UNITED STATES DISTRICT COURT

DISTRICT OF NEW MEXICO

STC.UNM,

Plaintiff,

v.

INTEL CORPORATION,

Defendant.

Civil No. 1:10–cv–01077–RB–WDS

INTEL'S OPPOSITION TO STC.UNM'S MOTION FOR FURTHER CLAIM CONSTRUCTION

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Introduction

On its face, STC's motion seeks construction of three additional claim terms. In reality, its motion is a thinly-disguised effort to reopen the parties' debate over the "combined mask" limitation of claim 6. The parties have already briefed that issue three times and submitted two rounds of expert reports on it. STC asks for construction of the "transferring" steps as wholes, but the parties have extensively briefed the significance of those steps as wholes. STC also wants to address dependent claim 7 (in particular the optional use of "damascene" processes to transfer patterns), but the parties stipulated months ago to the meaning of the "transferring" step of claim 7, and STC deposed Intel's expert at length about damascene processes. STC could have, and should have, presented its new evidence and arguments in its earlier briefing—and it certainly has not shown good cause for the Court to delay the progress of this case and order two more rounds of briefing and expert testimony that will make no difference to the end result.

STC's motion should therefore be denied.

Background

By Court order, the parties began the claim construction process last April by exchanging proposals for construing terms and phrases of the '998 patent asserted by STC. [*See* Dkt. 75, 86, 87] Starting in June, the parties briefed claim construction at length and over the course of three and a half months. They filed opening briefs (and extensive declarations and other supporting documents) on June 21. [Dkt. 110–113] They filed response briefs (and more declarations and supporting documents) on July 25. [Dkt. 133–135] Because STC's expert was out of the country over the summer, the parties were granted leave to file a third, supplemental set of briefs. [Dkt. 128 (amending scheduling order)] Indeed, the deadline for that supplemental briefing was

extended by two weeks to give the parties more time to incorporate expert deposition testimony given in mid-September. [*See* Dkt. 142 (stipulated time extension); Dkt. 147–149 (reply briefs and supporting documents)] Consistent with D.N.M. L.R. Civ. 7.4(e), Intel filed a notice of completion of briefing on October 7. [Dkt. 151]

All three rounds of briefing focused heavily on a key limitation of claim 6 (the only independent claim asserted) requiring both of two lithographic patterns in a semiconductor manufacturing process to be transferred into the substrate using "a combined mask including parts of said first mask layer and said second photoresist." ['998 patent col. 21, lines 42–44] Relying on the plain claim language and the corresponding portion of the specification, Intel has argued that the "combined mask" used to transfer both patterns must include portions of the second photoresist layer. [Dkt. 110 at 26; Dkt. 134 at 14–20; Dkt. 148 at 4–7] STC disagrees, arguing that the "combined mask" need not include any of the second photoresist and may be made of any combination of layers. [Dkt. 113 at 22–25; Dkt. 133 at 18–23; Dkt. 147 at 5–7]

Although the parties did not separately brief the limitations of dependent claim 7, they addressed claim 7 in correspondence and in deposition. Claim 7 reads: "The method of claim 6 wherein said transferring step includes at least one of etching, deposition and-lift off [sic], and damascene." ['998 patent col. 21, lines 47–49] Before the first round of briefs, the parties agreed not to construe it, stipulating that "said transferring step" meant "the first transferring step of claim 6, the second transferring step, or both." [Ex. A (6/20/11 email from B. Ferrall to S. Pederson)] In deposition between the second and third rounds of briefing, STC asked Intel's expert, Dr. Bruce Smith, about damascene processes and whether they were consistent with having a photoresist layer on the wafer. [*See* Dkt. 159–1] According to the asserted patent, a

damascene process involves "etching, deposition and polishing to produce an inlaid structure." ['998 patent, col. 14, lines 23–25] Dr. Smith explained that although parts of a damascene process would be done with photoresist present, the final polishing step would not. [Dkt. 159–1] STC now distorts that testimony, contending in its motion (at 2) that Dr. Smith has admitted that the second photoresist need not be present during the second transferring step, contrary to Intel's construction of the "combined mask" limitation.

