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Entered: 20 April 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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VOLKSWAGEN GROUP OF AMERICA, INC.,  
Petitioner,

v.

EMERACHEM HOLDINGS, LLC,  
Patent Owner.

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Case IPR2014-01554 (Patent 6,037,307)  
Case IPR2014-01555 (Patent 5,451,558)  
Case IPR2014-01556 (Patent 5,953,911)  
Case IPR2014-01557 (Patent 7,951,346 B2)  
Case IPR2014-01558 (Patent 5,599,758)

Before FRED E. McKELVEY, *Administrative Patent Judge*.

POST-CONFERENCE CALL AND REVISED SCHEDULING ORDER

I. Background

A conference call was held on 16 April 2015 at approximately  
10:00 a.m.

Counsel for both parties and Judges McKelvey and Moore  
participated in the conference call.

## II. Matters Discussed

### A.

Petitioner confirmed that it did not file a motions list and that as currently advised it does not plan to file any motion.

Should a need develop for filing a motion, Petitioner should arrange for a conference call to seek authorization to file the motion.

### B.

Patent Owner in an earlier notice to the Board indicated that it does not intend to file any motion to amend.

### C.

The parties advised the Board that settlement was being discussed.

At the present time, it would appear that settlement is not likely in the near future.

### D.

The parties advised that the patent infringement civil action in the Eastern District of Tennessee has been stayed pending outcome of the five IPRs before the Board.

Oral argument in these IPRs has been set for 23 November 2015 (9:30 a.m.) and a Final Written Decision can be expected no later than 15 March 2016.

### E.

Patent Owner advised that in IPR2014-01557 it will seek benefit (under 35 U.S.C. § 120) of its Provisional Application 61/110,482, filed 30 October 2008 (IPR2014-01557 Ex. 1003A).

Patent Owner is authorized to file a “Motion for Benefit” in IPR2014-01557. Twenty-five (25) pages are authorized for the motion and

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any Petitioner “Opposition to Benefit.” Ten (10) pages are authorized for any Patent Owner “Reply to Benefit.”

Times for filing any “Motion for Benefit,” “Opposition to Benefit,” and “Reply to Benefit” are set out in the attached Revised Schedule.

In order to be accorded benefit under 35 U.S.C. § 120, a party must establish that the subject matter claimed is described and enabled in a parent application as required by 35 U.S.C. § 112, first paragraph. *In re Lukach*, 442 F.2d 967 (CCPA 1971); *In re Ahlbrecht*, 435 F.2d 908 (CCPA 1971); *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) (“The question is not whether a claimed invention is an obvious variant of that which is disclosed in the specification. Rather, a prior application itself must describe an invention, and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought.”).

The most straightforward manner to present a benefit issue is via a claim chart.

In this case, the claim chart would be limited to claims 1, 5, 6, 9, 10, 12, 16, 39, 41, 45, 46 and 49.

F.

Discussed during the conference call was whether Patent Owner planned to antedate any non-statutory bars relied upon by Petitioner.

Patent Owner confirmed that in IPR2014-01558 it will seek to antedate at least Campbell, U.S. Patent 5,451,558 (issued 10 September 1995, filed 4 February 1994).

Patent Owner is authorized to file a “Motion to Antedate” in IPR2014-01558 and any other IPR where antedating would be appropriate.

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As of the conference call, Patent Owner was not certain of the basis upon which antedating is to be established, i.e., conception plus reasonable diligence, actual reduction to practice, or both.

Accordingly, a further conference call was set for **30 April 2015 at 10:00 a.m.**

The purpose of the conference call will be to set page limits for any motion, opposition, or reply and to determine whether Patent Owner intends to antedate other prior art in the five related IPRs.

Times for filing the motion, opposition, and reply are set out in the attached Revised Schedule.

G.

Patent Owner, as presently advised, intends to submit with its merits response evidence related to so-called “secondary considerations.”

The Board understands that the evidence will relate to commercial activities as opposed to showings of unexpected results.

Evidence of secondary considerations should form part of the Patent Owner’s merits response.

H.

Since Patent Owner will not file a motion to amend, there is no need for Due Date 3.

