

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

For the reasons in Petitioner's Motion to Exclude and below, the Board should exclude each of the following Patent Owner Exhibits.

I. Exhibit 2002

The attorney comments from *Ding's* file history (Exhibit 2002) are irrelevant because they were not available to a person of ordinary skill in the art (POSITA) as of the '324 patent's effective filing date. *Ding's* prior-art status under pre-AIA 35 U.S.C. § 102(e) only extends to *Ding's* disclosure and not its file history. See M.P.E.P. 2136.02(II). The cases Patent Owner cites address circumstances where references dated after a patent's priority date can show a POSITA's knowledge about general understanding of facts related to the state of the art, but they do not permit ascribing to a POSITA knowledge of attorney comments about a narrow concept in a prior-art patent that was kept secret in the Patent and Trademark Office. Since *Ding's* prosecution history was not publicly accessible until well after the 1999 effective filing date of the '324 patent (i.e., when the *Ding* patent issued in 2005), these statements would not have been available to a POSITA at the relevant time, so the Board should exclude Exhibit 2002. Fed. R. Evid. 401-403.

II. Exhibits 2003 and 2004

Patent Owner never demonstrates how online dictionaries from 2016 (Exhibits 2003 and 2004) would indicate the knowledge of a POSITA in 1999.

Phillips v. AWH Corp., 415 F.3d 1303, 1312 (Fed. Cir. 2005) (a claim term is to be

construed at the time of the invention). The Board must construe claims in a “temporal context” at the time of the invention. *Brookhill-Wilk 1, LLC. v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1299 (Fed. Cir. 2003) (refusing to consider dictionary and treatise from “unrelated and non-contemporaneous [online] authorities...dated well after the [patent-in-suit]” in its *de novo* claim construction analysis). *Google Inc. v. Intellectual Ventures II LLC*, IPR2014-01031, Paper 41 (Dec. 7, 2015) did not address “Intellectual Ventures’s temporal concern,” as Patent Owner asserts, but only whether the online dictionary was irrelevant or hearsay.

Patent Owner submitted replacement definitions (Exhibits 2008 and 2009) from dictionaries contemporaneous with the ’324 patent, yet for some unknown reason refuses to withdraw Exhibits 2003 and 2004. These exhibits are cumulative, and the Board should exclude them. Fed. R. Evid. 401-403.

III. Exhibits 2016, 2017, 2022-2027, 2034, and 2035

The MultiLing translator affidavits in Exhibits 2017, 2023, 2025, 2027, and 2035 fail to set forth “that all statements made of the declarant’s own knowledge are true and that all statements made on information and belief are believed to be true” as 37 C.F.R. § 1.68 required. Patent Owner does not disagree or offer any statements in these affidavits to satisfy this requirement. *See* Paper 36, at 5.

The MultiLing affidavits also fail to provide any evidence the affiant, Mr. Degn (a sales and marketing professional) had personal knowledge or could testify

to the statements in the affidavits. Affidavits must be made on personal knowledge and show the affiant is competent to testify to matters in those documents. *See Townsend Eng'g Co. v. Hitec Co.*, 1986 WL 13708 (N.D. Ill. 1986), *aff'd* 829 F.2d 1086 (Fed. Cir. 1987) (striking translations because the translator affidavit failed to set forth affiant's qualifications, and its statement regarding the translations' accuracy was insufficient because the affidavit was not based on his personal knowledge and did not establish his qualifications). The MultiLing affidavits have no information about the translators, their qualifications, or how they prepared the translations. Nor do the MultiLing affidavits explain the verification of the translations, so the affidavits do not properly certify the corresponding translations. The Board should exclude the affidavits (Exhibits 2017, 2023, 2025, 2027, 2035) and their corresponding translations (Exhibits 2016, 2022, 2024, 2026, 2034).

IV. Paragraph 83 (d-n, v, w) in Exhibit 2037

Although Patent Owner avers Dr. Harris's declaration (Ex. 2037) is based entirely on sufficient facts and data, Patent Owner neglected to address the portions Petitioner seeks to exclude, Paragraph 83 sub-parts d-n, v, and w. In those portions, Dr. Harris opined whether Exhibits 2014-2027, 2030-2035, 2039, and 2040 invalidate the Substitute Claims, but his opinions lack any supporting analysis, especially in view of the fact the invalidity report (Exhibit 2047) Patent Owner filed with its opposition maps certain references to the claims.

For example, Exhibit 2047 shows Patent Owner knew that defendants in that related lawsuit Patent Owner brought, asserted *Nogami* as anticipating claims 1, 3, 5, 7 and 9 of the '324 patent. Those defendants mapped *Nogami*'s top layer 16 to a "first film consist[ing] essentially of a mixture of crystalline or polycrystalline metal with nitrogen *throughout*." Ex. 2047, 36, 40-42 (emphasis added). Substitute Claims 11-13 seek to add the "throughout" limitation Patent Owner knew *Nogami* disclosed, but Dr. Harris provided no facts or analysis in Paragraph 83, sub-part v of Exhibit 2037 to distinguish *Nogami* alone or in view of *Zhang* and *Ding*.

Because Dr. Harris's opinions on Exhibits 2014-2027, 2030-2035, 2039, and 2040 are not based on substantial facts or data, the Board should exclude Paragraph 83, sub-parts d-n, v, and w in Exhibit 2037, which are the only paragraphs addressing these exhibits, under Fed. R. Evid. 702 and Rule 42.65(a).

V. Exhibits 2045 (redacted) and 2047 (unredacted)

Exhibit 2045, an invalidity expert report from a related district court litigation, is irrelevant because it has no bearing on Patent Owner's duty to distinguish the Substitute Claims from all prior art known to the Patent Owner.

Patent Owner contends the invalidity expert report shows "Exhibits 1025-1031 were not relied on in the expert report, evidencing that they are not material," but this is not the proper standard for determining materiality. For one, the claims addressed in that report are not the same as the proposed Substitute Claims. Patent

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