

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SUMITOMO ELECTRIC INDUSTRIES, LTD.,
Petitioner,

v.

UNITED TECHNOLOGIES CORPORATION,
Patent Owner.

Case IPR2017-00966
Patent 9,166,243 B2

Before CHRISTOPHER L. CRUMBLEY, JON B. TORNQUIST, and
JEFFREY W. ABRAHAM, *Administrative Patent Judges*.

CRUMBLEY, *Administrative Patent Judge*.

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

At the joint request of the parties, the Board held an initial conference call in this matter on October 11, 2017. The following matters were discussed with counsel.

Schedule. The parties jointly requested extensions of Due Dates 1 and 2 as set in our Scheduling Order (Paper 8), because they bridge the holiday season. Counsel noted that the parties could be granted a two-week extension of each date while still leaving three months between Due Date 7 (oral hearing, if requested) and the deadline for a final written decision. We noted that the parties are free to stipulate to different dates for Due Dates 1 through 5, and that additional time in the current schedule may be available if Patent Owner chooses not to file a motion to amend claims. We requested that the parties confer regarding the potential for such a stipulation, but if the parties are unable to reach agreement, we authorized the parties to file a joint motion to amend the Scheduling Order, setting forth new dates for Due Dates 1–7 that are agreeable to both parties. The parties are reminded that any requested dates will have to be evaluated in light of the scheduling needs of the Board.

Motions List. The parties submitted a list of potential motions to the Board, including motions to exclude, motions for additional discovery, and a motion for an extension of time to file supplemental evidence. We generally discussed these potential motions with counsel, but both parties agreed that they had not yet determined whether any of the motions would be necessary. Authorization to file the motions is, therefore, premature. The parties were invited to return to the Board to request authorization if such motions become necessary.

Foreign-Language Deposition. The parties informed us that on October 26, 2017, counsel for Patent Owner will depose Petitioner's expert, and that the deposition will be conducted in a foreign language. Pursuant to the Board's Rules, parties are to initiate a conference with the panel at least

five business days before a deposition if an interpreter is to be used. 37 C.F.R. § 42.53(e). As noted in the comments to the Rules, “[b]ased on the Board’s experience, non-English language depositions can be highly complex. In order to ensure such depositions are productive and to minimize unnecessary cost and delay, prior Board authorization is required.” 77 Fed. Reg. 48,624 (Aug. 14, 2012).

Based on the brief explanation provided by counsel during the phone call, it appears the parties have been able to reach agreement regarding the procedures to be used during the deposition, and that further involvement by the Board is unnecessary at this time. To the extent further guidance is required, the parties are directed to the Board’s Order articulating guidelines for the conduct of foreign-language depositions in *Ariosa Diagnostics v. Isis Innovation Ltd.*, IPR2012-00022, Paper 55 (PTAB Aug. 7, 2013) (informative) (available at <https://go.usa.gov/xnad2>).

In light of the foregoing, it is

ORDERED that, the parties are authorized to file, on or before October 18, 2017, a motion to amend the scheduling order if they are unable to reach agreement on a stipulation as outlined above; and

FURTHER ORDERED that the parties’ obligation to confer with the Board pursuant to 37 C.F.R. § 42.53(e) has been met.

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