

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VALVE CORPORATION,
Petitioner,

v.

IRONBURG INVENTIONS LTD.,
Patent Owner.

Cases

IPR2016-00948 (Patent 8,641,525 B2)

IPR2016-00949 (Patent 9,089,770 B2)

Before PHILLIP J. KAUFFMAN, MEREDITH C. PETRAVICK, and
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

KAUFFMAN, *Administrative Patent Judge*.

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

IPR2016-00948 (Patent 8,641,525 B2)

IPR2016-00949 (Patent 9,089,770 B2)

At Petitioner's request, a conference call was held on February 23, 2017, to discuss scheduling of cross-examination of Patent Owner's expert witness, Mr. Stevick. Judges Kauffman, Petravick, and Weatherly were on the call as well as counsel for the parties.

During the call, we reminded the parties that a request for a conference call should not contain substantive arguments. We also mentioned that while we will resolve disputes as needed, our hope is that ordinarily the parties will resolve matters, such as those at issue here, between themselves. *See* Paper 13 (resolving a scheduling dispute between the parties).¹

The dispute between the parties is the number of days and total hours of cross-examination of Mr. Stevick.² Specifically, Petitioner seeks a total of eleven hours³ of cross-examination over a two-day period, while Patent Owner opposes, offering eight or nine hours⁴ on a single day.

Regarding one day of testimony versus two, we find Patent Owner's proposal of one day to be impractical. It would involve eight to nine hours of cross-examination, redirect, re-cross examination, and presumably a lunch break and other breaks. Such a lengthy day would be difficult for the witness, counsel, and the court reporter. Further, such a lengthy day would unfairly pressure Petitioner to shorten the process. Accordingly, the cross-examination should take place over two days.

¹ This order is Paper 13 in both proceedings.

² The parties have agreed that Mr. Stevick is available on March 9 at Berkley and March 15 in New Orleans.

³ Seven hours for one proceeding and four for the second proceeding.

⁴ Seven for the first proceeding and an additional one or two hours for the second proceeding.

IPR2016-00948 (Patent 8,641,525 B2)

IPR2016-00949 (Patent 9,089,770 B2)

Before addressing the total hours of cross-examination, we provide some context. Although Mr. Stevick's Declarations are similar, they differ in that each addresses three claim terms not addressed in the other, and in that the analysis is tailored to the challenged claims of each patent. *See* Ex. 2002.⁵ The cases overlap in other respects (*e.g.*, the Specifications and most of the prior art involved), but differ at least in that each patent has different challenged claims and in that IPR2016-00948 involves a prior art reference (Oelsch) not relied upon in the other proceeding.

Absent stipulation otherwise by the parties or an order by the Board, cross-examination of a witness is limited to seven hours for a single proceeding. *See* 37 C.F.R. § 42.53(c)(2). In asking for an additional four hours of cross-examination for the second proceeding rather than the full seven hours, Petitioner acknowledges that the two proceedings overlap with regard to the Specifications and Mr. Stevick's Declarations, but emphasizes that the proceedings differ with regard to the challenged claims.

In seeking to limit Petitioner to one or two hours for the second proceeding, Patent Owner emphasizes the small differences between Mr. Stevick's Declarations in each case, and cites to purportedly supporting Board orders.

Patent Owner does not effectively address the differences between the Declarations, and does not effectively counter Petitioner's point that the challenged claims in each proceeding differ.

Further, the orders cited by Patent Owner do not support Patent Owner's contentions because the outcomes are consistent with our

⁵ The Declarations are filed as Ex. 2002 in each proceeding.

IPR2016-00948 (Patent 8,641,525 B2)

IPR2016-00949 (Patent 9,089,770 B2)

determination here. For example, one order cited by Patent Owner dealt with the amount of cross-examination for three related proceedings in which the witness at issue had submitted an identical 14-page reply declaration in each case. *Husky Injection Molding Systems LTD, et al. v. Plastics Engineering & Technical Systems, Inc.*, Case IPR2016-00431, slip op. at 3 (PTAB Dec. 14, 2016) (Paper 21). There, the patent owner requested a total of 21 hours of cross-examination of the witness (seven hours for each of three cases), petitioner opposed, requesting seven hours total, and the Board permitted 11 hours of cross-examination. *Id.* at 3–4. While the proceedings at hand involve two cases instead of three, this difference is counterbalanced by the fact that the proceedings at hand involve a longer submission by the witness that was not identical in each of the related proceedings.

IPR2016-00948 (Patent 8,641,525 B2)

IPR2016-00949 (Patent 9,089,770 B2)

Accordingly, it is ORDERED that Petitioner shall have up to 11 hours for the cross-examination (by deposition) of Mr. Stevick to be allocated as the parties agree over a two-day period.

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