

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AMKOR TECHNOLOGY, INC.  
Petitioner

v.

TESSERA, INC.  
Patent Owner

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Case IPR2013-00242  
Patent 6,046,076

Before KEVIN F. TURNER, JUSTIN T. ARBES, and  
CARL M. DeFRANCO, *Administrative Patent Judges*.

DeFRANCO, *Administrative Patent Judge*.

DECISION  
Patent Owner's Motion to Strike  
*37 C.F.R. § 42.20*

### *Introduction*

On March 31, 2014, the patent owner, Tessera, Inc., filed a motion to strike various portions of the “Reply to Patent Owner Response” (Paper 102) submitted by the petitioner, Amkor Technology, Inc., in this *inter partes* review proceeding. Paper 107 (“Mot.”). Amkor filed an opposition to the motion on April 3, 2014.<sup>1</sup> Paper 111 (“Opp.”).

In its motion, Tessera argues that Amkor’s reply, and an expert declaration submitted with the reply, go beyond the proper scope permitted for a reply. Under the Board’s rules, “[a] reply may only respond to arguments raised in the corresponding . . . patent owner response.” 37 C.F.R. § 42.23(b). The reply is not an opportunity to raise new issues or submit new evidence that reasonably could have been presented in the initial petition. *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012). After considering Tessera’s motion and Amkor’s opposition, we determine that Tessera has not shown that Amkor’s reply or the accompanying declaration exceed the proper scope of a reply. As such, the motion is *denied*.

### *Analysis*

Tessera points to four aspects of Amkor’s reply and the accompanying declaration of Alexander D. Glew, Ph.D. (Ex. 1046) that purportedly raise improper evidence and argument not previously discussed in the petition. Mot. 1-5. According to Tessera, the objected to material includes: (1) Amkor’s belated reliance on a second embodiment in one of the asserted prior art references in this proceeding, U.S. Patent No. 4,681,718 (Ex. 1003,

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<sup>1</sup> The Board authorized Tessera’s motion and Amkor’s opposition pursuant to an Order dated March 27, 2014. Paper 106.

“Oldham ’718”); (2) Amkor’s belated reliance on language in claim 17 of Oldham ’718; (3) Amkor’s reliance on a new prior art reference, U.S. Patent No. 4,559,272 (Ex. 2080, “Oldham ’272”); and (4) Amkor’s discussion of a new obviousness ground. *See id.*

First, Tessera contends that Amkor’s reply improperly raises a “different” embodiment in Oldham ’718 than the “single embodiment” Amkor relied upon in the petition. Mot. 1-3. Oldham ’718 teaches “two preferred embodiments,” referencing “one embodiment” at column 4 and “another embodiment” at column 9. Ex. 1003, 3:52, 4:45, 9:3. According to Tessera, Amkor’s petition relies solely on the first embodiment “to show anticipation of claim 1” and merely cites to the second embodiment in column 9 “for the preamble.” Mot. 1-2. The claim chart that Amkor submitted with Dr. Glew’s original declaration (Ex. 1008) , however, expressly identifies “another embodiment” in Oldham ’718 as corresponding to the first limitation of claim 1 *after* the preamble. *See* Ex. 1020 at 2-3. Moreover, Tessera does not convince us that the citations to Oldham ’718 in the petition do not apply equally to both preferred embodiments. Further, Amkor persuades us that the new citations to Oldham ’718 in the reply are responsive to arguments raised by Tessera in its patent owner response. *See* Opp. 1-4. As such, we decline to strike Amkor’s discussion of the second embodiment of Oldham ’718.

Second, Tessera asserts that Amkor’s references in the reply to other processes of Oldham ’718, such as the process of claim 17, are improper because the petition purportedly cites to only “one of Oldham ’718’s several processes.” Mot. 1-2; *see also* Mot. 5 (seeking to strike pages 10-11 of the reply that discuss claim 17). The fact that claim 17 and other passages of

Oldham '718 are not specifically cited in the petition does not preclude Amkor from relying on them in its reply. The very nature of a reply is to respond to opposing arguments in the patent owner response. *See* 37 C.F.R. § 42.23(b). The need to rely on evidence not previously discussed in the petition, as well as the need to submit rebuttal evidence in the form of other passages from the same relied upon reference, may not arise until after a certain point is raised in the patent owner response. In other words, much depends on the specific arguments made in the patent owner response. For instance, where the patent owner response raises an argument that reasonably could not have been anticipated by the petitioner, the petitioner properly may, as a part of its reply, rely on new evidence or cite to different portions of the same prior art reference. Here, Amkor's reliance on Oldham's claim 17 was made necessary by Tessera's response, which vigorously disputes a particular teaching in Oldham '718, "mold under vacuum," that Amkor cited and relied upon in its petition. *See* Pet. 46; Resp. 43-48. Amkor uses claim 17 of Oldham '718 to rebut Tessera's characterization of that same teaching. *See* Reply 9-11; Opp. 1-3. In doing so, Amkor is not raising a new argument. Rather, as used by Amkor, claim 17 constitutes proper rebuttal evidence.

Third, Tessera accuses Amkor's reply of improperly raising new prior art evidence, namely, Oldham '272. Mot. 2-4. We note that Amkor's petition does not discuss Oldham '272. However, it is Tessera, not Amkor, who first opens the door on Oldham '272. *See* Resp. 30-31. Specifically, in the patent owner response, Tessera cites Oldham '272 as evidence of how a skilled artisan would have understood the term "electrical component" in the context of Oldham '718. *See id.* Tessera's declarant likewise references

Oldham '272. *See* Ex. 2055 ¶¶ 55-60. In reply, Amkor merely uses Tessera's own evidence, Oldham '272, to rebut Tessera's portrayal of Oldham '718. Reply 5. Because Tessera raised Oldham '272 as an inherent reflection of the state of the art, it was permissible for Amkor to use the same evidence in an effort to negate that assertion.

Finally, Tessera seeks to strike Amkor's attempt to raise a new ground of obviousness in the reply. Mot. 4. Without question, Amkor's reply invites the Board to consider an obviousness ground that is not at issue in this trial. *See* Reply 8 n. 1 ("the Board did not institute trial on the proposed ground of Oldham rendering claims 1-5 and 19 obvious, . . . but the Board can still consider the proposed ground"). Based on Amkor's belated proposal, Tessera seeks to strike an entire section of Amkor's reply as improper. Mot. 5. However, striking the entire section, which also discusses the ground of anticipation on which we instituted, is unnecessary. The grounds of unpatentability at issue in this trial are those specified in the decision on institution. Paper 37 at 34. The Board is capable of discerning between proper discussion of the ground of anticipation at issue in this trial and any statements as to grounds not at issue. As such, we decline to strike any section of Amkor's reply.

#### *Conclusion*

For the foregoing reasons, Tessera's Motion to Strike is *denied* in its entirety.

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