

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHI MEI INNOLUX CORPORATION
Petitioner

v.

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

CASE IPR2013-00064
PATENT 7,923,311

PRELIMINARY RESPONSE OF THE PATENT OWNER

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EXHIBIT LIST

- 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 – ‘311 Patent Prosecution History Excerpt - Prior Art considered by the Office
- Exhibit 2007 – United States Patent No. 4,857,907 (Koden)

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I. INTRODUCTION

By its petition, Trial No. IPR2013-00064 (the “Petition”), Petitioner Chimei Innolux Corp. (“CMI”) challenges the validity of claims 9-11, 15, 17-19, 48, 51, and 52 of United States Patent No. 7,923,311 (“the ‘311 patent”). In response, the Patent Owner respectfully submits this Preliminary Response. The NOTICE OF FILING DATE ACCORDED TO PETITION, mailed on November 29, 2012, sets the deadline for this Preliminary response “no later than three months from the date of this notice” (page 2, Paper No. 3). *See also*, 37 C.F.R. § 42.107(b). Accordingly, this Preliminary Response of the Patent Owner is timely filed.

The Petition should be denied on the ground that all prior art cited, with the exception of one secondary reference, is the same prior art previously considered by the Office during prosecution of the ‘311 patent, and that secondary reference adds nothing new to the prior art already presented to the Office. *See* 35 U.S.C. § 325(d) (“In determining whether to institute or order a proceeding under ... chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.”).

The Petition should be denied on the additional statutory ground that the Petition fails to identify several real parties-in-interest, including Acer America Corporation (“Acer America”); Chi Mei Optoelectronics USA, Inc. (“CMO

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