.* at 18.

Petitioner did not request the opportunity to submit additional evidence of public accessibility during the Preliminary Proceeding. *Id.* at 17–18; *see* 37 C.F.R. § 42.2 (“*Preliminary Proceeding*”). Nevertheless, Petitioner now asks that we draw certain conclusions from the evidence that Petitioner did not argue in its Petition. Reh’g Req. 4–7.

First, Petitioner now argues that “Dr. Szepesi was himself a skilled artisan at the time he attended the conference.” *Id.* at 5. Petitioner repeats its assessment of a person of ordinary skill in the art (*id.* at 5 (citing Pet. 12)) and then states that:

By 1993, as disclosed in his resume and declaration, Dr. Szepesi had obtained a Ph.D. in Electrical Engineering and had spent nearly a decade as Senior Design Manager in the Power Management Group at National Semiconductor, where he “*managed the design* of integrated circuits for the Power Management product line.” Ex. 1003 at ¶¶ 13–14; Ex. 1007.

Id. at 5 (emphasis added). However, Petitioner fails to show by the arguments and evidence presented in its Request for Rehearing or, more importantly, in its Petition, that Dr. Szepesi “would be familiar . . . with the *operation, design and fabrication* of integrated circuits related to switching voltage regulators.” Pet. 12 (emphases added, citing Ex. 1003 ¶ 32). Thus, we remain unwilling to conclude from the argument and evidence presented *in the Petition* that Petitioner has shown that Dr. Szepesi was a person of ordinary skill in the art at the time of the 1993 Conference.

Second, Petitioner now argues that:

Moreover, Dr. Szepesi explained that Mammano was bound together with all of the other papers presented at the conference and was “freely² distributed to all attendees.” Ex. 1003, at ¶ 57. As the reference itself indicates, presenters at the conference included engineers from industry—including engineers from major corporations such as IBM, Raytheon, National Semiconductor, and AT&T Bell Laboratories, among others; and from academia—including engineering professors from the Warsaw University of Technology, the University of Vienna, and the University of Paderborn in Germany. *See* Ex. 1004, at 3 *Contrary to the Board’s suggestion, it is entirely reasonable to conclude that authors of papers being presented at a conference would attend the conference to present those papers. Moreover, it is equally reasonable to conclude that engineers from industry and academia presenting papers on, for example, “High Power, High Frequency Quasi-Zero-Voltage-Switched PWM Power Converters” would be skilled in the art of power conversion integrated circuits. See id.*

Reh’g Req. 5–6 (emphasis added). Regardless whether it “would be reasonable to conclude” that certain facts exist, Petitioner did not make these arguments *in its Petition*, and it was not error to fail earlier to draw these conclusions, and we decline to draw these conclusions now.

Third, Petitioner argues that:

What’s more, the title of the conference also suggests that it was attended by skilled artisans. The reference explains that this was the eighth annual “High Frequency Power Conversion” conference—suggesting that the conference was not an ad-hoc

² Petitioner now argues that Dr. Szepesi’s testimony that the bound conference papers were “*freely* distributed’ to attendees at the conference” (Reh’g Req. 9–10 (quoting Ex. 1003 ¶ 57)) should be interpreted to mean that the conference materials were distributed *without limitations* (*id.* at 10). Petitioner did not raise this argument in its Petition and appears now to read too much into a single, unexplained word in Petitioner’s declarant’s testimony.

group of a few individuals, but rather was a regular and established meeting of engineers interested in the very subject matter of the Mammano reference. Indeed, a “High Frequency Power Conversion” conference is more likely to raise the interest of those skilled in that field than the general public.

Id. at 6–7. Thus, again, Petitioner asks us to draw certain conclusions from evidence of record, which conclusions Petitioner did not argue in its Petition. Regardless whether the title of the conference could “suggest” certain conclusions regarding interest in any particular article presented at the conference or the nature of the attendees, Petitioner did not make this argument in its Petition, and it was not error to fail earlier to draw these conclusions, and we decline to draw these conclusions now.

Based on these requested “conclusions,” Petitioner now argues that we should find that Mammano is a printed publication consistent with the requirements of *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004). Reh’g Req. 10; *see id.* at 7–10. We decline to draw now the conclusions argued for the first time in this Request for Rehearing. A request for rehearing is not an opportunity for the requestor to present new arguments or evidence. It goes without saying that we could not have overlooked or misapprehended arguments that Petitioner did not make, and it is not an abuse of discretion not to consider such arguments.

