

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

METAVANTE CORPORATION and
FIDELITY NATIONAL INFORMATION SERVICES, INC.
Petitioner

v.

CHECKFREE COPRPORATION.
Patent Owner

Case CBM2013-00031
Patent 7,996,311

Before BRIAN J. McNAMARA, BARRY L. GROSSMAN, and
LYNNE E. PETTIGREW, *Administrative Patent Judges*.

McNAMARA, *Administrative Patent Judge*.

INITIAL CONFERENCE SUMMARY
Conduct of the Proceeding
37C.F.R. § 42.5

An initial conference in CBM2013-00031, which involves U.S. Patent 7,996,311 (the '311 Patent) was conducted on January 16, 2014. Metavante Corporation and Fidelity National Information Services, Inc. (collectively, Petitioner) was represented by lead counsel, Jeffrey Berkowitz. CheckFree Corporation (Patent Owner) was represented by lead counsel, Jeffrey Kushan. Judges McNamara, Grossman, and Pettigrew participated in the conference. The following subjects were discussed during the conference:

Related Matters

There are no reexaminations of the '311 patent underway. The district court litigation, *CheckFree Corporation et al. v. Metavante Corp. et al.*, No. 3:12-cv-00015 (M.D. Fla.), remains pending. A motion to stay has been filed, but has not been decided by the district court.

Scheduling Order

The parties confirmed that they are seeking no changes to the current Scheduling Order. The parties are reminded that they may stipulate to different dates for DATES 1-3, as provided in the Scheduling Order, by filing an appropriate Notice with the Board. The parties may not stipulate to any other changes to the Scheduling Order.

Protective Order

The parties have not discussed a protective order at this time. No protective order has been entered in this proceeding. The parties are reminded of the requirement for a protective order when filing a Motion To Seal. 37 C.F.R. § 42.54. If the parties choose to propose a protective order other than or departing from the default Standing Protective Order, Office Trial Practice Guide, 77 Fed. Reg. 48,756, App. B (Aug. 14, 2012), they must submit a joint, proposed protective order, accompanied by a red-lined version based on the default

protective order in Appendix B to the Board's Office Patent Trial Practice Guide.

See id. at 48,769.

Initial Disclosures

The parties have not stipulated to any initial disclosures at this time. Each party may depose experts and affiants supporting the opposing party. There are no other discovery issues pending at this time.

Motions

Prior to the initial conference, Patent Owner filed a list of anticipated motions, stating that Patent Owner may move to amend one or more of the claims involved in this proceeding. The parties indicated that there are currently no motions to be addressed.

The parties are reminded that, except as otherwise provided in the Rules, Board authorization is required before filing a motion. 37 C.F.R. § 42.20(b). A party seeking to file a motion should request a conference to obtain authorization to file the motion. No motions are authorized in this proceeding at this time.

Authorization to file one motion to amend is not required, although a conference with the Board before filing a motion to amend is required. 37 C.F.R. § 42.121(a). Patent Owner's request that the initial conference also serve as the conference required before filing a motion to amend was not opposed by Petitioner and is granted. It is not necessary for Patent Owner to arrange another conference with the Board prior to filing a motion to amend. The Board takes this opportunity to remind the Patent Owner that a motion to amend must explain in detail how any proposed substitute claim obviates the grounds of unpatentability authorized in this proceeding, and must clearly identify where the corresponding written description support in the original disclosure can be found for each amendment. If the motion to amend includes a proposed substitution of claims beyond a one-for-one substitution, the motion must explain why more than a one-for-one substitution of

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claims is necessary. For further guidance regarding these requirements, Patent Owner is directed to several decisions concerning motions to amend, including *Nichia Corporation v. Emcore Corporation*, IPR2012-00005, Paper No. 27 (June 3, 2013) and *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027, Paper No. 26 (June 11, 2013), Paper No. 66 (January 7, 2014). *See also, Invensense, Inc. v. STMicroelectronics, Inc.*, IPR2013-00241, Paper No. 21 (January 9, 2014).

Settlement

The parties stated that some settlement discussions have occurred, but at this time it is not anticipated that such discussions will have an immediate effect on this proceeding.

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