

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

CERTAIN SEMICONDUCTOR
INTEGRATED CIRCUITS USING
TUNGSTEN METALLIZATION AND
PRODUCTS CONTAINING SAME

Inv. No. 337-TA-648

**Order No. 81: Denying Motion Of Tower Semiconductor, Inc.
And Jazz Semiconductor For Summary Determination Of
Invalidity Due To Non-Enablement**

Respondents Tower Semiconductor, Inc. and Jazz Semiconductor filed a motion for summary determination¹ of invalidity of claim 1 of U.S. Patent No. 5,227,335 ("the '335 patent") for non-enablement. (Motion No. 648-115).² The motion is opposed by complainants LSI Corporation and Agere Systems Inc. The motion is also opposed by the Commission Investigative Staff ("Staff").³

Respondents argue that claim 1 of the '335 patent is invalid because it does not comply with the enablement requirement of 35 U.S.C. § 112.⁴ See Mot. at 4. They argue that as held in

¹ The motion does not cite the Commission Rule on summary determination. Nevertheless, the procedures and standards for summary determination are set forth in 19 C.F.R. § 210.18, and are applied herein.

² The motion was presented as a cross-motion along with an opposition to complainants' motion for summary determination (Motion No. 648-86) concerning prior art. Motion No. 648-86 was denied in Order No. 80.

³ Respondents' Motion No. 648-108 for leave to reply to the responses of complainants and the Staff is granted.

⁴ To satisfy the enablement requirement of 35 U.S.C. § 112, ¶ 1, the patent specification
(continued...)

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Sitrick v. Dreamworks, LLC, 516 F.3d 993, 999 (Fed. Cir, 2008), a patent specification must teach one of ordinary skill in the art to practice the claimed invention without undue experimentation for the entire breadth of the claim. It is argued that the '335 patent fails to support claim 1 accordingly. *See* Mot. at 3, 11-12.

In particular, movants argue that while claim 1 claims a glue layer that comprises at least one member of the group consisting of conducting nitrides, the patent “only teaches how to make a functioning glue layer out of one material, namely titanium nitride. The '335 patent provides no information about how to make a functioning glue layer using any of the other unlimited combinations of materials that are included in the scope of claim 1 of the '335 patent (i.e. any combination of materials, as long as at least one of those materials is a conducting nitride).” *See id.* at 3-4.

Complainants argue that there is nothing new about the techniques used to form the glue layer at issue, and it is undisputed that in view of the disclosure in the '335 patent, “a person of ordinary skill in the art would easily know how to deposit a conducting nitride layer to form a glue layer for use with the tungsten deposited by chemical vapor deposition.” Moreover, complainants argue, movants’ argument that a patent must describe every mode of a claimed invention contradicts well-established legal precedent. *See* Opp. at 1-2, 4 (quoting *Invitrogen Corp. v. Clontech Labs., Inc.*, 429 F.3d 1052, 1070-71 (Fed. Cir. 2005)).

⁴(...continued)

must provide sufficient information so that a person of ordinary skill in the art could make and use the full scope of the claimed invention without undue experimentation. *PPG Indus., Inc. v. Guardian Indus. Corp.*, 75 F.3d 1558, 1563-65 (Fed. Cir. 1996). Enablement is a question of law that the Federal Circuit reviews independently. It is, however, based on underlying factual findings that are reviewed for clear error. *See id.*

Similarly, the Staff argues that movants acknowledge that claim 1 of the '335 patent is enabled with respect to a titanium nitride glue layer. Further, the Staff argues that it is well-settled that if a patent claim is enabled as to any mode, it satisfies the enablement requirement of 35 U.S.C. § 112. Thus, in the Staff's view, the motion for summary determination must be denied. *See* Staff Resp. at 1-2 (citing *Engel Indus., Inc. v. Lockformer Co.*, 946 F.2d 1528, 1533 (Fed. Cir. 1991)).

In their reply, respondents argue that although a patentee need only enable one mode of a product claim, in the case of a method claim, the claim must be enabled over the "full breadth" of the claimed invention. Movants appear to argue that because claim 1 pertains to an "unpredictable area of technology," it must be enabled for "every conducting nitride other than TiN."⁵ Reply at 5-6 (emphasis in original) (quoting *Invitrogen*, 429 F.3d at 1071 and *PPG Indus.*, 75 F.3d at 1563-64).

Movants' argument concerning the scope of claim 1 (*i.e.*, "unlimited combinations") raises material questions concerning the proper construction of the claim. Yet, claim construction is not fully addressed in the parties' briefs. More importantly, movants' arguments concerning a broad scope for claim 1 highlight the materiality of their legal argument that process claims must be held to a different legal standard than that applied to claims for products. That issue was not fully developed by movants' rather limited briefing.

Finally, the pending motion does not provide adequate factual evidence of the level of skill in the relevant art. It is unclear whether one of ordinary skill could, without undue experimentation, practice the claimed invention with conducting nitrides other than titanium

⁵ Titanium nitride may be represented as "TiN." *See* Mot. at 4.

nitride.

Thus, there remain genuine issues of material fact to be decided. Further, it has not been shown that movants are entitled to summary determination as a matter of law. Clearly, the standard of 19 C.F.R. § 210.18 has not been satisfied.

Accordingly, Motion No. 648-115 for summary determination is denied.

So Ordered.



Carl C. Charneski
Administrative Law Judge

Issued: May 20, 2009

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PUBLIC CERTIFICATE OF SERVICE

I, Marilyn R. Abbott, hereby certify that the attached **ORDER** has been served upon the Commission Investigative Attorney, Ret Snotherly, Esq., and the following parties as indicated, on

MAY 21 2009



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