

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AUTEL U.S. INC.
and
AUTEL INTELLIGENT TECHNOLOGY CO. LTD.
Petitioner

v.

BOSCH AUTOMOTIVE SERVICE SOLUTIONS LLC
Patent Owner

Case IPR2014-00183
Patent 6,904,796 B2

Before JOSIAH C. COCKS, SHERIDAN K. SNEDDEN, and
SCOTT A. DANIELS, *Administrative Patent Judges*.

DANIELS, *Administrative Patent Judge*.

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

INITIAL CONFERENCE SUMMARY

The initial conference call for this proceeding was held on May 29, 2014. Autel filed a list of potential motions (Paper 20); Bosch did not.

1. Scheduling Order

Neither party identified any concerns with the Scheduling Order or proposed any changes to it. The parties are reminded that, without obtaining prior authorization from the Board, they may stipulate to different dates for DATES 1-5¹ by filing an appropriate notice with the Board.

2. Related Proceedings

The parties confirmed that the related District Court action is currently stayed pending settlement discussions, but that no settlement had been reached. We reminded the parties to notify the Board of status changes of that proceeding, and whenever any new related proceedings are commenced.

3. Protective Order

We reminded the parties that a protective order does not exist in a case until approved by the Board. Where a motion to seal is filed by either party, the proposed protective order should be presented as an exhibit to the motion, not appended to the motion paper. The parties are encouraged to operate under the Board's default protective order. *See* Default Protective Order, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, App. B (Aug. 14, 2012); 37 CFR § 42.55(a). If the parties choose to propose a protective order other than or departing from the default Standing Protective Order, Office Trial Practice Guide, 77 Fed. Reg. 48756, App. B (Aug. 14, 2012), they must submit a joint, proposed protective order, accompanied by a red-lined version based on the default protective order in Appendix B to

¹ The parties may not stipulate to changes for any other DUE DATE.

the Board's Office Patent Trial Practice Guide. *See id.* at 48769.

We explained that information subject to a protective order will become public if identified in a final written decision in this proceeding, and that a motion to expunge the information will not necessarily prevail over the public interest in maintaining a complete and understandable file history. *See Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,761.*

4. *Discovery*

We encouraged the parties to reach agreement on discovery. The parties may request a conference call with the Board only if they cannot reach agreement.

5. *Motion to Amend*

We explained that a Motion to Amend must be filed by DUE DATE 1 of the Scheduling Order (July 8, 2014). Bosch is reminded that, should it decide to file a motion to amend, it must confer with the Board before filing the motion, and the conference should take place at least two weeks before filing the motion to amend.

We take this opportunity to remind the Patent Owner that a motion to amend must, in addition to obviating the grounds of unpatentability authorized in this proceeding, demonstrate the patentability of any proposed substitute claims over the prior art in general, and clearly identify where the corresponding written description support in the original disclosure can be found for each substitute claim. 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*

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Corporation v. Emcore Corporation, IPR2012-00005, Paper No. 27 (June 3, 2013); *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027, Paper No. 26 (June 11, 2013), Paper No. 66 (January 7, 2014); *ZTE Corp. v. ContentGuard Holdings*, IPR2013-00136, Paper 33 (November 7, 2013); and *Invensense, Inc. v. STMicroelectronics, Inc.*, IPR2013-00241, Paper No. 21, (January 9, 2014).

6. *Motion to Exclude*

We explained to the parties that motions to exclude evidence are extraordinary remedies and not always granted. We encouraged the parties to consider issues of admissibility of evidence, in light of the Board's experience and diligence in applying appropriate weight to evidence, before filing any motion to exclude evidence.

7. *Settlement*

The parties stated that there is no immediate prospect of settlement that will affect the conduct of this proceeding.

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