

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SUPERIOR COMMUNICATIONS, INC.,
Petitioner

v.

VOLTSTAR TECHNOLOGIES, INC.,
Patent Owner

Case IPR2017-00067
Patent 7,910,833

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

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I. INTRODUCTION

This Reply is submitted in response to the Patent Owner's (Voltstar) Response filed August 8, 2017. Petitioner submits the Reply Declaration of Dr. Mark Horenstein (Ex.1033) in support of this Reply.

All grounds of rejection raised in the Institution Decision should be maintained by this Board.

II. CLAIM CONSTRUCTION

Voltstar identifies the Federal Circuit construed "circuitry for converting" in claim 11, and "the power device draws no input power in the 'off' state" in claim 1 (Response at 1–2). However, these claim constructions still result in the invalidity of the claims in this proceeding.

Voltstar points to no aspect of the Federal Circuit constructions that results in the validity of any of the claims in this proceeding.

Petitioner asserts that the claims at issue in this proceeding are invalid under these constructions.

III. PRIOR FACT FINDINGS BY THE BOARD

Voltstar identifies the PTAB made a fact finding in the prior reexamination that a capacitive filter does not "convert" (Response at 3). Voltstar points to no aspect of this fact finding that results in the validity of any of the claims in this

proceeding. Petitioner asserts that the claims in this proceeding are invalid even under this finding of fact.

IV. THERE IS NO ESTOPPEL UNDER 35 U.S.C. § 315(e)

Voltstar argues “Estoppel – Patent Owner Reasonably Could have raised these issues in the prior proceedings – 35 U.S.C. §315(e) – Petitioner should be estopped” (Response at 3–8). Voltstar also argues “Superior is now estopped from proceeding with this second reexamination” (Response at 8 (emphasis added)).

As an initial point, Petitioner notes that this proceeding is not a reexamination. This is an *inter partes* review.

As a second point, Petitioner asserts there is no estoppel under 35 U.S.C. § 315(e). The plain language of § 315(e) states: “[t]he petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review” (emphasis added).

The prior proceeding was not an *inter partes* review. It was an *inter partes* reexamination. The prior proceeding did not result in a final written decision under section 318(a). Rather, it resulted in an *inter partes* reexamination certificate under pre-AIA 35 U.S.C. § 316. Thus, estoppel under § 315(e) is

inapplicable in the present proceeding, contrary to Voltstar's arguments.

All of Voltstar's arguments and evidence regarding whether a "rehash" is raised of the prior reexamination, or whether the prior art was available to Petitioner during the prior reexamination, should be disregarded because there is no estoppel under § 315(e).

Voltstar raises these arguments regarding § 315(e) on pages 3–8, 16–21, and 27–29 of its Response, and in the Declaration of Robert Pershes (Ex.2019) and in the Declaration of John Tobias (Ex.2021). All of these arguments and evidence are inapplicable because there is no estoppel under § 315(e).

An *inter partes* review is a different proceeding than an *inter partes* reexamination, with different procedures such as discovery and deposition of declarants, which were not available to Petitioner in the reexamination.

In addition, information regarding whether the same or substantially the same prior art or arguments were raised in the prior reexamination was presented to this Board prior to the Institution Decision. The prior record of the reexamination proceeding was available to this Board prior to the Institution Decision. The Board already made the determination of whether to institute this proceeding in light of the prior record and these issues are accordingly moot.

Further, the prior art and arguments raised in this *inter partes* review do not constitute a "rehash" of the prior art and arguments raised in the reexamination.

A. Sakamoto in View of Odaohhara Does Not Constitute Same Prior Art and Arguments as Bhogal in view of Odaohhara or Yang in view of Odaohhara

Voltstar improperly attempts to make it seem that the same prior art and arguments are raised by Sakamoto in view of Odaohhara, as was raised with Bhogal with Odaohhara or Yang with Odaohhara in the prior reexamination.

In the prior reexamination, Bhogal was combined with Odaohhara to demonstrate invalidity of claim 4. Yang was also combined with Odaohhara to demonstrate invalidity of claim 4. The rejections, however, were removed by the PTAB because it found that limitations were not rendered invalid in claim 1 (from which claim 4 depends), however, and not those added by claim 4, as Voltstar improperly wishes to make it appear (see Ex.1004 at 21–29).

The rejection to claim 4 of Bhogal in view of Odaohhara was removed because the PTAB found that Bhogal did not sufficiently disclose “no input power” in claim 1 (Ex.1004 at 26). The PTAB found Bhogal did not indicate power cut-off on the primary side of the transformer (Ex.1004 at 28).

The PTAB never found the combination of Odaohhara’s sheath with Bhogal’s switch in claim 4 was improper. The Examiner asserted this combination of sheath and switch was proper in claim 4, and this finding remained untouched by the PTAB (Ex.1003 at 10).

