

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

ENFISH, LLC,
Patent Owner.

Case IPR2013-00559 (Patent 6,163,775)
Case IPR2013-00560 (Patent 6,163,775)
Case IPR2013-00561 (Patent 6,163,775)
Case IPR2013-00562 (Patent 6,151,604)
Case IPR2013-00563 (Patent 6,151,604)¹

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Before THOMAS L. GIANNETTI, BRYAN F. MOORE, SCOTT A. DANIELS,
and BARBARA A. PARVIS, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

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

¹ This decision addresses issues that are identical in the five cases. The parties are not authorized to use this heading style in their papers.

IPR2013-00559 (Patent 6,163,775)
IPR2013-00560 (Patent 6,163,775)
IPR2013-00561 (Patent 6,163,775)
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IPR2013-00563 (Patent 6,151,604)

The Board held a conference call in this proceeding on October 10, 2014. The participants were counsel for the Petitioner and Patent Owner, respectively, and Administrative Patent Judges Thomas Giannetti, Bryan Moore, Scott Daniels, and Barbara Parvis. The call was requested by Petitioner to request authorization to file a motion to quash the deposition notices of Petitioner's expert, Antony Hosking, Ph.D., that were served and filed by Patent Owner in each of these proceedings. The notices were served on October 2, 2014, and call for Dr. Hosking to appear for a deposition on October 16, 2014.

Petitioner objected to the notices as untimely. Petitioner also represented that Dr. Hosking is not available on the date noticed.

After hearing argument from the parties, the Board denied Petitioner's request and directed the deposition to proceed either on October 28, 2014, or October 31, 2014, the earliest dates on which Dr. Hosking is available for a deposition.

DISCUSSION

Petitioner's objection to the timeliness of the notices is based on the time line set forth in the Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48757 (Aug. 14, 2012). There, the Patent Owner's discovery period following the filing date of Petitioner's Reply to Patent Owner's Response (Due Date 2 on the Scheduling Order) is shown as one month, ending with Patent Owner's Reply to Petitioner's Opposition to Patent Owner's Motion to Amend. (Due Date 3).

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Patent Owner contends that its notice was timely because it was served within the one month period, and that because there is no motion to amend, there is no opposition or reply, eliminating Due Date 3.

While we see merit in Petitioner's argument that the timeline in the Practice Guide should be honored, on the facts of this case, we determine that the deposition should go forward. There is no motion to amend, and Petitioner was unable to point to any significant prejudice that cannot be addressed by adjusting Due Dates 4, 5, and 6, and permitting Petitioner to respond to Patent Owner's motions for observations.

It is, therefore,

ORDERED that Petitioner's request to file a motion to quash Patent Owner's Notice of Deposition of Antony Hosking, Ph.D., in each of these proceedings is denied;

FURTHER ORDERED that the deposition of Dr. Hosking shall proceed either on October 28, 2014 or October 31, 2014, at a location to be determined by the parties;

FURTHER ORDERED that the parties shall confer promptly on a new schedule for Due Dates 4-6 (but not Due Date 7) and file a notice of their agreement on those dates;

FURTHER ORDERED that the Request for Oral Argument shall remain due by October 27, 2014; and

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IPR2013-00563 (Patent 6,151,604)

FURTHER ORDERED that Patent Owner shall be permitted to respond to Patent Owner's Motion for Observations on Dr. Hosking's deposition testimony by Due Date 5.

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