

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 IPR2013-00038
U.S. Patent 7,956,978

PETITIONER'S OPPOSITION TO MOTION TO AMEND

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"). Because SEL's proposed amendments are not supported by the specification and also fail to respond to a ground of unpatentability involved in the trial, 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."). Moreover, 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. *See* 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

upon reasonably conveys to a person of ordinary skill in the art that the inventor had possession of the claim subject matter as of the filing date. *See* IPR2-12-00005, Paper 27 (citing *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F. 3d 1336, 1351 (Fed. Cir. 2010) (en banc)). If the claim language does not appear in *ipsis verbis* in the original disclosure, a mere citation to the original disclosure without any explanation as to why a person of ordinary skill in the art would have recognized that the inventor possessed the claimed subject matter as a whole may be inadequate. *See* IPR2-12-00005, Paper 27.

The written description test is whether the original disclosure of the application relied upon reasonably conveys to a person of ordinary skill in the art that the inventor had possession of the claim subject matter as of the filing date. *See* IPR2-12-00005, Paper 27 (citing *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F. 3d 1336, 1351 (Fed. Cir. 2010) (en banc)).

II. The Proposed Amendment is Not Supported in the Original Disclosure

In its Motion, SEL asserts that "layer" means "a continuous, unitary structure." *Id.* at 7. In the context of the proposed claims, SEL further asserts that "unitary" means that "the first conductive layer and the second conductive layer each is a unitary layer."¹ *See* Mot. 4-5. But, the construction of a "layer" being a

¹ SEL also mis-states the appropriate construction standard of the broadest reasonable construction. Instead, SEL states that its proposed construction of

continuous, unitary structure is inconsistent with the ordinary meaning of layer and the specification's description of layer in the '978 patent where a "layer" is described as a structure having multiple, discontinuous parts.² If the definition of a conductive layer is limited to continuous, unitary structures, then many of the conductive layers described in the '978 patent would be excluded:

- "As shown in in FIG. 4, the dummy wirings 304 for the second layer are disposed uniformly at the respective gaps defined between the ***dummy wirings 301, the wirings 302 and the wirings 303 for the first layer*** which are formed of the starting film (silicon film)..." See Ex. 1001, Col. 9, ll. 28-32 (emphasis added).
- "***the dummy wirings 301, the wirings 302 and 303 for the first layer*** is not limited to a silicon film.." See Ex. 1001, Col. 8, ll. 24-26 (emphasis added).
- "It should be noted that the pitch of ***the dummy wirings 304 for the second layer*** is set to the pitch of the scanning lines 106..." See Ex. 1001, Col. 9, ll. 60-61 (emphasis added).
- "As shown in Figure 6, in the sealing material formation region, first support ***members 301, 302, and 303*** made of the same material as the scanning lines 106..." See Ex. 1001, Col. 4, ll. 17-19 (emphasis added).
- "FIG. 4 is a top view showing the substrate interval correction means, in which first linear support ***members 301, 302, and 303*** and second support members 304 are disposed alternatively at regular intervals.." See Ex. 1001, Col. 4, ll. 63-66 (emphasis added).

"layer" is a "reasonable construction." See Mot. at 5.

² The Board held that all claims terms (with the exception of "pitch" and "black matrix") are to be given their ordinary and customary meaning. See Decision at 9.

- "**linear dummy wirings 301 for the first layer** are formed by patterning the silicon film.." See Ex. 1001, Col. 7, ll. 61-64; see also Ex. 1012, Hatalis Dep. at 139:19-141:4.

In each of the instances above, the "layer" is associated with a *plurality* of discontinuous, dummy wiring structures, which is inconsistent with the definition proposed by SEL. For example, one of ordinary skill in the art reading the specification would understand that the first layer comprises more than one dummy wiring, i.e., wirings 301, 302 and 303. SEL mis-states the specification when it says that it "describes conductive layers as 'support members' and/or 'dummy wirings,' each of which is unitary, i.e., one continuous member." See Mot. at 5. As shown above, however, the '978 specification actually refers to the support members and dummy wirings as a first or second layer. As such, the layer is neither continuous nor unitary.

SEL next asserts that the specification describes that "'first support members [301, 302 and 303 shown in Fig. 6]' correspond to the 'first and second conductive layers.'" See Mot. at 6. From this interpretation, SEL concludes that the first and second layers are unitary layers. *Id.* But, the specification actually describes that "[a]s shown in Fig. 6,...the dummy wirings 304 for the second layer are disposed on interlayer insulating film 220 at regular intervals in a region where the dummy wirings 301, and the wirings 302, 303 **for the first layer** are not formed..." See Ex. 1001, col. 10, ll. 9-20. Thus, contrary to SEL's unsupported interpretation, the '978 specification states that support members 301, 302 and 303 are the first layer and

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.