The combination of Sakamoto with Odaohhara is a different argument here

because Sakamoto discloses a circuit diagram showing power being cut off on the primary side of the transformer, and discloses all power is cut off (Ex.1009 [0015], Figure 1).

Thus, this is a new argument with new prior art (Sakamoto) regarding the features of claim 1 (and thus claim 4) (Ex.1033 ¶¶6–18).

The rejection to claim 4 of Yang in view of Odaohhara was removed by the PTAB because it found Odaohhara did not render “DC output” obvious in claim 1 (Ex.1004 at 21–24).

The PTAB never found the combination of Odaohhara’s sheath with Yang’s switch in dependent claim 4 was improper. The Examiner asserted the combination of Odaohhara’s sheath with Yang’s switch was proper in claim 4, and this finding remained untouched by the PTAB (Ex.1003 at 8).

The combination of Sakamoto with Odaohhara is a different argument here because Sakamoto itself discloses DC output (Ex.1009 [0009]).

Thus, this is a new argument with new prior art (Sakamoto) regarding the features of claim 1 (and thus claim 4 depending therefrom) (Ex.1033 ¶¶6–18).

B. Noguchi in View of Huang and Suzuki Does Not Constitute Same Prior Art and Arguments as Yang in view of Suzuki

The Patent Owner improperly attempts to make it seem that the same prior art and arguments are raised by Noguchi in view of Huang and Suzuki, as were

raised with Yang with Suzuki in the prior reexamination.

In the prior reexamination, Yang was combined with Suzuki to demonstrate invalidity of claim 18 (not claim 11) (Ex.1004 at 7).

The rejection to claim 18 was removed by the PTAB because it found Yang did not disclose “circuitry for converting” in claim 11 (claim 18 depends therefrom) (Ex.1004 at 20–21).

The PTAB never found the combination of Yang’s device with Suzuki’s latching relay in claim 18 was improper. The Examiner asserted the combination of Yang’s device with Suzuki’s switch was proper in claim 18, and this finding remained untouched by the PTAB (Ex.1003 at 9).

The combination of Noguchi with Suzuki is a different argument here because Noguchi itself discloses “a common AC/DC converter.” (Ex.1011 [0014]).¹

Thus, this is a new argument with new prior art (Noguchi and Huang) regarding the features of claim 11 (and thus claim 18 depending therefrom) (Ex.1033 ¶¶49–57).

C. Mr. Pershes’ Testimony Regarding Whether Prior Art Should Have Been Found Should Be Given No Weight

Mr. Pershes’ Declaration (Ex.2019) opines regarding whether Petitioner

¹ Dr. Tobias during deposition admitted Noguchi comprises different prior art than Yang in regard to claim 11 (See Ex.1031 at 7:16-18).

reasonably could have found and thus raised prior art references in the reexamination. Pershes' testimony should be given no weight because there is no estoppel under § 315(e) (estoppel on any ground petitioner "raised or reasonably could have raised during that inter partes review" (emphasis added)). The testimony regarding whether prior art reasonably could have been raised is inapplicable.

Pershes' testimony also should be given no weight because he never establishes he is an expert in prior art searching. He merely states he "directed and reviewed numerous patent searches and investigations" (Ex.2019 ¶3). He refused to produce any evidence of such patent searches and investigations upon request (see Notice of Deposition of Robert Pershes (paper 22) at 3); see also Ex.1030 (Email in which Voltstar refused to produce such documents on a claim of privilege and/or lack of possession, custody or control). He does not consider himself to be an expert in searching:

- Q: "So you are not claiming that you would be considered an experienced searcher yourself, are you?"

A: I would not consider myself an expert searcher. That's not the scope of what I was trying to opine on." (Ex.1032 at 11:19–22).

- Q: "[S]ince you have never searched Japanese-language documents, and you are not an expert on searching, do you have any knowledge, facts or data,

concerning how long or how difficult it would be to find the Noguchi reference or the Sakamoto reference?

A: I cannot answer that question.” (Ex.1032 at 23:9–14).

- Q: “Did you make any efforts to perform a search of your own to see how difficult it was to find the Noguchi and the Sakamoto references?

A: I did not.” (Ex.1032 at 26:15–18).

Pershes could not even guarantee the Noguchi and Sakamoto references would be found by a searcher in a “reasonable” patent search:

- Q: (Referring to Noguchi and Sakamoto being retrieved in a “reasonable” search) “Why do you say that? How do you know?

A: Whether it’s guaranteed that it would be found, I don’t know.” (Ex.1032 at 37:14–16).

Pershes’ testimony should be given no weight. It is uncontested that Petitioner was unaware of these references and did not have these references for use in the reexamination. It is also undisputed that the Cardinal IP firm and the Envision firm did not retrieve the Noguchi or Sakamoto references upon a search request. Further, the prior Shah Declaration (Ex.1025) never stated that foreign language documents were not retrieved in the search. Rather, the Shah Declaration stated the references were exceptionally difficult to retrieve because they were in a foreign language and did not have a corresponding English language patent

document (Ex.1025 ¶¶17, 21). By Mr. Shah's own standards, he indeed does search for foreign language documents when performing a search (Ex.2020).

