

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MACRONIX INTERNATIONAL CO., LTD., MACRONIX ASIA
LIMITED, MACRONIX (HONG KONG) CO., LTD., and
MACRONIX AMERICA, INC.,
Petitioner,

v.

SPANSION LLC,
Patent Owner.

Case IPR2014-00103 (Patent 6,369,416 B1)
Case IPR2014-00104 (Patent 6,459,625 B1)
Case IPR2014-00105 (Patent 6,731,536 B1)
Case IPR2014-00108 (Patent 7,151,027 B1)
Case IPR2014-00898 (Patent 7,151,027 B1)¹

Before HOWARD B. BLANKENSHIP, DEBRA K. STEPHENS,
KRISTEN L. DROESCH, JUSTIN T. ARBES, and
RICHARD E. RICE, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

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

¹ This Order addresses issues pertaining to all five cases. We exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

Cases IPR2014-00103, IPR2014-00104, IPR2014-00105, IPR2014-00108, and IPR2014-00898

An initial conference call in Cases IPR2014-00103, IPR2014-00104, IPR2014-00105, and IPR2014-00108 was held on June 5, 2014, among respective counsel for Petitioner and Patent Owner, and Judges Blankenship, Stephens, Droesch, Arbes, and Rice. The purpose of the call was to discuss any proposed changes to the Scheduling Order in each proceeding and any motions the parties intend to file. Prior to the call, the parties filed lists of proposed motions. *See* IPR2014-00103, Paper 11; IPR2014-00104, Papers 12, 13; IPR2014-00105, Papers 16, 17; IPR2014-00108, Paper 18. A subsequent conference call was held on June 9, 2014, regarding Cases IPR2014-00108 and IPR2014-00898. The following issues were discussed during the calls.

Schedule

The parties indicated that they had no issues with DUE DATES 1-6 in the Scheduling Order in each proceeding. Patent Owner requested that DUE DATE 7 be modified for at least some of the four instituted proceedings to allow the parties sufficient time to prepare in between hearings. We instructed the parties to confer with each other and provide, in a single email to *Trials@uspto.gov*, several other dates when both parties would be available for oral argument during the weeks of January 12 and 19, 2015. Patent Owner's request will be subject to Board availability. The parties also are reminded that they may stipulate to different dates for DUE DATES 1 through 3 in the Scheduling Orders (provided the dates are no later than DUE DATE 4) and, if they do so, the parties shall file promptly a notice of the stipulation.

Cases IPR2014-00103, IPR2014-00104, IPR2014-00105, IPR2014-00108, and IPR2014-00898

Motion for Additional Discovery

Patent Owner stated that it intends to seek additional discovery regarding secondary considerations of nonobviousness, such as copying, in Case IPR2014-00105. Patent Owner indicated that it had mentioned the issue to Petitioner, but had not yet conferred about the matter in detail. We advised the parties that they should continue their discussions and, if the parties are unable to reach an agreement, Patent Owner may request another conference call to seek authorization to file a motion for additional discovery under 37 C.F.R. § 42.51(b)(2). To make the parties' discussions more productive, Patent Owner should identify for Petitioner, as specifically as possible, exactly what materials Patent Owner is requesting.

The parties also are directed to *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 (Mar. 5, 2013), for guidance regarding motions for additional discovery. In particular, the mere possibility of finding something useful and a mere allegation that something useful will be found are insufficient. Further, requests for discovery will not be granted if they are unduly broad and burdensome.

Motion to Submit Supplemental Information

Petitioner requested authorization to file, in Cases IPR2014-00104 and IPR2014-00105, a motion to submit certain documents as supplemental information pursuant to 37 C.F.R. § 42.123(a). Petitioner stated that after filing its petitions in the instant proceedings, Patent Owner's technical expert, Sanjay Banerjee, Ph.D, and the named inventor of the challenged patent in IPR2014-00105 were deposed in the U.S. International Trade Commission investigation involving the two challenged patents, *Certain*

Cases IPR2014-00103, IPR2014-00104, IPR2014-00105, IPR2014-00108, and IPR2014-00898

Flash Memory Chips and Products Containing Same, Inv. No. 337-TA-893.

Petitioner argued that certain excerpts of the deposition transcripts, expert reports, and exhibits are relevant to the instant proceedings because they discuss the challenged patents and prior art. Patent Owner responded that Petitioner had not yet identified the specific portions of the documents it would like to submit as supplemental information. Patent Owner also expressed its concern that any new information that is submitted be complete, rather than merely excerpts. As discussed during the call, Petitioner should identify for Patent Owner the specific portions of the documents and, if the parties are unable to reach an agreement, Petitioner may request another conference call to seek authorization to file a motion to submit supplemental information.

Motion to Amend

Patent Owner stated that it had not yet determined whether it intends to file a motion to amend in any of the four instituted proceedings. If Patent Owner decides to file a motion to amend, Patent Owner must request a conference call and confer with the Board before doing so. *See* 37 C.F.R. § 42.121(a). The parties are referred to *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027, Paper 26 (June 11, 2013), and *Toyota Motor Corp. v. American Vehicular Sciences LLC*, IPR2013-00419, Paper 32 (Mar. 7, 2014), for guidance regarding the requirements for motions to amend.

Cases IPR2014-00103, IPR2014-00104, IPR2014-00105, IPR2014-00108, and IPR2014-00898

Joinder

On May 8, 2014, we instituted an *inter partes* review of claims 1-6 and 8-13 of U.S. Patent No. 7,151,027 B1 (“the ’027 patent”) in Case IPR2014-00108, and denied institution as to claims 7 and 14. On June 4, 2014, Petitioner filed a new petition in Case IPR2014-00898 challenging claims 7 and 14, along with a motion for joinder with Case IPR2014-00108.

Patent Owner stated during the call on June 9, 2014 that it intends to oppose the motion for joinder. As discussed during the call, Patent Owner will be permitted to file an opposition to the motion for joinder by June 23, 2014. Petitioner, in its motion, did not provide a proposed revised trial schedule for the joined proceeding if its motion is granted. Petitioner shall file a notice with its proposed dates by June 13, 2014. The notice may not contain any argument. In its opposition, Patent Owner should address Petitioner’s proposed revised trial schedule and state, if joinder is granted, what schedule Patent Owner would propose.

We also addressed the time period for any preliminary response in Case IPR2014-00898. As explained during the call, given that the petition in Case IPR2014-00898 challenges only two claims based on one ground of unpatentability, an expedited schedule is appropriate. The due date for Patent Owner to file a preliminary response in Case IPR2014-00898, should it choose to do so, will be set to July 16, 2014.

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner is not authorized to file a motion for additional discovery, and Petitioner is not authorized to file a motion to submit supplemental information, at this time;

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