

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TAIWAN SEMICONDUCTOR MANUFACTURING COMPANY, LTD. and
GLOBALFOUNDRIES U.S. INC.,
Petitioners,

v.

GODO KAISHA IP BRIDGE 1,
Patent Owner.

Case No. IPR2016-01376¹
Patent Number 6,197,696

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

**PATENT OWNER'S IDENTIFICATION OF ARGUMENTS EXCEEDING
THE PROPER SCOPE OF REPLY**

¹ GlobalFoundries U.S. Inc., who filed Petition IPR2017-00921, has been joined as a petitioner in this proceeding.

Pursuant to the Board’s August 18, 2017, email authorizing this paper, Patent Owner Godo Kaisha IP Bridge 1 identifies the following portions of Petitioner’s Reply (Paper 26) that exceed the proper scope of reply relative to Patent Owner’s Response, Paper 19 (“POR”):²

1. Petition lacked priority argument: Reply 14:8-22:15; Ex. 1036; Ex. 1037; Ex. 1038; Ex. 1049 ¶¶37-54.
2. New priority arguments: Reply at 17 (sentence beginning “Layer 58...” and the citation that follows), 19 (sentence beginning “Photoresist layer 62 ...” and the citations that follow), 21:4-15; Ex. 1036; Ex. 1037; Ex. 1038; Ex. 1049 ¶¶46-52.
3. New combination/success arguments: Reply 22:16-23:2; Ex. 1039; Ex. 1040.
4. New combination/success arguments: Reply 27:15-28:5; Ex. 1039; Ex. 1040; Ex. 1049 ¶¶66-68.

² Citations to Petitioner’s Reply are in the format of page:lines.

Respectfully submitted by:

Dated: August 23, 2017

/James L. Davis, Jr./

Andrew N. Thomases (lead
counsel) - Reg. No. 40,841
ROPES & GRAY, LLP
1900 University Ave., 6th Floor
East Palo Alto, CA 94303
(650) 617-4000/F: 617-235-9492
andrew.thomases@ropesgray.com

Jordan M. Rossen
Reg. No. 74,064
ROPES & GRAY LLP
2099 Pennsylvania Ave., NW
Washington D.C. 20006-6807
P: 202-508-4759/F: 617-235-9492
jordan.rossen@ropesgray.com

J. Steven Baughman
Reg. No. 47,414
Paul, Weiss, Rifkind, Wharton &
Garrison LLP
2001 K Street, NW
Washington, DC 20006-1047
P: 202-223-7340/F: 202-403-3740
sbaughman@paulweiss.com

James L. Davis, Jr.
Reg. No. 57,325
ROPES & GRAY LLP
1900 University Avenue, 6th
Floor
East Palo Alto, CA 94303-2284
P: 650-617-4794/F: 617-235-9492
james.l.davis@ropesgray.com

Attorneys For Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that this PATENT OWNER'S IDENTIFICATION OF ARGUMENTS EXCEEDING THE PROPER SCOPE OF REPLY was served by filing this document through the Patent Trial and Appeal Board PTAB E2E, as well as providing a courtesy copy via e-mail to the following attorneys of record for the Petitioner listed below:

Petitioner TSMC's Counsel of Record:

Darren M. Jiron, Darren.jiron@finnegan.com
E. Robert Yoches, bob.yoches@finnegan.com
J. Preston Long, j.preston.long@finnegan.com
Joshua L. Goldberg, Joshua.Goldberg@finnegan.com

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
ATTN: Patent Administration, Two Freedom Square, 11955 Freedom Drive,
Reston, VA 20190-5675

Petitioner GlobalFoundries's Counsel of Record:

Christopher Carroll, christopher.carroll@whitecase.com
75 State St, Boston, MA 02109-1814
Shamita Etienne-Cummings, setienne@whitecase.com
701 Thirteenth St NW, Washington, DC 20005-3807

WHITE & CASE, LLP

Dated: August 23, 2017

Respectfully submitted,

By: /Crena Pacheco/
Name: Crena Pacheco

ROPES & GRAY LLP