Trials@uspto.gov
571-272-7822

Paper No. 15
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HENKEL CORPORATION,
Petitioner,

v.

H.B. FULLER COMPANY,
Patent Owner.

IPR2014-00606
Patent 6,833,404 B2

Before DONNA M. PRAISS, CHRISTOPHER L. CRUMBLEY, and BRIAN P. MURPHY, *Administrative Patent Judges*

MURPHY, *Administrative Patent Judge*.

INITIAL CONFERENCE SUMMARY
Conduct of the Proceeding
37 C.F.R. § 42.5

An initial conference in IPR2014-00606, which involves U.S. Patent No. 6,833,404 B2 ("the '404 patent"), was conducted on October 29, 2014. Henkel Corporation (Petitioner) was represented by Anthony Tridico (Lead Counsel) and Michele Bosch (Back-up Counsel). H.B. Fuller Co. (Patent Owner) was represented by Walter Linder (Lead Counsel) and Timothy Grimsrud (Back-up Counsel). Judges Praiss, Crumbley, and Murphy participated in the conference. Counsel for Petitioner arranged for a certified court reporter, Donna Peterson, to transcribe the proceedings. Petitioner is responsible for promptly filing the transcript of the initial conference. The following subjects were discussed during the conference:

Scheduling Order

Counsel for Patent Owner indicated the parties had conferred about stipulating to changes in Due Dates 1-3 as set forth in the current Scheduling Order. The parties were reminded that they are free to stipulate to different dates for Due Dates 1-5, but not later than Due Date 6, as provided in the Scheduling Order. The parties were instructed to file an appropriate stipulation with the Board to provide notice of any due dates changed from those listed in the Scheduling Order.

Protective Order

The parties previously discussed whether a protective order is needed, and agreed that a protective order is not needed at this time. Therefore, no protective order has been entered in this proceeding. The parties were reminded of the requirements for filing a protective order, which includes filing a proposed protective order in conjunction with a motion to seal. 37 C.F.R. § 42.54. If the parties choose to propose a protective order other than or departing from the default Standing Protective Order, Office Trial Practice Guide, 77 Fed. Reg.

48756, App. B (Aug. 14, 2012), they must submit a joint motion and proposed protective order, accompanied by a red-lined version based on the default protective order in Appendix B, and explain their reasons for the requested changes to the default protective order. *See id.* at 48769-71.

We also remind the parties of the expectation that confidential information relied upon or identified in a final written decision will be made public. *Id.* at 48760. Confidential information that is subject to a protective order ordinarily becomes public 45 days after denial of a petition to institute or 45 days after final judgment in a trial. *Id.* A party seeking to maintain the confidentiality of the information may file a motion to expunge the information from the record prior to the information becoming public. 37 C.F.R. § 42.56.

Initial Disclosures and Discovery

The parties are reminded of the discovery provisions of 37 C.F.R. § 42.51-52 and Office Trial Practice Guide. *See,* 77 Fed. Reg. at 48761-2. Discovery requests and objections are not to be filed with the Board without prior authorization. If the parties are unable to resolve discovery issues between them, the parties may request a conference with the Board. As explained to the parties during the conference, a motion to exclude, which does not require Board authorization, must be filed to preserve any objection. *See,* 37 C.F.R. § 37.64, Office Trial Practice Guide, 77 Fed. Reg. at 48767. The parties did not identify any pending discovery issues during the conference.

The parties are reminded of the provisions for taking testimony found at 37 C.F.R. § 42.53 and the Office Trial Practice Manual at 77 Fed. Reg. at 48772, App. D.

Motions

Prior to the initial conference, the parties each filed a list of anticipated motions. Petitioner indicated that it did not propose to file any motions at the present time. Patent Owner indicated that it intends to file a motion to amend the claims of the '404 patent by proposing a limited number of substitute claims.

Although Patent Owner may file one motion to amend without Board authorization, we reminded Patent Owner of the requirement to request a conference with the Board before filing a motion to amend. 37 C.F.R. § 42.121(a). The conference should take place at least two weeks before Due Date 1. The Board takes this opportunity to remind the Patent Owner that a motion to amend must explain in detail how any proposed substitute claim obviates the grounds of unpatentability authorized in this proceeding, and clearly identify where the corresponding written description support in the original disclosure can be found for each claim added. If the motion to amend includes a proposed substitution of claims beyond a one-for-one substitution, the motion must explain why more than a one-for-one substitution of claims is necessary. For further guidance regarding these requirements, Patent Owner is directed to several decisions concerning motions to amend, including *Nichia Corporation v. Emcore Corporation,* Case IPR2012-00005, Paper No. 27 (PTAB June 3, 2013); *Idle Free Systems, Inc. v. Bergstrom, Inc.,* IPR2012-00027, Paper No. 26 (PTAB June 11, 2013), Paper No. 66 (PTAB January 7, 2014); *ZTE Corp. v. ContentGuard Holdings*, Case IPR2013-00136, Paper 33 (PTAB November 7, 2013); *Invensense, Inc. v. STMicroelectronics, Inc.,* Case IPR2013-00241, Paper No. 21, (PTAB January 9, 2014); *Toyota Motor Corp. v. American Vehicular Sciences LLC,* Case IPR2013-00423, Paper No. 27 (PTAB March 7, 2014); and *International Flavors & Fragrances Inc. v. United States,* Case IPR2013-00124, Paper No. 12 (PTAB May 20, 2014).

The parties were reminded that, except as otherwise provided in the Rules, Board authorization is required before filing a motion. 37 C.F.R. § 42.20(b). A party seeking to file a motion should request a conference to obtain authorization to file the motion. No motions are authorized in this proceeding at this time beyond those previously authorized by order or rule.

FOR PETITIONER:

Anthony C. Tridico, Lead Counsel
Michele Bosch, Back-up Counsel
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
anthony.tridico@finnegan.com
michele.bosch@finnegan.com

FOR PATENT OWNER:

Walter C. Linder, Lead Counsel
Timothy E. Grimsrud, Back-up Counsel
FAEGRE BAKER DANIELS LLP
walter.linder@FaegreBD.com
tim.grimsrud@FaegreBD.com