

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHENZHEN HUIDING TECHNOLOGY CO., LTD.,
Petitioner,

v.

SYNAPTICS INCORPORATED,
Patent Owner.

Case IPR2015-01739
Patent 8,558,811 B2

Before JAMESON LEE, BART A. GERSTENBLITH, and
CHARLES J. BOUDREAU *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

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

An initial telephone conference call was held on March 16, 2016. The participants were respective counsel for the parties and Judges Lee, Gerstenblith, and Boudreau. Counsel for Petitioner indicated that Petitioner does not presently contemplate the filing of any motion but may file a motion to exclude, already authorized by the rules, if circumstances would justify filing of such a motion. Patent Owner filed a proposed motions list that includes only a motion to exclude and a “motion to strike.”

We explained that the parties do not need prior permission to file a motion to exclude. We also inquired as to what Patent Owner means by “to strike,” as opposed to “to exclude.” Counsel for Patent Owner explained that the term “strike” was used because Patent Owner may seek to exclude only a portion of a declaration but not its entirety. We indicated, based on that explanation, that Patent Owner should stay with the “Motion to Exclude” terminology, to avoid confusion.

Neither party sought to change any of the due dates set in the Scheduling Order dated February 16, 2016 (Paper 9).

We directed the parties not to use the Motion to Exclude for any purpose other than to raise admissibility issues under the Federal Rules of Evidence. If an issue arises with regard to a paper being out of proper scope, e.g., belatedly raising new issues or belatedly submitting new evidence, the parties shall contact the Board in a timely manner to raise the matter.

We explained to the parties that supplemental evidence is not the same as supplemental information, and that the rules do not contemplate more than one cycle of objection to evidence and subsequent supplemental evidence to cure the objection.

We instructed Patent Owner that if it decides to file a motion to amend claims, it must request a conference call with the Board more than two weeks prior to the due date of such a motion, so that a conference call may be arranged at least two weeks prior to the due date of such a motion and so that the parties will have sufficient time to consider any guidance we may provide. We noted that with respect to any feature the Patent Owner proposes to add by way of a substitute claim, Patent Owner should be aware of the duty of candor requirement under 37 C.F.R. § 42.11. We explained that the initial focus should be on the individual features proposed to be added, and that secondary references making up deficiencies of a primary reference are pertinent. We directed attention of the parties to *MasterImage 3D, Inc. v. RealD Inc.*, Case IPR2015-00040, slip op. at 3 (PTAB July 15, 2015) (Paper 42) (Representative), which states:

Thus, when considering its duty of candor and good faith under 37 C.F.R. § 42.11 in connection with a proposed amendment, Patent Owner should place initial emphasis on each added limitation. Information about the added limitation can still be material even if it does not include all of the rest of the claim limitations. *See VMWare, Inc. v. Clouding Corp.*, Case IPR2014-01292, slip op. at 2 (PTAB Apr. 7, 2015) (Paper 23) (“With respect to the duty of candor under 37 C.F.R. § 42.11, counsel for Patent Owner acknowledged a duty for Patent Owner to disclose not just the closest primary reference, but also closest secondary reference(s) the teachings of which sufficiently complement that of the closest primary reference to be material.”).

Order

It is

ORDERED that a motion to exclude shall be used only to address admissibility issues under the Federal Rules of Evidence; and

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FURTHER ORDERED that any conference call to discuss a motion to amend claims by the Patent Owner shall take place at least two weeks prior to the due date of such a motion;

FURTHER ORDERED that for any “to confer” call with respect to a motion to amend claims, Patent Owner shall be prepared to indicate how it understands the duty of candor under 37 C.F.R. § 42.11 insofar as secondary or complementary prior art references are concerned; and

FURTHER ORDERED that all due dates set in the Scheduling Order entered February 16, 2016 (Paper 9) remain unchanged at this time.

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For PETITIONER:

Bing Ai
John P. Schnurer
Hwa C. Lee
Kevin J. Patariu
PERKINS COIE LLP
ai-ptab@perkinscoie.com
jschnurer@perkinscoie.com
hlee@perkinscoie.comkpatariu@perkinscoie.com

For PATENT OWNER:

Robert P. Lord
Tammy J. Terry
Peter C. Schechter
OSHA LIANG LLP
lord@oshaliang.com
terry@oshaliang.comschechter@oshaliang.com