V. THERE IS NO ESTOPPEL UNDER 35 U.S.C. § 315(b)

Voltstar raises the same argument regarding 35 U.S.C. § 315(b) it raised in its Preliminary Response (paper 10) and that this Board dismissed in the Institution Decision (paper 14 at 8–11). Petitioner filed responsive papers (paper 11) on this point. Voltstar raises the same argument to “avoid any waiver” (Response at 8). This Board should continue to disagree with Voltstar's position. There are no additional facts or authority raised here warranting the Board to change its finding.

Petitioner raises the same rebuttal arguments in its responsive paper (paper 11) to similarly prevent any waiver. The decision in *Microsoft Corp. v. Parallel Networks Licensing LLC*, IPR2015-00483, paper 10 at pgs. 12–14 (July 15, 2015) is directly contrary to Voltstar's position. The PTAB held a private agreement between parties that may create significant “on-going legal effect” does not change the *de jure* legal effect of a voluntary dismissal without prejudice, and there is no time bar. *Id.*

Voltstar argues it raises this issue again under “additional ... authority” (Response at 8). Voltstar raises no additional authority (Response at 8–13).

Voltstar argues it raises this issue again under “additional facts” (Response at 8). No additional facts are raised. The tolling agreement referenced by Voltstar

was already submitted to this Board as Exhibit 2010. Voltstar submits the declaration of James McGinley (Ex.2018). However, this declaration merely attests to facts presented to the Board prior to the Institution Decision and that are in the tolling agreement. The declaration and arguments do not change the result that a private agreement between parties that may create significant “on-going legal effect” does not change the *de jure* legal effect of a voluntary dismissal without prejudice.

VI. ANY ALLEGED DISQUALIFICATION OF ANDREW FLIOR IS MOOT

Voltstar argues Andrew Flior should be disqualified because Voltstar has the right to seek documentary discovery from Petitioner’s counsel and to depose Mr. Flior (Response at 13–14). Petitioner responds that this issue is moot because Voltstar did not seek documentary discovery or to depose Mr. Flior during Voltstar’s assigned discovery period.

Petitioner also asserts there is no disqualification of Mr. Flior’s entire law firm because there is no violation of 37 CFR 11.307(b). Mr. Vakil has served as lead counsel and advocate since the start of this proceeding and Mr. Leach is back-up counsel, and neither violates §§ 11.307(b), 11.107, or 11.109.

VII. CLAIM 4 IS OBVIOUS OVER SAKAMOTO IN VIEW OF ODAOHARA

A. Sakamoto with Odaohara Is Not a “Rehash” of an Unsuccessful Argument in the Reexamination

Voltstar’s arguments that Sakamoto in view of Odaohara is a “rehash” of a prior unsuccessful argument is misplaced because there is no estoppel under §315(e) as stated above in Section IV. In addition, it is not a “rehash” of a prior unsuccessful argument for the reasons stated above in Section IV.A.

B. Sakamoto Does Not “Teach Away” from Odaohara

Voltstar argues the presence of an alternative design in Sakamoto, specifically Sakamoto’s Figure 10(b) embodiment, would “teach away” from substituting Odaohara’s sheath (52) for Sakamoto’s pin (34) (Response at 21–24). This is incorrect because there is no teaching away — there is no criticism, discrediting, or discouragement of the combination of Sakamoto with Odaohara. *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004) (“the prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed....” (emphasis added)).

Figure 10(b) merely represents an alternative manner of reducing deformation of Sakamoto’s pin (34). The mere presence of this alternative does not mean it would not be obvious to also substitute Odaohara’s sheath (52) for

Sakamoto's pin (34) to remedy the problem of pin deformation, or to allow for various plug entry orientations. Voltstar points to no disclosure or teaching of Sakamoto that criticizes, discredits, or discourages use of a sheath structure and there is no disclosure or teaching of Sakamoto that teaches away from use of a sheath structure (Ex.1033 ¶¶19–26).

Further, the combination of Sakamoto and Odaohhara would beneficially allow Sakamoto's central DC (+) terminal (32) (shown in Sakamoto's Figure 2) to be utilized and mate with a corresponding female shaped positive terminal. This is an advantage that a sheath has over the Figure 10(b) embodiment if such a female terminal was used. In Sakamoto's Figure 10(b) embodiment, the central DC (+) terminal (32) is not utilized because the central terminal (32) is replaced by pin (34(a)) (Ex.1033 ¶25).

