

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 LIMITED,
and GLOBALFOUNDRIES U.S. INC.,
Petitioners,

v.

GODO KAISHA IP BRIDGE 1,
Patent Owner.

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

**PATENT OWNER'S REPLY TO PETITIONER'S OPPOSITION TO
PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE**

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

I. EXHIBIT 1037 SHOULD BE EXCLUDED

A. Petitioner Has Not Properly Authenticated Exhibit 1037

Fed. R. Evid. 901 requires that the proponent produce sufficient evidence to support a finding that an item is what the proponent claims it is. Petitioner has not produced sufficient evidence to authenticate Exhibit 1037. Accordingly, for the reasons set forth in Patent Owner's Motion To Exclude Evidence (Paper 29), Exhibit 1037 should be excluded for lack of authentication under FRE 901.

B. Exhibit 1037 Contains Inadmissible Hearsay

Petitioner asserts that statements offered to show knowledge are not hearsay, citing *United States v. Figueroa*, 818 F.2d 1020, 1026-1027 (1st Cir. 1987). In *United States v. Figueroa*, the court stated:

In the case at bar, the record adequately evinces that Malfi's testimony concerning Venuti's statements was not aimed at establishing the veracity of those remarks. Indeed, the truth or falsity of what Venuti is alleged to have said--e.g., that his counterfeit was of better quality than Figueroa's, that it would be easier to pass, etc.--was altogether immaterial to the case and to the purpose for which the evidence was introduced. Rather, Malfi's testimony was offered as evidence of the defendant's knowledge of, and sophistication in, the counterfeiting industry.

Id. at 1026-27.

The facts in *United States v. Figueroa* are completely different from the present case. In *United States v. Figueroa*, the testimony was “offered as evidence of the defendant's knowledge of, and sophistication in, the counterfeiting industry.” *Id.*

In the present case, Petitioner is not merely relying on Patent Owner’s alleged knowledge of the existence of Exhibit 1037. Rather, Petitioner’s entire argument is based on the alleged truth of the matters asserted in Exhibit 1037. For example, Petitioner asserts: “The fact that the invalidity claim charts mapped each of these prior-art references to the ‘324 patent claims on an element-by-element basis establishes their materiality.”

Petitioner’s Opposition To Patent Owner’s Contingent Motion To Amend (Paper 20), p. 3.

No evidence or testimony has been provided establishing the materiality of any of the prior art references cited in Exhibit 1037, or the truth of any of the statements or assertions contained in Exhibit 1037.

Indeed, Petitioner’s expert did not even discuss Exhibit 1037 or the documents Petitioner asserts are of interest (other than to mention that they were reviewed). Patent Owner’s Reply To Petitioner’s Opposition To Patent Owner’s Contingent Motion To Amend (Paper 25), pp.6-7. Petitioner’s

argument therefore depends on the truth of the matters asserted in Exhibit

1037.

Exhibit 1037 is hearsay under FRE 802 and not subject to any of the FRE 803 hearsay exceptions. Petitioner's reliance on the contentions for the truth of any of the matters presented therein constitutes impermissible hearsay. *Shimano, Inc. v. Globeride, Inc.*, IPR2015-00273, Paper 40, at 27 (PTAB 2016).

Accordingly, Exhibit 1037 should be excluded as inadmissible hearsay under FRE 802.

II. CONCLUSION

For the reasons discussed herein and in Patent Owner's Motion To Exclude Evidence (Paper 29), the Board should exclude Exhibit 1037.

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Respectfully Submitted by:

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the foregoing:

**PATENT OWNER'S REPLY TO PETITIONER'S OPPOSITION TO
PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE**

was served by electronic mail on this 2nd day of August, 2017, upon Counsel for

Petitioners, as follows:

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