

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GEA PROCESS ENGINEERING, INC.
Petitioner

v.

STEUBEN FOODS, INC.
Patent Owner

Cases¹

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

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.

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A conference call in IPR2014-00041, IPR2014-00051, IPR2014-00054 and IPR2014-00055 was held on April 8, 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 a joint proposal concerning: (1) Steuben Foods’ proposed motion to disqualify Petitioner’s witness, Joseph Dunn, Ph.D. (“Dr. Dunn”), who submitted a declaration in support of the petitions in the above identified cases; and (2) an impasse between the parties concerning the production of documents allegedly in the possession of Dr. Dunn, reflecting communications between Dr. Dunn and Steuben Foods that allegedly took place prior to GEA filing the instant petitions.

A conference call in 2014-00043 was held on April 14, 2014, among respective counsel for GEA and Steuben Foods, and Judges Elluru, DeFranco, and Bunting. The purpose of the call was to discuss GEA’s request for authorization to file a renewed motion for a stay or consolidation of the parallel reexamination of U.S. Patent No. 6,475,435 (“the ’435 patent”), the patent at issue at issue in the 2014-00043 case. *See* Reexam. Control No. 90/012,135.

IPR2014-00043

In support of its request to file a motion to stay or consolidate the parallel reexamination of the ’435 patent, GEA asserted that the final office action issued in the reexamination on March 28, 2014, adopted a claim construction that is inconsistent with a claim construction adopted by us in

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our decision instituting review of the '435 patent ("Dec."), issued on March 10, 2014. GEA further asserted that, based on the claim construction that is inconsistent with ours, the Examiner confirmed certain original claims and allowed new claims. Specifically, GEA alleged that while we construed the limitation "maintaining" specified "sterilant concentration levels" as a functional limitation of intended use (Dec. 12-13), the Examiner construed the limitation as a structural limitation. Steuben Foods argued that there was no inconsistency between claim constructions because we also stated that maintaining different sterilant concentration levels in different zones of a sterilizing system was a known, result effective parameter (Dec. 14). Steuben Foods also noted that even assuming the existence of inconsistent claim constructions, the only overlap in the asserted prior art references in the two proceedings is Scholle.

Because we are persuaded that there exists the potential for conflicting decisions in the reexamination and in the present *inter partes* review based on inconsistent claim constructions, we grant GEA authority to file a motion for stay or consolidation of the parallel reexamination. We further authorize Steuben Foods to file an opposition.

IPR2014-00041, IPR2014-00051, IPR2014-00054 and IPR2014-00055

The April 8 call focused on the impasse regarding the production of documents as that production influences a possible motion to disqualify. Steuben Foods alleged that Dr. Dunn possesses a draft declaration prepared by Steuben Foods in a reexamination proceeding relating to patent(s) in

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these *inter partes* review cases. Steuben Foods alleged it forwarded the draft declaration to Dr. Dunn, while under the impression that Steuben Foods and Dr. Dunn had a relationship (i.e., Steuben Foods believed it had retained Dr. Dunn) pursuant to an oral agreement. Steuben Foods alleged that it has a copy of the cover letter forwarding the draft declaration, but not the declaration itself. Steuben Foods further alleged that its counsel conducted a conference call with Dr. Dunn after sending the declaration to Dr. Dunn.

GEA alleged, based on its current communications with Dr. Dunn, that: (1) Steuben Foods' counsel forwarded a draft declaration to Dr. Dunn, asking him to sign it; (2) Dr. Dunn never signed the declaration or any other document provided by Steuben Foods; and (3) Dr. Dunn never agreed to be retained by Steuben Foods. GEA further alleged that it does not know whether the declaration contains privileged/work-product information because it has not seen it.

Steuben Foods further alleged that, after forwarding the draft declaration, Steuben Foods' counsel sent a Nondisclosure Agreement to Dr. Dunn, which indicated, in a preamble, an understanding that Steuben Foods was under an agreement with Dr. Dunn as its declarant in the reexamination proceeding. GEA alleged that Dr. Dunn did not sign the Nondisclosure Agreement after he declined to be a declarant for Steuben Foods. GEA further alleged that Dr. Dunn never billed Steuben Foods for any work.

Steuben Foods seeks the draft declaration from Dr. Dunn. GEA stated that it was not willing to request the document from Dr. Dunn, and produce it through GEA's counsel, because Steuben Foods potentially could move to

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disqualify GEA's counsel from representing GEA in this proceeding based on its possible review of allegedly privileged/work-product information in the draft declaration. Thus, Steuben Foods requested the Board to either order GEA to instruct Dr. Dunn to produce the document to Steuben Foods or authorize Steuben Foods to move pursuant to 37 C.F.R. § 41.52 to compel production of the draft declaration via a district court subpoena to Dr. Dunn.

