

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

ZOND, LLC,
Patent Owner.

Cases IPR2014-00578 and IPR2014-00604¹
Patent 6,896,775 B2

Cases IPR2014-01479 and IPR2014-01481²
Patent 6,896,773 B2

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

TURNER, *Administrative Patent Judge*.

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

¹ IPR2014-01494 has been joined with IPR2014-00578 and IPR2014-01482 has been joined with IPR2014-00604.

² IPR2014-01479 and IPR2014-01481 have been joined with IPR2014-00580 and IPR2104-00726, respectively.

IPR2014-00578, IPR2014-00604, IPR2014-01479, and IPR2014-01481
Patents 6,896,775 B2 and 6,896,773 B2

We instituted an *inter partes* review in the following proceedings, challenging U.S. Patent No. 6,896,775 B2: IPR2014-00578 and IPR2014-00604. Papers 13, 9, respectively. The Petitioner in each proceeding is The Gillette Company (“Gillette”). For efficiency, we synchronized the Scheduling Orders that set forth the due dates for the parties to take action for both reviews, ensuring that the reviews will be completed within one year of institution. IPR2014-00578, Paper 14; IPR2014-00604, Paper 10. We also instituted an *inter partes* review, challenging the same patent, in both of the following: IPR2014-01494 and IPR2014-01482 (Papers 12, 12, respectively) and subsequently granted Motions for Joinder filed by Taiwan Semiconductor Manufacturing Company, Ltd., TSMC North America Corp., Fujitsu Semiconductor Limited, and Fujitsu Semiconductor America (“TSMC/Fujitsu”). IPR2014-01494, Paper 13; IPR2014-01482, Paper 13.

In addition, we instituted an *inter partes* review in the following proceedings, challenging U.S. Patent No. 6,896,773 B2: IPR2014-01479 and IPR2014-01481. Papers 11, 11, respectively. We also granted Motions for Joinder filed by TSMC/Fujitsu, joining those proceedings with IPR2014-00580 and IPR2104-00726, respectively. Papers 12, 12. A list of these Joinder Cases is provided in the Appendix of the instant Order.

An initial conference call was held on November 13, 2014, between respective counsel for the parties for all four above-identified reviews and Judges Turner, 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 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 their due dates. They also expressed 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. The parties may request a single-combined oral hearing in their requests for oral hearing before or on Due Date 4, on a per patent basis. Thus, a single oral hearing may be requested for all proceedings directed to U.S. Patent No. 6,896,775 B2, and a single oral hearing may be requested for all proceedings directed to U.S. Patent No. 6,896,773 B2.

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 Order, in each of the original reviews. And the Joinder Decisions set forth a procedure for consolidated filings and discovery. The parties stated that they are in agreement with the procedure.

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 of the reviews.

IPR2014-00578, IPR2014-00604, IPR2014-01479, and IPR2014-01481
Patents 6,896,775 B2 and 6,896,773 B2

A question was raised about the usability of deposition transcripts in subsequent depositions. We indicated that prior transcripts can be utilized in subsequent questioning in another proceeding, but their use should be directed to the same issue in both or several cases and be relevant to the instituted grounds and claims in the particular proceeding for which the deposition is being taken. In addition, the deposition transcript from one patent can be cited in papers submitted about another patent as long as the particular, cited testimony is directed to the same issue in both. We acknowledged that although the patents at issue disclose and claim similar subject matter, there can be differences in the specifications of each patent that would inform the constructions of specific claim terms, for example. Any such process should not be burdensome on the declarant and any abuse of process should be brought to the panel's attention immediately.

Motions for Pro Hac Vice Admission and Withdrawal of Counsel

During the conference call, we indicated that the Petitioners did not appear to be in agreement as to whether they opposed the Motions for Pro Hac Vice Admission filed by Zond. Gillette had appeared to indicate no opposition to those motions, but counsel for TSMC/Fujitsu indicated that the petitioner would not oppose those motions if: (1) a district court protective order is made of record in the proceedings; (2) the Board orders that the Zond admitted counsel comply with the protective order, including the prosecution bar provisions of paragraph 22; and (3) that the admitted counsel confirm in writing their assent to such compliance.

During the call, we indicated that the district court's protective order is not before us and is not an order that the Board will enforce. The parties are free to

IPR2014-00578, IPR2014-00604, IPR2014-01479, and IPR2014-01481
Patents 6,896,775 B2 and 6,896,773 B2

reach such agreements between themselves, but the Board need not be a part of any such agreement. We further indicated that we would not require compliance with the district court's protective order in any decision on the motions. Subsequently, counsel for Zond seeking admission agreed to supply Petitioners with a statement indicating certain understandings, and Petitioners agreed to email the Board indications of their non-opposition.

Upon further query, Petitioners also agreed to provide the same with respect to the motions for withdrawal of counsel filed in several proceedings. We also reminded the parties that given the complexities of the instant family of proceedings, it will be crucial for parties to indicate readily whether oppositions to motions will be made. In addition, we request that the parties provide appendices of related motions with any filings so that all such related motions can be considered at one time, if possible.

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.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.