

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTERNATIONAL BUSINESS MACHINES CORPORATION,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

Cases IPR2015-01322
Patent 6,314,409 B2

Before KRISTEN L. DROESCH, BARBARA A. PARVIS, and
MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

ORDER

Denying Patent Owner's Request to File a Motion to Strike Exhibit,
Authorizing Petitioner to File Motion to Apply for Subpoena to Compel
Cross-Examination Testimony of Lindsey Miles
37 C.F.R. §§ 42.5, 42.52(a)

BACKGROUND

In its Petition (Paper 2, “Pet.”), International Business Machines Corporation (“Petitioner”) relied upon statements made by Lindsey Miles in a document entitled “DECLARATION” (Exhibit 1012) to support its assertion that Exhibit 1008 is a prior art printed publication. Pet. 7. Intellectual Ventures II LLC (“Patent Owner”), in its Preliminary Response (Paper 10, “Prelim. Resp.”), contended that Exhibit 1012 should not be given any weight because it is not a sworn affidavit under 37 C.F.R. § 1.68. Prelim. Resp. 38. On December 8, 2015, we instituted trial (Paper 12, “Inst. Dec.”), and indicated that, under the circumstances, the proper course of action is to object to the evidence, thereby allowing the other party an opportunity to supplement the evidence. Inst. Dec. 17; *see* 37 C.F.R. § 42.64. Patent Owner timely served objections to Exhibit 1012 on Petitioner on December 22, 2015. *See* Paper 14, 3–4, 8; *see* 37 C.F.R. § 42.64(b)(1). Petitioner did not respond to the objection by serving supplemental evidence. *See* 37 C.F.R. § 42.64(b)(2).

CONFERENCE CALL

A conference call was held on January 29, 2016 between respective counsel for Petitioner and Patent Owner, and Judges Droesch, Parvis, and Clements.

Motion to Strike

Patent Owner initiated the conference call to seek authorization to file a motion to strike Petitioner’s Exhibit 1012. Counsel for Patent Owner sought authorization for the motion on the basis that Exhibit 1012 is not a sworn affidavit or declaration, and because Petitioner would not make Ms. Miles available for cross-examination as it is obligated to do under routine

discovery. *See* 37 C.F.R. §§ 42.51, 42.53(g). Counsel for Petitioner indicated that Ms. Miles is an employee of ProQuest, a third party to this proceeding, and is not under Petitioner's control. Petitioner indicated that, after speaking with counsel for ProQuest, Ms. Miles would be available to testify if a subpoena was sought. Petitioner further indicated that it would not oppose any request by Patent Owner to compel the cross-examination testimony of Ms. Miles, and that such non-opposition satisfied its obligations under routine discovery.

We denied Patent Owner's request to file a motion to strike as premature because Patent Owner's initial discovery period has not lapsed (Patent Owner's Response is due March 10, 2016). *See* Paper 13 (Scheduling Order). Until the discovery period closes, Petitioner has an opportunity to make Ms. Miles available for cross-examination, and thereby render moot one of the bases for Patent Owner's motion to strike.

Motion for Authorization to Apply for a Subpoena

Cross-examination of the opposing party's declarants typically is provided for under routine discovery. *See* 37 C.F.R. § 42.51(b)(1)(ii); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,761 (Aug. 14, 2012). We determine that Petitioner's obligations in this case are not satisfied by merely not opposing a motion to compel by Patent Owner. As the proponent of the testimony, if the declarant is not made available for cross-examination, Petitioner runs the risk that the direct testimony will not be considered. With that in mind, and because Petitioner cannot secure the voluntary appearance by Ms. Miles for cross-examination, we asked whether Petitioner seeks to file a motion for authorization to apply for a subpoena to compel the testimony of Ms. Miles. *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, 48,622 (Aug. 14, 2012) (“Section 42.52(a) requires the party seeking a subpoena to first obtain authorization from the Board; otherwise, the compelled evidence would not be admitted in the proceeding.”). Counsel for Petitioner answered affirmatively.

We authorize Petitioner to file a motion for authorization to apply for a subpoena to compel the cross-examination testimony of Ms. Miles. *See* 37 C.F.R. § 42.52(a); 35 U.S.C. § 24. We further authorize Patent Owner to file an opposition to Petitioner’s motion, if it so chooses. Alternatively, if Patent Owner wishes to expedite a decision on the Motion, and thereby expedite the subpoena and the deposition, Patent Owner may indicate to Petitioner that Patent Owner will not oppose, or Patent Owner may file a waiver of opposition. The parties are reminded that, pursuant to 37 C.F.R. § 42.53(d)(5)(ii), the scope of cross-examination testimony is limited to the scope of the direct testimony (i.e., the statements made in Exhibit 1012). Our authorization **shall not be construed as an authorization to file a motion to compel direct testimony**. Our authorization also **shall not be construed as an authorization to file a motion to submit late supplemental information** pursuant to 37 C.F.R. § 42.123(b).

Correcting Exhibit 1012

We informed the parties that, given the defects with Exhibit 1012, the statements contained therein would likely be accorded little weight at trial. Petitioner indicated that it could provide a corrected Declaration from ProQuest or, alternatively, could address the issues objected to by Patent Owner during the compelled deposition of Ms. Miles. At this stage in the

proceeding, however, neither of those remedies is appropriate. Petitioner had an opportunity to serve a corrected declaration as supplemental evidence within 10 days of Patent Owner's objections on December 22, 2015, but the window for serving supplemental evidence has long since closed.

Moreover, the deposition of Ms. Miles is an opportunity for Patent Owner to cross-examine her about her direct testimony (i.e., Exhibit 1012), not an opportunity for Petitioner to supplement that direct testimony. Accordingly, the only procedural vehicle available to Petitioner for submitting a corrected declaration would be a motion for late submission of supplemental information under 37 C.F.R. § 42.123(b), but such a motion requires Petitioner to "show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice" (*id.*). If Petitioner seeks authorization to file such a motion, it should request a conference call with the panel.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's request to file a motion to strike is denied without prejudice;

ORDERED that Petitioner is authorized to file a motion to apply for a subpoena under 35 U.S.C. § 24 to compel the cross-examination testimony of Lindsey Miles pursuant to 37 C.F.R. § 42.52(a), limited to five (5) pages, due no later than five business days after the entry of this order; and

FURTHER ORDERED that Patent Owner is authorized to file an opposition to Petitioner's motion, limited to five (5) pages, or a waiver of

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opposition, due no later than five business days after the filing of Petitioner's motion.

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