

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 CBM2012-00003 (JL)
Patent 8,140,358

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 February 28, 2013, a telephone conference call was held between respective counsel for the parties and Judges Lee, Chang, and Zecher. The subject of discussion was what motions the parties intend to file.

The parties indicated a general desire to have a protective order put in place to cover disclosure of confidential information. Counsel for the parties agreed to work toward that end and to ask the Board for assistance if they need authorization to deviate from the default protective order in Appendix B to the Board's Trial Practice Guide. *See Office Patent Trial Practice Guide*, 77 Fed. Reg. 48756, 48769 (Aug. 14, 2012). Counsel offered to submit a red-lined copy based on the default protective order prior to initiating a conference call to discuss any variation from the default protective order. The panel appreciates the offer. The red-lined copy for discussion should not be officially filed. It should be sent by electronic mail as a courtesy copy for use in the telephone conference call to each party and the Board.

Petitioner proposed to file a motion for *pro hac vice* admission of a number of individuals. The panel referred counsel to an order posted on the Board's website with regard to the filing of such a motion.

Counsel for the patent owner indicated that the patent owner may seek to amend one or more claims. The panel expressed appreciation for patent owner's commitment to not add new matter and not to enlarge the scope of existing claims. Note also that all proposed amendments must reasonably reflect an effort to obviate or otherwise render moot one or more of petitioner's arguments against an unamended claim.

Finally, counsel for petitioner proposed joining this covered business method patent review with any covered business method patent review to be instituted on CBM2013-00009 directed to the same involved patent.

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Counsel for the patent owner indicated that he could not take a meaningful position on that request prior to reviewing the decision to institute a covered business method patent review in CBM2013-00009. Nevertheless, counsel for both parties agreed to work together in a cooperative manner, if and when a decision to institute a review is rendered in CBM2013-00009, to see what measures can be proposed to improve the efficiencies of the two reviews on the same patent.

It is

ORDERED that the petitioner is authorized to file a motion for *pro hac vice* admission under 37 C.F.R. § 42.10(c), and that such a motion shall be filed in accordance with the “Order -- Authorizing Motion for *Pro Hac Vice* Admission” in Case IPR2013-00010 (MPT), a copy of which is available on the Board Web site (at <http://www.uspto.gov/PTAB>) under “Representative Orders, Decisions, and Notices”; the patent owner has one week from the time of filing of the motion to oppose the motion; and

FURTHER ORDERED that the patent owner may file a motion to amend one or more of its claims which are subject to at least one ground of unpatentability for which this review has been instituted; and

FURTHER ORDERED that petitioner may initiate a joint conference call, if a review is instituted in CBM2013-00009, to discuss potential joinder.

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