

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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PRESIDIO COMPONENTS, INC.,  
Petitioner,

v.

AMERICAN TECHNICAL CERAMICS CORP.,  
Patent Owner.

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Case IPR2015-01330 (Patent 6,337,791)  
Case IPR2015-01331 (Patent 6,992,879)

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PRESIDIO COMPONENTS, INC.,  
Petitioner,

v.

AVX CORPORATION,  
Patent Owner.

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Case IPR2015-01332 (Patent 6,144,547)

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Before MITCHELL G. WEATHERLY and MATTHEW R. CLEMENTS,  
*Administrative Patent Judges.*

CLEMENTS, *Administrative Patent Judge.*

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

IPR2015-01330 (6,337,791)  
IPR2015-01331 (6,992,879)  
IPR2015-01332 (6,144,547)

On June 17, 2016, Patent Owner requested a conference call to request authorization to (1) file complete transcripts of the cross-examination testimony of expert witnesses; and (2) file a motion to strike the Reply and accompanying expert Declaration (Ex. 1015) or file a Sur-Reply to respond to alleged new arguments raised in Petitioner's Reply. On June 22, 2016, a conference call was held between Judges Weatherly and Clements, and counsel for the respective parties.

*Transcripts*

The parties sought permission for both Petitioner (in IPR2015-01330, IPR2015-01331, IPR2015-01332) and Patent Owner (in IPR2015-01331) to file complete transcripts of the cross-examination testimony of expert witnesses in accordance with 37 C.F.R. § 42.53(f)(7) and in the interest of maintaining a complete record of these proceedings. The panel authorizes the parties to do so.

*Alleged New Arguments in Petitioner's Reply*

Patent Owner contends that Petitioner introduced new arguments and evidence in its Reply that are beyond the proper scope of a Reply. Petitioner contends that the arguments and evidence are merely responsive to positions taken by Patent Owner in its Patent Owner Response.

The Board will determine whether the new argument and evidence is outside the proper scope of a reply when writing the final written decision. To aid us in resolving the dispute, Patent Owner is authorized to file a brief statement, limited to two pages, that identifies the allegedly new arguments and evidence introduced in Petitioner's Reply. Petitioner is authorized to file a brief response, limited to two pages, that identifies the portion of the

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Patent Owner Response to which the argument and evidence identified by Patent Owner responds. Also, either party may address these issues during the oral hearing. If, while preparing the final written decision, we agree with the Patent Owner that material in Petitioner's Reply exceeded the proper scope of a reply, then we will not consider such improper material.

*Adjustments to the Schedule*

On the call, Patent Owner raised a third issue regarding depositions and scheduling. Specifically, Petitioner offered its expert for deposition on July 6, 2016, which corresponds with Due Date 4 (Paper 12, "Scheduling Order"). Patent Owner contends that, in order to have sufficient time to prepare and file its Motion for Observation Regarding Cross-Examination, also due July 6, 2016, it needs to depose Petitioner's expert no later than July 1. Petitioner explained that it received Patent Owner's request for deposition dates last week and timely responded by offering July 6, 2016, the first date on which the witness is available after a vacation. Petitioner offered that it would not be opposed to adjusting Due Dates, but did not propose specific adjustments to the schedule. The panel asked Patent Owner to propose new Due Dates 4, 5, and 6 that would provide sufficient time for it to prepare a Motion for Observation on Cross-Examination if the deposition were to occur on July 6, 2016. After discussion, the parties agreed to adjust Due Dates 4, 5, and 6 as set forth below.

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## ORDER

It is

ORDERED that Petitioner and Patent Owner may file complete transcripts of the cross-examination testimony of expert witnesses; and

FURTHER ORDERED that:

(1) no later than five (5) days after entry of this Order, Patent Owner is authorized to file a paper not exceeding two (2) pages to identify the new evidence relied upon in Petitioner's Reply that it believes to be beyond the proper scope of a reply;

(2) no later than five (5) days after the filing of the above paper by Patent Owner, Petitioner is authorized to file a paper not exceeding two (2) pages to identify the portion of the Patent Owner Response to which the new evidence identified by Patent Owner is a proper response; and

FURTHER ORDERED that Due Date 4 is reset to July 19, 2016, Due Date 5 is reset to July 25, 2016, and Due Date 6 is reset to August 2, 2016.

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