

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TAIWAN SEMICONDUCTOR MANUFACTURING COMPANY, LTD.
and GLOBALFOUNDRIES U.S. INC.,
Petitioners,

v.

GODO KAISHA IP BRIDGE 1,
Patent Owner.

Case IPR2016-01246¹
Patent 7,126,174 B2

Before JUSTIN T. ARBES and JENNIFER MEYER CHAGNON,
Administrative Patent Judges.

ARBES, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ Case IPR2016-01247 has been consolidated with this proceeding. GlobalFoundries U.S. Inc.'s motions for joinder in Cases IPR2017-00925 and IPR2017-00926 were granted.

A conference call in the above proceeding was held on June 30, 2017, among respective counsel for Petitioner Taiwan Semiconductor Manufacturing Company, Ltd. and Patent Owner Godo Kaisha IP Bridge 1, and Judges Arbes and Chagnon. The purpose of the call was to discuss Patent Owner's request for authorization to file a sur-reply to Petitioner's Reply (Paper 21) and for an extension to DUE DATES 4–6 in the Scheduling Order (Paper 9) should a sur-reply be authorized.

Petitioner previously agreed to Patent Owner filing a sur-reply, *see* Paper 27, 3, but the parties were unable to reach agreement on the scope, word count, and timing of such briefing. Patent Owner requested authorization to file a sur-reply of up to 22,000 words (the same amount permitted for its Response in this proceeding) and new evidence, including a new declaration, by July 19, 2017. Patent Owner acknowledged that its request for 22,000 words was “highly unusual,” but argued that the amount was appropriate given the lengthy arguments made by Petitioner in its Reply and numerous exhibits submitted with the Reply. Petitioner agreed with Patent Owner's proposed deadline during the call, but argued that (1) Patent Owner should only be permitted 1500 words because Patent Owner does not object to the entire Reply, (2) Patent Owner should not be permitted to file new evidence with its sur-reply, and (3) Petitioner should be authorized to file a sur-sur-reply.

As discussed during the call and in an email to the parties on the same day, we authorized Patent Owner to file a sur-reply of up to 7000 words. *See* 37 C.F.R. §§ 42.5(a), 42.20(d). The requested sur-reply will be in response to Petitioner's Reply, which is 8843 words and 51 pages. *See* Paper 21, 51. Patent Owner stated during the call that it did not object to

approximately “the last ten pages” of the Reply. *See also* Ex. 2057, 14:21–15:1. A word count of 7000 words, therefore, corresponds roughly to the portion of the Reply to which Patent Owner objects. We are not persuaded that new evidence would be appropriate under the circumstances, given the substance of the parties’ arguments as well as the timing of this proceeding and our obligation to “secure the just, speedy, and inexpensive resolution of every proceeding.” *See* 37 C.F.R. § 42.1(b). A new declaration filed by Patent Owner, for instance, would require the opportunity for cross-examination and potentially further substantive briefing from Petitioner and/or motions for observations or to exclude. *See* Paper 9, 6 (oral argument scheduled for August 8, 2017, if requested by the parties). No further briefing other than the sur-reply is authorized at this time. Finally, we determined that Patent Owner had shown good cause for a one week extension to DUE DATES 4–6 to allow it time to prepare the sur-reply. *See* 37 C.F.R. § 42.5(c)(2).

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner is authorized to file a sur-reply, limited to 7000 words, by July 19, 2017;

FURTHER ORDERED that Patent Owner is not authorized to file new evidence with its sur-reply; and

FURTHER ORDERED that DUE DATE 4 in the Scheduling Order (Paper 9) is changed to July 12, 2017, DUE DATE 5 is changed to July 26, 2017, DUE DATE 6 is changed to August 2, 2017, and all other due dates are unchanged.

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