

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WINTEK CORPORATION,
Petitioner.

v.

TPK TOUCH SOLUTIONS,
Patent Owner.

Case IPR2013-00567
Case IPR2013-00568
Case IPR2014-00541¹
Patent 8,217,902

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

COCKS, *Administrative Patent Judge.*

ORDER

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

¹ This Order addresses matters pertaining to all three identified cases. Therefore, we exercise our discretion to issue one Order to be filed in each case. Other than the motions and oppositions authorized in this Order, the parties are not authorized to use this style heading for any subsequent papers.

1. Introduction

On April 14, 2014, a conference call (“first conference call”) in connection with related cases IPR2013-00567, IPR 2013-00568, and IPR2014-00541, all of which involve U.S. Patent No. 8, 217,902 (the “’902 patent”), was conducted between respective counsel for the parties and Judges Cocks, Rice, and Floyd. Petitioner, Wintek Corporation (“Wintek”), was represented by Joseph Palys and Naveen Modi. Patent Owner, TPK Touch Solutions (“TPK”), was represented by Joseph Richetti and David Bilsker. The call was requested by Wintek to discuss the following issues:

1. TPK’s request for discovery relating to prior testimony of Wintek’s expert in U.S.I.T.C. Inv. No. 337-TA-750; and
2. Wintek’s motion for joinder filed in IPR2014-00541 and proposed modifications to the schedule of that matter, and the schedules of IPR2013-00567 and IPR2013-00568, to align the schedule of the proceedings.

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

On April 21, 2014, a second conference call (“second conference call”) was conducted in connection with the involved *inter partes* review proceedings to further discuss the above-noted issue #2. A court reporter was on-line for the second call, and counsel for Wintek was asked to provide a transcript of the call as an exhibit in each proceeding.

2. Discussion

a. Issue 1

During the first conference call, counsel for Wintek indicated that TPK had requested from Wintek production of an expert report submitted by Wintek's declarant, Dr. Vivek Subramanian, in connection with a separate United States International Trade Commission ("ITC") proceeding involving the '902 patent.

Counsel for TPK stated that TPK believed that the report contained testimony from Dr. Subramanian that is inconsistent with testimony in the involved *inter partes* review proceedings concerning the '902 patent. TPK informed the Board that it drew that inference from a reference to the testimony in the decision of the ITC, and TPK believed that other portions of the report possibly may contain additional inconsistencies. TPK queried the Board as to the possibility of a Board-issued subpoena to pursue production of the report by a third-party or Board authorization for TPK to seek such a subpoena through District Court.

Counsel for Wintek represented to the Board that Wintek does not believe that the pertinent expert report from Dr. Subramanian contains statements that are inconsistent with those made by Dr. Subramanian in the involved *inter partes* review proceedings. Counsel for Wintek also stated that neither it nor Dr. Subramanian retained copies of the report. Wintek explained that the report had been the subject of a protective order in the ITC proceeding and that on conclusion of that proceeding all copies of the report had been destroyed in accordance with the protective order.

The panel informed the parties that the Board does not have subpoena power. When queried, counsel for TPK agreed that when deposing Dr. Subramanian in the involved *inter partes* review proceedings, it can question Dr. Subramanian concerning statements made by him that appear or are referenced

in the written decision of the ITC in the noted proceeding. TPK also acknowledged that it did not know if other testimony of Dr. Subramanian in the expert report was inconsistent with testimony presented in the involved *inter partes* review proceedings.

At this time, TPK is not authorized to seek production from Wintek or a third-party of Dr. Subramanian's expert report in U.S.I.T.C. Inv. No. 337-TA-750. TPK, however, is authorized to file a motion seeking authorization to compel production of that report pursuant to 37 C.F.R. § 42.52. As a part of the motion, TPK should explain its basis for believing that the expert report contains statements from Dr. Subramanian that are inconsistent with statements made by Dr. Subramanian as part of these *inter partes* review proceedings. TPK also should include with the motion any underlying documentation that supports its belief. TPK may file the motion by no later than 5 pm Eastern Time on April 30, 2014. The motion shall not exceed 10 pages.

Should TPK file the above-noted motion, Wintek is authorized to file an opposition by no later than 5 pm Eastern Time on May 7, 2014. As a part of any opposition, Wintek should explain the circumstances surrounding the destruction of the pertinent expert report including where, to the best of its knowledge, any copies of the report (paper or electronic) are located and the dates and reasons for destruction of any and all copies of the report. The opposition shall not exceed 10 pages.

b. Issue 2

Wintek filed a motion for joinder that accompanied the filing of the petition for *inter partes* review in IPR2014-00541. In the motion for joinder, Wintek "moves to join grounds 1 and 2 of this proceeding with IPR2013-00567 and grounds 3 and 4 of this proceeding with IPR2013-00568, or in the alternative,

joinder is requested of all four grounds of this proceeding with either IPR2013-00567 or IPR2013-00568.” IPR2014-00541, Paper 3, 1.

The Board has not yet decided whether or not to institute trial in connection with IPR2014-00541 and has not decided the motion for joinder in that case. Nevertheless, during the conference call, counsel for Wintek requested that the “scheduling” of the IPR2014-00541 proceeding be “modified” so as to align with the scheduling of the IPR2013-00567 and IPR2013-00568 proceedings. More specifically, Wintek requested that the Board expedite the IPR2014-00541 proceeding so as to impose a two-week time period for TPK to file its preliminary patent owner response in that proceeding. As support for the request, Wintek directed the Board to a separate *inter partes* review proceeding, *Ariosa Diagnostics v. Isis Innovation Limited*, IPR2013-00250 (“*Ariosa*”).

During the first call, the panel informed Wintek that its request in connection with scheduling of the proceeding in IPR2014-00541 seemed premature. That the Board has not yet determined whether to institute trial in IPR2014-00541 means that there is no “scheduling” to modify. During the first conference call, counsel for TPK also expressed that it was not agreeable to a shortened period of two weeks to file a preliminary patent owner response in the IPR2014-00541 proceeding.

During the second conference call, the Board sought clarification of TPK’s view as to the possibility of expediting the preliminary patent owner response. In response, counsel for TPK explained that it was willing to expedite the filing of its preliminary patent owner response and expressed a willingness to work with counsel for Wintek to develop a schedule in connection with the Scheduling Orders in IPR2013-00567 and IPR2013-00568 and to consider the possibility of a

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.