

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

REACTIVE SURFACES LTD., LLP,
Petitioner,

v.

TOYOTA MOTOR CORPORATION,
Patent Owner.

Case IPR2016-01462
Patent 8,324,295 B2

Before CHRISTOPHER M. KAISER, JEFFREY W. ABRAHAM, and
MICHELLE N. ANKENBRAND, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

ORDER

Petitioner's Request for Deposition of Robert Iezzi, Ph.D.
37 C.F.R. § 42.51

Petitioner contacted the Board by email to request that it be permitted to take the deposition of Robert Iezzi, Ph.D. Petitioner informed the Board that Patent Owner opposed this request. A conference call was held May 31, 2017, and was attended by Judges Kaiser, Abraham, and Ankenbrand, as well as counsel for Petitioner and Patent Owner.

Petitioner argues that it is entitled to take the deposition of Dr. Iezzi as a matter of routine discovery under 37 C.F.R. § 42.51(b)(1)(ii), because Dr. Iezzi prepared “affidavit testimony . . . for the proceeding.” Patent Owner argues that “the proceeding” in § 42.51(b)(1) is limited to the post-institution trial phase, because no routine discovery is permitted during the pre-institution phase. Accordingly, Patent Owner argues that Petitioner is not entitled to take Dr. Iezzi’s deposition as a matter of routine discovery, because Dr. Iezzi’s testimony was prepared only for the pre-institution proceeding and has not been relied on by Patent Owner during the post-institution proceeding. Patent Owner also argues that there is no need to permit Petitioner to take Dr. Iezzi’s deposition outside of the scope of routine discovery.

We are not persuaded that there is a clear need for Petitioner to take the deposition of Dr. Iezzi, but we agree with Petitioner that the cross-examination of Dr. Iezzi is available as a matter of routine discovery. Under 37 C.F.R. § 42.51(b)(1)(ii), “[c]ross examination of affidavit testimony prepared for the proceeding is authorized.” Under 37 C.F.R. § 42.2, a “proceeding” means “a trial or preliminary proceeding.” Accordingly, cross-examination of a declarant is authorized whenever that declarant prepares “affidavit testimony” for a trial or preliminary proceeding. If the testimony is prepared for the preliminary proceeding and not subsequently relied upon during the trial, cross-examination of the declarant may be unnecessary, but it is permitted. Therefore, we grant Petitioner’s request and allow Petitioner to take the deposition of Dr. Iezzi.

During the conference call, Patent Owner inquired into the appropriate scope of Dr. Iezzi's deposition. In particular, Patent Owner argues that the deposition should be limited to cross-examining only the direct testimony about the asserted grounds of unpatentability on which we instituted trial. Petitioner proposes a slightly different rule that would limit the cross-examination to those matters on which Dr. Iezzi offered direct testimony that is not irrelevant to the grounds of unpatentability on which we instituted trial. Patent Owner's proposed scope is too narrow, and Petitioner's proposed scope is too broad. We agree with Patent Owner in principle that, to the extent Dr. Iezzi testified about asserted grounds of unpatentability on which we did not institute trial, that testimony is beyond the scope of the direct testimony on which Dr. Iezzi may be cross-examined. Generally, "the scope of the [cross-]examination is limited to the scope of the direct testimony." 37 C.F.R. § 42.53(d)(5)(ii). But it is also true that "the Federal Rules of Evidence shall apply to a proceeding." *Id.* § 42.62(a). Under Federal Rule of Evidence 611(b), cross-examination also may include "matters affecting the witness's credibility." Accordingly, to the extent that Dr. Iezzi's testimony constitutes a "matter[] affecting [his] credibility," cross-examination of that testimony will be permitted, even if that testimony relates to asserted grounds of unpatentability on which we did not institute trial.

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It is therefore

ORDERED that Petitioner's request to depose Robert Iezzi, Ph.D., is granted; and

FURTHER ORDERED that the scope of the deposition of Robert Iezzi, Ph.D., will be governed by 37 C.F.R. § 42.53(d)(5)(ii) and Federal Rule of Evidence 611(b).

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