

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROBERT BOSCH LLC and DAIMLER AG,
Petitioner,

v.

ORBITAL AUSTRALIA PTY LTD,
Patent Owner.

Case IPR2015-01258 (Patent 5,655,365)
Case IPR2015-01259 (Patent 5,655,365)¹

Before KEN B. BARRETT, JEREMY M. PLENZLER, and
AMANDA F. WIEKER, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

AUTHORIZATION FOR PETITIONER TO FILE A MOTION
TO SUBMIT SUPPLEMENTAL INFORMATION
37 C.F.R. § 42.123

¹ The parties are not authorized to use a joint caption.

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On June 16, 2015, Robert Bosch LLC and Daimler AG (collectively “Petitioner”) filed in the above-captioned cases petitions requesting *inter partes* review of U.S. Patent No. 5,655,365. IPR2015-01258, Paper 3; IPR2015-01259, Paper 3. Patent Owner, Orbital Australia Pty Ltd, filed Preliminary Responses. IPR2015-01258, Paper 10; IPR2015-01259, Paper 8. In its Preliminary Responses, Patent Owner argued that Petitioner failed to establish Bernhardt² as prior art. *E.g.*, IPR2015-01258, Prelim. Resp. 29.

On October 20, 2015, and prior to the issuance of decisions on the petitions, Petitioner, through an email to the Board, “request[ed] permission, under 37 C.F.R. § 42.5(b), to submit additional documents relating to the publication of the Bernhardt paper in the 1970s.” IPR2016-00083, Ex. 1017.³ In that email, Petitioner represented “Patent Owner has had the opportunity to review the three documents.” *Id.*

The Board responded to the request on October 21, 2015, stating: “The Board, having considered Petitioner’s email of October 20, 2015, denies Petitioner’s request to submit additional documents at this time, and declines to schedule a telephone conference to discuss the matter.” *Id.*

On November 10, 2015, Petitioner filed a third petition requesting *inter partes* review of U.S. Patent No. 5,655,365. IPR2016-00083, Paper 3. According to Petitioner:

Out of an abundance of caution and in view of the approaching time bar under 35 U.S.C. § 315(b), Petitioner has filed the Third ’365 IPR consolidating the existing *Bernhardt*-related grounds

² Bernhardt is Exhibit 1002 in IPR2015-01258 and Exhibit 1007 in IPR2015-01259 (collectively the “Bernhardt Exhibits”).

³ The cited rule, 37 C.F.R. § 42.5, provides that the Board may determine the proper course of conduct in situations not specifically covered by the rules.

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with additional evidence showing the publication and public accessibility of *Bernhardt* well before the critical date.

IPR2016-00083, Paper 4 (Motion for Joinder) [5](#).

The Board instituted an *inter partes* review in the two earlier cases on December 30, 2015. IPR2015-01258, Paper 11; IPR2015-01259, Paper 9. Subsequently, Patent Owner filed authenticity and hearsay objections to the Bernhardt Exhibits. IPR2015-01258, Paper 14; IPR2015-01259, Paper 12. Our rules provide that “[t]he party relying on evidence to which an objection is timely served may respond to the objection by serving supplemental evidence within ten business days of service of the objection.” 37 C.F.R. § 42.64(b)(2). We understand Petitioner to have served on Patent Owner supplemental evidence directed to the Bernhardt objections. *See* IPR2015-01258, Paper 15 (Petitioner’s Updated Exhibit List identifying certain exhibits served but not filed); IPR2015-01259, Paper 13 (same).

Although not explicit in the Board’s response to Petitioner’s email requesting authorization to submit additional documents, the request was denied as premature because trial had not been instituted, yet. *See* IPR2016-00083, Ex. 1017 (“The Board . . . denies Petitioner’s request to submit additional documents as-at this time.”); *see also* 37 C.F.R. § 42.123(a) (“*Once a trial has been instituted*, a party may file a motion to submit supplemental information in accordance with [certain] requirements.”) (emphasis added). For purposes of these proceedings, we treat Petitioner’s email of October 20, 2015, as a timely request for authorization to file supplemental information. *See* 37 C.F.R. § 42.123.

It is:

ORDERED that the parties will meet and confer in good faith to discuss Patent Owner’s objections to the Bernhardt Exhibits in light of the

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supplemental evidence and to discuss any potential resolution of the issue of admissibility of the Bernhardt Exhibits;

FURTHER ORDERED that, should no agreement be reached regarding the issue, Petitioner is authorized to file a motion to submit supplemental information pursuant to 37 C.F.R. § 42.123;

FURTHER ORDERED that Petitioner's motion is due April 8, 2016, and is limited to five (5) pages;

FURTHER ORDERED that Patent Owner's opposition to the motion, if any, is due April 18, 2016, and is limited to five (5) pages;

FURTHER ORDERED that a reply by Petitioner is not authorized at this time;

FURTHER ORDERED that, should the parties reach an agreement regarding the admissibility of the Bernhardt Exhibits, they shall file on or before April 8, 2016, a paper so indicating; and

FURTHER ORDERED that each party shall file substantively identical respective papers in both IPR2015-01258 and IPR2015-01259.

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