

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.

Inter Partes Review No. IPR2016-01249
U.S. Patent No. 6,538,324

PETITIONER'S MOTION TO EXCLUDE EVIDENCE

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As authorized under 37 C.F.R. §§ 42.64(c) and 42.61(a) and the Federal Rules of Evidence, Petitioner Taiwan Semiconductor Manufacturing Company Limited moves to exclude the following exhibits Patent Owner Godo Kaisha IP Bridge submitted, to which Petitioner timely objected:

Exhibit 2002	Excerpt from Prosecution History of U.S. Patent Application No. 08/995,108, "Amendment A" Dated February 1, 2000
Exhibit 2003	"Amorphous." Merriam-Webster.com. http://www.merriam-webster.com/dictionary/amorphous . (Accessed September 30, 2016)
Exhibit 2004	"Nitride." Merriam-Webster.com. http://www.merriam-webster.com/dictionary/nitride . (Accessed September 30, 2016)
Exhibit 2016	JP H08-250596A
Exhibit 2017	English translation of JP H08-250596A
Exhibit 2022	JP H09-293690A
Exhibit 2023	English translation of JP H09-293690A
Exhibit 2024	JP H10-125627A
Exhibit 2025	English translation of JP H10-125627A
Exhibit 2026	JP H10-256256A
Exhibit 2027	English translation of JP H10-256256A
Exhibit 2034	N. Awaya, "Semiconductor World." Feb. 1998, pp. 91-96 ("Awaya")
Exhibit 2035	English translation of Awaya
Exhibit 2037	Declaration of Harlan Rusty Harris, Ph.D. in Support of Patent Owner's Motion to Amend
Exhibit 2045	Redacted version of Invalidity Expert Report of Chris Mack without attachments

I. Exhibit 2002

Exhibit 2002 is an Amendment dated February 1, 2000, from the prosecution history of U.S. Patent Application No. 08/995,108, which issued as the prior-art *Ding* patent (Ex. 1005). Petitioner objected to Exhibit 2002 under Fed. R. Evid. 401-403 as irrelevant in its January 3, 2017, Objections. Paper 9 at 2-3. Patent Owner relies on Exhibit 2002 in Patent Owner's Preliminary Response (Paper 6 at 21, 24) and Patent Owner's Response (Paper 14 at 26).

A person of ordinary skill in the art (POSITA) could not have known about Exhibit 2002 by the effective filing date of the '324 patent (June 14, 1999) because the Exhibit was created in 2000. Further, the application that led to the *Ding* patent was made public long after the '324 patent's effective filing date, so a POSITA could not have seen Exhibit 2002 until *Ding* issued on May 3, 2005. *See* 37 C.F.R. § 1.14 ("Patent applications that have not been published under 35 U.S.C. 122(b) are generally preserved in confidence pursuant to 35 U.S.C. 122(a)"); Manual of Patent Examining Procedure (M.P.E.P.) (Rev. 2, May 2004) § 1128 at 1100-22.

Because a POSITA could not have considered Exhibit 2002 by the filing date of the '324 patent, the date on which the test for obviousness occurs (pre-AIA 35 U.S.C. § 103(a)), Exhibit 2002 is irrelevant and the Board should exclude it. Fed. R. Evid. 401-403.

II. Exhibits 2003 and 2004

Exhibits 2003 and 2004 are printouts of online dictionary definitions of “amorphous” and “nitride” dated September 30, 2016, from Merriam-Webster.com. Petitioner objected to these exhibits under Fed. R. Evid. 401-403 as irrelevant. Paper 9 at 3-4. Patent Owner relies on these definitions in Patent Owner’s Preliminary Response (Paper 6 at 15) and Patent Owner’s Response (Paper 14 at 15).

Petitioner moves to exclude these 2016 printouts because Patent Owner has not established these definitions were publicly available to a POSITA by the effective filing date of the ’324 patent. Without such proof, these exhibits are irrelevant to how a POSITA would have understood these terms at the relevant time. *See, e.g., Brookhill-Wilk 1, LLC. v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1299 (Fed. Cir. 2003) (References “not contemporaneous with the patent, do not reflect the meanings that would have been attributed to the words in dispute by persons of ordinary skill in the art as of the grant of the ... patent”).

Moreover, these definitions are cumulative of other dictionary definitions for “amorphous” and “nitride” that Patent Owner filed as Exhibits 2008 and 2009. Fed. R. Evid. 401-403. The Board should exclude Exhibits 2003 and 2004.

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