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Paper 18
Entered: October 18, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

U.S. BANCORP
Petitioner,

v.

RETIREMENT CAPITAL ACCESS MANAGEMENT COMPANY
Patent Owner.

Case CBM2013-00014
Patent 6,625,582

Before GLENN J. PERRY, THOMAS L. GIANNETTI, and TRENTON A. WARD, *Administrative Patent Judges.*

WARD, *Administrative Patent Judge*.

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

An initial conference call was held on October 11, 2013 and attended by the above-identified panel members and respective counsel for the parties. The following matters were discussed.

Co-pending Litigation

The parties confirmed that the co-pending litigation between the parties, *Benefit Funding Systems LLC v. U.S. Bancorp,* Case No. 1:12-cv-803-LPS (D. Del.), is currently proceeding forward.

Scheduling Order

Petitioner's List of Proposed Motions (Paper 14) states that Petitioner may request authorization to file a motion for an expedited schedule. Petitioner indicated that it would prefer to expedite the schedule. Patent Owner's List of Proposed Motions (Paper 17) states that Patent Owner may request authorization for a motion to amend the scheduling order. Patent Owner stated that Patent Owner would prefer to extend the schedule. We requested counsel to confer regarding their respective issues with the schedule. We reminded counsel that they can agree to alter Due Dates 1-3 of the Scheduling Order (Paper 13) without authorization from the Board. We instructed counsel to request a conference with the Board if they are unable to reach an agreement as to the schedule.

Protective Order

Patent Owner filed a Motion to File Documents Under Seal ("Motion to Seal," Paper 11) along with its Preliminary Response, seeking to seal certain non-publicly available materials. Additionally, Patent Owner filed a proposed Protective Order (Ex. 2013) along with the Motion to Seal. During the conference,

Patent Owner indicated that it had not conferred with Petitioner concerning the motion since filing the supposedly confidential materials and Patent Owner's Preliminary Response relying on the supposedly confidential materials. The Board instructed Patent Owner to confer with Petitioner to discuss ways to avoid the use of materials that must be placed under seal. The motion is therefore dismissed without prejudice to refilling if the parties cannot reach an agreement.

Other Motions

Petitioner states in its List of Proposed Motions that it may seek authorization for a motion to submit supplemental information pursuant to 37 C.F.R. §42.223. During the conference, counsel for Petitioner indicated that it seeks to file supplemental information regarding a potentially precedential decision published after the filing of the Petition regarding patent eligibility under 35 U.S.C. §101. We informed Petitioner that no such submission is necessary as the Board is aware of the recent § 101 precedents and Petitioner will have the opportunity to address any relevant precedent in Petitioner's reply.

Patent Owner's List of Proposed Motions indicates that it may seek authorization for a motion under 37 C.F.R. §42.51(b)(2) for additional discovery. Patent Owner indicated that it may seek additional discovery regarding the relationship of the Petitioner to US Bancorp Licensing and certain patent prosecution activities by U.S. Bancorp Licensing. Because the parties had not discussed this issue prior to the call, we urged the parties to discuss the issue and attempt to reach agreement before involving the Board.

Patent Owner indicated that it may file a motion to amend. If Patent Owner seeks to file a motion to amend, it first must confer with the Board. *See* 37 C.F.R. § 42.121(a). Patent Owner is reminded that unlike a challenge to a patented claim,

where the burden is on the petitioner to demonstrate unpatentability, with a motion to amend, the burden is on the patent owner to demonstrate patentability. We direct the parties to the discussion in *Idle Free Systems, Inc. v. Bergstrom, Inc.* of the requirements for a motion to amend claims. *See* Decision—Motion to Amend Claims, IPR2012-00027, Paper 26.

ORDER

Accordingly, it is hereby

ORDERED that Patent Owner's Motion to Seal is dismissed; and

FURTHER ORDERED that no motions are authorized other than those already authorized by rule or in the Scheduling Order.

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