UNITED STATES DISTRICT COURT
DISTRICT OF NEW MEXICO

STC.UNM, Plaintiff, v. INTEL CORPORATION, Defendant.	Civil No. 10-CV-01077-RB-WDS

STC.UNM'S MOTION FOR CONSTRUCTION OF THE "TRANSFERRING" STEPS IN CLAIM 6

STC.UNM moves to add the two "transferring" claim terms to the list of terms for construction by the Court. Since claim construction is viewed as an evolving process, it is proper for the Court to construe later identified claim terms, in addition to the terms that were initially identified by the parties. The Federal Circuit repeatedly counsels that trial courts can "engage in rolling claim construction." *Conoco, Inc. v. Energy & Environment Int'l, L.C.*, 460 F.3d 1349, 1359 (Fed. Cir. 2006)[1]. Moreover, "[t]he claim construction process is often evolutionary rather than static, and courts must continually be open to reexamination of claim construction up to and including at trial in order to ensure that the construction ultimately relied upon by the fact finder

[1] *See also Pressure Prods. Med. Supplies v. Greatbatch Ltd.*, 599 F.3d 1308, 1316 (Fed. Cir. 2010) ("district courts may engage in a rolling claim construction, in which the court revisits and alters its interpretation of the claim terms as its understanding of the technology evolves.") (citing *Pfizer, Inc. v. Teva Pharms.*, USA, Inc., 429 F.3d 1364, 1377 (Fed. Cir. 2005); *Utah Med. Prods., Inc. v. Graphic Controls Corp.*, 350 F.3d 1376, 1381-82 (Fed. Cir. 2003) (holding that the district court did not err in amending its claim construction during oral arguments for pretrial motions nearly two years after the original construction); *O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1360 (Fed. Cir. 2008) ("[w]hen the parties raise an actual dispute regarding the proper scope of these claims, the court, not the jury, must resolve that dispute.").

is correct." *Sears Petroleum & Transp. Corp. v. Archer Daniels Midland Co.*, 2010 U.S. Dist. LEXIS 142958, at * 21 (N.D.N.Y. 2010) (construing additional terms five years into the lawsuit, and after summary judgment decided).

Because Intel's narrow constructions for the words "parts of said first mask layer" and "combined mask . . ." are designed to improperly limit claim 6 of its proper scope, STC.UNM has consistently argued that those words should be construed as part of the larger phrase:

> transferring said first pattern and said second pattern into said substrate using a combined mask including parts of said first mask layer and said second photoresist.

See Doc. 113, at 20, 22; and Doc. 133, at 14. Now, certain admissions made by Intel's expert show the inconsistency with Intel's narrow constructions and the overall "transferring" limitation. In short, but as may be explained in further detail in a supplemental brief, the "transferring" steps in claim 6 are required to be broad enough to encompass a transferring process called damascene which is part of claim 7. Claim 7 is "dependent" on claim 6, and thus must be consistent therewith. *See AK Steel Corp. v. Sollac*, 344 F.3d 1234, 1242 (Fed. Cir. 2003) (independent claims must be construed "at least as broad as the claims that depend from them").[2] But Intel's own expert admitted during his deposition the second photoresist cannot be present during the completion of the damascene process. Smith [Ex. A], at 206:23 – 207:2. Thus, Intel's narrow constructions, which require the second photoresist to be present during the second transferring step are wrong, and should be rejected.

[2] *See also Phillips v. AWH Corp.*, 415 F.3d 1303, 1314-15 (Fed. Cir, 2005) ("Differences among claims can also be a useful guide in understanding the meaning of particular claim terms. For example, the presence of a dependent claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim.").

By textually construing the "transferring" limitations, the Court will be assured that it is providing a proper scope to the disputed terms. In this regard, claim construction is not meant to change the scope of the claims but only to clarify their meaning. The Federal Circuit has explained that "[t]he construction of claims is simply a way of elaborating the normally terse claim language in order to understand and explain, but not to change, the scope of the claims." *Embrex, Inc. v. Service Eng'g Corp.*, 216 F.3d 1343, 1347 (Fed. Cir. 2000).

Accordingly, STC.UNM requests the Court to add the "transferring" limitations to the list of terms for construction, and receive supplemental briefing limited to those terms.[3]

Dated: November 16, 2011

Respectfully submitted,

/s/ Steven R. Pedersen

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Certificate of Conference: The undersigned conferred with counsel for Intel regarding the relief requested herein and was informed that Intel objects to the motion. /s/ Steven R. Pedersen

Certificate of Service: I hereby certify that on November 16, 2011, I caused the foregoing to be electronically filed with the Clerk of the Court using the CM/ECF system which will send notification of such filing via electronic mail to all counsel of record. /s/ Steven R. Pedersen

[3] STC.UNM respectfully submits that the briefing format used for the previous terms would be proper here as well. For example, initial briefs within 14 days of an order granting this motion, and responses 10 days thereafter, limited to 6 and 4 pages, respectively.