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 Nos. IPR2016-01264 and IPR2016-01249

PETITIONER'S OPPOSITION TO PATENT OWNER'S CONTINGENT MOTION TO AMEND FOR *INTER PARTES* REVIEW OF UNITED STATES PATENT NO. 6,538,324

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I. INTRODUCTION

Petitioner files this Opposition to Patent Owner's Contingent Motion to Amend proposing Substitute Claims 11-13, in which Patent Owner seeks to amend independent claim 5 and dependent claims 7 and 9 to require nitrogen content throughout the claimed "first film" and in contact with a copper layer. Patent Owner fails to meet its burden—procedurally and substantively—of establishing that the Substitute Claims are novel, non-obvious, and supported by the '324 patent's written description.

II. PATENT OWNER OMITS MATERIAL PRIOR ART FROM ITS ANALYSIS

Patent Owner fails to comply with the requirements for filing a Motion to Amend as set forth in the Board's decisions in *Idle Free Systems, Inc. v. Bergstrom Inc.*, IPR2012-00027, Paper 26 (June 11, 2013) (informative) and *MasterImage 3D, Inc. v. Reald Inc.*, IPR2015-00040, Paper 42 (July 15, 2015) (precedential). For at least this reason alone, the Board should deny Patent Owner's motion.

The Board has articulated a procedure for properly offering substitute amended claims under 37 C.F.R. § 42.121: "For each proposed substitute claim, we expect a patent owner: (1) in all circumstances, to make a showing of patentable distinction over the prior art . . . ." *Idle Free* at 6-7. "The burden is not on the petitioner to show unpatentability, but on the patent owner to show patentable distinction over the prior art of record and also prior art known to the

patent owner." *Id.* at 7. In *MasterImage 3D*, the Board clarified that "prior art known to the patent owner" refers to material prior art that Patent Owner makes of record pursuant to its duty of candor and good faith under 37 C.F.R. § 42.11. *MasterImage 3D* at 3. This is not limited to only material prior art in the prosecution history or of record in PTO proceedings. *Id.* at 2-3.

While Patent Owner represents to the Board that the Substitute Claims are patentable over "all prior art known to Patent Owner" (Motion at 16), it fails to mention several material prior-art references it was aware of from the related district-court litigation, let alone show any patentable distinction over them.

Patent Owner possessed detailed invalidity claim charts mapping the challenged '324 patent claims 1, 3, 5, 7, and 9 to prior art identified in the related litigation. Ex. 1037 (June 20, 2016, Patent Rule 3-3 Invalidity Contentions) at 2, 26-28, 60-229 (invalidity claim charts B-1 to B-15 served on Patent Owner as part of invalidity contentions in the related district court litigation). Patent Owner fails to mention at least the following relevant prior art from those contentions:

- UK Patent 2,298,657 (Exhibit 1025) in chart B-1;
- US 5780908 (Exhibit 1026) in chart B-3;
- US 5869902 (Exhibit 1027) in chart B-4;
- US 5882399 (Exhibit 1028) in chart B-5;
- US 6057237 (Exhibit 1029) in chart B-7;

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