

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOYOTA MOTOR CORPORATION
Petitioner

v.

LEROY G. HAGENBUCH
Patent Owner

Case IPR2013-00483
Patent 8,014,917

Before JAMESON LEE, MICHAEL W. KIM, and
ADAM V. FLOYD, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

Order
Conduct of Proceedings
37 C.F.R. § 42.05

Introduction

On April 14, 2014, a conference call was held between respective counsel for the parties and Judges Lee, Kim, and Floyd. The subject matter of the call concerns expiration of the involved patent subsequent to the institution of trial. Both parties believe that Patent No. 8,014,917 is now expired.¹ Under 37 C.F.R. § 42.100(b), a claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears. At the time of institution of this trial, the involved patent was not expired. The patent, however, expired subsequent to institution of trial. At the time of rendering of a final written decision in this case, it appears that the “broadest reasonable construction” rule should not apply. *In re Rambus, Inc.*, 694 F.3d 42, 46 (Fed. Cir. 2012).

Discussion

We asked the parties to consider the situation and indicate whether they agree that the rule of “broadest reasonable construction” per 37 C.F.R. § 42.100(b) no longer applies to the involved patent in this proceeding. We noted that the same patent is involved in IPR2013-00638, with the same Petitioner, and that that trial was instituted on March 25, 2014, subsequent to expiration of the involved patent.

For the only term interpreted in the Decision on Institution in this case, “monitoring,” we propose to issue an order to indicate that the rule of broadest reasonable construction no longer applies in this proceeding, but that, nonetheless, the meaning of “monitoring” is unchanged as “watching, keeping track of, or checking,” substantively no different from the meaning accorded the same term in

¹ Counsel for Patent Owner agreed to confirm expiration of the patent and to provide an expiration date during the next conference call currently schedule for April 16, 2014.

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IPR2013-00638: “watching or keeping track of, or checking.” For consistency purposes, we propose to reword the construed meaning of “monitoring,” in this case, as: “watching or keeping track of, or checking.”

Order

It is ORDERED that a conference call will be held on April 16, 2014, at 2:00 PM, at which time the parties will inform the Board of their positions with regard to the above-discussed subject.

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