

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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INNOLUX CORPORATION  
Petitioner

v.

SEMICONDUCTOR ENERGY  
LABORATORY CO., LTD.  
Patent OWNER

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Cases IPR2013-00028 (Patent 6,404,480 B2) (SCM)  
IPR2013-00038 (Patent 7,956,978 B2)<sup>1</sup>

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Before SALLY C. MEDLEY, KARL D. EASTHOM, and KEVIN F. TURNER  
*Administrative Patent Judges.*

MEDLEY, *Administrative Patent Judge.*

ORDER  
Conduct of the Proceeding  
*37 C.F.R. § 42.5*

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<sup>1</sup> This order addresses a similar issue in the two cases. Therefore, we exercise discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style of heading in subsequent papers.

On June 11, 2013, the following individuals participated in a conference call:

- (1) Mr. Scott McKeown and Mr. Gregory Cordrey, counsel for Innolux;
- (2) Mr. Sean Flood, Mr. Stanley Schlitter, and Mr. Douglas Peterson, counsel for SEL; and
- (3) Sally Medley, Karl Easthom, and Kevin Turner, Administrative Patent Judges.<sup>2</sup>

The purpose of the conference call was for Patent Owner to confer with the Board prior to filing a motion to amend.<sup>3</sup>

#### *Motion to Amend*

SEL intends to file a motion to amend in both IPR2013-00028 and IPR2013-00038. During the call, counsel for SEL sought guidance for SEL's motions to amend. The parties were directed to the Patent Trial Practice Guide for guidance. *See Office Patent Trial Practice Guide*, 77 Fed. Reg. 48756, 48766-48767 (Aug. 14, 2012). More specifically, in any motion to amend SEL files, the motion must explain in detail how the proposed substitute claims obviates the grounds of unpatentability authorized in this trial and clearly identify where corresponding written description support in the specification can be found for each claim added. If the motion to amend includes a proposed substitution of claims beyond a one-for-one substitution, the motion must explain why more than a one-for-one substitution of claims is necessary. 37 C.F.R. § 42.121. For further guidance regarding these requirements, the parties were directed to two recent Board

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<sup>2</sup> A court reporter was also present.

<sup>3</sup> 37 C.F.R. § 42.121(a) provides that a patent owner may file one motion to amend, but only after conferring with the Board.

Cases IPR2013-00028 and 00038  
Patents 6,404,480 B2 and 7,956,978 B2

decisions: (1) IPR2012-00005, Paper 27 (June 3, 2013) and (2) IPR2012-00027, Paper 26 (June 11, 2013).

Counsel for SEL represented that SEL will not include in its motion to amend a request for a proposed substitution of claims beyond a one-for-one substitution. The Board encouraged counsel for SEL to consider that SEL need not substitute a claim for each claim involved in each case. A single claim in each case may suffice. Counsel for SEL inquired as to whether any substitute dependent claims should be written in independent form. The Board expressed that it would not be necessary to do so. For further guidance on substitute dependent claims, SEL is directed to IPR2012-00027, Paper 26 at 9-10.

Counsel for SEL requested a five page extension of the fifteen page limit for its motion to amend with respect to case IPR2013-00028. The request was denied as premature. SEL has not had opportunity to consider the two Board decisions to which it is directed in formulating its motion to amend. Moreover, counsel for SEL did not represent he had a complete draft that was currently over the allowed page limits. The parties are encouraged to stay within the confines of the regulations for these proceedings. Nonetheless, the Board indicated that SEL is not foreclosed from later requesting authorization for a page limit extension. If SEL chooses to do so, it should be prepared to show that such an extension is warranted.

*Order*

It is

ORDERED that SEL's request for a five page extension for its motion to amend is DENIED.

Cases IPR2013-00028 and 00038  
Patents 6,404,480 B2 and 7,956,978 B2

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