

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

ARISTOCRAT TECHNOLOGIES, INC.,  
Petitioner,

v.

IGT,  
Patent Owner,

---

Case IPR2016-00252  
Patent 7,303,469

---

Before MICHAEL W. KIM and RICHARD E. RICE, *Administrative Patent Judges*.

KIM, *Administrative Patent Judge*.

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

On July 25, 2016, a conference call was held between counsel for Patent Owner, counsel for Petitioner, and Judges Kim and Rice. A court reporter was also on the call.<sup>1</sup> Patent Owner requested the call to seek authorization to file two motions:

(1) a Motion to Strike the declaration of Mr. Derek James (Ex. 1007), as Petitioner denied Patent Owner's request to depose the declarant; and

(2) a contingent Motion to Terminate, as Petitioner cannot meet its burden of proving prior art status of the sole primary reference in this proceeding.

Due Date 1 is currently set for July 28, 2016. For the reasons set forth in the call, the request for authorization to file either motion is *denied*. The Board provides further the following brief analysis.

For the Motion to Strike, the Board agrees with Patent Owner that the burden is on Petitioner to produce a witness for cross-examination, and that Petitioner's failure to make Mr. James available for deposition indicates that Petitioner should not be permitted to rely on the testimony of Mr. James. We acknowledge that Petitioner indicated that it made diligent efforts to contact Mr. James after Patent Owner first requested to depose him on June 30<sup>th</sup>, and that some panels of the Board have merely discounted the weight given testimony not subject to cross-examination. Petitioner did not indicate that additional time would remedy the situation, nor did either party propose or seek an extension of Due Date 1 for these purposes.<sup>2</sup> On these facts and at this juncture in the proceeding, we are persuaded that in weighing the various factors, the equities as a whole fall in favor

---

<sup>1</sup> A transcript of the call was filed on July 26, 2016 as Exhibit 2011.

<sup>2</sup> Patent Owner indicated that they would not be filing a motion to amend, effectively rendering superfluous Due Date 3 and affording an opportunity to adjust Due Dates 1 and 2 so as to provide additional time.

of Patent Owner. Primarily, Petitioner should have known when it submitted Mr. James's Declaration that the witness would need to be available for deposition, and we are persuaded that it would be unfair to Patent Owner for us to hold against them, and to require them to respond to, testimony of a witness whom they did not have the opportunity to depose, especially in light of the impending due date for filing a patent owner response. Nevertheless, while Petitioner is not permitted to rely on the Declaration of Mr. James, we decline to actually strike the Declaration from the record, as it provides a basis for the public to understand the proceeding as a whole.

For the Motion to Terminate, with our determination that Petitioner is not permitted to rely on the Declaration of Mr. James, the issue becomes whether Petitioner has shown sufficiently that the "Let's Made a Deal" reference is prior art. Such issues are routinely addressed by patent owners in the patent owner response, and, thus, we are unpersuaded a separate Motion to Terminate is necessary.

It is

ORDERED that unless Mr. James is made available for cross-examination, Petitioner is not permitted to rely on the Declaration of Mr. James (Ex. 1007); and

FURTHER ORDERED that Patent Owner's request for authorization to file a Motion to Strike and Motion to Terminate is *denied*.

IPR2016-00252  
Patent 7,303,469

For PETITIONER:

Andrea Reister  
[areister@cov.com](mailto:areister@cov.com)

Jay Alexander  
[jalexander@cov.com](mailto:jalexander@cov.com)

For PATENT OWNER:

Holby Abern  
[habern@ngelaw.com](mailto:habern@ngelaw.com)

Kevin Cukierski  
[kcukierski@ngelaw.com](mailto:kcukierski@ngelaw.com)

Michelle Holoubek  
[Mholoubek-PTAB@skgf.com](mailto:Mholoubek-PTAB@skgf.com)

Robert Sterne  
[rsterne@skgf.com](mailto:rsterne@skgf.com)

Adam Masia  
[amaisa@ngelaw.com](mailto:amaisa@ngelaw.com)