

Filed on behalf of Godo Kaisha IP Bridge 1

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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 IPR2016-01249¹
U.S. Patent No. 6,538,324

**PATENT OWNER'S MOTION FOR OBSERVATIONS REGARDING THE
CROSS-EXAMINATION OF SANJAY K. BANERJEE, PH.D.**

¹ GlobalFoundries U.S. Inc.'s motion for joinder in Case IPR2017-00919 was granted.

Pursuant to the Scheduling Order dated December 21, 2016 (Paper 8), Patent Owner provides the following observations on the cross-examination testimony of Sanjay K. Banerjee, Ph. D., a reply declarant of Petitioner. The transcript of this cross-examination testimony was previously filed as Exhibit 2044.

Observation No. 1:

In Exhibit 2044, on p. 53:3-16, the witness testified that the broadest reasonable interpretation of “composed of” as recited in the challenged claims of the ‘324 patent and the proposed Substitute Claims (together “Claims”) means “consisting essentially of” or “consisting of”:

Q So composed of can mean either consisting of or consisting essentially of, correct?

A Yes.

Id., p. 53:14-16.

The testimony is relevant to the issue of claim construction. The testimony contradicts Petitioner’s argument that “composed of” does not mean “consisting essentially of.” Reply, Paper 19, p. 6. The testimony also supports Patent Owner’s claim construction (PO Response, Paper 14, pp. 11-13), and evidences how a person of ordinary skill in the art (“POSITA”) would have understood and construed “composed of” as recited in the Claims.

Observation No. 2:

In Exhibit 2044, on p. 54:7-18, the witness testified that “composed of” as recited in the Claims of the ‘324 patent means “consisting essentially of” as stated in the MPEP (Exhibit 2012):

Q So my question is, how are you applying your understanding of the term "composed of"? Is it more in line with comprising, which is open ended, or more limited as consisting essentially of, which we saw on the previous page means it's limited to the scope of a claim to the specified materials or steps and those that do not materially affect the basic and novel characteristics of the claimed invention?

MR. KABAKOFF: Objection, form.

THE WITNESS: I interpreted that as described in page 9 [of the MPEP section, Exhibit 2012], consisting essentially of.

Id., p. 54:7-18.

The testimony is relevant to the issue of claim construction. The testimony contradicts Petitioner’s argument that “composed of” does not mean “consisting essentially of.” Reply, Paper 19, p. 6. The testimony also supports Patent Owner’s claim construction (PO Response, Paper 14, pp. 11-13), and evidences how a POSITA would have understood and construed “composed of” as recited in the Claims.

Observation No. 3:

In Exhibit 2044, on p. 56:4-13, the witness testified:

Q So we're just talking about a first film composed of crystalline metal containing nitrogen therein, and claim 11 adds the nitrogen being present throughout the first film. Again, I just want to make sure that you agree that composed of as used in that claim limitation would be properly construed to mean consisting essentially of as set forth in the MPEP section that we read, Exhibit 2012.

A Yes.

The testimony is relevant to the issue of claim construction. The testimony contradicts Petitioner's argument that "composed of" does not mean "consisting essentially of." Reply, Paper 19, p. 6. The testimony also supports Patent Owner's claim construction (PO Response, Paper 14, pp. 11-13), and evidences how a POSITA would have understood and construed "composed of" as recited in the Claims.

Observation No. 4:

In Exhibit 2044, on pp. 115:1-116:15, the witness testified that the district court's claim construction of a film being composed of crystalline metal containing nitrogen therein, which in pertinent part states that "the first film consists essentially of a mixture of crystalline or polycrystalline metal with nitrogen throughout" looks reasonable:

Q Okay. Do you disagree with the court's construction?

A As I said, I didn't analyze it in depth, but offhand it looks reasonable.

Id., p. 116:12-15.

The testimony is relevant to Petitioner's arguments regarding claim construction. Petitioner's Reply, Paper 19, pp. 2-6. The testimony is relevant because it contradicts Petitioner's claim construction arguments, and supports Patent Owner's claim construction arguments. PO Response, Paper 14, pp. 8-18.

Observation No. 5:

In Exhibit 2044, on pp. 48:6-51:12, the witness testified that "consisting essentially of" means that the material can consist of what's specified in the claim limitations and other components which do not impact those limitations, and that amorphous tantalum nitride added to a film composed of crystalline metal containing nitrogen therein would impact the properties of the film:

Q Do you understand what the definition here of consisting essentially of means?

A Yes.

Q And what does it mean to you that it limits the scope of the claim to the specified materials or steps and those that do not materially affect the basic and novel characteristics of the claimed invention?

MR. KABAKOFF: Objection, scope.

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