

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SYNOPSISYS, INC.
Petitioner

v.

MENTOR GRAPHICS CORPORATION
Patent Owner

Case IPR2012-00042 (SCM)
Patent 6,240,376 B1

Before HOWARD B. BLANKENSHIP, SALLY C. MEDLEY, and
JENNIFER S. BISK, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

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

On June 19, 2013, the following individuals participated in a
conference call:

(1) Mr. William Wright and Mr. Travis Jensen, counsel for Synopsys,
Inc. (Synopsys);

(2) Mr. Christopher McKee and Mr. Michael CuvIELlo, counsel for Mentor Graphics Corporation (Mentor Graphics); and

(3) Howard Blankenship, Sally Medley, and Jennifer Bisk, Administrative Patent Judges.

The purpose of the call was for Mentor Graphics to seek: (1) a one week extension of DUE DATE 1; (2) authorization to file a motion to dismiss the proceeding based on assignor estoppel; (3) authorization to file a motion to dismiss the proceeding based on EVE being a real party-in-interest; (4) authorization to file a motion to dismiss the proceeding based on Synopsys and Eve being in privity under 35 U.S.C. § 315(b); (5) authorization to file a motion for additional discovery on issue 3; (6) authorization to file a motion for additional discovery on issue 4; and (7) guidance on a motion to amend.

Extension of time

As set forth per the Scheduling Order entered February 22, 2013, the parties may stipulate to different dates for DUE DATES 1 through 3 (earlier or later, but not later than DUE DATE 4). The parties may not stipulate to an extension of DUE DATES 4-7.

In early May, 2013, the parties, at the request of Mentor Graphics, agreed to a one month extension for DUE DATES 1-3. Paper 26. Mentor Graphics seeks yet another extension of DUE DATE 1; this time for a one week extension beyond the already extended due date. Unlike the first time, no agreement could be made. As explained during the call, counsel for Synopsys opposes the one week extension because the schedule has already

been compressed by a month leaving a shorter time for Synopsys to respond to any papers filed by Mentor Graphics.

When the parties cannot agree to an extension of time between themselves, the Board will not normally change the times without a showing of good cause by the party requesting the extension of time. 37 C.F.R. § 42.5(c)(2). This requirement is consistent with the requirements of 35 U.S.C. § 316(a)(11) which provides that the Board issue a final decision not less than one year after institution of the review.

During the conference call, it became clear that counsel for Mentor Graphics seeks postponement of this proceeding pending a decision in two other cases.¹

As explained during the call, the Board is of the opinion that the instant proceeding can proceed at the same time as the other two pending cases and counsel for Mentor Graphics provided no reason to the contrary. Moreover, Mentor Graphics has had ample notice of the challenges to the 6,240,376 patent from the time the petition was filed nearly nine months ago. The issues for trial have been streamlined and simplified even further and Mentor Graphics has had nearly four months from the notification of institution of the trial to formulate its response.

Since counsel for Mentor Graphics did not present an adequate factual basis to support a good cause showing for extending Due Date 1, the request for an extension of DUE DATE 1 was denied.

¹ *Synopsis, Inc., EVE-USA, Inc. and Emulation and Verification Engineering S.A. v. Mentor Graphics Corp.*, 3:12-cv-05025-LB (N.D. Cal., filed September 27, 2013). See Paper 11 at 2. *Mentor Graphics Corporation v. Teresa Stanek Rea*, 1:13-cv-518 (E.D. Va., filed April 29, 2013). See Paper 26.

Mentor Graphics' Request to file motions to dismiss this proceeding

Counsel for Mentor Graphics requested leave to file three substantive motions to dismiss the instant proceeding. Specifically, Mentor Graphics seeks authorization to file (1) a motion to dismiss the proceeding based on assignor estoppel; (2) a motion to dismiss the proceeding based on EVE being a real party-in-interest; and (3) a motion to dismiss the proceeding based on Synopsys and Eve being in privity under 35 U.S.C. § 315(b).² In connection with issue 1 directly above, Mentor Graphics further requests an extension of the 15 page limit for the motion.

During the conference call, counsel for Mentor Graphics explained that it was his understanding that the patent owner response is limited per rule 37 C.F.R. § 42.120. That rule provides that a patent owner may file a response to the petition addressing any ground for unpatentability not already denied. The Board does not read the rule as precluding a patent owner response from including issues of standing. As explained, the issues Mentor Graphics seeks to raise per individual motions can all be addressed in its patent owner response. Counsel for Mentor Graphics did not contend otherwise. Accordingly, the Board denied Mentor Graphics' request to file the three separate motions.

Counsel for Mentor Graphics indicated that he may need additional pages beyond the 60 page limit for the patent owner response. However, no indication was made that Mentor Graphics currently has a draft patent owner

² Mentor Graphics has, on several occasions, raised these same issues and the Board has ruled on some of the issues. *See*, Papers 15, 16, 18, 19, 23 and 24.

response that will exceed the 60 page limit. Thus, no extension of the 60 page limit was granted.

Motions for additional discovery

Mentor Graphics seeks authorization to file two separate motions for additional discovery. Specifically, Mentor Graphics seeks authorization to file a motion for additional discovery on the basis that Synopsys and Eve are in privity for purposes of 35 U.S.C. § 315(b), and a separate motion for additional discovery on the basis that Eve is a real party-in-interest.

Mentor Graphics was authorized on March 21, 2013 to file a motion for additional discovery covering the same exact two issues. Paper 20. On March 29, 2013, Mentor Graphics filed a motion for additional discovery. Paper 21. On April 25, 2013, the Board denied the motion. Paper 24. The time for filing a request for rehearing of that decision was within 14 days of entry of the decision. 37 C.F.R. § 42.71(d)(1). Mentor Graphics did not file a rehearing request within the allotted time frame.

When asked why the Board should consider yet another motion(s) for additional discovery, counsel for Mentor Graphics indicated that having the advantage of the Board's previous decision on its first motion for additional discovery Mentor Graphics would like to supplement its explanation for why the discovery would be necessary for this proceeding. Counsel for Mentor Graphics also indicated that he was not given the opportunity to include in Mentor Graphics' motion for additional discovery, a request for additional discovery based on the issue of privity at the time of filing the petition. The Board disagrees. Mentor Graphics requested authorization to raise that issue

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