

Filed on behalf of Godo Kaisha IP Bridge 1

By: Neil F. Greenblum (ngreenblum@gbpatent.com)
Greenblum & Bernstein, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
Tel: 703-716-1191
Fax: 703-716-1180

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TAIWAN SEMICONDUCTOR MANUFACTURING COMPANY LIMITED,
Petitioner,

v.

GODO KAISHA IP BRIDGE 1,
Patent Owner.

Case IPR2016-01246
U.S. Patent No. 7,126,174

**PATENT OWNER'S PRELIMINARY RESPONSE
PURSUANT TO 37 C.F.R. §42.107**

Mail Stop PATENT BOARD, PTAB
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TABLE OF CONTENTS

I.	REQUESTED RELIEF	1
II.	INTRODUCTION	1
	A. Dispositive Issue In IPR2016-01246 And IPR2016-01247	2
	B. Background	3
	C. The Premise Of The Petitioner’s Argument Is Legally Insufficient ...	10
III.	RELEVANT CASE LAW	13
	A. There Must Be A Likelihood Of Invalidity.....	13
	B. The Burden Of Persuasion	13
	C. The Petitioner Bears The Burden Of Establishing A Rationale For Combining The Prior Art	14
	D. The PTO is Bound by Record Arguments Petitioner has Made	15
IV.	THE CLAIMED INVENTION OF THE ‘174 PATENT	16
V.	LEVEL OF ORDINARY SKILL	18
VI.	CLAIM CONSTRUCTION	18
VII.	THE ‘174 PATENT – RIGHT OF PRIORITY	20
VIII.	PRIOR ART.....	20
	A. U.S. Patent No. 5,153,145 (“ <i>Lee</i> ”).....	21
	B. U.S. Patent No. 5,539,229 (“ <i>Noble</i> ”)	22
	C. U.S. Patent No. 4,506,434 (“ <i>Ogawa</i> ”).....	24
IX.	ARGUMENT: <i>LEE & NOBLE</i>	25
	A. Claim 1 Of The ‘174 Patent	25
	B. Petitioner’s Rejection Of The Claims Over <i>Lee</i> In View Of <i>Noble</i> Has No Merit	26
	C. The Initial Processing Sequence Of <i>Noble</i> Is Opposite From <i>Lee</i>	27
	D. <i>Lee</i> And <i>Noble</i> Processes Are Not Compatible	33

E.	A <i>Lee-Noble</i> Rejection Fails On Further Grounds.....	38
1.	There is No Disclosure Of How L-Shaped Sidewalls Can Be Formed	38
2.	Salicidation Of <i>Lee</i>	39
F.	Conclusions Regarding The <i>Lee-Noble</i> Combination	39
X.	ARGUMENT: <i>LEE & OGAWA</i>	41
A.	<i>Lee & Ogawa</i>	42
B.	Initial Processing Sequence Of <i>Ogawa</i> Is Opposite From <i>Lee</i>	43
C.	<i>Lee</i> And <i>Ogawa</i> Processes Are Not Compatible	46
D.	Conclusions Regarding The <i>Lee-Ogawa</i> Combination	52
XI.	CONCLUSION.....	54

TABLE OF AUTHORITIES

CASES

<i>Allied Erecting and Dismantling Co., Inc. v. Genesis Attachments, LLC,</i> 825 F.3d 1373, 1381 (Fed. Cir. 2016).	14
<i>Arendi S.A.R.L. v. Apple Inc.,</i> No. 2015-2073, 2016 WL 4205964, *9 (Fed. Cir. Aug. 10, 2016)	15
<i>Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.,</i> 800 F.3d 1375, 1378 (Fed. Cir. 2015).	13
<i>In re Giannelli,</i> 739 F. 3d 1375, 1380 (Fed. Cir. 2014)	15
<i>In re Lee,</i> 277 F.3d 1338, 1345 (Fed. Cir. 2002)	14
<i>In re Warsaw Orthopedic, Inc.,</i> 2016 U.S. App. LEXIS 14560, *18 (Fed. Cir. 2016)	14, 15
<i>In re: Lemay,</i> 2016 U.S. App. LEXIS 17041, *5 (Fed. Cir. 2016).	15
<i>In Re: Magnum Oil Tools International, Ltd.,</i> 119 U.S.P.Q.2D (BNA) 1541, 1548, 1552, 1553 (Fed. Cir. 2016).	13, 14, 15
<i>Pfizer, Inc. v. Apotex, Inc.,</i> 480 F.3d 1348, 1361 (Fed. Cir. 2007)	14
<i>Phillips v. AWH Corp.,</i> 415 F.3d 1303 (Fed. Cir. 2005)	18, 19
<i>Synopsys, Inc. v. Mentor Graphics Corp.,</i> 814 F.3d 1309, 1322 (Fed. Cir. 2016)	14

STATUTES

35 U.S.C. §313.....1

REGULATIONS

37 C.F.R. § 42.100(b)18
37 C.F.R. §42.1071
37 C.F.R. §42.1081, 13
37 C.F.R. §42.108.....13
37 C.F.R. §42-100 *et seq.*1

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.