

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SDI TECHNOLOGIES, INC.,
Petitioner,

v.

BOSE CORPORATION,
Patent Owner.

IPR2014-00346
Patent 8,364,295 B2

Before KARL D. EASTHOM and DAVID C. McKONE, *Administrative
Patent Judges.*

EASTHOM, *Administrative Patent Judge.*

ORDER

Conduct of the Proceeding and Decision on Motion for Joinder
37 C.F.R. §§ 42.5, 42.122(b)

The Board held an initial conference call in the above proceeding on July 29, 2014, between respective counsel for Petitioner and Patent Owner, and Judges Easthom, Fitzpatrick, and McKone. The Board held the conference call to discuss any proposed changes to the Scheduling Order (Paper 14), any motions that the parties intend to file, and Petitioner's Motion for Joinder (Paper 2). The parties do not intend to file any motions at this time.

Protective Order

No protective order has been entered. The parties must file a protective order when filing a motion to seal. 37 C.F.R. § 42.54. If the parties have agreed to a proposed protective order, including the Standing Default Protective Order, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, App. B (Aug. 14, 2012) ("TPG"), they should file a signed copy of the proposed protective order with the motion to seal. If the parties propose a protective order departing from the Standing Default Protective Order, they must submit a joint, proposed protective order, accompanied by a red-lined version based on the default Standing Protective Order.

Initial Disclosures and Discovery

The parties have not stipulated to any initial disclosures. The parties are reminded of the discovery provisions of 37 C.F.R. §§ 42.51, 41.52, and the TPG at 48,761–762. The parties may not file a motion for discovery without prior authorization. If the parties are unable to resolve discovery

issues, the parties may request a conference with the Board. There are no discovery issues at this time.

The Board informed the parties that “[t]he moving party must show that such additional discovery is in the interests of justice.” 42 C.F.R. § 42.51(b)(2). The Board also directed attention to *Garmin Int’l, Inc. v. Cuozzo Speed Techs LLC*, IPR2012-00001, Paper 26 (Mar. 6, 2013), and the Board’s website, for relevant discovery decisions. Provisions for taking testimony are specified at 37 C.F.R. § 42.53 and the TPG at 48,772, App. D.

Motion to Amend

Patent Owner currently does not anticipate filing a motion to amend. Patent Owner has the burden of proof in demonstrating patentability of each proposed substitute claim. That task is different from presenting amendments and responding to an *ex parte* rejection of claims by an examiner. For example, Patent Owner should address written description support for any proposed substitute claim, the level of ordinary skill involved in the invention, claim features relied upon to show a patentable distinction of the claimed invention as a whole, and information on whether such features were known outside of the specific combination of the proposed claims.

The Board directs attention to *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027, Paper 26 (June 11, 2013); *Invensense, Inc. v. STMicroelectronics, Inc.*, IPR2013-00241, Paper 21 (January 9, 2014); and *Int’l Flavors & Fragrances Inc. v. The United States of America*, IPR2013-

00124, Paper 12 (May 20, 2014) (informative), which provide guidance on the proper content of a motion to amend claims. Patent Owner is advised, but is not required, to request another conference call should any questions arise in connection with such a motion.

Motion to Join

During the conference, Petitioner contingently withdrew its previous motion to join (Paper 2) the instant proceeding with IPR2013-00465. Petitioner stated that pursuing the motion is contingent upon maintaining the current trial schedule, and in particular, ending the trial in IPR2013-00465 according to its current schedule. Patent Owner opposed the motion for joinder during the conference and prior thereto in a written response. *See* Paper 9 (Opposition to Motion for Joinder).

During the conference, Petitioner and Patent Owner each recognized that IPR2013-00465 has advanced significantly, relative to the instant proceeding, with an oral hearing scheduled in IPR2013-00465 on September 4, 2014. A Patent Owner Response is not due in the instant case until September 16, 2014. By statute, absent prior termination, the Board must produce a final written decision in IPR2013-00465 on or before December 13, 2014. *See* 35 U.S.C. 316 (11).

Basically, the trial schedules in the two cases are out of synchronization by roughly six months. It would not be practical to join or consolidate the instant case with IPR2013-00465 without moving the date

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for the oral hearing, an outcome neither the parties, nor the Board, desires. Accordingly, joinder would not be appropriate under the circumstances.

Scheduling Order

Both parties confirmed that they do not seek changes to the current Scheduling Order. Without obtaining prior authorization from the Board, the parties may stipulate to different dates for DUE DATES 1–5, as provided in the Scheduling Order, by filing an appropriate notice with the Board.

ORDER

For the reasons given, it is hereby ORDERED that Petitioner's Motion to Join IPR2014-00346 to IPR2013-00465 is *denied*.

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