

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 CBM2012-00004 (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 February 25, 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.

First, 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 for the petitioner identified two items with respect to which he would like to submit supplemental information under 37 C.F.R. § 42.223. The first is an infringement analysis by the patent owner. According to petitioner, that analysis conflicts with certain positions taken by the patent owner in the patent owner's preliminary response. The second is a letter dated November 2011 from petitioner's counsel to patent owner's counsel. According to the petitioner, that letter rebuts certain arguments in the patent owner's preliminary response. The panel informed petitioner's counsel that filing of such supplemental information at this time is not authorized, but that if the patent owner maintains those arguments in the full patent owner's response, the petitioner may submit the information in its reply.

Finally, petitioner inquired about whether there is a minimum threshold for number of years of legal experience sufficient to qualify one as having substantial litigation experience to support a motion for *pro hac vice* admission. The panel replied that the totality of the circumstances including all pertinent factors must be considered to determine whether there is good cause pursuant to 37 C.F.R. § 42.10(c) for admission, and that no specific number of years represents a minimum threshold.

Counsel for the patent owner indicated that the patent owner may seek to amend one or more claims. The panel informed counsel 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.

It is

ORDERED that the petitioner is not authorized to file the supplemental information referred to in the conference call; and

FURTHER 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 proceeding has been instituted.

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