

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.,
Petitioner

v.

DRAGON INTELLECTUAL PROPERTY, LLC.,
Patent Owner.

Case IPR2014-01252
Patent 5,930,444

Before NEIL T. POWELL, GREGG I. ANDERSON, and
J. JOHN LEE, *Administrative Patent Judges*.

POWELL, *Administrative Patent Judge*.

Order
Conduct of the Proceedings
37 C.F.R. § 42.5

Introduction

A conference call was held on October 23, 2014. The participants were Michael Kiklis and Katherine D. Cappaert on behalf of Unified Patents Inc. (“Petitioner”), Jason Angell on behalf of Dragon Intellectual Property, LLC (“Patent Owner”), and Judges Powell, Anderson, and Lee. The purpose of the call was to discuss which party would pay court reporter costs for a deposition of a corporate representative of Petitioner on the issue of real party in interest.

The parties have engaged in prior discussion and negotiation concerning the deposition. Petitioner offered to make the witness available at the offices of Patent Owner’s counsel in California and pay the associated travel expenses. The parties agreed the deposition will take place on October 28, 2014. Patent Owner filed a Notice of Deposition on October 23, 2014 (Paper 7). The parties have reached an impasse as to who would pay the costs of the court reporter.

Discussion

We advised Patent Owner that its email communication requesting the conference call did not comply with our practice. In the future, any email from the parties requesting a conference with the Board shall fairly describe the essence of the dispute, providing the facts and authority that relate to the dispute, without attorney argument.

Petitioner objects to the Notice of Deposition and argues that it includes substantial amounts of content exceeding what is provided in our rules. Under 37 C.F.R. § 42.53(d)(5)(i) a notice for direct testimony must list: (A) The time and place of the deposition; (B) The name and address of the witness; (C) A list of the exhibits to be relied upon during the deposition; and (D) A general description of the scope and nature of the testimony to be elicited. We have reviewed the Notice of Deposition and it includes content beyond what is required by the rule.

Furthermore, page 1 of the Notice of Deposition indicates the deposition testimony will be recorded “at least stenographically.” To the extent this portion of the Notice of Deposition indicates the testimony may be videotaped, videotaping was not agreed to by the parties, as our rules require. *See* 37 C.F.R. § 42.53(a). During the conference, Patent Owner acknowledged the deposition would not be videotaped. The Notice of Deposition will be expunged from the record and Patent Owner may file a Notice of Deposition complying with our rules and the agreement of the parties.

Patent Owner argues Petitioner should pay the costs associated with the deposition. Patent Owner further contends the burden is on Petitioner to establish it is the real party in interest and that it should bear the burden of costs, arguably as the proponent of the testimony. *See* 37 C.F.R. § 42.53(g). Petitioner responds that it has volunteered to produce the witness to allay any concerns Patent Owner may have that Petitioner is not the real party in interest. Petitioner has agreed to provide the witness at an agreed location, pay the costs associated with the appearance of both the witness and counsel, and to pay for a copy of the transcript of the deposition. As such, Petitioner has already assumed many of the costs that might be incurred under 37 C.F.R. § 42.53(g).

The parties both represent that the only remaining cost at issue is the cost of a court reporter. The parties have demonstrated the ability to agree on procedural matters, as indicated by the scheduling of the deposition. Going forward, both parties are advised to, whenever possible, meet and confer on issues of disagreement before coming to the Board.

We are not persuaded that, for purposes of 37 C.F.R. § 42.53(g), Petitioner is the proponent of the deposition testimony Patent Owner desires from the witness. Petitioner has represented in its Petition and during the conference that it has a good faith belief that it is the real party in interest. Pet. 2-4. Patent Owner seeks to

test that representation, and Petitioner has agreed to produce a witness on the issues involved. Patent Owner wants discovery on the issue and is taking the deposition to either confirm the representation of Petitioner or to contest it. We are mindful that Petitioner has already committed to incur the vast majority of the costs associated with the deposition. Accordingly, we use our discretion as it relates to administration of this proceeding and require Patent Owner to pay the costs of a court reporter. *See* 37 C.F.R. § 42.5(a) and (b).

ORDER

Accordingly, it is

ORDERED that the Notice of Deposition (Paper 7) is expunged and Patent Owner may file a Notice of Deposition complying with our rules and the agreement of the parties; and

FURTHER ORDERED that the costs of a court reporter associated with the taking of the deposition on October 28, 2014, will be paid by Patent Owner.

PETITIONER:

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