

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WINTEK CORPORATION
Petitioner

v.

TPK TOUCH SOLUTIONS
Patent Owner

Case IPR2013-00568
Patent 8,217,902

Before JOSIAH C. COCKS, RICHARD E. RICE, and ADAM V. FLOYD
Administrative Patent Judges.

COCKS, *Administrative Patent Judge.*

INITIAL CONFERENCE SUMMARY

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

1. Introduction

On March 27, 2014, an initial conference call in IPR2013-00568, which involves U.S. Patent No. 8, 217,902 (the “’902 patent”), was conducted between respective counsel for the parties and Judge Cocks. Petitioner, Wintek Corporation (“Wintek”), was represented by Joseph Palys and Naveen Modi. Patent Owner, TPK Touch Solutions (“TPK”), was represented by Joseph Richetti. The purpose of the call was to determine if the parties have any issues concerning the Scheduling Order (Paper 11) and to discuss any motions contemplated by the parties. Prior to the call, Wintek filed a paper indicating that it does not contemplate filing any motions at this time. Paper 13. TPK filed a paper indicating that it may file a motion to amend. Paper 15.

Counsel for Wintek represented that it had arranged for a court reporter to be present on the call. The Board indicated that, when available, a transcript of the call should be filed in this *inter partes* review proceeding as an exhibit.

2. Related Matters

The parties have identified the following related matters involving the ’902 patent; an *ex parte* reexamination (Control No. 90/012,869), and litigation filed on May 15, 2013 in the North District of California (case no. 3:13-cv-2218). A joint motion to stay the *ex parte* reexamination is pending in this *inter partes* review. The Board indicated that the motion would be decided in a separate paper. The parties indicated that litigation is pending and has entered a Discovery phase.

During the call, counsel for Wintek indicated that it had recently filed an additional Petition directed to claims of the ’902 patent and that the Petition included a motion for joinder in connection with this *inter partes* review, IPR2013-00568, as well as related proceeding, IPR2013-00567. The Board stated that

discussion of joinder of a separate *inter partes* proceeding for which trial has not been instituted is premature in connection with this initial conference call.

3. *Scheduling Order*

Neither party indicated any issues with respect to the Scheduling Order. The parties are reminded that, without obtaining prior authorization from the Board, they may stipulate to different dates for DATES 1-3 by filing an appropriate notice with the Board. The parties may not stipulate to any other changes to the Scheduling Order.

4. *Protective Order*

The parties have not discussed a protective order at this time and do not anticipate needing a protective order. No protective order has been entered. Should circumstances change, the parties are reminded of the requirement for a protective order when filing a Motion to Seal. 37 C.F.R. § 42.54. If the parties choose to propose a protective order other than or departing from the default Standing Protective Order, Office Trial Practice Guide, 77 Fed. Reg. 48,756, App. B (Aug. 14, 2012), they must submit a joint, proposed protective order, accompanied by a red-lined version based on the default protective order in Appendix B to the Board's Office Patent Trial Practice Guide. *See id.* at 48,769.

5. *Discovery*

The parties are reminded of the discovery provisions of 37 C.F.R. §§ 42.51-52 and Office Trial Practice Guide. *See* 77 Fed. Reg. at 48,761-2. Discovery requests and objections are not to be filed with the Board without prior authorization. If the parties are unable to resolve discovery issues between them, the parties may request a conference with the Board. A motion to exclude, which does not require Board authorization, must be filed to preserve any objection. *See*

37 C.F.R. § 37.64, Office Trial Practice Guide, 77 Fed. Reg. at 48,767. Counsel for TPK indicated that there is possibility of a dispute between the parties as to a need for additional discovery in this proceeding, but that the parties had not yet discussed the matter between them. At this time, there are no discovery issues pending for resolution by the Board.

Each party may depose experts and affiants supporting the opposing party. The parties are reminded of the provisions for taking testimony found at 37 C.F.R. § 42.53 and the Office Trial Practice Manual at 77 Fed. Reg. at 48,772, App. D.

6. Motions

The parties are reminded that, except as otherwise provided in the Rules, Board authorization is required before filing a motion. 37 C.F.R. § 42.20(b). A party seeking to file a motion should request a conference to obtain authorization to file the motion. No motions are authorized in this proceeding at this time.

7. Motion to Amend

Although TPK may file one motion to amend the patent by cancelling or substituting claims without Board authorization, TPK must confer with the Board before filing a motion to amend. 37 C.F.R. § 42.121(a). During the call, TPK indicated that its contemplation of an amendment is only preliminary at this stage. The Board informed the parties that this initial conference call does not satisfy TPK's obligation to confer with the Board prior to filing a motion to amend.

The Board takes this opportunity to remind TPK that in filing a motion to amend, as the moving party, it bears the burden of proof in establishing entitlement for the requested relief. *See* 37 C.F.R. § 42.20(c). The Board advised TPK that a motion to amend must explain in detail how any proposed substitute claim obviates the grounds of unpatentability authorized in this proceeding, explain how any

substitute claim is patentable generally over the prior art known to the TPK, and clearly identify where the corresponding written description support in the original disclosure can be found for each substitute claim. If the motion to amend includes a proposed substitution of claims beyond a one-for-one substitution, the motion must explain why more than a one-for-one substitution of claims is necessary.

For further guidance regarding these requirements, TPK is directed to prior Board decisions concerning motions to amend, including *Nichia Corporation v. Emcore Corporation*, IPR2012-00005, Paper No. 27 (June 3, 2013); *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027, Paper No. 26 (June 11, 2013), Paper No. 66 (January 7, 2014); *ZTE Corp. v. ContentGuard Holdings*, IPR2013-00136, Paper 33 (November 7, 2013); and *Invensense, Inc. v. STMicroelectronics, Inc.*, IPR2013-00241, Paper No. 21, (January 9, 2014) ; and *Toyota Motor Corp. v. American Vehicular Sciences LLC*, IPR2013-00419, Paper 32 (March 7, 2014).

8. Settlement

The parties stated that there is no immediate prospect of settlement that will affect the conduct of this proceeding.

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