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 IPR2013-00066
PATENT 7,876,413

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**PATENT OWNER'S LISTING OF ANTICIPATED MOTIONS FOR DISCUSSION IN INITIAL CONFERENCE CALL**

An initial conference call is scheduled in this matter for May 21, 2013 at 2 PM EST. Pursuant to the *Office Patent Trial Practice Guide* (OPTPG), 77 Fed. Reg., 48765 (Aug. 14, 2012), Patent Owner submits this initial listing of motions it may bring during this trial. Patent Owner reserves its right to seek authorization to bring additional motions, or to decide not to bring motions as indicated, as circumstances may warrant.

**1. Motion to Amend the Claims**

On May 8, 2013, Patent Owner filed a Request for Rehearing on the Board's Decision to institute *inter partes* review (IPR), which is currently pending. Depending on Patent Owner's continuing evaluation of the Board's Decision, and upon the Board's decision on Patent Owner's Request for Rehearing, Patent Owner may move to amend or propose substitute claims pursuant to 37 C.F.R. § 42.121 for one or more of the claims of U.S. Patent 7,876,413 for which a trial has been granted. If Patent Owner determines that it will file a motion to amend one or more claims, Patent Owner will arrange a conference call with the Board and opposing counsel to discuss the proposed motion to amend.

## 2. Motion to Take Discovery Relating to the Identification of Real Parties-In-Interest Under 35 U.S.C. § 312(a)(2)

Patent Owner may move to take additional discovery [1] regarding the identification of real parties-in-interest with respect to the current Petition. More specifically, the additional discovery may seek information concerning the involvement of Chi Mei Optoelectronics USA, Inc., Acer America Corporation, ViewSonic Corporation, VIZIO, Inc., and Westinghouse Digital, LLC, in the preparation and filing of the current Petition.

Patent Owner believes that the facts presently before the Board as described in the Patent Owner's Preliminary Response demonstrate that the Petitioner failed to identify all real parties-in-interest as required by the 35 U.S.C. § 312(a)(2). However, insofar as the Board disagrees, the requested discovery is "necessary in the interest of justice," as required by 35 U.S.C. § 316(a)(5) in order to allow the Patent Owner an opportunity to show that Petitioner failed to identify all real parties-in-interest.

There is more than a "mere possibility" of discovering relevant evidence that the Petitioner failed to identify all real parties-in-interest as required by 35 U.S.C. § 312(a)(2). This is because Patent Owner has already provided at least the following evidence in its Preliminary Response:

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[1] This includes, potentially, a reasonable number of requests for production, interrogatories, and requests for admission.

- Exhibit 2002, pages 2, 5-6, and 17 – In a Motion to Stay, the Defendants in the District Court case collectively refer to the earlier Petition as "***their***" Petition that "***Defendants filed,***" and stated that "***Defendants have moved expeditiously to prepare and file*** a comprehensive petition for an IPR of the Asserted Patents."
- Exhibit 2003, page 3 – In support of the Defendants' Motion to Stay in the District Court case, the Petitioner's Backup Counsel in this IPR proceeding, Gregory Cordrey submitted a declaration stating that the collective "**Defendants** filed with the U.S. Patent and Trademark Office ('PTO') its petition for IPR for U.S. Patent No. 7,876,413 (''413 Patent')."
- Exhibit 2005, page 2 – Westinghouse Digital, LLC stated in its Notice of Joinder in the District Court case that it "hereby joins Defendants' motion to stay" and "[a]dditionally, in the event that the Court grants the Motion and stays the litigation, Westinghouse agrees to be bound by the PTO's determinations on the IPRs pursuant to the estoppel provisions of 35 U.S.C. § 315(e)(2)."
- Petitioner's backup counsel, Mr. Cordrey, also represents Chi Mei Optoelectronics USA, Inc., Acer America Corporation, ViewSonic Corporation, and VIZIO, Inc. in the District Court case, which gives

these parties an opportunity to exercise control of the instant Petition through their counsel, Mr. Cordrey.

The Patent Owner may request additional discovery to show that the above quoted statements mean what they say, and that is that some or all Defendants exercised some control, or had the opportunity to exercise some control, over the preparation and filing of the instant Petition.

The Patent Trial Practice Guide notes (at pages 48759-60) that the determination of whether or not a party is a real party-in-interest is a fact specific inquiry that must be made on a case by case basis. The Patent Owner respectfully submits that the Board, and not Petitioner, should make the determination that parties in addition to Petitioner are in fact real parties-in-interest as to this Petition. To enable the Board to make this fact intensive determination, the requested discovery relating to the identification of the real parties-in-interest is necessary because only Petitioner and the other defendants in the pending litigation are in possession of this information. Thus, the requested discovery is "necessary in the interest of justice," as required by 35 U.S.C. § 316(a)(5).

Any requested discovery will be limited and will not ask for Petitioner's litigation positions or the underlying basis for those positions. Instead, the requested information will be directed to the Petitioner and limited to the involvement of

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