

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 IPR2014-00781 and IPR2014-00782¹
Patent 7,147,759 B2

Before KEVIN F. TURNER, DEBRA K. STEPHENS, 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 IPR2014-00845, IPR2014-00985, and IPR2014-01047 have been joined with IPR2014-00781 and IPR2014-00850, IPR2014-00986, and IPR2014-01059 have been joined with IPR2014-00782.

IPR2014-00781 and IPR2014-00782
Patent 7,147,759 B2

We instituted an *inter partes* review in each of the following proceedings, challenging U.S. Patent No. 7,147,759 B2: IPR2014-00781 and IPR2014-00782 (“the TSMC reviews”), as well as IPR2014-01083, IPR2014-01086, and IPR2014-01087 (“the GlobalFoundries reviews”). Paper 13.² For efficiency, we entered a single Scheduling Order that sets forth the due dates for the parties to take action in all five reviews, ensuring that the reviews will be completed within one year of institution. Paper 14. 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 16, 17, 18. A list of these Joinder Cases is provided in the Appendix of the instant Order.

An initial conference call was held on October 27, 2014, between respective counsel for the parties for all five above-identified reviews and Judges Turner, Stephens, 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

² For the purpose of clarity and expediency, we treat IPR2014-00781 as representative, and all citations are to IPR2014-00781 unless otherwise noted.

changes to the Scheduling Order (Paper 14), as well as any motions that the parties intend to file.

Trial Schedule

During the conference call, we explained that the trial schedule for all five above-identified reviews had been synchronized. 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. 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. Paper 14, 2, 6.

We further noted that the oral hearings for all five reviews are scheduled on the same day. We explained that, although Petitioners for the TSMC reviews and the GlobalFoundries reviews are different, the oral hearings for all five reviews could be combined and the transcript from the combined oral hearing could be useable across all five reviews, given the similarity in claimed subject matter and overlapping asserted prior art. The parties may request a single-combined oral hearing in their requests for oral hearing before or on Due Date 4. *Id.* at 6.

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 TSMC reviews and the GlobalFoundries reviews. Papers 16, 17, 18. And the Joinder Decisions set forth a procedure for consolidated filings and discovery.

Paper 18. Upon inquiry from the Board, the parties stated that they are in agreement with the procedure. *Id.* at 5–7.

The parties indicated that they have been 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 five reviews. For example, the cross-examination of Petitioners’ expert witness may be combined and useable in all five reviews, for efficiency and consistency.

Incorporation by Reference is Prohibited

During the conference call, we directed the parties’ attention to 37 C.F.R. § 42.6(a)(3), which provides “[a]rguments must not be incorporated by reference from one document into another document.” 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.

Objection and Motion to Exclude Evidence

As we noted during the conference call, certain due dates are set forth in the Scheduling Order (Paper 14, 6), but 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 reply witness, and a response to observation because the Scheduling Order sets forth the due date for these motions and responses. *See* Paper 14, 6. 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.

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 19. We previously authorized the parties to file motions for *pro hac vice* admission. Paper 4, 2. On October 27, 2014, Petitioners filed a motion for *pro hac vice* admission of Mr. Anthony J. Fitzpatrick. Paper 20. 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 4, 2; *Unified Patents, Inc. v. Parallel Iron, LLC*, Case IPR2013-00639, slip op. at 3 (PTAB Oct. 15, 2013) (Paper 7). 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. For any future motion for *pro hac vice* admission, the parties may agree in advance and notify the Board that the motion is unopposed, so that the Board may expedite its decision on the motion.

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