C. Sakamoto Is Enabling

Prior art publications and patents are presumed to be enabled. *In re Antor Media Corp.*, 689 F.3d 1282, 1287–89 (Fed. Cir. 2012); *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354–55 (Fed. Cir. 2003). This presumption of enablement applies to foreign patents because 35 U.S.C. § 282 is not the source for the presumption. *See Amgen*, 314 F.3d at 1355.

In addition, “[u]nder § 103 ... a reference need not be enabled; it qualifies as a prior art, regardless, for whatever is disclosed therein ... enablement of the prior

art is not a requirement to prove invalidity under § 103.” *See Amgen*, 314 F.3d at 1357 (emphasis added). As stated in *Beckman Instruments, Inc. v. LKB Produkter AB*, “[e]ven if a reference discloses an inoperative device, it is prior art for all that it teaches.” 892 F.2d 1547, 1551 (Fed. Cir. 1989); *see also Finjan, Inc. v. Fireeye, Inc.*, IPR2014-00344, paper 39, at pg. 36 (July 10, 2015) (“a non-enabling reference can qualify as prior art for the purpose of determining obviousness”).

Here, Voltstar’s arguments that Sakamoto is non-enabled are misplaced because Sakamoto is used in an obviousness combination under § 103. In addition, even if Voltstar’s arguments regarding non-enablement were applicable, they are insufficient to overcome Sakamoto’s presumption of enablement. *See Amgen*, 314 F.3d at 1355.

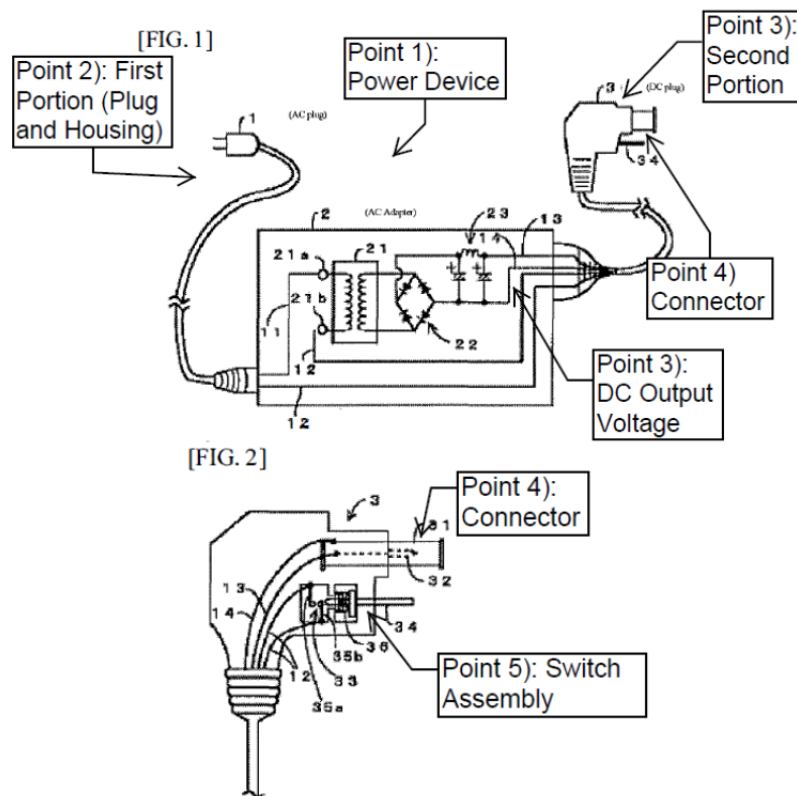
Voltstar argues Sakamoto is not-enabling because “it violated electromagnetic interference and safety standards” (Response at 24). However, Voltstar and its expert Dr. Tobias both fail to identify or specify any such interference or safety standards (Response at 24–25; Ex.2021 ¶23).

In addition, the issue of whether any regulatory standards would be violated in a particular jurisdiction is directed to the laws of that jurisdiction, and not to whether Sakamoto’s disclosure is enabling for the limitations of claim 4. Further, whether Sakamoto’s disclosure would be commercially accepted or successful is not the inquiry regarding enablement. *See Impax Labs. Inc. v. Aventis Pharm. Inc.*,

468 F.3d 1366, 1383 (Fed. Cir. 2006) (“proof of efficacy is not required for a prior art reference to be enabling for purposes of anticipation”); *CFMT, Inc. v. Yieldup Int’l Corp.*, 349 F.3d 1333, 1338 (Fed. Cir. 2003) (to comply with the enablement requirement it is not necessary to “enable one of ordinary skill in the art to make and use a perfected, commercially viable embodiment absent a claim limitation to that effect.”). Whether a device would be approved by a regulatory agency is also not the inquiry regarding enablement. *See, e.g., Scott v. Finney*, 34 F.3d 1058, 1063 (Fed. Cir. 1994) (“Testing for full safety and effectiveness of a prosthetic device is more properly left to the [FDA] ... [c]ongress has given the responsibility to the FDA, not to the [PTO], to determine ... whether drugs are sufficiently safe.”).

