

In re Patent of: Milton Clair Webb, et al.
U.S. Patent No.: 9,831,306 Attorney Docket No.: 39843-0151IP1/IP2
Issue Date: November 28, 2017
Appl. Serial No.: 15/024,750
Filing Date: December 19, 2013
Title: SELF-ALIGNED GATE EDGE AND LOCAL INTERCONNECT
AND METHOD TO FABRICATE SAME

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**PETITIONER'S NOTICE RANKING AND EXPLAINING MATERIAL
DIFFERENCES BETWEEN PETITIONS FOR *INTER PARTES* REVIEW
OF U.S. PATENT NO. 9,831,306**

Petitioner is concurrently filing two petitions (IPR2023-00403 and IPR2023-00404) challenging U.S. Patent No. 9,831,306 (the “’306 Patent”). This paper provides “(1) a ranking of the petitions in the order in which [Petitioner] wishes the Board to consider the merits,...and (2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions.” Trial Practice Guide, 59-61.

I. Ranking of Petitions

Although both petitions are meritorious and justified, as further detailed *infra*, Petitioner requests that the Board consider the petitions in the following order:

Rank	Petition	Challenged Claims
1	IPR2023-00403	26-35
2	IPR2023-00404	26-29, 31

II. Material Differences Between the Petitions

Material differences exist between the petitions, which are non-redundant at least in their reliance on different combinations of references that demonstrate the obviousness of the Challenged Claims in materially different ways.

For example, in IPR2023-00403, Petitioner relies on Xie and Anderson as the primary references. In contrast, in IPR2023-00404, Petitioner relies on Chang and Akarvardar as the primary references. These distinct primary references, in combination with various secondary references, apply differently to the claims of the '306 Patent—and are further applied to different claims in each of the petitions. Additionally, the motivation to combine the distinct sets of references presented in the two petitions materially differs. Thus, the petitions are not redundant, duplicative, or substantially similar. Rather, each petition compellingly demonstrates the unpatentability of the Challenged Claims, without repeating the same theory.

In particular, IPR2023-00403 is based on a mapping of “gate edge isolation structure” in a manner that does not require a self-aligned gate edge isolation structure as disclosed in the '306 Patent. This invalidity theory is consistent with positions first taken by Patent Owner in the co-pending ITC case. *See* SAMSUNG-1051, 16-17; SAMSUNG-1052, 22-23; SAMSUNG-1053, 12-14. On the other hand, IPR2023-00404 is based on an invalidity theory in which “gate edge isolation structure” is taken to be a structure that is self-aligned, in a manner consistent with the written description of the '306 Patent.

Due to word count constraints and given the uncertainty of the construction of “gate edge isolation structure” in the parallel litigation, two petitions are needed

to address both theories. Therefore, Petitioner respectfully submits that institution of both petitions is justified. *See* IPR2019-00237, Paper 15, 14 (instituting multiple petitions based on arguments that result in “different manner of application of the prior art.”). The Board’s institution of IPRs based on both petitions, which compellingly demonstrate invalidity of the Challenged Claims based on materially different grounds, would serve to efficiently address issues of invalidity for all parties.

For at least these reasons, Petitioner respectfully requests that the Board institute trial on both petitions.

Respectfully submitted,

Dated: January 19, 2023

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4)(i) *et seq.* and 42.105(b), the undersigned certifies that on January 19, 2023, a complete and entire copy of this Petitioner's Notice Ranking And Explaining Material Differences Between Petitions For Inter Partes Review Of U.S. Patent No. 9,831,306 was provided by Federal Express, to the Patent Owner by serving the correspondence address of record as follows:

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