

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner

v.

ACORN SEMI, LLC,
Patent Owner

Case No. IPR2020-01264
Patent No. 8,766,336

PATENT OWNER'S UPDATED MANDATORY NOTICE

Acorn, the patent owner, submits the following updated mandatory notice. Only related matters information is updated. No updates to real party-in-interest, counsel, or service information are made at this time.

Pursuant to 37 C.F.R. §§ 42.8(a)(3) and 42.8(b)(2), Acorn provides the following update regarding related matters:

In the related litigation, the district court issued a claim construction order on October 16, 2020.* *See Acorn Semi, LLC v. Samsung Elecs. Co.*, No. 2:19-cv-00347-JRG, Dkt. # 85 (E.D. Tex. filed Oct. 16, 2020). A copy is provided as a courtesy as Ex. 2053. United States Magistrate Judge Roy S. Payne construed the following terms and phrases of challenged claims of the '336 Patent:

* Acorn also furnishes this information pursuant to the Board's guidance. *See* PTAB Consol. Trial Prac. Guide (Nov. 2019) at 47 ("Parties should submit a prior claim construction determination by a federal court or the ITC in an AIA proceeding as soon as that determination becomes available."). The claim construction order issued October 16, 2020, the same day Acorn filed its preliminary response, but not in time to be submitted with the preliminary response.

- “sufficiently thick to depin a Fermi level of the semiconductor” (claim 5) construed as “displacing the semiconductor from the contact metal by a sufficient distance to eliminate or at least reduce the effects of metal-induced gap states in the semiconductor and terminating all or substantially all dangling bonds that may be present at the surface of the semiconductor without the layer present.” *Id.* at 17.
- “having a thickness sufficient to depin a Fermi level of the conductor” (claims 13, 77) construed as “displacing the semiconductor from the conductor by a sufficient distance to eliminate or at least reduce the effects of metal-induced gap states in the semiconductor and terminating all or substantially all dangling bonds that may be present at the surface of the semiconductor without the layer present.” *Id.*
- “interface layer” (claims 1, 5, 13, 77) given “its plain and ordinary meaning without the need for further construction.” *Id.* at 27.
- “configured to” (claim 1) given “its plain and ordinary meaning without the need for further construction.” *Id.* at 31.

Respectfully submitted,

Date: 2020 Oct. 27

By: / M.C. Phillips /

Matthew C. Phillips
Registration No. 43,403
Lead Counsel for Acorn

CERTIFICATE OF SERVICE

I hereby certify that on October 27, 2020, copies of the foregoing PATENT OWNER'S UPDATED MANDATORY NOTICE and all documents filed with it were served via electronic mail, as agreed to by counsel, upon the following counsel for the patent owner:

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