Sakamoto in view of the Odaohhara is enabling for the limitations of claim 4 (Ex.1033 ¶¶27–42). “An anticipatory reference need only enable subject matter that falls within the scope of the claims at issue, nothing more.” *Schering Corp. v. Geneva Pharms., Inc.*, 339 F.3d 1373, 1381 (Fed. Cir. 2003). Claim 4 recites (the entire text of claim 4 is not reproduced below to conserve word count, but the entire text is referred to in the discussion below): 1) a power device ... comprising : 2) a first portion ... having an input voltage; 3) a second portion ... having a DC output voltage; 4) a connector ... with the electronic device; and 5) a switch assembly ... in the “off” state; and 6) wherein the switch assembly member ... the

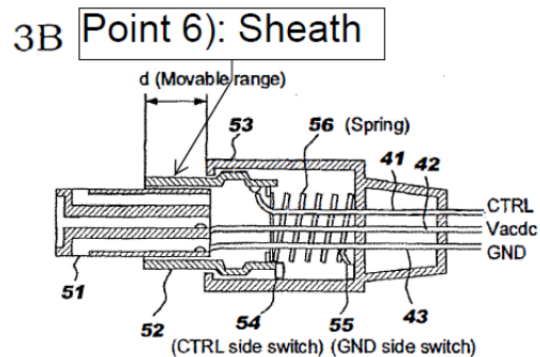
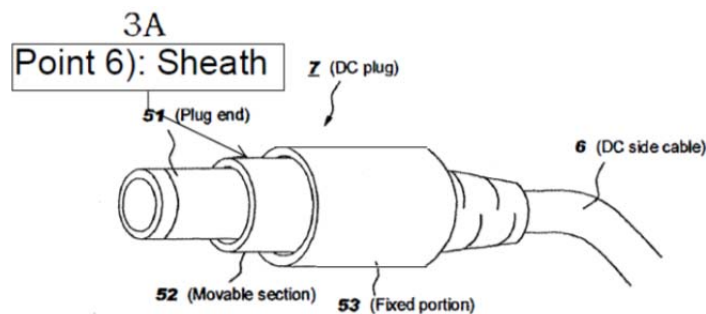
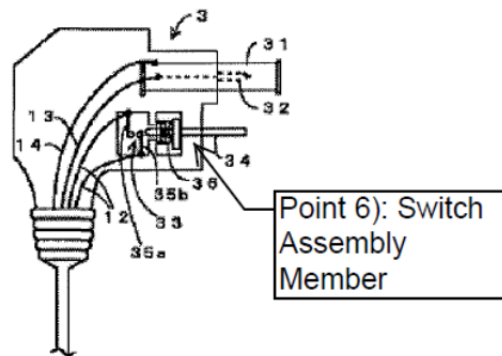
first and second positions (Ex.1001 at 11:39–53, 58–60). All of the features of points 1–5 are taught and detailed in Sakamoto through circuit diagrams and structural diagrams in Figures 1 and 2 of Sakamoto and corresponding portions of Sakamoto’s written disclosure. Sakamoto’s Figures 1 and 2 are shown below with call-outs added corresponding to points 1–5.



The correspondence between the claim features in points 1–5 and the figures and teachings of Sakamoto were detailed in the Petition on pages 16–22.

The features of point 6 are disclosed in Odaohhara in detailed illustrations (including a cross sectional view) in Figures 3A and 3B, and in a detailed illustration in Figure 2 of Sakamoto. Sakamoto’s Figure 2 and Odaohhara’s

[FIG. 2]



Sakamoto and Odaohhara are of the type and kind relied upon by a person having ordinary skill in the art (a “PHOSITA”) to make and use such a device as is claimed in claim 4, and are sufficient for a PHOSITA to make and use the device in claim 4 without undue experimentation. Dr. Horenstein’s declaration stated that a PHOSITA would have had a Bachelor of Science degree in Electrical Engineering or a closely-related field, and a minimum of one to two years of professional experience in the development of electronic power devices or other equivalent experience (See Ex.1019, ¶33). A PHOSITA having this level of experience would be able to make and use the device claimed in claim 4 without undue experimentation based on the level of detailed teachings provided in Sakamoto and Odaohhara (Ex.1033 ¶¶27–42).

To the extent Voltstar argues Sakamoto does not enable features that are not present in claim 4, such as features that might allegedly result in additional safety, then these features are simply not present in claim 4 and do not constitute a part of the enablement inquiry. *See Schering Corp.*, 339 F.3d at 1381 (“An anticipatory reference need only enable subject matter that falls within the scope of the claims at issue, nothing more.”); *CFMT, Inc.*, 349 F.3d at 1338 (to comply with the enablement requirement it is not necessary to “enable one of ordinary skill in the art to make and use a perfected, commercially viable embodiment absent a claim limitation to that effect.” (emphasis added)). If a PHOSITA sought to add these

additional safety features (insulation, control circuitry), these would be within the ability of a PHOSITA (Ex.1033 ¶42).

