

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

CYWEE GROUP LTD.,
Patent Owner.

Case IPR2018-01257 (Patent 8,552,978 B2)
Case IPR2018-01258 (Patent 8,441,438 B2)¹

Before PATRICK M. BOUCHER, KAMRAN JIVANI, and
CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

ORDER

Conduct of the Proceeding
37 C.F.R. §§ 42.5, 42.51(b)

¹ The parties are not authorized to use this style of caption.

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A conference call was conducted with the parties on April 17, 2019, to discuss potential cross-examination of Patent Owner’s witness, Gary L. Blank, Ph.D. Prior to institution of the trial, Dr. Blank provided testimony in support of Patent Owner’s Preliminary Response. Paper 7; Ex. 2001.² After institution, Patent Owner filed a Response that does not rely on that testimony, but instead relies on testimony by a different witness, Joseph LaViola, Ph.D. Paper 14; Ex. 2004. During the call, Patent Owner stated that it did not intend to rely on Dr. Blank’s testimony during the trial, and that it was prepared to file an express withdrawal of that testimony.

Regardless of whether Dr. Blank’s testimony is withdrawn, Petitioner contends that it is entitled to cross-examine Dr. Blank as routine discovery pursuant to 37 C.F.R. § 42.51(b)(1). Petitioner wishes to cross-examine Dr. Blank at least in part to explore what it alleges are inconsistencies between Dr. Blank’s testimony and Dr. LaViola’s testimony. Patent Owner disagrees that cross-examination of Dr. Blank qualifies as routine discovery because the regulations governing *inter partes* reviews distinguish between testimony prepared during the preliminary phase before institution and the trial phase after institution.

We agree with Patent Owner. Routine discovery includes “[c]ross examination of affidavit testimony prepared for the proceeding.” 37 C.F.R. § 42.51(b)(1). The regulations define “proceeding” as “a trial or preliminary proceeding.” 37 C.F.R. § 42.2. In turn, a “[p]reliminary proceeding . . . ends with a written decision as to whether a trial will be instituted” and a “[t]rial . . . begins with a written decision notifying the petitioner and patent

² Citations are to IPR2018-01257. Similar papers and exhibits have been filed in both proceedings.

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owner of the institution of the trial.” *Id.* When the Office revised the regulations governing *inter partes* reviews to permit patent owners to file testimonial evidence in support of a preliminary response, it provided the following guidance. The guidance was made in response to a comment from the public asking how the scope of discovery post-institution would be modified where testimonial evidence was presented pre-institution:

The Office will resolve these issues on a case-by-case basis. In general, a party has the opportunity to cross-examine affidavit testimony submitted by another party unless the Board orders otherwise. 37 CFR 42.51(b)(1)(ii). If expert testimony presented by the patent owner at the preliminary stage is relied on at the trial stage, the rule would apply unless the panel decides otherwise. For example, if the testimony is withdrawn at the trial stage, the Board would have to consider whether cross-examination falls within the scope of additional discovery. *See* 35 U.S.C. 316(a)(5), 326(a)(5); 37 CFR 42.51(b)(2).

81 Fed. Reg. 18,750, 18,756 (Apr. 1, 2016).

In light of this guidance, and in light of Patent Owner’s express indication that it would file an express withdrawal of Dr. Blank’s testimony, we determine that Petitioner is not entitled to cross-examine Dr. Blank as routine discovery.³ We make no determination at this time whether cross-examination of Dr. Blank may be justified as additional discovery under 37 C.F.R. § 42.51(b)(2).

³ We recognize that a different panel reached a different conclusion under similar facts. *Reactive Surfaces Ltd., LLP v. Toyota Motor Corp.*, Case IPR2016-01462, slip op. (Paper 30) (PTAB May 31, 2017).

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Accordingly, it is

ORDERED that Patent Owner shall file, as a paper in both proceedings, and by April 24, 2019, an express withdrawal of Dr. Blank's testimony; and

FURTHER ORDERED that Petitioner is not authorized to cross-examine Dr. Blank as routine discovery.

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