

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THE UNITED STATES POSTAL SERVICE (USPS) AND
THE UNITED STATES OF AMERICA,
AS REPRESENTED BY THE POSTMASTER GENERAL,
Petitioner,

v.

RETURN MAIL, INC.,
Patent Owner.

CBM2014-00116
Patent 6,826,548 B2

Before KEVIN F. TURNER, BARBARA A. BENOIT, and
JO-ANNE M. KOKOSKI, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*

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

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An initial conference call in *inter partes* review CBM2014-00116 occurred on November 6, 2014. Respective counsel for Petitioner and Patent Owner and Judges Turner, Benoit, and Kokoski were in attendance. Petitioner also indicated that it had a court reporter on the conference call. The purpose of the call was to discuss proposed changes, if any, to the Scheduling Order (Paper 12) and any motions that the parties intend to file.

The parties indicated that no protective orders for this proceeding are contemplated, although there was a protective order in the underlying litigation, which has been stayed. The parties also indicated that no settlement discussions had occurred, other than during the litigation, and that neither had initial disclosures, or any additional discovery requests, at this time. The parties are reminded that prior authorization is required for all motions filed with the Board.

Patent Owner indicated that no decision on whether to seek to file a motion to amend had been made. The Board directs the attention of the parties to *Nichia Corporation v. Emcore Corporation*, IPR2012-00005, Paper Nos. 27 and 68; *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027, Paper Nos. 26 and 66; and *ZTE Corporation and ZTE (USA) Inc. v. Contentguard Holdings, Inc.*, IPR2013-00136, Paper No. 33, which discuss the requirements of a motion to amend claims. If the Patent Owner decides to file a motion to amend claims, it must initiate a conference call with the Board prior to such filing, to confer about the intended motion.

We noted the filing of Patent Owner's Notice of Objections to Petitioner's Evidence (Paper 14) and Petitioner's Request for Rehearing (Paper

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15) in the instant proceeding. Petitioner inquired about the propriety of the filing of Patent Owner's Notice, given that 37 C.F.R. 42.64(b)(1) requires that any objection to evidence during a preliminary proceeding must be served within ten business days of the institution of trial, but does not contemplate that such an objection may be filed, without authorization. Based on discussions during the conference call, Petitioner requested that Patent Owner's Notice of Objections to Petitioner's Evidence (Paper 14) be expunged and Patent Owner did not object. As such, we expunge the paper filed without authorization.

It is

ORDERED that Patent Owner's Notice of Objections to Petitioner's Evidence (Paper 14) be expunged; and

ORDERED that Petitioner will file a copy the transcript of the conference call by the court reporter with the Board when completed.

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