

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
Patent 7,893,501 B2

Before MELISSA A. HAAPALA, *Acting Vice Chief Administrative Patent Judge*, and JUSTIN T. ARBES, *Administrative Patent Judge*.

ARBES, *Administrative Patent Judge*.

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

¹ Case IPR2017-01844 has been consolidated with Case IPR2017-01843.

A conference call in the above proceeding was held on September 26, 2018, among respective counsel for Petitioner and Patent Owner, and Judges Haapala, Arbes, and Chagnon.² Patent Owner requested the call to seek authorization to file additional briefing and evidence regarding two matters.

First, in a previous Order dated September 14, 2018, the panel authorized Patent Owner to file a limited sur-reply responding to Petitioner's argument in its Reply (Paper 22) that Misra (Ex. 1204) teaches that spacers 23 may be formed of a material other than silicon nitride, such as thermally grown silicon dioxide. Paper 40. Patent Owner argued during the call that if Petitioner's argument is considered, Patent Owner should be permitted to also file with its sur-reply an expert declaration with supporting evidence. Patent Owner stated that the new evidence would demonstrate that the structure Petitioner argues is taught by Misra is not enabled and that a person of ordinary skill in the art would not have understood Misra to disclose making spacers 23 out of thermally grown silicon dioxide. Patent Owner argued that both issues are "highly technical" and require expert testimony. Petitioner opposed Patent Owner's request, arguing that Petitioner's argument in the Reply was proper and that Patent Owner was aware of the issue and should have addressed it in Patent Owner's Response because it originally arose during the cross-examination of Petitioner's declarant. We took the matter under advisement.

After further consideration, we are not persuaded that the Order should be modified to permit new evidence with Patent Owner's sur-reply.

² A court reporter, retained by Patent Owner, was present on the call. Patent Owner subsequently filed a transcript of the call as Exhibit 2234.

As stated in the Order, we have not yet determined whether Petitioner's argument regarding spacers 23 is within the proper scope of a reply, and will do so in the final written decision. *See id.* at 2 n.4; Paper 27 (Patent Owner's identification of allegedly improper arguments in Petitioner's Reply); Paper 28 (Petitioner's response). If the argument is determined to be improper, it will not be considered. If the argument is determined to be proper, Patent Owner is provided the opportunity to file a sur-reply substantively responding to the argument. *See* Paper 40, 2 n.4. This is in accord with the recent update to the Office Patent Trial Practice Guide, which permits sur-replies without new evidence:

Sur-replies to principal briefs (i.e., to a reply to a patent owner response or to a reply to an opposition to a motion to amend) normally will be authorized by the scheduling order entered at institution. The sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness. Sur-replies should only respond to arguments made in reply briefs, comment on reply declaration testimony, or point to cross-examination testimony.

Trial Practice Guide Update (August 2018), 14, *available at* https://www.uspto.gov/sites/default/files/documents/2018_Revised_Trial_Practice_Guide.pdf. In addition to filing a substantive sur-reply, Patent Owner had the opportunity to file observations on the cross-examination testimony of Petitioner's declarant, and in fact addressed the relevant testimony regarding spacers 23. *See* Paper 30, 11–12 (Patent Owner's observations); Paper 35, 12–13 (Petitioner's responses).

We are not persuaded that a departure from the standard procedure to allow new evidence with Patent Owner's sur-reply would be appropriate under the circumstances, given the substance of the parties' arguments as

well as the timing of this proceeding and our obligation to “secure the just, speedy, and inexpensive resolution of every proceeding.” *See* 37 C.F.R. § 42.1(b). We reiterate that Petitioner’s argument regarding spacers 23, and any sur-reply Patent Owner files, will only be considered if we determine Petitioner’s argument is within the proper scope of a reply.

Second, Patent Owner requested authorization for both parties to submit additional briefing and expert declarations regarding how a person of ordinary skill in the art would have understood certain disclosures in the Specification of the challenged patent, U.S. Patent No. 7,893,501 B2 (Ex. 1201, “the ’501 patent”), specifically:

- (1) whether a person of ordinary skill in the art would have understood the ’501 patent to refer to gate insulating film 5 and sidewall 7 as different films;
- (2) whether a person of ordinary skill in the art would have understood gate insulating film 5 and sidewall 7 to be formed of the same material; and
- (3) how a person of ordinary skill in the art would have understood the disclosures in the ’501 patent regarding the various materials described for forming gate insulating film 5, the process for forming gate insulating film 5 from those materials, and the disclosure that sidewall 7 is silicon oxide.

Patent Owner argued that, if permitted, its brief and declaration would support Patent Owner’s proposed claim interpretation for the term “silicon nitride film” and respond to questions asked by the panel about the Specification of the ’501 patent during the oral hearing on September 6, 2018. Petitioner opposed Patent Owner’s request.

We are not persuaded that additional briefing and testimony on how a person of ordinary skill in the art would have understood the Specification of

the '501 patent is warranted. All substantive briefing in this proceeding (other than Patent Owner's authorized sur-reply) has been completed and the hearing has taken place. Both parties had the opportunity to propose interpretations for the challenged claims and advocate for those interpretations at the hearing, including referring to portions of the Specification that allegedly support the parties' proposed interpretations and answering the panel's questions regarding claim interpretation. The questions asked by the panel at the hearing related to determining the correctness of the parties' proposed interpretations in light of the Specification. We do not see why further briefing and testimony is necessary at this late stage.

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's requests to submit additional briefing and evidence are *denied*, and the Order of September 14, 2018 (Paper 40), remains unchanged.

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