

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ACTIFIO, INC.,
Petitioner,

v.

DELPHIX CORP.,
Patent Owner.

IPR2015-00014, IPR2015-00016, IPR2015-00019, IPR2015-00034
(Patent 8,150,808 B2)
IPR2015-00025, IPR2015-00026
(Patent 8,161,077 B2)
IPR2015-00050, IPR2015-00052
(Patent 8,548,944 B2)
IPR2015-00100, IPR2015-00108
(Patent 8,566,361 B2)
IPR2015-00128
(Patent 8,468,174 B1)

Before KARL D. EASTHOM, PATRICK R. SCANLON, and MINN
CHUNG, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

ORDER¹

Request for Authorization to Depose Declarant Joseph Ortiz
37 C.F.R. §§ 42.51(b), 42.53(d)

¹ This Order will be entered in each case. The parties are not authorized to use this caption style.

IPR2015-00014, IPR2015-00016, IPR2015-00019,
IPR2015-00025, IPR2015-00026, IPR2015-00034,
IPR2015-00050, IPR2015-00052, IPR2015-00100,
IPR2015-00108, IPR2015-00128

The parties and panel conducted a conference call in the above-captioned proceedings on November 25, 2015. Patent Owner requested the call to seek authorization to depose Petitioner's declarant, Mr. Joseph Ortiz. Prior to the request, Petitioner filed the Declaration of Joseph Ortiz (Ex. 1030 ("Ortiz Declaration")) as evidence in support of its Reply (Paper 33).² Prior to filing the Ortiz Declaration with its Reply, and prior to the Patent Owner Response (Paper 24), Petitioner served (but did not file) the Ortiz Declaration as supplemental evidence in response to an objection by Patent Owner (objecting to alleged prior art on the ground that it had not been publicly disseminated). *See* 37 C.F.R. § 42.53(b)(2) (Supplemental Evidence). In its Response, Patent Owner characterized some of the contents of the Ortiz Declaration (which had not yet been filed) as being deficient. *See* Paper 24, 2. In Reply to that Response, as indicated above, Petitioner filed the Ortiz Declaration and cited it as rebuttal evidence (of public dissemination of the alleged prior art). *See* Paper 33, 4–5.

During the call, Petitioner argued that it would be improper to allow Patent Owner to cross-examine Mr. Ortiz at this late stage, because Patent Owner should have deposed Mr. Ortiz shortly after Petitioner first *served* Patent Owner with the Ortiz Declaration (i.e., served prior to Patent Owner's Response). In response, Patent Owner cited 37 C.F.R. § 42.53(d)(2), which states that "[c]ross-examination should ordinarily take place after any supplemental evidence relating to the direct testimony has been *filed*."

² Citations refer to Exhibit and Paper numbers in IPR2015-00014.

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(Emphasis added). The panel noted that 37 C.F.R. § 42.51(b) (1)(ii) routinely provides for cross-examination of declaration testimony. Petitioner argued that the latter rule does not require the declaration testimony to be filed. Patent Owner countered that it would be overly cumbersome and expensive to force a party to cross-examine each declarant before the other party even decides whether or not to file and rely upon that declarant's testimony.

Patent Owner's position is more persuasive. Cross-examining a declarant on evidence that may never be filed potentially wastes resources and time.³ A party cannot rely on an unfiled declaration as evidence. 37 C.F.R. § 42.63 (a) ("evidence must be filed in the form of an exhibit"). On the other hand, the Board ordinarily allows for cross-examination after a party files a declaration. *See* 37 C.F.R. § 42.51(b)(1)(ii)(1) (routine cross-examination within time periods set by Board); Paper 12 (Scheduling Order setting Due Date 4 for an observation on the cross-examination testimony of a reply witness); *see also* 37 C.F.R. § 42.53(d)(2) (cross-examination after filing supplemental evidence relating to direct testimony).

Accordingly, filing the Oritz Declaration with the Reply rendered it ripe for cross-examination. In light of the circumstances and arguments

³ During the call, Petitioner also argued *GoPro, Inc. v. Contour, LLC.*, IPR 2015-00511, slip. op. at 2–3 (PTAB Oct. 28, 2015) (Paper 17) supports Petitioner's position here. *GoPro* does state that cross-examination should occur when evidence is ripe, but *GoPro* involved a *filed* declaration and therefore is distinguishable from and coalesces with our ruling. *See id.* (ruling that patent owner could not postpone cross-examination until after the due date of petitioner's reply about a witness's *filed* petition declaration).

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presented, the panel granted Patent Owner the right to depose Mr. Ortiz. In response, Petitioner explained that providing Mr. Ortiz for a deposition at this late stage would be overly burdensome and costly. Therefore, Petitioner offered to move to expunge the Ortiz Declaration and conceded it would not rely on it. Patent Owner agreed to the offer and concession.

Accordingly, it is

ORDERED that Patent Owner's request to depose Mr. Ortiz is moot;
and

FURTHER ORDERED that Petitioner shall move to expunge the
Ortiz Declaration from the above-captioned proceedings.

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