

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VALVE CORPORATION,
Petitioner,

v.

IRONBURG INVENTIONS LTD.,
Patent Owner.

Cases¹

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

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

Before PHILLIP J. KAUFFMAN and MITCHELL G. WEATHERLY
Administrative Patent Judges.

KAUFFMAN, *Administrative Patent Judge.*

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

¹ We use this caption to indicate that this Decision applies to, and is entered in, each case. The parties are not authorized to use this type of caption.

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

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

On October 17, 2017, Judges Kauffman and Weatherly held a call with counsel for each party. The parties requested the call to resolve differences over cross examination of a witness. Specifically, Petitioner seeks to cross examine Mr. Rubinger in person for two hours, while Patent Owner contends that cross examination by phone or video for one hour would be sufficient. Petitioner expressed a willingness to conduct the cross examination either where Patent Owner is located or where the witness is located.

Background

Patent Owner recently filed a Motion to Terminate (Paper 26) in each of these proceedings.² In that Motion, Patent Owner relies on the Declaration of Bruce Rubinger (Exhibit 2034) as evidence that typical prior art searches would have discovered a prior art reference that was relied on for each Petition (Wörn). Paper 26, 5–6.

The substance of the Declaration is five pages. Ex. 2034. Patent Owner compensated Mr. Rubinger for the Declaration. *Id.* ¶ 5. Patent Owner indicates that Mr. Rubinger resides in the United States. Patent Owner indicates that Mr. Rubinger is available for telephonic cross examination on the afternoon of October 23 or later, and is available for in-person cross examination on 26 or 27 October.

We set the deadline for submission of Petitioner’s Opposition for ten business days from the filing of Patent Owner’s Motion. *See* Paper 24. That deadline was set in the context that the Petitions already addressed how and

² Unless otherwise noted, we reference the papers and exhibits of IPR2017-00136. IPR2017-00137 contains similar papers.

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why Wörn was discovered, and Patent Owner did not mention that new evidence would be submitted. Paper 24, 2. We would have set a different schedule had we known new evidence would be submitted.

Analysis

Patent Owner chose to submit a Declaration from Mr. Rubinger. That choice came with certain foreseeable consequences. Specifically, it was foreseeable that the witness would be subject to cross examination, and that the burden and expense of producing that witness would fall on Patent Owner. *See* 37 C.F.R. § 42.51(b)(1)(ii); Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48,761 (August 14, 2012) (a party presenting a witness, including an expert, should normally bear the burden and expense of producing that witness and should arrange to make the witness available for cross-examination). Further, our rules provide that ordinarily, cross examination takes place more than a week prior to the filing date for a paper that may rely upon that testimony. 37 C.F.R. § 42.53(d)(2). Thus, Patent Owner should have planned to make Mr. Rubinger available promptly for his cross examination and recognized that any delay in doing so might justify an extension of time for Petitioner's Opposition to Patent Owner's Motion to Terminate.

During the call, we explained the impact of Patent Owner's choice as outlined above, and estimated that, given Mr. Rubinger's availability, in-person cross examination would justify extending the due date for the Opposition by six business days. Patent Owner's counsel expressed concern that a deposition may delay resolution of the Motion to Terminate. To address that concern, we offered Patent Owner the choice of keeping the

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Opposition due as set by Paper 24 in exchange for removing the Rubinger Declaration from consideration in this proceeding. Patent Owner elected not to pursue that option. Patent Owner's choice to rely upon Mr. Rubinger's testimony, Petitioner's proper request to depose him in person, and Mr. Rubinger's immediate unavailability for cross examination, collectively warrant an extension of time for Petitioner to file its Opposition. Given that choice, it would be duplicitous for Patent Owner to suggest that the delay of permitting in-person cross examination is unwarranted.

Patent Owner cited three *inter partes* reviews as analogous to the situation at hand. We disagree.

Two of those proceedings are distinguishable because they dealt with cross examination of a witness that did not live within the United States. *Instradent USA, Inc. v. Nobel Biocare Services, AG*, Case No. IPR2015-01786 (PTAB Aug. 25, 2016) (Paper 61) (witness was an Israeli citizen residing in Israel); *Activision Blizzard, et al. v. Acceleration Bay, LLC*, Case No. IPR2015-01951, slip op. at 4–7 (PTAB May 19, 2016) (Paper 17) (witnesses resided in Australian).

The third case, *IBM*, is distinguishable for at least two reasons. *IBM Corp. v. Intellectual Ventures I LLC*, Case No. IPR2014-01385, slip op. at 2–3 (PTAB May 4, 2015) (Paper 19). In *IBM*, the Declaration was obtained from a third party witness pursuant to subpoena while Mr. Rubinger is a witness within Patent Owner's control. *Id.* at 2–3. Further, in *IBM*, it was not shown that the third party witness was compensated by the party offering the Declaration, while here, as mentioned above, Mr. Rubinger, was compensated by Patent Owner. *See Ex. 2034 ¶ 5.*

Patent Owner argues that telephonic or video cross examination should be sufficient and would reduce time and expense, while Petitioner requests in-person cross examination to ensure that its cross examination is as effective as possible.³ Mr. Rubinger's Declaration and his cross examination relate to the issue of whether Petitioner reasonably could have raised the grounds of unpatentability based in part on Wörn. This issue is at the heart of our consideration of Patent Owner's Motion to Terminate, the grant of which would terminate these proceedings. Consequently, we grant Petitioner's request for in-person cross examination. Patent Owner cites no persuasive authority to the contrary.

Petitioner's request for two hours of cross examination is reasonable.

Conclusion

Patent Owner's choice to submit new evidence with its Motion to Terminate comes with the foreseeable consequences that Patent Owner must make that witness available for cross examination at Patent Owner's expense, and that Petitioner would be permitted sufficient time to prepare an Opposition. The slight delay in the deadline for Petitioner's Opposition, which flows directly from Patent Owner's choice to use Mr. Rubinger's testimony and Mr. Rubinger's unavailability, will not significantly affect the overall schedule of the proceedings. We are not persuaded by Patent

³ Patent Owner observed that we are required to interpret Part 42 to secure the just, speedy, and inexpensive resolution of these proceedings, and we have done so. 37 C.F.R. § 42.1(b). Although a prompt telephonic deposition may reduce cost and result in a faster resolution of the Motion to Terminate, we must also ensure that the parties have every opportunity to present evidence for us to arrive at a just resolution.

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