Thus, Petitioner’s submission of new arguments and evidence in its Request for Rehearing is both improper and unpersuasive.

B. Petitioner Held to Unreasonably High Standard of Proof for Mammano’s Public Accessibility

As noted above, in the Institution Decision, we explained that Petitioner had the burden to establish in its Petition a reasonable likelihood of success in its challenge to at least one claim, “including, among other

things, *making a threshold showing that Mammano is a ‘printed publication’* within the meaning of 35 U.S.C. §§ 102(b) and 311(b).” Inst. Dec. 9 (emphasis added). Petitioner argues that:

The Board faulted [Petitioner] for not providing every possible detail about the publication of Mammano. None of the cases sets out any particular quantum of fact required—rather, the cases all say that whether a reference qualifies as a printed publication should be determined based on all of the facts and circumstances present—not based on the facts and circumstances not presented. Moreover, [Petitioner] did not have to prove public accessibility to an absolute certainty. To demonstrate a reasonable success on the merits, [Petitioner]’s petition only had to demonstrate that it had a reasonable likelihood of proving public accessibility. 37 C.F.R. ¶ 42.108(c). The uncontradicted facts put forward by [Petitioner] certainly did so here, and the Board clearly erred in concluding otherwise.

Reh’g Req. 11–12. Although we did not require that Petitioner show “every possible detail,” we did require Petitioner to make a threshold showing.

In finding that Petitioner failed to make the necessary threshold showing, we applied the standard clearly set forth by our reviewing court in *Blue Calypso, Kyocera Wireless, and SRI International* to Petitioner’s arguments and evidence. *See supra* Section III.A. A request for rehearing is not merely the opportunity for the requester to reargue positions, elaborate on previous positions, or to disagree with the analysis or conclusions of the panel. *See Nestlé Purina Petcare Co. v. Oil-Dri Corp. of Amer.*, Case IPR2015-00737, slip op. at 8 (PTAB Feb. 9, 2017) (Paper 39) (“Merely disagreeing with our analysis or conclusions does not serve as a proper basis for a request for rehearing.”); *see also* Inst. Dec. 11 n.3.

Petitioner further argues that we “should have evaluated [Petitioner]’s petition in the light most favorable to [Petitioner].” Reh’g Req. 12.

Although our rules provide that, when a patent owner presents testimonial

evidence and when such testimonial evidence creates a genuine issue of material fact, “such testimonial evidence will be viewed in the light most favorable to the petitioner solely for purposes of deciding whether to institute an *inter partes* review.” 37 C.F.R. § 42.108(c). Here, as Petitioner acknowledges, Patent Owner did not submit testimonial evidence with its Preliminary Response. Reh’g Req. 12 (“Although Patent Owner did not provide any declaratory evidence (or any evidence for that matter), the reasoning behind this rule suggests that, where several reasonable interpretations of the facts exist, instituting the case for further development of the factual record is the proper course of action.”). Consequently, we decline to adopt Petitioner’s suggestion that we extend our rule to the present situation.

Thus, after careful review of Petitioner’s arguments and evidence and applying the proper standard for evaluating this threshold issue, we determined that Petitioner’s arguments and evidence with respect to the status of Mammano as a printed publication failed to persuade us that Petitioner met the necessary threshold. Inst. Dec. 11, 18.

C. Petitioner Should Have Been Given the Opportunity to Reply to Patent Owner’s Preliminary Response

Petitioner argues that:

The Board’s conclusions regarding publication are all the more significant because the Board faulted [Petitioner] for failing to explain certain details about the public availability of these publications but at the same time denied [Petitioner] the ability to do so. *After Patent Owner challenged the public availability of the Mammano reference, [Petitioner] asked the Board to allow it to file a reply to the [Patent Owner’s Preliminary Response] in order to address “incorrect legal and factual assertion[s] made therein.” See Ex. 1019, at 5:20–6:2; see also Paper 9, at 17. The Board denied [Petitioner]’s request. See Ex.*

1019, at 20. Despite denying the request, the Board still faulted [Petitioner] for failing to make “arguments” that could have been presented in such a reply. *See, e.g.*, Paper 9, at 14 (“Petitioner, however, leaves it to us to suppose the facts that would support” that the conference was attended by industry members); *id.* at 15 (“Petitioner does not argue that Dr. Szepesi was a person of ordinary skill in the art at the time of the conference”).

