Trials@uspto.gov
Tel: 571-272-7822

Paper 7
Entered: November 17, 2016

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.

Case IPR2016-01376
Case IPR2016-01377
Case IPR2016-01378
Case IPR2016-01379[1]
Patent 6,197,696 B1

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

CHAGNON, *Administrative Patent Judge*.

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.5

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[1] This Order addresses issues common to all cases; therefore, we issue a single Order to be entered in each case. The parties are authorized to use this style heading when filing the same paper in multiple proceedings, provided that such heading includes a footnote attesting that "the word-for-word identical paper is filed in each proceeding identified in the heading."

On November 16, 2016, a conference call was held among counsel for both parties and Judges Arbes, Fitzpatrick, and Chagnon. Particular issues discussed during the call are summarized below.[2]

Additional Briefing on Burdens of Production at Institution:

In its Preliminary Response (Paper 6,[3] "Prelim. Resp."), Patent Owner, Godo Kaisha IP Bridge 1, argues that Petitioner, Taiwan Semiconductor Manufacturing Company, Ltd., has failed to show that Grill[4] is prior art as to the patent challenged in these proceedings—namely, U.S. Patent No. 6,197,696 B1 ("the '696 patent"). *See* Prelim. Resp. 9–38.

During the conference call, Petitioner argued that the arguments presented in Patent Owner's Preliminary Response amount to an improper burden shifting. Patent Owner disagreed. In particular, the parties' disagreement centers on whether Petitioner must show, in its Petition, that the '696 patent is not entitled to its claimed foreign priority date, or whether the burden is on Patent Owner first to show that the '696 patent is entitled to its claimed foreign priority date. The parties also disagreed regarding whether the Petition must address whether the asserted prior art (i.e., Grill) is entitled to the filing date of its provisional application.

Petitioner requested authorization to file a reply to the Preliminary Response, limited to the legal issue of the parties' respective burdens of

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[2] A court reporter was present for the conference call. This Order summarizes statements made during the conference call. A complete record also may be found in the court reporter's transcript, which is to be filed by Petitioner as an exhibit.

[3] The relevant papers have been filed in each of the four cases. Citations are to the papers filed in IPR2016-01376 for convenience.

[4] U.S. Patent No. 6,140,226 (Ex. 1005).

production, where disputes arise as to whether a patent or cited prior art is entitled to the benefit of an earlier priority date. Patent Owner opposed Petitioner's request as prejudicial and untimely, but requested authorization to file a sur-reply if a reply is authorized.

Petitioner is authorized to file a reply, limited to the legal issue of the parties' respective burdens, as discussed above. The reply is limited to three (3) pages and is to be filed by November 23, 2016. Patent Owner also is authorized to file a sur-reply, similarly limited in subject matter. The sur-reply also is limited to three (3) pages and is to be filed by December 1, 2016. Neither brief may present arguments regarding whether a burden has been met; they may address only which party bears what burden(s). Neither party is authorized to file any new evidence.

Corrected Declarations:

Petitioner also requested authorization to file, in each proceeding, a corrected declaration to correct an alleged typographical error in Exhibit 1002. Exhibit 1002 is a declaration of Bruce W. Smith, Ph.D. Petitioner argued that there is an obvious typographical error in the claim chart on page B-10 of "Appendix B" to Dr. Smith's declaration. In particular, Petitioner requested authorization to change the sentence that reads "A person of ordinary skill in the art would have understood that etching layer 12 under such circumstances concurrently etches layer 58 because the two layers have similar etch properties," to instead read "A person of ordinary skill in the art would have understood that etching layer 12 under such circumstances concurrently etches layer 62 because the two layers have similar etch properties." (emphases added).

Patent Owner opposed Petitioner's request, arguing that certain arguments set forth in its Preliminary Response (e.g., Prelim. Resp. 28–30) were premised on the as-filed declaration, such that if Petitioner is permitted to file a corrected declaration, Patent Owner would have no opportunity to respond. Patent Owner argued that Petitioner's proposed change was not, in fact, a typographical error, but would amount to a substantive change to Dr. Smith's declaration.

Patent Owner also argued that "Appendix B" contains argument that was improperly incorporated by reference into the Petition, and that it is not cited to support any argument made in the Petition itself. Petitioner indicated that "Appendix B" was submitted as a demonstration that evidence does exist to show Grill is entitled to the filing date of its provisional application.

Based on the particular facts and circumstances in these proceedings, Petitioner is not authorized to file corrected declarations.

Accordingly, it is:

ORDERED that Petitioner is authorized to file in each proceeding a reply to the Preliminary Response, limited to the legal issue of the parties' respective burdens, as discussed herein, limited to three (3) pages, by November 23, 2016;

FURTHER ORDERED that Patent Owner is authorized to file in each proceeding a sur-reply, limited to three (3) pages, by December 1, 2016; and

FURTHER ORDERED that no other papers or exhibits are authorized to be filed, at this time.

PETITIONER:

Darren M. Jiron
E. Robert Yoches
J.P. Long
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
darren.jiron@finnegan.com
bob.yoches@finnegan.com
j.preston.long@finnegan.com

PATENT OWNER:

J. Steven Baughman
Andrew N. Thomases
ROPES & GRAY LLP
steven.baughman@ropesgray.com
andrew.thomases@ropesgray.com