

Paper No. _____
Filed: September 10, 2015

Filed on behalf of: Samsung Electronics Company, Ltd.

By: Naveen Modi (nVidia-Samsung-IPR@paulhastings.com)
Joseph E. Palys (nVidia-Samsung-IPR@paulhastings.com)
Paul Hastings LLP

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NVIDIA CORPORATION
Petitioner

v.

SAMSUNG ELECTRONICS COMPANY, LTD.
Patent Owner

Case IPR2015-01327
Patent No. 6,287,902

**Patent Owner's Preliminary Response
to Petition for *Inter Partes* Review
of U.S. Patent No. 6,287,902**

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I. Introduction

Patent Owner Samsung Electronics Company, Ltd. (“Patent Owner” or “Samsung”) respectfully submits this preliminary response in accordance with 35 U.S.C. § 313 and 37 C.F.R. § 42.107, responding to the Petition for *Inter Partes* Review (the “Petition”) filed by nVidia Corporation (“Petitioner” or “nVidia”) against Samsung’s U.S. Patent No. 6,287,902 (“the ’902 patent”). Samsung requests that the Board not institute *inter partes* review for several reasons.

Petitioner has not met its burden of demonstrating a reasonable likelihood of prevailing with respect to any of the challenged ’902 patent claims. For example, Petitioner has not established that at least one of the alleged prior art references, which is part of each of Petitioner’s proposed grounds, is statutory prior art. Petitioner has also not established that any of the alleged prior art teaches all of the features recited in the claims. In addition, Petitioner proposes redundant grounds raised in a concurrently filed petition challenging the ’902 patent without identifying how any one ground improves on any other in the other petition, contravening Board precedent requiring petitioners to identify differences in proposed rejections addressing the same claims of a challenged patent. Furthermore, Petitioner proposes a number of incorrect claim constructions upon which it bases its unpatentability grounds. For these and other reasons discussed below, the Board should not institute an *inter partes* review of the ’902 patent.

II. The Petition Fails to Meet the Requirements for Instituting an *Inter Partes* Review

In order for an *inter partes* review to be instituted, the Petition must show a “reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Here, the Petition contends that claims 1, 3-5, 7-12, 14-16, and 18 of the ’902 patent are unpatentable under 35 U.S.C. § 103 based on KR App. No. 1994/021255 to Lee (“*Lee*”) in view of JP Pub. No. H7-86158 to Yasushige (“*Yasushige*”). The Petition further contends that claims 2 and 17 are unpatentable under 35 U.S.C. § 103 based on *Lee*, *Yasushige*, and U.S. Patent No. 4,916,514 to Nowak (“*Nowak*”). In addition, the Petition further contends that claims 6 and 13 are unpatentable under 35 U.S.C. § 103 based *Lee*, *Yasushige*, and U.S. Patent No. 4,952,524 (“the ’524 Patent”). However, for at least the reasons discussed below, the Petition fails to establish a reasonable likelihood that Petitioner will prevail with respect to even one claim challenged in the Petition.

A. The Petition Has Not Met Its Burden to Establish *Lee* as Statutory Prior Art

Prior art relied on in a petition for *inter partes* review may only consist of “patents or printed publications.” 35 U.S.C. § 311(b). As such, the burden is on Petitioner to establish that *Lee*, which is not a patent and on which Petitioner relies on for every one of its proposed grounds of unpatentability, was “sufficiently

accessible to the public interested in the art” to qualify as a printed publication. *In re Klopfenstein*, 380 F.3d 1345, 1348 (Fed. Cir. 2004); *see also Coalition for Affordable Drugs (ADROCA) LLC v. Acorda Therapeutics, Inc.*, IPR2015-00720, Paper No. 15 at 4-5 (Aug. 24, 2015); *Actavis, Inc. v. Research Corp. Techs., Inc.*, IPR2014-01126, Paper No. 22 at 9-13 (Jan. 9, 2015) (finding that “Petitioner has not satisfied its burden to prove that [a] thesis is a printed publication under § 102(b)”); *L-3 Comm. Holdings, Inc. v. Power Survey, LLC*, IPR2014-00832, Paper No. 9 at 12 (Nov. 14, 2014) (“The party seeking to introduce the reference ‘should produce sufficient proof of its dissemination or that it has otherwise been available and accessible to persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents.’”); *A.R.M., Inc. v. Cottingham Agencies Ltd.*, IPR2014-00671, Paper No. 10 at 7 (Oct. 3, 2014).

