

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 March 18, 2013, a telephone conference call was held between
respective counsel for the parties and Judges Lee, Chang, and Zecher.
Mr. James Myers, admitted *pro hac vice*, and Mr. Steven Baughman

appeared for petitioner (Liberty), Messrs. Calvin Griffith, James Wamsley, and John Biernacki appeared for patent owner (Progressive). Progressive initiated the conference call to discuss Liberty's desire to have Progressive combine the cross examination of Liberty's technical witness Scott Andrews in all three CBM2012-00002, CBM2012-00003, and CBM2012-00004, and perhaps also CBM2013-00004, in a single deposition, for cost savings, convenience, and enhanced efficiency. The parties also had unresolved differences about (1) the location of the cross examination of Scott Andrews, (2) the duration of the cross-examination in a combined deposition, and (3) Progressive's desire to videotape the cross examination of Scott Andrews.

Progressive's counsel expressed a general willingness to combine its cross examination of Scott Andrews, but only if the expiration date for Time Period 1 (DUE DATE 1) for filing of patent owner's response in CBM2012-00003 is postponed. As set forth in the respective Scheduling Orders, Time Period 1 is currently set in CBM2012-00003 to expire on April 12, 2013, in CBM2012-00002 and CBM2012-00004 to expire on April 25, 2013, and in CBM2013-00004 to expire on May 29, 2013. The respective times are different because CBM2012-00003 was instituted on February 12, 2013, CBM2012-00002 and CBM2012-00004 were instituted on January 25, 2013, and CBM2013-00004 was instituted on March 15, 2013.

Liberty's counsel offered to extend Time Period 1 in CBM2012-00003 to allow sufficient preparation time for Progressive to take a single cross examination of Scott Andrews for CBM2012-00002, CBM2012-00003, CBM2012-00004, and possibly CBM2013-00004. Liberty's counsel

was asked by the judges whether Liberty is offering some of its own reply time in Time Period 2 which expires on DUE DATE 2 for use by Progressive in Time Period 1. In response, counsel for Liberty proposed to work with counsel for Progressive to stipulate to different dates for DUE DATES 1 through 3 (earlier or later, but no later than DUE DATE 4) as authorized in the Scheduling Orders, for CBM2012-00002, CBM2012-00003, CBM2012-00004, and possibly CBM2013-00004, to accommodate and enable a single combined cross examination of Scott Andrews.

With regard to the location of the cross examination, Liberty offered to make Scott Andrews available for cross examination at the office of Liberty's counsel in Chicago, the same city where the office of Progressive's counsel is located. The judges explained to counsel for Progressive that Liberty's proposal was reasonable and Liberty has no obligation to provide Scott Andrews for cross examination at the office of Progressive's counsel.

With regard to setting a maximum number of hours for any combined cross examination of Scott Andrews, the judges informed counsel for Liberty that there is no good reason to set such a maximum number of hours in advance. The combined cross examination is expected to take more time than any single non-combined cross examination, but less than all the individual cross examination times combined. The judges do not want to be speculative at this time. However, counsel for both parties were informed that if repetitive questioning becomes a problem, either party may call the Board during cross examination to seek a resolution of the issue at that time.

With regard to Progressive's request to make a video recording of the cross examination of Scott Andrews, counsel for Progressive explained that Progressive will pay for all costs associated with video recording and that the content of the deposition transcript will be mapped to specific locations on the recorded video such that corresponding video to any portion of the deposition transcript will be easily locatable. The judges informed counsel for the parties that if video recording is permitted, the parties should call to the judges' attention only those "exceptional" moments which have "special" significance to the demeanor of the witness, and that the Board may decide not to review any portion of the recorded video. By providing the video recording, Progressive is only preserving an opportunity for the Board to review the recorded video.

It is

ORDERED that the parties may stipulate to different DUE DATES 1-3 without changing DUE DATES 4-7, to enable a single cross examination of Scott Andrews in CBM2012-00002, CBM2012-00003, CBM2012-00004, and possibly CBM2013-00004;

FURTHER ORDERED that Liberty need not provide Scott Andrews at the office of Progressive's counsel but may provide the witness in the office of its own counsel;

FURTHER ORDERED that at its own cost, Progressive may record a video of the cross examination of Scott Andrews and submit the same as an exhibit in this case. *See* 37 C.F.R. § 42.53(a).

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