

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.¹
Patent OWNER

Case IPR2013-00028
Patent 6,404,480

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)

¹ A paper has been filed on behalf of the patent owner indicating that the owner of the patent is Semiconductor Energy Laboratory Co., Ltd. as evidenced by the recorded assignment in parent application 09/046,685. (Paper 6 at 1-2).

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 of applications 12/257,514 and 12/257,521, applications that are progeny of the patent upon which CMI seeks review (“the involved ‘480 patent”), or (2) review and authorize any further patent application filings, or claim changes to applications 12/257,514 and 12/257,521 prior to submitting such papers to the examiner handling the applications (Paper 2 at 4). We treat the request as a motion.² The motion is DENIED.

B. Analysis

In its petition for *inter partes* review, CMI argues that applications 12/257,514 and 12/257,521 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 applications 12/257,514 and 12/257,521, or review and authorize any further patent application filings, or claim changes to applications 12/257,514 and 12/257,521 prior to submitting such papers to the examiner handling the applications. (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

² 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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“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).

The ‘480 patent is involved since it is the subject matter of the proceeding. However, we disagree with CMI that the 12/257,514 and 12/257,521 applications are involved, since those applications are not the subject of the proceeding. Thus, there is no requirement that the Board exercise exclusive jurisdiction over those continuing applications of the involved ‘480 patent. Absent such a requirement to do so, we decline to exercise jurisdiction over the 12/257,514 and the 12/257,521 applications and suspend prosecution of those applications.

CMI alternatively requests that the Board review and authorize any patent application papers or claim changes to applications 12/257,514 and 12/257,521 prior to submitting such papers to the examiner handling the applications. (Paper 2 at 4). CMI’s request would require the Board to be gate keeper for all papers filed during *ex parte* prosecution of applications 12/257,514 and 12/257,521. CMI has not sufficiently demonstrated why the Board should take on such a role. CMI has not explained how the claims currently present in either of the 12/257,514 and 12/257,521 applications are patentably indistinct from the claims of the involved ‘480 patent.

Moreover, the patent examiner handling the respective applications, and who has jurisdiction over the applications, can consider whether the claims in either of

determinations regarding the remainder of the petition.

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the 12/257,514 and 12/257,521 applications are patentably indistinct from the involved '480 patent claims. If the examiner makes a determination that the claims of the applications are patentably indistinct from the '480 patent claims, then the examiner can suspend the applications 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 applications 12/257,514 and 12/257,521 prior to submitting such papers to the examiner handling the applications.

C. Order

It is

ORDERED that CMI's request for the Board to exercise exclusive jurisdiction over applications 12/257,514 and 12/257,521 and to suspend prosecution of those applications, or to review and authorize any further patent application filings, or claim changes to applications 12/257,514 and 12/257,521 prior to submitting such papers to the examiner handling those applications is DENIED; and

FURTHER ORDERED that a copy of this decision be entered in the administrative records of applications 12/257,514 and 12/257,521.

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