According to Petitioner, *Lee* (Ex. 1107) “is a Korean application filed on August 27, 1994.” (Pet. at 9.) Petitioner does not allege that *Lee* itself was ever actually published. Rather, Petitioner alleges that when KR Patent Pub. No. 1996-0009001 (Ex. 1112) published on March 22, 1996, it provided “information on: 1) the applicant; 2) the application number, classification code and filing date; 3) the inventor; 4) application publication number and date of publication; 5) *title of invention*; 6) *scope of patent claims*; 7) *drawings*; 8) *priority claims*; 9) *summary*; and [10]) other matters for the Lee application.” (Pet. at 9-10 (emphasis original).)

Petitioner concludes that “[b]y providing a publication of the title, claims, drawing, and summary of the invention of the Lee application, anyone can search and inspect the full Lee application.” (*Id.* at 10.) Petitioner basis its conclusion solely on *In re Wyer*, 655 F.2d 221 (CCPA 1981), a case that analyzed the publication process employed by the Australian Patent Office in 1974. Rather than supporting Petitioner’s position, however, *Wyer* actually supports a finding that Petitioner has failed to meet its burden to establish *Lee* as a printed publication.

In *Wyer*, the CCPA considered whether a process of disseminating Australian patent applications to the public used by the Australian Patent Office in 1974 caused those Australian patent applications to become “printed publications.” *Wyer*, 655 F.2d 221, 223. As explained in *Wyer*, the Australian process was thorough, including, among other things, “[e]quipment [that] was available to the public in the [Australian] Patent Office and in the sub-offices for providing an enlarged reproduction of [] diazo copies on a display screen,” “[e]quipment . . . for producing enlarged paper copies for purchase by the public,” and “diazo copies . . . also available for sale to the public upon application to the Australian Patent Office.” *Id.* Based on these facts, the court found that there was sufficient proof of dissemination of the Australian application at issue. *Id.* at 226-27. *Wyer* was explicitly limited to “the totality of the facts of [the] case,” and rejected the “rather sweeping statement” that a “microfilm of a foreign patent application maintained

in the foreign patent office, accessible to the pertinent part of the public and available for duplication is a ‘printed publication.’” *Id.* at 227.

The Petition is completely void of any facts regarding how, or even whether, *Lee* would have been available to the public based on the publication of KR Patent Pub. No. 1996-0009001 (Ex. 1112). For example, the Petition includes no explanation as to the Korean Patent Office’s practices in 1996 with respect to making Korean applications (as opposed to mere abstracts) publicly accessible. Even if the Board takes what Petitioner states about Ex. 1112 as true, the Petition does not proffer any evidence, argument, or any other representation that by providing the information highlighted by the Petitioner, *Lee* would have been sufficiently accessible to the public interested in the art at a time prior to the effective priority date of the ’902 patent. Indeed, Petitioner has not even established that its conclusory statement that “anyone can search and inspect the full *Lee* application” is true or would have been true at a time prior to the effective priority date of the ’902 patent. Petitioner has thus not performed the case-specific analysis required by *Wyer* or met the requirements set forth in the guidance provided by the Federal Circuit and the Board. Therefore, Petitioner has not met its burden to establish *Lee* as a printed publication and, as a result, all of Petitioner’s proposed grounds of rejection (which each rely on *Lee*) are improper and should be rejected.

