

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TAIWAN SEMICONDUCTOR MANUFACTURING COMPANY, LTD., TSMC
NORTH AMERICA CORP., FUJITSU SEMICONDUCTOR LIMITED, FUJITSU
SEMICONDUCTOR AMERICA, INC., 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., TOSHIBA CORPORATION, and
THE GILLETTE COMPANY,
Petitioner,

v.

ZOND, LLC,
Patent Owner.

Cases IPR2014-00818, IPR2014-00819, IPR2014-0821,
IPR2014-0827, and IPR2014-01098¹
Patent 6,853,142 B2

Before KEVIN F. TURNER, JONI Y. CHANG, and JENNIFER M. MEYER,
Administrative Patent Judges.

TURNER, *Administrative Patent Judge.*

¹ IPR2014-00866, IPR2014-01012, and IPR2014-01075 have been joined with IPR2014-00818; IPR2014-00867, IPR2014-01014, and IPR2014-01046 have been joined with IPR2014-00819; IPR2014-00863, IPR2014-01013, and IPR2014-01057 have been joined with IPR2014-00821; IPR2014-00865, IPR2014-01015, and IPR2014-01063 have been joined with IPR2014-00827; and IPR2014-01016 has been joined with IPR2014-01098.

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IPR2014-0827, and IPR2014-01098
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ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

We instituted *inter partes* review in each of the above-identified proceedings to review the claims of U.S. Patent No. 6,853,142 (“the ’142 Patent”). Paper 9.² A list of Joinder Cases is provided in the Appendix of the instant Order. For efficiency, we synchronized the Scheduling Orders that set forth the due dates for the parties to take action for each of the above-identified reviews, ensuring that the reviews will be completed within one year of institution. *See* Paper 10. An initial conference call was held on November 25, 2014, between respective counsel for the parties³ for the above-identified reviews and Judges Turner, Chang, and Meyer. The purpose of the call was to discuss any proposed changes to the Scheduling Orders, as well as any motions that the parties intend to file, and to address questions that the parties might have.

Trial Schedule

The parties indicated that they do not, at this time, foresee any problems with meeting the due dates set forth in the Scheduling Orders. We remind the parties that they may stipulate to different dates for Due Dates 1–5. If the parties decide to stipulate to different due dates, the parties should file 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.

² For the purpose of clarity and expediency, we treat IPR2014-00818 as representative, and all citations are to IPR2014-00818 unless otherwise noted.

³ We note that Petitioner in IPR2014-01098 is limited to GLOBALFOUNDRIES U.S., Inc., GLOBALFOUNDRIES Dresden Module One LLC & Co. KG, and GLOBALFOUNDRIES Dresden Module Two LLC & Co. KG, and The Gillette Company.

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We noted that the oral hearings for each of the above-identified reviews are scheduled on the same day. The parties may request a single-combined oral hearing in their requests for oral hearing on or before Due Date 4. Given the similarity in claimed subject matter and overlapping asserted prior art, the transcript from the combined oral hearing could be usable across all of the above-identified reviews.

The Procedure for Consolidated Filings and Discovery

As we noted during the conference call, the Decisions on the Motions for Joinder (“the Joinder Decisions”) did not change the grounds of unpatentability on which a trial was instituted or the Scheduling Orders, in each of the original reviews. The Joinder Decisions set forth a procedure for consolidated filings and discovery. The parties stated that they are in agreement with the procedure.

Given the similarity in claimed subject matter and overlapping asserted prior art and that Petitioner submitted declarations from the same expert witness in each review, the parties may coordinate and combine discovery for these proceedings, as well as other proceedings involving the parties, but different patents. For example, cross-examination of Petitioners’ declarant may be combined and useable in each of the above-identified reviews, for efficiency and consistency. Should the parties combine discovery of the above-identified reviews, which involve the ’142 Patent, with other proceedings that involve *another patent*, the parties are encouraged to keep the record clear as to each proceeding and each patent.

The parties indicated that there were no issues with the upcoming cross-examination of Petitioners’ declarant, Dr. Kortshagen, scheduled to occur on December 3 and 4, 2014.

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Motions for Pro Hac Vice Admission

During the conference call, Zond indicated that it did not oppose the pending motions for pro hac vice admission by Petitioners. We also reminded the parties that indicating to the Board whether identical or similar motions are being filed in particular proceedings allows for those motions to be decided concordantly. We also counseled that agreements between the parties, in particular indications of opposition or non-opposition to particular motions and/or papers, assist the Board in making speedy decisions on such motions and/or papers.

Incorporation by Reference is Prohibited

During the conference call, we reminded the parties that incorporation by reference from one document to another is not permitted under our rules. *See* 37 C.F.R. § 42.6(a)(3). We observed that, in a family of cases challenging the same patent, as here, briefing papers may cross-reference between different *inter partes* reviews, but incorporation by reference is still prohibited. For example, the Patent Owner Response or Reply to a Patent Owner Response filed in one proceeding may not incorporate by reference arguments submitted in another proceeding. Each briefing paper must stand on its own, with appropriate supporting evidence.

Objections and Motions to Exclude Evidence

We remind the parties that while certain due dates are set forth in the Scheduling Orders, the times for serving objections to evidence are set forth in 37 C.F.R. § 42.64(b). For instance, the parties are not required to seek prior authorization for filing a motion to exclude evidence under 37 C.F.R. § 42.64(c), a motion for observation regarding cross-examination of a reply witness, and a response to such observation because the Scheduling Orders set forth the due date

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for these motions and responses. However, any objection to evidence submitted during a preliminary proceeding must be served within *ten* business days of the institution of the trial. After institution, any objection must be served within *five* business days of service of evidence to which the objection is directed. The parties further should note that a motion to exclude evidence must identify and explain the objections.

ORDER

It is

ORDERED that the parties are authorized to request a single-combined oral hearing for the above-identified *inter partes* reviews; and

FURTHER ORDERED that the parties are authorized to consolidate discovery for the above-identified *inter partes* reviews, so that the cross-examination and redirect examination may be usable in each of the above-identified *inter partes* reviews.

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