

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

UNIFIED PATENTS INC.,  
Petitioner,

v.

DIGITAL STREAM IP, LLC,  
Patent Owner.

---

Case IPR2016-01749  
Patent 6,757,913 B2

---

Before MICHAEL J. FITZPATRICK, STACEY G. WHITE, and  
MICHELLE N. WORMMEESTER, *Administrative Patent Judges*.

FITZPATRICK, *Administrative Patent Judge*.

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

We held a conference call today with counsel for each party and Mr. Kevin Jakel of Unified Patents. The call was requested by Patent Owner to discuss its request to cross-examine Mr. Jakel on his testimony set forth in Exhibit 1012. Petitioner declined to produce Mr. Jakel for a deposition voluntarily on the theory that Exhibit 1012 is not an affidavit within the meaning of 37 C.F.R. § 42.51(b)(1)(ii), which Rule provides for the cross-examination of affiants as part of routine discovery.

Exhibit 1012 is titled “Petitioner’s Voluntary Interrogatory Responses.” Despite its format, we find that it constitutes an affidavit for purposes of 37 C.F.R. § 42.51(b)(1)(ii). “Affidavit means affidavit *or declaration*” wherever used in Part 42 of the Rules. *See* 37 C.F.R. § 42.2 (emphasis added). At the end of the interrogatory responses, Exhibit 1012 includes a “Verification” in which Mr. Jakel includes the following language taken from 28 U.S.C. § 1746: “I declare under penalty of perjury that the foregoing is true and correct.” Ex. 1012, 8; 28 U.S.C. § 1746(2). Thus, we find that Exhibit 1012 is a declaration and, therefore, it is an affidavit as that term is used in 37 C.F.R. § 42.51(b)(1)(ii).

As the panel decided during the conference call, in lieu of producing Mr. Jakel for cross-examination, Petitioner is authorized to file a motion—without arguments—to withdraw Exhibit 1012 in its entirety.

Accordingly, it is

ORDERED that Petitioner may file a motion to withdraw Exhibit 1012 within two business day of this Order; and

FURTHER ORDER that, if Petitioner does not so move, Patent Owner promptly may depose Mr. Jakel.

IPR2016-01749  
Patent 6,757,913 B2

PETITIONER:

David Cavanaugh  
[David.cavanaugh@wilmerhale.com](mailto:David.cavanaugh@wilmerhale.com)

Dan Williams  
[Daniel.williams@wilmerhale.com](mailto:Daniel.williams@wilmerhale.com)

Jonathan Stroud  
[Jonathan@unifiedpatents.com](mailto:Jonathan@unifiedpatents.com)

PATENT OWNER:

Tarek Fahmi  
[Tarek.fahmi@ascendalaw.com](mailto:Tarek.fahmi@ascendalaw.com)

Jason LaBerteaux  
[Jason.laberteaux@ascendalaw.com](mailto:Jason.laberteaux@ascendalaw.com)