

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EDMUND OPTICS, INC.,
Petitioner,

v.

SEMROCK, INC.,
Patent Owner.

Case IPR2014-00599
Patent 7,119,960 C1

Before WILLIAM A. CAPP, TRENTON A. WARD, and
DAVID C. McKONE, *Administrative Patent Judges*.

CAPP, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request
to Present Live Testimony at Oral Argument
37 C.F.R. § 42.70

Following a request for a teleconference initiated by Edmund via email on May 11, 2015, we convened a teleconference on May 12, 2015, to consider Edmund's oral request to present live testimony at the scheduled May 21, 2015, hearing from its expert witness, Professor Angus MacLeod. Judges Capp, Ward, and McKone presided over the teleconference which was attended by counsel for both parties.

Prior to the teleconference, we asked Edmund, via email, to submit a short statement stating:

1. The subject matter for the proposed testimony.
2. Whether the proposed testimony is new or is redundant of earlier declaration and/or deposition testimony of Prof MacLeod and, if redundant, identify where it was previously presented.
3. How much time is proposed for each of (1) Direct Examination; (2) Cross-Examination; and (3) Redirect Examination
4. Whether the parties agree or disagree on the proposal.
5. Whether Patent Owner desires an equal amount of time to present live testimony.

Prior to the teleconference, Edmund responded with the following statement:

1. Subject matter of the proposed testimony: Petitioner would like to present limited testimony from Prof. Macleod relating to his opinion on the appropriate k values for thin-film filters made using zinc sulfide. This testimony relates only to the original claims 33–36, 39–41, and 44–45 of U.S. Patent No. 7,119,960, and it relates to the 90% transmission limitation recited by those claims.
2. Prior presentation of the proposed testimony: The proposed testimony would track the direct testimony of Prof. Macleod provided in his Declaration Ex. 1029, namely at paragraphs 15–26. It would also track the cross-examination testimony of Prof Macleod previously elicited

by Semrock and submitted to the Board as Ex. 2028. Most of the deposition related to this topic, namely at pages 22 to 172 and 218–221 of Ex. 2028.

3. Total time for the proposed testimony: 10 minutes for direct examination; 10 minutes for cross-examination; and 5 minutes for re-redirect examination.
4. Whether the parties or disagree on the proposal: Patent Owner opposes the proposal to present live testimony from Prof. Macleod.
5. Patent Owner's Request for Live Expert Testimony: Patent Owner does not request time for live hearing testimony from Patent Owner's expert, Dr. Rancourt.

Before the teleconference, we also solicited and received from Semrock an email indicating that it opposed Edmund's request.

As indicated by Edmund's responses to questions 1 and 2 above, the subject matter of Professor MacLeod's proposed live testimony relates to the so-called extinction coefficient (" k ") of zinc sulfide (ZnS) used in thin film optical filters. Edmund represented that it does not propose to introduce new testimony on this subject and, instead, Edmund merely desires to have Professor MacLeod reiterate his previous declaration and deposition testimony that is already of record in this case. Edmund stated that it desires to do this so that we can observe Professor MacLeod's demeanor while repeating his previous testimony.

After reviewing portions of the record, including the Patent Owner's Response (Paper 20), Petitioner's Reply (Paper 27), Professor MacLeod's declarations (Ex. 1011 and 1029) and the declaration of Semrock's expert, Dr. Rancourt (Ex. 2031), we understand that the disputed issue of fact on which Edmund desires to present live testimony relates to the scientific reliability of various items of literature relied on by the parties. In other

words, Edmund and Professor MacLeod rely on certain items of scientific literature as evidence of the value of “*k*”, while Semrock and Dr. Rancourt rely on other items of scientific literature as evidence of “*k*”. Edmund does not appear to contend that Professor MacLeod has personal knowledge of the value of “*k*” apart from the scientific literature he relies on and neither does Semrock appear to contend that Dr. Rancourt has personal knowledge of the value of “*k*” apart from the scientific literature he relies on.

Essentially, we perceive Edmund’s motivation for presenting live testimony at the hearing is to attempt to bolster the weight of Edmund’s items of scientific literature on the value of “*k*” through Professor MacLeod’s personal presence in the hearing room.

In an appropriate case, the Board may authorize or require live testimony in an IPR. *See* 37 C.F.R. § 42.53(a). For example, the Board may require live testimony where the Board considers the demeanor of a witness critical to assessing credibility. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48762 (Aug. 14, 2012). Live testimony may be requested by either party. *Id.* at 48768.

In the instant case, the witness at issue is an expert, not a fact witness. The subject matter on which testimony will be elicited is not fact evidence based on the personal knowledge or observation of the witness. The credibility issue here, if anything, relates to the scientific reliability of literature that was not authored by the witness and does not purport to be based on scientific experiments or similar empirical research performed by or for the witness.

In view of the foregoing, we determine that it would not be helpful to the Board to receive live testimony from Professor MacLeod that is entirely

redundant to declaration and/or deposition testimony that is already of record. We are not persuaded that observation of Professor's MacLeod demeanor will be helpful in assessing the scientific reliability of published scientific research in which Professor MacLeod did not participate.

ORDER

In view of the foregoing, it is hereby

ORDERED, that Edmund's oral request to present live testimony of Professor MacLeod at the final hearing on May 21, 2015, is DENIED.

IPR2014-00599
Patent 7,119,960 C1

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