

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
Case IPR2017-01843²
Patent 7,893,501 B2

Before JENNIFER MEYER CHAGNON and MELISSA A. HAAPALA,
Administrative Patent Judges.

CHAGNON, *Administrative Patent Judge.*

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

¹ Case IPR2017-01842 has been consolidated with Case IPR2017-01841.

² Case IPR2017-01844 has been consolidated with Case IPR2017-01843.

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On July 19, 2018, a conference call was held involving counsel for the respective parties and Judges Chagnon and Haapala. A court reporter was present for the conference call; Patent Owner filed a copy of the transcript (IPR2017-01841, Ex. 2022; IPR2017-01843, Ex. 2230). The parties' positions are fully set forth in the court reporter's transcript; we provide a summary herein.

Request for Authorization to File a Listing of Allegedly Improper New Reply Arguments

In each of IPR2017-01841 and IPR2017-01843, Patent Owner requests authorization to file a short paper identifying allegedly new arguments in Petitioner's Reply. According to Patent Owner, each of Petitioner's Replies presents new arguments. Petitioner asserts that the Replies are properly responsive to the Patent Owner Response filed in each proceeding, and opposes Patent Owner's request.

Having considered the parties' positions, we authorize Patent Owner to file, in each proceeding, a paper identifying any allegedly new arguments by page and line number(s). Patent Owner may include a brief statement of the basis for its contention (e.g., "change in theory," "not responsive"). Patent Owner's paper shall not exceed two (2) pages, and shall be filed no later than July 24, 2018. Petitioner is authorized to file, in each proceeding, a responsive paper, indicating where the identified argument was previously raised and/or portions of the Patent Owner Response to which the identified argument responds, and a brief explanation as necessary. Petitioner's paper shall not exceed two (2) pages, and shall be filed no later than July 27, 2018. Patent Owner shall provide a numbered list of the allegedly new arguments, and Petitioner shall respond with a correspondingly numbered list.

Request for Authorization to File a Sur-Reply

In IPR2017-01841, Patent Owner requests authorization to file a limited sur-reply and supporting expert declaration. Patent Owner indicates that a sur-reply is necessary to address Exhibits 1025 and 1026, as well as relevant declaration testimony from Petitioner's declarant, Stanley R. Shanfield, Ph.D., submitted with Petitioner's Reply in support of its assertions regarding claim construction. Patent Owner contends that its declarant has not had the opportunity to provide his opinion as to these exhibits, and that he disagrees with Dr. Shanfield's characterizations thereof.

Petitioner opposes Patent Owner's request. Specifically, Petitioner argues that a sur-reply is not necessary, because the arguments presented in the Reply are not improper new arguments but are responsive to an "unforeseeable" claim construction position Patent Owner took in its Response; new exhibits often are submitted in support of a reply without the need for a sur-reply; and Patent Owner can use its opportunity to depose Dr. Shanfield and submit observations on cross-examination to address these issues.

Having considered the parties' positions, we determine that additional briefing on claim construction may be helpful to the panel in rendering a final written decision. Accordingly, we authorize Patent Owner to file a sur-reply, not to exceed three (3) pages, addressing Exhibits 1025 and 1026, as well as relevant testimony in Dr. Shanfield's reply declaration (Ex. 1027), and the implications on claim construction in this proceeding. Patent Owner may submit with its sur-reply an expert declaration, also limited to three (3) pages. Patent Owner's sur-reply shall be filed no later than July 27, 2018.

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Patent Owner shall make its declarant available for cross-examination no later than August 3, 2018.

Petitioner is authorized to file a sur-sur-reply, not to exceed three (3) pages, responsive only to arguments made in Patent Owner's sur-reply. Petitioner's sur-sur-reply shall be filed no later than one week after the cross-examination of Patent Owner's declarant (e.g., if the deposition occurs on August 3, Petitioner's sur-sur-reply is due on August 10). Petitioner may file the transcript of the cross-examination of Patent Owner's declarant, but is not authorized, at this time, to submit other new evidence or testimony with its sur-sur-reply. Petitioner may cite to record evidence in support of its arguments in the sur-sur-reply. If, after reviewing Patent Owner's sur-reply, Petitioner believes additional evidence is necessary, Petitioner may contact the Board for further consideration of the question.

Request for Authorization to File a Motion to Strike

Also in IPR2017-01841, Patent Owner requests authorization to file a motion to strike certain testimony in Dr. Shanfield's declaration (Ex. 1027) submitted with Petitioner's Reply. Patent Owner contends that, during cross-examination regarding his original declaration (Ex. 1002), Dr. Shanfield took varying positions and/or refused to answer questions with respect to the meaning of the claim term "active region." Patent Owner further contends that Dr. Shanfield then provided declaration testimony on these same points in the reply declaration. Petitioner opposes Patent Owner's request, and asserts that Dr. Shanfield did not refuse to answer questions, and that Patent Owner's line of questioning was confusing and/or technically flawed. In support of these assertions, counsel for both parties

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pointed to several portions of the Dr. Shanfield's deposition transcript (Ex. 2010).

Having considered the parties' positions, Patent Owner is not authorized to file a motion to strike. Patent Owner has the opportunity to explore any alleged inconsistencies in Dr. Shanfield's testimony during the cross-examination related to his reply declaration, which currently is scheduled for July 25, 2018 (*see* Paper 24). Patent Owner may bring any relevant testimony in this regard to the panel's attention via observations on cross-examination, as set forth in the Scheduling Order (*see* Paper 11).

It is

ORDERED that Patent Owner is authorized to file, in each of IPR2017-01841 and IPR2017-01843, consistent with the requirements and deadline set forth above, a paper not to exceed two (2) pages identifying any allegedly new arguments in Petitioner's Replies;

FURTHER ORDERED that Petitioner is authorized to file, in each of IPR2017-01841 and IPR2017-01843, consistent with the requirements and deadline set forth above, a responsive paper not to exceed two (2) pages indicating where the identified argument was previously raised and/or portions of the Patent Owner Response to which the identified argument responds;

FURTHER ORDERED that Patent Owner is authorized to file, in IPR2017-01841, consistent with the requirements and deadline set forth

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