

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLUEHOUSE GLOBAL LTD.
Petitioner

v.

SEMICONDUCTOR ENERGY LABORATORY CO., LTD.
Patent Owner

Case IPR2018-01393
Patent 9,293,545

**PATENT OWNER'S
PRELIMINARY RESPONSE**

TABLE OF CONTENTS

	<u>Pages</u>
I. INTRODUCTION	1
II. PETITIONER’S PROPOSED GROUND 1 FAILS TO SHOW A REASONABLE LIKELIHOOD THAT CLAIMS 1, 5, 7-11, 15, AND 17-20 ARE ANTICIPATED BY TOYOTA.....	2
A. Background of the ’545 Patent.....	4
B. Ground 1 Fails Because Petitioner Does Not Show That Toyota Discloses a Step in a Lower End Portion of a Side Surface of a Metal Film of the Source or Drain Electrode	9
C. Ground 1 Fails With Respect to Claims 5 and 15 Because Petitioner Does Not Show That Toyota, Alone or in Combination with Chung, Discloses the Claimed Angle Between the Side Surface of the Metal Film and an Upper Surface of the Glass Substrate	12
III. PETITIONER’S PROPOSED GROUND 2 FAILS TO SHOW A REASONABLE LIKELIHOOD THAT CLAIMS 3, 4, 13, AND 14 ARE RENDERED OBVIOUS BY TOYOTA IN VIEW OF AKIMOTO	18
A. Ground 2 Fails With Respect to Claims 3 and 13 Because Petitioner Does Not Provide “an adequate evidentiary basis” and “a satisfactory explanation” That Toyota in view of Akimoto Teaches the Source and Drain Electrodes Being in Contact with the Gate Insulating Film	18
B. Ground 2 Fails With Respect to Claims 4 and 14 for Relying Only on Conclusory Statements to Support Its Proposed Combination of Toyota and Akimoto.....	23
IV. CLAIM CONSTRUCTION	26
V. LEVEL OF ORDINARY SKILL	27
VI. THE FLASCK STATEMENT SHOULD BE GIVEN LITTLE OR NO WEIGHT.....	27
A. Mr. Flasck’s Statement Is Not a Declaration or a Sworn Testimony Under 37 C.F.R. §1.68	27

TABLE OF CONTENTS (cont'd)

	<u>Pages</u>
B. The Flsck Statement Merely Repeats Attorney Argument	31
VII. CONCLUSION.....	36

TABLE OF AUTHORITIES

CASES	PAGE(S)
<i>Apple Inc. v. Chestnut Hill Sound Inc.</i> , IPR2015-01464	32
<i>Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.</i> , 776 F.2d 281, 294 (Fed. Cir. 1985)	32
<i>Bumble Bee Foods v. Kowalski</i> , IPR2014-00224	29
<i>Continental Can Co. v. Monsanto Co.</i> , 948 F.2d 1264, 1268 (Fed. Cir. 1991)	3
<i>Corning Inc. v. DSM IP Assets B.V.</i> , IPR2013-00048.....	31
<i>Fedex v. Katz</i> , CBM2015-00053	28
<i>General Electric Co. v. TAS Energy Inc.</i> , IPR2014-00163	32
<i>Hockerson-Halberstadt, Inc. v. Avia Group Int'l</i> , 222 F.3d 951, 956 (Fed. Cir. 2000).....	16
<i>IBM Corporation v. Intellectual Ventures II LLC</i> , IPR2015-01323.....	29
<i>In re Bond</i> , 910 F.2d 831, 832 (Fed. Cir. 1990)	2, 18
<i>In re Magnum Oil Tools Int'l, Ltd.</i> , 829 F.3d 1364, 1380 (Fed. Cir. 2016).....	24, 25, 31
<i>In re Nuvasive, Inc.</i> , 842 F.3d 1376, 1383 (Fed. Cir. 2016).....	18, 23, 26, 31
<i>In re Oelrich</i> , 666 F.2d 578, 581 (CCPA 1981)	3
<i>In re Olson</i> , 212 F.2d 590, 592, 101 USPQ 401, 402 (CCPA 1954)	16
<i>In re Preda</i> , 401 F.2d 825, 826 (CCPA 1968).....	3
<i>In re Wright</i> , 569 F.2d 1124, 1127, 193 USPQ 332, 335 (CCPA 1977).....	16
<i>In re: Nuvasive</i> , No. 2015-1670 at 10 (Fed. Cir. Dec. 7, 2016)	24
<i>Microsoft v. Enfish</i> , No. 2015-1734 at 14-15 (Fed. Cir. Nov. 30, 2016).....	24
<i>Net MoneyIN, Inc. v. VeriSign, Inc.</i> , 545 F.3d 1359, 1371 (Fed. Cir. 2008).....	3, 18
<i>See Zimmer Biomet Holdings, Inc., v. Four Mile Bay, LLC</i> , IPR2016-00011	26
<i>Verdegaal Bros., Inc. v. Union Oil Co.</i> , 814 F.2d 628, 631 (Fed. Cir. 1987)	2, 18
<i>Verlander v. Garner</i> , 348 F.3d 1335, 1371 (Fed. Cir. 2003).....	26

STATUTES	PAGE(S)
28 U.S.C. § 1746.....	30
35 U.S.C. § 102.....	2, 3, 17
35 U.S.C. § 103.....	17
35 U.S.C. § 312.....	4, 18
35 U.S.C. § 314.....	1
35 U.S.C. § 316.....	31

OTHER	PAGE(S)
37 C.F.R. § 1.68.....	28, 30
37 C.F.R. § 42.2.....	28, 30
37 C.F.R. § 42.53.....	28
37 C.F.R. § 42.104.....	17
37 C.F.R. § 2.20.....	30
<i>Manual of Patent Examining Procedure</i> § 2125 (1998).....	16

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.