

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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EBAY ENTERPRISE, Inc. and EBAY Inc.,  
Petitioner,

v.

LAWRENCE B. LOCKWOOD,  
Patent Owner.

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Case CBM2014-00026  
(Patent 5,576,951)

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Before SALLY C. MEDLEY, MICHAEL W. KIM, and  
BENJAMIN D. M. WOOD, *Administrative Patent Judges*.

WOOD, *Administrative Patent Judge*.

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

By Order dated July 23, 2014, the Board authorized eBay Enterprise, Inc. and eBay, Inc. (collectively, "Petitioner") to file a motion to expunge the Declaration of Dr. Sandra Newton (Ex. 1009), Petitioner's sole declarant in this proceeding. Paper 31, 5. Petitioner filed its motion on July 28, 2014. Paper 32 ("Mot."). Patent Owner filed an opposition to the motion on August 1, 2014. Paper 33 ("Opp.")

In its motion, Petitioner asserts that Dr. Newton’s declaration “is no longer necessary to the trial.” Mot. 1. Petitioner explains that the “Board instituted this proceeding solely on the grounds that the challenged claims are indefinite,” and that “Dr. Newton does not opine on indefiniteness in her declaration.” *Id.* at 2. Petitioner also notes that “neither Petitioner nor the Board relied on Dr. Newton’s declaration for indefiniteness.” *Id.*<sup>1</sup>

According to Petitioner, “[e]xpunging Dr. Newton’s declaration will further simplify and streamline this proceeding, by removing unnecessary testimony.” *Id.*

Patent Owner opposes Petitioner’s motion. Patent Owner asserts that Dr. Newton’s declaration is “germane to the only issue at trial—*i.e.*, whether the claims meet the definiteness requirement of § 112, ¶ 2.” Opp. 1.

According to Patent Owner, Dr. Newton “construed the claims and applied the cited art from the perspective of a person of skill in the art (‘POSA’), demonstrating that a POSA would understand the [metes] and bounds of the claims.” *Id.* at 1-2. Patent Owner also asserts that it “is entitled to receive and . . . submit to the Board ‘relevant information that is inconsistent with a position advanced by [eBay] during the proceeding.’” *Id.* (quoting 37 C.F.R. 42.51(b)(1)(iii)).

We deny Petitioner’s motion. While we are sympathetic to Petitioner’s desire to simplify and streamline the proceeding, we are not persuaded that retaining the Newton Declaration in the record would be unduly confusing or otherwise burdensome for the parties or the Board. Conversely, expunging the declaration might prejudice Patent Owner by

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<sup>1</sup> Prior to Petitioner’s motion, we determined not to compel Dr. Newton’s deposition. Ex. 1016, 15:24-16:3.

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denying it the opportunity to argue in its Response that certain portions of the declaration are inconsistent with a position advanced by Petitioner (we do not decide now what weight, if any, we may give the Newton Declaration in this regard). Therefore, we have determined that the better course of action is to retain the Newton Declaration in the record.

*Order*

Accordingly, it is

ORDERED that Petitioner's motion to expunge the Newton Declaration (Ex. 1009) is *denied*.

PETITIONER:

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