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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 IPR2017-01843¹

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

¹ Case IPR2017-01844 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.

Specifically, Patent Owner 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. Dr. Shanfield's Deposition Testimony is Proper and Admissible

Patent Owner seeks to exclude portions of Dr. Shanfield's deposition transcript at Ex. 2232 at 144:1-12, 145:1-147:8, 167:14-173:3, and 173:10-178:4. Patent Owner alleges wrongly that Dr. Shanfield was coached and seeks to exclude his re-direct testimony and his testimony during its own re-cross. Patent Owner's motion should be rejected because it is premised on a mischaracterization of the record. While Petitioner believes the record speaks for itself and the Board can appropriately weigh the evidence, Petitioner nonetheless responds here to address Patent Owner's mischaracterization of the deposition.

Dr. Shanfield offered consistent technical testimony throughout the deposition. Ex. 2232 [Shanfield Reply Tr.], 51:22-52:2; *id.*, 30:4-6; *id.* 52:21-53:6. To provide a clear record for the Board, Petitioner asked Dr. Shanfield routine re-direct questions to clarify his responses to unclear questioning during cross. E.g., Ex. 2232 [Shanfield Reply Tr.], 143:10-21 ("Q. Do you also recall discussing embodiments in the specification of the '501 patent that includes stress films? A. Yes, I do. Q. Could you please look at Claim 1 of the '501 patent. A. Yes. Q.

Does Claim 1 recite any stress limitations? A. No.”) On re-cross, after a long day of deposition, Dr. Shanfield confused how the requirements of dependent claims relate to independent claims and offered testimony that was clearly based on that misunderstanding. Ex. 2232 [Shanfield Reply Tr.], 159:5-160:23. To provide a clear record, counsel for Petitioner provided a representation to Dr. Shanfield on the record regarding how as a legal matter dependent claims relate to independent claims, so that Dr. Shanfield could provide his technical testimony based on that legal understanding. Ex. 2232 [Shanfield Reply Tr.], 167:14-18. Dr. Shanfield then confirmed his initial testimony during cross – *before* any alleged coaching – was correct. On re-cross, Counsel for Patent Owner tried desperately to get Dr. Shanfield to admit he had changed his *technical* testimony, knowing full well that he had not. Ex. 2232 [Shanfield Reply Tr.], 174:12-23; *see also id.* 175:2-15. Having failed to create a misleading record during the deposition, Patent Owner now seeks to exclude Dr. Shanfield's confirmation that his initial testimony during cross (before any alleged coaching) was correct.

The Board should reject Patent Owner's attempt to create an incomplete and misleading record. Even Patent Owner appears to agree this testimony is admissible. For purposes of its Observations on Cross, it asks the Board to consider the exact same testimony it seeks to exclude in this motion. *Compare* Patent Owner's Observations on Cross (Paper 30), Observation #12 (asking the

Board to consider testimony at 144:1-12, 145:1-147:8), Observation #11 (asking the Board to consider testimony at 167:14-173:3, and 173:10-178:4) *with* Mot. (seeking to exclude the exact same testimony). This further illustrates why the Board should consider the full record. While Petitioner does not rely on the testimony Patent Owner seeks to exclude for its affirmative case, this testimony illustrates how the Patent Owner's seeks to mischaracterize the record and should be considered by the Board.

A. Dr. Shanfield's consistent Testimony During Cross-Examination

Patent Owner argues that Dr. Shanfield testified during cross-examination that claim 1 requires stress. To the contrary, Dr. Shanfield consistently testified – before any alleged coaching – that claim 1 does not require stress. Ex. 2232 [Shanfield Reply Tr.], 51:22-52:2 (“Q. Does that language require that the silicon nitride film apply stress? A. No. The claim language doesn’t require stress.”); *id.*, 30:4-6; *id.* 52:21-53:6. This testimony is consistent with Dr. Shanfield’s testimony in his initial declaration that the challenged claims do not require stress, where he explains that none of the challenged claims recite stress limitations and that the stress limitations appear in only the unchallenged dependent claims. Ex. 1202

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