

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN HONDA MOTOR CO., INC.,
Petitioner,

v.

AMERICAN VEHICULAR SCIENCES LLC,
Patent Owner.

Case IPR2014-00634
Patent 6,738,697 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. § 42.5

On September 17, 2014, an initial conference call was held. The participants were respective counsel for the parties and Judges Lee, Parvis, and Anderson. Only Petitioner filed a list of proposed motions. Paper 11. During the conference call, counsel for the parties indicated that the parties do not have a need to change Due Date 6 or Due Date 7 as set in the Scheduling Order dated August 26, 2014 (Paper 9), but will stipulate to different Due Date 1–5 as is authorized in the Scheduling Order.

Petitioner’s list of proposed motions identifies a single item, i.e., authorization for filing a Motion for Additional Discovery of deposition transcripts and other testimony from “other IPR proceedings involving related patents owned by American Vehicular Sciences (‘AVS’).” The request is overbroad for several reasons. First, counsel for Petitioner explained, during the conference call, that “related patents” means all of Patent Owner’s patents now involved in an *inter partes* review proceeding; that position fails to consider the substantive content of each patent. Second, counsel for Petitioner acknowledged that he has no reason to think that such material would be favorable in substantive content to any of Petitioner’s contentions. Third, there are other sources for the requested material, such as the Petitioner in the other proceedings. In response to our noting that the request is overbroad, counsel for Petitioner withdrew the sole request identified in its list of proposed motions.

Petitioner’s list of proposed motions also states: “Honda reserves its right pursuant to 77 Fed. Reg. 48765 to seek authorization from the Board to file additional motions as appropriate.” Paper 11, 2. We explained to the parties that if a party has the right to take certain action, it need not make a reservation for that right, and that if a party does not have the right to take

certain action, none would be created by reservation. We noted that such reservations of right are not helpful and tend only to add cost and confusion to the proceeding by requiring specific attention of the opposing party and the Board to check if anything meaningful is embedded in the assertion. Counsel for Petitioner agreed to refrain from attempting to “reserve” rights.

We advised counsel for each party that a proper Motion to Exclude Evidence should not include arguments alleging that a reply exceeds the scope of a proper reply. If such an issue arises, the parties should initiate a telephone conference call to the Board.

It is

ORDERED that all due dates set in the Scheduling Order dated August 26, 2014 (Paper 9), remain unchanged as a result of the initial conference call on September 17, 2014;

FURTHER ORDERED that the page limit for a Motion for Observation Regarding Cross-Examination of Reply Witness is set to 7 pages; and

FURTHER ORDERED that the parties contact each other to initiate settlement discussion, within ten days of the date of this Order.

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Patent 6,738,697 B2

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