

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAP AMERICA, INC.
Petitioner

v.

PI-NET INTERNATIONAL, INC.
Patent Owner

Case CBM2014-00018
Patent 8,037,158 B2

Before KARL D. EASTHOM, WILLIAM V. SAINDON, and
BRIAN J. McNAMARA, *Administrative Patent Judges*

McNAMARA, *Administrative Patent Judge.*

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

An initial conference in CBM2014-00018, which involves U.S. Patent 8,037,158 (the '158 Patent), was conducted on April 7, 2014. SAP America, Inc. ("Petitioner") was represented by Michael Lee and Lori Gordon. PI-NET International, Inc. ("Patent Owner") was represented by Tam Pham. The following subjects were discussed during the conference:

Scheduling Order

Both parties confirmed that they seek no changes to the current Scheduling Order. The parties are reminded that, without obtaining prior authorization from the Board, they may stipulate to different dates for DATES 1-3, as provided in the Scheduling Order, by filing an appropriate notice with the Board. The parties may not stipulate to any other changes to the Scheduling Order.

Protective Order

Patent Owner's List of Anticipated Motions, Paper 20, filed before the initial conference, states that Patent Owner seeks authorization to file a motion for protective order should the standing default protective order not govern the exchange and submission of confidential information. Entry of the standing protective order is not automatic and no protective order has been entered in this proceeding. The parties are reminded of the requirement for a protective order when filing a motion to seal. 37 C.F.R. § 42.54. Authorization to file a Motion for Protective Order is granted. If the parties have agreed to a protective order, including the default Standing Protective Order, Office Trial Practice Guide, 77 Fed. Reg. 48756, App. 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 departing from the default protective order, they must submit a joint, proposed protective order, accompanied by a red-lined version based on the

default protective order in Appendix B to the Board's Office Patent Trial Practice Guide. *See, id.* at 48769.

Initial Disclosures and Discovery

The parties have not stipulated to any initial disclosures at this time. 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. 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. There are no discovery issues pending at this time.

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

Motions

Prior to the initial conference, Patent Owner filed a list of potential motions, including a motion to stay certain related other proceedings. The parties indicated that, at this time, there are currently no motions to be addressed.

The parties are 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. The parties are not authorized to file any motions in this proceeding at this time.

Although Board authorization is not required for the Patent Owner to file one motion to amend the patent by cancelling or substituting claims, we remind

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 filing the motion to amend. 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*, IPR2012-00005, Paper 27 (June 3, 2013); *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027, Paper 26 (June 11, 2013), Paper 66 (January 7, 2014); *ZTE Corp. v. ContentGuard Holdings*, IPR2013-00136, Paper 33 (November 7, 2013); *Invensense, Inc. v. STMicroelectronics, Inc.*, IPR2013-00241, Paper 21, (January 9, 2014); and *Toyota Motor Corp. v. American Vehicular Sciences LLC*, IPR2013-00423, Paper 27 (March 7, 2014).

Settlement

The parties stated that there are no immediate prospects of settlement that will affect this proceeding.

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