Paper No. __

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TAIWAN SEMICONDUCTOR MANUFACTURING CO., LTD,
Petitioner,

v.

GODO KAISHA IP BRIDGE 1,
Patent Owner.

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IPR2017-01841[1]
Patent 7,893,501

_____

PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE PURSUANT TO 37 C.F.R. §42.64(C)

[1] Case IPR2017-01842 has been consolidated with this proceeding. *See* Paper 10 at 3.

TABLE OF CONTENTS

TABLE OF AUTHORITIES

CASES

RULES

REGULATIONS

I. INTRODUCTION

Patent Owner moves to exclude two types of evidence. First, Petitioner offered Exhibit 1026 (U.S. Patent No. 8,618,607, "Rashed") as "prior art" to purportedly establish how a disputed term would have been understood in the relevant timeframe before the '501 patent was filed, but it demonstrably is not prior art to the '501 patent. Rashed and the testimony of Petitioner's expert that relied on it should be excluded as irrelevant. Second, during redirect (and re-redirect) of its expert, Petitioner's counsel blatantly led and coached the witness to change the testimony he offered under cross-examination. The testimony Petitioner elicited through improper leading and coaching should be excluded.

A. Rashed Is Not Prior Art

Under 37 C.F.R. § 42.64(c), Patent Owner moves to exclude Rashed and portions of Petitioner's expert's reply declaration that rely on Rashed (Exhibit 1027 at ¶¶18, 29), because Petitioner alleges that Rashed is relevant "prior art" in this proceeding, but Rashed is demonstrably not prior art to the '501 patent.

In Exhibit 1027 at ¶¶17-18, Petitioner's expert ("Shanfield") mistakenly identifies Rashed as prior art to the '501 patent and relies on Rashed as describing what was purportedly known in the art at the time the '501 patent was filed. In fact, Rashed was filed in 2012—***more than 9 years after the priority date of the***

'501 patent—and is not prior art to the '501 patent. Thus, Rashed is not relevant to establishing what was known in the art in the relevant time frame.

Patent Owner timely served and filed objections to this evidence in accordance with 37 C.F.R.§ 42.64(b)(1) on July 14, 2018. Paper No. 23. Petitioner served no supplemental evidence in response, and failed to provide any evidence explaining how or why a 2012 reference could be relevant to the understanding of the state of the art nine years earlier in 2003. Rashed and Exhibit 1027 at ¶¶18, 29, which improperly rely upon it as prior art, should be excluded.

B. Deposition Testimony Elicited Via Improper Leading and Coaching Should Be Excluded

During redirect (and re-redirect) at Shanfield's deposition on his reply declaration, Petitioner's counsel improperly led and coached Shanfield by providing express and ***direct*** instructions to Shanfield during questioning. Ex. 2026 at 144:1-12, 145:1-147:8, 167:14-173:3, 173:10-178:4. This improper coaching and leading prompted Shanfield to directly alter the testimony he had given under cross-examination. See § III below.

The testimony elicited via improper leading and coaching should be excluded pursuant to Fed. R. Evid. 611(c). *E.g.*, *Universal Remote Control v. Universal Elecs.*, IPR2014-01146 Paper No. 36 at 6-7 (PTAB Dec. 10, 2015) (excluding re-direct examination, finding the questions were leading because they "contained contextual cues sufficient to suggest the answer that counsel desired to

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