

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TARGET CORPORATION,
Petitioner

v.

DESTINATION MATERNITY CORPORATION,
Patent Owner

Case IPR2013-00532
Case IPR2013-00533
Patent RE43,531 E

Before JENNIFER S. BISK, MICHAEL J. FITZPATRICK, and
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

FITZPATRICK, *Administrative Patent Judge*.

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

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On March 13, 2014, an initial conference call was held among counsel for Petitioner, Target Corporation, counsel for Patent Owner, Destination Maternity Corporation, and Judges Bisk, Fitzpatrick, and Weatherly.

Both parties filed lists of proposed motions in each proceeding prior to the call. *See* IPR2013-00532 Papers 13, 14; IPR2013-00533 Papers 14, 15.

I. Motion to Amend

Patent Owner indicated that it may file a motion to amend. Patent Owner is reminded that, unlike a challenge of a patented claim, where the burden is on the petitioner to demonstrate unpatentability, in a motion to amend, the burden is on the patent owner to demonstrate patentability. During the call, we directed the parties to the discussion in *Idle Free Systems, Inc. v. Bergstrom, Inc.* for the requirements of a motion to amend claims. *See* Decision—Motion to Amend Claims, IPR2012-00027, Paper 26 (“*Idle Free*”). Patent Owner should review that discussion prior to filing a motion to amend.

Although a patent owner is authorized by statute to file one motion to amend during an *inter partes* review, *see* 35 U.S.C. § 316(d), it first must confer with the Board. *See* 37 C.F.R. § 42.121(a). Patent Owner has met its obligation to confer.

II. Motions to Seal and for Protective Order

Both parties list possible motions to seal and for a protective order. The Board does not enter a protective order automatically. The parties were advised that, if the need does arise for a protective order, the parties should first confer, prepare a joint stipulated protective order, and seek authorization to file a motion for entry of the proposed order, which motion should indicate clearly what, if

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anything, is different between the proposed order and the model protective order set forth in the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,771 (Aug. 14, 2012).

III. Motion to Exclude Evidence

Both parties indicated they may file a motion to exclude evidence. The deadline for doing so is DUE DATE 4, currently September 2, 2014. IPR2013-00532 Paper 11 (“Scheduling Order”), 5.¹

IV. Motion to Modify Schedule

Patent Owner indicated it may seek to file a “motion for observation on the dates set forth in the scheduling order,” but indicated that it did not have any problem with the due dates set forth in the scheduling order. We remind the parties that they may stipulate to different dates for DUE DATES 1–3 (earlier or later, but no later than DUE DATE 4). *See* Scheduling Order 2. A notice of the stipulation, specifically identifying the changed due dates, must be promptly filed. The parties may not stipulate to an extension of DUE DATES 4–7. *See id.*

V. Motions to Consolidate

Petitioner indicated that it may seek to file a motion to consolidate IPR2013-00532 with IPR2013-00533, because both cases involve the same patent and the same parties. Patent Owner presently objects to consolidation, at least in part, because Patent Owner would be limited to filing a single Patent Owner Response.

¹ IPR2013-00533 Paper 12.

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Also, Petitioner indicated that it would file imminently a petition for a third *inter partes* review of the same patent along with a motion for joinder under 37 C.F.R. § 42.122(b). Such a request for joinder will be considered only if trial is instituted. Further, we informed the parties that, due to scheduling constraints, it may be impractical to consolidate a third proceeding filed more than six months after the first two.

VI. Motions for Discovery

Although both parties list motions for discovery and/or additional discovery in their proposed motions lists, during the call, they indicated that no discovery dispute currently exists, and they are not contemplating such motions at this time.

VII. Motion for Observations on Cross-Examination

Patent Owner indicated that it may want to file observations on cross-examination of a Petitioner reply witness. We advised Patent Owner to seek authorization at the appropriate time (i.e., promptly after Petitioner's reply is filed) and if circumstances support the request (i.e., if Petitioner submits declaration testimony in its reply).

VIII. Requests for Oral Hearing

Both parties indicated they may file a paper requesting oral argument. The deadline for doing so is DUE DATE 4, currently September 2, 2014. Scheduling Order 5.

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IX. Motion to Submit Supplemental Information

Petitioner indicated it may seek to file a motion to submit supplemental information such as deposition transcripts and exhibits from a related lawsuit. The Board advised that, before seeking to do so, it should consider whether such documents, to the extent they are relevant, could be submitted as exhibits to a paper (e.g., Petitioner's reply, which is currently due by July 14, 2014).

Also, pursuant to a prior order,² two deposition transcripts from the related lawsuit have already been filed. However, they will be expunged as they are labeled Exhibits 1 and 2. Either party is authorized to re-file the exhibits, as properly labeled. Thus, Petitioner may file them using the applicable numbers from the 1000 series, and Patent owner may file them using the applicable numbers from the 2000 series. Alternatively, the parties may agree to file them using Exhibit 3001 and Exhibit 3002. Because no paper currently refers to those exhibits, however, the parties may also choose not to re-file those exhibits at this time.

Accordingly, it is

ORDERED that Exhibits 1 and 2 are expunged.

² IPR2013-00532 Paper 9; IPR2013-00533 Paper 10.

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