

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HENKEL CORPORATION, :
Petitioner, :
v. : Case IPR2014-00606
H.B. FULLER CO., : Patent 6,833,404B2
Patent Owner. :

Telephonic Conference Call

Before The Patent Trial And Appeal Board

Washington, D.C.

Wednesday, October 29, 2014

11:02 a.m.

Reported by: Donna Ann Peterson

1 A P P E A R A N C E S

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3 ADMINISTRATIVE PATENT JUDGE CHRISTOPHER L.
4 CRUMBLEY, Presiding

5 ADMINISTRATIVE PATENT JUDGE DONNA M. PRAISS

6 ADMINISTRATIVE PATENT JUDGE BRIAN P. MURPHY

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C O N T E N T S

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Hearing: Initial Conference Call

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1 P R O C E E D I N G S

2 JUDGE CRUMBLEY: Good morning everyone.

3 This is Judge Crumbley, and I have with me
4 on the line Judges Praiss and Murphy.

5 This is the initial conference call for
6 IPR2014-00606, Henkel Corporation versus H.B. Fuller
7 Company.

8 Can we, please, get a roll call of who's
9 on the line, starting with Petitioner's counsel?

10 MR. TRIDICO: Hello. This is Anthony
11 Tridico, from Finnegan.

12 MS. BOSCH: And Michele Bosch, from
13 Finnegan.

14 JUDGE CRUMBLEY: Good morning.

15 MR. TRIDICO: Good morning.

16 JUDGE CRUMBLEY: Who do we have for the
17 Patent Owner?

18 MR. LINDER: We've got Walter Linder, lead
19 counsel, and, also, Timothy Grimsrud, backup counsel.

20 JUDGE CRUMBLEY: All right.

21 And I understand we have a court reporter
22 with us, is that correct?

1 THE REPORTER: Yes, it is. I'm Donna
2 Peterson.

3 JUDGE CRUMBLEY: Okay. Good morning.
4 Which party provided the court reporter
5 this morning?

6 MR. TRIDICO: It was Henkel.

7 JUDGE CRUMBLEY: Okay. Just, we ask that
8 you provide the transcript to us once you receive it,
9 just file on PRPS, when you get a chance.

10 MR. TRIDICO: No problem. It should be
11 early next week.

12 JUDGE CRUMBLEY: Okay.

13 All right. Well, It's good to have
14 everyone here. The reason we have these conferences
15 early on is to lay the groundwork for the proceeding,
16 answer any questions that the parties might have
17 about how this works, in the hopes of sort of
18 avoiding any issues before they become problems.
19 That's why we have you file these motions list that I
20 have before me, not to bind you in any way. You
21 know, parties like to reserve rights to file things
22 in these motions. That's not really necessary, and

1 we're not looking to foreclose you from anything just
2 because you don't bring it up today, but we just want
3 to make sure we're all on the same page from a
4 procedural standpoint on how this proceeding is gonna
5 go.

6 So with that in mind, I guess the first
7 thing to start with is the scheduling order. We
8 issued an order, along with the institutional
9 decision, to set a number of dates, and I just want
10 to find out at this time whether either party has any
11 issue with those dates as set?

12 MR. LINDER: Your Honor, this is Walter
13 Linder, for the Patent Owner. We had a brief
14 conference call with the Petitioner's counsel earlier
15 this week and have tentatively stipulated to some
16 relatively modest extensions to the dates one through
17 three on the scheduling order. And if all right with
18 you, we would propose to file a joint motion or
19 stipulation to -- to clarify that.

20 JUDGE CRUMBLEY: Sure. And there's no
21 need for a motion. As it says in the scheduling
22 order, the parties are free to stipulate to different

1 dates for dates one through five, so long as they
2 don't fall after due date six.

3 MR. LINDER: I'm sorry, do we do that by
4 filing a paper with -- with the PTAB?

5 JUDGE CRUMBLEY: That's correct. What you
6 would do is you would execute a stipulation and then
7 you would just file a notice of that stipulation on
8 PRPS with us, so we know the schedule has been
9 changed. But that way, there's no need to involve
10 us, you know, by asking permission to modify the
11 schedule. As long as the final dates don't change,
12 the parties are free to, you know, come to a schedule
13 that works for everyone.