B. The Alleged Prior Art Does Not Disclose the Claimed “Patterned Conductive Layer Is a Dummy Pattern Electrically Isolated From the Substrate and Circuits Thereon”

Independent claims 1, 11, 12, 15, and 18 each recite a “patterned conductive layer [that] is a dummy pattern electrically isolated from the substrate and circuits thereon.” (Ex. 1001 at 6:65-67, 7:56-58, 8:17-19, 8:49-51, 9:14-10:2.) According to the Petition:

Lee explicitly contemplates two embodiments—one where the conductive pattern is an “internal connection line” and the other where the conductive pattern is a “dummy pattern.” Lee Decl. at ¶ 104. . . . For example, Lee teaches that where an internal connection line is not conveniently located to form the etch stop layer on the field oxide layer, a dummy pattern may be created to serve this mechanical function. *Id.* . . . And where a dummy pattern was created for the purpose of serving as a step for forming the etch stop layer, a POSITA would know that keeping the mechanical structure electrically isolated is the best and most efficient practice to prevent accidental electrical connections or shorting damage. *Id.*

(Pet. at. 37-38.) The Petition does not include a citation to *Lee* for any of these propositions, but rather cites to an expert declaration that parrots back the exact same wording and is similarly devoid of citations to *Lee*. (*See id.*; *see also* Ex. 1116 at ¶ 104.) It is well settled that obviousness cannot be sustained by mere

conclusory statements. *See KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007). In addition, even if Petitioner’s statement regarding what a POSITA “would know” is correct, as the Board has previously held such a “statement does not address what one of ordinary skill in the art *would have known at the time*” of the invention of the ’902 patent, “and thus is not relevant to the determination of obviousness.” *See Gen. Elec. Co. v. TAS Energy Inc.*, IPR2014-00163, Paper No. 11 at 10 (May 13, 2014) (emphasis original).

Showing a lack of confidence in its position, Petitioner nebulously states that, “[t]o the extent this limitation of ‘the second patterned conductive layer is a dummy pattern electrically isolated from the substrate and circuits thereon’ is not explicitly disclosed in Lee, this limitation is obvious based on Lee in view of Yasushige.” (Pet. at 39.) According to Petitioner, “Yasushige explicitly discloses a dummy pattern that is ‘electrically isolated.’” (Pet. at 39 (citing Ex. 1109 at ¶¶ [0029], [0041]).) But *Yasushige* simply states that it includes a “conductive film identical to the gate electrode of [a] MOS transistor [that] is formed around the base region of [a] bipolar transistor, and said conductive film is electrically isolated from the base region.” (Ex. 1109 at ¶ [0029]; *see also id.* at ¶ [0041].) *Yasushige* does not disclose, nor does Petitioner allege that *Yasushige* discloses, that the “conductive film” is electrically isolated from anything other than the “base region.” (*See id.* at ¶¶ [0029], [0041].) However, independent claims 1, 11, 12,

15, and 18 of the '902 patent require a “patterned conductive layer” that is “electrically isolated *from the substrate and circuits thereon.*” (Ex. 1001 at 6:65-67, 7:56-58, 8:17-19, 8:49-51, 9:14-10:2 (emphasis added).) Since Petitioner has not established that either *Lee* or *Yasushige* discloses a “patterned conductive layer [that] is a dummy pattern electrically isolated *from the substrate and circuits thereon,*” which is recited in every independent claim, Petitioner has not established a reasonable likelihood that it will prevail with respect to these claims. Petitioner also has failed to establish a reasonable likelihood that it will prevail with respect to claims 2-10, 13, 14, 16, and 17 because they depend from independent claims 1, 12, and 15, respectively, and thus also require the limitation discussed above for claims 1, 12, and 15.

C. The Petition’s Grounds Are Redundant and Should Be Denied

Concurrent with the Petition, in which Petitioner challenges claims 1, 3-5, 7-12, 14-16, and 18 as obvious over *Lee* and *Yasushige*, claims 2 and 17 as obvious over *Lee*, *Yasushige*, and *Nowak*, and claims 6 and 13 as obvious over *Lee*, *Yasushige*, and the '524 Patent, Petitioner also filed a petition for *inter partes* review in IPR2015-01320 (“the '1320 Petition”) challenging the same claims. The '1320 Petition asserts three grounds of rejection that rely entirely on alleged prior art not at issue in this proceeding. The Petition is entirely void of any explanation as to why the proposed grounds in the Petition are not redundant to the grounds in

the '1320 Petition.

