
INNOLUX CORPORATION
Petitioner

v.

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

CASE IPR2013-00038
PATENT 7,956,978

PATENT OWNER'S NOTICE OF OBJECTIONS TO EVIDENCE
PURSUANT TO 37 C.F.R. § 42.64

Reply to Response of Patent Owner, dated September 23, 2013 (“New Hatalis Declaration”), which Petitioner Innolux Corporation (“Petitioner”) submitted in connection with the case IPR2013-00038. Patent Owner objects to Exhibit 1013 on the grounds that (i) at least paragraphs 23, 25, 36, 38, 40-49, and 53-55 contain evidence that could have been presented in a prior filing, (ii) paragraph 46 contains new evidence, U.S. Patent No. 5,105,187,¹ which could have been presented during the deposition of Roger Stewart, and (iii) all other paragraphs are merely repetition of Exhibit 1005, Declaration of Miltiadis Hatalis, Ph.D., dated November 6, 2012 (“Initial Hatalis Declaration”). Thus, all of the New Hatalis Declaration comprises unauthorized testimony and should not be considered.

I. Objections to Exhibit 1013 and any reference to or reliance thereon.

Patent Owner hereby objects to Exhibit 1013, New Hatalis Declaration, because it contains evidence that could have been submitted along with Petitioner’s

¹ Petitioner failed to attach a copy of U.S. Patent No. 5,105,187 (the “187 patent”) as required by 37 C.F.R. §§ 42.6(c), 42.63(a). In any event, the ‘187 patent is irrelevant because it does not pertain to any issue raised in the Board’s decision.

2) the New Hatalis Declaration fails to comply with 37 C.F.R. § 42.123 (Filing of Supplemental Evidence).

Petitioner cites to Exhibit 1013, the New Hatalis Declaration, in its Reply to Response of the Patent Owner as new evidence to support its arguments of unpatentability of the claims. The New Hatalis Declaration and the reference to and reliance on paragraphs 23, 25, 36, 38, 40-49, and 53-55 of the New Hatalis Declaration in Petitioner's Reply are improper because this new evidence could have been submitted along with the Petitioner's Petition. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48767 (Aug. 14, 2012), which states the following:

I. Petitioner Reply to Patent Owner Response and Patent Owner Reply to Opposition To Amend

A reply may only respond to arguments raised in the corresponding opposition. § 42.23. While replies can help crystalize issues for decision, a reply that raises a new issue or belatedly presents evidence will not be considered and may be returned. The Board will not attempt to sort proper from improper portions of the reply. Examples of indications that a new issue has been raised in a reply include new evidence necessary to make out a prima facie case for the patentability or unpatentability of an original or proposed

evidence that could have been presented in a prior filing, such as the filing of the Petition. At least paragraphs 23, 25, 36, 38, 40-49 and 53-55 of the New Hatalis Declaration include opinions from Dr. Hatalis relating to the background of the technology, U.S. Patent No. 5,513,028 (“Sono”), and U.S. Patent No. 5,504,601 (“Watanabe”). These new opinions could have been presented in the Petition and in the Initial Hatalis Declaration because Petitioner asserted Sono and Watanabe in its Petition. Instead, Petitioner submits this unauthorized testimony and improperly refers to the unauthorized testimony in its Reply to Response of the Patent Owner.

For example, in paragraphs 36, 38, and 40-49 of the New Hatalis Declaration, Dr. Hatalis provides opinions as to how statements in Sono should be interpreted and, in paragraphs 53-55, Dr. Hatalis provides opinions as to how statements in the Watanabe should be interpreted. Moreover, in paragraphs 23 and 25, Dr. Hatalis elaborates on the background of the technology, providing his opinion on significant details regarding TFTs and shift registers. All of these opinions could have been provided as part of the Initial Hatalis Declaration.

Petitioner should have submitted the entire substance of the supplemental

Additionally, the remaining paragraphs in the New Hatalis Declaration are merely repetition of the Initial Hatalis Declaration and are not provided to rebut an argument raised for the first time in Patent Owner's Response. Thus, these repetitious paragraphs also are unauthorized testimony.

Moreover, 37 C.F.R. § 42.123 provides a procedure for filing a motion to submit supplemental information, including late submission of supplemental evidence. Petitioner did not seek authorization from the Board to file supplemental information as required by 37 C.F.R. § 42.123(b). Instead, Petitioner improperly filed the New Hatalis Declaration along with its Reply to Response of the Patent Owner.

II. Objections to U.S. Patent No. 5,105,187 in Exhibit 1013

Patent Owner hereby objects to Exhibit 1013, New Hatalis Declaration, because it contains new evidence, including, for example, the '187 patent and the detailed discussion thereof, that was not submitted as an exhibit and is not relevant to any issue raised in the Board's decision. The following are the grounds for objection:

- 1) F.R.E. 403 (Excluding Relevant Evidence for Prejudice, Confusion, Waste

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