

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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RESPIRONICS, INC.  
Petitioner

v.

ZOLL MEDICAL CORPORATION  
Patent Owner

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Case No. IPR2013-00322  
Patent 6,681,003

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Before BRYAN F. MOORE, BRIAN J. MCNAMARA, and  
SCOTT E. KAMHOLZ, *Administrative Patent Judges*.

McNAMARA, *Administrative Patent Judge*.

ORDER CONCERNING FILING OF MOTIONS TO EXCLUDE AND  
MOTIONS FOR OBSERVATIONS ON CROSS EXAMINATION

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

A teleconference was held on May 19, 2014 in response to Petitioner's request of May 16, 2014. Petitioner provided a Court Reporter for the teleconference.

In a teleconference on May 2, 2014, we authorized Patent Owner to cross examine Petitioner's expert, Dr. Efimov, on his direct testimony (declaration) in support of Petitioner's Opposition to Patent Owner's Motion to Amend and, further, to cross examine Dr. Efimov on his direct testimony (declaration) in support of Petitioner's Reply to the Patent Owner Response.

On May 7, 2014, in response to an e-mail inquiry, we ordered that, because Patent Owner had not yet filed its last paper, it should incorporate arguments that refute the testimony of Patent Owner's expert concerning the Motion to Amend in its Reply to Petitioner's Opposition to the Motion to Amend. Paper 26. However, because Patent Owner had filed its last substantive paper in response to Petitioner's challenges on which we instituted trial, but had not deposed Dr. Efimov on that topic, we authorized Patent Owner to file a motion for observation on cross examination of Dr. Efimov concerning testimony relating only the subject matter addressed in Petitioner's Reply to the Patent Owner Response. *Id.* We ordered that Patent Owner file such observations not later than May 23, 2014, which is the same day that Petitioner's observations are due and the same day on which motions to exclude evidence are due. *Id.* The due date for both parties to respond to each other's motions for observations on cross examination is June 6. *Id.*

Petitioner now seeks clarification regarding the timing for objecting to and moving to exclude testimony that may be cited in Patent Owner's observations on cross examination. Observations on cross examination are for the purpose of bringing testimony to the Board's attention, where a party does not believe a motion to exclude the testimony is warranted. Office Trial Practice Guide, 77 Fed.

Reg. 48756, 48767-8 (Aug. 14, 2012). Observations on cross examination do not control the timing of objecting to deposition testimony. An objection to the admissibility of deposition evidence must be made during the deposition. 37 C.F.R. § 42.64(a). Thus, Petitioner cannot now object to evidence that Petitioner did not object to during Patent Owner's deposition of Dr. Efimov. Because all evidence should have been introduced and corresponding objections should have been made by this time, all motions to exclude evidence must be filed by May 23, 2014, in accordance with the Scheduling Order.

During the teleconference, Petitioner noted that the Office Trial Practice Guide appears to expand the requirements under 37 C.F.R. § 42.64(c) for motions to exclude to include an identification of where in the record the evidence sought to be excluded was relied upon by the opponent. Office Trial Practice Guide, 77 Fed. Reg. at 48767. In this case Patent Owner is filing its observations on cross examination on the same date motions to exclude are due. Petitioner observed that, having not received Patent Owner's observations, Petitioner's motion to exclude could not identify Patent Owner's reliance with respect to evidence from the deposition of Dr. Efimov conducted on May 5, 2014. We noted Petitioner's concern and recommended that Petitioner state that its motion to exclude evidence from Dr. Efimov's May 5, 2014 deposition applies to the extent that Patent Owner relies upon the subject evidence.

Petitioner also seeks guidance on the proper scope and timing of motions to strike. Although the Board has received numerous pleadings styled as a "motion to strike," there is no specific provision for such a motion in our rules. A party seeking to remove an improperly filed paper should request authorization from the Board to file a motion to expunge. No such request has been made in this proceeding. While there may be circumstances where the Board may authorize a

party to file a paper styled as a “motion to strike,” no such circumstances are apparent in this case. A “motion to strike” is not a substitute for a motion to exclude evidence and is not the proper approach to arguing the merits or adequacy of evidence. The circumstances described by Petitioner in this case appear to involve an objection to the admissibility of certain testimony as irrelevant. In that case, a motion to exclude appears to be the proper course. The weight to be accorded arguments that rely upon excluded evidence will be adjusted accordingly.

In consideration of the above, it is

ORDERED, that Petitioner remains authorized to file a motion for observations on cross examination of reply witnesses, not later than May 23, 2014, as stated in the Scheduling Order;

FURTHER ORDERED that all motions to exclude are to be filed by May 23, 2013, as stated in the Scheduling Order; and

FURTHER ORDERED, that Patent Owner and Petitioner remain authorized to file responses to the respective motions for observations on cross examination not later than June 6, 2014.

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Patent 6,681,003

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