

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
Case IPR2016-01264
Patent 6,538,324 B1¹

Before JUSTIN T. ARBES, MICHAEL J. FITZPATRICK, and
JENNIFER MEYER CHAGNON, *Administrative Patent Judges*.

FITZPATRICK, *Administrative Patent Judge*.

ORDER
Management of the Record
37 C.F.R. § 42.7

¹ This Order employs a joint caption, as it governs both of the identified *inter partes* reviews. The parties may not use a joint caption unless authorized.

IPR2016-01249
IPR2016-01264
Patent 6,538,324 B1

After each of these *inter partes* reviews was instituted, Petitioner, Taiwan Semiconductor Manufacturing Company Limited, filed objections to evidence filed by Patent Owner, Godo Kaisha IP Bridge 1. *See* Paper 9 (objecting to the admissibility of Exhibits 2001–2004).² In response to those objections, Patent Owner filed supplemental evidence (namely, Exhibits 2005–2007), a Notice of Supplemental Evidence (Paper 10), and an updated list of Patent Owner’s exhibits (Paper 11). Petitioner conferred with Patent Owner regarding the propriety of Patent Owner’s filing of Exhibits 2005–2007 and Papers 10 and 11, and the parties remained in disagreement. A Petitioner-requested conference call was held January 19, 2017, among counsel for both sides and the panel.

During the call, Petitioner argued that Exhibits 2005–2007 and Papers 10 and 11 should be expunged, contrasting the express language of 37 C.F.R. § 42.64(b)(1) and (2). *See id.* at (b)(1) (“Any objection to evidence submitted during a preliminary proceeding must be filed within ten business days of the institution of the trial.”), (b)(2) (“The party relying on evidence to which an objection is timely served may respond to the objection by serving supplemental evidence within ten business days of service of the objection.”) (emphasis added).

Patent Owner argued that, although 37 C.F.R. § 42.64(b)(2) expressly refers only to serving supplemental evidence, the rule does not prohibit filing supplement evidence.

² All citations in this Order apply with respect to both *inter partes* reviews.

As explained during the call, we view 37 C.F.R. § 42.64(b)(2) as authorizing the service, but not filing, of supplemental evidence in response to objections. The rule does not require (or authorize) the filing of supplemental evidence at the time it must be served. This is so because it is contemplated that, in some instances, supplemental evidence will cure objections to the satisfaction of the objecting party. In those instances, the supplemental evidence never becomes relevant to any issue that must be decided by the panel. In other instances, supplemental evidence served on an objecting party may not cure the objections to the satisfaction of the objecting party, and the objecting party may thereafter file a motion to exclude. If the evidence-proffering party opposes the motion to exclude, it may file supplemental evidence (assuming it had been previously timely served) to support the arguments for admissibility it makes in its opposition brief. *See* 37 C.F.R. § 42.6(c) (“Each exhibit must be filed with the first document in which it is cited except as the Board may otherwise order.”). In sum, we agree with Petitioner’s view that 37 C.F.R. § 42.64(b)(2) does not authorize filing of supplemental evidence in response to objections.

Patent Owner also argued that other panels, in non-precedential decisions, have allowed the filing of supplemental evidence in response to objections, and that no prejudice would result from leaving Exhibits 2005–2007 and Papers 10 and 11 in the record. We did not ask Patent Owner to identify any such non-precedential decisions, as they would not be binding on us. Indeed, Patent Owner acknowledged that any such decisions would not bind us and conceded that other panels have interpreted 37 C.F.R. § 42.64(b)(2) as we are interpreting it. Also, the existence (or not) of

IPR2016-01249
IPR2016-01264
Patent 6,538,324 B1

prejudice to the objecting party does not control whether a party is authorized to file a paper or exhibit.

Patent Owner was not authorized to file Exhibits 2005–2007 and Papers 10 and 11. We have the authority to expunge them. 37 C.F.R. § 42.7(a).

Accordingly, it is ORDERED that Exhibits 2005–2007 and Papers 10 and 11 be expunged from each of the *inter partes* reviews.

IPR2016-01249
IPR2016-01264
Patent 6,538,324 B1

PETITIONER

E. Robert Yoches
Stephen Kabakoff
Joshua Goldberg
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
bob.yoches@finnegan.com
Stephen.kabakoff@finnegan.com
joshua.goldberg@finnegan.com

PATENT OWNER

Michael Fink
Neil Greenblum
Arnold Turk
GREENBLUM & BERNSTEIN, P.L.C.
mfink@gbpatent.com
ngreenblum@gbpatent.com
aturk@gbpatent.com