Trials@uspto.gov
571-272-7822

Paper No. 11
Entered: July 2, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner,

v.

PROMPTU SYSTEMS CORPORATION,
Patent Owner.

Case IPR2018-00344
Patent 7,047,196 B2

Before JAMESON LEE, ROBERT L. KINDER, and
ALEX S. YAP, *Administrative Patent Judges*

YAP, *Administrative Patent Judge*.

SCHEDULING ORDER
37 C.F.R. § 42.5(a)

I. DUE DATES

This Order sets forth 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). The parties may not stipulate to an extension of DUE DATES 6 and 7, and with respect to DUE DATE 4, may not stipulate to an extension of the date set forth in this Order for requesting oral argument.

If the parties stipulate to different due dates, notice of the stipulation specifically identifying the changed due dates must be promptly filed. 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.

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.

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. Neither party may incorporate by reference any analysis or reasoning expressed in the Decision on Institution review.

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 observation 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)) and 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 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

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

II. INITIAL CONFERENCE CALL

The parties are directed to contact the Board (TRIALS@USPTO.GOV) within one 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).

III.PROTECTIVE ORDER

A protective order does not exist in this proceeding, and will not exist until a party files a motion to seal that includes a proposed protective order, and the proposed protective order is approved by the Board. *See* 37 C.F.R. 42.54(a). 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. *Id.* A party filing confidential

information must use the appropriate availability indicator in PTAB E2E, regardless of who owns the confidential information. The owner of the confidential information, not necessarily the party filing the information, must file the motion to seal and bears the burden of showing the information for which protection is sought is confidential information and should be sealed. The motion *must* balance the strong public interest in maintaining a complete and understandable record with any need of a party to rely on the subject information and to keep the information confidential. *See Argentum Pharmaceuticals LLC v. Alcon Research, Ltd.*, Case IPR2017-01053 (PTAB January 19, 2018) (Paper 27); *Corning Optical Communications RF, LLC, v. PPC Broadband, Inc.*, Case IPR2014-00440 (PTAB April 14, 2015) (Paper 47).

We encourage the parties to adopt the Board's default protective order if they conclude that a protective order is necessary in this proceeding. *See* Default Protective Order, Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,769–71, App. B. If the parties file a proposed protective order that deviates from the default protective order, they must submit the proposed protective order jointly, together with a marked-up copy showing the differences between the default and proposed protective orders.

The Board has a strong interest in the public availability of 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 redacted documents. 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.

IV. 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*.

V. 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 48,756. 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.

VI. 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.

VII. MOTION TO EXCLUDE

A Motion to Exclude shall only raise admissibility issues under the Federal Rules of Evidence, and not be used as additional briefing on any other topic, subject, or issue, for example, any assertion that a certain brief or evidentiary submission exceeds the proper scope for such brief or submission. In case of an issue based on exceeding the proper scope of a submission, the parties must raise the matter by initiating a conference call with the Board.

VIII. MISCELLANEOUS

The parties shall file any order of a court, or the International Trade Commission, construing or interpreting any claim term of the challenged patent within seven days of issuance of that order. Similarly, the parties shall file any order addressing the patentability of any claim of the challenged patent within seven days. Such orders shall be filed as an exhibit with a corresponding email sent to TRIALS@USPTO.GOV identifying the filing by tribunal and issue date, and also the claim term(s) construed or the claim(s) ruled upon.

When filing an exhibit, the parties should provide a descriptive name for the exhibit and not just label it as Exhibit ##. The PTAB's filing system already identifies exhibits by the exhibit number and providing a description for each exhibit enables the Board to quickly find relevant exhibits without reference to separate papers.

DUE DATE APPENDIX

INITIAL CONFERENCE CALL .....July 27, 2018

DUE DATE 1 ..... Sept. 4, 2018

Patent owner's response to the petition

Patent owner's motion to amend the patent

DUE DATE 2 ..... Nov. 13, 2018

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

Petitioner's opposition to motion to amend

DUE DATE 3 .....Dec. 10, 2018

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

DUE DATE 4 .....Dec. 24, 2018

Motion for observation regarding cross-examination of reply witness

Motion to exclude evidence

Request for oral argument

DUE DATE 5 .....Jan. 7, 2019

Response to observation

Opposition to motion to exclude

DUE DATE 6 .....Jan. 14, 2019

Reply to opposition to motion to exclude

DUE DATE 7 .....Jan. 28, 2019

Oral argument (if requested)

PETITIONER:
James L. Day
Daniel Callaway
FARELLA BRAUN + MARTEL LLP
jday@fbm.com
dcallaway@fbm.com

Leo L. Lam
KEKER, VAN NEST & PETERS LLP
llam@keker.com

PATENT OWNER:
Joshua L. Goldberg
Jacob A. Schroeder
Cory C. Bell
Daniel Klodowski
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
joshua.goldberg@finnegan.com
jacob.schroeder@finnegan.com
cory.bell@finnegan.com
daniel.klodowski@finnegan.com

John S. Ferrell
Wade C. Yamazaki
CARR & FERRELL LLP
jsferrell@carrferrell.com
wyamazaki@carrferrell.com