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 IPR2013-00066 (SCM)
Patent 7,876,413 B2

PATENT OWNER'S REQUEST FOR REHEARING OF DECISION TO INSTITUTE INTER PARTES REVIEW PURSUANT TO 37 C.F.R. § 42.71

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PATENT OWNER'S REQUEST FOR REHEARING OF DECISION TO INSTITUTE INTER PARTES REVIEW PURSUANT TO 37 C.F.R. § 42.71

The Decision to Institute *inter partes* review mailed April 24, 2013 has been carefully considered. This Request for Rehearing on behalf of the Patent Owner ("SEL") is filed within 14 days of the Decision (Paper 10) and is timely under 37 C.F.R. § 42.71. SEL respectfully requests rehearing because the Board incorrectly construed the claim language and improperly interpreted what the asserted prior art U.S. Patent 5,636,329 to Sukegawa disclosed.

I. THE CLAIM CONSTRUCTION OF "CONTACT THROUGH AN OPENING" IS UNREASONABLE

In Paper 10, pp. 10-12, the Board construed the claimed phrase "… contact through an opening." From an English language dictionary, the Board reproduced "several ordinary definitions" for the word "*through.*" *Id.*, p. 11. SEL had proposed a definition that in the context of this phrase and patent specification, "contact through an opening" means contact made possible by the opening or by virtue of the opening. The Board agreed that SEL's definition is consistent with the specification of U.S. Patent No. 7,876,413 ("the '413 patent") and three of the dictionary definitions which the Board cited.

However, the Board then made further comments on the ordinary meaning of "through" according to these dictionary definitions, "tempered by the meaning thereof in light of the '413 patent specification and the claim phrase at issue …" *Id.*

It concluded that these dictionary definitions do not preclude contact from occurring "between" the vertical limits of the claimed contact opening or through-hole defined by the surrounding insulation film, even if the opening does not cause or permit the contact to be made. The Board referenced Figure 4A of the '413 patent which shows that the electrical contact between ITO transparent conductive layer 114 and second wiring 403 occurs at the bottom boundary of the opening in the second insulating film 113 such that "between" includes that bottom boundary of the opening in insulating film 113. *Id.*, pp. 11-12. It ruled, "Accordingly, 'contact through an opening' means contact which occurs because of, or by virtue of, the opening, *or which occurs between the vertical limits of the opening*." *Id.*, p. 12 [emphasis added]. SEL respectfully submits that the ruling wrongly includes the alternate definition, reproduced here in italics. Everything beginning with "or" should be stricken.

A. The Board Followed Incorrect Claim Construction Procedure

The Board consulted *The American Heritage Dictionary of the English Language* (1975) and developed a construction of "contact through an opening" based on some general definitions it found there. The Board followed a procedure similar to one overruled en banc in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005). That Court specifically addressed the use of dictionaries at 415 F.3d 1303, 1319-1324. It cited (and abrogated) the panel decision in *Texas Digital*

Systems, Inc. v. Telegenix, Inc., 308 F.3d 1193 (Fed. Cir. 2002). *Texas Digital* had ruled that words often have multiple dictionary meanings so the intrinsic record must be consulted to determine which of the different possible meanings is most consistent with the use of the term in question by the inventor. *Texas Digital* added that the patent specification and file history must be consulted to determine whether the patentee has used the words of the claim in a manner clearly inconsistent with the ordinary meaning reflected, for example, in a dictionary definition. *Phillips* at 1319 [internal quotation marks omitted]. Under *Texas Digital* the presumption in favor of a dictionary definition is overcome where the patentee acts as a lexicographer or has made a disavowal or disclaimer of claim scope. *Id.*

The reason given by the *Texas Digital* panel for this *modus operandi* was to avoid importing limitations into the claims. The Federal Circuit agreed in *Phillips* that the *goal* expressed in *Texas Digital* was valid but the methodology adopted to achieve that goal "placed too much reliance on extrinsic sources such as dictionaries, treatises, and encyclopedias and too little on intrinsic sources, in particular the specification and prosecution history." *Phillips,* at 1320. The Federal Circuit explained, "In effect, the *Texas Digital* approach limits the role of the specification in claim construction to serving as a check on the dictionary meaning of a claim term if the specification requires the court to conclude that fewer than all the dictionary definitions apply, or if the specification contains a sufficiently

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