

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.

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

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CASE IPR2013-00038  
PATENT 7,956,978

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**PATENT OWNER'S MOTION TO TAKE ADDITIONAL  
DISCOVERY UNDER 37 C.F.R. § 42.51(b)(2)**

## EXHIBIT LIST

### Previously Filed

- 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

### Currently Filed

- Exhibit 2008 – [Proposed] Patent Owner’s Requests for Production To Petitioner
- Exhibit 2009 – [Proposed] Patent Owner’s Interrogatories To Petitioner
- Exhibit 2010 – [Proposed] Patent Owner’s Requests for Admission To Petitioner

**PATENT OWNER'S MOTION TO TAKE ADDITIONAL**  
**DISCOVERY UNDER 37 C.F.R. § 42.51(b)(2)**

Pursuant to the Board's authorization in its Order dated April 26, 2013, Patent Owner Semiconductor Energy Laboratory Co., Ltd. ("SEL") respectfully submits this motion to take discovery of Petitioner Chimei Innolux Corporation ("CMI" or "Petitioner")<sup>1</sup>. Specifically, Patent Owner requests that the Board authorize discovery requests as follows:

- Patent Owner's Requests for Production To Petitioner (Nos. 1-2) (Exhibit 2008);
- Patent Owner's Interrogatories To Petitioner (Nos. 1-3) (Exhibit 2009); and
- Patent Owner's Requests for Admission To Petitioner (Nos. 1-5) (Exhibit 2010).

**I. Discovery Is Relevant to Whether CMI Identified All Real Parties In Interest as Required Under 35 U.S.C. § 312(a)(2)**

The proposed discovery pertains to the identification of real parties in interest with respect to the current Petition. As discussed in the initial conference call conducted on April 23, 2013, Patent Owner believes that the facts presently before the Board as described in the Patent Owner's Preliminary Response and in the pending Request for Rehearing on the Decision to institute a trial in this IPR demonstrate that the Petitioner failed to identify all real parties in interest as

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<sup>1</sup> While Patent Owner acknowledges the name change of the Petitioner, Patent Owner continues to refer to that party as "Chimei Innolux Corporation" or "CMI" in this document.

required by the 35 U.S.C. § 312(a)(2). However, insofar as the Board disagrees, the requested discovery is “necessary in the interest of justice,” as required by 35 U.S.C. § 316(a)(5) in order to allow the Patent Owner an opportunity to show that CMI failed to identify all real parties in interest. The five factors<sup>2</sup> identified by the Board in Paper No. 26 in *Garmin v. Cuozzo* (IPR2012-00001) as relevant to determining whether discovery should be permitted in the context of an IPR weigh in favor of allowing further discovery in this case.

Considering the Board’s first factor, there is more than a “mere possibility” of discovering relevant evidence that the Petitioner failed to identify all real parties in interest as required by 35 U.S.C. § 312(a)(2). This is because Patent Owner has already provided at least the following evidence in its Preliminary Response and Request for Rehearing:

- Exhibit 2002, pages 2, 5-6, and 17 – In a Motion to Stay, the Defendants in the District Court case collectively refer to the earlier Petition as “*their*” Petition that “*Defendants filed,*” and stated that “*Defendants have moved expeditiously to prepare and file a comprehensive petition for an IPR of the Asserted Patents.*”
- Exhibit 2003, page 1 – In support of the Defendants’ Motion to Stay in the District Court case, the Petitioner’s Backup Counsel in this IPR

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<sup>2</sup> The five factors listed by the Board are the following: (1) more than a possibility and mere allegation; (2) litigation positions and underlying basis; (3) ability to generate equivalent information by other means; (4) easily understandable instructions; and (5) requests not overly burdensome to answer.

proceeding, Gregory Cordrey submitted a declaration stating that the collective “**Defendants** filed with the U.S. Patent and Trademark Office (‘PTO’) its petition for IPR for U.S. Patent No. 7,956,978 (‘978 Patent’).”

- Exhibit 2005, page 2 – Westinghouse Digital, LLC stated in its Notice of Joinder in the District Court case that it “hereby joins Defendants’ motion to stay” and “[a]dditionally, in the event that the Court grants the Motion and stays the litigation, Westinghouse agrees to be bound by the PTO’s determinations on the IPRs pursuant to the estoppel provisions of 35 U.S.C. § 315(e)(2).”
- Petitioner’s backup counsel, Mr. Cordrey, also represents Chi Mei Optoelectronics USA, Inc., Acer America Corporation, ViewSonic Corporation, and VIZIO, Inc. in the District Court case, which gives these parties an opportunity to exercise control of the instant Petition through their counsel, Mr. Cordrey.

Even though the Board’s March 21 Decision gave little or no weight to the statements and admissions made by all Defendants in the District Court case, the above statements and admissions support the Patent Owner’s contention that the parties in addition to CMI participated in the filing of the instant Petition. Specifically, the March 21 Decision stated that the “statements that SEL refer to are just that. SEL has not shown persuasively that the statements mean what SEL

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