

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SPTS TECHNOLOGIES LTD.,
Petitioner,

v.

PLASMA-THERM LLC,
Patent Owner.

Case IPR2017-01674
Patent 8,802,545 B2

Before WILLIAM V. SAINDON, ELIZABETH M. ROESEL, and
AMANDA F. WIEKER, *Administrative Patent Judges*.

WIEKER, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request for Rehearing of Final Written Decision
37 C.F.R. § 42.71(d)

I. INTRODUCTION

SPTS Technologies Ltd. (“Petitioner”) filed a Request for Rehearing (Paper 28, “Request” or “Req.”) of our Final Written Decision (Paper 27, “Final Written Decision,” “Decision,” or “Dec.”), in which we determined that Petitioner had not shown by a preponderance of the evidence that challenged claims 1, 2, 4, and 5 of U.S. Patent No. 8,802,545 B2 (Ex. 1001, “the ’545 patent”) are unpatentable. Dec. 2. For the reasons that follow, Petitioner’s Request for Rehearing is denied.

II. THE REQUEST FOR REHEARING

In pertinent part, 37 C.F.R. § 42.71(d) states:

The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

Thus, a request for rehearing is not an opportunity merely to disagree with the Board’s assessment of the arguments or weighing of the evidence, or to present new arguments or evidence not presented previously.

Petitioner argues that “the PTAB overlooked and/or misapprehended Petitioner’s evidence and argument” regarding five specific issues. Req. 3. We have reviewed Petitioner’s Request and carefully considered each argument presented. For the following reasons, we are not persuaded that we misapprehended or overlooked arguments or evidence, as asserted by Petitioner.

III. DISCUSSION

A. *Argument Regarding Sekiya (Exs. 1020, 2014)*

Petitioner argues that the Decision “largely rests on [the Board’s] conclusion that Petitioner has not demonstrated that the POSITA would expect undercutting to occur in Fischer,” wherein the Board improperly credited the testimony of Patent Owner’s declarant, Dr. Shanfield, over that of Petitioner’s declarant, Dr. Spencer. Req. 4. According to Petitioner, “the PTAB has not addressed Petitioner’s argument that Dr. Shanfield supports his testimony on the back of a mischaracterization of the teachings of Sekiya,” a prior art U.S. patent submitted into evidence by both Petitioner and Patent Owner. *Id.* Petitioner contends that “Dr. Shanfield relies on an alternative embodiment of Sekiya that runs counter to the notion of the carrier film being reached during etching. That is, in contrast to Fischer, Sekiya’s alternative embodiment stops etching before the carrier film is reached.” *Id.* (citing Pet. Reply 9–10 (quoting Dr. Shanfield’s testimony that Sekiya teaches “that a slight thickness of unetched region may remain,” which may be fractured by application of “a slight bending force”)). According to Petitioner, this “infects” Dr. Shanfield’s entire testimony regarding “residual material.” *Id.*

Petitioner is correct that the Board found Dr. Shanfield’s testimony more persuasive than that of Dr. Spencer, in part because Dr. Spencer failed to support adequately his opinion and failed to account for Fischer’s disclosure that the etching process stops at the boundary surface to Fischer’s carrier film. Dec. 19–21; Ex. 1005, 6:55–59; Ex. 1009 ¶ 90. The Board credited Dr. Shanfield’s testimony that, when etching stops at the boundary to Fischer’s carrier film, undercutting is not likely to occur because charge

will not build up on the surface of the film. Dec. 20 (citing Ex. 2010 ¶¶ 21–22, 25). Thus, the Board determined that Petitioner failed to establish that a build-up of ions would have been expected to occur on Fischer’s carrier film, and thus failed to establish that Fischer would have been perceived as suffering from an undercutting problem, motivating consideration of Donohue. The Board also found that “Dr. Shanfield further explains that *even if* some amount of interface undercutting might occur in Fischer, this still would not have motivated a POSITA to employ Donohue’s technique” because “any undercut associated with dicing is ‘far removed from the electronic devices, which all reside in the top 0.1 – 0.3 μm of the wafer . . . making even significant undercut from dicing inconsequential.’” *Id.* at 21 (citing Ex. 2001 ¶ 41).

Contrary to Petitioner’s assertion, the Board did not overlook Petitioner’s argument that Dr. Shanfield’s testimony was based, in part, on a mischaracterization of Sekiya’s teachings. Although the Decision does not mention Sekiya by name, the Board considered Sekiya’s discussion of an embodiment in which residual silicon may remain between chip components. *Compare* Req. 4, *with* Dec. 20–23. The Board first found that Dr. Shanfield consistently stated that Fischer’s etching process stops at the boundary of the carrier film. Dec. 22 (citing Ex. 2001 ¶ 48; Ex. 2010 ¶ 13). As discussed above, Fischer’s teaching is consistent with Dr. Shanfield’s testimony that a build-up of ions would *not* occur at the carrier film, such that undercutting would not have been expected. Ex. 2010 ¶¶ 21–22, 25. Second, and as related to Petitioner’s argument about Sekiya, the Board stated:

Dr. Shanfield did *not* testify that residual silicon necessarily remains after Fischer’s etching operation stops, nor did he testify that residual silicon is the reason that undercutting is absent. . . . Dr. Shanfield’s discussion of residual silicon appears to explain that *even if* some small amount of silicon were to remain on a wafer, it is inconsequential, because it would simply be fractured by hand.

Dec. 22–23.

Thus, the Board considered Petitioner’s argument that Dr. Shanfield improperly relied upon Sekiya’s embodiment in which residual material remains, but simply found this argument unpersuasive to discredit Dr. Shanfield’s testimony. Dec. 19–23.

B. Argument Regarding Dr. Shanfield’s “Admission”

Petitioner argues that the Board overlooked Petitioner’s argument that, in Dr. Shanfield first declaration, he acknowledged that undercutting may occur in Fischer’s process, but that any such undercutting would have been acceptable. Req. 5 (citing Pet. Reply 8–9, 14–17).

The Board expressly addressed this argument on pages 21–23 of the Decision. As discussed above, the Board credited Dr. Shanfield’s testimony, provided in his first declaration, that *even if* some undercutting occurred in Fischer’s process, it would be inconsequential because it would be far away from the functional chip components. Dec. 21; Ex. 2001 ¶ 41. As stated in the Decision, Dr. Shanfield’s testimony on this point “aligns with the different purposes of Fischer—a dicing technique—and Donohue—a chip fabrication technique.” *Id.* Additionally, the Board stated:

Petitioner argues that Dr. Shanfield provides inconsistent explanations for the asserted absence of undercutting in Fischer, first testifying that Fischer discloses a process in which the chips

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