

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION,
Petitioner,

v.

IMATION CORPORATION,
Patent Owner.

Case IPR2015-01557
Patent 6,890,188 B1

Before KEVIN F. TURNER, STACEY G. WHITE, and KERRY BEGLEY,
Administrative Patent Judges.

BEGLEY, *Administrative Patent Judge.*

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

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An initial conference call was held on February 11, 2016. The conference was attended by Judges Turner, White, and Begley; Gregory S. Gewirtz for Petitioner Sony Corporation (“Petitioner”); and Michelle E. Dawson and Devan V. Padmanabhan for Patent Owner Imation Corporation (“Patent Owner”). The following matters were discussed.

Scheduling Order

Counsel for Patent Owner requested an extension of each due date in the scheduling order by either more than one month or two months so that the Patent Owner Response would be due after the statutory deadline (March 26, 2016) for the final written decision in IPR2015-00066, *Kingston Technology Co. v. Imation Corp.*, a pending *inter partes* review involving the same patent, with a different petitioner. *See* Paper 8 (Scheduling Order), 6. Patent Owner indicated that it was requesting the extension only for this proceeding, and not for IPR2015-01556, *Sony Corp. v. Imation Corp.*, another proceeding pending between the same parties, which currently have the same schedule as this proceeding. Counsel for Petitioner responded that Petitioner would prefer to maintain the existing schedule and that the proposed extensions would prejudice Petitioner because they would cause scheduling conflicts for counsel, resulting from a previously scheduled trial, and are strategically helpful to Patent Owner. Counsel for Petitioner further represented that Petitioner has discussed with Patent Owner a willingness to extend due date 1 in the Scheduling Order, the due date for the Patent Owner Response, until four business days after the Board issues the final written decision in IPR2015-00066.

We reminded the parties that, as stated in our Scheduling Order, they may stipulate to extend due dates 1 through 5 in the Scheduling Order, including the due date for the Patent Owner Response (due date 1). *Id.*

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at 2, 6. We, however, denied Patent Owner's request to extend due dates 6 (reply to opposition to motion to exclude) and 7 (oral argument).

Patent Owner's desire to address the final written decision from IPR2015-00066 in its Patent Owner Response does not warrant extending the final two due dates set in the Scheduling Order. The Patent Owner Response affords Patent Owner the opportunity to address the grounds of unpatentability instituted in this case, including Petitioner's arguments and the analysis in the Institution Decision regarding these grounds—it is not intended to be a response to a decision in another case. *See* 37 C.F.R. § 42.120. In addition, Petitioner's concerns regarding possible prejudice to Petitioner and scheduling difficulties for its counsel strongly weigh against granting the requested extensions. Moreover, because this *inter partes* review is an expedited proceeding that, by statute, must be completed within one year of institution, the requested one-month or two-month extension of all due dates, including the oral hearing, would increase the burdens and demands on Petitioner and the Board to comply with the statutory deadlines. We also noted that Patent Owner's Preliminary Response was filed nearly a month early, which expedited the statutory deadline for the institution decision and, therefore, the final written decision and all intermediate due dates, including the Patent Owner Response. *See* Paper 5 (Notice of Filing Date Accorded), 2; 37 C.F.R. § 42.107(b); 35 U.S.C. § 314(b). Finally, granting the requested extension would bring the schedule for this proceeding out of alignment with IPR2015-01556, thereby creating further scheduling difficulties and expense (e.g., requiring two separate hearings).

Motions

Counsel for Petitioner represented that the only motion Petitioner currently intends to file is for *pro hac vice* admission of Russell Faegenburg.

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We reminded Petitioner that they have been authorized to file motions for *pro hac vice* admission. See Paper 5 (Notice of Filing Date Accorded), 2. Counsel for Patent Owner indicated that it does not oppose the proposed *pro hac vice* motion. In addition, counsel for Patent Owner represented that Patent Owner does not contemplate any motions at this time.

We reminded the parties that, except as otherwise provided in our rules, Board authorization is required before filing a motion. We encouraged the parties to confer and make reasonable efforts to reach agreement before requesting authorization from the Board to file a motion.

Protective Order

Both parties indicated that, at present, they do not anticipate the need for a protective order in this proceeding. We reminded the parties that there is no protective order in place in this proceeding, and none will be entered unless a party files a motion to seal with a proposed protective order that is approved by the Board. We advised counsel that if the parties later request entry of a protective order, the Board encourages use of the default protective order in Appendix B of the Office Patent Trial Practice Guide. See *Office Patent Trial Practice Guide; Rule, 77 Fed. Reg. 48,756, 48,769-71 (Aug. 14, 2012) (App. B)*. If the parties choose to propose a protective order that deviates from the default protective order, they must submit the proposed protective order jointly and we request that they submit a marked-up comparison of the proposed and default protective orders.

Related Proceedings

Counsel for both parties indicated that the district court case between the parties, *Imation Corp. v. Sony Electronics, Inc.*, 14-cv-00628 (D. Minn.), has been stayed. The parties indicated that they had nothing to report regarding any possible settlement.

ORDER

Accordingly, it is:

ORDERED that Due Dates 6 and 7 set forth in the Scheduling Order remain unchanged.

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