

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOSHIBA CORPORATION, TOSHIBA MEMORY CORPORATION, and
TOSHIBA AMERICA ELECTRONIC COMPONENTS, INC.,
Petitioners,

v.

MACRONIX INTERNATIONAL CO., LTD.,
Patent Owner.

Case IPR2017-01632
Patent 8,035,417 B1

Before KEN B. BARRETT, JENNIFER S. BISK, and JASON M. REPKO,
Administrative Patent Judges.

REPKO, *Administrative Patent Judge.*

SCHEDULING ORDER

No initial conference call is scheduled for this proceeding. If there is a need to discuss proposed changes to this Scheduling Order or proposed motions, the parties are directed to contact the Board within a month of this Order. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,765–66 (Aug. 14, 2012) (guidance regarding initial conference calls).

A. DUE DATES

This order sets 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). A notice of the stipulation, specifically identifying the changed due dates, must be promptly filed. The parties may not stipulate to an extension of DUE DATES 6 and 7.

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 (*see* section B, below).

The parties are reminded that the Testimony Guidelines appended to the Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,772 (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.

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 an observation on the cross-examination testimony of a reply witness (*see* section C, 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

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

B. 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.*

C. OBSERVATION ON CROSS-EXAMINATION

An 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 48,768.* The observation must be a concise statement of the

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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.

D. PETITIONER'S REPLY

Notwithstanding the page limit set forth in 37 C.F.R. § 42.24(c), petitioner's reply brief to patent owner response is limited to twenty-five (25) pages. *See* 37 C.F.R. § 42.5(b).

E. MOTION TO AMEND

Although the filing of a Motion to Amend is authorized under the trial Rules, Patent Owner must confer with the Board, preferably no less than ten business days prior to DUE DATE 1, before filing any Motion to Amend. The parties are also directed to the Board's Guidance on Motions to Amend in view of *Aqua Products* (Nov. 21, 2017) on the USPTO's website and available at

https://www.uspto.gov/sites/default/files/documents/guidance_on_motions_to_amend_11_2017.pdf.

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