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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 IPR2017-01841¹

**PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO
EXCLUDE**

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

I. Introduction

Patent Owner moves to exclude admissible evidence from the Board's consideration to create an incomplete record and to avoid the merits. The Board can review the full record and appropriately weight the evidence and should deny Patent Owner's motion.

Patent Owner argues Rashed (Ex. 1026) – a reference cited for illustrative purposes in Dr. Shanfield's Reply Declaration (Ex. 1027) – and related testimony is irrelevant because Rashed is not prior art. Patent Owner mischaracterizes the manner in which Dr. Shanfield discusses Rashed. Dr. Shanfield does not rely on Rashed as prior art. Rather, Dr. Shanfield testifies based on his experience and expertise about the understanding of the term "active region" by those of skill in the art at the time of the '501 patent and uses a figure from Rashed as a demonstrative example to illustrate his testimony. Patent Owner offers no response on the merits, despite having multiple opportunities, and instead seeks to exclude what is cannot dispute. Rashed is just one example Dr. Shanfield discusses. He also includes U.S. 5,389,810 to Agata (Ex. 1025), issued in 1995, which also shows multiple transistors formed in an active region.

Patent Owner also moves to exclude portions of Dr. Shanfield's testimony during the re-direct and re-cross related to undisputed issues because Dr. Shanfield was allegedly coached. He was not. Dr. Shanfield gave consistent technical

testimony throughout the deposition. After a series of misleading questions on cross, Petitioner's counsel conducted a routine re-direct. When Dr. Shanfield offered testimony on re-cross based on a misstatement of the law, Petitioner's counsel represented to Dr. Shanfield what the law was, and Dr. Shanfield promptly confirmed his original technical testimony, which he had offered *before* any alleged coaching.

Even Patent Owner appears to agree the Board should review the full record. Patent Owner's motion for observations asks the Board to consider the *exact same* testimony it seeks to exclude in this motion. This further highlights the improper nature of Patent Owner's motion to exclude. Office Trial Practice Guide, 77 Fed. Reg. 48756, 48767-68 (Aug. 14, 2012) ("In the event that cross-examination occurs after a party has filed its last substantive paper on an issue, such cross-examination may result in testimony that should be called to the Board's attention, but the party does not believe a motion to exclude the testimony is warranted.")

The Board should review and weigh the evidence with the benefit of the full record. Patent Owner's Motion to Exclude should be denied.

II. The Rashed reference and Dr. Shanfield's Related Testimony are Relevant and Admissible

A. Rashed (Ex. 1026) is admissible to illustrate Dr. Shanfield's testimony

Patent Owner moves to exclude Rashed (Ex. 1026), arguing it is not relevant

because it is not prior art. Mot., 1-5. Patent Owner erroneously presupposes a requirement that a document be prior art to be admissible. Patent Owner's argument should be rejected because Rashed (Ex. 1026) is at least admissible as a demonstrative example to illustrate Dr. Shanfield's testimony regarding how a POSITA would have understood the term "active region."

It is well established that "[t]he mere fact that the documents are not prior art does not merit their exclusion." *See Apple Inc. v. Achates Reference Publishing, Inc.*, IPR2013-00080, Paper No. 90 at 52 (PTAB June 2, 2014); *Thomas & Betts Corp. v. Litton Sys., Inc.*, 720 F.2d 1572, 1580-81 (Fed. Cir. 1983).

Dr. Shanfield's discussion of Rashed (Ex. 1026) demonstrates its relevance and persuasiveness. In response to Patent Owner's attempt to limit the claimed "active region" to "a region in which a single transistor is formed" (POR at 74), Dr. Shanfield explains that "more than one transistor can exist in an active region." Ex. 1027 [Shanfield Reply Decl.], ¶17. As part of this discussion, Dr. Shanfield explains that "Isolation regions are designed to *isolate one active region from another active region*, not each transistor from every other transistor." Ex. 1027 [Shanfield Reply Decl.], ¶18. Dr. Shanfield illustrates this testimony with a figure from Rashed (Ex. 1026). *Id.* Dr. Shanfield explains: "For example, when observing a plan view laying out a configuration of semiconductor devices, it becomes evident that an active region can include more than one transistor. U.S.

Patent No. 8,618,607 to Rashed et al. ("Rashed") illustrates such a plan view"

Id. Thus, Dr. Shanfield does not testify that Rashed (Ex. 1026) is itself prior art.

Rather, Dr. Shanfield testifies how a POSITA would have understood the term active region and Rashed (Ex. 1026) is relevant to help illustrate this testimony.

Rashed (Ex. 1026) is just one example Dr. Shanfield discusses in connection with showing that "more than one transistor can exist in an active region." Ex. 1027 [Shanfield Reply Decl.], ¶17. Dr. Shanfield also discusses U.S. 5,389,810 to Agata (Ex. 1025), issued in 1995, which similarly shows multiple transistors formed in an active region. Ex. 1027 [Shanfield Reply Decl.], ¶17.

Patent Owner's motion selectively quotes from and mischaracterizes the Reply and Dr. Shanfield's Reply Declaration. Mot., 1, 3. Contrary to Patent Owner's assertions, Dr. Shanfield does not "mistakenly identify Rashed as prior art to the '501 patent." *Id.* Rather, as explained above, Dr. Shanfield uses Rashed as a demonstrative example to illustrate his testimony about how the term active region was understood. Ex. 1027 [Shanfield Reply Decl.], ¶17-18. Patent Owner also argues, again incorrectly, that this testimony was offered in support of a new claim construction argument. It was not. As noted above, this testimony responds to Patent Owner's attempt to limit the claimed "active region" to having a "single transistor." POR, 74; Reply, 12-13; *see also* Petitioner's Response Pursuant to July 20, 2018 Order (Paper 29), item number 4.

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