

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC., ZTE (USA) INC.,
OLYMPUS CORPORATION, and OLYMPUS AMERICA INC.,
Petitioner,

v.

PAPST LICENSING GMBH & CO. KG,
Patent Owner.

Case IPR2017-00415 (Patent 6,895,449 B2)¹
Case IPR2017-00443 (Patent 6,470,399 B1)²

Before JONI Y. CHANG, JENNIFER S. BISK, JAMES B. ARPIN, and
MIRIAM L. QUINN, *Administrative Patent Judges*.³

CHANG, *Administrative Patent Judge*.

ORDER⁴
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ IPR2017-01617 has been joined with IPR2017-00415.

² IPR2017-01682 has been joined with IPR2017-00443.

³ The panel for IPR2017-00415 includes Judges Bisk, Quinn, and Chang.
The panel for IPR2017-00443 includes Judges Chang, Arpin, and Bisk.

⁴ This Order addresses issues that are identical in both cases.

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The instant Petitions for *inter partes* review (“IPR”) were filed by LG Electronics, Inc. (“LG”) and ZTE (USA) Inc. (“ZTE”) (Paper 1⁵), and we instituted a trial in each proceeding (Paper 8). Subsequently, we granted the Motions for Joinder filed by Olympus Corporation and Olympus America Inc. (“Olympus”). Paper 15. The Decisions granting the Motions for Joinder indicate that all Petitioner’s filings must be consolidated, and “no filing by Petitioner Olympus alone will be considered without prior authorization by the Board.” *Id.* at 5.

On November 2, 2017, a conference call was held between (1) counsel for LG; (2) counsel for ZTE; (3) counsel for Olympus; (4) counsel for Papst; and (5) Judges Chang, Bisk, Arpin, and Quinn. Olympus requested the conference call to seek (1) the authorization to file Petitioner’s Replies and cross-examine Papst’s declarant, Mr. Thomas A. Gafford; and (2) discovery of Mr. Gafford’s deposition transcript from a related district court proceeding.

At the outset, we notified the parties that the email sent to the Board on October 30, 2017, is improper, as it contains substantive arguments, and hence, it will not be taken into consideration. We also directed the parties attention to 37 C.F.R. § 42.1(c), which provides that “[e]very party must act with courtesy and decorum in all proceedings before the Board, including in interactions with other parties.” We further noted that our rules and procedures encourage the parties to meet and confer, resolving their disputes quickly and efficiently without the Board’s involvement. For example, the Scheduling Order provides flexibility for the parties to stipulate to different

⁵ All citations are to IPR2014-00415 unless otherwise noted.

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due dates as to Due Dates 1–5. Paper 9, 2, 6. Also, 37 C.F.R. § 42.51(b)(2) provides that “[t]he parties may agree to additional discovery between themselves.”

During the conference call, we discussed each of the issues raised by Olympus in turn, giving the parties the opportunity to present their arguments and explanations to support their positions.

1. Permitting Olympus to File Petitioner’s Replies and Participate in Discovery

Olympus indicated that LG and ZTE are in the process of finalizing a settlement with Papst, and do not intend to file a Reply to Papst’s Patent Owner Response (Paper 14) or to participate in further discovery, in each of the instant IPR proceedings. Both LG and ZTE confirmed Olympus’s statement. Papst indicated that it does not oppose Olympus’s participation, provided that LG and ZTE will not be filing separate papers or seeking separate depositions. Upon inquiry, LG and ZTE further confirmed that they will work together with Olympus to ensure that Petitioner’s filings, discovery, and oral arguments at the hearing will be consolidated. Based on the statements presented by the parties, we authorize Olympus to file the Petitioner’s Reply, participate in discovery, and present oral argument at the hearing in each IPR proceeding, but no separate filing, deposition, or oral argument from Petitioner is permitted without prior authorization.

Subsequent to the conference call, LG and ZTE filed an updated mandatory notice, designating an appropriate lead counsel and back-up counsel in accordance with 37 C.F.R. § 42.8(b)(3), so that counsel for Olympus may file the Replies. Paper 16. Olympus should file a power of attorney, and contact the Board’s administrative staff regarding filing

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privileges for PTAB E2E electronic filing system. Other means of filing are *not* authorized and any papers previously submitted via email or other means of filing will *not* be entered or considered.

2. Discovery of a Deposition Transcript From a Related District Court Proceeding

The parties indicated that Papst retained Mr. Gafford as an expert witness, in the related district court proceeding and the instant IPR proceedings. Olympus requested the authorization to seek discovery of portions of Mr. Gafford's deposition transcript from the district court proceeding, concerning the prior art reference, Murata.⁶ Papst opposed, explaining that the transcript has been designated confidential, as it contains third-party source codes. Subsequent to the conference call, Papst notified the panel and opposing counsel on November 3, 2017, via email, that "[a]fter discussion with litigation counsel, Patent Owner Papst will produce the Tom Gafford deposition transcripts dated June 8–9, 2017 with redactions to all discussion of the DeskLab and Pucci/ION Node systems," and the "transcripts will be produced to counsel for Olympus on 11/6/17." We appreciate the parties' efforts in resolving the issues quickly and efficiently.

ORDER

In consideration of the foregoing, it is:

ORDERED that Olympus is authorized to file the Petitioner's Reply, participate in discovery, and present oral argument at the hearing in each instant IPR proceeding, but no separate filing, deposition, or oral argument from Petitioner is permitted without prior authorization.

⁶ U.S. Patent 5,508,821 (Ex. 1005).

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