

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 IPR2017-01841
Case IPR2017-01842
Case IPR2017-01843
Case IPR2017-01844
Patent 7,893,501 B2

Case IPR2017-01861
Case IPR2017-01862
Patent 7,265,450 B2¹

Before JUSTIN T. ARBES, MICHAEL J. FITZPATRICK, and
JENNIFER MEYER CHAGNON, *Administrative Patent Judges*.

CHAGNON, *Administrative Patent Judge*.

¹ This order addresses issues common to all cases; therefore, we issue a single order to be entered in each case. The parties may not use this format without prior authorization.

IPR2017-01841; IPR2017-01842; IPR2017-01843; IPR2017-01844
Patent 7,893,501 B2
IPR2017-01861; IPR2017-01862
Patent 7,265,450 B2

ORDER

Denying Petitioner's Request to File Reply to Preliminary Response
37 C.F.R. § 42.108(c)
Conduct of the Proceedings
37 C.F.R. § 42.5

On December 19, 2017, a conference call was held involving counsel for the respective parties² and Judges Arbes, Fitzpatrick, and Chagnon. A court reporter was present for the conference call; Petitioner is directed to file a copy of the transcript as an exhibit in each proceeding when it is available. We summarize the call herein.

Petitioner Taiwan Semiconductor Manufacturing Company Ltd. requested the conference call with the Board for authorization to file a reply to the Preliminary Responses of Patent Owner Godo Kaisha IP Bridge 1. Pursuant to 37 C.F.R. § 42.108(c), a “petitioner may seek leave to file a reply to the preliminary response,” and “[a]ny such request must make a showing of good cause.”

Petitioner contends there is good cause for a reply because Patent Owner has taken claim construction positions in the Preliminary Responses that are inconsistent with positions taken by Patent Owner in its infringement contentions in the co-pending district court litigation. According to Petitioner, Patent Owner's claim construction positions were not foreseeable, and it would benefit the Board and the parties to have

² Although different counsel is representing Petitioner in the various proceedings, a single conference call was held due to the similar nature of the requests in each proceeding.

IPR2017-01841; IPR2017-01842; IPR2017-01843; IPR2017-01844
Patent 7,893,501 B2
IPR2017-01861; IPR2017-01862
Patent 7,265,450 B2

additional briefing in order to assist the Board in properly construing the claims.

Patent Owner disagrees, and argues that Petitioner had access to the infringement contentions before the Petitions were filed. According to Patent Owner, Petitioner should have addressed the district court infringement contentions in the Petitions if Petitioner thought they were relevant to claim construction issues in these proceedings. Patent Owner further disagrees that its positions are inconsistent.

Having considered the matter and as discussed during the conference call, we determine Petitioner has not shown good cause for further briefing on the claim construction issues in these proceedings. The Board has the infringement contentions alleged to be inconsistent with Patent Owner's arguments in the Preliminary Responses.³ Both parties have had the opportunity to present their proposed claim constructions, and therefore we see no need for further briefing at this stage. The panel is capable of reviewing the record and applying the broadest reasonable construction to the claim terms.

³ The parties indicated that the relevant infringement contentions are of record in IPR2017-01861 and IPR2017-01862 (*see, e.g.*, Ex. 1024, 31–36, 63–66), but are not of record in IPR2017-01841, IPR2017-01842, IPR2017-01843, and IPR2017-01844. Petitioner in IPR2017-01841, IPR2017-01842, IPR2017-01843, and IPR2017-01844 shall file the infringement contentions as an exhibit in each of those proceedings, as set forth in the Order.

IPR2017-01841; IPR2017-01842; IPR2017-01843; IPR2017-01844
Patent 7,893,501 B2
IPR2017-01861; IPR2017-01862
Patent 7,265,450 B2

In consideration of the foregoing, it is:

ORDERED that Petitioner's request, in each proceeding, for authorization to file a Reply to Patent Owner's Preliminary Response is *denied*;

FURTHER ORDERED that Petitioner shall file the transcript of the conference call as an exhibit in each proceeding; and

FURTHER ORDERED that Petitioner in IPR2017-01841, IPR2017-01842, IPR2017-01843, and IPR2017-01844 shall file the infringement contentions as an exhibit in each of those proceedings, no later than January 12, 2018.

IPR2017-01841; IPR2017-01842; IPR2017-01843; IPR2017-01844
Patent 7,893,501 B2
IPR2017-01861; IPR2017-01862
Patent 7,265,450 B2

IPR2017-01841; IPR2017-01842; IPR2017-01843; IPR2017-01844
PETITIONER:

David H. Cavanaugh
Dominic E. Massa
Michael H. Smith
WILMER CUTLER PICKERING HALE AND DORR LLP
David.Cavanaugh@wilmerhale.com
Dominic.Massa@wilmerhale.com
MichaelH.Smith@wilmerhale.com

IPR2017-01861; IPR2017-01862
PETITIONER:

Lori A. Gordon
Christian A. Camarce
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
Lgordon-PTAB@skgf.com
Ccamarce-PTAB@skgf.com

PATENT OWNER:

Gerald B. Hrycyszyn
Richard F. Giunta
Edmund J. Walsh
WOLF, GREENFIELD & SACKS, P.C.
GHrycyszyn-PTAB@wolfgreenfield.com
RGiunta-PTAB@wolfgreenfield.com
EWalsh-PTAB@wolfgreenfield.com