

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOYOTA MOTOR CORPORATION,
Petitioner

v.

BLITZSAFE TEXAS, LLC,
Patent Owner

Case IPR2016-00421
Patent 7,489,786 B2

Before JAMESON LEE, THOMAS L. GIANNETTI, and HUNG H. BUI,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

Conduct of Proceedings
37 C.F.R. § 42.5

On July 29, 2016, an initial conference call was held. The participants were respective counsel for the parties and Judges Lee, Giannetti, and Bui. Only Patent Owner filed a list of proposed motions for discussion. Paper 15.

Oral Hearing Date

Oral hearing is currently scheduled for February 9, 2017. Paper 14. Counsel for Patent Owner informed us that the trial in related district court action is scheduled to begin a few days prior to February 9, 2017, and thus Patent Owner's lead counsel would not be available on February 9, 2017, for the scheduled hearing at the Board. Patent Owner, however, proposed no alternative date for oral hearing. Upon inquiry from the Board, counsel for Patent Owner stated that he could not commit to an alternative date, because he did not know how the trial schedule in district court might develop. Counsel for Petitioner informed us that there are multiple related actions in the district court and each defendant may be entitled to a separate trial.

Given that Patent Owner has proposed no alternative date, the request to reset oral hearing date is denied. Patent Owner may renew its request within 30 days of this communication. After that time, we will not consider a request to change in the oral hearing date due to a conflict with district court trial. Any proposed alternative date should be one Patent Owner can commit to and which is not too distant from February 9, 2017. Patent Owner also should consider having its backup counsel conduct the oral hearing at the Board if its lead counsel cannot be available at any time near February 9, 2017. Once reset, we are unlikely to move the oral hearing date again because of changes in the scheduling of trial in related district court action(s).

Other Scheduling Matters

The parties do not need our authorization to stipulate to different Due Dates 1–5 so long as none extends beyond Due Date 6. The stipulation, however, must be filed prior to the first Due Date changed.

Discovery

Patent Owner withdrew its request for discovery, an item mentioned in its proposed list of motions.

Motion to Amend Claims

Patent Owner indicated that it is contemplating the filing of a motion to amend claims, but that it is not ready to discuss which claims it intends to amend or what limitation it seeks to add to original patent claims. Under 37 C.F.R. § 42.121, prior to the filing of a motion to amend claims, Patent Owner must initiate a conference call with the Board to “confer.” Because Patent Owner is not ready to discuss its motion at this time, this initial conference call does not satisfy the requirements of such a “to confer” call. Patent Owner is herein directed to make arrangements to have the “to confer” call conducted no later than two weeks prior to filing of its motion to amend claims.

For the “to confer” call, Patent Owner should be prepared to discuss how its duty of candor under 37 C.F.R. § 42.11 would be satisfied. We direct attention of the parties to *MasterImage 3D, Inc.*, IPR2015-00040, slip op. at 3 (PTAB July 15, 2015) (Paper 42) (precedential), which states:

Thus, when considering its duty of candor and good faith under 37 C.F.R. § 42.11 in connection with a proposed amendment, Patent Owner should place initial emphasis on each added limitation. Information about the added limitation can still be material even if it does not include all of the rest of the claim limitations. *See VMWare, Inc. v. Clouding Corp.*, Case IPR2014-01292, slip op. at 2 (PTAB Apr. 7, 2015) (Paper 23) (“With respect to the duty of candor under 37 C.F.R. § 42.11, counsel for Patent Owner acknowledged a duty for Patent Owner to disclose not just the closest primary reference, but also closest secondary reference(s) the teachings of which sufficiently complement that of the closest primary reference to be material.”).

We also direct the Patent Owner to inform Petitioner, two business days prior to the “to confer” call, how it proposes to amend each claim sought to be amended, so that Petitioner may come to the “to confer” call with any prior art reference it desires to discuss, *limited* to two in number for each substantive limitation added to the claims.

Motions to Exclude

The parties are on notice that the Motion to Exclude shall not be used for any purpose other than exclusion of evidence on admissibility grounds under the Federal Rules of Evidence. Issues improperly raised in a Motion to Exclude will not be considered and may cause the entirety of the Motion to Exclude to be dismissed including the parts addressing issues that are not improper. If any issue not pertaining to admissibility under the Federal Rules of Evidence arises, such as a reply exceeding the proper scope of a reply, the parties should promptly request a conference call with the Board.

Supplemental Evidence

Supplemental evidence is not supplemental information. *See* 37 C.F.R. § 42.64(b)(2); 37 C.F.R. § 42.123. There should be only one round of objections to evidence and subsequent service of supplemental evidence. No objections shall be made to supplemental evidence to trigger another round of supplemental evidence.

Substitution of Lead and Backup Counsel

Patent Owner in its list of proposed motions raised the issue of possible substitution of lead and backup counsel. In that regard, the parties do not need the Board's prior authorization to re-designate a new lead counsel or to designate additional backup counsel. However, no counsel may withdraw from representation without prior authorization from the Board. 37 C.F.R. § 42.10(e).

ORDER

It is

ORDERED that Due Dates 6 and 7 as set in the Scheduling Order (Paper 14) remain unchanged.

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