

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO. LTD.,
SAMSUNG ELECTRONICS AMERICA, INC. and APPLE, INC.,
Petitioner,

v.

NEONODE SMARTPHONE LLC,
Patent Owner.

IPR2021-00145
Patent 8,812,993 B2

Before MICHELLE N. ANKENBRAND, KARA L. SZPONDOWSKI, and
CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

OGDEN, *Administrative Patent Judge*.

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

On January 18, 2022, we conducted a telephone conference with the parties. In that call, Patent Owner asked us for authorization to file an errata sheet for the deposition transcript of Dr. Craig Rosenberg, Patent Owner's expert witness, as an exhibit to its Sur-Reply.¹ According to Patent Owner, the errata sheet would include both typographical and substantive corrections.

The substantive corrections relate to a factual issue. According to Patent Owner, after Dr. Rosenberg had reviewed the deposition transcript, he determined that part of his testimony was factually incorrect as to whether a prior art disclosure constitutes a "tap" on a touch-sensitive display as that word appears in the challenged claims. The proposed errata sheet includes Dr. Rosenberg's substantive correction to this testimony as well as other minor corrections that Patent Owner indicates are of a typographical nature. Patent Owner shared the proposed errata sheet with Petitioner and offered to allow one hour of additional deposition time and two pages of additional briefing to address the altered testimony. Patent Owner contends that allowing the correction would provide an accurate and complete testimonial record, and that such corrections are part of the "transcript" contemplated in 37 C.F.R. § 42.53(f)(7).

In response, Petitioner argues that the proposed changes to Dr. Rosenberg's deposition transcript are extensive, including striking full sentences and adding new testimony. Petitioner contends that Patent Owner had the opportunity to ask additional questions on redirect to correct any

¹ Dr. Rosenberg's deposition was held on November 17, 2021, and Petitioner filed a copy of the transcript with its Reply on December 15, 2021. *See* Ex. 1052; Paper 49 (Petitioner's Reply).

perceived error, but did not do so. Petitioner also argues that Patent Owner did not propose submitting the proposed errata sheets until nearly two months after the deposition on November 17, 2021, and that the time for correcting the testimony has passed.

First, we disagree with Patent Owner that errata sheets are part of the “transcript” contemplated in 37 C.F.R. § 42.53(f)(7). The Final Rule Notice for this section states, in response to a comment “requesting that proposed § 42.53 provide for the submission of errata sheets and provide guidance on what is and is not acceptable in an errata sheet,” that

[t]he Board’s experience with errata sheets is that parties tend to disagree on what is and is not considered an errata sheet. For example, there have been instances where a party has attempted to change a deponent’s answer from “yes” to “no” over the objection of the opponent. Accordingly, the final rules do not provide for the submission of errata sheets, however, where a party believes that the submission of an errata sheet is necessary to the proceeding, the party may arrange for a conference call with the Board to discuss the matter.

Rules of Practice for Trials Before the Patent Trial and Appeal Board, 77 Fed. Reg. 48612, 48642 (Aug. 14, 2012). Also, prior Board decisions have not favored the submission of errata sheets that make substantive changes in testimony. *See, e.g., Garmin Int’l, Inc. v. Cuozzo Speed Techs LLC*, IPR2012-00001, Paper 50 at 4 (PTAB July 18, 2013) (“[U]nless unopposed by the other party, a request to make a material change to the substance of cross examination testimony is unlikely to be successful no matter when the request is made.”); *CBS Interactive Inc. v. Helferich Patent Licensing, LLC*, IPR2013-00033, Paper 101 at 2–3 (PTAB Oct. 7, 2013) (“The Board may decline to consider a submission of errata sheets containing any substantive change.”); *Apple Inc. v. Achates Reference*

Publ'g, Inc., IPR2013-00080, Paper 61 at 5 (PTAB Jan. 21, 2014) (“The errata sheets may only correct typographical or minor grammatical errors, and may not make any substantive changes to the witnesses’ testimony.”); *SNF Holding Co. v. BASF Corp.*, IPR2015-00600, Paper 49 at 20–21 (PTAB Aug. 2, 2016) (“[E]rrata sheets that seek to change the substantive testimony of a witness are disfavored.”); *Deere & Co. v. Gramm*, IPR2015-00898, Paper 22 at 4–5 (PTAB Jan. 7, 2016) (“[A] deposition transcript errata sheet . . . is not an opportunity to make changes to the transcript to include testimony that was not, in fact, elicited during the deposition.”); *Sony Corp. v. Cascades Projection LLC*, IPR2015-01846, Paper 24 at 2–3 (PTAB Aug. 31, 2016) (“In the past, we have refused to authorize the filing of errata that include corrections or clarifications beyond transcription errors.”).

Patent Owner’s request to correct the substance of Dr. Rosenberg’s testimony comes too late. Near the close of Dr. Rosenberg’s deposition, the parties took a ten-minute recess after the close of cross-examination for Patent Owner to consider whether to ask questions on redirect. Ex. 1052, 125:10–17. But after the break, counsel for Patent Owner stated that “we will not be having any questions on redirect so I think this deposition is concluded.” *Id.* at 125:20–21. Thus, Patent Owner has had a fair opportunity to elicit testimony correcting any substantive errors it perceived in Dr. Rosenberg’s testimony, and did not do so. Petitioner has also relied on this testimony in its Reply. *See* Paper 49, 3, 6, 9, 13.

Therefore, under the circumstances, Patent Owner has not shown that it is necessary for Dr. Rosenberg to provide, at this late stage, what amounts to new, substantive testimony in the form of an errata sheet. To the extent, however, that Patent Owner wishes to provide an unopposed errata sheet

seeking to confirm the transcript to Dr. Rosenberg's actual testimony elicited during the deposition (such as by correcting typographical errors or incorrect transcriptions), Patent Owner may do so.

Accordingly, it is

ORDERED that Patent Owner is authorized to submit an errata sheet containing corrections to Dr. Rosenberg's deposition transcript that seek to conform the transcript to Dr. Rosenberg's actual testimony elicited during the deposition, so long as it is accompanied by a statement that Petitioner does not oppose the submission; and

FURTHER ORDERED that Patent Owner is not otherwise authorized to submit an errata sheet for Dr. Rosenberg's deposition transcript.

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