

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SKYHAWKE TECHNOLOGIES, LLC,
Petitioner,

v.

L&H CONCEPTS, LLC,
Patent Owner.

Case IPR2014-01485
Patent 5,779,566

Before JAMES T. MOORE and PATRICK R. SCANLON, *Administrative Patent Judges*.

SCANLON, *Administrative Patent Judge*.

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

The Petition for *inter partes* review in the above proceeding indicates that this proceeding is related to two other proceedings presently before this panel, IPR2014-00437 and IPR214-00438. Paper 5.¹ All three proceedings involve the same patent, U.S. Patent No. 5,779,566 (“the ’566 patent”). Petitioner submitted, concurrently with the original Petition, a motion under 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b) for joinder of the present Petition with IPR2014-00438. Paper 3.

During the initial conference call for the related proceedings, held on September 18, 2014, Petitioner informed the Board that the present Petition had been filed, and the parties agreed—at least to some extent—to expedite this proceeding in an attempt to synchronize the final decisions in the three related proceedings. *See* IPR2014-00438, Paper 9.

On September 26, 2014, respective counsel for the parties and Judges Moore and Scanlon participated in a conference call, requested by Petitioner, to discuss disagreement between the parties regarding the motion for joinder and the synchronizing of schedules in the proceedings.² During the call, Petitioner stated that the present Petition was necessitated by Patent Owner asserting in the related district court case two claims of the ’566 patent, which were not previously asserted, after the case had been transferred from

¹ Paper 5 is a corrected Petition for *inter partes* review, filed September 25, 2014. The original Petition for *inter partes* review (Paper 1) has been accorded the filing date of September 11, 2014. *See* Paper 4.

² We note that at the outset of the call, David Hoffman, participating on behalf of Patent Owner, stated for the record that neither he nor David Morris, also participating on behalf of Patent Owner, had power of attorney from Patent Owner. Mr. Hoffman indicated that, as Lead Counsel in the two related proceedings, he anticipated that such power of attorney would be forthcoming.

the Eastern District of Texas to the Southern District of Mississippi. Petitioner also stated that the challenges to the claims in the present Petition are based on the same prior art and same grounds on which the challenges in IPR2014-00438 are based. Petitioner indicated that, while there seemed to have been a consensus between the parties and the Board to work together in an effort to “catch up” in the present proceeding during the initial conference call of September 18, 2014, Patent Owner has not agreed to file its Preliminary Response early.

Patent Owner stated its belief that it is premature, at this time, to discuss scheduling in the present proceeding and noted that Petitioner is acting as though the motion for joinder being granted is a foregone conclusion. Patent Owner does not agree with this conclusion. Patent Owner, however, indicated it would be willing to consider some scheduling adjustments pending a decision on the motion for joinder.

In summary, we see no reason that Patent Owner should be required to submit its Preliminary Response in this proceeding earlier than what is required by 37 C.F.R. § 42.107(b). For the sake of efficiency, however, if the motion for joinder is granted, we then direct the parties to discuss the scheduling issue and attempt to agree on reasonable adjustments to the schedule for synchronizing this proceeding with the two related proceedings. If the parties cannot come to an agreement during these discussions, they may contact the Board for further guidance.

Accordingly, it is

ORDERED that, if Patent Owner elects to file a Preliminary Response, such paper may be filed in accordance with 37 C.F.R. § 42.107(b); and

IPR2014-01485
Patent 5,779,566

FURTHER ORDERED that, if Petitioner's motion for joinder is granted in due course, the parties are then directed to confer on possible scheduling adjustments to synchronize this proceeding with its two related proceedings.

PETITIONER:

Thomas Fisher
cpdocketfisher@oblon.com

Scott McKeown
cpdocketmckeown@oblon.com

Christopher Ricciuti
cricciuti@oblon.com

Alexander Englehart
cpdocketenglehart@oblon.com

PATENT OWNER:

JASON J YOUNG
3001 W BIG BEAVER ROAD SUITE 624
TROY, MI 48084-3109

David M. Hoffman
Matthew K. Wernli
3200 RBC Plaza
60 South Sixth Street
Minneapolis, MN 55402