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571-272-7822

Paper 32 (IPR2014-00041)
Paper 31 (IPR2014-00043)
Paper 31 (IPR2014-00051)
Paper 28 (IPR2014-00054)
Paper 24 (IPR2014-00055)
Entered: May 23, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GEA PROCESS ENGINEERING, INC.
Petitioner

v.

STEUBEN FOODS, INC.
Patent Owner

Cases[1]
IPR2014-00041 (Patent 6,945,013 B2)
IPR2014-00043 (Patent 6,475,435 B1)
IPR2014-00051 (Patent 6,209,591 B1)
IPR2014-00054 (Patent 6,481,468 B1)
IPR2014-00055 (Patent 6,536,188 B1)

Before RAMA G. ELLURU, BEVERLY M. BUNTING, and CARL M. DEFRANCO, *Administrative Patent Judges.*

ELLURU, *Administrative Patent Judge.*

ORDER

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[1] This order addresses issues raised in all five cases. We exercise our discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style heading in subsequent papers.

A conference call in IPR2014-00041, IPR2014-00043, IPR2014-00051, IPR2014-00054 and IPR2014-00055 was held on May 21, 2014, among respective counsel for Petitioner, GEA Process Engineering, Inc. ("GEA"), and Patent Owner, Steuben Foods, Inc. ("Steuben Foods"), and Judges Elluru, DeFranco, and Bunting. The purpose of the call was to discuss: (1) a discovery dispute between the parties; (2) Steuben Foods' motions to amend; and (3) GEA's motions to seal and entry of a protective order. A court reporter was present on the call, and Petitioner indicated that it would file a copy of the hearing transcript as an exhibit.[2]

Discovery Dispute

In our decision denying Steuben Foods' rehearing request asking us to reconsider our decision denying additional discovery relating to the identification of real parties-in-interest ("RPI") in the petitions, we ordered the parties to try to reach agreement about appropriate and narrowly focused additional discovery. Paper 29, 4.[3] The parties represented that GEA continues to assert that Steuben Foods has waived the right to seek additional discovery relating to the identification of real parties-in-interest, and Steuben Food disagrees. Steuben Foods also asserted that it did not

[2] This order summarizes the statements made during the conference call. A more detailed record may be found in the transcript.

[3] While the analysis herein applies to each of these trials, we refer to the papers and exhibits filed in IPR2014-00041 for convenience.

raise the section 312(a) issue before we instituted trials because it was not in possession of evidence of which it is currently aware.

GEA maintains that Steuben Foods waived its right to raise any challenges pursuant to 35 U.S.C. § 312(a) ("Requirements of Petition") by failing to raise the issue in a preliminary patent owner response, or before we instituted *inter partes* reviews in these cases. GEA argued that the issue of whether all RPIs have been properly identified in a petition is a "petition completeness" issue that must be raised before institution, and is not a "standing" issue that may be raised at any time during the trial. GEA, thus, argued that because Steuben Foods allegedly waived its right to raise a section 312(a) issue, the additional discovery sought by Steuben Foods is not relevant, and therefore, cannot be in the "interest of justice." *See Garmin Int'l, Inc. v. Cuozzo Speed Techs*, IPR2012-00001, Paper 20 at 2-3 (identifying factors to be considered in determining whether additional discovery is warranted).

We declined to decide whether a section 312(a) issue is a "petition completeness" or "standing" issue because the discovery sought by Steuben Foods may be relevant under either circumstance. We noted that GEA's objections to providing the discovery sought by Steuben Foods speak to the use of the discovery. We noted that even if a failure to properly identify a RPI in the petition is not a standing issue, the discovery sought by Steuben Foods may still be relevant to, for example, possibly sanctioning GEA for failing to properly identify the RPI in its petitions. We asked Steuben Foods whether it would be interested in renewing its request for authorization to

file another motion for additional discovery and Steuben Foods responded in the affirmative. We informed Steuben Foods that any discovery requests proposed by GEA should be narrowly focused given the issues we have discussed. We further indicated that GEA's proposed requests do not have to be limited to discovery relating to GEA's sister company Procomac, but also may include discovery relating to GEA's parent company. We note, however, that in our rehearing decision we determined that "some level of additional discovery might be justified if Patent Owner presented an adequate foundation for discovery that was sufficiently narrowly tailored to GEA's statement in the District Court proceeding and to Procomac's "control and/or funding." Paper 29, 3-4. Thus, while we give Steuben Foods some leeway in drafting its proposed discovery requests, the evidence that persuaded us that additional discovery may be warranted is GEA's statement in the District Court litigation that the instant review proceedings would simplify the District Court litigation by statutorily limiting GEA's (collectively, GEA and Procomac) invalidity defenses. *Id*. at 2.

