

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TIANMA MICRO-ELECTRONICS CO., LTD.,
Petitioner,

v.

JAPAN DISPLAY INC. and
PANASONIC LIQUID CRYSTAL DISPLAY CO., LTD.,
Patent Owner.

Case IPR2016-00990 (Patent 7,718,234 B2)
Case IPR2016-00991 (Patent 8,758,871 B2)¹

Before JO-ANNE M. KOKOSKI, KRISTINA M. KALAN, and
ELIZABETH M. ROESEL, *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*.

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

¹ Because this Order addresses issues applicable to these two cases, we exercise our discretion to issue one Order to be filed in each case. The parties may not use this style heading unless authorized.

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IPR2016-00991 (Patent 8,758,871 B2)

Tianma Micro-electronics Co., Ltd. (“Petitioner”) contacted the Board via e-mail on February 13, 2017, requesting a conference call with the parties and the Board regarding Japan Display Inc.’s (“JDI”) and Panasonic Liquid Crystal Display Co., Ltd.’s (“PLD”) (collectively, “Patent Owner”) failure to file a Patent Owner Response in either of the above-captioned cases. A conference call was held with the Board on February 21, 2017.

Apart from Patent Owner’s Powers of Attorney and Mandatory Disclosures (IPR2016-00990, Papers 4–6; IPR2016-00991, Papers 4–6), Patent Owner has filed no other papers in these proceedings. In its Mandatory Notices, Patent Owner designated John R. Fuisz as lead counsel, and Jennifer C. Chen as back-up counsel, both of Fuisz Chen LLP.² IPR2016-00990 Paper 6, 4; IPR2016-00991 Paper 6, 4. Petitioner’s email to the Board indicated that Mr. Fuisz recently informed Petitioner that he and Ms. Chen now only represent JDI, and no longer represent PLD. During the conference call, Mr. Fuisz represented that ethical and other issues preclude their continued representation of PLD, but that he did inform PLD of the February 21st conference call.³ We informed Mr. Fuisz that he remains counsel for both JDI and PLD in these proceedings until a motion to withdraw has been authorized, filed, and granted. *See* 37 C.F.R. § 42.10(e).

During the conference call, Petitioner sought guidance from the Board as to whether Petitioner may file a motion for adverse judgment under 37 C.F.R. § 42.73(b), for what Petitioner characterized as Patent Owner’s

² Subsequent to the filing of the Mandatory Notices, Mr. Fuisz and Ms. Chen joined Vinson & Elkins LLP. Patent Owner did not file anything with the Board identifying this change, despite its duty to update its Mandatory Notices within 21 days of a change in information. 37 C.F.R. § 42.8(a)(3).

³ Other than Mr. Fuisz, PLD did not have representation on the call.

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abandonment in both cases. Petitioner also requested that the Board issue a show cause order as to why Patent Owner's failure to file Patent Owner Responses in these proceeding does not constitute abandonment of the proceedings, citing Case IPR 2016-00342, Paper 11. Patent Owner affirmatively stated that it was not abandoning the contest.

Patent Owner requested a revised scheduling order, citing Case IPR 2013-00498, Paper 15, in which the Board adjusted Due Dates 2–7 of the Scheduling Order, finding Due Dates 2 and 3 moot and resetting Due Dates 4–7. Patent Owner did not propose a specific schedule during the call.

At this time, we decline to authorize Petitioner to file a motion for adverse judgment, and we decline to issue a show cause order as requested by Petitioner, in view of Patent Owner's representation that it has not abandoned the contest. 37 C.F.R. § 42.73(b). We also decline to revise the scheduling order at this time, as we are unpersuaded by any of Patent Owner's arguments that such a revised scheduling order is necessitated by the circumstances of these cases.

It is:

ORDERED that Petitioner's request to file a motion for adverse judgment, or to have the Board issue a show cause order, is *denied* without prejudice;

FURTHER ORDERED that Patent Owner's request for a revised scheduling order is *denied* without prejudice;

FURTHER ORDERED that Mr. Fuisz and Ms. Chen remain as counsel for JDI and PLD, and have all of the duties and responsibilities as counsel until a motion to withdraw has been authorized, filed, and granted; and

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FURTHER ORDERED that if Mr. Fuisz and/or Ms. Chen desires to file a motion to withdraw, prior authorization for filing the motion is required. 37 C.F.R. § 42.20(b).

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