Further, the combination of Sakamoto and Odaohhara would work for its intended purpose. Sakamoto teaches “an AC adapter suited to be applied to an electronic device such as a computer or a cellular telephone.” (Ex. 1009 at [0001]). Sakamoto and Odaohhara provide the teachings (through the circuit diagrams and detailed teachings) that allow a PHOSITA make and use the AC adapter to operate for its intended purpose to supply power to a portable rechargeable electronic device without undue experimentation (Ex.1033 ¶40).

The Declaration of Dr. Tobias should be given no weight regarding Sakamoto’s alleged “non-enablement.” Tobias’ opinions are based on the understanding that a prior art reference must be operative to contribute to obviousness:

- “Q: But at least in reaching the opinions that you reached in this case where you deemed a prior art reference to be inoperative, in your view, it did not contribute to obviousness?

A: The answer is yes. Looking at each of them in context, yes” (Ex.1031 at 15:19–24).

Tobias’ opinions are also based on the understanding that if a prior art reference is non-enabling, then it does not contribute to obviousness:

- “Q: So to rephrase your answer, if a prior art reference is not enabling, then it does not contribute to obviousness?

A: Correct” (Ex.1031 at 15:5–8).

Tobias’ opinions should be given no weight because the basis for Tobias’ opinions conflict with established law. *See Amgen*, 314 F.3d at 1357 (“[u]nder § 103 ... a reference need not be enabled) (emphasis added); *see also Beckman Instruments, Inc.*, 892 F.2d at 1551 (“[e]ven if a reference discloses an inoperative device, it is prior art for all that it teaches.”).

In sum, even if Voltstar’s arguments regarding non-enablement were applicable, they are insufficient to overcome Sakamoto’s presumption of enablement. *See Amgen*, 314 F.3d at 1355. *Sakamoto* properly serves as prior art to invalidate claim 4.

D. Sakamoto Would Not Be Modified to Draw Power Greater Than Microwatts

There is no disclosure in Sakamoto that its adapter draws power greater than microwatts in an “off state.” Sakamoto explicitly states “the consumption of energy from the commercial power source is completely eliminated” (Ex. 1009 at [0015]) (emphasis added).

Voltstar contends Sakamoto would draw power greater than microwatts if

modified to do so (Response at 25–26).² A PHOSITA, however, would have no motivation to modify Sakamoto to draw any power because this would thwart the stated purpose of Sakamoto that “the consumption of energy from the commercial power source is completely eliminated.” (Ex. 1009 at [0015]) (emphasis added) (Ex.1033 ¶¶43–48).

A PHOSITA would not be motivated to make Sakamoto draw power in response to any alleged enablement issue regarding Sakamoto. As stated above in section VII.C., Sakamoto and Odoahhara enable claim 4. Further, Sakamoto explicitly states the consumption of energy from the commercial power source is completely eliminated. Even if circuitry, such as filtering circuitry suggested by Voltstar, was added for some reason, then the circuitry would be placed electrically downstream of Sakamoto’s switch assembly (Ex.1033 ¶48). There is nothing electrically incorrect with placing circuitry that might draw power downstream of Sakamoto’s switch assembly. The ‘833 Patent discloses a Figure 8 embodiment having a cut-off switch 50a, 50b placed upstream of circuitry that draws power (connected with lines L1' and L2') (Ex. 1001 at 8:31–35).

² During deposition Dr. Tobias stated Sakamoto would only draw power in the “off” state if modified to do so: “Q: you say that then if you add the other elements that are not disclosed in Sakamoto ... it would draw power in the off condition, correct?; A: That’s right.; Q. But only if you add those additional elements?; A: Which are – yes” (Ex.1031 at 13:8–14).

