

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MARKER VOLKL USA, INC.,
Petitioner

v.

KNEEBINDING, INC.,
Patent Owner

Case IPR2017-01265
Patent 8,955,867 B2

Before MICHAEL W. KIM, PATRICK R. SCANLON, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEYERS, *Administrative Patent Judge*.

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

On November 2, 2017, the initial telephone conference call for this proceeding was held between respective counsel for the parties and Judges Kim, Scanlon, and Meyers.

IPR2017-01265
Patent 8,955,867 B2

Scheduling Order

During the conference call, counsel for both parties indicated that they do not, at this time, need to request modifying any due dates set in the Scheduling Order dated October 18, 2017 (Paper 11). Counsel were informed that there is flexibility to modify all due dates, except the date for Oral Hearing (Paper 11, Due Date 7: June 27, 2018). Counsel also were informed that although Due Date 4 (Paper 11, Due Date 4: May 21, 2018) may be adjusted, both parties must still enter their request for Oral Hearing by May 21, 2018.

Proposed Motions

Neither party filed a list of proposed motions prior to the conference call.

Protective Order

Counsel were informed that no protective order has been entered in the case at this time.

Motion to Amend

Patent Owner indicated that they are still considering whether or not to file a motion to amend. Counsel was reminded that if and when Patent Owner desires to file a motion to amend claim(s), a conference call should be requested to confer with the Board at least two weeks prior to the filing of such a motion. *See* 37 C.F.R. § 42.121(a). The Board directs counsel to *Toyota Motor Co. v. American Vehicular Sciences LLC*, Case IPR2013-00421 (PTAB Feb. 11, 2014) (Paper 21) for guidance concerning motions to amend.

In the event Patent Owner does file a motion to amend, Petitioner indicated that they are concerned about having adequate opportunity to respond to the

IPR2017-01265
Patent 8,955,867 B2

motion, in light of the recent decision by the U.S. Court of Appeals for the Federal Circuit in *Aqua Products, Inc. v. Matal*, No. 2015-1177, 2017 WL 4399000 (Fed. Cir. Oct. 4, 2017) (en banc). We note, however, that the current rules provide Petitioner the opportunity, in its opposition, to raise any basis for denying the proposed motion to amend, including procedural bases, as well as address any grounds of unpatentability that it believes applies to the proposed amended claims. That said, should there be a need to adjust the schedule in light of changes necessitated by *Aqua Products*, the parties should feel free to contact the Board to schedule a call to discuss their concerns.

Motion to Exclude and Observations on Cross-Examination

Counsel are reminded that motions to exclude and observations on cross-examination should not be treated as sur-replies. Guidance for proper motions to exclude and observations on cross-examination can be found in sections II.K and II.L of the Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48767 (Aug. 14, 2002).

It is

ORDERED that if and when Patent Owner desires to file a motion to amend, a conference call should be requested to confer with the Board at least two weeks prior to the filing of such a motion. *See* 37 C.F.R. § 42.121(a).

IPR2017-01265
Patent 8,955,867 B2

For PETITIONER

Patrick D. McPherson
Carolyn A. Alenci
DUANE MORRIS LLP
pdmcperson@duanemorris.com
caalenci@duanemorris.com

For PATENT OWNER

Donald R. Steinberg
Arthur C. H. Shum
WILMER CUTLER PICKERING HALE AND DORR LLP
don.steinberg@wilmerhale.com
arthur.shum@wilmerhale.com