

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PCT INTERNATIONAL, INC.
Petitioner

v.

AMPHENOL CORPORATION
Patent Owner

Case IPR2013-00229
Patent 7,544,094 B1

Before BRIAN J. McNAMARA, JAMES B. ARPIN, and
MIRIAM L. QUINN, *Administrative Patent Judges*.

McNAMARA, *Administrative Patent Judge*.

SUMMARY OF CONFERENCE CONCERNING
NEWLY DISCOVERED PRIOR ART
Conduct of the Proceeding
37C.F.R. § 42.5

A teleconference was held on May 19, 2014, concerning newly discovered prior art to U.S. Patent No. 7,544,094 B1, which is the subject of this proceeding. Miles Finn represented Petitioner, and Charles Wolfe Jr. represented Patent Owner. Judges McNamara, Arpin, and Quinn participated in the conference.

During the conference, Patent Owner advised us it recently had become aware of additional prior art, through an action in a corresponding European patent application. Patent Owner further stated that it had disclosed this additional prior art to Petitioner. Noting that there is no procedure in an *inter partes* review for submitting an information disclosure statement, Patent Owner inquired if any further action was required to comply with its duty of candor and good faith under 37 C.F.R. § 42.11.

Briefing in this proceeding is complete, and an oral hearing is scheduled for June 17, 2014. Neither party sought authorization to file a motion under 37 C.F.R. § 42.123(c) requesting that the newly discovered prior art be considered as supplemental information. The newly-discovered prior art is not relevant to a claim for which the trial has been instituted. At this stage of the proceeding, neither party would have an opportunity to address the newly-discovered prior art. In view of these circumstances, there is no basis to conclude that consideration of the supplemental information in this proceeding would be practical or would be in the interests-of-justice. 37 C.F.R. § 42.123(c). Therefore, we advised the parties that we do not authorize submission of the newly-discovered prior art as supplemental information in this proceeding.

Our decision in this matter does not relieve the parties of any other obligations that they may have under the duty of candor to the Office concerning the newly-discovered prior art.

PETITIONER:

Cyrus A. Morton
Miles A. Finn
ROBINS, KAPLAN, MILLER & CIRESI L.L.P.
800 LaSalle Avenue
2800 LaSalle Plaza
Minneapolis, MN 55402-2015
camorton@rkmc.com
mafinn@rkmc.com

PATENT OWNER:

Charles R. Wolfe, Jr.
Tara Marcus
BLANK ROME LLP
600 New Hampshire Ave. N.W.
Washington DC 20037
wolfe@blankrome.com
marcus@blankrome.com