

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BENTLEY MOTORS LIMITED AND BENTLEY MOTORS, INC.,
Petitioner,

v.

JAGUAR LAND ROVER LIMITED,
Patent Owner.

IPR2019-01539
Patent RE46,828 E

Before BARRY L. GROSSMAN, KEVIN W. CHERRY, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

GROSSMAN, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
Supplemental Briefing on Discretionary Denial
35 U.S.C. § 314(a) and 37 C.F.R. § 42.5(a)

I. INTRODUCTION

Bentley Motors Limited and Bentley Motors, Inc. (“Petitioner”) filed a petition (Paper 1, “Pet.”) to institute an *inter partes* review of claims 21, 24, 30, 32–34, 37, 39, 41–43, 45, and 46 (the “challenged claims”) of U.S. Patent No. RE46,828 E (Ex. 1001, “the ’828 patent”). 35 U.S.C. § 311. Jaguar Land Rover Limited (“Patent Owner”) timely filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). In its Preliminary Response, Patent Owner requested that the Board apply its discretion under 35 U.S.C. § 314(a) to deny institution of the requested proceeding due to the advanced state of a parallel district court litigation¹ in which the same issues have been presented. Prelim. Resp. 49–52 (citing *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019)).

The Board denied institution pursuant to 35 U.S.C. § 314(a). Paper 9 (March 10, 2020) (Decision Denying Institution or “DDI”). When the Decision Denying Institution was entered, a jury trial was scheduled for October 13, 2020. DDI, 14. The trial date was two months before a PTAB hearing would occur (if we were to institute), and five months before a PTAB Final Decision would issue (again, if we were to institute). *Id.* The factors weighing most in favor of discretionary denial were (1) substantial overlap in patent claims challenged in the Virginia District Court litigation; (2) overlap in the obviousness theories and references that Petitioner is pursuing here and in the Virginia District Court litigation; (3) the advanced

¹ *Jaguar Land Rover Limited v. Bentley Motors Limited and Bentley Motors, Inc.*, Civ. No. 2:18-cv-320 (E.D. Va.) (“the Virginia District Court litigation”).

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stage of the Virginia District Court litigation; and (4) the significant investment by the Court and parties into the Virginia District Court litigation. *Id.* at 15.

Petitioner filed a Request for Rehearing of the Denial Decision. Paper 10 (“Req. Reh’g” or “Request for Rehearing”). Concurrently therewith, Petitioner requested that the Board’s Precedential Opinion Panel (“POP”) reconsider the Denial Decision. Paper 11; Ex. 3002 (“POP Request”).

On June 16, the POP declined to review the issue raised in Petitioner’s POP Request. Paper 12. Thus, jurisdiction over this proceeding has returned to the Panel to consider Petitioner’s Request for Rehearing.

By an e-mail dated June 19, 2020 (*see* Ex. 3003), Petitioner contacted the Board to “call to the Board’s attention” a June 16, 2020 decision in *Sand Revolution II, LLC v. Continental Intermodal Group – Trucking LLC*, IPR2019-01393, Paper 24 (PTAB, June 16, 2020), wherein the parties were provided an opportunity to address the factors relevant to a discretionary denial discussed in *Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 11 (PTAB March 20, 2020 (designated Precedential May 5, 2020)). Petitioner’s e-mail also informed us that the status of the related Virginia District Court litigation] “has changed since the Board’s original decision,” stating only that “the October 13, 2020 trial date has now been rescheduled for February 23, 2021.” Ex. 3003. The trial date was changed based on a Joint Motion to Extend Deadlines filed by the parties seeking “to extend the currently pending deadlines set in the September 25, 2019 Scheduling Order (ECF No. 55, “Scheduling Order”), and other currently pending deadlines, by sixty (60) to ninety (90) days . . . in light of complications related to the

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coronavirus disease (COVID-19) outbreak.” Ex. 3004. On May 5, 2020, the Court stated the new trial date is February 23, 2021. Ex. 3005. Another change since our Decision Denying Institution is that the Court held a remote Markman hearing on May 21, 2020 via ZoomGov. Ex. 3007 (*ssee* docket entries 344, 358). Thus, this case is still very active. *See, e.g.*, Ex. 3007, which is an excerpt of the District Court docket for the last 90 days as of June 24, 2020.

Having reviewed Petitioner’s Request for Rehearing, we determine that supplemental briefing of the Request for Reconsideration is warranted on the application of *Apple v. Fintiv* to the facts of this case.

II. ORDER

The panel requests that the parties submit supplemental briefing, as set forth below, to present on the record facts in this case relevant to the factors discussed in *Apple v. Fintiv*. The supplemental briefing may be accompanied by documentary evidence in support of any facts asserted in the supplemental briefing, but may not be accompanied by declaratory evidence. The parties should address specifically the proximity of the Court’s February 23, 2021 trial date to the Board’s projected statutory deadline for a Final Decision *if* a trial were instituted.

Accordingly, it is:

ORDERED that Petitioner is authorized to file a supplemental brief in support of its Request for Reconsideration, no more than ten (10) pages and limited to addressing the issue of discretionary denial under 35 U.S.C. § 314(a), by July 10, 2020; and it is

FURTHER ORDERED that Patent Owner is authorized to file a supplemental response to Petitioner’s supplemental brief, no more than ten

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(10) pages and limited to the issue of discretionary denial under 35 U.S.C.
§ 314(a), by July 24, 2020.

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