The redundant grounds in the Petition and the '1320 Petition would place a significant burden on the Board and the patent owner, and cause unnecessary delay that jeopardizes meeting the statutory deadline for final written decisions. *Liberty Mut. Ins. Co. v. Progressive Cas. Ins. Co.*, CBM2012-00003, Paper No. 7 at 2 (Oct. 25, 2012). The consideration of redundant grounds frustrates Congress's intent that the Board "secure the just, speedy, and inexpensive resolution of every proceeding," in violation of 37 C.F.R. § 42.1(b).

Where multiple grounds of rejection are presented, the "[d]ifferences between the claimed invention and the prior art are a critically important underlying factual inquiry" *Liberty Mut. Ins. Co.*, CBM2012-00003, Paper No. 7 at 2-3. The redundancy inquiry does not focus on "whether the applied prior art disclosures have differences, for it is rarely the case that the disclosures of different prior art references, will be literally identical." *EMC Corp. v. Personal Web Techs., LLC*, IPR2013-00087, Paper No. 25 at 3 (June 5, 2013). Rather, the Board considers "whether the petitioner articulated a meaningful distinction in terms of relative strengths and weaknesses with respect to application of the prior art disclosures to one or more claim limitations." *Id.* at 3-4. The Petitioner carries the burden of articulating that "meaningful distinction." *ScentAir Techs., Inc. v. Prolitic, Inc.*, IPR2013-00180, Paper No. 18 at 3 (Aug. 26, 2013). Put simply,

“[t]o avoid a holding of redundancy, the Petition has to explain why one reference is better in one respect but worse in another respect.” *Toyota Motor Corp. v. Am. Vehicular Sciences LLC*, IPR2013-00421, Paper No. 15 at 29 (Jan. 13, 2014).

Petitioner’s burden of articulating a distinction between its redundant grounds is not lessened or removed simply because those grounds may appear in more than one petition. In fact, the policy considerations behind denying redundant grounds are even more compelling when those grounds are presented across multiple petitions. Multiple petitions necessitate multiple written decisions and an analysis of a corresponding number of briefs, as well as the potential for differing panels of judges, multiple scheduling conferences, and multiple oral arguments—all of which tax the Board’s resources and diminish its ability to ensure the speedy resolution of each proceeding. Moreover the Board has previously recognized grounds as being redundant across petitions and dismissed the redundant grounds. See *E*TRADE Financial Corp. v. Droplets, Inc.*, IPR2015-00471, Paper No. 18 at 10-12 (July 6, 2015).

In *Liberty Mutual*, the Board identified two types of redundant rejections: (1) “horizontally” redundant rejections and (2) “vertically” redundant rejections. *Liberty Mut. Ins. Co.*, CBM2012-00003, Paper No. 7 at 3. The Board explained that horizontally redundant rejections apply “a plurality of prior art references . . . not in combination to complement each other but as distinct and separate

alternatives.” *Id.* Vertical redundancy “exists when there is assertion of an additional prior art reference to support another ground of unpatentability when a base ground already has been asserted against the same claim without the additional reference and the Petitioner has not explained what are the relative strength and weakness of each ground.” *Id.* at 12.

Here, the Petition is at least horizontally redundant in view of the ’1320 Petition. In both petitions, Petitioner alleges that claims 1-18 are invalid based on separate references. Petitioner offers no explanation at all as to why the grounds of rejection proposed in the Petition are not redundant to those in the ’1320 Petition, let alone explained why the references in the Petition and/or the ’1320 Petition are “better in one respect but worse in another respect.” *Toyota Motor Corp.*, IPR2013-00421, Paper No. 15 at 29. As such, to the extent the Board decides to institute review, at most only one set of grounds (i.e., the grounds in the Petition or the grounds in the ’1320 Petition) should be instituted.

In addition, Petitioner’s redundant challenge of the ’902 patent claims in the Petition and the ’1320 Petition is an example where the Board should exercise its discretion under 35 U.S.C. § 325(d) to deny institution in order to avoid burdening the both the Office and Patent Owner in litigating the same claims of the same patent in two separate *inter partes* review proceedings given that Petitioner did not attempt at all to explain to the Board how the multiple challenges to the claims in

the petitions are materially different. Indeed, Petitioner failed to discuss any of the strengths or weaknesses of the cited prior art as they are applied to the challenged claims across the two petitions, much less explain any difference at all between the two petitions. The Board should therefore exercise its discretion under Section 325(d) and deny institution of the Petition and/or the '1320 Petition.

