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Paper No. 5

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

DANIEL L. FLAMM,
Patent Owner.

CASE IPR2016-01512
U.S. Patent No. RE40,264

**PATENT OWNER'S PRELIMINARY RESPONSE
UNDER 37 C.F.R. § 42.107**

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Daniel L. Flamm, Sc.D., the inventor and sole owner of the U.S. Patent No. RE40,264 (“the ‘264 patent”), through his counsel, submits this preliminary response pursuant to 37 C.F.R. § 42.107 and asks that the Patent Trial and Appeals Board decline to institute *inter partes* review on the instant petition because the petition fails to show a reasonable likelihood that any challenged claim is unpatentable.

I. Introduction

Samsung is not the first party to challenge the validity of the ‘264 patent through *inter partes* review. Lam Research Corp. sells tools used in semiconductor manufacturing to entities such as Samsung. Dr. Flamm has accused Samsung of using the tools it purchased from Lam and others in a manner that infringes the methods claims in the ‘264 patent.

In addition to commencing an action for declaratory judgment in the United States District Court for the Northern District of California, Lam asserted seven petitions for *inter partes* review of the ‘264 patent. *See* Case Nos. IPR2015-01759; IPR2015-01764; IPR2015-01766; IPR2015-01768; IPR2016-0468; IPR2016-0469; and IPR2016-0470.¹ The Board instituted trial on only two of those petitions, IPR2015-01764 and IPR2015-01768 and denied to

¹ A chart summarizing the claims of the ‘264 patent to which Lam’s seven petitions were directed is attached hereto as Appendix A.

institute on the remaining five.

The instant petition is directed toward independent claims 27 and 37 and several, but not all, claims that depend from those claims, *i.e.*, dependent claims 31, 32, 34, 40, 41, 47, 48, and 50.

In this petition, Samsung does not assert that any of the subject claims are anticipated under 35 U.S.C. § 102. Instead, Samsung argues for obviousness under 35 U.S.C. § 103, and relies on combinations of four references, Kadomura, Matsumura, Narita, Wang I, and Wang II. None of those references are new to the Board. None of those references are new to the Board in the context of an attack on the '264 patent. Lam relied on Matsumura, Narita, and Wang II in IPR2015-01766 and Lam relied on Kadomura and Wang I in IPR2016-0470. Both of those petitions were directed toward independent claims 27 and 37. The Board declined to institute on either of those petitions.

Thus, in essence, Samsung has simply reshuffled the prior art references Lam has already used to attack claims 27 and 37 of the '264 patent. The Board should reach the same conclusion in this petition as it did in IPR2015-01766 and IPR2016-0470, and should not institute the instant Petition.

II. Overview of the '264 Patent

The invention set forth in the '264 patent provides a method “for etching a substrate,” including “a chamber and a substrate holder.” (Ex. 1001, Abstract.)

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