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.

_____

Case IPR2017-01843[1]
Patent 7,893,501

_____

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

[1] Case IPR2017-01844 has been consolidated with this proceeding. *See* Paper 10 at 3.

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I. INTRODUCTION

Godo Kaisha IP Bridge 1 ("Patent Owner") moves to exclude portions of the deposition transcript of Petitioner's expert ("Shanfield") because, during redirect (and re-redirect), Petitioner's counsel blatantly led and coached Shanfield to change the testimony he offered under cross-examination. Ex. 2232 at 144:1-12, 145:1-147:8, 167:14-173:3, 173:10-178:4. The testimony Petitioner elicited through 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 elicit.").

Shanfield's willingness to completely alter his testimony in response to improper coaching should be considered in judging the credibility of ***all*** his testimony in this proceeding, but more is required. In addition to the Trial Practice Guide's strict prohibition on coaching witnesses, Fed. R. Evid. 611(c) requires exclusion of the deposition testimony because it was influenced by the improper leading questions, coaching and instructions.

II. SHANFIELD'S IMPROPERLY COACHED DEPOSITION TESTIMONY SHOULD BE EXCLUDED

Shanfield's declarations (Exs. 1202 and 1232) are near verbatim copies of ***Petitioner's*** arguments in the Petition and Reply, respectively. But ***Shanfield's***

own opinions offered during cross-examination contradict Petitioner's arguments. Faced with this, Petitioner's counsel improperly coached, instructed and led Shanfield on redirect (and re-redirect) to elicit testimony consistent with the arguments in the Petition. The improperly elicited testimony should be excluded.

At deposition, Shanfield opined that claim 1 "requires that the [claimed] silicon nitride film induce stress" in the substrate. Exhibit 2232 at 160:20-23; *see also id.* at 56:17-58:2. He further testified that an etch stop layer cannot induce stress. Exhibit 2232 at 45:3-18. Taken together, these two opinions contradict the arguments in the Petition at 29-30 (copied in Shanfield's declaration at Ex. 1202 at ¶¶89-90) that Misra's plasma-enhanced nitride layer 20, which is an etch stop layer, meets the ***claimed*** silicon nitride layer.

On redirect and re-redirect, Petitioner's counsel led, coached, and even instructed Shanfield, leading him to directly contradict his earlier testimony that claim 1 requires that the silicon nitride film impart stress and that an etch stop layer cannot satisfy the silicon nitride film limitation.

Shanfield's deposition revealed that he signed declarations, largely parroting Petitioner's arguments, and offered opinions about claim interpretation, even though he "didn't know" the legal principles necessary to properly interpret the claims. Ex. 2232 at 167:14-21. Indeed, Shanfield "needed to be instructed on"

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