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Paper 38
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIBERTY MUTUAL INSURANCE CO.
Petitioner,

v.

PROGRESSIVE CASUALTY INSURANCE CO.
Patent Owner.

Case CBM2012-00002 (JL)
Patent 6,064,970

Before JAMESON LEE, JONI Y. CHANG, and MICHAEL R. ZECHER, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*

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

On August 29, 2013, a telephone conference call was held between respective counsel for the parties and Judges Lee, Chang, and Zecher. Counsel for the Patent Owner commenced the discussion by representing

that Petitioner's Reply is improper and is accompanied by evidence which could have been submitted together with the initial petition.

The Board explained that while it is possible that Petitioner's Reply may be inappropriate, the Patent Owner should recognize the following:

(1) the standard for determining whether a Reply is appropriate is not whether an argument contained therein or evidence submitted therewith "could have been" submitted in the original petition;

(2) the Board already determined it is more likely than not that Petitioner would prevail on one or more grounds of alleged unpatentability; thus, it is generally less likely than in the case of a motion which has not yet been reviewed by the Board that Petitioner in its initial petition did not make out a prima facie case and needs to rely on its reply to do so;

(3) by standard procedure the Petitioner has the last word with regard to the petition and it would not be unusual that one or more reply declarations may be necessitated by the arguments and evidence presented with the Patent Owner Response;

(4) a petitioner reasonably cannot anticipate in advance everything that may be presented in a Patent Owner Response; and

(5) the mere fact that Petitioner did not rely on declarations of Ms. O'Neal and Mr. Andrews in the initial petition does not mean automatically that Petitioner may not rely on testimony of those declarants to support its Reply.

Counsel for Patent Owner, upon hearing the Board's explanation, did not pursue the subject of the allegedly inappropriate reply further except to

state that the Patent Owner has no opportunity to file a surreply or to cross-examine Petitioner's reply declarants. The Board stated that that is only partially true. While there is no preset opportunity to file a surreply, Patent Owner does have the right to cross-examine Petitioner's reply declarants and then, in appropriate circumstance, request authorization to file a motion for observation on cross-examination. That is so notwithstanding that the Scheduling Order issued in this case made no reference to such cross-examination and filing of a motion for observation on cross-examination.

Counsel for each party agreed to confer with each other to propose a time schedule for Patent Owner to cross-examine Petitioner's reply declarants, and to propose to the Board an appropriate adjustment to Due Dates 4-6. The Board indicated that it would move Due Dates 4-6 to accommodate the schedule jointly proposed by the parties but that Due Date 7 will not be moved. The Board further indicated that any motion for observation on cross-examination of Petitioner's reply declarants should be filed by Due Date 4.

It is

ORDERED that the parties shall, by September 4, 2013, file a proposed revised Scheduling Order for consideration by the Board, which makes it possible for Patent Owner to cross-examine Petitioner's reply declarants and file a motion for observation on cross-examination by Due Date 4; and

FURTHER ORDERED that subsequent to the cross-examination of Petitioner's reply declarants, if Patent Owner desires to file a motion for

observation on cross-examination, a joint telephone conference call should be made to confer with the Board about authorization to file the motion for observation.

Case CBM2012-00002
Patent 6,064,970

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