Trials@uspto.gov
571-272-7822

Paper No. 11
Entered: April 13, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ABS GLOBAL, INC.,
Petitioner,

v.

XY, LLC,
Patent Owner.

Case IPR2017-02184
Patent 7,208,265 B1

Before GRACE KARAFFA OBERMANN, SUSAN L. C. MITCHELL, and ROBERT A. POLLOCK, *Administrative Patent Judges.*

OBERMANN, *Administrative Patent Judge*.

SCHEDULING ORDER

The Appendix to 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 addition, even if the parties stipulate to an extension of DUE DATE 4, any request for oral hearing must still be filed on or before the date set forth in this Order, to provide sufficient time for the Board to accommodate the hearing.

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 D, 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 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.

A. INITIAL CONFERENCE CALL

The parties are directed to contact the Board within a month of this Order if there is a need to discuss proposed changes to this Order or proposed motions. *See*

Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,765–66 (Aug. 14, 2012) (guidance in preparing for the initial conference call).

B. PROTECTIVE ORDER

1. Confidential Information

The parties must file confidential information using the appropriate availability indicator in PTAB E2E, regardless of whose confidential information it is. It is the responsibility of the party whose confidential information is at issue, not necessarily the proffering party, to file the motion to seal.

A protective order does not exist in a case until one is filed in the case and is approved by the Board. If a motion to seal is filed by either party, the proposed protective order should be presented as an exhibit to the motion. The motion to seal must include a certification that the moving party has in good faith conferred or attempted to confer with other affected parties in an effort to resolve any dispute. *See* 37 C.F.R. 42.54(a).

The parties are urged to operate under the Board's default protective order, should that become necessary. *See* Default Protective Order, Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,769–71, App. B.

If the parties choose to propose a protective order deviating from the default protective order, they should submit the proposed protective order jointly. A marked-up comparison of the proposed and default protective orders should be presented as an additional exhibit to the motion to seal, so that differences can be

understood readily. The parties should contact the Board if they cannot agree on the terms of the proposed protective order.

2. Redactions

Redactions should be limited strictly to isolated passages consisting entirely of confidential information. The thrust of the underlying argument or evidence must be clearly discernable from the redacted version.

3. Confidential Information in Final Written Decisions

Information subject to a protective order will become public if identified in a final written decision in this proceeding. A motion to expunge the information will not prevail necessarily over the public interest in maintaining a complete and understandable file history. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,761.

C. DUE DATES

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 observations on the cross-examination testimony of a reply witness (*see* section E, 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. As noted above, DUE DATE 4 is not extendible with respect to any request for oral argument.

5. 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.

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.

D. 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*.

E. OBSERVATIONS ON CROSS-EXAMINATION

Observations on cross-examination provide 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 (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.

F. MOTION TO AMEND

Although the filing of a Motion to Amend is authorized under our Rules, the patent owner must confer with the Board before filing any Motion to Amend. *See* 37 C.F.R. § 42.121(a). A conference call to satisfy the requirement of 37 C.F.R. § 42.121(a) must be scheduled no less than ten (10) business days prior to DUE DATE 1.

G. COMMUNICATIONS WITH THE BOARD

Except as otherwise provided in the Rules, Board authorization is required before filing a motion. 37 C.F.R. § 42.20(b). A party seeking to file a non-preauthorized motion should request a conference to obtain authorization to file the motion. Parties may request a conference with us by contacting the Board staff by e-mail at Trials@uspto.gov or by telephone at 571-272-7822.

Regarding discovery disputes, the parties are encouraged to resolve such issues 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 should 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 to discuss the issue and, if necessary, seek authorization to file a motion in that regard. An email requesting a conference call shall: (a) copy the other party, (b) indicate generally the subject matter of the conference call and relief requested, (c) state whether the opposing party opposes the request, and (d) include multiple times when all parties are available for a conference. The email shall not contain substantive argument.

DUE DATE APPENDIX

DUE DATE 1 .....July 9, 2018

Patent owner's response to the petition

Patent owner's motion to amend the patent

DUE DATE 2 ..... October 9, 2018

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

Petitioner's opposition to motion to amend

DUE DATE 3 ..... November 9, 2018

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

DUE DATE 4 ..... November 30, 2018

Observations regarding cross-examination of reply witness

Motion to exclude evidence

Request for oral argument

DUE DATE 5.....December 14, 2018

Response to observations

Opposition to motion to exclude

DUE DATE 6 ..... December 21, 2018

Reply to opposition to motion to exclude

DUE DATE 7 ..... January 11, 2018

Oral argument (if requested).

For PETITIONER:

Jeffrey P. Kushan
Paul J. Zegger
SIDLEY AUSTIN LLP
jkushan@sidley.com
pzegger@sidley.com

For PATENT OWNER:

Kirt O'Neill
Daniel L. Moffett
George Rosbrook
Dorian Ojemen
AKIN GUMP STRAUSS HAUER & FELD LLP
koneill@akingump.com
dmoffett@akingump.com
arosbrook@akingump.com
dojemen@akingump.com