

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TAIWAN SEMICONDUCTOR MANUFACTURING COMPANY, LTD.
(TSMC),
Petitioner,

v.

DSS TECHNOLOGY MANAGEMENT, INC.,
Patent Owner.

Case IPR2014-01030
Patent 5,652,084

Before ERICA A. FRANKLIN, JACQUELINE WRIGHT BONILLA, and
KRISTINA M. KALAN, *Administrative Patent Judges*.

BONILLA, *Administrative Patent Judge*.

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

1. Introduction

We instituted trial in this proceeding on December 31, 2014. IPR2014-01030, Paper 7 (“Dec. to Inst.”). On January 27, 2015, counsel for Samsung Electronics Co., Ltd. (“Samsung”), i.e., Petitioner in IPR2014-01493, involving the same challenged patent at issue here, requested that it attend an upcoming initial conference call in this proceeding, and asked that we address its request for authorization to file a motion to join as a party to IPR2014-01030. We authorized Samsung to participate in the call, and indicated that we would address its request to file a motion for joinder during the call.

On January 28, 2015, an initial conference call was conducted among counsel for Petitioner Taiwan Semiconductor Manufacturing Company, Ltd. (“TSMC”), counsel for Patent Owner DSS Technology Management, Inc. (“Patent Owner”), counsel for Samsung, and Judges Franklin, Bonilla, Kokoski, and Kalan. The purpose of the call was to determine if the parties have any issues concerning the Scheduling Order (Paper 8) and to discuss any motions contemplated by the parties, including Samsung’s proposed motion for joinder.

2. Samsung’s Request to File a Motion for Joinder

Samsung requests authorization to file a motion in IPR2014-01493 to join as a party to IPR2014-01030. In the event of joinder, Samsung agrees to limit its Petition to grounds upon which we instituted trial in the current proceeding. Dec. to Inst. 19. Samsung agrees to consolidated filings and discovery with TSMC, and to rely on the same expert as TSMC, Dr. Richard Blanchard. Samsung requests that it, and TSMC, conduct cross-examination of any witnesses produced by Patent Owner, and redirect of any witnesses produced by Petitioners, within the same time frame normally allotted by the rules for one party. In addition, Samsung

requests that, in the event of joinder, we proceed as outlined in the Scheduling Order in the current proceeding. Paper 8.

During the call, neither TSMC nor Patent Owner objected to Samsung's requests as discussed above. We authorized Samsung to file a motion for joinder by Friday, January 30, 2015, as stated in an Order we issue concurrently in IPR2014-01493.

3. *Related Matters*

Other than IPR2014-01493, the parties have identified no other *inter partes* reviews, reexaminations or reissue applications of U.S. Pat. No. 5,652,084 ("the '084 patent"). The parties also confirmed that Patent Owner has asserted the '084 patent against both TSMC and Samsung, among other co-defendants, in *DSS Technology Mgmt. Inc. v. Taiwan Semiconductor Mfg. Co., Ltd.* et al., 2-14-CV-00199 (E.D.Tx.).

4. *Scheduling Order*

None of the parties indicated any issues with respect to the Scheduling Order. The parties are reminded that, without obtaining prior authorization from the Board, they may stipulate to different dates for DATES 1–5 by filing an appropriate notice with the Board. The parties may not stipulate to any other changes to the Scheduling Order.

5. *Discovery*

There are no discovery issues pending at this time. The parties are reminded of the discovery provisions of 37 C.F.R. §§ 42.51-52 and Office Patent Trial Practice Guide. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,761–2 (Aug. 14, 2012). As noted in 37 C.F.R. § 42.51(b)(2)(i), the parties may agree to additional discovery between themselves. Discovery requests and

objections are not to be filed with the Board without prior authorization. If the parties are unable to resolve discovery issues between them, the parties may request a conference with the Board. A motion to exclude, which does not require Board authorization, must be filed to preserve any objection. *See* 37 C.F.R. § 37.64, Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,767.

Each party may depose experts and affiants supporting the opposing party. The parties are reminded of the provisions for taking testimony found at 37 C.F.R. § 42.53 and the Office Patent Trial Practice Guide at 77 Fed. Reg. at 48,772, App. D.

6. Protective Order

As discussed in the conference call, no protective order is currently in place, and none will be entered in the proceeding unless a party files a motion to seal with a proposed protective order. If the parties choose to propose a protective order other than, or departing from, the default protective order, they must submit a joint, proposed protective order, accompanied by a red-lined version based on the default protective order in Appendix B to the Board's Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,771.

If a party's filed documents or things are accompanied by a motion to seal, any redacted information for which the motion is granted cannot be used in the Board's final decision and also remain under seal, because the final decision is a matter of public record. Thus, the parties are cautioned to keep any redactions to a minimum, and to also consider other ways of presenting the information.

7. Motions

The parties are reminded that, except as otherwise provided in the Rules, Board authorization is required before filing a motion. 37 C.F.R. § 42.20(b).

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A party seeking to file a motion should request a conference to obtain authorization to file the motion. No other motions are authorized in this proceeding at this time.

Accordingly, it is

ORDERED that Samsung's request for authorization to file a motion for joinder in IPR2014-01493 is granted, as stated in an Order issued concurrently in that case;

FURTHER ORDERED that no other motions are authorized at this time, other than those already authorized by rule or the Scheduling Order; and

FURTHER ORDERED that due dates specified in the Scheduling Order dated December 31, 2014, remain unchanged.

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