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Paper 75
Entered: December 4, 2013

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
Patent 8,140,358

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

LEE, *Administrative Patent Judge*

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

December 2, 2013, a telephone conference call was held between respective counsel for the parties and Judges Lee and Chang. Counsel for Petitioner initiated the conference call to ask that this proceeding be joined

with CBM2013-00009, which is also directed to Patent 8,140,358. The reason for the requested joiner is to avoid any possible argument that once a final written decision is issued in this case, another final written decision cannot be pursued or issued on the same claims, in CBM2013-00009, and vice versa. Petitioner's concern stems from what it regards as potentially incorrect application of 35 U.S.C. § 325(e) and 37 C.F.R. § 42.73(d)(1). Alternatively, Petitioner proposed that a single joined decision be issued for this case and CBM2013-00009, or that the final written decisions for the two cases be issued on the same date, in that order of preference.

Counsel for the Patent Owner expressed that he previously has not considered the issues that are involved, that it seems nothing should be created or engineered to avoid whatever consequences that naturally flow from the Board's issuance of the final written decisions in the two cases, and that at the very least, there has to be substantive briefing on the issue.

The Board agrees with the Patent Owner that nothing unusual should be arranged to avoid a potential issue that hinges on when the Board renders final written decisions in CBM2012-00003 and CBM2013-00009. Whatever is the consequence of the timing of the decisions, it is. The Board should not act in favor of one party or another.

However, the Board noted that the schedules of CBM2012-00003 and CBM2013-00009 have been synchronized since April 19, 2013, and that final hearing was held on the same date. The parties can expect that the final written decisions for the two cases will issue on the same date, as that has been the plan according to the formal schedule. In particular, note Revised

Scheduling Order in CBM2012-00003 (Paper 30), and Second Revised Scheduling Order in CBM2013-00009 (Paper 17).

It is

ORDERED that Petitioner is not authorized to file a motion to join this proceeding with CBM2013-00009, to seek that a single joint decision be issued for CBM2012-00003 and CBM2013-00009, or to seek that the final written decisions for CBM2012-00003 and CBM2013-00009 be issued on the same date.

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