We stated that prior to deciding whether to authorize the filing by Steuben Foods of a motion for additional discovery, we would like to see the discovery requests. Steuben Foods agreed to provide the proposed discovery requests to us by this Friday, May 23, 2014. Steuben Foods should file the proposed discovery requests in a paper captioned "Proposed Discovery Requests for Additional Discovery." *See* IPR2013-00586, *Unified Patents, Inc. v. Clouding IP, LLC* (Papers 12, 15). We note that a successful motion

for additional discovery will need to show how all the Garmin factors are satisfied. *See Garmin Int'l*, IPR2012-00001, Paper 20 at 2-3.

Protective Order and Motions to Seal

The parties requested that we enter the default Protective Order in the record of all five cases noted above. *See* Office Patent Trial Practice Guide, Appendix B, 77 Fed. Reg. 48769-71 (Aug. 14, 2012). We authorized entry of the Board's default Protective Order in all five cases identified in the caption of this Order. *See, e.g.*, IPR2014-00041, Ex. 1043. GEA sought authorization to file a Motion to Seal portions of the deposition transcript of Mr. Spinak in IPR2014-00041 and IPR 00051, IPR2014-00054, and IPR2014-00055, which we granted. We further authorized Steuben Foods to file the transcript of the teleconference with a Motion to Seal portions of the transcript.

Motion to Amend

Steuben Foods sought guidance on filing motions to amend in IPR2014-00041 and IPR2014-00054. We stated that Steuben Foods' requirement that it confer with the panel before filing such motions to amend had been satisfied by the instant teleconference. *See* 37 C.F.R. § 42.121(a). We further stated that Steuben Foods should make assertions as to any prior art and discuss any patentability issues of which it is aware in its motions to amend.

We further direct Steuben Foods to the discussion in *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027, Paper 26, which sets forth

in detail the requirements of a motion to amend.[4] In particular, in the absence of special circumstances, a challenged claim can be replaced by only one claim. 37 C.F.R. § 42.121(a)(3). Furthermore, a motion to amend should, for each proposed substitute claim, specifically identify the challenged claim it is intended to replace. Given the burden on a patent owner to demonstrate patentability of any substitute claim, the Board encourages Steuben Foods, if feasible, to begin its analysis by proposing amendments to the independent claims. *See Idle Free* at 9-10 (discussing amending dependent claims).

[4] Further guidance on motions to amend may be found in *Unified Patents, Inc. v. Clouding IP*, LLC, IPR2013-00586 (Paper 16); *International Flavors & Fragrances Inc. v. The United States of America, as Represented by the Secretary of Agriculture*, IPR2013-000124 (Papers 10, 12) (granting in part Patent Owner's Motion to Amend).

In consideration of the foregoing, it is hereby:

ORDERED that the Board's default Protective Order (IPR2014-00041, Ex. 1043) is entered in all five cases identified in the caption of this Order;

FURTHER ORDERED that Steuben Foods shall file the transcript of the May 21, 2014, teleconference as an exhibit in all five cases identified in the caption of this Order and move to file certain portions of the transcript under seal;

FURTHER ORDERED that GEA is authorized to file a Motion to Seal portions of the deposition transcript of Mr. Spinak in IPR2014-00041 and IPR 00051, IPR2014-00054, and IPR2014-00055;

FURTHER ORDERED that by Friday, May 23, 2014, Steuben Foods shall file a set of "proposed" discovery requests in all five cases identified in the caption of this Order, and label the submission as "Steuben Foods' First Proposed Discovery Requests"; and

FURTHER ORDERED that Steuben Foods has satisfied the requirement pursuant to 37 C.F.R. § 42.121(a) to confer with the panel prior to filing motions to amend in IPR2014-00041 and IPR2014-00054.

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