

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FINJAN, INC.,  
Petitioner,

v.

FIREEYE, INC.,  
Patent Owner.

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Case IPR2014-00492  
Patent 8,171,553 B2

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Before BRYAN F. MOORE, LYNNE E. PETTIGREW, and  
FRANCES L. IPPOLITO, *Administrative Patent Judges*.

IPPOLITO, *Administrative Patent Judge*.

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

## INTRODUCTION

Pursuant to our Order entered on August 28, 2014 (Paper 14), Patent Owner filed Dr. Jaeger's deposition transcript (Exs. 2003–2006) with a brief explanation directing us to portions of the transcript to consider in reviewing Patent Owner's Submission Regarding the Deposition of Dr. Trent Jaeger and Request for Relief (Paper 15, "Request for Relief"). In its Request for Relief, Patent Owner seeks an additional seven (7) hours to depose Dr. Jaeger in California or at PTAB offices in Alexandria, Virginia. Request for Relief 5. Petitioner opposes Patent Owner's requests. Paper 16 ("Opposition"). This decision addresses these issues.

## DISCUSSION

Patent Owner asserts that during Dr. Jaeger's deposition on August 27 and 28, Dr. Jaeger was evasive and refused to answer or avoided answering questions, including questions directed to the prior art references at issue in this *inter partes* review. Request for Relief 2–3. Patent Owner further asserts that Dr. Jaeger "frustrated the deposition process through lengthy pauses between questions and answers." *Id.* at 3. Patent Owner also points to several instances in the transcript where Patent Owner asserts Petitioner's counsel made inappropriate objections that "suggested an answer to the witness, who upon hearing the objection agreed with it and refused to answer." *Id.* at 4.

In response, Petitioner asserts that Dr. Jaeger provided responsive testimony "despite deeply flawed, confusing, ambiguous and harassing questions asked by the Patent Owner." Opposition 1. Petitioner further asserts that during "Dr. Jaeger's 'pauses,' he was diligently consulting his Declarations (which each run approximately 350 pages) or specific references." *Id.* at 2. Patent Owner adds that "the number of objections

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made by Petitioner's counsel is indicative of the unclear and harassing nature of Patent Owner's questions that continued throughout the deposition." *Id.* at 4. Petitioner further asserts it would suffer prejudice if Patent Owner is permitted "the strategic advantage of having extensive time to consider Dr. Jaeger's initial testimony before taking additional deposition testimony." *Id.* at 1.

Upon review of the transcript, we are persuaded that permitting an additional seven (7) hours for Patent Owner to depose Dr. Jaeger is warranted. As Patent Owner indicates, we observe several locations in the transcript where Dr. Jaeger took long pauses before answering Patent Owner's question. Request for Relief 4 (citing Ex. 2004, 128:11–24, 129:9–16, 164:14–165:11). Moreover, as Petitioner noted, Dr. Jaeger's two declarations are sizeable with each spanning more than 300 pages. Thus, the length of Dr. Jaeger's two declarations and the delays in Dr. Jaeger's answers evidence a need for additional deposition time to allow Patent Owner a fair cross-examination of Dr. Jaeger's testimony.

Further, we are not persuaded Petitioner would be prejudiced from Patent Owner's attempt to "regroup[] and reassess strategy." Petitioner offered Patent Owner additional deposition time during the August 28th deposition and did not indicate then that any prejudice would result from the additional time. Opposition 5. Thus, we grant Patent Owner's request for an additional seven (7) hours in total for deposing Dr. Jaeger. Patent Owner may allocate the seven (7) hours between the subject matter of IPR2014-00344 and IPR2014-00492 as needed. However, the additional deposition time may not exceed seven (7) hours unless agreed to by the parties or otherwise permitted by the Board. We do not, however, conclude that the deposition location must be in California or at a PTAB office.

We also take this opportunity to observe a general lack of courtesy and decorum from counsel for both parties. *See* Ex. 2003, 99:20–102:10; 164:14–165:22. The parties are strongly cautioned to follow all rules applicable to this proceeding, including that “[e]very party must act with courtesy and decorum, . . . including in interactions with other parties.” 37 C.F.R. § 42.1(c). Further, in any future deposition in this proceeding, the parties shall refrain from interrupting each other and the witness, and shall not make speaking objections. *See Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,772 (Aug. 14, 2012). In particular, **counsel must not make objections or statements that suggest an answer to a witness and objections should be limited to a single word or term**. *Id.* (emphasis added). Objections to form are properly stated as “**Objection, form.**”

Finally, we remind the parties of the need to confer with each other sufficiently, and attempt in good faith to resolve issues, before seeking intervention from the Board. For example, the parties should confer on a reasonable location and time for Dr. Jaeger’s continued deposition. In the event that the parties are not able to come to an agreement, the parties should contact the Board for assistance.

#### ORDER

In view of the foregoing considerations, it is hereby:

ORDERED that Patent Owner’s request for additional time to cross-examine Dr. Jaeger for IPR2014-00344 and IPR2014-00492 is *granted* with a limit to a total of seven (7) hours; and

FURTHER ORDERED that Petitioner shall make Dr. Jaeger available as soon as possible for the completion of his cross-examination pursuant to 37 C.F.R. § 42.53(c)(2).

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