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 REPLY IN SUPPORT OF ITS MOTION TO EXCLUDE EVIDENCE

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

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

Petitioner's assertion that Shanfield "offered consistent technical testimony throughout the deposition" and "***consistently*** testified" that "the claim language doesn't require stress" (*see* Opp. 2-6) is belied by Shanfield's repeated testimony that while the language does not literally require it, the "***silicon nitride being discussed <u>in this claim</u> is a stress-inducing film***." Ex. 2232 at 52:3-19; *see also* 56:13-16, 56:17-58:2; 160:20-23. Shanfield's testimony at 51:22-53:6 provides a clear example of this. Shanfield provided opinions on the claim language in a vacuum stating that "the language doesn't require stress" and that stress isn't required to meet the limitations (51:22-52:2, 52:21-53:6); however, when asked regarding "his understand[ing]" (as opposed to the language) of the claims he testified that ***in view of the specification*** claim 1 requires stress (52:3-19). Similarly, Petitioner's erroneous assertion that testimony at 56:17-58:2 was limited to an embodiment of the specification ignores that 52:3-19 provides the same testimony ***prior*** to the alleged discussion of the embodiment at 56:4-16, and it ignores that the suggestion that it was limited to an embodiment was introduced through Petitioner's improper leading questions. Opp. at 5-6.

Petitioner strains its credibility again by asserting that the redirect was "routine," that counsel's questions were "open-ended" and that counsel avoided "even a hint of coaching." Opp. at 6-7. Petitioner's legal instruction and leading

questions which ***expressly incorporated that instruction*** constitute coaching. Petitioner does not try to distinguish *Universal Remote*, address FRE 611(c), or cite ***any*** support for its extraordinary assertion that counsel was authorized to "clarif[y] the law for Dr. Shanfield" ***during*** questioning. Opp. at 8-9. Petitioner's assertion that the "legal representations" were not leading fails on its face. In addition, as the examples below illustrate, counsel's questions "were phrased narrowly so as to elicit either a 'yes' or 'no' answer." *Universal Remote Control v. Universal Elecs.*, IPR2014-01146 Paper No. 36 at 6-7.

144:1-2	Q. Do Claims 2, 3, and 20 recite stress limitations?
144:9-10	Q. Does Claim 1 require that a silicon nitride film be a stress film?
167:14-168:2	Q. I'm going to represent to you that as a legal matter, a dependent claim recites additional limitations that are not present in the independent claim from which it depends. * * * Q. With that understanding in mind, does … Claim 2 require -- or recite a stress limitation?

During recross, Shanfield had a copy of the '501 patent (*compare* 159:19-20 ("Oh, there it is.") *with* Opp. at 8) when, without Petitioner's counsel's improper guidance regarding the dependent claims, he ***returned*** to his opinion that claim 1 requires stress. Ex. 2232 at 160:20-23. Petitioner's assertion that Shanfield's Ex. 1002 declaration analyzed claim 2 (Opp. 4-5) ***reinforces*** that Shanfield rubber-stamped Petitioner's arguments because, at deposition, Shanfield couldn't identify

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