

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHI MEI INNOLUX CORPORATION
Petitioner

v.

Patent of SEMICONDUCTOR ENERGY
LABORATORY CO., LTD.
Patent OWNER

Case IPR2013-00038
Patent 7,956,978

Before SALLY C. MEDLEY, KARL D. EASTHOM, and JEFFREY B.
ROBERTSON, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

DECISION – CMI Motion – 37 C.F.R. § 42.3(a)

A. Introduction

Chi Mei Innolux Corporation (CMI), as part of its petition for *inter partes* review, requests that the Board (1) take jurisdiction over, and suspend prosecution

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of application 13/484,800, an application that is a progeny of the patent upon which CMI seeks review (“the involved ‘978 patent”), or (2) review and authorize any further patent application filings, or claim changes to application 13/484,800 prior to submitting such papers to the examiner handling the application (Paper 2 at 4). We treat the request as a motion.¹ The motion is DENIED.

B. Analysis

In its petition for *inter partes* review, CMI argues that application 13/484,800 may be utilized as a possible basis to present patentably indistinct claims which would be inconsistent with 37 CFR § 42.73(d)(3)(i). (Paper 2 at 3). For relief from that possibility, as stated *supra*, CMI requests that we either take jurisdiction over, and suspend prosecution of application 13/484,800, or review and authorize any further patent application filings, or claim changes to application 13/484,800 prior to submitting such papers to the examiner handling the application. (Paper 2 at 4).

The Trial Rules, which apply to *inter partes* review, set forth certain jurisdictional requirements. In particular, 37 CFR § 42.3(a) provides that the “Board may exercise exclusive jurisdiction within the Office over every involved application and patent during the proceeding, as the Board may order.” An “involved” patent means a patent that is the subject of the proceeding. An “involved” application means an application that is the subject of a proceeding, for example in a derivation proceeding. 37 CFR § 42.2 (definition of involved).

¹ Ordinarily, a party requesting relief must seek Board authorization to file a motion. 37 CFR § 42.20(b). Here, we exercise our discretion to decide CMI’s request at page 2:13 to 4:10 of its petition and treat that request as a motion. 37 CFR § 42.1(b) and 37 CFR § 42.5 (b). This decision makes no other

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The '978 patent is involved since it is the subject matter of the proceeding. However, we disagree with CMI that the 13/484,800 application is involved, since the application is not the subject of the proceeding. Thus, there is no requirement that the Board exercise exclusive jurisdiction over the continuing application of the involved '978 patent. Absent such a requirement to do so, we decline to exercise jurisdiction over the 13/484,800 application and suspend prosecution of the application.

CMI alternatively requests that the Board review and authorize any patent application papers or claim changes to application 13/484,800 prior to submitting such papers to the examiner handling the application. (Paper 2 at 4). CMI's request would require the Board to be gate keeper for all papers filed during *ex parte* prosecution of application 13/484,800. CMI has not sufficiently demonstrated why the Board should take on such a role. CMI has not explained how the claims currently present in the 13/484,800 application are patentably indistinct from the claims of the involved '978 patent.

Moreover, the patent examiner handling the application, and who has jurisdiction over the application, can consider whether the claims in the 13/484,800 application are patentably indistinct from the involved '978 patent. If the examiner makes a determination that the claims of the application are patentably indistinct from the '978 patent claims, then the examiner can suspend the application pending the outcome of this proceeding. For these reasons, we deny CMI's request to review and authorize patent application papers or claim changes to application 13/484,800 prior to submitting such papers to the examiner handling the

determinations regarding the remainder of the petition.

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application.

C. Order

It is

ORDERED that CMI's request for the Board to exercise exclusive jurisdiction over application 13/484,800 and to suspend prosecution of the application, or to review and authorize any further patent application filings, or claim changes to application 13/484,800 prior to submitting such papers to the examiner handling the application is **DENIED**; and

FURTHER ORDERED that a copy of this decision be entered in the administrative records of application 13/484,800.

PETITIONER:

Scott A. McKeown, Esq.
Oblon, Spivak, McClelland,
Maier & Neustadt, LLP
Email: cpdocketmckewon@oblon.com

Gregory S. Cordrey, Esq.
Jeffer Mangels Butler & Mitchell, LLP
Email: gcordrey@jmbm.com

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PATENT OWNER:

Eric J. Robinson, Esq.
Sean C. Flood, Esq.
Robinson Intellectual Property Law Office, PC
Email: erobinson@riplo.com
Email: sflood@riplo.com