

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOYOTA MOTOR CORPORATION.
Petitioner,

v.

AMERICAN VEHICULAR SCIENCES LLC.
Patent Owner.

Case IPR2013-00417
Patent 8,036,788 B2

Before JAMESON LEE, BARBARA A. PARVIS, and
GREGG I. ANDERSON, *Administrative Patent Judges.*

LEE, *Administrative Patent Judge.*

Order
Conduct of Proceedings
37 C.F.R. § 42.05

Introduction

On February 3, 2014, an initial telephone conference call was held between respective counsel for the parties and Judges Lee, Parvis, and Anderson. Both parties filed a list of proposed motions. Paper 18 (Patent Owner's list); Paper 19 (Petitioner's list).

Discussion

The sole item listed on Petitioner's list of proposed motions is a motion to extend the deadline for submitting supplemental evidence, under 37 C.F.R. § 42.64(b)(2), in response to Patent Owner's objection to Petitioner's evidence. However, counsel for both parties indicate jointly that they have resolved the issue by agreeing that such supplemental evidence will be due on February 18, 2014. The Board approves of that agreement by the parties. Therefore, it is not necessary for Petitioner to file a motion for such extension.

The parties indicated that they have stipulated to different Due Dates 1-3. The Board instructed that the stipulation be filed. However, none of the stipulated Due Dates 1-3 should extend beyond the original Due Date 4, July 10, 2014.

Item 1 on Patent Owner's list of proposed motions pertains to a proposed motion for modification of Due Dates 1-3 in the Scheduling Order dated January 13, 2014 (Paper 15). The proposed motion is moot in light of the parties' agreement to different stipulated Due Dates 1-3.

Item 2 on Patent Owner's list pertains to a proposed motion for additional discovery. Based on discussions in the conference call, it is evident that that proposed motion is premature at this time. Counsel for Patent Owner will contact the Board at an appropriate time when he has more specifics with regard to the material Patent Owner seeks to discover. The parties should note IPR2012-00001

(Paper 20) with regard to the factors applicable for determining appropriateness of additional discovery.

Item 3 on Patent Owner's list pertains to a potential motion to exclude evidence. The matter is premature. The Board also noted that a party does not need prior authorization from the Board to file a motion to exclude evidence. Motions to exclude evidence are provided for in the Scheduling Order. Also, the Board advised counsel for both parties that the motion to exclude evidence is not provided as a vehicle via which to contend that any argument or evidence in support of a reply exceeds the proper scope of a reply. Accordingly, neither party is authorized to include in a motion to exclude evidence an assertion that a reply argument or evidence in support of a reply exceeds the proper scope of a reply.

Item 4 on Patent Owner's list pertains to a potential motion to amend claims. Based on discussions in the conference call, this matter is premature, as Patent Owner does not yet know in what way it would seek to amend claims. In any event, Patent Owner does not need authorization from the Board to file a first motion to amend claims. Under 37 C.F.R. § 1.121(a), however, Patent Owner is required to confer with the Board prior to filing such an amendment. In that connection, because the discussion is premature, this conference call does not satisfy the requirement "to confer" under 37 C.F.R. § 1.121(a).

Item 5 on Patent Owner's list pertains to a potential motion to substitute Lead and/or Back-Up Counsel. The Board explained that a party may re-designate lead or back-up counsel without need of a formal motion, subject, however, to the requirements that (1) lead counsel must be a registered practitioner, and (2) a non-registered practitioner may not be designated as counsel unless a motion for *pro hac vice* admission of the non-registered practitioner has been granted. Note

further that counsel may not withdraw from this proceeding unless the Board has authorized the withdrawal. 37 C.F.R. § 42.10(e).

Finally, counsel for Patent Owner indicated that he would like to withdraw the objections which note that Petitioner's evidence is deficient on the merits on substantive issues. The Board approved and granted the withdrawal of such objections. Given that the noted objections are withdrawn, counsel for Petitioner agreed not to submit supplemental evidence which add to the substantive merit of the evidence relied on in the petition.

The Board asked counsel for both parties to contemplate whether the final hearing for this trial may be conducted as part of a joint final hearing with IPR2013-00412, IPR2013-00413, IPR2013-00414, IPR2013-00415, and IPR2013-00416, on a single day, and to inform the Board accordingly at an appropriate time.

Order

It is

ORDERED that the sole item on Petitioner's list of proposed motions is dismissed as moot, and that the due date with regard to Petitioner's supplemental evidence under 37 C.F.R. § 42.64(b)(2) is reset to February 18, 2014;

FURTHER ORDERED that all of the items on Patent Owner's list of proposed motions are dismissed as moot, premature, or unnecessary; and

FURTHER ORDERED that Patent Owner should initiate a conference call with the Board to "confer" about a motion to amend claims at least one week prior to the filing of the motion to amend claims.

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