

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BANK OF AMERICA, N.A. et al.
Petitioners,
v.

INTELLECTUAL VENTURES I & II LLC
Patent Owner¹

Case CBM2014-00028
Case CBM2014-00029
Case CBM2014-00030
Case CBM2014-00031
Case CBM2014-00033

Before THOMAS L. GIANNETTI, HYUN J. JUNG, and GREGG I.
ANDERSON, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

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

¹ This caption is not authorized for use by the parties.

Case CBM2014-00028
Case CBM2014-00029
Case CBM2014-00030
Case CBM2014-00031
Case CBM2014-00033

On June 23, 2014, an initial conference call was held in these cases. Present on the call were respective counsel for the parties and Administrative Patent Judges Thomas Giannetti, Hyun Jung, and Gregg Anderson. The following matters were discussed:

1. Schedule

No proposed changes were requested.

2. Protective Order

No protective order was entered. The parties will contact the Board to request entry of the default protective order if necessary.

3. Additional Discovery

No requests for additional discovery are expected.

4. Motions to Amend

Patent Owner requested authorization to file a motion cancelling the claims on which a covered business method patent review was instituted in proceeding CBM2014-00031. Petitioners do not oppose. The request was granted. Patent Owner will file its motion promptly.

Patent Owner plans to file a contingent motion to amend in CBM2014-00033 (and possibly other proceedings) and will request a conference with the Board before filing such motions.

6. Motions to Exclude

The parties are referred to 37 C.F.R. § 42.64 regarding procedures for objecting to evidence and motions to exclude. The Board will require the moving

Case CBM2014-00028
Case CBM2014-00029
Case CBM2014-00030
Case CBM2014-00031
Case CBM2014-00033

party to show that the procedures have been followed in considering any motion to exclude evidence.

7. Settlement

The parties had nothing to report.

8. Other Matters

Petitioners request that depositions of experts be limited to a half day per expert per patent. According to Petitioners, the issues do not warrant the full seven hours provided by our rules for expert depositions. Patent Owner opposes.

After due consideration by the panel, Petitioners' request is denied. While the issues are limited, the expert declarations are quite detailed. Nevertheless, the parties are expected to cooperate in conducting expert depositions in an efficient manner. Seven hours for expert depositions should be regarded as a time limit and not a requirement. Any perceived deposition abuses should be brought to the immediate attention of the panel.

Case CBM2014-00028
Case CBM2014-00029
Case CBM2014-00030
Case CBM2014-00031
Case CBM2014-00033

PETITIONERS:

Donald R. Steinberg
Monica Grewal
WILMER CUTLER PICKERING
don.steinberg@wilmerhale.com
monica.grewal@wilmerhale.com

PATENT OWNER:

Herbert D. Hart III
Jonathan R. Sick
Eligio C. Pimentel
MCANDREWS, HELD & MALLOY, LTD.
hhart@mcandrews-ip.com
jsick@mcandrews-ip.com
epimentel@mcandrews-ip.com

Henry A. Petri, Jr.
James P. Murphy
NOVAK DRUCE CONNOLLY BOVE + QUIGG LLP
henry.petri@novakdruce.com
james.murphy@novakdruce.co