

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SCHOTT GEMTRON CORPORATION
Petitioner

v.

SSW HOLDING COMPANY, INC.
Patent Owner

Case IPR2013-00358
Patent 8,286,561 B2

Before JUSTIN T. ARBES, GEORGIANNA W. BRADEN, and
MIRIAM L. QUINN, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

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

A conference call in the above proceeding was held on March 19, 2014, among respective counsel for Petitioner and Patent Owner, and Judges Arbes, Braden, and Quinn. The call was requested by Petitioner to address an issue that arose during the deposition of one of Patent Owner's

declarants, Richard Bruce Mills, taking place on the same day. A court reporter was present on the call, and a more complete record may be found in the transcript of Mr. Mills' deposition, which Petitioner shall file as an exhibit in the instant proceeding as soon as it is available.

Petitioner's counsel stated that he asked Mr. Mills what Patent Owner's counsel told Mr. Mills about his testimony (i.e., his declarations filed as Exhibits 2005 and 2022) prior to the deposition, but Patent Owner's counsel instructed the witness not to answer on the basis of privilege. Petitioner argued that the information is relevant and within the scope of cross-examination because Mr. Mills allegedly testified during the deposition that he has no personal knowledge of certain information in his declarations provided to him by Patent Owner's counsel. In particular, according to Petitioner, Mr. Mills testified that he obtained the two photographs on page 13 of Exhibit 2022 from Patent Owner's counsel and knew nothing about them beforehand. Petitioner argued that the substance of what Patent Owner's counsel told Mr. Mills about the photographs is relevant to whether Mr. Mills has sufficient personal knowledge to make the statements in his declaration and, accordingly, whether the statements are admissible. Petitioner further argued that Mr. Mills' discussions with Patent Owner's counsel regarding the declarations are not privileged and that, even if they were, any privilege was waived when Mr. Mills testified during the deposition about other conversations he had with counsel. Petitioner requested that the Board overrule Patent Owner's objections and compel Mr. Mills to answer the question about his discussions with counsel.

Patent Owner responded that the substance of Mr. Mills' discussions with Patent Owner's counsel is protected by attorney-client privilege and

attorney work product privilege, and also under Federal Rule of Civil Procedure 26(b)(4)(C). Patent Owner argued that, pursuant to the exceptions in Rule 26(b)(4)(C), Petitioner may inquire as to communications identifying “facts,” “data,” and “assumptions” provided by Patent Owner’s counsel to Mr. Mills, but is not entitled to any further information regarding the substance of those communications. Patent Owner also asserted that, although Mr. Mills did not take the photographs himself, he has personal knowledge of what is shown in the photographs. Patent Owner’s counsel acknowledged that he does not represent Mr. Mills, but stated that Mr. Mills is an expert witness engaged by Patent Owner.

After hearing from the parties, the Board ruled that the information sought by Petitioner is not protected by attorney-client privilege, but further consideration and review of the deposition transcript (particularly Mr. Mills’ testimony regarding the photographs) is necessary to determine whether Petitioner’s questions are within the scope of cross-examination and whether attorney work product privilege applies. The Board ordered that Petitioner may ask Mr. Mills to identify any facts, data, and assumptions provided by Patent Owner’s counsel to Mr. Mills in connection with his declarations and should complete its questioning of the witness, subject to any instructions from Patent Owner not to answer. Patent Owner was cautioned that, to the extent the instructions not to answer are determined to have been improper, Patent Owner is subject to the risk that another deposition would be ordered.

Upon further consideration, we are persuaded that limited and expedited briefing from the parties on the issue is appropriate. Petitioner may file a brief identifying the disputed question(s) in the deposition transcript and explaining its position as to (1) why the information sought is

within the scope of cross-examination of Mr. Mills pursuant to 37 C.F.R. § 42.53(d)(5)(ii), and (2) why the information is not privileged and/or any privilege was waived. Patent Owner then may file its own brief in response. The parties' papers should include citations to relevant portions of the deposition transcript.

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner is authorized to file a brief, under the terms set forth above, limited to five pages, by March 25, 2014; and

FURTHER ORDERED that Patent Owner is authorized to file a responsive brief, limited to five pages, by March 28, 2014.

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