Filed on behalf of: Nichia Corporation

Paper ____

Date filed: September 18, 2018

By: Martin M. Zoltick, Lead Counsel

Robert P. Parker, Back-up Counsel

Derek F. Dahlgren, Back-up Counsel

Michael H. Jones, Back-up Counsel

Mark T. Rawls, Back-up Counsel

ROTHWELL, FIGG, ERNST & MANBECK, P.C.

607 14th Street, N.W., Suite 800

Washington, DC 20005 Phone: 202-783-6040

Facsimile: 202-783-6031 Emails: mzoltick@rfem.com

rparker@rfem.com ddahlgren@rfem.com mjones@rfem.com mrawls@rfem.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIZIO, INC., Petitioner,

V.

NICHIA CORPORATION,

Patent Owner.

Case IPR2018-00437 Patent 9,537,071

DECLARATION OF DR. E. FRED SCHUBERT IN SUPPORT OF PATENT OWNER'S CONTINGENT MOTION TO AMEND

DOCKET A L A R M NICHTA DVIIIDIT 4040

TABLE OF CONTENTS

1.	INTRODUCTION1									
II.	QUALIFICATIONS									
III.	MATERIALS CONSIDERED									
IV.	SUM	MARY OF OPINIONS7								
V.	TECH	HNOLOGY BACKGROUND8								
VI.	PROI	PROPOSED SUBSTITUTE CLAIMS9								
VII.	DEFI	DEFINITION OF ONE OF ORDINARY SKILL IN THE ART14								
VIII.	CLAI	M CONSTRUCTION18								
IX.	AL STANDARDS BEING APPLIED IN MY DECLARATION18									
	A.	Written Description Support								
	B.	Anticipation19								
	C.	C. Obviousness19								
X.	WRITTEN DESCRIPTION SUPPORT FOR THE PROPOSED SUBSTITUTE CLAIMS									
	A.	Independent Claim 27								
		1. "A light emitting device comprising" [Preamble]37								
		2. "a light emitting element" [27A]37								
		3. "a resin package consisting of a resin part and first and second metal leads, the resin part including a thermosetting resin" [27B]								
		4. "wherein said resin package has four outer lateral surfaces and has a concave portion having a bottom surface" [27C]40								



5.	"wherein the light emitting element is mounted on the bottom surface of the concave portion and electrically connected to the first and second metal leads" [27D]				
6.	"wherein, at each of the four outer lateral surfaces of the resin package, at least a portion of an outer lateral surface of the resin part and at least a portion of an outer lateral surface of one or more of the first and second metal leads are coplanar" [27E]42				
7.	"wherein the first metal lead is exposed at three outer lateral surfaces of the resin package" [27F]				
8.	"wherein a notch is formed in one or more of the first and second metal leads at each of the four outer lateral surfaces of the resin package" [27G]				
9.	"wherein, at a first of the four outer lateral surfaces of the resin package, the resin part is located at left and right sides of an exposed surface of the first metal lead" and "wherein, at a second of the four outer lateral surfaces of the resin package, the resin part is located at left and right sides of an exposed surface of the second metal lead" [27H]				
10.	"wherein all upper edges of the first and second metal leads are coplanar" [27I]				
Indep	pendent Claim 2850				
1.	"A light emitting device comprising" [Preamble]51				
2.	"a resin package comprising a resin part and a metal part, said metal part consisting of first and second metal plates, said resin package having four outer lateral surfaces and having a concave portion having a bottom surface" [28A]				
3.	"a light emitting element mounted on the bottom surface of the concave portion and electrically connected to the metal part" [28B]				
4.	"wherein at least a portion of an outer surface of the resin part and at least a portion of an outer surface of the metal part are				



B.

- : :

	coplanar at an outer bottom surface of the resin package" [28C]				
5.	"wherein at least a portion of an outer lateral surface of the resin part and at least a portion of an outer lateral surface of the metal part are coplanar at each of the four outer lateral surfaces of the resin package" [28D]				
6.	"wherein a notch is formed in the metal part at each of the four outer lateral surfaces of the resin package" [28E]58				
7.	"wherein, at a first of the four outer lateral surfaces of the resin package, portions of an outer lateral surface of the resin part are located above and at left and right sides of an exposed outer lateral surface of the first metal plate" and "wherein, at a second of the four outer lateral surfaces of the resin package, portions of an outer lateral surface of the resin part are located above and at left and right sides of an exposed outer lateral surface of the second metal plate" [28F]				
8.	"wherein a lower surface of the metal part is exposed from the resin part in a region directly under the light emitting element" [28G]				
9.	"wherein the portions of the outer lateral surface of the resin part that are located above and at left and right sides of the exposed outer lateral surface of the first metal plate are integrally formed and are coplanar with the exposed outer lateral surface of the first metal plate" and "wherein the portions of the outer lateral surface of the resin part that are located above and at left and right sides of the exposed outer lateral surface of the second metal plate are integrally formed and are coplanar with the exposed outer lateral surface of the second metal plate" [28H]				
Depe	ndent Claims 29-3463				
1.	Claim 2963				
2	Claim 30				



C.

		3.	Clair	n 31	65				
		4.	Clair	m 32	69				
		5.	Clair	n 33	70				
		6.	Clair	n 34	71				
XI.	PAT	TENTABILITY OF THE PROPOSED SUBSTITUTE CLAIMS72							
	A.	Prior art references							
		1.	Loh		72				
		2.	Mori		74				
		3.	Wan	g	74				
		4.	Oshi	o	75				
	B.				aims Are Patentable Over the Grounds Involved in and the References Asserted as Prior Art75				
		1.	Clair	n 27 is	s patentable over Grounds 1-576				
			a)	Clair	m 27 is not anticipated by Loh (Ground 1)76				
				(1)	Loh does not disclose "a resin package consisting of a resin part and first and second metal leads, the resin part including a thermosetting resin"77				
				(2)	Loh does not disclose "wherein the first metal lead is exposed at three outer lateral surfaces of the resin package"				
			b)		m 27 would not have been obvious in view of Loh und 2)79				
				(1)	Loh would not have suggested "a resin package consisting of a resin part and first and second metal leads, the resin part including a thermosetting resin"				



DOCKET A L A R M

Explore Litigation Insights



Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time** alerts and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.

