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USPTO Patent Trial and Appeal Board
Case No. IPR2014-00563
Chrysler Group LLC v. Norman IP Holdings, LLC

Document 28



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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NISSAN NORTH AMERICA, INC.
Petitioner,

v.

NORMAN IP HOLDINGS, LLC,
Patent Owner.

Case IPR2014-00563
Patent 5,502,689

Before BRYAN F. MOORE, HYUN J. JUNG, and FRANCES L. IPPOLITO,
Administrative Patent Judges.

IPPOLITO, *Administrative Patent Judge.*

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

The initial conference call in the above proceeding was held on October 16, 2014 between Sean Hsu, counsel for Petitioner Nissan North America, Inc., and Minghui Yang, counsel for Patent Owner Norman IP Holdings, LLC; and Judges Moore, Jung, and Ippolito. The following subjects were discussed during the call.

A. Related Proceedings

The Board was advised that the litigation in the U.S. District Court for the Eastern District of Texas that exists between the parties involving the patent is currently stayed.

B. Petitioner's Request to Substitute Petitioner's Declarant, Mr. Joseph C. McAlexander, and Mr. McAlexander's Declaration (Ex. 1011)

Petitioner informed the Board that it has become aware of a conflict-of-interest concerning Mr. Joseph McAlexander's participation in this proceeding. The Petition relies on the testimony of Mr. McAlexander submitted in Exhibit 1011. On the call, Petitioner requested permission to replace Petitioner's declarant Mr. McAlexander with a substitute declarant. Petitioner further requested permission to replace Mr. McAlexander's declaration with a substitute declaration containing the same substantive testimony presented in Exhibit 1011 except for (1) changes regarding the identity of the substitute declarant (e.g. name and qualifications of the declarant); and (2) removal of testimony directed toward grounds of unpatentability that the Board did not adopt for institution of IPR2014-00563. Patent Owner does not oppose the substitution of the original declarant or declaration provided that no additional arguments are presented.

We grant Petitioner's request with the proviso that the substitute declaration may include changes reflecting the identity and qualifications of the substitute declarant, however, it may not include any other change such as additional

arguments or the deletion of testimony regarding any of the grounds of unpatentability provided in the original declaration (Ex. 1011).

C. Scheduling Order

The parties indicated that they are currently discussing modifications to DUE DATES 1–7. We remind the parties that they may stipulate to different dates for DUE DATES 1–5, as provided in the Scheduling Order (Paper 25), by filing an appropriate notice with the Board. However, the parties are requested to file the request for oral hearing, if desired, by original DUE DATE 4 as set forth in the Scheduling Order, that is, by April 27, 2015.

Additionally, the parties may not stipulate to modifications of DUE DATES 6 and 7. Any change to these dates must be granted by the Board. Further, because an *inter partes* review proceeding is conducted on a strict statutory timeline, we are not inclined generally to delay DUE DATES 6 and 7.

D. Motion to Stay Ex Parte Reexamination

Patent Owner also requested authorization to file a motion to stay *ex parte* reexamination control no. 90/012,784. Patent Owner asserted the *ex parte* reexamination involves the same patent at issue in IPR2014-00563. Patent Owner argued a stay of the reexamination would avoid duplicative work and different outcomes in the reexamination and *inter partes* review. Petitioner opposed Patent Owner's request and argued that any possibility of a discrepancy between proceedings is minimal given the similarity of the issues and art in both proceedings and the expiration of the patent. We are persuaded that there exists a potential for conflicting decisions and grant Patent Owner authorization to file a motion to stay the *ex parte* reexamination. We further authorize Petitioner to file an opposition. No reply is authorized.

E. Protective Order

The parties have not discussed a protective order at this time. No protective order has been entered. The parties are reminded of the requirement for 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, 77 Fed. Reg. 48756, Appendix B (Aug 14, 2012), they should file a signed copy of the proposed protective order with the motion to seal. If the parties propose a protective order other than or departing from the default Standing Protective Order, Office Patent Trial Practice Guide, *id.*, they must submit a joint, proposed protective order, accompanied by a red-lined version based on the default Standing Protective Order in Appendix B to the Board's Office Patent Trial Practice Guide. *See id.* at 48769.

F. Settlement

The parties advised the Board that there is no impending settlement.

In consideration of the foregoing, it is hereby:

ORDERED that Norman IP Holdings, LLC is authorized to file a motion to stay *ex parte* reexamination control no. 90/012,784 no later than Wednesday, October 22, 2014, consisting of no more than five (5) pages;

FURTHER ORDERED that Nissan North America, Inc. is authorized to file an opposition to Norman IP Holdings, LLC's motion to stay no later than Tuesday, October 28, 2014, consisting of no more than five (5) pages; and

FURTHER ORDERED that Norman IP Holdings, LLC is authorized to file a substitute declaration replacing Mr. McAlexander's declaration (Ex. 1011) in IPR2014-00563. The substitute declaration shall contain identical testimony presented in Exhibit 1011 with the exception of changes reflecting the identity and

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qualifications of the declarant substituted for Mr. McAlexander. No other changes are authorized.

PETITIONER:

Sean Hsu
HARTLINE DACUS BARGER DREYER LLP
shsu@hdbdlaw.com

PATENT OWNER:

Minghui Yang
Greg Donahue
DINOVO PRICE ELLWANGER & HARDY LLP
myang@dpelaw.com
gdonahue@dpelaw.com