

Filed on behalf of Phison Electronics Corp.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Silicon Motion Technology Corp.  
Petitioner

v.

Phison Electronics Corp.  
Patent Owner

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Case IPR2013-00473  
Patent 8,176,267

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**PATENT OWNER'S NOTICE OF APPEAL**

Pursuant to 37 C.F.R. § 90.2(a) and 35 U.S.C. § 142, Patent Owner Phison Electronics Corp. (“Phison”) hereby appeals to the United States Court of Appeals for the Federal Circuit from the Patent Trial and Appeal Board’s (“Board’s”) Final Written Decision entered January 28, 2015 (Paper 36), and from all underlying and related findings, orders, decisions, rulings, and opinions, including without limitation the Decision on Institution of *Inter Partes* Review entered January 28, 2014 (Paper 7).

For the limited purpose of providing the Director with the information requested in 37 C.F.R. § 90.2(a)(3)(ii), Phison further indicates that the issues on appeal may include, but are not limited to:

(1) Whether claims 1, 3-7, 9-11, 13-17, 21, 22, 24, and 25 of U.S. Patent No. 8,176,267 have been shown to be unpatentable under 35 U.S.C. 103(a) as obvious over U.S. Patent Publication No. 2008/0151618 to Sharon (“Sharon”) in view of U.S. Patent Publication No. 2007/0113030 to Bennett (“Bennett”);

(2) Whether the Board commits reversible error when it construes a claim to have a particular requirement, but then does not identify that requirement in the cited art—here, a requirement that “predetermined data” be “replacement data,” although the data in the prior art here cannot actually function as a replacement.

(3) Whether the Board acted contrary to this Court’s precedent (*see In re NTP*, 654 F.3d 1279, 1278) by reasoning that a skilled artisan would add a

superfluous feature to a primary reference that already had a fully adequate version of the feature.

(4) Whether the Board acted contrary to this Court's precedent by determining that one of ordinary skill in the art would have reason to modify a prior art reference in such a way as to make that reference non-functional by returning information for which the prior art reference is incapable of processing;

(5) Whether the Board may rely on testimony of a witness whose knowledge of the relevant art is challenged, without determining that the witness is a person skilled in the art or would otherwise understand the thinking of a person skilled in the art; and

(6) Whether the Board acted contrary to this Court's precedent by basing its determination of obviousness on a finding that a single element in the prior art satisfied multiple claim elements that recite structurally distinct components of the claimed invention.

Each of the above listed findings conflicts with the law, the evidence of record and/or is not supported by substantial evidence. The Board's reliance on testimony and/or evidence that conflicts with the evidence of record, is unreliable, is not admissible under the Federal Rules of Evidence, and/or violates the principles of *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 509 U.S. 579 (1993) and its progeny.

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Phison further reserves the right to challenge any finding or determination supporting or relating to the issues listed above, and to challenge any other issues decided adversely to Phison in the Board's Final Written Decision or in any other order, decision, ruling, or opinion underlying the Final Written Decision, or issuing after the Final Written Decision.

Simultaneous with this submission, three (3) copies of this Notice of Appeal are being filed with the Clerk of the United States Court of Appeals for the Federal Circuit, together with the requisite fee in the amount of \$500. In addition, a copy of this Notice of Appeal is being filed with the Patent Trial and Appeal Board and served upon counsel of record for Silicon Motion Technology Corp.

No fees are believed to be due to the United States Patent and Trademark Office in connection with this filing, but authorization is hereby given for any required fees to be charged to Phison Deposit Account No. 06-1050.

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Respectfully submitted,

Counsel for Patent Owner,  
Phison Electronic Corp.

Date: March 31, 2015

/ David M. Hoffman /  
David M. Hoffman, Reg. No. 54,174

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**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. §§ 90.2(a)(1) and 104.2(b), the undersigned hereby certifies that on March 31, 2015, the original of the foregoing Notice of Appeal was filed with the Director of the United States Patent and Trademark Office **by hand-delivery**, at the following address:

Director of the United States Patent and Trademark Office  
c/o Office of General Counsel  
10B20, Madison Building East  
600 Dulany Street  
Alexandria, VA 22314-5793

In addition, pursuant to 37 C.F.R. § 90.2(a)(1) and 37 C.F.R. § 42.6(b), the undersigned certifies that on March 31, 2015, a copy of the foregoing Notice of Appeal was filed **electronically** with the Board through the Board's Patent Review Processing System.

In addition, pursuant to 37 C.F.R. § 90.2(a)(2) and Federal Circuit Rule 15(a)(1), the undersigned certifies that on March 31, 2015, the requisite fee for the appeal and three (3) true and correct copies of the foregoing Notice of Appeal were filed with the Clerk of Court of the United States Court of Appeals for the Federal Circuit **by hand-delivery**, at the following address:

Daniel E. O'Toole  
Clerk of Court  
United States Court of Appeals for the Federal Circuit  
717 Madison Place, NW, Room 401  
Washington, DC 20439

**CERTIFICATE OF SERVICE**

Pursuant to 37 CFR § 42.6(e)(4) and 37 C.F.R. § 90.2(a)(3)(ii), the undersigned certifies that on March 31, 2015, a true and correct copy of the foregoing the Notice of Appeal was served **via email** on the Petitioner by serving the correspondence email addresses of record below:

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