

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 IPR2016-01249
Patent No. 6,538,324

PETITIONER'S OBJECTIONS TO PATENT OWNER'S EXHIBITS 2001-2004

Pursuant to 37 C.F.R. § 42.64(b)(1), Petitioner objects to the following

Patent Owner exhibits:

2001	Chang, C.C., Chen, J.S. and Hsu, W.S., “Failure Mechanism of Amorphous and Crystalline Ta-N Films in the Cu/Ta-N/Ta/SiO ₂ Structure.” <i>Journal of The Electrochemical Society</i> , 151 (11), pp. G746-G750 (2004).
2002	Excerpt from Prosecution History of U.S. Patent Application No. 08/995,108, “Amendment A” Dated February 1, 2000.
2003	“Amorphous.” Merriam-Webster.com. http://www.merriam-webster.com/dictionary/amorphous . (Accessed September 30, 2016)
2004	“Nitride.” Merriam-Webster.com. http://www.merriam-webster.com/dictionary/nitride . (Accessed September 30, 2016)

I. Exhibit 2001

Petitioner objects to Exhibit 2001 under Federal Rules of Evidence (FRE) 401-403 and 802. To the extent Patent Owner relies on Exhibit 2001 for the truth of the information printed in this exhibit, Petitioner objects to it as inadmissible hearsay. FRE 802.

Patent Owner cites Exhibit 2001 for a single sentence: “Tantalum nitride can be crystalline or amorphous depending upon how it is deposited.” Patent Owner’s Preliminary Response (POPR) at 6; *see also id.* at 28, 30, 31, 35, and 53. The description in this sentence is cumulative to the challenged ’324 patent, which also discloses that tantalum nitride can be crystalline or amorphous depending on how it is deposited, such as by varying the nitrogen gas ratio. *See Ex. 1001 at 12:11-32.*

Thus, Exhibit 2001 is irrelevant because it needlessly presents cumulative information. FRE 401-403.

II. Exhibit 2002

Petitioner objects to Exhibit 2002 under FRE 401-403 as irrelevant because it was not in the prior art as of the U.S. filing date (June 19, 2000) or the foreign priority filing date (June 24, 1999) of the '324 patent. Regardless of whether the '324 patent is entitled to its claim of foreign priority, a person of ordinary skill in the art would not have had access to Exhibit 2002 as of the '324 patent's earliest effective filing date and, therefore, would not have referred to this exhibit to interpret any terminology in the prior-art *Ding* patent (U.S. 6,887,353) as Patent Owner contends. *See, e.g.*, POPR at 21, 24.

Exhibit 2002 is an Amendment dated February 1, 2000, from the prosecution history of the patent application that eventually issued as the *Ding* patent. According to the USPTO Public PAIR system, this application was never published before issuance. As a result, the prosecution history in the *Ding* application would not have been available to persons of ordinary skill in the art until after the *Ding* patent 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

persons of ordinary skill in the art could not have accessed Exhibit 2002 before 2005, this exhibit is irrelevant to how a person of ordinary skill in the art, as of June 19, 2000, or earlier, would have understood anything in the *Ding* or '324 patents at the relevant time period. FRE 401-403.

Petitioner also objects to Exhibit 2002 as irrelevant under FRE 401-403 because this portion of the prosecution history does not modify or override the express teachings in the *Ding* patent. Because *Ding* qualifies as prior art under pre-AIA 35 U.S.C. 102(e), the disclosure of *Ding* being relied upon must be present in the issued patent. M.P.E.P. 2136.02(II); *see also* M.P.E.P. 2136.02(III) (explaining pre-AIA 102(e) prior art may be used in obviousness rejections). Accordingly, Exhibit 2002 is irrelevant. FRE 401-403.

III. Exhibits 2003 and 2004

Petitioner objects to Exhibits 2003 and 2004 under FRE 401-403 as irrelevant because they were not in the prior art as of the U.S. filing date (June 19, 2000) or the foreign priority filing date (June 24, 1999) of the '324 patent. Exhibits 2003 and 2004 are printouts of certain online dictionary definitions dated September 30, 2016. Patent Owner has not established that these definitions were available to a person of ordinary skill in the art as of the U.S. or claimed foreign-priority filing dates of the '324 patent, or that a person of ordinary skill in the art

would have referred to either of these definitions to interpret any terminology in the '324 patent in the relevant time period. FRE 401-403.

Petitioner also objects to Exhibits 2003 and 2004 because Patent Owner has not submitted evidence to authenticate either of these exhibits. FRE 901.

Respectfully submitted,

Dated: January 3, 2017

By: / Stephen E. Kabakoff/
Stephen E. Kabakoff
Reg. No. 51,276
Counsel For Petitioner

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