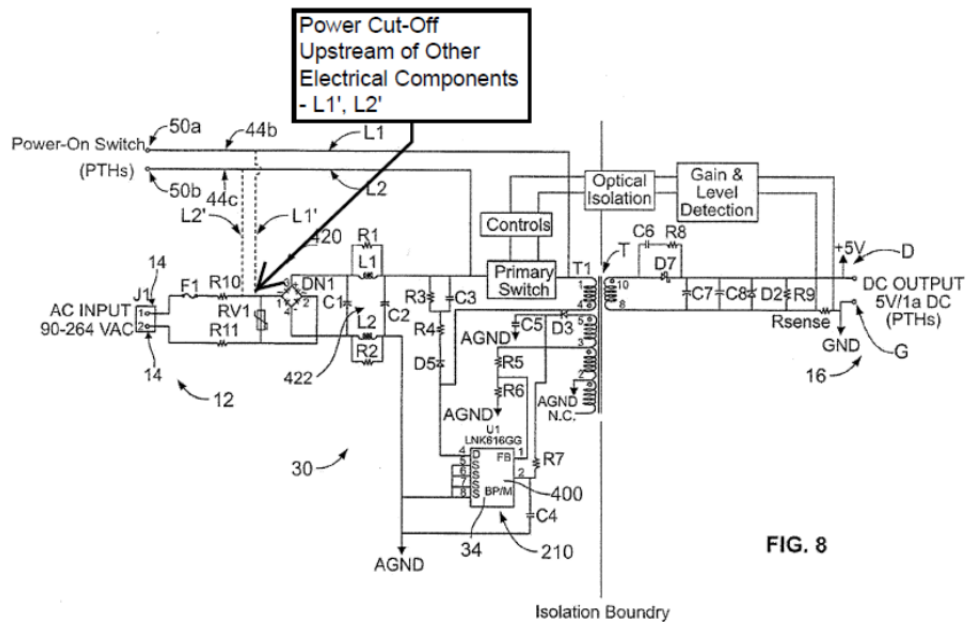


FIG. 8

Further, Sakamoto is explicit the purpose of Sakamoto's invention is to cut off all power, and not merely that power is cut in front of Sakamoto's primary transformer. Sakamoto's paragraph [0004] uses the word "and" to specifically identify that cutting off power to the primary transformer is an alternative, yet related benefit to also cutting off all power from the power source: "an AC adaptor that resolves the problem of the above stated conventional art [referring to AC flowing in the primary transformer], and is configured so that AC power is not consumed from the commercial power source." (Ex. 1009 at [0004] (emphasis added)) (Ex.1033 ¶¶45-46).

VIII. CLAIMS 11, 12, 17, 18, 20 AND 21 ARE OBVIOUS OVER NOGUCHI IN VIEW OF HUANG (AND IN VIEW OF SUZUKI TO THE EXTENT NEEDED)

A. Noguchi with Suzuki Is Not a “Rehash” of an Unsuccessful Argument in the Reexamination

Voltstar’s arguments that Noguchi in view of Suzuki is a “rehash” of a prior unsuccessful argument is misplaced because there is no estoppel under §315(e) as stated above in Section IV. In addition, it is not a “rehash” of a prior unsuccessful argument for the reasons stated above in Section IV.B.

B. Suzuki Would Be Combined with Noguchi

Voltstar presents no arguments that a hard switch is a limitation of claim 11. The Institution Decision notes the circuitry in claim 11 “need not be a ‘hard switch’” (Institution Decision at 28).

Petitioner agrees with the Board that claim 11 does not include a “hard switch” for the reasons stated in the Institution Decision. Thus, Petitioner’s arguments related to Suzuki are only provided in the possibility that this Board find the circuitry in claim 11 requires a hard switch, and also in regard to the “latching relay” recited in claim 18.

Voltstar argues a latching relay “cannot be activated by switch (10) of Noguchi.” (Response at 29–30). The combination proposed in the Petition, however, did not address a latching relay being activated by switch (10) of

Noguchi. Rather, the combination stated it would be obvious to substitute Noguchi's switch (10) with Suzuki's latching relay (Petition at 52–54).

In addition, providing a latching relay in a circuit is within the skill and ability of a PHOSITA (Ex.1033 ¶¶58–65). A complete redesign of Noguchi's circuitry is not required because the latching relay control circuitry would simply be added to Noguchi along with the latching relay (Ex.1033 ¶61). This modification is within the skill level of a PHOSITA. (Id.). The claimed combination does not change the principle of operation of Noguchi or render Noguchi inoperable for its intended purpose (Ex.1033 ¶62).

Voltstar argues Noguchi and Suzuki “[do] not use a latching relay for either of the two purposes advanced by Superior.” (Response at 30). However, the Federal Circuit has rejected that an express written motivation to combine must appear in prior art references. *See Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276–76 (Fed. Cir. 2004).

Dr. Horenstein attested to reasons for substituting Noguchi's switch (10) for Suzuki's latching relay. (Ex.1019 ¶¶ 193–201). Horenstein's findings were based, *inter alia*, on a PHOSITA's understanding of the benefits and properties of a latching relay and the predictable result of using the latching relay (Ex.1033 ¶63–65). In addition, Horenstein identified explicit teachings in prior art (Eishi – Ex.1015) that supported his reasoning: “Other prior art supports this

understanding. Eishi, for example, discloses that by using a latching relay (3) in its power cutoff device, only a ‘momentary current’ is required to operate the latching relay (3), which Eishi states beneficially reduces the power to operate the power cutoff device.” (Ex.1019 ¶196 (emphasis added)).

C. Suzuki Does Not “Teach Away” from the ‘833 Patent

Voltstar argues Suzuki discloses a circuit drawing 2 mw to 40 mw and this allegedly “teaches away” from the ‘833 Patent (Response at 30–31).