14 MR. LINDER: Okay. Thank you. We will
15 confer with Petitioner's counsel, then, and move on
16 that action.

17 JUDGE CRUMBLEY: All right. So let's take
18 up the motions list the parties have filed.
19 There's nothing on the Petitioner's list that I see
20 we'll need to discuss, so I'll just jump straight to
21 the Patent's Owner's list.

22 So there's a motion to amend claims on

1 there. Have you decided whether you'll be filing
2 that or not at this point in time?

3 MR. LINDER: We have not decided to a high
4 degree of certainty yet, but we think it's likely
5 that we would likely file a motion with some limited
6 number of substitute claims.

7 JUDGE CRUMBLEY: Okay. Do you have in
8 mind at this time, you know, what the substitute, the
9 proposed substitute claims will look like?

10 MR. LINDER: Yeah. We -- our current
11 anticipation is that they would be substitutes to the
12 independent claims, with some additional limitations
13 out of the specification.

14 JUDGE CRUMBLEY: Okay. Here's what I
15 typically advise parties to do. First, I would
16 recommend that you familiarize yourself with our
17 rules as they pertain to motions to amend, 42.121 in
18 particular. I would take a look at the prior
19 decisions of the board that have been designated,
20 either informative or representative. In particular,
21 I would look at the Idle Free decisions. That case
22 is IPR 2012-00027. There's an interim order that's

1 paper 26 and a final decision that's paper 66.

2 You may also want to look at Toyota versus
3 AVS, which is IPR2013-00423, paper 27. And
4 International Flavor versus the United States, which
5 is IPR2013-00124, paper 12. So take a look at those,
6 come to some sort of finalized idea of what your
7 proposed substitute claims will look like, and then
8 the rules require that you confer with the board
9 prior to filing. That's so we can sort of walk you
10 through the requirements of a motion to amend and
11 what you have in mind for proposed substitute claims,
12 so we can avoid any issues before they -- they become
13 a problem for you.

14 So what you'll do is just when you reach
15 that point, just e-mail the board and they'll set up
16 a conference call so we can -- we can all talk
17 through the issues.

18 Is that understood?

19 MR. LINDER: Very clearly, thank you.

20 Say, Your Honor, would there be any
21 advantage to the procedure and from the board's
22 perspective if we were to file such a motion prior to

1 the dates scheduled by the scheduling order? Does
2 that enhance the efficiency of the process, from the
3 board's perspective, at all?

4 JUDGE CRUMBLEY: I'm trying to think that
5 through. Usually it's parties asking for more time,
6 not less time.

7 MR. LINDER: I understand.

8 JUDGE CRUMBLEY: You know, I -- I think
9 you're obviously welcome to file earlier. Whether
10 that means that then, you know, you can talk with
11 Petitioner's counsel about whether, you know, that
12 moves up some of the other dates in the case, you
13 know, because, like I said, you're welcome to move
14 dates in the schedule around. But, you know, I doubt
15 that we'll end up moving the hearing up or, you know,
16 the final decision up.

17 So, you know, you're welcome to do it. I
18 just, off the top of my head, I'm not sure I see
19 any -- any efficiency for, you know, the board in
20 terms of -- of an early motion to amend.

21 MR. LINDER: Okay, thank you.

22 JUDGE CRUMBLEY: Okay. The other thing

1 I'll note on the Patent Owner's list is a potential
2 motion to exclude. And, again, I just typically like
3 to walk through, the parties through the way,
4 objections, and, you know, motions to exclude are
5 handled in these cases because they're a little bit
6 different than how you would do it in a district
7 court.

8 So the way exclusion of evidence works
9 here is that parties may object to evidence, either
10 during a deposition or within a certain period of
11 time after service of the evidence, which is Rule
12 42.64. It's important to know that you don't file
13 those objections with the board, what you do is you
14 serve them on the opposing party. And what that does
15 is that then gives the non-objecting party the time
16 to cure the objection through the service of
17 supplemental evidence, under 42.64(B)(2). And,
18 again, that supplemental evidence is served but not
19 filed with the board.

