

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EBAY ENTERPRISE, INC. and EBAY INC.

Petitioner

v.

LAWRENCE B. LOCKWOOD

Patent Owner

CASE NO: CBM2014-00026

Patent No. 5,576,951

**EBAY ENTERPRISE, INC. AND EBAY INC.'S
MOTION TO EXPUNGE**

Petitioner moves to expunge the declaration of Dr. Sandra Newton (Ex. 1009) from this proceeding, because that declaration is no longer necessary to the trial. In the July 21 conference call, Petitioner sought and received authorization to move to expunge Dr. Newton's declaration. Ex. 1016, July 21, 2014 Hearing Tr., 11:10-19. At the hearing, Counsel for Patent Owner seemingly agreed to expunging the declaration, stating "I think it's true, we do not oppose them withdrawing or striking the Newton declaration." *Id.*, 12:8-11.¹ Indeed, the Board declined to compel Dr. Newton's deposition at least in part "because the declaration is going to be expunged." *Id.*, 15:24-16:3.

Where an IPR declarant is not made available for cross-examination, that declarant's declaration is excluded from the record. *Clearwire Corp. v. Mobile Telecommunications Tech., Inc.*, IPR2013-00306, Paper No. 18, at 3 (PTAB, Dec. 9, 2013) (advising a party that if it failed to make its witness available for cross-examination, "the declaration of its witness will be excluded.") Similarly, where declarations or other exhibits are no longer being relied upon by the party that submitted them, such exhibits are expunged. *Palo Alto Networks, Inc. v. Juniper*

¹ It appears that Patent Owner is now taking the opposite stance. Two days after the hearing, Counsel for Patent Owner advised counsel for Petitioner that while Patent Owner hadn't made a final decision, "I anticipate we will oppose the motion."

Networks, Inc., IPR2013-00466, Paper No. 23, at 3 (PTAB, Feb. 13, 2014) (expunging an expert report excerpt, where Patent Owner “indicated that it does not rely up[on the exhibit] for a ‘substantive’ purpose regarding the merits of the grounds of unpatentability proposed in the petition”); *Gnosis SPA, v. South Alabama Med. Sci. Found.*, IPR2013-00116, Paper No. 37, at 2 (PTAB, October 31, 2013) (expunging exhibits that Patent Owner no longer relied on).

The Board instituted this proceeding solely on the grounds that the challenged claims are indefinite. Paper No. 25, at 25. Dr. Newton does not opine on indefiniteness in her declaration. Therefore, neither Petitioner nor the Board relied on Dr. Newton’s declaration for indefiniteness. Indeed, Petitioner does not cite to Dr. Newton’s declaration in support of the indefiniteness issue in the Petition. Pet. 18-23; Paper No. 31, at 3. And the Board also did not cite to Dr. Newton’s declaration in the analysis portion of the Board’s Decision to Institute. Paper No. 24, at 17-24; Paper No. 31, at 3. The Board found that this case would be simplified by cancelling Dr. Newton’s deposition, because in that event “the declaration would be for naught.” Ex. 1016, July 21, 2014 Hearing Tr., 7:17-18; Paper No. 31, at 3. Expunging Dr. Newton’s declaration will further simplify and streamline this proceeding, by removing unnecessary testimony.

Patent Owner has suggested that it may be prejudiced, because it may want to cite to portions of Dr. Newton’s declaration itself. Ex. 1016, July 21, 2014

Hearing Tr., 8:22-9:1. Yet Patent Owner has already argued that Dr. Newton’s testimony “should be given ‘little or no weight.’” PO Prelim. Resp. at 33. Patent Owner also tacitly conceded that there is no prejudice, when it agreed on the record that it did not oppose withdrawing or striking the Newton declaration. Ex. 1016, 12:8-11.

Patent Owner also suggested in correspondence to Petitioner that it believes that Petitioner should be estopped from taking positions in the future that contradict the Newton declaration. Patent Owner, however, is merely speculating about what may or may not occur in the future. Paper No. 31, at 3 (holding that “[i]t is speculative as to what Petitioner may or may not argue or include with their Reply Brief.”). Furthermore, Dr. Newton’s declaration cannot give rise to any future estoppel. Before estoppel could be triggered the Board must have relied on Dr. Newton’s declaration. *New Hampshire v. Maine*, 532 U.S. 742, 750-51 (2001). However, the Board has not relied on Dr. Newton’s declaration. Paper No. 31, at 3. Petitioner respectfully requests that Dr. Newton’s declaration, Exhibit 1009, be expunged.

ORRICK, HERRINGTON & SUTCLIFFE LLP

Dated: July 28, 2014

By: /Don Daybell/
Don Daybell, Lead Counsel for Petitioner
eBay Inc. and eBay Enterprise, Inc.
Reg. No. 50,877

APPENDIX
PETITIONER'S EXHIBIT LIST

Exhibit No.	Description	Filed
1001	U.S. Patent No. 4,359,631	X
1002	"A Model of an Audit Judgment in the Form of an Expert System", Dungan, Chris W.	X
1003	"Oncocin: An Expert System for Oncology Protocol Management," Edward H. Shortliffe, et al.	X
1004	U.S. Patent No. 5,241,671	X
1005	"Expert System for Diesel Electric Locomotive Repair," Harold E. Johnson, et al.	X
1006	"An Interactive Video Information Terminal," Ronald D. Gordon	X
1007	"The EMYCIN Manual," William van Melle, et al.	X
1008	U.S. Patent No. 5,576,951 to Lockwood	X
1009	Declaration of Dr. Sandra Newton, Ph.D.	X
1010	iRobot Complaint	X

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