

Filed on behalf of Patent Owner by:

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TAIWAN SEMICONDUCTOR MANUFACTURING CO., LTD,
Petitioner,

v.

GODO KAISHA IP BRIDGE 1,
Patent Owner.

IPR2017-01841¹
Patent 7,893,501

**PATENT OWNER'S IDENTIFICATION OF IMPROPER NEW
ARGUMENT IN PETITIONER'S REPLY
PURSUANT TO JULY 20, 2018 ORDER (PAPER NO. 26)**

¹ Case IPR2017-01842 has been consolidated with this proceeding.

1. Reply, p. 3 ll. 2-4; Ex. 1027, p. 4, ll. 2-3: Petitioner ***changed its theory of unpatentability*** based on a new argument that it would have been obvious to ***modify*** Igarashi's Fifth Embodiment to ***add*** isolation regions in view of Igarashi's disclosure of isolation regions in its First Embodiment, which changes the Petition's argument that Igarashi ***discloses*** that its Fifth Embodiment already has isolation regions. Pet. at 22 (“[T]he ***disclosure of the features in Igarashi*** common to different illustrations ***are applicable to ... Figure 12.***”), 25-26 (similar).

2. Reply, p. 3, ll. 2-7, p. 14, l. 10, p. 26 ll. 4-7, p. 28, ll. 3-11; Ex. 1027, p. 4, ll. 2-3, p. 21, ll. 6-9, p. 27, l. 4 to p. 28, l. 8, 29, ll.1-9: Petitioner ***changed its theory of unpatentability*** based on a new argument that it would have been obvious to ***modify*** Igarashi's Fifth Embodiment to ***add*** isolation regions and form an active region in view of Woerlee whereas the Petition relied on Woerlee only to teach locating in the substrate the ***isolation/active regions allegedly taught by Igarashi.*** Pet. at 27 (“To the extent that Igarashi does not explicitly disclose ***the location*** of the ‘active element region’ ... Woerlee discloses this limitation.”), *id.* at 31 (“***By locating Igarashi's*** active [] region ... according to ... Woerlee.”)).

3. Reply, p. 14, ll. 1-3; Ex. 1027, p. 15, ll. 4-6: ***New argument*** that transistors without isolation regions have an active region. *Compare* Pet. at 33 (“***isolation regions*** that define ... the active regions ***are required in all transistor devices.***”).

4. Reply, p. 19, l. 16 to p. 21, l. 3, p.10, l. 17 to p. 13, l. 5; Ex. 1027, ¶¶ 16-18, 29-31: Argument that the *entire* area “between the two STI in Igarashi [modified Fig. 12]” meets the claimed “active region” is *new*, as the Petition and its supporting expert declaration *nowhere* explain whether this area is alleged to include one or two (one per transistor) active regions as confirmed by the contradictory and ultimately non-comital testimony of Petitioner’s expert at deposition. *E.g.*, Ex. 2009 at 91:12-92:14 (two active regions); Ex. 2010 at 400:16-401:11 (denying prior testimony; identifying one active region); 406:5-408:9 (retracting testimony for annotated Figure 12 (Ex. 2002 described at Ex. 2010 at 404:12-20; 192:21-22) and requesting to strike testimony); 410:1-24 (“can’t answer”); 416:11-17 (not relevant to understanding the claim); 424:2-11 (not needed to understand claim).

5. Reply, p. 20, l. 11, p. 21, l. 3; Ex. 1027, ¶ 31: Petitioner’s cursory and conclusory “argument,” that the area “between the two STI in Igarashi [modified Fig. 12]” includes multiple “active regions” (one per transistor) contradicts the new argument in #4 and also is new, as the Petition and its supporting expert declaration *nowhere* explained whether this area is alleged to include one or two (one per transistor) active regions as confirmed by the contradictory and ultimately non-comital testimony of Petitioner’s expert at deposition cited in #4.

Dated: July 24, 2018

Respectfully submitted,

By /Gerald B. Hrycyszyn /
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CERTIFICATE OF SERVICE UNDER 37 C.F.R. §42.6 (e)(4)

I certify that on July 24, 2018 I will cause a copy of the foregoing document, including any exhibits referred to therein, to be served via electronic mail, as previously consented to by Petitioner, upon the following:

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