

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
U.S. Patent 8,068,204

**PETITIONER'S OBJECTION TO THE DECLARATION AND
TESTIMONY OF PATENT OWNER'S EXPERT
DR. MICHAEL J. ESCUTI**

Petitioner Innolux Corporation (“Innolux”) hereby submits its objection to the testimony of Semiconductor Energy Laboratory Co., Ltd.’s (“SEL” or “Patent Owner”) expert, Dr. Michael J. Escuti (“Dr. Escuti”), in connection with the case IPR2013-00068 involving U.S. Patent No. 8,068,204.

Petitioner objects to the declaration of Dr. Escuti on the grounds that he does not qualify as a person of ordinary skill in the art at the relevant time, which the parties agree is 1997. This defect only became apparent upon cross-examination, conducted less than five days ago, September 5-6th. As such, this objection is timely filed for the purpose of preserving the right to pursue a motion to exclude, which will more particularly point out the deficiencies in the proffered evidence. 42.64(a)(1).

This objection is identified with more particularity as follows:

- The basis for the objection became ripe during last week’s deposition of Dr. Escuti in which he testified regarding his educational background, published papers, industry activities, and lab research.

Based on his testimony, Petitioners established that Dr. Escuti’s expertise is in photonics and liquid crystals rather than the TFT technology at issue in ‘413 patent. In addition, Dr. Escuti, who had just graduated from his undergraduate studies in 1997, admitted that the only prior art patents he analyzed in connection with these proceedings were

references Sukegawa (U.S. Patent No. 5,636,329), Nakamoto (JP H08-160446), Shiba (U.S. Patent No. 5,684,555) and Watanabe (U.S. Patent No. 5,504,601) and that he did not review the state of the art in 1997, including other patents such as SEL's other patents (e.g., U.S. Patent Nos. 6,404,480 and 7,697,102) that were readily available and are also prior art to the '413 patent.

Accordingly, Petitioner hereby objects to the declaration of Dr. Escuti and preserves its right to move to exclude Dr. Escuti's testimony.

Dated: September 12, 2013

Respectfully submitted,

/Scott A. McKeown/

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CERTIFICATE OF SERVICE

I hereby certify that PETITIONER'S OBJECTION TO THE DECLARATION AND TESTIMONY OF PATENT OWNER'S EXPERT DR. MICHAEL J. ESCUTI in connection with *Inter Partes* Review Case IPR2013-00068 was served on the Patent Owner by UPS Express Standard Overnight at the following addresses on September 12, 2013.

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