

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CHI MEI INNOLUX CORPORATION  
Petitioner

v.

PATENT OF SEMICONDUCTOR ENERGY LABORATORY CO., LTD.  
Patent Owner

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CASE IPR2013-00038  
PATENT 7,956,978

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**PRELIMINARY RESPONSE OF THE PATENT OWNER**

## TABLE OF CONTENTS

I.	INTRODUCTION .....	1
II.	THE PETITION LACKS A STATUTORY BASIS TO PROCEED.....	3
A.	The Petition May Not Be Considered Because It Fails to Identify all Real Parties-in-Interest. ....	3
1.	The Real Parties-in-Interest, Besides the Petitioner, Include CMO USA, Acer America, ViewSonic, VIZIO and Westinghouse.....	4
B.	The Petition Should Be Denied Because It Presents the Same Prior Art the Office Considered Previously.....	7
C.	The Petition Fails to Establish a Reasonable Likelihood that at Least One of the Challenged Claims in the Petition is Unpatentable. ....	11
1.	The invention of the ‘978 Patent.....	12
2.	Claims of the ‘978 Patent.....	17
3.	Claims 7 and 17 are patentable over Sono.....	19
a.	Sono does not teach claim element (j), “at least first and second conductive layers formed from a same layer as the plurality of second conductive lines, wherein at least a part of each of the first and second conductive layers is overlapped with the portion of the sealing member.” .....	20
b.	Sono does not teach claim element (k), “wherein a length of the first conductive layer along the first direction and a length of the second conductive layer along the first direction are longer than a pitch of adjacent ones of the plurality of second conductive lines.” .....	30
c.	Sono does not teach claim element (l), “wherein the first and second conductive layers are electrically isolated from both of the plurality of first conductive lines and the plurality of second conductive lines, and wherein the first and second conductive layers are electrically isolated from each other.” .....	38
d.	Sono does not teach claim element (m), “a black matrix at least partly overlapped with intersections of the plurality of first conductive lines and the plurality of second conductive lines and the first and second conductive layers .”.....	40

e.	Sono does not teach claim element (b), “a first substrate having a first side edge extending in a first direction and a second side edge extending in a second direction orthogonal to the first direction.” .....	42
f.	Sono does not teach claim element (c), “a plurality of first conductive lines extending over the first substrate in the first direction.” .....	44
g.	Sono does not teach claim element (d), “a plurality of second conductive lines extending over the first substrate in the second direction.” .....	45
h.	Sono does not teach claim element (i) “a sealing member disposed between the first substrate and the second substrate, the sealing member having a portion adjacent to the first side edge.” .....	47
4.	Claims 7 and 17 are patentable over the APA and Sono.....	47
5.	Claims 7 and 17 are not obvious based on the APA, Sono, and Watanabe.....	49
a.	The improper reading of Watanabe in the Petition .....	49
b.	The APA, Sono and Watanabe do not teach claim element (k), “wherein a length of the first conductive layer along the first direction and a length of the second conductive layer along the first direction are longer than a pitch of adjacent ones of the plurality of second conductive lines.” .....	52
c.	The APA, Sono and Watanabe do not teach claim element (l), “wherein the first and second conductive layers are electrically isolated from both of the plurality of first conductive lines and the plurality of second conductive lines, and wherein the first and second conductive layers are electrically isolated from each other.” .....	56
d.	The APA, Sono and Watanabe do not teach claim element (m), “a black matrix at least partly overlapped with intersections of the plurality of first conductive lines and the plurality of second conductive lines and the first and second conductive layers.” .....	58
III.	CONCLUSION.....	60

## **EXHIBIT LIST**

- Exhibit 2001 – Complaint, *Semiconductor Energy Laboratory Co., Ltd. v. Chimei Innolux Corp., et al.*, Case No. SACV 12-0021-JST (C.D. Cal).
- Exhibit 2002 – Defendants’ Motion to Stay Litigation Pending Outcome of Inter Partes Review, *Semiconductor Energy Laboratory Co., Ltd. v. Chimei Innolux Corp., et al.*
- Exhibit 2003 – Supplemental Declaration of Gregory S. Cordrey in Support of Defendants' Motion for Stay, *Semiconductor Energy Laboratory Co., Ltd. v. Chimei Innolux Corp., et al.*
- Exhibit 2004 – Defendants’ Reply in Support of their Motion to Stay, *Semiconductor Energy Laboratory Co., Ltd. v. Chimei Innolux Corp., et al.*
- Exhibit 2005 – Defendant Westinghouse Digital's Notice of Joinder, *Semiconductor Energy Laboratory Co., Ltd. v. Chimei Innolux Corp., et al.*
- Exhibit 2006 – ‘978 Patent Prosecution History Excerpt Part I - Prior Art considered by the Office
- Exhibit 2007 – ‘978 Patent Prosecution History Excerpt Part II - Expert Opinion of Dr. Silzars considered by the Office

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## I. INTRODUCTION

By its petition, Trial No. IPR2013-00038 (the “Petition”), Petitioner Chimei Innolux Corp. (“CMI”) challenges the validity of claims 7 and 17 of United States Patent No. 7,956,978 (“the ‘978 patent”). In response, the Patent Owner respectfully submits this Preliminary Response. The NOTICE OF FILING DATE ACCORDED TO PETITION and the REVISED NOTICE OF FILING DATE ACCORDED TO PETITION, mailed on November 9, 2012, sets the deadline for filing this preliminary response “no later than three months from the date of this notice” (page 2, Paper No. 3; page 2, Paper No. 4). *See also*, 37 C.F.R. § 42.107(b). Accordingly, this Preliminary Response of the Patent Owner is timely filed.

The Petition should be denied on the statutory ground that the prior art cited is the same prior art previously considered by the Office during prosecution of the application that became the ‘978 patent. *See* 35 U.S.C. § 325(d) (“In determining whether to institute or order a proceeding under ... chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.”).

The Petition should be denied on the additional statutory ground that the Petition fails to identify several real parties-in-interest, including Acer America Corporation (“Acer America”), Chi Mei Optoelectronics USA, Inc. (“CMO

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