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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 IPR2013-00068(SCM)
Patent 8,068,204 B2

Before SALLY C. MEDLEY, KARL D. EASTHOM, and KEVIN F. TURNER, *Administrative Patent Judges.*

EASTHOM, *Administrative Patent Judge*.

DECISION
Request for Rehearing

37 C.F.R. § 42.71(d)

I. BACKGROUND

Patent Owner, Semiconductor Energy Laboratory Co., Ltd. ("SEL"), in its Rehearing Request, seeks reversal of the Board's Decision ("Decision") to institute an *inter partes* review of certain claims in the `204 patent. (*See* Rehearing Req. 1.) SEL directs arguments toward a claim phrase which appears in claims 54, 56, 59, 61, 63, 66, 68, 70, 73, 75, 76, 78, 81, and 83, "contact *through an opening* in the second insulating film." (*See* Rehearing Req. 7.)[1] SEL argues that the Decision unreasonably construes the phrase and that the claims define over Sukegawa. (*See* Rehearing Req. 1-15.)

The applicable standard for a request for rehearing is set forth in 37 C.F.R. § 42.71(d), which provides in relevant part:

> A party dissatisfied with a decision may file a request for rehearing, without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, opposition, or a reply.

For the reasons that follow, SEL fails to show that the Board misapprehended or overlooked any material matters warranting a reversal of the Decision. Accordingly, the Board denies the requested relief.

II. DISCUSSION

SEL's contention that the Board overlooked or misapprehended the meaning of "contact through an opening" is not persuasive. (*See* Rehearing Req. 1.) The Board construed the phrase to include SEL's definition; i.e., the contact occurs

[1] The Board instituted review of claims 31, 33, 36, 38, 40, 43, 45, 46, 48, 51, 53, 54, 56, 59, 61, 63, 66, 68, 70, 73, 75, 76, 78, 81, and 83. (Dec. 2.)

"through" or "because of" the opening. The Board also construed the phrase to include another ordinary definition supported by the `204 patent; i.e., the location of the contact occurs "through" or "between the vertical limits of the opening." (*See* Dec. 11-12.)

SEL urges that the Board's claim construction misinterprets the meaning of "through" because "the Board's general purpose dictionary is completely unrelated to semiconductor technology." (Rehearing Req. 5.) SEL also contends that the `204 patent Specification does not support the Board's claim construction. (*See* Rehearing Req. 8-13.)

The Decision addresses SEL's contention that "through" is not limited to a definition which means "because of" or "by virtue of." (*See* Rehearing Req. 9; Dec. 10-12, 18.) SEL now contends that "[w]hen the Board consulted a general purpose dictionary for the definitions of 'through,' it found some definitions beyond the context of the '204 patent specification." (Rehearing Req. 10.) SEL includes the following dictionary definitions cited by the Board as "beyond the [proper] context": defining "through" to mean "[a]mong or between; in the midst of: *a walk through the flowers*" or "[h]ere and there in; around: *a tour through France*." (*See* Dec. 11 (dictionary citation omitted); Rehearing Req. 5, 10.)

Contrary to SEL's argument, the `204 patent employs the word "through" in different contexts. For example, the patent notes that "a spacer . . . penetrates through the resin." (Ex. 1001, col. 13, ll. 43-44.) In other words, contrary to SEL's arguments, the word "through" as employed in the `204 patent does not always take on its alternative ordinary meaning of "because of" or "by virtue of." Rather, the word implies that "through an opening" can mean "between the vertical limits of the opening" as the Decision reasons and as discussed further below. (*See* Rehearing Req. 11; Dec. 12.)

While SEL contends that it is not clear how the Board's definition of "through" is "relevant" to the phrase at issue, SEL virtually acknowledges that the Board provides the relevance in SEL's statement that "Figure 4A of the '204 patent shows that the electrical contact occurs at the bottom of the opening in resin inter-layer film 113, as the Board notes." (Rehearing Req. 11.) While SEL also contends that the depicted contact satisfies their proposed definition that the contact occurs "because of" the opening, the depicted contact location is also consistent with the Board's definition which specifies a contact location. In other words, Figure 4A shows contact "between the vertical limits of the opening." The Figure 4A depiction and the Board's definition coalesce with one of the Board's cited dictionary definitions of "through" as meaning, for example, "among or between" as discussed *supra*.

Moreover, the `204 patent states that electrical lines are "connected in parallel by forming contact holes in the first inter-layer film." (Ex. 1001, col. 8, ll. 48-49.) That disclosure implies that the claims at issue are broader than any single embodiment described therein. If the disclosed contact occurs "because of" the opening, it does so because a connection occurs "by [first] forming" the opening. In other words, the thrust of SEL's arguments is that an implied order of making the opening exists in which an electrical contact is formed after forming the opening: "To permit that contact to be made, an opening had to be provided before depositing the ITO 114." (Rehearing Req. 12.) However, contrary to SEL's thrust, the device claims at issue here do not require the specific order of making as required, even if the `204 patent happens to disclose such an order. Therefore, for this additional reason, SEL does not show that the Decision misapprehends the meaning of the claim phrase, "contact through an opening."

Moreover, even under SEL's definition of "contact through an opening," SEL does not show that the Decision misapprehends that the combination of Sukegawa and Shiba renders obvious the disputed phrase in the claims at issue. (*See* Rehearing Req. 14-15; Dec. 18.) SEL focuses on limited portions of Sukegawa's teachings instead of addressing the prior art combination of Sukegawa and Shiba involved in the Decision. Pursuant to SEL's definition, the Board alternatively reasons that "CMI shows that it would have been obvious to employ the known contact structure . . . by forming Sukegawa's transparent ITO layer 8 through Shiba's slit 243 to create a reliable . . . contact." (Dec. 18.) The Board further explains that, "at the time of the invention, skilled artisans knew how to make through-hole contacts as Sukegawa's Figure 3B verifies by showing contact between metal wiring layers 7 and 2 through holes in an insulation layer 3. (*See* Ex. 1005.)" (*Id*.) SEL does not contend that skilled artisans were unaware of how to extend metal material through pre-existing contact holes to form reliable electrical connections.

Accordingly, SEL does not show that the Decision misapprehends the claim phrase "contact through an opening," or overlooks a material point related to the obviousness of providing such contact through an opening as set forth in the claims at issue here.

III. CONCLUSION

Based on the foregoing discussion, SEL's Rehearing Request is granted to the extent that the Board has reconsidered its Decision, but SEL's requested relief for a reversal of the Decision is denied because SEL has not shown that the Decision overlooks or misapprehends a material point.

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