

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TAIWAN SEMICONDUCTOR MANUFACTURING COMPANY, LTD., TSMC
NORTH AMERICA CORPORATION, FUJITSU SEMICONDUCTOR
LIMITED, FUJITSU SEMICONDUCTOR AMERICA, INC., ADVANCED
MICRO DEVICES, INC., RENESAS ELECTRONICS CORPORATION,
RENESAS ELECTRONICS AMERICA, INC., GLOBAL FOUNDRIES U.S.,
INC., GLOBALFOUNDRIES DRESDEN MODULE ONE LLC & CO. KG,
GLOBALFOUNDRIES DRESDEN MODULE TWO LLC & CO. KG, TOSHIBA
AMERICA ELECTRONIC COMPONENTS, INC., TOSHIBA AMERICA INC.,
TOSHIBA AMERICA INFORMATION SYSTEMS, INC., TOSHIBA
CORPORATION, and THE GILLETTE COMPANY
Petitioners,

v.

ZOND, LLC,
Patent Owner.

Cases IPR2014-00800, IPR2014-00802, and IPR2014-00805
Patent 7,811,421 B2¹

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

CHANG, *Administrative Patent Judge*.

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

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

Cases IPR2014-00800, IPR2014-00802, and IPR2014-00805
Patent 7,811,421 B2

On October 6, 2014, we instituted an *inter partes* review in each of the above-identified proceedings to review the claims of U.S. Patent No. 7,811,421 B2 (“the ’421 patent”). Paper 9.² For efficiency, we entered a single Scheduling Order that sets forth the due dates for the parties to take action in all three reviews, ensuring that the reviews will be completed within one year of institution. Paper 10. After institution, we also granted the revised Motions for Joinder filed by Fujitsu Semiconductor Limited and Fujitsu Semiconductor America, Inc. (collectively, “Fujitsu”), Advanced Micro Devices, Inc., Renesas Electronics Corporation, Renesas Electronics America, Inc., GLOBALFOUNDRIES U.S., Inc., GLOBALFOUNDRIES Dresden Module One LLC & Co. KG, GLOBALFOUNDRIES Dresden Module Two LLC & Co. KG, Toshiba America Electronic Components, Inc., Toshiba America Inc., Toshiba America Information Systems, Inc., and Toshiba Corporation (collectively, “AMD”), and The Gillette Company (“Gillette”). Papers 12, 13. A list of these Joinder Cases is provided in the Appendix of the instant Order.

An initial conference call was held on October 29, 2014, between respective counsel for the parties for the above-identified reviews and Judges Chang, Mitchell, and Meyer. Counsel for each of the Joinder Cases also attended the conference call. The purpose of the call was to discuss any proposed changes to the Scheduling Order (Paper 10), as well as any motions that the parties intend to file.

² For the purpose of clarity and expediency, we treat IPR2014-00800 as representative, and all citations are to IPR2014-00800 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 10, 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. They also expressed that they may stipulate to different dates for certain due dates as to Due Dates 1 through 5. If the parties decide to stipulate to different due dates, the parties should file promptly a notice of stipulation that includes a copy of the due date appendix of the Scheduling Order, showing the new due dates next to the original due dates. Paper 10, 2, 5.

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

Currently, the oral hearing is scheduled on June 4, 2015 (Due Date 7). Paper 10, 6. We indicated that, due to a scheduling conflict for the Board's hearing rooms, the oral hearing is rescheduled to June 8, 2015. If the parties are not available on June 8, 2015, the revised date for the oral hearing, they should notify the Board within 2 business days via electronic mail, and jointly propose several dates for the oral hearing near the same timeframe. We will enter a revised Scheduling Order, to reflect the change to Due Date 7, in due course.

The Procedure for Consolidated Filings and Discovery

As we noted during the conference call, the Decisions on the revised Motions for Joinder (“the Joinder Decisions”) did not change the grounds of unpatentability on which a trial was instituted or the Scheduling Order, in each of the above-identified reviews. *See, e.g.*, Paper 13. And the Joinder Decisions set forth a procedure for consolidated filings and discovery. *Id.* at 5–7. Upon inquiry from the Board, the parties stated that they are in agreement with the procedure.

The parties indicated that they have been engaging in discussions regarding the discovery schedule. 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 further expressed the desire to coordinate and combine discovery between all three reviews and, possibly, also with other proceedings that involve the parties. We observed that such coordination and consolidation may be helpful in streamlining the proceedings, and reduced the cost and burden on the parties. For example, cross-examination of Petitioners’ expert witness may be combined and useable in all three reviews, for efficiency and consistency. Should the parties combine discovery of the above-identified reviews, which involve the ’421 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 14. 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 15. Petitioners further provided a list of other cases in which Petitioners filed such a motion, to assist the Board in expediting our decisions on the motions.

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). Upon inquiry from the Board, Patent Owner stated that it will not oppose Petitioners' motions for *pro hac vice* admission of Mr. Fitzpatrick, as the parties agreed not to oppose the motions for *pro hac vice* admission of each party's respective litigation counsel. As we articulated during the conference call, we are not a party to such an agreement and we will not enforce such an agreement. Each Petitioners' motion will be decided in due course, after the expiration of the one-week time period or the filing of an opposition, whichever is earlier.

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