

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCEDES-BENZ USA, LLC and MERCEDES-BENZ U.S.
INTERNATIONAL, INC.,
Petitioner,

v.

VELOCITY PATENT LLC,
Patent Owner.

IPR2014-01247
Patent 5,954,781

Before JAMESON LEE, GLENN J. PERRY, and PETER P.
CHEN, *Administrative Patent Judges*.

CHEN, *Administrative Patent Judge*.

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

On December 12, 2014, a conference call was held among the respective counsel for the parties and Judges Lee, Perry, and Chen. The subject matter of the call concerned Petitioner's request for authorization to file a motion for consolidation of this proceeding with IPR 2015-00290, and with *ex parte* reexamination proceeding 90/013,252 ("the reexamination proceeding"), all of which involve U.S. Patent No. 5,954,781 ("the '781 patent").

The Petition herein was filed on August 4, 2014 (Paper 1), challenging only claims 31 and 32 of the '781 patent. In its Preliminary Response filed on November 4, 2014 (Paper 9), Patent Owner stated that in the reexamination proceeding, Patent Owner had "amended independent claim 31 and, by virtue of its dependency, claim 32." *Id.*

On November 21, 2014, Petitioner filed IPR 2015-00290, challenging claims 31 and 32 "as currently amended" in the reexamination proceeding, along with claims 61-80 and 82-84, which had been added in the reexamination proceeding by Patent Owner. *Mercedes-Benz USA, LLC and Mercedes-Benz International, LLC v. Velocity Patent LLC*, IPR 2015-00290 (Paper 2, 1).

Patent Owner stated during the conference call that no reexamination certificate has been issued as a result of the reexamination proceeding. Patent Owner further stated that on December 10, 2014, it filed in the reexamination proceeding a statutory disclaimer of original patent claims 31 and 32, which are the only claims challenged by the Petition in this proceeding. In addition, Patent Owner indicated that its proposed amended claims 31 and 32 of the '781 patent, and claims 61-84, which are all of the claims being challenged in IPR 2015-00290, have also been cancelled in the

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reexamination proceeding. We authorized Patent Owner to file promptly in this proceeding, a request or motion to cancel claims 31 and 32 of the '781 patent. Counsel for Patent Owner indicated that Patent Owner will file such a request in this proceeding.

We do not authorize Petitioner to file a motion seeking to consolidate this proceeding with IPR 2015-00290 and/or with the reexamination. Given the indication from counsel for Patent Owner that Patent Owner will file a motion or request to cancel patent claims 31 and 32, which are all of the challenged claims in this proceeding, we likely will be entering adverse judgment against Patent Owner shortly, without need of significant further action in this proceeding. Accordingly, consolidation of this proceeding with IPR 2015-00290 and/or the reexamination proceeding is neither necessary nor appropriate.

ORDER

It is

ORDERED that Patent Owner is authorized to file, by December 22, 2014, a request or motion in this proceeding, cancelling claims 31 and 32 of the '781 patent; and

FURTHER ORDERED that Patent Owner shall file, as an exhibit, a copy of the Statutory Disclaimer filed in the reexamination proceeding, by December 22, 2014.

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