

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WESTLAKE SERVICES, LLC,
Petitioner,

v.

CREDIT ACCEPTANCE CORP.,
Patent Owner.

Case CBM2014-00176
Patent 6,950,807

Before JUSTIN T. ARBES, DAVID C. McKONE, and
GREGG I. ANDERSON, *Administrative Patent Judges*.

McKONE, *Administrative Patent Judge*.

ORDER
DENYING PETITIONER'S REQUEST FOR AUTHORIZATION TO FILE
MOTION TO COMPEL INVENTOR DEPOSITION
37 C.F.R. §§ 42.20(b), 42.51(b)

On a May 14, 2015, conference call with the Board, Petitioner requested authorization to file a motion to compel the deposition testimony of Jeffrey Brock, the named inventor on U.S. Patent No. 6,950,807 (“the ’807 patent”), the patent challenged in this proceeding. Petitioner argues that Patent Owner relied upon the Specification of the ’807 patent as factual evidence supporting its Patent Owner Response (Paper 27). According to Petitioner, Mr. Brock signed an oath, accompanying the patent application, stating that he read and understood the contents of the Specification when the application was filed (standard in all patent applications), and that because of this oath, the ’807 patent is testimony of the inventor.

As specified by 37 C.F.R. § 42.51(b)(1)(ii), a party is authorized, as a matter of routine discovery, to cross examine “affidavit testimony” submitted by its opponent.¹ Petitioner contends that the Specification is affidavit testimony giving rise to a right to cross examine. Petitioner, however, was unable to point to any instance in which a tribunal considered a patent specification to be affidavit testimony of the inventor. Instead, Petitioner argues that courts have referred to specification statements colloquially as inventor statements (e.g., the inventor can act as his own lexicographer).

We disagree with Petitioner. We are not persuaded that the existence of the required oath or affidavit that accompanies a patent application converts a patent specification into inventor “affidavit testimony,” as defined in the rules and subject to cross examination under Rule 42.51(b)(1)(ii). If

¹ “Uncompelled direct testimony must be submitted in the form of an affidavit.” 37 C.F.R. § 42.53(a); *see also* 37 C.F.R. § 42.2 (defining the term “affidavit” as an “affidavit or declaration under [37 C.F.R.] § 1.68”).

that were the case, inventor testimony would be sought as routine discovery in nearly every case. We are not persuaded that this is contemplated by the Rules.

Petitioner also seeks the deposition of Mr. Brock as additional discovery under Rule 42.51(b)(2). According to Petitioner, there is good cause to cross examine Mr. Brock with prior art that it believes conflicts with the Specification. *See* 37 C.F.R. §§ 42.51(b)(2)(i), 42.224(a). We are not persuaded. Petitioner is in possession of the allegedly conflicting prior art and may, if appropriate, submit this evidence with its reply (subject, of course, to 37 C.F.R. § 42.23(b) (“A reply may only respond to arguments raised in the corresponding opposition or patent owner response.”)).

Petitioner has given us no reason to conclude that inventor testimony on this prior art would net any useful information. *See Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, slip op. at 6 (Mar. 5, 2013) (Paper 26) (“The party requesting discovery should already be in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered.”).

In sum, we deny authorization to file a motion to compel Mr. Brock’s testimony under either Rule 42.51(b)(1) or Rule 42.51(b)(2).

On the conference call, Patent Owner requested authorization to file a motion for sanctions. Patent Owner argues that Petitioner failed to meet and confer adequately. In particular, Patent Owner contends, Petitioner refused to explain the bases for which it was seeking Mr. Brock’s deposition, leaving Patent Owner at a disadvantage in opposing Petitioner’s request for authorization to depose Mr. Brock. We granted Patent Owner authorization

to submit for our review an email string containing the communications between the parties on this issue, which Patent Owner has now done.

It is not the Board's role to micromanage all disputes between the parties and our intervention should be limited to concrete, specific disagreements. It is for that reason that we expect the parties to meet and confer in good faith to see if an agreement can be reached prior to requesting the assistance of the Board. Upon review of the parties' communications, we agree that Patent Owner's summary of the meet and confer communications, given during the conference call, is largely correct. When asked for its bases for seeking Mr. Brock's testimony, Petitioner simply quoted Rule 42.51(b). Patent Owner again asked for clarification. Petitioner refused. This was not a good faith attempt to meet and confer on Petitioner's part.

We decline to authorize a motion for sanctions at this time. Nevertheless, we are troubled by Petitioner's failure to meaningfully engage in the meet and confer process and to discuss and disclose its position to Patent Owner prior to the conference call. Our Rules, in part, address the concerns of "the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings." 35 U.S.C. § 326(b). Failure to meet and confer in good faith prior to seeking the Board's relief wastes our time, as well as that of the parties, and thwarts the Board's goals of administering just and speedy trials. Thus, we take this opportunity to remind the parties, and Petitioner in particular, that the Board may impose sanctions on a party that abuses the discovery process. *See* 37 C.F.R. § 42.12(a)(6) and (7). Such sanctions are outlined in Rule 42.12(b). We trust that the parties will make a better effort to cooperate in the future.

CBM2014-00176
Patent 6,950,807

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's request for authorization to file a motion to compel the deposition of Jeffrey Brock is *denied*; and

FUTHER ORDERED that Patent Owner's request for authorization to file a motion for sanctions is *denied*.

PETITIONER:

John van Loben Sels
Ellen Wang
FISH & TSANG, LLP
patents@fishiplaw.com

PATENT OWNER:

Douglas Nemec
James Pak
P. Anthony Sammi
SKADDEN, ARPS, SLATE, MEAGHER & FLOM LLP
dlp_cac@skadden.com