

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EBAY ENTERPRISES, Inc. and EBAY Inc.,
Petitioner,

v.

LAWRENCE B. LOCKWOOD,
Patent Owner.

Case CBM2014-00025
Patent 7,010,508

Before MICHAEL W. KIM, and BENJAMIN D. M. WOOD,
Administrative Patent Judges.

KIM, Administrative Patent Judge

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

On July 21, 2014, a conference call was held between counsel for the parties and Judges Kim and Wood. Counsel for Patent Owner requested the call to seek guidance concerning the cross-examination of Dr. Sandra Newton, Petitioner's sole declarant in support of its Petition. Pet. (citing Ex. 1008). Specifically, counsel for Patent Owner indicated that the parties had agreed to conduct the cross-examination of Dr. Newton on July 24, 2014 and July 25, 2014 (Paper 27). Approximately one week before deposition,

counsel for Petitioner contacted counsel for Patent Owner, and indicated that they would no longer be relying on Dr. Newton's Declaration in this proceeding, and thus cancelled the cross-examination. Counsel for Patent Owner expressed concern regarding Petitioner's position, and requested the Board to compel Petitioner to either (1) make Dr. Newton available for cross-examination on the agreed upon date or (2) if Dr. Newton is not made available, reimburse Patent Owner for certain costs and fees incurred by Patent Owner in connection with Dr. Newton's cross-examination.

As an initial matter, the parties indicated that the matter concerning costs and fees was addressed, and thus Patent Owner withdraws that request. The Board appreciates the parties coming to an agreement on that matter.

Request to Compel Cross-Examination

Concerning the request to compel the cross-examination of Dr. Newton, counsel for Patent Owner raised several issues. Upon consideration of both party's positions, Patent Owner's request is denied for the reasons set forth below.

Counsel for Patent Owner asserts that because the Board instituted a trial based on the Petition, and the Petition cites Dr. Newton's Declaration, the Board relied on Dr. Newton's Declaration in instituting a trial in this proceeding, and thus Patent Owner should be provided the opportunity to cross-examine Dr. Newton. Petitioner opposes the request, as Petitioner acknowledges that they cannot rely further on any statement made in Dr. Newton's Declaration, and thus the failure to provide Dr. Newton for cross-examination is to the detriment of Petitioner. On these facts, we are not

persuaded there is sufficient reason to compel Dr. Newton's testimony. In addition to the reasons set forth by Petitioner, we note that concerning the instituted grounds, neither the relevant portions of the Petition nor the analysis portion of the Decision to Institute (Paper 24) refer to Dr. Newton's Declaration. Accordingly, it is not apparent how either Patent Owner would be prejudiced or the proceeding would benefit from the cross-examination of Dr. Newton.

Counsel for Patent Owner asserts that if another declaration is filed with Petitioner's Reply Brief in this proceeding, Patent Owner will not have a chance to provide a full written response. It is not apparent how any cross-examination of that possible declarant is related to the cross-examination of Dr. Newton. Additionally, it is speculative as to what Petitioner may or may not include with their Reply Brief. Moreover, even if such a declaration is filed, Patent Owner will have a chance to cross-examine such a declarant, if any, and file observations.

Counsel for Patent Owner indicated that it was concerned that the substance of Petitioner's Reply Brief and supporting declaration would exceed the proper scope of the grounds instituted by the Board in this proceeding. Again, it is not apparent how a possible scope of the Reply Brief is related to the cross-examination of Dr. Newton. It is speculative as to what Petitioner may or may not argue or include with their Reply Brief. Moreover, the Board is capable of ascertaining whether or not the substance of Petitioner's Reply Brief, including any declaration, exceeds the proper scope of the instituted grounds.

Other Requests

Counsel for Petitioner requested authorization to file a motion to expunge the Declaration of Dr. Newton. Counsel for Petitioner proffers that this would clarify matters in this proceeding. Counsel for Patent Owner indicated that they may wish to cite certain portions of Dr. Newton's Declaration that they assert support their positions. We authorize Petitioner's request.

Counsel for Patent Owner requested that if Petitioner cannot rely on Dr. Newton's Declaration, the trial should be terminated. Essentially, Patent Owner is asserting that without Dr. Newton's Declaration, Petitioner has no basis to support any of the grounds of unpatentability set forth in the Petition, and thus, facially, there is no basis to conduct a trial. Petitioner opposes the request, and asserts that there is other evidence of record to support its arguments with regards to the instituted grounds. We agree with Petitioner that termination of the trial is not warranted. As set forth above, concerning the instituted grounds, neither the relevant portions of the Petition nor the analysis portion of Decision to Institute (Paper 24) refers to Dr. Newton's Declaration.

Counsel for Patent Owner requests authorization to file a transcript of the conference call as an exhibit. The request is granted.

For the reasons given, it is

ORDERED that Patent Owner's request to compel Petitioner to make Dr. Newton available for cross-examination on July 24, 2014 and July 25, 2014 is DENIED;

FURTHER ORDERED that if Petitioner does not make Dr. Newton available for cross-examination, Petitioner cannot rely further on Dr. Newton's Declaration (Ex.1008) for any purpose in this proceeding;

FURTHER ORDERED that Petitioner's request to file a motion to expunge Dr. Newton's Declaration is GRANTED. Petitioner is authorized to file a three page motion by July 28, 2014, and Patent Owner is authorized to file a three page opposition by August 1, 2014;

FURTHER ORDERED that Patent Owner's request to terminate this proceeding is DENIED; and

FURTHER ORDERED that Patent Owner's request to file the transcript of this call as an exhibit in this proceeding is GRANTED. Patent Owner shall submit the transcript with a one-page cover sheet indicating the exhibit number only. No other papers are permitted to be filed in connection with this request.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.