

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MAXLINEAR, INC.,

Petitioner,

v.

CRESTA TECHNOLOGY CORPORATION,

Patent Owner.

Case IPR2015-00594

Patent 7,265,792 B2

Before PHILLIP J. KAUFFMAN, GREGG I. ANDERSON, and
PATRICK M. BOUCHER *Administrative Patent Judges*.

KAUFFMAN, *Administrative Patent Judge*.

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

On May 28, 2015, a conference call was conducted between respective counsel for the parties and Judges Kauffman and Boucher. Petitioner, MaxLinear, Inc., and Patent Owner, Cresta Technology Corporation, were each represented by counsel. A court reporter was present and counsel indicated a copy of the transcript would be placed in the file.

The purpose of the call was to discuss Patent Owner's request to submit new testimonial evidence under 37 C.F.R. § 42.107(c). A patent owner's preliminary "shall not present new testimony evidence beyond that already of record, except as authorized by the Board." 37 C.F.R. § 42.107(c). Generally, a patent owner submits testimonial evidence in the response rather than the preliminary response.¹

During the call, Patent Owner contended that Favrat, U.S. Patent 7,075,585, is not prior art under 35 U.S.C. § 102(e) because it is not "by another," in that there is a complete overlap in inventorship between Favrat and the challenged claims. Such evidence would be relevant because each of the eight grounds of unpatentability in the Petition rely at least in part on Favrat. *See* Paper 2, 7–8. Patent Owner proffered that such evidence would be presented in the form of testimony from one of the eight inventors identified on the face of the patent that is the subject of the Petition.

Petitioner contends that such testimony would not be in the interests of justice in that the testimony is from only one of the eight inventors, and it would not be subject to cross examination. Petitioner contends that this

¹ *See* Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, 37 C.F.R. Part 42, Final Rule, 77 Fed. Reg. 48,680–48,732, 48,701–702 (Aug. 14, 2012) (comments 50, 51, and 53 and responses).

information could instead be included in Patent Owner's response.

We agree with Petitioner that inclusion of this testimony is not in the interest of justice at this time, primarily because the testimony would not be subject to cross examination. Patent Owner noted that if trial is instituted, Petitioner would then be able to cross examine the person providing the proffered testimony. However, were Patent Owner's evidence to have the desired effect, institution would be denied, leaving Petitioner with no such opportunity to cross examine.

ORDER

It is hereby ORDERED that Patent Owner's request to file new testimonial evidence under 37 C.F.R. § 42.107(c) is *denied*.

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