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Paper 25
Date: April 26, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHI MEI INNOLUX CORPORATION
Petitioner

v.

SEMICONDUCTOR ENERGY
LABORATORY CO., LTD.
Patent OWNER

Case IPR2013-00028 (SCM)
Patent 6,404,480 B2

Before SALLY C. MEDLEY, KARL D. EASTHOM, and KEVIN F. TURNER
Administrative Patent Judges.

MEDLEY, *Administrative Patent Judge.*

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

On April 24, 2013, the following individuals participated in the initial

conference call:[1]

(1) Mr. Scott McKeown and Mr. Gregory Cordrey, counsel for CMI;

(2) Mr. Eric Robinson, Mr. Sean Flood, Mr. Stanley Schlitter, and Mr. Douglas Peterson, counsel for SEL; and

(3) Sally Medley, Karl Easthom, and Kevin Turner, Administrative Patent Judges.

Motions List

In preparation for the initial call, SEL filed a motions list. Paper 24. CMI does not seek authorization to file any motions, but SEL does. The parties were reminded that the purpose of the motions list is to provide the Board and an opposing party adequate notice to prepare for the initial call and the proceeding. *See, e.g.*, 37 C.F.R. § 42.21(a) and *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48756, 48765 (Aug. 14, 2012). In particular, the list should contain a short, concise statement generally relaying enough information for the Board and opposing counsel to understand the proposed motion. As explained during the call, SEL's motions list with respect to its proposed motion for discovery regarding the real party-in-interest issue (*see, e.g.*, Paper 24, No. 3) does not provide adequate notice. Instead of dismissing the motions list, the Board determined to proceed with the motions list information and any other information provided during the conference call to determine whether to authorize a motion for discovery regarding the real party-in-interest issue.

[1] The initial conference call is held to discuss the Scheduling Order and any motions that the parties anticipate filing during the trial. *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48756, 48765 (Aug. 14, 2012).

Motion to Amend

During the call, counsel for SEL represented that at this time, SEL does not intend to file a motion to amend. As discussed, if SEL determines that it will file a motion to amend, SEL must arrange a conference call soon thereafter with the Board and opposing counsel to discuss the proposed motion to amend.

Motion for Additional Discovery

The parties were reminded that they may agree to additional discovery between themselves and only if they disagree is it necessary to seek Board authorization to file a motion for additional discovery. 37 CFR § 42.51(b)(2). The parties could not agree to the additional discovery listed per SEL's motions list (Nos. 2 and 3), and therefore SEL requests authorization to file a motion for additional discovery.

During the call, the Board explained that a party moving for additional discovery "must show that such additional discovery is in the interests of justice." *See* 35 U.S.C. § 316(a)(5) and 37 C.F.R. § 42.51(b)(2). Based on the facts presented during the initial conference call, the Board authorized SEL to file a single motion for discovery of (1) the information described in the second, third, and fourth bullets of No. 2 (pages 2-3) of SEL's motions list,[2] and (2) the information described per No. 3 (pages 3-4) of SEL's motions list.[3] CMI is authorized to file an opposition.

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[2] Counsel for SEL did not, during the call, present a sufficient basis for including the information provided per bullet 1 since the theory was based on speculation, *e.g.*, on what CMI may argue in a reply to SEL's patent owner response to the petition.

[3] As discussed and agreed upon, SEL is authorized to request obtaining such information from CMI and not from any of the listed co-defendants.

The Board advised counsel for SEL that the factors set forth in the "Decision - On Motion For Additional Discovery" entered in IPR2012-00001 (Paper 26 at 6-7) are important factors in determining whether a discovery request meets the statutory and regulatory necessary "in the interest of justice" standard. Accordingly, SEL's motion should explain with specificity the discovery requested and why such discovery is necessary "in the interest of justice" using those factors. In that regard, SEL should not expect the Board to attempt to sort through a list of items to ascertain which items may meet the necessary in the interest of justice standard. SEL bears the burden to demonstrate that the additional discovery (*e.g.*, each requested item) should be granted. *See* 37 C.F.R. § 42.20(c).

Schedule

Counsel for the respective parties indicated that they have no issues with the Scheduling Order (Paper 15) entered on March 21, 2013.

Settlement

The parties represented that they have no report regarding settlement.

Miscellaneous

Counsel for CMI indicated that CMI has undergone a name change. Despite counsel's representation that the company is the same and that the real party-in-interest has not changed (that only the name of the real party-in-interest has changed), the company name change should be identified to make clear who is the

petitioner in this proceeding. *See* 37 C.F.R. § 42.8(a)(3).[4] Accordingly, CMI must provide an update.

Order

It is

ORDERED that SEL is authorized to file a motion for additional discovery under 37 C.F.R. § 42.51(b)(2) by May 2, 2013, limited to 15 pages as specified in this order;

FURTHER ORDERED that CMI is authorized to file an opposition by May 9, 2013, limited to 15 pages;

FURTHER ORDERED that CMI shall provide an update of its company name change in compliance with 37 C.F.R. § 42.8(a)(3) by April 30, 2013; and

FURTHER ORDERED that no other motions are authorized at this time.

[4] In the event that the name change occurred more than twenty-one (21) days ago, the 37 C.F.R. § 42.8(a)(3) twenty-one (21) day requirement is waived for the sole purpose of allowing CMI to update its notice information. 37 C.F.R. § 42.5(b).

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