20 But then if the two of you can't work out
21 a resolution, after seeing that supplemental
22 evidence, then you may file a motion to exclude

1 evidence. There's a due date, I think it's due date
2 four in the scheduling order by which those may be
3 filed. Again, you can file them early. I think it
4 makes more sense to wait till the close of the
5 evidence, but -- but that's the only time at which
6 the board will be made aware of the objections or the
7 supplemental evidence that has been attempted to cure
8 those objections.

9 And I guess the only other thing to point
10 out is that motions to exclude evidence don't need
11 authorization from us under the rules, so that's just
12 something you can file as of the due dates set in the
13 scheduling order. Other motions do need
14 authorization from us, unless they've been
15 preauthorized, like pro hac vice motions, so just
16 keep that in mind.

17 Any question from the parties on how that
18 system works before the board?

19 MS. BOSCH: No, Your honor.

20 MR. LINDER: No, Your Honor. Not from
21 Patent Owner, Your Honor.

22 JUDGE CRUMBLEY: Okay. I think that

1 covers everything that the Patent Owner has raised.

2 Have I missed anything?

3 MR. LINDER: Nope, not from our
4 perspective.

5 JUDGE CRUMBLEY: Okay. I don't see
6 anything on either party's list about a protective
7 order.

8 Do the parties anticipate needing one?

9 MR. LINDER: We have discussed that and,
10 at this point, neither party thinks that there's
11 gonna be the need for a protective order.

12 JUDGE CRUMBLEY: Okay. I appreciate you
13 talking about that before, like I said, before it
14 becomes an issue. If you do decide to file one, a
15 motion for protective order at some point, I would
16 just direct your attention to the Trial Practice
17 Guide. Appendix B in there has a default protective
18 order, which, if you want to just use that order,
19 what you would do is file, you know, your motion to
20 seal, along with the proposed default protective
21 order and we'll get that entered.

22 If you want to depart from the default

1 order in any way, you need to file a joint motion for
2 protective order, setting forth any departures from
3 the default and justifying why, why you want to
4 depart from the language of the default order. So
5 that's all I have to say about protective orders and
6 the parties' lists.

7 Is there anything else we need to discuss
8 today? And I'll ask the Petitioner's counsel first.

9 MR. TRIDICO: I don't think so, Your
10 Honor, not from our end.

11 JUDGE CRUMBLEY: Okay. Anything from the
12 Patent Owner?

13 MR. LINDER: No, there is not.

14 JUDGE CRUMBLEY: All right. Well, I
15 appreciate everyone's time, and if there is anything
16 that arises that you need us to discuss, we're here
17 to help, so just contact the board and we can set up
18 a conference call. Until that point, we will stand
19 adjourned.

20 Thank you very much.

21 MS. BOSCH: Thank you.

22 MR. TRIDICO: Thank you.

1 MR. LINDER: Thank you.

2 JUDGE CRUMBLEY: Good-bye, everyone.

3 (Thereupon, the telephonic conference call
4 hearing was concluded at 11:13 a.m., October 29,
5 2014.)

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1 CERTIFICATE OF SERVICE

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3 I, DONNA ANN PETERSON, Notary Public in
4 and for the District of Columbia, the officer before
5 whom the proceedings were taken, do hereby certify
6 that the foregoing transcript is a true and accurate
7 record of these proceedings; that said proceedings
8 were taken in Stenotype note by me on the 29th day of
9 October, 2014, commencing at one o'clock p.m., and
10 ending at 1:10 p.m.

11 I further certify that present on behalf
12 of Petitioner, Henkel Corporation, were Anthony C.
13 Tridico, Attorney at Law, and Michele Bosch, Attorney
14 at Law, of Finnegan, Henderson, Farabow, Garrett &
15 Dunner, LLP, and on behalf of Patent Owner, H.B.
16 Fuller Co., were Walter C. Linder, Attorney at Law,
17 and Timothy E. Grimsrud, Attorney at Law, of Faegre,
18 Baker, Daniels, LLP.

19 I further certify that I am not related
20 to, nor associated with any of the parties or their
21 attorneys, nor do I have any disqualifying interest,
22 personal or financial, in the actions within.

1 Dated this 31st day of October, 2014, at
2 Washington, District of Columbia.

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6 _____
Donna Ann Peterson

7 Notary Public

8 My commission expires April 14, 2019

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