

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RENESAS ELECTRONICS CORPORATION and
RENESAS ELECTRONICS AMERICA, INC.,
Petitioner,

v.

LONE STAR SILICON INNOVATIONS, LLC,
Patent Owner.

Case IPR2017-01868, Patent 6,326,231 B1
Case IPR2017-01869, Patent 6,388,330 B1¹

Before JENNIFER MEYER CHAGNON, JOHN F. HORVATH, and
ELIZABETH M. ROESEL, *Administrative Patent Judges*.

ROESEL, *Administrative Patent Judge*.

SCHEDULING ORDER
37 C.F.R. § 42.5

¹ This Order applies to each of the listed cases. We exercise our discretion to issue one Order to be docketed in each case. The parties, however, are not authorized to use this caption for any subsequent papers.

A. GENERAL INSTRUCTIONS

1. Requests for an Initial Conference Call

Unless at least one of the parties requests otherwise, we will not conduct an initial conference call as described in the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,765–66 (Aug. 14, 2012). Any request for an initial conference call must be made no later than 25 days after the institution of trial.

2. Standing Procedure for Requests for Conference Calls

If the parties request a conference call, including an initial conference call, the parties must follow these procedures:

- a. Prior to requesting a conference call, the parties must confer in an effort to resolve any issue to be discussed with the Board, or be prepared to explain to the Board why such a conference was not possible.
- b. Parties may request a conference call by contacting the Board at the email address or telephone number listed above the caption of this Order. Requests via email are expected and preferred; requests via telephone should be reserved for time-critical circumstances. Requests by email must copy opposing counsel. Requests by telephone should include opposing counsel as practicable.
- c. The request must include a list of proposed issues and/or motions to be discussed during the call.
- d. The request may include a brief background discussion of the issue(s) and/or motion(s) to be discussed, but must not include arguments.

- e. The request must certify that the parties conferred in accordance with 2.a., and must indicate the result of the conference (e.g., whether the non-requesting party opposes or does not oppose the request).
- f. The request must include a list of dates and times when both parties are available for the call.

3. Protective Order

A protective order does not exist in this proceeding unless the parties file one and the Board approves it. If either party files a motion to seal before entry of a protective order, a jointly proposed protective order should be presented as an exhibit to the motion. We encourage the parties to adopt the Board's default protective order if they conclude that a protective order is necessary. *See* Default Protective Order, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, App. B (Aug. 14, 2012). If the parties choose to propose a protective order deviating from the default protective order, they must submit the proposed protective order jointly along with a marked-up comparison of the proposed and default protective orders showing the differences; and the parties must explain why the proposed deviations from the default protective order are necessary.

The Board has a strong interest in the public availability of the proceedings. We advise the parties that redactions to documents filed in this proceeding should be limited to isolated passages consisting entirely of confidential information, and that the thrust of the underlying argument or evidence must be clearly discernible from the redacted versions. We also advise the parties that information subject to a protective order will become public if identified in a final written decision in this proceeding, and that a

motion to expunge the information will not necessarily prevail over the public interest in maintaining a complete and understandable file history.

See Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,761.

4. Motions 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). To satisfy this requirement, Patent Owner should contact the Board to request a conference call in sufficient time to ensure that the conference is conducted at least one week before DUE DATE 1.

5. Discovery Disputes

The panel encourages parties to resolve disputes relating to discovery on their own and in accordance with the precepts set forth in 37 C.F.R. § 42.1(b). To the extent that a dispute arises between the parties relating to discovery, the parties shall meet and confer to resolve such a dispute before contacting the Board. If attempts to resolve the dispute fail, a party may request a conference call with the Board and the other party in order to seek authorization to move for relief.

In any request for a conference call with the Board to resolve a discovery dispute, the requesting party shall: (1) certify that it has conferred with the other party in an effort to resolve the dispute; (2) identify with specificity the issues for which agreement has not been reached; (3) identify the precise relief to be sought; and (4) propose specific dates and times at which both parties are available for the conference call.

6. Depositions

The parties are advised 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 this proceeding. 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.

Whenever a party submits a deposition transcript as an exhibit in this proceeding, the submitting party shall file the full transcript of the deposition rather than excerpts of only those portions being cited. After a deposition transcript has been submitted as an exhibit, all parties who subsequently cite to portions of the transcript shall cite to the first-filed exhibit rather than submitting another copy of the same transcript.

7. Cross-Examination

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

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

8. 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. 48,756, 48,768 (Aug. 14, 2012). 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.

9. *Motions*

Prior to filing any motion (other than a motion to amend, a motion to exclude evidence, or a motion for observation on cross-examination), the moving party shall meet and confer with each non-moving party regarding the relief requested in the motion and, unless previously authorized, request the Board's authorization for the motion pursuant to 37 C.F.R. § 42.20(b) and paragraph A.2. of this Order. The motion must certify that the moving party complied with the meet-and-confer requirement and must indicate whether each non-moving party opposes or does not oppose the requested relief.

B. DUE DATES

This order sets due dates for the parties to take action after institution of the proceeding. 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. ***Due to scheduling constraints, such as hearing room availability, the parties must advise the panel if there are any conflicts that arise with DUE DATE 7 by email as soon as practicable.***

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.

1. 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.

2. 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.

3. 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.

4. DUE DATE 4

- a. Each party must file any motion for an observation on the cross-examination testimony of a reply witness (*see* section A.7, above) 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.

5. DUE DATE 5

- a. Each party must file any reply to a petitioner 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.

6. DUE DATE 6

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

7. DUE DATE 7

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

DUE DATE APPENDIX

DUE DATE 1 **July 11, 2018**

Patent owner's response to the petition

Patent owner's motion to amend the patent

DUE DATE 2 **October 11, 2018**

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

Petitioner's opposition to motion to amend

DUE DATE 3 **November 13, 2018**

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

DUE DATE 4 **December 3, 2018**

Motion for observation regarding cross-examination of reply witness

Motion to exclude evidence

Request for oral argument

DUE DATE 5 **December 14, 2018**

Response to observation

Opposition to motion to exclude

DUE DATE 6 **December 21, 2018**

Reply to opposition to motion to exclude

DUE DATE 7 **January 9, 2019**

Oral argument (if requested)

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