

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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**RESPONSE OF THE PATENT OWNER**

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## **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

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

### **Currently Filed**

Exhibit 2011 – Declaration of Roger Stewart

Exhibit 2012 – Deposition transcript of Miltiadis Hatalis, Ph.D dated May 20, 2013

Exhibit 2013 – Declaration of Miltiadis Hatalis, Ph.D, Exhibit 1007 in IPR2013-00068

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## **I. INTRODUCTION**

Semiconductor Energy Laboratory Co., Ltd. (“Patent Owner”) provides this response under 35 U.S.C. § 316(a)(8) and 37 C.F.R. § 42.220 and respectfully submits that U.S. Patent No. 5,513,028 (“Sono”) and the admitted prior art (“APA”) with Sono and U.S. Patent No. 5,504,601 (“Watanabe”) fail to render obvious claims 7 and 17 of U.S. Patent No. 7,956,978 (the “’978 patent”). Specifically, Sono fails to disclose numerous limitations of both claims 7 and 17, and Watanabe and the APA fail to cure the deficiencies of Sono. Accordingly, the claims are patentable over the prior art and Patent Owner respectfully requests that claims 7 and 17 be confirmed.

## **II. THE REAL PARTIES IN INTEREST**

Patent Owner respectfully submits that the Board lacks statutory authority to consider the Petition because Petitioner failed to identify all real parties-in-interest according to 35 U.S.C. § 312(a)(2). Notably, Chi Mei Optoelectronics USA, Inc., Acer America Corporation, ViewSonic Corporation, VIZIO Inc., and Westinghouse Digital, LLC are real parties-in-interest, which Petitioner failed to identify in its Petition. *See* Paper No. 8, Preliminary Response, (“Preliminary Resp.”), at 3-7; Paper No. 13, Request for Rehearing (“Reh. Request”), at 1-6. The Petition should have been denied on this ground.

### **III. THE '978 PATENT**

#### **A. The Background of the Technology**

The '978 patent relates to an active matrix LCD device for reducing problems associated with the TFT and counter substrates being bonded together with an uneven cell gap and for preventing moisture from entering from the exterior. Preliminary Resp., at 12; Ex. 1001, '978 patent, at col. 1, ll. 7-11, col. 12, ll. 38-50, and col. 14, ll. 7-27; Ex. 2011, Declaration of Roger Stewart ("Stewart Decl."), at ¶¶ 36-53. As the Decision to Institute ("Decision" or "Dec.") notes, an LCD with an uneven cell gap, due to wiring inconsistently crossing the sealing material on the four sides of the sealant, results in a deteriorated image quality. Paper No. 9 ("Decision" or "Dec."), at 2-3; Preliminary Resp., at 12-13; Ex. 1001, '978 patent, at col. 1 l. 27-col. 2, l. 58, FIGS. 16, 17. The '978 patent solves this problem by using dummy structures (or as the claims recite, conductive layers) to create a uniform sealant between the two substrates. Preliminary Resp., at 12-17; Dec., at 3; Ex. 1001, '978 patent, at col. 6, ll. 16-49, and col. 13, l. 14-col. 14, l. 54, FIGS. 1, 9; Ex. 2011, Stewart Decl., at ¶¶ 41-53. Through the use of these dummy structures, deterioration of the liquid-crystal and deterioration of image quality are prevented and other advantages are achieved. Ex. 2011, Stewart Decl., at ¶¶ 41-53.

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