

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VEEAM SOFTWARE CORPORATION
Petitioner

v.

SYMANTEC CORPORATION
Patent Owner

Case IPR2013-00141 (Patent 6,931,558)
Case IPR2013-00142 (Patent 6,931,558)
Case IPR2013-00143 (Patent 7,191,299)
Case IPR2013-00150 (Patent 7,093,086)¹

Before THOMAS L. GIANNETTI, SCOTT E. KAMHOLZ, and
TRENTON A. WARD, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

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

¹ This paper addresses issues that are identical in the listed cases. We exercise our discretion to issue a single paper to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

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At the request of counsel for Patent Owner, the Board held a telephone conference in these cases on October 28, 2013. The participants were counsel for the parties, including attorneys Gordon and Richetti, and Administrative Patent Judges Ward, Kamholz, and Giannetti.

1. Motion to Amend

Patent Owner intends to file a contingent motion to amend in each of the proceedings. Patent Owner is familiar with the requirements for such motions set forth in the *Idle Free* decision (*Idle Free v. Bergstrom*, IPR2012-00027, Paper 26), including the presumption of a one-for-one claim substitution. The motions will accompany the Patent Owner's responses to the petitions.

2. Motion to Compel

In IPR2013-00150, Petitioner requested authorization to file a motion to compel deposition testimony from a non-party, VMware, Inc. The motion is necessitated, according to Petitioner, by the inability of the parties to reach agreement on the date by which a particular VMware software manual (Ex. 1005) being relied on by Petitioner became publicly accessible. The manual bears a copyright notice date of 2001, and is similar (but not identical) to another VMware manual (Ex. 1006) whose status as prior art is not challenged by Patent Owner.

After discussing the matter with the parties, the Board authorized filing of the motion to compel. Petitioner was requested to address the applicable *Garmin* factors (*see Garmin v. Cuozzo*, IPR2012-00026, Paper 26), with special attention to

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factor 3, concerning ability to obtain the information without need of additional discovery. Petitioner's motion should explain why the VMware manual (Ex. 1006) that is not challenged is not sufficient for its purposes.

In view of the foregoing, it is hereby

ORDERED that Patent Owner has complied with its duty under 37 C.F.R. § 42.121 to confer with the Board before filing a motion to amend;

FURTHER ORDERED that Petitioner is authorized to file a motion to compel the deposition of VMware for the limited purpose of proving whether Exhibit 1005 became accessible to the public prior to March 28, 2002, the earliest priority date relied on by Patent Owner;

FURTHER ORDERED that the motion to compel will be filed no later than Friday, November 1, 2013; Patent Owner's opposition no later than Friday, November 8, 2013; and that no reply is authorized at this time;

FURTHER ORDERED that in addition to the other *Garmin* factors, Petitioner's motion will address the question of why the other VMware manual (Ex. 1006) is not sufficient;

FURTHER ORDERED that in its opposition to the motion, Patent Owner will specifically set forth the respects in which the proffered evidence of public accessibility of the challenged manual (Ex. 1005) is insufficient;

FURTHER ORDERED that after these briefs have been exchanged, and by no later than November 15, 2013, the parties shall meet and confer (in person or by telephone) in a good faith attempt to resolve this issue without the need for

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additional discovery, and shall advise the Board promptly, in a joint email, of the result.

For PETITIONER:

Lori A. Gordon
Michael Q. Lee
Byron L. Pickard
STERNE, KESSLER, GOLDSTEIN
& FOX PLLC
lgordon-PTAB@skgf.com
mlee-PTAB@skgf.com
bpickard-ptab@skgf.com

For PATENT OWNER:

Joseph J. Richetti
Lawrence G. Kurland
BRYAN CAVE LLP
joe.richetti@bryancave.com
lgkurland@bryancave.com