

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

K/S HIMPP,
Petitioner,

v.

BRAGI GmbH,
Patent Owner.

IPR2023-01204
Patent 10,117,014 B2

IPR2023-01205
Patent 10,397,688 B2

Before LARRY J. HUME, STACEY G. WHITE, and GARTHD. BAER,
Administrative Patent Judges.

HUME, *Administrative Patent Judge.*

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

I. INTRODUCTION

On June 11, 2024, Patent Owner (BRAGI GmbH) filed Motions to Amend (IPR2023-01204, Paper 13; IPR2023-01205, Paper 13), that included respective Requests for Preliminary Guidance. Subsequently, Patent Owner filed corrected motions (Paper 14 in each of the two cases) to correct the Certificates of Service.

Patent Owner filed these motions without providing advanced notice to the Board.

II. DISCUSSION

“A patent owner may file one motion to amend a patent, but only after conferring with the Board.” 37 C.F.R. § 42.121(a). The Scheduling Order (Paper 9) directs, “Patent Owner may file a motion to amend without prior authorization from the Board. Nevertheless, Patent Owner must confer with the Board before filing such a motion. . . . To satisfy this requirement, Patent Owner should request a conference call with the Board no later than two weeks prior to DUE DATE 1.” Paper 9 at 4 (citation omitted).

Notwithstanding Patent Owner’s oversight, we have discretion to waive certain rules in the interests of advancing judicial efficiency in the conduct of the proceeding. “The Board may determine a proper course of conduct in a proceeding for any situation not specifically covered by this part and may enter non-final orders to administer the proceeding.” 37 C.F.R. § 42.5(a). “The Board may waive or suspend a requirement of parts 1, 41, and 42 [of 37 C.F.R.] and may place conditions on the waiver or suspension.” 37 C.F.R. § 42.5(b).

Thus, we have the authority to waive Patent Owner’s violation of Rule 42.121.

We further note that Patent Owner has not yet filed an updated Mandatory Disclosure, as ordered in the “Order Dismissing Patent Owner’s Motions to Withdraw Backup Counsel Kaylee Hoffner.” Paper 12 at 3.

We urge the parties to ensure their familiarity with and adherence to our rules of practice. *See generally* 37 C.F.R. § 42; *and see* 84 FR 9497, 9497–9507 (“Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board”).

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, Rule 42.121(a) is waived with respect to Patent Owner’s requirement to confer with the Board prior to filing their Motion to Amend;

FURTHER ORDERED that, scheduling of a conference between the parties and the Board concerning this matter is optional upon either of the party’s request at this stage of the proceeding; and

FURTHER ORDERED that, Patent Owner shall file updated Mandatory Notices for these two cases.

IPR2023-01204, Patent 10,117,014 B2

IPR2023-01205, Patent 10,397,688 B2

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