III. The Petition's Claim Constructions Are Flawed and Should Be Rejected

In *inter partes* review, claims are to be given their broadest reasonable interpretation (“BRI”) in light of the specification.¹ 37 C.F.R. § 42.100(b). In applying this standard, the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989). The ordinary meaning of a term may be evidenced by a variety of sources, including “the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005) (en banc) (citation omitted).

Additionally, the prosecution history is part of the intrinsic record and should be considered when construing the claims. *Id.* at 1317. The Federal Circuit

¹ Patent Owner does not concede that the BRI standard is the proper standard, and reserves the right to address the claims under a different standard.

recently provided additional guidance, explaining that “[t]he PTO should also consult the patent’s prosecution history in proceedings in which the patent has been brought back to the agency for a second review.” *Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir. 2015). Consequently, in *inter partes* review proceedings, the Board considers the prosecution history when construing the claims. See, e.g., *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper No. 15 at 8 (Jan. 9, 2013); *Motorola Solutions, Inc. v. Mobile Scanning Techs., LLC*, IPR2013-00093, Paper No. 28 at 10 (Apr. 29, 2013). As explained below, Petitioner proposes defective claim constructions that do not represent the BRI of the claims.

A. “insulating spacer along a sidewall of the [second] patterned conductive layer” (Claims 1, 11, 12, 15, and 18)²

Patent Owner’s Proposed Construction	Petitioner’s Proposed Construction
Plain and ordinary meaning	an insulating spacer, along a sidewall of the [second] patterned conductive layer, that prevents etch damage to the field isolation layer if the contact hole is misaligned

Claims 1, 11, 12, 15, and 18 recite an “insulating spacer along a sidewall of the [second] patterned conductive layer.” (Ex. 1001 at 6:61-63, 7:53-54, 8:14-15,

² Patent Owner identifies only the challenged claims that expressly recite the terms at issue.

8:46-47, 9:11-12.) Patent Owner submits that the term should be given its plain and ordinary meaning under the broadest reasonable construction. Nothing in the phrase warrants any special meanings, and Petitioner has not demonstrated that is the case. In fact, Petitioner's proposed construction of the term introduces ambiguity and is a blatant attempt to add limitations to the claim where none exist. For example, Petitioner's proposed construction includes two parts. The first part of Petitioner's proposed construction is consistent with the plain and ordinary meaning of the limitation. In particular, Petitioner's construction states that the insulating spacer is "along a sidewall of the [second] patterned conductive layer." (Pet. at 26.) Patent Owner agrees that the limitation can be readily understood by its plain language, i.e., an "insulating spacer along a sidewall of the [second] patterned conductive layer." As such, this limitation should be interpreted according to its plain and ordinary meaning.

Petitioner, however, goes further, and introduces proposed interpretations that inappropriately add ambiguous and extraneous language to the already parroted meaning of the term. In particular, Petitioner proposes that the claim term be rewritten to include an additional requirement that the insulating spacer "prevents etch damage to the field isolation layer if the contact hole is misaligned," citing to excerpts from the specification and prosecution history. (Pet. at 26.) Petitioner's construction is improper because it incorrectly attempts to impart

limitations from the specification and prosecution history without any “clear and unambiguous disavowal of claim scope.” *Storage Tech. Corp. v. Cisco Sys., Inc.*, 329 F.3d 823, 833 (Fed. Cir. 2003). While the ’902 patent discloses an insulating spacer that can prevent etch damage to a field isolation layer if a contact hole is misaligned (*see, e.g.*, Ex. 1001 at 4:41-50), the ’902 patent does not define the term “insulating spacer” so as to *necessarily* prevent etch damage to a field isolation layer if a contact hole is misaligned. Therefore, Petitioner’s proposed construction is inconsistent with the BRI and should not be adopted. A district court in the co-pending litigation in fact rejected the same arguments as those presented by Petitioner here, finding that “insulating spacer along a sidewall of the [second] patterned conductive layer” should be interpreted in accordance with its plain and ordinary meaning. (Ex. 2001 at 18-19; Ex. 2002 at 2.) The Board should likewise adopt the same understanding in these proceedings, as the disputed phrase does not warrant any other special definition for understanding what it means.