Accordingly, Due Date 1 was extended until 19 June 2015 (previously set as 8 June 2015) and Due Date 2 was extended until 18 September 2015 (previously set as 27 August 2015).

These new dates are reflected in the Revised Schedule.

I.

The parties indicated that both will probably request oral argument.

Oral argument in all five IPRs will be held on the same date.

On Due Date 6.1, the Board will hold a conference call to receive input from counsel to develop a suitable schedule for oral argument in connection with the five IPRs.

J.

Various other matters were called to the parties' attention with the view to simplifying procedure in these five related IPRs.

1.

As noted on page 2 of original Scheduling Order:

Unless agreed to by the parties, any redirect examination shall proceed, without a recess, immediately after conclusion of cross-examination; "coaching" of a witness is not permitted.

The parties advised the Board that cross-examination deposition may take some given witnesses have testified in more than one of the five related IPRs.

The parties may wish to consider five deposition transcripts, one for each IPR. Alternatively, the parties could provide six deposition transcripts, one that would apply to all IPRs and would be filed in all five IPRs and one for each IPR dealing with the specifics of the IPR. Cross-examination testimony in one IPR may, and probably would, not be relevant in another IPR. The Board leaves to the parties a determination on how cross-examination testimony is best presented.

If a deposition is concluded on a particular day, there would be no redirect the next day and as a result there would not be even an appearance of overnight “coaching.”

2.

A motion to exclude should be limited to admissibility under the rules (37 C.F.R. § 41.51(a)) or the Federal Rules of Evidence.

Assuming evidence is not excluded, argument related to the weight to be given evidence should be made in Patent Owner’s merits response and Petitioner’s merits reply.

Petitioner raised a question as to how arguments related to nexus involving commercial activities can be presented. According to Petitioner, admissibility of “nexus” may be questioned in district court in the form of a motion *in limine*. In an IPR, nexus should be addressed in the first instance by Patent Owner in its merits response followed by Petitioner’s views as set out in Petitioner’s merits reply.

Patent Owner may place a conference call to the Board if it feels that a sur-reply on any “nexus” issues is necessary.

3.

The parties were advised that when a large document (e.g., a file wrapper) is offered as evidence, the Board will consider only those portions of the large document called to its attention. Portions not called to the attention of the Board are deemed not to be in evidence.

4.

The Board requests that in the future in the case of an exhibit is filed in more than one of the five IPRs, that the exhibit bear the same exhibit number.

It is permissible to skip exhibit numbers in any given IPR, a matter which can be reflected in a party's exhibit list.

5.

As noted on page 4 of the original Scheduling Order, the style of a paper should not exceed one line. Examples include "Patent Owner's Merits Response," "Petitioner's Merits Reply," "Patent Owner's Motion for Benefit," "Petitioner's Opposition to Benefit," "Patent Owner's Reply to Benefit," "Patent Owner's Antedating Motion," "Petitioner's Opposition to Antedating," and "Patent Owner's Antedating Reply."

REVISED SCHEDULE

CONFERENCE CALL .....**30 Apr. 2015 10:00 a.m. (ET)**

DUE DATE 1 ..... **19 June 2015**

Patent Owner Response to Petition  
Motion for Benefit; Motion to Antedate

DUE DATE 2 ..... **18 Sept. 2015**

Petitioner Reply to Patent Owner Response  
Opposition to Benefit; Opposition to Antedating

DUE DATE 2.1 ..... **05 Oct. 2015**

Patent Owner Benefit Reply  
Patent Owner Antedating Reply

DUE DATE 4 ..... **19 Oct. 2015**

Observation of cross-examination of reply witness  
Motion to Exclude Evidence  
Request for Oral Argument

DUE DATE 5 ..... **02 Nov. 2015**

Response to Observation  
Opposition to Motion to Exclude

DUE DATE 6 ..... **09 Nov. 2015**

Reply to Opposition to Motion to Exclude

DUE DATE 6.1 ..... **10 Nov. 2015 10:00 a.m**

Conference call to discuss argument schedule

DUE DATE 7 ..... **23 Nov. 2015**

Oral argument, if requested **09:30 am (ET)**



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