

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INNOLUX CORPORATION
Petitioner,

v.

SEMICONDUCTOR ENERGY LABORATORY CO., LTD.
Patent Owner.

Case IPR2013-00028
U.S. Patent 6,404,480

PETITIONER'S OPPOSITION TO MOTION TO AMEND

EXHIBIT LIST

Previously Filed

- | | |
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| Exhibit 1001 | U.S. Patent No. 6,404,480 to Hirakata |
| Exhibit 1004 | Unexamined Patent Application Publication H5-243333 ("Moriyama") |
| Exhibit 1005 | U.S. Patent No. 4,600,273 to Ohno |

Currently Filed

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| Exhibit 1009 | Deposition transcript of Miltiadis Hatalis, Ph.D. dated May 20, 2013 |
| Exhibit 1010 | Deposition transcript of Paul A. Kohl, Ph.D. dated August 14, 2013 |
| Exhibit 1011 | Declaration of Miltiadis Hatalis, Ph.D. in support of Innolux Corp.'s Opposition to Amendment and Reply |

Petitioner Innolux Corporation ("Innolux") hereby provides its opposition to Patent Owner Semiconductor Energy Laboratory Co., Ltd.'s ("SEL" or "Patent Owner") Motion to Amend ("Motion") claims 1, 6 and 11 of United States Patent No. 6,404,480 ("the '480 Patent"). For the reasons stated below, SEL's Motion should be denied.

I. Legal Standards

The Patent Owner, as the moving party, bears the burden to show entitlement to the requested relief. *See* 37 C.F.R § 42.20(c). For a patent owner's motion to amend, 37 C.F.R §42.20(c) places the burden on SEL to show a patentable distinction of each proposed substitute claim over the prior art of record and prior art known to the patent owner. *See Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027, Paper 26 ("Some representation should be made about the specific technical disclosure of the closest prior art known to the patent owner, and not just a conclusory remark that no prior art known to the patent owner renders obvious the proposed substitute claims."). A motion to amend may be denied where the amendment does not respond to a ground of unpatentability involved in the trial. *See Id.*

A motion to amend may also be denied if it introduces new matter. 35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii). The burden is on the patent owner to show written description support in the original disclosure of the patent. The

upon reasonably conveys to a person of ordinary skill in the art that the inventor had possession of the claim subject matter as of the filing date. *See* IPR2-12-00005, Paper 27 (citing *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F. 3d 1336, 1351 (Fed. Cir. 2010) (en banc)). If the claim language does not appear in *ipsis verbis* in the original disclosure, a mere citation to the original disclosure without any explanation as to why a person of ordinary skill in the art would have recognized that the inventor possessed the claimed subject matter as a whole may be inadequate. *See* IPR2-12-00005, Paper 27.

II. The Proposed Amendment Does Not Obviate A Ground of Unpatentability

As a result of the Board's refusal of SEL's position that the claimed elements must be limited to a single common contact portion, SEL now seeks to amend the claims to make this an express limitation. *See* Decision at 13-15; *see also* Decision on Request for Rehearing at 9-10 ("Although the disclosed embodiments provide contact structures in the common contact portion, the Specification does not indicate that that structure is necessary, or that there can be no contact in the pixel regions."). SEL's proposed claim amendments would require (1) that the "at least two openings" and "plurality of conductive spacers" to be present in a single common contact portion and (2) that the second interlayer insulating film is provided over a source electrode and a drain electrode in the pixel region.

However, the proposed substitute claims 31, 32 and 33 are disclosed in the prior art and remain obvious in view of the original prior art presented in the Petition, *i.e.* the Admitted Prior Art ("APA") and Moriyama.

A. The Proposed Amendment of "a plurality of conductive spacers held between said first substrate and said second substrate in said single common contact portion" Do Not Distinguish, or Overcome, The Prior Art

1. Moriyama discloses the presence of multiple conductive spacers in a single common contact portion

Moriyama discloses a plurality of conductive spacers, *i.e.* metal particles 16, in a single common contact portion to provide a uniform distance, and an electrical connection, between opposing substrates 14. *See* Ex. 1004 at ¶¶ 7, 20 and Figs. 4, 5 and 7; *see also* Deposition transcript of Miltiadis Hatalis, Ph.D. dated May 20, 2013 ("Ex. 1009") at 68:16-70:17. The copper plating pattern 21 and transparent metal layer 4 are connected to each other via the metal particles 16. *See* Ex. 1009 at 69:6-8; *see also* Ex. 1004 at Fig. 7A. Moriyama's Figure 7(a) shows a plurality of conductive spacers 16 held over the second interlayer insulating film 5 and in contact with the second conductive film (layers 3 and 4) and third conductive film on the counter-substrate. *Id.*; Ex. 1009 at 164:7-165:7. Similarly, Figure 4 of Moriyama (and the associated cross-section of Figure 5) shows a plurality of conductive spacers 16 held over the insulating film and making contact with the second and third conductive films. *Id.* SEL's expert, Dr. Kohl, agreed that Moriyama discloses a plurality of conductive spacers which are held over an

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