

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

A.C. DISPENSING EQUIPMENT INC.,
Petitioner,

v.

PRINCE CASTLE LLC,
Patent Owner.

Case IPR2014-00511
Patent 8,534,497 B2

Before LINDA M. GAUDETTE, DONNA M. PRAISS, and
SCOTT E. KAMHOLZ, *Administrative Patent Judges*.

KAMHOLZ, *Administrative Patent Judge*.

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

By email dated October 9, 2014 (copy attached), Patent Owner requested a conference call to seek authorization either (a) to conduct cross-examination of Petitioner's witness Dr. Militzer on his Petition testimony after Due Date 2, or (b) to file a motion to require Petitioner to make Dr. Militzer available for cross-examination during the week of October 20, 2014. Petitioner opposes either course of action. A conference call was held on October 9, 2014. We denied both of Patent Owner's requests.

During the call, Patent Owner argued that, under 37 C.F.R. § 42.53(d)(2), any new declaration from Dr. Militzer submitted with Petitioner's Reply would constitute "supplemental evidence relating to the direct testimony," so that cross-examination of Dr. Militzer should not be taken until after such Reply declaration is filed, or the deadline for same has passed. Patent Owner also pointed to the response to Comment 149 in the Notice of Final Rulemaking for the Rules of Practice for Trials, which explains that "supplemental evidence" in the context of 37 C.F.R. § 42.53(d)(2) refers to "additional proofs" relating to the direct testimony.* Patent Owner argued that conducting a single deposition at the close of evidence would be more efficient than possibly having to conduct two depositions.

We disagree with Patent Owner. The more efficient course, and the

* See Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions; Final Rule, 77 Fed. Reg. 48,612, 48,642 (Aug. 14, 2012).

one the Board routinely follows, is to expect a party to conduct cross-examination of a witness once that witness's direct testimony becomes ripe for cross examination, i.e., after any supplemental evidence relating to the direct testimony is due, and at least one week before the due date of the party's next substantive paper. *See* Paper 11, 4. Postponing cross-examination until the close of evidence does not promote efficiency, because it impairs the orderly development of the record, and it delays the identification of factual issues to be resolved during trial.

We do not consider a witness's Reply declaration evidence to be supplemental evidence to the witness's Petition declaration evidence, because the two declarations need not relate to the same issues, and because the only permitted use by a Petitioner of a Reply declaration is to rebut evidence proffered by Patent Owner in its Patent Owner response, not to present additional proofs to bolster the witness's Petition declaration. *See* 37 C.F.R. § 42.23(b).

For these reasons, we will not authorize Patent Owner to conduct cross-examination of Dr. Militzer on his Petition declaration evidence after Due Date 2. Nor will we authorize Patent Owner to file a motion to require Petitioner to make Dr. Militzer available for deposition during the week of October 20, 2014, because Patent Owner has not explained how Petitioner's actions necessitate such relief.

Accordingly, it is

ORDERED that Patent Owner is not authorized to conduct cross-examination of Dr. Militzer on his Petition declaration evidence after Due

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Date 2; and

FURTHER ORDERED that Patent Owner is not authorized to file a motion to require Petitioner to make Dr. Militzer available for deposition during the week of October 20, 2014.

PETITIONER:

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From: Marie Mikolainis [<mailto:mariem@andruslaw.com>]
Sent: Wednesday, October 08, 2014 6:03 PM
To: Trials
Cc: Aaron Olejniczak; Chris Liro; Robert M. Asher; Steven G. Saunders; Melissa Guzman
Subject: Request for Phone Conference - IPR2014-00511, A.C. Dispensing Equipment Inc. v. Prince Castle LLC

On behalf of Atty. Aaron Olejniczak, this email is to request a phone conference on Thursday, October 9, 2014 to discuss authorization to file either (a) a Motion to Amend the Scheduling Order to confirm that Patent Owner may take a single cross examination deposition of Petitioner's expert witness after Due Date 2 and submit a Motion for Observations on his cross examination by Due Date 4, addressing subject matter presented with both Petitioner's Petition and Reply, or (b) a Motion to Depose Petitioner's expert the week of October 20, 2014.

We conferred with Petitioner, who opposes either approach.

Kind Regards,

MARIE G. MIKOLAINIS

Paralegal



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