

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Taiwan Semiconductor Manufacturing Company, Ltd.

Petitioner

v.

Godo Kaisha IP Bridge 1

Patent Owner

Patent No. 6,197,696
Filing Date: March 23, 1999
Issue Date: March 6, 2001

Title: METHOD FOR FORMING INTERCONNECTION STRUCTURE

Inter Partes Review No. IPR2016-01378

PETITIONER'S REPLY UNDER 37 C.F.R. § 42.108(c)

Table of Authorities

Cases

<i>Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.</i> , 800 F.3d 1375 (Fed. Cir. 2015).....	1, 2, 3
<i>Goeddel v. Sugano</i> , 617 F.3d 1350 (Fed. Cir. 2010)	2
<i>In re Magnum Oil Tools Int’l, Ltd.</i> , 829 F.3d 1364 (Fed. Cir. 2016)	2, 3
<i>Tech. Licensing Corp. v. Videotek, Inc.</i> , 545 F.3d 1316 (Fed. Cir. 2008).....	1, 2, 3

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35 U.S.C. § 102(e)	1
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Other Authorities

<i>Alarm.com Inc. v. Vivint, Inc.</i> , 2016IPR-00129, Paper 13 (May 3, 2016)	3
<i>Core Survival, Inc. v. S&S Precision, LLC</i> , PGR2015-00022, Paper 8 (Feb. 19, 2016).....	1, 2, 3
MPEP §201.15 (7th ed. July 1998).....	3
<i>Polaris Wireless, Inc. v. TruePosition, Inc.</i> , IPR2013-00323, Paper 9 (Nov. 15, 2013).....	2

TSMC's petition satisfied its initial burden of production by showing that *Grill*, on its face, is prior art under §102(e). Even though the law did not require it, TSMC referenced examples of evidence showing that the '696 patent is not entitled to the benefit of foreign priority and that *Grill* is entitled to the filing date of its provisional. *See Core Survival, Inc. v. S&S Precision, LLC* PGR2015-00022, Paper 8, at 8-9 (Feb. 19, 2016).

In its POPR, Patent Owner IPB did not offer the requisite §112 support for all limitations of the claims to establish foreign priority for the '696 patent. Instead it argued that TSMC failed to prove the '696 patent is not entitled to foreign priority. Thus, IPB defies the well-established burden framework and erroneously implies the '696 patent is presumptively entitled to foreign priority.

Once Petitioner shows a reference is prior art, the burden then shifts to Patent Owner to show the challenged claim benefits from a filing date before the prior art. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1379 (Fed. Cir. 2015); *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1327 (Fed. Cir. 2008) [*TLC*]. This requires showing "not only the existence of the earlier application, but why the written description in the earlier application supports the claim." *Drinkware*, 800 F.3d at 1379 (quoting *TLC*, 545 F.3d at 1327). Where there is a foreign priority claim, Patent Owner must identify §112 support in the priority document for all limitations of the claims. *See Goeddel v. Sugano*, 617

F.3d 1350, 1353–54 (Fed. Cir. 2010). Only if Patent Owner makes this showing does the burden then shift back to Petitioner to rebut Patent Owner’s arguments or to show the prior art benefits from an earlier filing date. *Drinkware*, 800 F.3d at 1379–80; *TLC*, 545 F.3d at 1327–28. This burden-shifting framework is “warranted because the patentee affirmatively seeks to establish a proposition not relied on by the patent challenger and not a necessary predicate for the unpatentability claim asserted—effectively an affirmative defense.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1376 (Fed. Cir. 2016).

IPB attempts to avoid its burden of properly establishing foreign priority for the ’696 patent by attacking examples of why the ’696 patent is not entitled to priority, which TSMC did not even need to provide. *See Core Survival* at 8-9. IPB relies on *Polaris Wireless, Inc. v. TruePosition, Inc.*, IPR2013-00323, Paper 9 (Nov. 15, 2013), hoping to meet its burden by simply criticizing these examples TSMC identified as limitations lacking support. It cannot, according to the *Drinkware/TLC* framework. And the Board has rejected other propositions IPB seeks to derive from *Polaris*. *See Core Survival* at 8-10 & n.3 (rejecting the notion, based on *Polaris*, that a document is not prior art if the Petitioner fails to show the challenged patent is not entitled to priority). The Board did not find “any support in [*Polaris*] for the proposition that a Petitioner has any initial burden to contest entitlement to a provisional filing date,” and “the only showing Petitioner needed

to make is that ‘the art must have existed as of the date of invention, presumed to be the filing date of the application until an earlier date is proved.’” *Id.* at 8-9.

IPB’s arguments amount to requiring TSMC to *disprove* foreign priority, which would result in presumptive entitlement to foreign priority. But the Federal Circuit has rejected as unsound the notion that a patent can be presumed to benefit from an earlier filing date when the PTO did not examine the priority document. *Drinkware*, 800 F.3d at 1380. Claims for foreign priority fall into that category. MPEP §201.15 (7th ed.) (now §215). And, contrary to IPB’s suggestion, notice of a priority claim on the patent does not require Petitioner to disprove foreign priority, because *TLC* involved a priority claim (to a CIP, where earlier benefit is not automatic) on the face of the patent. *See* 545 F.3d at 1321 & n.2, 1327–28.

TSMC’s petition was not required to show that *Grill* benefits from its provisional filing date, and IPB’s reliance on *Alarm.com Inc. v. Vivint, Inc.* is misplaced. The reference there did not predate the challenged patent, so establishing priority for the reference was “a necessary predicate” to the invalidity grounds. *Magnum*, 829 F.3d at 1376; *see also* IPR2016-00129, Paper 13, at 16 (May 3, 2016). Here, establishing an earlier priority for *Grill* is not a “necessary predicate” because *Grill* is prior art, on its face, and remains so unless and until IPB identifies adequate §112 support for all limitations of the challenged claims on an element-by-element basis, as required.

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