

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZHONGSHAN BROAD OCEAN MOTOR CO., LTD.,
BROAD OCEAN MOTOR LLC, and
BROAD OCEAN TECHNOLOGIES, LLC,
Petitioners,

v.

NIDEC MOTOR CORPORATION,
Patent Owner.

Case IPR2014-01121 (Patent 7,626,349 B2)
Case IPR2014-01122 (Patent 7,208,895 B2)¹

Before BENJAMIN D. M. WOOD, JAMES A. TARTAL, and
PATRICK M. BOUCHER, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

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

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

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A conference call was held with counsel for the parties and Judges Wood, Tartal, and Boucher on September 9, 2015.

First, certain exhibits filed in these proceedings are excerpts from deposition transcripts. We order the parties to file full transcripts of any deposition relied on by a party. Specifically, the party that first relied on any citation to a deposition transcript shall file the full transcript of that deposition as an exhibit. Any future deposition transcripts that may be filed in these proceedings shall also be filed as full transcripts.

Second, Petitioner's Replies cite excerpts of deposition testimony of Patent Owner's witnesses. Patent Owner requests authorization to cite additional testimony from the full deposition transcripts to place the excerpts relied on by Petitioner in context. The Board's regulations for *inter partes* review proceedings do not specifically provide a mechanism for a party to provide observations on cross-examination of its own witnesses. A similar request was considered in *Schott Gemtron Corp. v. SSW Holding Co., Inc.*, Case IPR2013-00358, slip op. at 2 (PTAB May 16, 2014) (Paper 77). The *Schott* panel denied the patent owner's request to file observations but authorized the patent owner to cite other portions of the deposition testimony at the oral hearing for "a limited purpose." *Schott* at 3–4. Specifically, the patent owner was authorized to "cite other portions of the testimony *only* to demonstrate that Petitioner's characterization of the witnesses' testimony is incorrect (e.g., Petitioner cites to the transcript where a witness made a particular statement, but the witness later corrected his testimony and said the opposite)." *Id.* at 4. The patent owner was not authorized to cite other

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portions of the testimony to make any new argument or expand on the testimony in the witnesses' declarations. *Id.*

The Board's regulations provide that "the Federal Rules of Evidence shall apply to a[n *inter partes* review] proceeding." 37 C.F.R. § 42.62(a). The Federal Rules of Evidence provide that "[w]hen a writing or recorded statement or part thereof is introduced by a party, an adverse party may require the introduction at that time of any other part or any other writing or recorded statement which ought in fairness to be considered contemporaneously with it." Fed. R. Evid. 106. The context of a witness's statements "ought in fairness" to be considered "contemporaneously" when evaluating the witness's testimony. It would be helpful to the Board to have context-providing statements identified by the adverse party, and we see little value in deferring such identification to the oral hearing; the Board routinely considers the entire record in preparation for the oral hearing.

Accordingly, we authorize Patent Owner to file, as an exhibit, a chart that identifies portions of deposition testimony that provide context for portions relied on by Petitioner in its Replies. The identifications shall be by page and line number, and no additional statement or explanation is authorized.

Third, Petitioner's Replies cite excerpts of deposition testimony of Dr. Ehsani taken before Patent Owner filed its Response. Patent Owner requests authorization to provide observations on cross-examination of Dr. Ehsani's testimony. The Office Patent Trial Practice Guide contemplates that observations on cross-examination may be authorized "[i]n the event that

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cross-examination occurs after a party has filed its last substantive paper on an issue.” 77 Fed. Reg. 48,767 (Aug. 14, 2012). We see insufficiently compelling reason for an exception in this instance. Patent Owner was able to file its Patent Owner Response after cross-examination of Dr. Ehsani occurred. Accordingly, the request is denied.

It is

ORDERED that the party that first relied or relies on any citation to a deposition transcript shall file the full transcript of that deposition as an exhibit;

FURTHER ORDERED that Patent Owner is authorized to file, as an exhibit, a chart that identifies portions of deposition testimony that provide context for portions relied on by Petitioner in its Replies; and

FURTHER ORDERED that Patent Owner’s request for authorization to provide observations on cross-examination of Dr. Ehsani’s testimony is *denied*.

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