

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VALVE CORPORATION,
Petitioner,

v.

IRONBURG INVENTIONS LTD.,
Patent Owner.

Cases

IPR2017-00136 (Patent 8,641,525 B2)
IPR2017-00137 (Patent 9,089,770 B2)

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

KAUFFMAN, *Administrative Patent Judge*.

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

Case IPR2017-00136 (Patent 8,641,525 B2)

Case IPR2017-00137 (Patent 9,089,770 B2)

At Petitioner's request, a call was held with the panel and counsel for each party on August 31, 2017. Petitioner requests guidance regarding cross examination of Patent Owner's expert, Dr. Stevick.

BACKGROUND

Patent Owner filed a Declaration from Dr. Stevick in both proceedings.¹

On August 11, 2017, Petitioner filed a Notice of Deposition of Dr. Stevick for both proceedings.² The Notice states that the deposition will begin on September 6, 2017, and will continue from day-to-day until completed.

On August 27, 2017, Petitioner filed the Petitioner's Reply in IPR2017-00136 (Paper 20), but did not file the Reply for IPR2017-00137.

ISSUE

With regard to IPR2017-00137, the parties agree that the Deposition of Dr. Stevick should be carried out as scheduled.

Patent Owner contends that in these circumstances, Dr. Stevick is unavailable for cross-examination regarding IPR2017-00136 pursuant to 37 C.F.R. § 42.53(b)(1).

Petitioner contends that 37 C.F.R. § 42.53(b)(1) is not applicable to this situation, and that the cross-examination should proceed as scheduled.

¹ Exhibits 2002 and 2032 in each proceeding.

² Papers 18 and 19 of each proceeding.

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ANALYSIS

We agree with Petitioner that Patent Owner's reliance upon 37 C.F.R. § 42.53(b)(1) is misplaced because that rule deals with un compelled direct testimony, not cross examination testimony. However, the Scheduling Order in this case states that the period for cross-examination, "ends no later than a week before the filing date for any paper in which the cross-examination testimony is expected to be used." Paper 13 ¶ B.2. The filing date for Petitioner's Reply in IPR2017-00136 was August 27, 2017, and consequently the period for cross-examination has ended. Petitioner elected to file the Reply early, and in doing so closed the period for cross-examination.

We recognize that these proceedings are related, and consequently cross-examination of Dr. Stevick with regard to IPR2017-00137 may reveal information relevant to IPR2017-00136. Should this situation arise, we are willing to consider if the Deposition taken for IPR2017-00137 and an associated paper may be filed in IPR2017-00136.

Accordingly, it is ORDERED that the cross-examination of Dr. Stevick will proceed as scheduled for and IPR2017-00137, but Dr. Stevcik may not be cross-examined with regard to IPR2017-00136.

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