

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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**LIBERTY MUTUAL INSURANCE CO.**  
Petitioner,

v.

**PROGRESSIVE CASUALTY INSURANCE CO.**  
Patent Owner.

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Case CBM2012-00004 (JL)  
Patent 6,064,970

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Before JAMESON LEE, JONI Y. CHANG, and MICHAEL R. ZECHER,  
*Administrative Patent Judges.*

LEE, *Administrative Patent Judge*

**ORDER**  
**Conduct of Proceedings**  
**37 C.F.R. § 42.5**

On February 21, 2013, a telephone conference call was held between respective counsel for the parties and Judges Lee, Chang, and Zecher. The parties expressed a desire to have this proceeding joined under 35 U.S.C.

§ 325(c) and 37 C.F.R. § 42.222(b) with CBM2012-00002, in the interest of efficiency. For instance, if oral argument can be held at the same time, if the same witness can be cross-examined once rather than twice, and if the same prior art can be discussed once, not twice, that would lead to better efficiency. Also, if the two proceedings result in final decisions that are not rendered at the same time, there may be unintended effects on the second proceeding to finish.

A discussion ensued and it became apparent that most items of concern to the parties are not at issue. The scheduling orders in both cases coincide with each other and both cases have been scheduled for oral argument on the same day. Counsel for the parties were informed that there will be a single oral argument held for both cases and that the Board expects to enter judgment in both cases on the same day. Counsel for the parties further agreed to coordinate with each other so that cross examination of the same witness can be conducted just once with the transcript thereof being useable for both cases.

In light of that discussion, each counsel agreed that there is no pressing need to join the two proceedings. The Board prefers to proceed without making any formal joinder or consolidation, given the focus and clarity afforded by two smaller proceedings with different prior art issues. The parties indicated no objection to non-joinder.

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It is

**ORDERED** that the parties' request to join this proceeding under 35 U.S.C. § 325(c) and 37 C.F.R. § 42.222(b) with CBM2012-00002 is considered withdrawn; and

**FURTHER ORDERED** that the parties may renew the request for joinder, if still so desired at a time subsequent to the time for oral argument.

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