

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

CORRECTED PETITIONER'S OPPOSITION TO MOTION TO AMEND

Petitioner, Innolux Corporation, hereby submits a Corrected Petitioner's Opposition to Motion to Amend. This corrected version replaces the first filed version that was timely filed on September 23, 2013, which included typographical errors. Specifically, the below listed corrections were made:

- Page 6, Line 12: Ex. 1011, ¶ 36 – corrected to Ex. 1011, ¶ 37, 42
- Page 6, Line 20: Ex. 1011, ¶ 52 – corrected to Ex. 1011, ¶ 39
- Page 7, Line 5: Ex. 1011, ¶ 75-76, 85 – corrected to Ex. 1011, ¶ 37, 42
- Page 7, Line 10: Ex. 1011, ¶ 50 – corrected to Ex. 1011, ¶ 37
- Page 7, Line 13: Ex. 1011, ¶ 55 – corrected to Ex. 1011, ¶ 35, 36
- Page 7, Line 19: Ex. 1011, ¶ 53 – corrected to Ex. 1011, ¶ 38
- Page 8, Line 5: Ex. 1011, ¶ 53 – corrected to Ex. 1011, ¶ 40-41
- Page 8, Line 15: Ex. 1011, ¶ 53 – corrected to Ex. 1011, ¶ 40
- Page 9, Line 6: Ex. 1011, ¶ 58 – corrected to Ex. 1011, ¶ 45
- Page 11, Lines 6-7: Ex. 1011, ¶¶ 35-45-46 – corrected to Ex. 1011, ¶¶ 38-41

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EXHIBIT LIST

Previously Filed

- | | |
|--------------|--|
| 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

- | | |
|--------------|---|
| 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

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