

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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Taiwan Semiconductor Manufacturing Company Limited  
Petitioner,

v.

Godo Kaisha IP Bridge 1  
Patent Owner.

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*Inter Partes* Review No. IPR2016-01264  
U.S. Patent No. 6,538,324

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**PETITIONER'S REQUEST FOR ORAL ARGUMENT**

Pursuant to 37 C.F.R. § 42.70(a) and in accordance with the Board's Scheduling Order dated December 21, 2016 (Paper 8), Petitioner Taiwan Semiconductor Manufacturing Company Limited ("TSMC") respectfully submits this Request for Oral Argument. The Board has currently scheduled the oral argument in IPR2016-01264 for August 8, 2017 (Paper 8 at 7).

TSMC specifies the following issues to be argued during oral argument:

- Whether claims 1-3, 5-7, and 9 of U.S. Patent No. 6,538,324 are unpatentable under pre-AIA 35 U.S.C. § 103 as obvious over *Zhang* in view of *Ding*;
- Whether claims 1-3, 5-7, and 9 of the '324 patent are unpatentable under pre-AIA 35 U.S.C. § 103 as obvious over *Zhang* in view of *Ding* and in further view of *Sun*;
- The proper construction of independent claims 1 and 5, including the claim term "first film being composed of crystalline metal containing nitrogen therein";
- Whether Patent Owner failed to comply with the requirements for filing a Motion to Amend when it failed to disclose several material prior-art references known to it from the related district court litigation;

- Whether substitute claims 11-13 in Patent Owner’s Contingent Motion to Amend are obvious over the instituted grounds of (1) *Zhang* in view of *Ding* and (2) *Zhang* in view of *Ding* and in further view of *Sun*;
- Whether substitute claims 11-13 are obvious over *Zhang* in view of *Ding* and in further view of *Chiang* and/or *Nogami*;
- Whether substitute claims 11-13 are obvious over *Zhang* in view of *Ding* and *Sun* and in further view of *Chiang* and/or *Nogami*;
- The proper construction of substitute claim 13, including the language “solid solution”;
- Whether substitute claim 13 lacks written description support in the ’324 patent;
- Any issues identified in Patent Owner’s Request for Oral Hearing;
- Any issues raised in either party’s Motions to Exclude; and
- Any other issues the Board deems necessary for issuing a final written decision.

The Board has schedule oral hearing for this proceeding on the same day as the related IPR2016-01249 proceeding between the same parties concerning the same patent. The proceedings are summarized in the table below:

<u>Proceeding</u>	<u>Patent</u>	<u>Oral Argument</u>	<u>Ground</u>
IPR2016-01249	U.S. 6,538,324	August 8, 2017	Ding and Zhang
IPR2016-01264	U.S. 6,538,324	August 8, 2017	Zhang and Ding
			Zhang, Ding, and Sun

Petitioner requests that these two proceedings be argued in a single consolidated hearing to eliminate any redundant arguments. Petitioner further requests 45 minutes of argument time for the proposed consolidated hearing. But to the extent the Board schedules the hearing to last longer than 90 minutes, Petitioner requests half the length of the hearing be allocated to Petitioner to address these issues.

Finally, Petitioner requests that ten spaces be reserved at the oral hearing to accommodate its counsel and corporate representatives. Petitioner also requests that two attorneys at Petitioner's counsel's table be allowed to use computers at the hearing (in addition to the counsel making the argument using his or her computer to show the demonstratives), to avoid the need for the parties to bring entire paper copies of the record into the hearing room and to facilitate efficient answering of panel questions.

Respectfully submitted,

Dated: July 12, 2017

By: /E. Robert Yoches/  
E. Robert Yoches,  
Lead Counsel  
Reg. No. 30,120

**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that the foregoing **PETITIONER'S REQUEST FOR ORAL HEARING** was served on July 12, 2017, via electronic mail directed to counsel of record for the Patent Owner at the following:

Michael J. Fink (Reg. No. 31,827)  
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Patent Owner has agreed to electronic service.

Dated: July 12, 2017

By: /Lauren K. Young/  
Lauren K. Young  
Litigation Legal Assistant  
FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.