

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BROSE NORTH AMERICA, INC.
and
BROSE FAHRZEUGTEILE GMBH & CO. KG, HALLSTADT,
Petitioner,

v.

UUSI, LLC,
Patent Owner.

Case IPR2014-00416
Patent 8,217,612

Case IPR2014-00417¹
Patent 7,579,802

Before GLENN J. PERRY, HYUN J. JUNG, and GEORGE R. HOSKINS,
Administrative Patent Judges.

PERRY, *Administrative Patent Judge.*

ORDER
Conduct of Proceeding
37 C.F.R. § 42.5

¹ Even though this ORDER pertains to two cases, the parties may not use a combined caption and must file documents separately in each case until such time as cases may become consolidated and such authorization is granted.

A combined initial conference call was held on September 4, 2014 and attended by the above-identified panel members and respective counsel for the parties. We received from Petitioner a list of proposed motions² in each of the cases. The following matters were discussed.

Court Reporter

Petitioner indicated that it had arranged for a court reporter to be present on the call. A court reporter is not necessary for the initial conference call. Nevertheless, given that a transcript is being made we ask that it be filed by Petitioner as an exhibit in both cases.

Scheduling Order

Petitioner and Patent Owner indicated they are generally comfortable with the dates set forth in the Scheduling Order.³ Patent Owner indicated that there does not appear to be a scheduling order of record in the '417 case. The Board appreciates Patent Owner calling this to our attention, will check the PRPS system, and make a correction if appropriate.

Counsel may agree, without consulting the Board, to alter any of Due Dates 1-5 of the Scheduling Order so long as they do not intrude on Due Dates 6 and 7. Counsel should request a conference with the Board if they are ever unable to reach an agreement as to the schedule.

² IPR2014-00416 Paper 13; IPR2014-00417 Paper 13.

³ IPR2014-00416 Paper 14; IPR2014-00417 Paper 15.

Protective Order (Rule 42.54)

The parties have indicated that there is no present need for a protective order. If one is needed as these cases proceed, an appropriate motion can be filed. A protective order is not automatically in place in AIA proceedings. The parties are advised that in the event a protective order is needed, they should first attempt to agree on the language of a protective order. There is a default protective order set forth in an appendix to our Trial Practice Guide. It is intended as a model which can be adopted as is, or altered as appropriate to the circumstances. After working out language for the protective order, counsel should initiate a conference call with the panel in order to obtain authorization for filing a motion to have the agreed-upon protective order made effective.

Supplemental Information

Petitioner seeks authorization to file a motion in the '417 case under 37 C.F.R. § 42.123(a) to submit supplemental information, viz.: (1) U.S. Patent No. 6,404,158; (2) U.S. Patent Pub. No. 2002/0121872; and (3) U.S. Patent Pub. No. 2002/0101210. Petitioner indicated during the conference call that the proposed supplemental information is not needed in the '416 case. We waived⁴ the thirty day requirement set forth in 37 C.F.R. § 42.123(a), (b) in order to more efficiently deal with this issue in this initial conference call, previously scheduled to take place beyond the thirty day period. Petitioner represents that the documents to be submitted are patent documents related to the '802 patent and that they will help the Board with the claim construction of the '802 patent. Patent owner does not oppose

⁴ IPR2014-00417 Paper 14.

IPR2014-00416 and IPR2014-00417
Patent 8,217,612 and Patent 7,579,802

authorization. Authorization to file the motion in the '417 case is granted.

Motion for Appearance Pro Hac Vice

Petitioner seeks authorization for a motion under 37 C.F.R. § 42.10(c) to permit the *pro hac vice* appearance of Luke Dauchot, P.C. of Kirkland & Ellis LLP in these IPR proceedings. Such *pro hac vice* motions were authorized in the Notices of Filing Date Accorded.⁵ No further authorization is needed.

Potential Joinder

The patents at issue in these cases are also involved in additional IPR cases brought by Petitioner Webasto Roof Systems.⁶ Petitioner Webasto Roof Systems was not invited to participate in this initial conference call. Petitioner notes that Webasto Roof Systems filed a motion in Case IPR2014-00648 to “partially join” IPR2014-00416 because of the overlap (but not identity) of issues, and similarly in IPR2014-00650 and IPR2014-00417. Although we plan to separately deal with the joinder issues in this family of cases, we invited comment from the parties concerning such potential combination.

Both Petitioner and Patent Owner note that although there may be efficiencies to be gained by joining cases, there are legal issues that will be raised by joinder, e.g. estoppels forced on Petitioner with regard to claims 11, 15 and 16 of the '802 patent, that are not present in these cases as they now stand. Patent Owner opposes joinder and suggests the possibility of combined hearing dates.

We note that one consequence of joinder is that multiple parties

⁵ IPR2014-00416 Paper 4; IPR2014-00417 Paper 5.

⁶ IPR2014-00648 and IPR2014-00650.

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constitute a single “Petitioner” that must speak with one voice through the same Counsel. Such is not the case for separately tried cases. The Board will take up the question of joinder with respect to cases IPR2014-00648 and IPR2014-00650.

Copending Litigation

The parties confirmed that the copending litigation between the parties, *UUSI, LLC v. Robert Bosch LLC and Brose North America, Inc.*, Civil Action No. 2:13-cv-10444 (E.D. Mich.), has been stayed pending our decision in these *inter partes* reviews.

Settlement

The parties indicated that settlement has not been discussed.

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