On the April 14 call with the parties, we further questioned the parties about this discovery issue. Steuben Foods asserted that it sought the draft declaration as well as any other potential documents from Dr. Dunn. Steuben Foods further asserted that the discovery would reflect the relationship and the substance of conversations between Dr. Dunn and Steuben Foods regarding legal positions. GEA reiterated its position that there was no relationship and no signed agreement between Dr. Dunn and Steuben Foods.

Steuben Foods' Request for Authorization to Move to Compel Document(s)

We decline, at this time, to order GEA to instruct Dr. Dunn to produce the draft declaration through GEA's counsel. Steuben Foods did not sufficiently demonstrate that GEA can instruct Dr. Dunn to produce the declaration at issue. Even if GEA could instruct Dr. Dunn to do so, Steuben Foods has not explained why the mode of delivery should be through GEA's counsel if, as alleged by Steuben Foods, the declaration contains privileged/work-product information. We are persuaded, however, to authorize Steuben Foods to file a motion with the Board seeking

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authorization to compel production of the document(s) pursuant to 37 C.F.R. § 41.52.

The Office does not have authority to issue a subpoena for the production of documents. Production of documents is compelled through a subpoena from a United States District Court. *See* 35 U.S.C. § 24. Section 42.52 of our Rules provides procedures for compelling the production of documents. 37 C.F.R. § 41.52. Section 42.52(a) requires the party seeking to compel production of documents to first obtain authorization from the Board; otherwise, the compelled evidence will not be admitted in the proceeding. The motion for authorization must describe the general relevance of each document and the general nature of the document. *Id.* at § 42.52(a)(2). In addition, Steuben Foods' motion shall be accompanied by a declaration from Steuben Foods' counsel attesting to the facts substantiating what agreement Steuben Foods asserts existed between Steuben Foods and Dr. Dunn when the declaration was allegedly sent to Dr. Dunn.

GEA is authorized to file an opposition to Steuben Foods' motion.

Guidance Regarding Whether to File Second Declaration as Supplemental Information

GEA sought guidance on whether GEA should file a declaration by Mr. Spinak as "supplemental information" pursuant to 37 C.F.R. § 42.123. GEA asserted that in response to Steuben Foods' objection to Dr. Dunn's declaration, GEA "served" a substitute declaration by Mr. Spinak to Steuben

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Foods pursuant to 37 C.F.R. § 42.64. GEA further asserted that Steuben Foods responded that Mr. Spinak's declaration should be "filed" as supplemental information pursuant to Rule 42.123. Steuben Foods asserted that the substitute declaration should be filed so that the record is clear as to which declarant GEA is relying upon. Steuben Foods asserted that Mr. Spinak's declaration is "identical" to that of Dr. Dunn. GEA stated that it is willing to file Mr. Spinak's declaration as "supplemental information" pursuant to Rule 123, but noted that Rule 123(a)(1) requires parties to seek authorization to file a motion to submit supplemental information within one month of the date the trial is instituted. Steuben Foods asserted that it did not object to GEA making the request more than one month after institution. *See* Rule 123(b) (late submission of supplemental information).

At our request, the parties agreed to meet and confer regarding GEA's two declarants. If Steuben Foods agreed that Mr. Spinak's declaration could properly substitute Dr. Dunn's declaration, it would obviate the issues related to Dr. Dunn, namely Steuben Foods' motion to compel document(s) pursuant to Rule 42.52 and a possible motion to disqualify Dr. Dunn. The parties agreed to inform us of the result of the meet and confer and that the current schedule for the two motions addressed in this Order would stay in place.

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In consideration of the foregoing, it is hereby:

ORDERED that GEA is authorized to file a motion to stay or consolidate the parallel reexamination of the '435 patent no later than Friday, April 18, 2014, consisting of no more than 5 pages;

FURTHER ORDERED that Steuben Foods is authorized to file an opposition to GEA's motion for stay or consolidation no later than Friday, April 25, 2014, consisting of no more than 5 pages;

FURTHER ORDERED that Steuben Foods is authorized to file a motion to compel the production of document(s) by Dr. Dunn pursuant to 37 C.F.R. § 42.52 no later than Friday, April 18, 2014, consisting of no more than 5 pages;

FURTHER ORDERED that GEA is authorized to file an opposition to Steuben Foods' motion to compel the production of document(s) by Dr. Dunn no later than Friday, April 25, 2014, consisting of no more than 5 pages; and

FURTHER ORDERED that GEA and Steuben Foods meet and confer regarding the substitution of Mr. Spinak's declaration for Dr. Dunn's declaration and any related issues.

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