

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOSHIBA CORPORATION, TOSHIBA AMERICA, INC.,
TOSHIBA AMERICA ELECTRONIC COMPONENTS, INC.,
and TOSHIBA AMERICA INFORMATION SYSTEMS, INC.,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

Case IPR2014-00418
Patent 5,500,819

Before KEVIN F. TURNER, TREVOR M. JEFFERSON,
and DAVID C. McKONE, *Administrative Patent Judges*.

JEFFERSON, *Administrative Patent Judge*.

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

An initial conference call in the above proceeding was held on September 8, 2014, between respective counsel for Petitioner and Patent Owner, and the Board. The purpose of the call was to discuss any proposed changes to the Scheduling Order (Paper 8) and any motions that the parties intend to file. Petitioner filed a statement (Paper 10) that it does not anticipate filing any motions beyond those set forth in the Scheduling Order. Patent Owner filed a statement (Paper 9) that it might file a motion to amend the claims.

Patent Owner indicated that it might file a motion to amend. Patent Owner is reminded that, should it decide to do so, it must confer with the Board in a conference call before filing the motion. *See* 37 C.F.R. § 42.121(a); *see, e.g., ZTE Corporation and ZTE (USA) Inc. v. Contentguard Holdings, Inc.*, IPR2013-00136, Paper 33 (PTAB November 7, 2013). One of the purposes of the conference requirement is for the Board to give guidance on the requirements of a motion to amend. Therefore, Patent Owner should leave sufficient time before any such motion to amend is filed so that changes can be made, if needed.

The parties indicated that there were no adjustments to the due dates of the Scheduling Order. Should the parties stipulate to dates that differ from the Scheduling Order, the parties must provide prompt notice of the stipulation, specifically identifying any changed due dates. In addition, the parties indicated that they have not discussed settlement.

Counsel for Patent Owner requested clarification regarding the grounds upon which *inter partes* review is instituted. Per our Order (Paper 7 at 19), *inter partes* review is instituted as to claims 1–11 and 17–19 on the ground that the claims are unpatentable under 35 U.S.C. § 103(a) as rendered obvious by the combination of Ogawa '577, Ogawa '045, and JP '832.

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PETITIONER:

Gianni Minutoli
Gianni.minutoli@dlapiper.com

Kevin Hamilton
Kevin.hamilton@dlapiper.com

PATENT OWNER:

Lori Gordon
Lgordon-PTAB@skgf.com

Michael Specht
Mspecht-PTAB@skgf.com

Omar Amin
Oamin-PTAB@skgf.com