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Paper No. 12
Entered: January 18, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TAIWAN SEMICONDUCTOR MANUFACTURING COMPANY, LTD.,
Petitioner,

v.

GODO KAISHA IP BRIDGE 1,
Patent Owner.

Case IPR2016-01376
Case IPR2016-01377
Case IPR2016-01378
Case IPR2016-01379
Patent 6,197,696 B1[1]

Before JUSTIN T. ARBES, MICHAEL J. FITZPATRICK, and JENNIFER MEYER CHAGNON, *Administrative Patent Judges*.

CHAGNON, *Administrative Patent Judge*.

SCHEDULING ORDER

[1] This order addresses the schedule and other issues common to all cases; therefore, we issue a single order to be entered in each case.

I. DUE DATES

This order sets due dates for the parties to take action after institution of these proceedings. The parties may stipulate to different dates for DUE DATES 1 through 5 (earlier or later, but no later than DUE DATE 6). A notice of the stipulation, specifically identifying the changed due dates, must be promptly filed. The parties may not stipulate to an extension of DUE DATES 6 and 7.

In stipulating to different times, the parties should consider the effect of the stipulation on times to object to evidence (37 C.F.R. § 42.64(b)(1)), to supplement evidence (37 C.F.R. § 42.64(b)(2)), to conduct cross-examination (37 C.F.R. § 42.53(d)(2)), and to draft papers depending on the evidence and cross-examination testimony (*see* section II, below).

The parties are reminded that the Testimony Guidelines appended to the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,772 (Aug. 14, 2012) (Appendix D), apply to these proceedings. The Board may impose an appropriate sanction for failure to adhere to the Testimony Guidelines. 37 C.F.R. § 42.12. For example, reasonable expenses and attorneys' fees incurred by any party may be levied on a person who impedes, delays, or frustrates the fair examination of a witness.

A. INITIAL CONFERENCE CALL

The parties are directed to contact the Board within 21 days of this Order if there is a need to discuss proposed changes to the Scheduling Order or proposed motions. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,765–66 (guidance in preparing for an initial conference call). To request an initial conference call, the parties should submit to Trials@uspto.gov a list of dates and times when they are available for a call.

B. DUE DATE 1

The patent owner may file—

a. A response to the petition (37 C.F.R. § 42.120), and

b. A motion to amend the patent (37 C.F.R. § 42.121).

The patent owner must file any such response or motion to amend by DUE DATE 1. If the patent owner elects not to file anything, the patent owner must arrange a conference call with the parties and the Board. The patent owner is cautioned that any arguments for patentability not raised in the response will be deemed waived.

C. DUE DATE 2

The petitioner must file any reply to the patent owner's response and opposition to the motion to amend by DUE DATE 2.

D. DUE DATE 3

The patent owner must file any reply to the petitioner's opposition to patent owner's motion to amend by DUE DATE 3.

E. DUE DATE 4

a. Each party must file any motion for an observation on the cross-examination testimony of a reply witness (*see* section III, below) by DUE DATE 4.

b. Each party must file any motion to exclude evidence (37 C.F.R § 42.64(c)) by DUE DATE 4.

c. Each party must file any request for oral argument (37 C.F.R. § 42.70(a)) by DUE DATE 4.

F. DUE DATE 5

a. Each party must file any response to an observation on cross-examination testimony by DUE DATE 5.

b. Each party must file any opposition to a motion to exclude evidence by DUE DATE 5.

G. DUE DATE 6

Each party must file any reply for a motion to exclude evidence by DUE DATE 6.

H. DUE DATE 7

The oral argument (if requested by either party) is set for DUE DATE 7.

II. CROSS-EXAMINATION

Except as the parties might otherwise agree, for each due date—

1. Cross-examination begins after any supplemental evidence is due. 37 C.F.R. § 42.53(d)(2).

2. Cross-examination ends no later than a week before the filing date for any paper in which the cross-examination testimony is expected to be used. *Id*.

III. MOTION FOR OBSERVATION ON CROSS-EXAMINATION

A motion for observation on cross-examination provides the parties with a mechanism to draw the Board's attention to relevant cross-examination testimony of a reply witness because no further substantive paper is permitted after the reply. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,768. The observation must be a concise

statement of the relevance of precisely identified testimony to a precisely identified argument or portion of an exhibit. Each observation should not exceed a single, short paragraph. The opposing party may respond to the observation. Any response must be equally concise and specific.

IV. MOTION TO AMEND

Patent Owner may file a motion to amend without prior authorization from the Board. Nevertheless, Patent Owner must confer with the Board before filing such a motion. *See* 37 C.F.R. § 42.121(a). Patent Owner should arrange for a conference call with the panel and opposing counsel at least one week before DUE DATE 1 in order to satisfy the conferral requirement. We direct the parties to the Board's website for decisions relating to Motions to Amend among other topics, including *MasterImage 3D, Inc. v. RealD Inc.*, Case IPR2015-00040 (PTAB July 15, 2015) (Paper 42) (precedential) and *Idle Free Systems, Inc. v. Bergstrom, Inc.*, Case IPR2012-00027 (PTAB June 11, 2013) (Paper 26) (informative).

V. PROTECTIVE ORDER

No protective order has been entered in these proceedings. If the parties have agreed to a proposed protective order, including the Default Standing Protective Order, 77 Fed. Reg. at 48,771 (Appendix B), they should file a signed copy of the proposed protective order with the motion to seal. If the parties choose to propose a protective order other than, or departing from, the Default Standing Protective Order, they must submit a joint, proposed protective order, accompanied by a red-lined version based on the Default Standing Protective Order.

DUE DATE APPENDIX

DUE DATE 1 ..... April 5, 2017

Patent owner's response to the petition

Patent owner's motion to amend the patent

DUE DATE 2 ..... June 21, 2017

Petitioner's reply to patent owner's response to petition

Petitioner's opposition to motion to amend

DUE DATE 3 ..... July 19, 2017

Patent owner's reply to petitioner's opposition to motion to amend

DUE DATE 4 ..... August 8, 2017

Motion for observation regarding cross-examination of reply witness

Motion to exclude evidence

Request for oral argument

DUE DATE 5 ..... August 23, 2017

Response to observation

Opposition to motion to exclude

DUE DATE 6 ..... August 30, 2017

Reply to opposition to motion to exclude

DUE DATE 7 ..... September 12, 2017

Oral argument (if requested)

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PETITIONER:

Darren M. Jiron
E. Robert Yoches
J. Preston Long
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
darren.jiron@finnegan.com
bob.yoches@finnegan.com
j.preston.long@finnegan.com

PATENT OWNER:

J. Steven Baughman
Andrew N. Thomases
ROPES & GRAY LLP
steven.baughman@ropesgray.com
andrew.thomases@ropesgray.com