

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

DIRECTSTREAM, LLC,
Patent Owner.

Case IPR2018-01594 (Patent 6,434,687 B2)
Case IPR2018-01599 (Patent 6,076,152)
Case IPR2018-01600 (Patent 6,247,110 B1)
Case IPR2018-01601 (Patent 7,225,324 B2)¹
Case IPR2018-01604 (Patent 7,421,524 B2)
Case IPR2018-01605 (Patent 7,620,800 B2)^{2,3}

Before KALYAN K. DESHPANDE, JUSTIN T. ARBES, and
CHRISTA P. ZADO, *Administrative Patent Judges*.

ZADO, *Administrative Patent Judge*.

ORDER

Granting In Part Petitioner's Motion to Compel and Strike
37 C.F.R. §§ 42.20, 42.22

¹ IPR2018-01602 and IPR2018-01603 have been consolidated with IPR2018-01601.

² IPR2018-01606 and IPR2018-01607 have been consolidated with IPR2018-01605.

³ This Order addresses an issue pertaining to all the above-captioned cases. Therefore, we exercise our discretion to issue a single Order to be filed in each case. The parties are not authorized to use this style of heading.

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I. INTRODUCTION

On October 8, 2019, during the cross-examination of DirectStream, LLC's ("Patent Owner") declarant, Jon Huppenthal, the parties to this proceeding emailed the Board seeking guidance regarding the proper scope of Mr. Huppenthal's deposition. On October 10, 2019, the parties contacted the Board again, seeking guidance during the deposition of Steven Guccione, Ph.D., regarding the proper scope of questioning. The parties and the Board (Judges Arbes and Zado) held a conference call on October 10, 2019 regarding the proper scope of questioning during a deposition. Pertinent to the motion before us, Microsoft Corporation ("Petitioner") asserted that Patent Owner's counsel had improperly instructed Mr. Huppenthal not to answer certain questions, based on (1) objections to the form and/or the scope of the questions, and (2) objections on the grounds answering certain questions would require Mr. Huppenthal to reveal classified information. Patent Owner asserted that the instructions not to answer were proper. We authorized Petitioner to file a motion specifying and requesting any relief sought regarding the cross-examination of Mr. Huppenthal. Ex. 3001.

Pursuant to our authorization, in each of the above-captioned cases, Petitioner timely filed a Motion to Compel and Strike. IPR2018-01594, Paper 42 ("Mot." or "Motion"). Patent Owner timely filed an Opposition to

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Petitioner's Motion to Compel and Strike in each of the above-captioned cases. IPR2018-01594, Paper 44 ("Opp." or "Opposition").⁴

II. DISCUSSION

Petitioner requests that we (1) compel Mr. Huppenthal to be produced at the offices of Petitioner's counsel for continued cross-examination, and (2) strike portions of Mr. Huppenthal's declaration (Ex. 2084 ¶¶ 80, 82–86) for which Petitioner alleges he declined to answer questions based on his counsel's instruction not to answer on the grounds the information sought is classified. Mot. 1–5.

A. Request to Compel Testimony

With regard to Petitioner's request for continued cross-examination of Mr. Huppenthal, Petitioner asserts that Mr. Huppenthal was instructed not to answer several questions about his direct testimony, i.e., his declaration (Ex. 2084), based on form objections only. Mot. 1. Petitioner identifies portions of the transcript of Mr. Huppenthal's deposition for which Mr. Huppenthal was instructed not to answer, and corresponding portions of his declaration to which Petitioner asserts the questions were directed. Mot. 1–2 (citing Ex. 1051, 57:21–59:11, 99:8–100:10; Ex. 2084, 18–24, 56).

⁴ The parties filed similar motions and oppositions in all of the above-captioned cases, raising similar arguments. Although our citations are to the parties' arguments and evidence in IPR2018-01594, our reasoning and our Order applies to all cases, as Mr. Huppenthal's deposition was entered in to all of the proceedings.

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Patent Owner responds that the questions for which Mr. Huppenthal was instructed not to answer were objected to not just as to form but also as being beyond the scope of Mr. Huppenthal's declaration. Opp. 1–4. Patent Owner argues that Petitioner is not entitled to any relief as a result of Mr. Huppenthal's refusal to answer the questions objected to as beyond the scope of Mr. Huppenthal's declaration. *Id.* (citing 37 C.F.R. § 42.53(d)(5)(D)(ii); Ex. 1051, 12:9–36:7, 51:20–57:7, 57:21–59:11).

“For cross-examination testimony, the scope of the examination is limited to the scope of the direct testimony.” 37 C.F.R. § 42.53(d)(5)(D)(ii). However, during cross-examination, “[t]he defending lawyer must not act as an intermediary, interpreting questions the witness should answer, *deciding which questions the witness should answer*, and helping the witness formulate answers while testifying.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,772 (Aug. 14, 2012) (“Trial Practice Guide”) (emphasis added). “Consistent with the policy expressed in Rule 1 of the Federal Rules of Civil Procedure, and corresponding § 42.1(b), unnecessary objections, ‘speaking’ objections, and coaching the witnesses in proceedings before the Board are strictly prohibited.” *Id.* Therefore, “[a]n objection at the time of the examination—whether to evidence, to a party's conduct, to the officer's qualifications, to the manner of taking the testimony, or any aspect of the testimony—must be noted on the record, *but the examination still proceeds; testimony is taken subject to any such objection.*” *Id.* (emphasis added). “Counsel may instruct a witness not to answer only when

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necessary to preserve a privilege, to enforce a limitation ordered by the Board, or to present a motion to terminate or limit the testimony.” *Id.* (emphasis added). A party may initiate a conference call with the Board to seek authorization to move to terminate or limit the testimony “on the ground that it is being conducted in bad faith or in a manner that unreasonably annoys, embarrasses, or oppresses the witness or party.” *Id.* at 48,772–73.

We do not address the merits of all of Patent Owner’s objections on the basis of scope, because that issue is not before us. The issue before us is whether certain instructions not to answer were proper, and whether Patent Owner’s instructions impeded, delayed, or frustrated the fair cross-examination of Mr. Huppenthal. *Id.* at 48,772. Per the Trial Practice Guide, Patent Owner’s counsel is permitted to concisely state his objection, in a non-argumentative and non-suggestive manner, e.g., “objection, scope,” but the examination thereafter is required to still proceed, the testimony subject to the objection. *Id.* Here, certain instructions not to answer were improper because Patent Owner did not make the objection to preserve a privilege, enforce a limitation ordered by the Board, or to present a motion to terminate or limit the testimony. *Id.*; see, e.g., Ex. 1051, 57:21–60:19, 99:8–100:9. By instructing Mr. Huppenthal not to answer, Patent Owner’s counsel impeded and frustrated the fair cross-examination of Mr. Huppenthal.

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