

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 CBM2013-00009 (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 April 10, 2013, the initial telephone conference call for this trial was held between respective counsel for the parties and Judges Lee, Chang, and Zecher. The purpose of the call was to discuss the motions that the parties intend to file and any proposed changes to the Scheduling Order (Paper 11). Each party filed its list of proposed motions (Papers 12 and 13)

to provide the Board and the opposing party adequate notice to prepare for the conference call.

Protective Order

Liberty indicated that the parties may desire to have a protective order put in place to cover disclosure of confidential information. 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). The parties 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 order. The Board appreciates the offer. The red-lined copy for discussion should not be filed. It should be sent by electronic mail as a courtesy copy for use in the telephone conference call to the Board with copy to each party.

Pro Hac Vice Admission

Liberty further proposed to file motions for *pro hac vice* admission of attorneys under 37 C.F.R. § 42.10(c). Such motions are already authorized in the Notice According Filing Date. (Paper 4.) Note, however, that the Office has published a Final Rule adopting new Rules of Professional Conduct. *See Changes to representation of others Before the United States Patent and Trademark Office; Final Rule*, 78 Fed. Reg. 20180 (Apr. 3, 2013). The changes set forth in that Final Rule including the USPTO Rules of Professional Conduct take effect on May 3, 2013. *Id.* at 20180-81. Any motion for *pro hac vice* admission to be filed by the parties should also

indicate that the person sought to be admitted will be subject to the USPTO's new Rules of Professional Conduct which become effective on May 3, 2013.

Claim Amendments

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

Changes to the Scheduling Order

During the conference call, the judges first noted that the instant trial is the last of the seven trials involving the same parties, and then explained to counsel of both parties that the schedule illustrated in the *Office Trial Practice Guide*, 77 Fed. Reg. 48757 (Aug. 14, 2012), provides merely a sample illustrative of how the statutory time limits may be met. It is not a "default" or "standard" schedule that should be expected for all cases. Instead, the judges consider all the factors on a case-by-case basis and set an appropriate schedule accordingly. Given that the instant trial is the second one for the same patent, that the prior art references on the basis of which review was instituted are the subject of another petition in CBM2013-00003 involving the same parties, and that the parties jointly were seeking ways to minimize separate cross-examinations of the same witness whose testimony is relied on in multiple trials involving the same parties, the Board considered seven weeks sufficient for preparation of the patent owner's

response. The Board did not regard seven weeks as sufficient for the petitioner to prepare an opposition to any motion to amend claims to be submitted by the patent owner who has indicated in the other six trials that it intends to file such a motion, because it would be difficult to anticipate in what ways the patent owner would amend its claims.

Counsel for the patent owner represented that the patent owner would need only to have the oral argument date, DUE Date 7, pushed back by ten days to November 7, 2013, and that he can work backwards from DUE Date 7 to determine new DUE Dates 1-6 that would be mutually acceptable to the parties. Counsel for petitioner made no objection to the ten day adjustment. Instead, counsel for the petitioner requested that the schedules of this review and that in CBM2013-00003 be adjusted in a way that will ensure that the two cases have oral argument on the same date. The judges explained that while the due dates set in CBM2013-00003 cannot be pushed back in any substantial manner because of the statutory one-year period from the time of institution to issue a final written decision, the Board would consider shortening the time periods in this trial if there is agreement between the parties to do so.

Counsel were instructed to consult with each other, after the conference call, regarding whether they can agree on new DUE Dates 1-6, with DUE Date 7 reset to November 10, 2013, and counsel for patent owner was instructed to provide such new dates to the Board.

On April 11, 2013, counsel for patent owner informed the Board that the parties were unable to reach agreement with respect to new dates for DUE Dates 1-6.

Order

It is

ORDERED that Liberty 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; any motion for *pro hac vice* admission should also indicate that the person sought to be admitted will be subject to the USPTO’s new Rules of Professional Conduct which become effective on May 3, 2013;

FURTHER ORDERED that Progressive may file a motion to amend one or more of its claims which are subject to at least one ground of unpatentability challenge for which this trial has been instituted;

FURTHER ORDERED that if the parties need authorization to deviate from the default protective order, the parties may initiate a joint conference call and send by electronic mail a courtesy copy of a proposed default protective order to the Board with copy to the opposing party no later than two business days prior to the joint telephone conference call; and

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