There is no “teaching away” from the ‘833 Patent in Suzuki in the manner alleged by Voltstar. Suzuki does not criticize, discredit, or discourage zero or microwatts power draw in a different circuit. The mere presence of Suzuki disclosing an alternative circuit that draws 2 mw to 40 mw does not constitute a teaching away of another circuit that draws less than this amount. *See In re Fulton*, 391 F.3d at 1201; *see also* (Ex.1033 ¶¶66–71). Voltstar appears to seek a blanket rule that any art drawing more than microwatts would not be considered by a PHOSITA for obviousness – and this is incorrect.

Dr. Tobias during deposition could point to no teaching in Suzuki informing a PHOSITA not to cut the power off completely in a different circuit (Ex.1031 at 14:16–19).

In addition, it is undisputed that a latching relay would allow zero power to pass therethrough if opened (Ex.1033 ¶¶70–71). Suzuki provides no disclosure or

teaching suggesting one should have greater than zero or microwatts power draw in Noguchi's circuit (Id.).

IX. CLAIM 16 IS OBVIOUS OVER NOGUCHI IN VIEW OF HUANG AND BYUN (AND IN VIEW OF SUZUKI TO THE EXTENT NEEDED)

Byun teaches the timer and the timer signal in claim 16. The reasoning of the combination of Byun with Noguchi is stated in the Petition on pages 60–62. The reasoning is that it would be obvious for a PHOSITA to incorporate Byun's timer and timer signal into Noguchi's control unit (21) to allow for delay before opening switch (10) in response to removing a cell phone from Noguchi's charging base. This would prevent unnecessarily shutting “off” power if the cell phone is inadvertently removed from or knocked out of the charging base and placed back in the base within a predetermined time period.

Voltstar argues this combination is improper because “Noguchi goes between ‘off’ and ‘on’ while Byun only functions between ‘standby’ and ‘off’” (Response at 33). This statement is incorrect and conflicts with Voltstar's prior statement that Byun refers to three modes of operation – the “on” state, the “standby” mode and the “off” state (Response at 32). As stated in the Petition, the obvious combination would result in Noguchi having a “standby state” in which the timer ran. The standby state is the time between the phone being on the base (“on state”) and Noguchi's switch (10) opening (“off state”). The mere presence

of a “standby state” does not render the modification unobvious (Ex.1033 ¶¶72–82).

Voltstar argues Noguchi “does not require a user instruction as a condition precedent to eventual operation of the timer” (Response at 33). This is also incorrect because the user instruction would comprise the user removing the phone from Noguchi’s base (Ex.1033 ¶77).

Voltstar argues “the timer as disclosed by Byun, incorporated into Noguchi would either not function or defeat the purpose of Noguchi’s device” (Response at 33). This is incorrect because Noguchi’s device would operate in the same manner with the added functionality of a time delay before the switch (10) was opened in response to the phone being inadvertently removed from or knocked out of the charging base. This would add function and would not defeat the purpose of Noguchi’s device. *See DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1368 (Fed. Cir. 2006) (an “implicit motivation to combine exists” when the combination “results in a product or process that is more desirable, for example because it is stronger, cheaper, faster, lighter, smaller, more durable, or more efficient.”); (Ex.1033 ¶¶78–79).

Voltstar finally argues “the combination would not draw zero power.” This is incorrect because the timer would only function in the “standby” period before all power was cut off. The timer does not operate in the “off state” (when switch

(10) is open) and the timer draws no power in the “off state” (Ex.1033 ¶82).

X. CLAIM 22 IS OBVIOUS OVER NOGUCHI IN VIEW OF SUZUKI AND SAKAMOTO (AND IN VIEW OF SUZUKI TO THE EXTENT NEEDED)

Voltstar incorporates its arguments regarding claim 4 to argue for the patentability of claim 22. Petitioner here similarly incorporates its arguments regarding claim 4 to assert that claim 22 is invalid (Ex.1033 ¶¶83–85).

Claim 22 is invalid and should be so found by this Board.

XI. CONCLUSION

Petitioner asserts that all grounds in the Institution Decision are proper and all claims at issue in this proceeding should be found invalid.

Respectfully submitted,

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CERTIFICATION UNDER 37 CFR § 42.24(d)

Under the provisions of 37 CFR § 42.24(d), the undersigned hereby certifies that the word count (relying on the word count of Microsoft Word) for the foregoing Petitioner's Reply to Patent Owner's Response (excluding the table of contents, the certificate of service, and the certificate of word count) totals 5,598, which is less than the 5,600 allowed under 37 CFR § 42.24(c)(1).

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of this Petitioner's Reply to Patent Owner's Response, and exhibits Ex.1027–1033 were served in their entirety by Priority Mail Express® and via email this 15th day of November 2017 on the attorneys of record of Voltstar Technologies, Inc., owner of the subject patent, as indicated below:

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