

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PNY TECHNOLOGIES, INC.
Petitioner

v.

PHISON ELECTRONICS CORP.
Patent Owner

Case IPR2013-00472
Patent 7,518,879

Before KEVIN F. TURNER, STEPHEN C. SIU, and
RAMA G. ELLURU, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

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

An initial conference call in the above proceeding was held on February 21, 2014, between respective counsel for Petitioner and Patent Owner, and Judges Turner, Siu, and Elluru. The purpose of the call was to discuss any proposed changes to the Scheduling Order (Paper 11) and any motions that the parties intend to file. Petitioner filed a proposed motions list, including motions for *pro hac vice* admission. As the panel indicated on the initial conference call, no prior authorization is required for motions for *pro hac vice* admission. Once filed, the panel will consider the motions in due course.

The parties also acknowledged that no protective orders are presently in place, that there are no initial disclosures, and that no additional discovery requests are being made at this time. The parties confirmed that no settlement discussions have occurred with respect to this proceeding, but acknowledged that the pending lawsuit, *Phison Electronics Corp. v. PNY Technologies, Inc.*, Civil Action No. 1:12-cv-01478-GMS (D. Del.), could have ongoing mediation efforts. The Board acknowledged the filing of a request for rehearing (Paper 12) by Patent Owner, which will be decided in due course.

Counsel for Patent Owner indicated that Patent Owner did not intend to file a motion to amend at this time. The Board directs the attention of the parties to *Nichia Corporation v. Emcore Corporation*, IPR2012-00005, Paper Nos. 27 and 68, *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027, Paper Nos. 26 and 66, and *ZTE Corporation and ZTE (USA) Inc. v. Contentguard Holdings, Inc.*, IPR2013-00136, Paper No. 33, which discuss

the requirements of a motion to amend claims. If the Patent Owner decides to file a motion to amend claims, it must initiate a conference call with the Board prior to such filing to confer about the intended motion.

Patent Owner inquired about the possibility of joining the instant proceeding with a proceeding for *PNY Technologies, Inc. v. Phison Electronics Corp.*, IPR2014-00150, should a trial be instituted in the latter, where the latter involves the same parties, covering the same patent, albeit with slightly different sets of claims subject to review. In the latter, Patent Owner's preliminary response is due February 27, 2014, and Patent Owner inquired whether it would be appropriate to file a motion for joinder, per 35 U.S.C. § 325(c), along with any preliminary response. The panel indicated that some type of consolidation of the proceedings had been discussed by the panel. The panel also indicated that no decision on institution of the latter proceeding would occur until after the Patent Owner had filed a preliminary response in the instant proceeding, or the due date for such a filing had elapsed. The Board authorizes the filing of a motion for joinder, which can be either a motion filed by one party, or can be a joint motion for joinder. If the motion for joinder is a joint motion, the Board also authorizes the filing of a proposed revised scheduling order, which could be used in the joined proceeding.

The Board reminds the parties that prior authorization is required for all motions. *See* 37 C.F.R. § 42.20(b). The Board is available for additional conference calls should the need arise due to issues that the parties are not able to resolve on their own.

Order

It is

ORDERED that all due dates set in the Scheduling Order dated February 4, 2014 (Paper 11), remain unchanged;

FURTHER ORDERED that Patent Owner is authorized to file a motion for joinder with IPR2014-00150 with its Patent Owner preliminary response, or Petitioner is authorized to file a motion for joinder with IPR2014-00150, or the parties are authorized to file a joint motion for joinder with IPR2014-00150; and

FURTHER ORDERED that a joint motion for joinder, if agreed to and filed by both parties, and may be accompanied by a proposed revised scheduling order, proposing due dates for such a joined proceeding.

Case IPR2013-00472
Patent 7,518,879

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