Based on the dependent nature of claim 7 and Dr. Smith's supposed admission two months ago, before reply briefs were filed, STC now urges the Court to reopen claim construction. STC ostensibly seeks to brief the meaning of the "overall 'transferring' limitations" but in reality wants to reopen the debate over the "combined mask" limitation. In particular, STC's motion asks (at 3 n.3) for two more rounds of briefing. STC does not say whether it also wants to reopen expert discovery, but it presumably intends to have its own expert opine on these issues, and Dr. Smith would need an opportunity to respond.

Argument

Once a notice of completion of briefing is filed, the matters are deemed joined, and no further briefs are permitted unless the Court finds good cause to allow them. *See*, *e.g.*, *Dingman v. Donjack Enters., Inc.*, Civ. No. 05-1278 WJ/WDS, 2007 WL 4618598 (D.N.M. Jan. 26, 2007). Here, STC has not shown good cause to reopen claim construction and engage in fourth and fifth rounds of briefing and expert discovery. Although claim construction is an interlocutory process whose structure must sometimes yield to the unexpected, there is no new issue here. STC simply decided a month after the close of briefing that it wanted to offer additional evidence and to make an additional argument against Intel's construction of the "combined mask" limitation.

That evidence and argument could have, and should have, been raised in the three rounds of briefing that the Court authorized.

STC had ample opportunity to make its current argument that inclusion of damascene processes within the "transferring" steps of claim 6 is inconsistent with Intel's proposed claim constructions. In earlier briefing, both parties discussed how the "combined mask" limitation and its "parts of said first mask layer" and "parts of … said second photoresist" components should be construed in the context of the overall "transferring" step that completes claim 6. [*See*, *e.g.*, Dkt. 110 at 23–27; Dkt. 113 at 20–23; Dkt. 133 at 14, 18; Dkt. 134 at 13–14; Dkt. 147 at 4–5] The parties also addressed the import of dependent claim 7 in a stipulated construction. Moreover, STC specifically probed Intel's expert about the presence of photoresist during damascene processes in a deposition that occurred three weeks before the third round of briefing. STC either overlooked its current argument or, more likely, made a tactical choice not to raise it. Either way, it is now too late. The Court should not be burdened with four more briefs, and Intel should not be forced to bear the cost of more briefing and expert discovery.

In any event, further briefing will make no difference in the outcome because Intel's constructions and Dr. Smith's testimony are fully consistent with the optional use of damascene processes recognized in claim 7. Claim 7 says that the "transferring" step of claim 6 "includes at least one of etching, deposition and-lift off [sic], and damascene." ['998 patent col. 21, lines 42–44 (emphasis added)] Even under claim 7, damascene processes are not mandatory, and transferring may include non-damascene steps. Moreover, contrary to STC's suggestion, using a combined mask that includes both hard-mask and photoresist layers is entirely consistent with using a damascene process. The damascene processes envisioned by the patent involve etching a

pattern of trenches, depositing an inlay material such as copper, and then polishing the surface. [*See id.*, col. 14, lines 23–25] As Dr. Smith recognized, etching and deposition may take place with a photoresist layer remaining on the substrate. [*See* Dkt. 159–1] The final "transferring" step of claim 6 thus can both "*include*" damascene techniques and "*use*" a combined mask that includes a photoresist layer. As STC notes, Dr. Smith also recognized that the final polishing step of a damascene process typically takes place after the photoresist has been removed [*id.*], but that polishing is done to a pattern that has already been transferred into the substrate. Intel's proposed construction fully comports with the language of both claim 6 and claim 7, and STC's suggestion that Dr. Smith admitted otherwise is a gross distortion.

Conclusion

The issues have been fully briefed, STC waived its opportunity to make its new, last-ditch argument, and further briefing would not change the outcome in any event. STC's motion for yet more briefing should be denied, and the Court should instead proceed directly to a claim construction hearing and ruling.

Dated: November 30, 2011.

Respectfully submitted,

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Certificate of Service

The undersigned hereby certifies that on November 30, 2011, the foregoing document and its attachment were electronically filed with the Clerk of Court using the CM/ECF system, which will automatically send notification of such filing to all counsel who have entered an appearance in this action.

ATKINSON, THAL & BAKER, P.C.

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20336-1313/LEGAL22187542.4