

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INNOLUX CORPORATION
Petitioner

v.

SEMICONDUCTOR ENERGY LABORATORY CO., LTD.
Patent Owner

Cases IPR2013-00066 (Patent 7,876,413 B2) (SCM)
IPR2013-00068 (Patent 8,068,204 B2)¹

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

MEDLEY, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On July 15, 2013, the following individuals participated in a conference call:

¹ This order addresses a similar issue in the two cases. Therefore, we exercise discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style of heading in subsequent papers.

(1) Mr. Scott McKeown, Mr. Gregory Cordrey, and Mr. Stanley Gibson, counsel for Innolux;

(2) Mr. Mark Murphy, Mr. Edward Manzo, and Mr. Stanley Schlitter, counsel for SEL; and

(3) Sally Medley, Karl Easthom, and Kevin Turner, Administrative Patent Judges.

The purpose of the conference call was for Patent Owner to confer with the Board prior to filing a motion to amend.²

Motion to Amend

SEL intends to file a motion to amend in both IPR2013-00066 and IPR2013-00068. During the call, counsel for SEL sought guidance for SEL's motions to amend. The parties were directed to the Patent Trial Practice Guide for guidance. *See Office Patent Trial Practice Guide*, 77 Fed. Reg. 48756, 48766-48767 (Aug. 14, 2012). More specifically, in any motion to amend SEL files, the motion must explain in detail how the proposed substitute claims obviates the grounds of unpatentability authorized in this trial and clearly identify where corresponding written description support in the specification can be found for each claim added. If the motion to amend includes a proposed substitution of claims beyond a one-for-one substitution, the motion must explain why more than a one-for-one substitution of claims is necessary. 37 C.F.R. § 42.121. For further guidance regarding these requirements, the parties were directed to two Board decisions: (1) IPR2012-00005, Paper 27 (June 3, 2013) and (2) IPR2012-00027, Paper 26 (June 11, 2013).

² 37 C.F.R. § 42.121(a) provides that a patent owner may file one motion to amend, but only after conferring with the Board.

SEL requests authorization for four (4) additional pages for its IPR2013-00066 motion to amend and ten (10) additional pages for its IPR2013-00068 motion to amend. SEL alternatively requests authorization to, in its motion to amend, list its claims using single spacing in a claim chart, or that it be authorized to incorporate by reference arguments from its patent owner response into the motion to amend. Upon consideration, the requests are *denied*.

An *inter partes* review is a streamlined and focused proceeding, unlike *ex parte* prosecution or patent reexamination. A final determination must be made generally no later than a year after institution of the *inter partes* review. 35 U.S.C. § 316(a)(11). As a result, and pursuant to 35 U.S.C. § 316(b), rules for *inter partes* review proceedings were promulgated to take into account the “regulation on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings.” The promulgated rules provide that they are to “be construed to secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b).

SEL requests authorization to, in its motion to amend, list its claims using single spacing in a claim chart.³ Eventually a certificate will be issued and published for each patent in each case. 35 U.S.C. § 318(b). The certificate may include any new claim determined to be patentable. The publisher of such certificates expects a particular format for a new claim, which includes all of the formatting requirements of 37 C.F.R. § 42.6(a). SEL’s proposal to deviate from those requirements is impractical because it would either require the Office to assemble the new claims in proper format or to instruct the patent owner to present

³ 37 C.F.R. § 42.121(b) requires that a motion to amend claims must include a claim listing. The claim listing is part of the motion, whereby all of the formatting requirements, such as double spacing, must be used. 37 C.F.R. § 42.6(a).

the claims in the proper format long after a case has been decided. In either case, there would be associated costs, inefficiencies, and possible delays in publishing the certificate.

SEL alternatively seeks authorization to, in its motion to amend, incorporate by reference arguments made in SEL's Patent Owner Response.⁴ As explained during the conference call, it is not clear why SEL would want to do so. The Patent Owner Response should be directed to the claims involved in the proceeding. A motion to amend is contingent upon the Board determining that some or all of the involved claims are unpatentable. In the context of a motion to amend, the patent owner should focus on the feature or features added to each substitute claim. As explained on page 7 of the decision in IPR2012-00027, Paper 26 (June 11, 2013):

A patent owner should identify specifically the feature or features added to each substitute claim, as compared to the challenged claim it replaces, and come forward with technical facts and reasoning about those feature(s), including construction of new claim terms, sufficient to persuade the Board that the proposed substitute claim is patentable over the prior art of record, and over prior art not of record but known to the patent owner.

Thus, in the context of showing that a substitute claim is patentable over prior art, it would not appear to be beneficial to make the same arguments made in a patent owner response which focuses on different claims. A motion to amend is contingent upon the Board determining that the arguments made in a patent owner response are not persuasive. Therefore, it is not clear why a patent owner would want to include those same exact arguments in its motion to amend. In any event, the Board would not want arguments from one document incorporated by reference

⁴ 37 C.F.R. § 42.6(a)(3) requires that arguments must not be incorporated by reference from one document into another document.

into another. A party doing so would run the risk of either the Board or an opposing party overlooking an argument or point made.

Lastly, SEL alternatively requests authorization for more pages for its motions to amend. Counsel for SEL explained that a draft of SEL's motion to amend for each case revealed that the majority of the required fifteen page motion is comprised of the claim listing. As explained during the conference call, SEL need not present a substitute claim for each involved claim. A single claim per motion to amend may be sufficient. During the discussion, for example, it became apparent that the additional feature that SEL intends to add to its original claims is the same for each proposed substitute claim. There were no representations made that the various claims SEL seeks to add are patentably distinct from one another. Rather, they would all have the identical patentable feature and presumably all would be to the same patentable invention. Thus, there is no apparent reason, and none was provided, why one claim, or even just a few claims, with the single patentable addition would not suffice. To the extent that SEL perceives the limit for motions to amend to be unfair, SEL is not without remedy. SEL may possibly pursue such additional claims by filing a request for *ex parte* reexamination or by filing a reissue application.

For the reasons provided above, each of SEL's requests would impede the goal to secure the just, speedy, and inexpensive resolution of IPR2013-00066 and IPR2013-00068. Accordingly, SEL's requests are *denied*.

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