CHI MEI INNOLUX CORPORATION
Petitioner

v.

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

CASE IPR2013-00038
PATENT 7,956,978

PATENT OWNER'S REQUEST FOR REHEARING OF DECISION TO INSTITUTE INTER PARTES REVIEW PURSUANT TO 37 C.F.R. § 42.71

Request for Rehearing on behalf of the Patent Owner is filed within fourteen days of the Decision and is timely filed pursuant to 37 C.F.R. § 42.71. The Patent Owner respectfully requests rehearing because the Board abused its discretion in failing to dismiss the Petition as required under 35 U.S.C. 312(a)(2) and 37 C.F.R. § 42.8(b)(1), in view of the Petition's failure to name real parties-in-interest who have admitted participation in the "preparation and filing" of the Petition, in a related court proceeding. The Board abused its discretion in failing to afford proper weight or construction to the word "matrix," in view of the ordinary meaning of the word. Furthermore, the Board abused its discretion in failing to properly consider and interpret what the asserted prior art, including U.S. Patent No. 5,513,028 to Sono (Ex. 1003) and U.S. Patent No. 5,504,601 to Watanabe (Ex. 1004), would reasonably have disclosed to a person of ordinary skill in the art.

I. THE DECISION ERRED IN FINDING THAT OTHER CIVIL DEFENDANTS ARE NOT REAL PARTIES-IN-INTEREST.

As stated at pages 3-7 of the Patent Owner's Preliminary Response, the Petition fails to identify all the real parties-in-interest, and therefore, the Office lacks statutory authority to consider it under 35 U.S.C. § 312 (a)(2). In response,

and that "[i]t is likely that no such stay would have been granted without all co-defendants agreeing to the estoppel provision." (Decision, pages 7-8.) Thus, the Decision concludes, "SEL has not demonstrated that CMI has failed to list all the real parties-in-interest." (Decision, page 8.) However, the Patent Owner respectfully disagrees.

The Decision's error is again fundamental. The one point it does consider (i.e., that the unambiguous statements by all defendant parties of ownership of the IPR Petition before the District Court may have meant something other than their plain meaning, *see* Decision p. 8) is only reached by ignoring the legally binding nature of those statements (which in turn necessarily governs and limits how they may be interpreted). A brief outline of this basic principle is set out on pp. 4 - 6 below.

The specific facts of this proceeding clearly establish that unnamed parties, including Chi Mei Optoelectronics USA, Inc. ("CMO USA"), Acer America Corporation ("Acer America"), ViewSonic Corporation ("ViewSonic"), VIZIO, Inc. ("VIZIO"), and Westinghouse Digital, LLC ("Westinghouse"), are real

(hereinafter the "*CMI* case") (Ex. 2001) that they all participated in filing the Petition.[1] Namely, in a joint Motion to Stay, the Defendants collectively refer to the Petition as "***their***" Petition that "***Defendants filed.***" (Ex. 2002, pp. 2 and 5-6). Further, the Defendants made admissions to the Court in the *CMI* case that the "***Defendants have moved expeditiously to prepare and file*** a comprehensive petition for an IPR of the Asserted Patents." (Id. at 17). Also, in support of the Defendants' Motion to Stay, the Petitioner's Backup Counsel in this IPR proceeding, Gregory Cordrey, who also represents CMO USA, Acer America, ViewSonic, and VIZIO, submitted a declaration stating that collectively "[o]n November 7, 2012, **Defendants** filed with the U.S. Patent and Trademark Office ('PTO') its petition for IPR for U.S. Patent No. 7,956,978." (Ex. 2003, p. 1). Since CMI's backup counsel, Mr. Cordrey, also represents CMO USA, Acer America, ViewSonic, and VIZIO, these parties surely have an opportunity to exercise control of the instant Petition through Mr. Cordrey. Thus, the Petition is not just CMI's

[1] As noted in the Preliminary Response of the Patent Owner, at 5, n.1, Westinghouse joined in the motion to stay and agreed to be bound by the PTO's determinations on the IPR petitions. *See* Exhibit 2019.

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