

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

SIGHTSOUND TECHNOLOGIES, LLC
Patent Owner

Case CBM2013-00020 (Patent 5,191,573)
Case CBM2013-00023 (Patent 5,966,440)¹

Before MICHAEL P. TIERNEY, JUSTIN T. ARBES, and
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

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

¹ This Order addresses issues pertaining to both cases. Therefore, we exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

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An initial conference call in the above proceedings was held on October 30, 2013, among respective counsel for Petitioner and Patent Owner, and Judges Tierney, Arbes, and Braden. The purpose of the call was to discuss any proposed changes to the Scheduling Orders in the proceedings and any motions that the parties intend to file. Prior to the call, Petitioner and Patent Owner filed notices (Papers 19 and 21 in Case CBM2013-00020, and Papers 16 and 18 in Case CBM2013-00023) listing various potential motions. The following issues were discussed.

Schedule

The parties indicated that they do not have any issues with the Scheduling Orders.

Additional Back-Up Counsel

Petitioner and Patent Owner both stated that they may file motions for *pro hac vice* admission of additional attorneys as back-up counsel. The parties are directed to the “Order -- Authorizing Motion for *Pro Hac Vice* Admission” in Case IPR2013-00639, Paper 7 (a copy of which is available on the Board Web site under “Representative Orders, Decisions, and Notices”), regarding the requirements for *pro hac vice* admission.

Protective Order

Petitioner indicated that it may request a protective order to be entered at some point in the proceedings. The parties are directed to the requirements of 37 C.F.R. § 42.54 and the instructions for filing documents in the Patent Review Processing System (PRPS) on the Board’s website at

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<http://www.uspto.gov/ip/boards/bpai/prps.jsp>. Should the parties believe there is a need to file certain information under seal at some point in these proceedings, the parties may file a motion to seal containing a proposed protective order. The motion should identify specifically how the proposed protective order differs from the Board's default protective order and explain why such changes are warranted. If there are any changes, the parties should file with the motion a separate redlined version of the proposed protective order showing the differences between the default protective order and the proposed protective order.

Motion for Additional Discovery

Patent Owner requested authorization to file a motion for additional discovery of materials pertaining to the alleged commercial success of Petitioner's iTunes Music Store ("ITMS") and an alleged nexus between the claimed inventions and such commercial success. The parties indicated that they were still in the process of discussing the issue. The Board encouraged the parties to continue those discussions to reach an agreement on what materials should be produced, if any. Further, to the extent possible, Patent Owner should identify *specific* materials or information it is requesting in discovery. If the parties cannot reach an agreement, Patent Owner may request another conference call. No motion for additional discovery is authorized at this time.

Motion to Permit Two Attorneys to Observe the Proceedings

Patent Owner requested authorization to file a motion to permit two of its litigation counsel, Tracy Tosh Lane and Sean M. Callagy, to observe the

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instant proceedings. Patent Owner stated that the attorneys would only observe and would not participate in the proceedings in any way. Patent Owner argued that having the attorneys observe is warranted because they are aware of the litigation record and documents that may be relevant or need to be requested in discovery in the instant proceedings. Petitioner objected to the two attorneys observing these proceedings, arguing that they are prohibited from doing so under the terms of a protective order in the related district court litigation. Patent Owner responded that the two attorneys would not be violating the protective order by observing these proceedings.

The Board took the matter under advisement, and encouraged the parties to work together to resolve the issue. The Board also advised the parties that issues pertaining to counsel obligations under the protective order can only be resolved by the district court, not the Board. The parties shall file, by November 8, 2013, a joint statement stating whether an agreement has been reached regarding the request to observe the proceedings.

Motion to Amend in Case CBM2013-00023

Patent Owner stated that it has not yet determined whether it will file a motion to amend in Case CBM2013-00023. Should Patent Owner decide to file a motion to amend, Patent Owner must request a conference call and confer with the Board before doing so. *See* 37 C.F.R. § 42.121(a).

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PETITIONER:

J. Steven Baughman

Ching-Lee Fukuda

ROPES & GRAY LLP

steven.baughman@ropesgray.com

ching-lee.fukuda@ropesgray.com

PATENT OWNER:

David R. Marsh

Kristan L. Lansbery

ARNOLD & PORTER LLP

david.marsh@aporter.com

kristan.lansbery@aporter.com