B. “an insulating layer” (Claims 1, 2, 8, 11, 12, 14-18)

Patent Owner’s Proposed Construction	Petitioner’s Proposed Construction
a structure comprising one or more electrically insulating sublayers	Plain and ordinary meaning

Claims 1, 2, 8, 11, 12, and 14-18 recite “an insulating layer.” (Ex. 1001 at 7:1, 7:4, 7:7-8, 7:27-28, 7:59, 7:62, 8:19, 8:23, 8:29-31, 8:52, 8:55, 8:60-61, 8:64-65, 10:3, 10:6.) The BRI of “insulating layer” is “a structure comprising one or

more electrically insulating sublayers.” This interpretation is consistent with how the term is used in the claims and specification of the ’902 patent.

For example, claim 1 includes the use of “an insulating layer.” (Ex. 1001 at 7:1-3.) Dependent claim 2 narrows the scope of the “insulating layer” and states that the insulating layer “comprises nitride.” In using the term “comprises,” claim 2 is open-ended and permits for additional elements (e.g., additional sublayers). Claim 1, which is necessarily broader than dependent claim 2, similarly is written so as to permit the insulating layer to include one or more electrically insulating sublayers. (*Id.* at 7:1-3.) The specification of the ’902 patent also does not limit the scope of an “insulating layer” to a particular number of layers. (*See, e.g., id.*, 4:32-40, 5:60-65.) (*See also* Ex. 2001 at 20-22; Ex. 2002 at 1 (construing “an insulating layer” as “a structure comprising one or more electrically insulating layers”).) Therefore, the BRI of “an insulating layer” is “a structure comprising one or more electrically insulating sublayers.”

C. “forming a trench in said substrate, and wherein said field isolation layer fills said trench” (Claim 6)

Patent Owner’s Proposed Construction	Petitioner’s Proposed Construction
Plain and ordinary meaning	Plain and ordinary meaning

Claim 6 recites “forming a trench in said substrate, and wherein said field isolation layer fills said trench.” (Ex. 1001 at 7:18-21.) For purposes of this proceeding at this time, Patent Owner agrees with Petitioner that this limitation

may be understood in accordance with its plain and ordinary meaning. Patent Owner notes that in co-pending litigation, it proposed a construction under the *Phillips* standard that this limitation means “etching a recess into said substrate and subsequently filling said recess with a field isolation layer.” (*See* Ex. 2001 at 23.) However, as noted by the district court in that co-pending litigation, that construction was proposed to make clear that claim 6 does not claim the “LOCOS method” of forming a field isolation layer, but rather the “trench method.” (*See id.*; *see also* Ex. 1001 at 4:10-18 (disclosing the LOCOS method and the trench method of forming a field isolation layer).) Since both Petitioner and Patent Owner agree that claim 6 does not claim the LOCOS method (*see* Ex. 2001 at 23), Patent Owner submits that this clarification is not necessary for purposes of this proceeding.

IV. Conclusion

For these reasons, Patent Owner respectfully requests that the Board deny the Petition and not institute an *inter partes* review of the '902 patent.³

Dated: September 10, 2015

Respectfully submitted,

/Naveen Modi/
Naveen Modi
Reg. No. 46,224

Counsel for Patent Owner

³ If trial is instituted, Patent Owner reserves its rights to raise additional arguments, including claim construction arguments, as to why Petitioner has failed to carry its burden and why the claims should be confirmed.

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that I caused to be served on the counsel for Petitioner a true and correct copy of the foregoing Patent Owner's Preliminary Response to Petition for *Inter Partes* Review of U.S. Patent No. 6,287,902, by electronic means on September 10, 2015 on Counsel for Petitioner at the following addresses of record:

Robert Steinberg (Bob.steinberg@lw.com)
Julie Holloway (Julie.Holloway@lw.com)
Clement Naples (Clement.Naples@lw.com)
Latham & Watkins LLP

Dated: September 10, 2015

Respectfully submitted,

/Naveen Modi/
Naveen Modi
Reg. No. 46,224

Counsel for Patent Owner