

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TAIWAN SEMICONDUCTOR MANUFACTURING COMPANY, LTD, TSMC  
NORTH AMERICA CORPORATION, FUJITSU SEMICONDUCTOR  
LIMITED, and FUJITSU SEMICONDUCTOR AMERICA, INC.,

Petitioners,

v.

ZOND, LLC,  
Patent Owner.

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Cases IPR2014-00799 and IPR2014-00803  
Patent 7,808,184 B2<sup>1</sup>

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Before KEVIN F. TURNER, JONI Y. CHANG, SUSAN L. C. MITCHELL, and  
JENNIFER M. MEYER,  
*Administrative Patent Judges.*

MITCHELL, *Administrative Patent Judge.*

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

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<sup>1</sup> This Order addresses the same issues in all of the above-identified cases.  
Therefore, we issue one Order to be filed in all cases.

Cases IPR2014-00799 and IPR2014-00803  
Patent 7,808,184 B2

Cases IPR2014-00799 and IPR2014-00803  
Patent 7,808,184 B2

On October 1, 2014, we instituted an *inter partes* review in each of the above-identified proceedings to review the claims of U.S. Patent No. 7,808,184 B2 (“the ’184 patent”). Paper 10.<sup>2</sup> For efficiency, we entered a single Scheduling Order that sets forth the due dates for the parties to take action in both reviews, ensuring that the reviews will be completed within one year of institution. Paper 11. After institution, we also granted the revised Motions for Joinder filed by Fujitsu Semiconductor Limited and Fujitsu Semiconductor America, Inc. (collectively, “Fujitsu”). IPR2014-00855, Paper 12; IPR2014-00858, Paper 13. A list of these Joinder Cases and a list of the cases awaiting decision at the time of the conference call that also seek joinder are provided in the Appendix to the instant Order.

An initial conference call was held on October 28, 2014, between respective counsel for the parties for the above-identified reviews and Judges Chang, Turner, Stephens, Mitchell, and Meyer. Counsel for The Gillette Company, a Petitioner seeking joinder, and counsel seeking *pro hac vice* admission on behalf of Taiwan Semiconductor Manufacturing Company, Ltd. and TSMC North America Corporation (collectively, “TSMC”) also attended the conference call. The purpose of the call was to discuss any proposed changes to the Scheduling Order (Paper 11), as well as any motions that the parties intend to file.

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<sup>2</sup> For the purpose of clarity and expediency, we treat IPR2014-00799 as representative, and all citations are to IPR2014-00799 unless otherwise noted.

*Trial Schedule*

During the conference call, we explained that the trial schedule for the above-identified reviews had been synchronized. The Scheduling Order provides certain flexibility for the parties to change Due Dates 1 through 5. Paper 11, 2. Should the parties believe that there is a good reason for changing other due dates, they may contact the Board to set up a conference call with us. The parties indicated that they do not, at this time, foresee any problems with meeting their due dates.

In Petitioners' Notice of Proposed Motions, they indicated that they are discussing possible changes to dates in the Scheduling Order, and stated during the conference that the parties were close to agreement, but none had been reached yet. As the Petitioners acknowledged in their Notice of Proposed Motions, if an agreement to adjust the due dates is reached, the parties should file promptly a notice of stipulation, which should include a copy of the due date appendix of the Scheduling Order, showing the new due dates next to the original due dates. Paper 11, 2, 6.

We further noted that the oral hearings for both reviews are scheduled on the same day. The oral hearings will be merged and conducted at the same time, and the transcript from the combined oral hearing is useable across both reviews, given the similarity in claimed subject matter and overlapping asserted prior art.

*The Procedure for Consolidated Filings and Discovery*

The Joinder Decisions set forth a procedure for consolidated filings and discovery. IPR2014-00855 (Paper 12) 5–6; IPR2014-00858 (Paper 13) 5–6. Upon

inquiry from the Board, the parties stated that they understand and did not have any issues with the procedure.

Given the similarity in claimed subject matter and overlapping asserted prior art and that Petitioners' submitted declarations from the same expert witness in each review, the parties expressed the desire to coordinate and combine discovery between both reviews and, possibly, also with other proceedings that involve the parties. Should the parties combine discovery of the above-identified reviews, which involve the '184 patent, with other proceedings that involve *another patent*, the parties are encouraged to keep the record clear as to each proceeding and each patent.

*Motion for pro hac vice admission under 37 C.F.R. § 42.10(c).*

Petitioners filed a Notice of Proposed Motions indicating that they will file a motion for *pro hac vice* admission. Paper 13. We previously authorized the parties to file motions for *pro hac vice* admission. Paper 3, 2. On October 28, 2014, Petitioners filed a motion for *pro hac vice* admission of Mr. Anthony J. Fitzpatrick in the above-identified reviews. Paper 14. We stated that we could expedite resolution of the motion if Patent Owner did not oppose the motion. Counsel for Patent Owner offered a tentative agreement not to oppose the motion pending agreement by Patent Owner.

Patent Owner is authorized to file an opposition no later than one week after the filing of the Petitioners' motion for *pro hac vice* admission. *See* Paper 3, 2; *Unified Patents, Inc. v. Parallel Iron, LLC*, Case IPR2013-00639, slip op. at 3 (PTAB Oct. 15, 2013) (Paper 7). Because we have no unequivocal representation

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