

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GREENE'S ENERGY GROUP, LLC,
Petitioner,

v.

OIL STATES ENERGY SERVICES, LLC,
Patent Owner.

Case IPR2014-00216 (Patent 6,179,053 B1)
Case IPR2014-00364 (Patent 6,289,993 B1)

Before SCOTT E. KAMHOLZ, WILLIAM A. CAPP, and
JAMES A. TARTAL, *Administrative Patent Judges*.

KAMHOLZ, *Administrative Patent Judge*.

INITIAL CONFERENCE SUMMARY
Conduct of the Proceeding
37 C.F.R. § 42.5

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IPR2014-00364 (Patent 6,289,993 B1)

The initial conference call for these cases was held on June 27, 2014. Patent Owner filed a list of proposed motions in each case; Petitioner filed a list of proposed motions only in IPR2014-00364. The following matters were discussed during the call.

Scheduling Order

Neither party expressed concerns about the schedule or proposed changes.

Related Cases

The parties indicated that the related litigation in the U.S. District Court for the Eastern District of Texas is in discovery and that no motion to stay is pending. We reminded the parties to advise the Board of any status changes in the litigation and to notify the Board of any new proceedings involving either patent.

Patent Owner indicated that it was considering filing an application to reissue at least one of the patents involved in these *inter partes* reviews. We reminded Patent Owner that, because the Board exercises jurisdiction over the patents, *see* 37 C.F.R. § 42.3(a), Patent Owner must contact the Board before filing any reissue application concerning the '053 or '993 patents.

Patent Owner's Proposed Motions

Patent Owner proposed filing a motion for additional discovery concerning deposition of Petitioner's petition witness(es) and certain other employees of Petitioner. Patent Owner indicated that at least some of this discovery may relate to issues concerning secondary considerations of

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obviousness. We reminded Patent Owner that deposition of petition witnesses on topics addressed in petition declarations constitute routine discovery, not additional discovery, and do not require further authorization. We also reminded Patent Owner that a motion for additional discovery relating to secondary considerations evidence based on Petitioner's products or services requires a showing of nexus to establish Patent Owner's entitlement to the relief requested. *See Microsoft Corp. v. Proxyconn, Inc.*, IPR2012-00026, Paper 32, 5; 37 C.F.R. § 42.20(c).

Patent Owner did not indicate any present intention to seek additional discovery. We do not authorize a motion at this time.

We encouraged the parties to reach agreement on this issue, as well as discovery in general. The parties may request a conference call with the Board only if they cannot reach agreement.

Patent Owner also indicated that it was considering filing a motion to amend in at least one of the cases. We reminded Patent Owner that, should it decide to file a motion to amend, it must confer with the Board before filing the motion. Guidance for motions to amend may be found on the Board's web site, www.uspto.gov/ptab. *See also Respironics v. ZOLL Medical Corp.*, IPR2013-00322, Paper 13 (exemplary summary of motion to amend conference). The conference should be requested at least one week before Due Date 1.

Petitioner's Proposed Motions

Petitioner proposed to file a motion to submit supplemental information to respond to certain arguments in Patent Owner's Preliminary

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Response and to show the publication date and authenticity of a reference. We declined to authorize this motion, because arguments from the Preliminary Response will be given no further consideration unless they are repeated in the Patent Owner Response, and because the parties first should attempt to resolve authentication-related evidentiary issues between themselves. Petitioner may respond to the repeated arguments as part of its Reply. We cautioned Petitioner to confine its Reply arguments and evidence to the proper scope of reply, i.e., that directly refute Patent Owner's Response arguments and evidence, do not raise new issues, and do not seek to improve Petitioner's case-in-chief. 37 C.F.R. § 42.23(b). A reply that exceeds the permissible scope will not be considered, and the Board will not distinguish proper portions from improper ones. *Corning Inc. v. DSM IP Assets B.V.*, IPR2013-00047, Paper 84, 14-18; *Ariosa Diagnostics v. Stanford*, IPR2013-00308, Paper 20, 2; *Amneal Pharm. v. Supernus Pharm.*, IPR2013-00368, Paper 62, 3.

Petitioner also reserved the right to seek authorization for other motions. We advised the Petitioner that this is unnecessary; Petitioner may seek authorization for motions as need arises.

Protective Order

We reminded the parties that a protective order does not exist in a case, until one is filed in the case and is approved by the Board. If a motion to seal is filed by either party, the proposed protective order should be presented as an exhibit to the motion. We encourage the parties to operate under the Board's default protective order, should that become necessary.

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See Default Protective Order, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, App. B (Aug. 14, 2012). If the parties choose to propose a protective order deviating from the default protective order, they must submit the proposed protective order jointly. We would appreciate the inclusion of a marked-up comparison of the proposed and default protective orders, so that we can readily understand the differences.

We emphasized that redactions to documents filed in this proceeding should be limited strictly to isolated passages consisting entirely of confidential information, and that the thrust of the underlying argument or evidence must be clearly discernible from the redacted versions. We also reminded the parties that information subject to a protective order will become public if identified in a final written decision in this proceeding, and that a motion to expunge the information will not necessarily prevail over the public interest in maintaining a complete and understandable file history. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,761.

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