

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 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*

On August 19, 2014, a conference call was held between counsel for the parties and Judges Kim and Wood. Counsel for Patent Owner requested the call to renew its request to compel the deposition of Sandra Newton, Ph.D. Petitioner had submitted Dr. Newton's Declaration (Ex. 1009) in support of its Petition, but subsequently determined not to rely on the Newton Declaration given that Dr. Newton did not expressly opine on the

sole issue on which we instituted this covered-business-method (CBM) review: whether the challenged claims are indefinite. Ex. 1016, 10:14-11:3. Accordingly, Petitioner withdrew its offer to make Dr. Newton available for cross-examination. *Id.* at 11:3-9.

In an Order issued July 23, 2014 (Paper 31), we denied Patent Owner's first request to compel Dr. Newton's cross-examination. In doing so we noted, *inter alia*, Petitioner's acknowledgement that it would not be able to rely on the Newton Declaration in any respect, and thus we determined that it was not necessary to compel her cross-examination to protect Patent Owner's interests. Paper 31, 2-3. We also authorized Petitioner to move to expunge the Newton Declaration from the record. *Id.* at 4. Petitioner filed its Motion on July 28, 2014 (Paper 32), and Patent Owner filed an Opposition on August 1, 2014 (Paper 33).

In an Order dated August 12, 2014 (Paper 35), we denied Petitioner's Motion. It should be noted that the Motion was denied at Patent Owner's request, and solely for the benefit requested by Patent Owner in its Opposition: to preserve for Patent Owner the opportunity to argue in its Response that certain portions of the Newton Declaration are inconsistent with positions advanced by Petitioner. Paper 33, 3. This Order did not authorize Patent Owner to seek, again, the cross-examination of Dr. Newton, particularly given that the Order did not change the fact that Petitioner cannot rely on the Newton Declaration in any respect. But if Patent Owner now believes that it is prejudiced by leaving the Newton Declaration in the record without it being able to cross-examine Dr. Newton (a position that Patent Owner did not advance in its Opposition to Petitioner's Motion to Expunge), it may request expungement of the Newton Declaration no later

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than August 21, 2014.

*Order*

Accordingly, it is

ORDERED that Petitioner may file a paper including a cover page and only the following one-sentence statement no later than August 21, 2014: “We desire that the Newton Declaration (Ex. 1008) be expunged from the record.”

PETITIONER:

Don Daybell  
James Maune  
ORRICK, HERRINGTON & SUTCLIFFE LLP  
[ddaybell@orrick.com](mailto:ddaybell@orrick.com)  
[jmaune@orrick.com](mailto:jmaune@orrick.com)

PATENT OWNER:

Robert Sterne  
Donald Featherstone  
Jason Eisenberg  
Richard Bemben  
Byron Pickard  
STERNE, KESSLER, GOLDSTEIN & FOX PLLC  
[rsterne@skgf.com](mailto:rsterne@skgf.com)  
[donf-PTAB@skgf.com](mailto:donf-PTAB@skgf.com)  
[jasone-PTAB@skgf.com](mailto:jasone-PTAB@skgf.com)  
[rbemben-PTAB@skgf.com](mailto:rbemben-PTAB@skgf.com)  
[bpickard-PTAB@skgf.com](mailto:bpickard-PTAB@skgf.com)