Reh’g Req. 12–13 (emphasis added).

Because *inter partes* reviews only may be instituted on anticipation and obviousness challenges based on “prior art consisting of *patents or printed publications*” (35 U.S.C. § 311(b) (emphasis added)), we start from the assumption that Petitioner was aware that it might have to demonstrate that the *sole* reference relied upon in *each* of its grounds for challenging the patentability of claims of the ’933 patent was a printed publication. Thus, it was not Patent Owner’s Preliminary Response that triggered the need for Petitioner to make a threshold showing that Mammano is a printed publication.

Although Petitioner sought to file a reply in order to address “incorrect legal and factual assertion[s]” made in the Patent Owner’s Preliminary Response, Patent Owner did not argue in its Preliminary Response that the conference was *not* attended by industry members or that Dr. Szepesi was *not* a person of ordinary skill in the art at the time of the conference. *See* Reh’g Req. 12–13 (quoting Inst. Dec. 14, 15). Patent Owner asserted that “Petitioner offers no facts regarding the constitution of the [conference] audience, another important factor in determining public accessibility” (Prelim. Resp. 5) and that “Dr. Szepesi does not state whether persons having ordinary skill in the art constituted a significant portion of the attendees at the Conference” (*id.*; *see* Ex. 1003 ¶ 57). These assertions are not “incorrect.”

Petitioner argues that, “[d]espite denying the request, the Board still faulted [Petitioner] for failing to make ‘arguments’ that could have been presented in such a reply.” Reh’g Req. 13. We found that the arguments and evidence that were presented in the Petition were insufficient to make the required, threshold showing that Mammano was a printed publication. Inst. Dec. 11 (“For the reasons set forth below, we determine that Petitioner’s arguments and evidence with respect to the status of Mammano as a printed publication are unpersuasive and, therefore, that Petitioner is not reasonably likely to succeed in establishing the unpatentability of any challenged claim.”). Moreover, a reply is not a second chance to cure deficiencies in the Petition. *Hewlett-Packard Co. v. U.S. Philips Corp.*, Case IPR2015-01505, slip op. at 3 (PTAB Dec. 16, 2015) (Paper 15) (denying a reply to Patent Owner’s Preliminary Response and stating that “Petitioner has the burden to establish *in its Petition* a reasonable likelihood of success, including, among other things, making a threshold showing that the relied upon references are ‘printed publications’ within the meaning of 35 U.S.C. §§ 102 and 311(b).” (emphasis added)).

As we noted in the Institution Decision,

[d]uring a conference call on January 9, 2018, Petitioner requested authorization to file a reply to Patent Owner’s Preliminary Response and to respond to Patent Owner’s contentions regarding the public accessibility of Mammano. Ex. 1019, 5:20–6:2. Nevertheless, Petitioner acknowledged that the panel was capable of assessing the requirements of the law and the evidence of record (*see id.* at 7:17–8:4) and that Petitioner did not intend to submit further evidence regarding public accessibility (*see id.* at 10:13– 12:3). In particular, Petitioner stated that it did not wish to submit a further declaration from Dr. Szepesi, who was not only an attendee, but appears to have been a presenter (*see* Ex. 1004, 3 (Session 2.9)), concerning the public accessibility of the technical papers book.

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Ex. 1019, 11:11–13. Therefore, we denied authorization for a reply. *Id.* at 19:20–21:11.

Inst. Dec. 17–18. The decision to deny Petitioner’s request for a reply was based on its failure to show good cause for such a reply when afforded an opportunity to argue for such a reply. Ex. 1019, 19:22–21:4; *see* 37 C.F.R. § 42.108(c) (“A petitioner may seek leave to file a reply to the preliminary response in accordance with §§ 42.23 and 42.24(c). *Any such request must make a showing of good cause.*” (emphasis added)).

It was Petitioner’s burden to show in its Petition that it was entitled to institution of an *inter partes* review, including showing a reasonable likelihood of prevailing in showing that its challenges to the claims of ’933 patent were based on patents or printed publications, as required by statute. After reviewing the arguments and evidence presented by Petitioner in light of Patent Owner’s Preliminary Response, we determined that Petitioner failed to meet this burden.

D. Conclusion

We are not persuaded that Petitioner shows that we misapprehended or overlooked arguments or evidence.

IV. ORDER

Accordingly, it is hereby:

ORDERED that Petitioner’s Request for Rehearing is *denied*.

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