

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ASPHALT PRODUCTS UNLIMITED, INC.,  
Petitioner,

v.

BLACKLIDGE EMULSIONS, INC.,  
Patent Owner.

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Case IPR2017-01241 (Patent 7,503,724 B2)  
Case IPR2017-01242 (Patent 7,918,624 B2)

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Before MITCHELL G. WEATHERLY, JAMES A. TARTAL, and  
TIMOTHY J. GOODSON, *Administrative Patent Judges*.

GOODSON, *Administrative Patent Judge*.

ORDER

Granting Petitioner's Request for Authorization to  
File Motion for Additional Discovery  
*37 C.F.R. § 42.51(b)(2)*

On February 21, 2018, the panel held a conference call with counsel for the parties to discuss Petitioner's request for authorization to file a motion for additional discovery. The additional discovery Petitioner seeks is a deposition of Mr. Roy B. Blacklidge, the sole named inventor of the patents challenged in these proceedings, U.S. Patent Nos. 7,503,724 ("the '724 patent") and 7,918,624 ("the '624 patent") (collectively "the

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Challenged Patents”). *See* Ex. 1001, (75).<sup>1</sup> A declaration from Mr. Blacklidge was submitted during prosecution of the ’724 patent, and Patent Owner submitted that declaration and referred to it in the Patent Owner Response in these proceedings. *See* Ex. 2081; Paper 32, 60–61, 64–66. In its email requesting the conference call, Petitioner stated that the “requested deposition would be restricted to the topics covered in Mr. Blacklidge’s declaration.” Petitioner arranged for a reporter to transcribe the call, and indicated that it would file the transcript as an exhibit in these proceedings.

During the call, Patent Owner explained that it opposes Petitioner’s request on the grounds that Petitioner has not shown why a deposition would be in the interests of justice, considering that Mr. Blacklidge’s declaration was submitted more than ten years ago and it concerned events that took place years before that. In addition, Patent Owner expressed its concern that the declaration was quite lengthy and Patent Owner relied on only a small portion of the declaration in its Patent Owner Response, such that further clarification or limitations on the issues to be covered in the deposition may be necessary.

After considering the arguments presented on the conference call, we authorize Petitioner to file a motion for additional discovery of no more than five pages. Patent Owner is authorized to file an opposition, which also must not exceed five pages. No reply is authorized at this time. In their briefs, the parties should address the factors set forth in the Board’s decision

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<sup>1</sup> For expediency, citations in this Order refer only to the record in IPR2017-01241.

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in *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, slip op. at 6–7 (PTAB Mar. 5, 2013) (Paper 26) (precedential).

We also note that, as discussed on the call, Mr. Blacklidge was deposed in Cases IPR2016-01031 and IPR2016-01032, which proceedings concerned the same Challenged Patents. During that deposition, Mr. Blacklidge was questioned about the declaration from the prosecution history of the '724 patent. Petitioner indicated on the call that the Federal Rules of Evidence may constrain Petitioner's ability to use the deposition transcript from the earlier proceedings in these proceedings. However, Patent Owner stated that it does not oppose Petitioner's use of that transcript in these proceedings. Although Petitioner stated a preference to ask its own questions rather than rely on a transcript of a deposition conducted by another party, Patent Owner's concession suggests a possible avenue for compromise. Against this backdrop, it would be helpful for Petitioner to address in its motion why another deposition of Mr. Blacklidge is appropriate considering the availability of the earlier deposition transcript covering the same proposed topic.

For the foregoing reasons, it is

ORDERED that Petitioner is authorized to file, no later than Wednesday, February 28, 2018, a motion for additional discovery not to exceed five pages; and

FUTHER ORDERED that Patent Owner is authorized to file, no later than one week after the date on which Petitioner files its motion for additional discovery, an opposition not to exceed five pages.

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PETITIONER:

Robert Waddell

Michael K. Leachman

JONES WALKER LLP

[rwaddell@joneswalker.com](mailto:rwaddell@joneswalker.com)

[mleachman@joneswalker.com](mailto:mleachman@joneswalker.com)

PATENT OWNER:

John F. Triggs

Ryan D. Levy

Seth R. Odgen

PATTERSON INTELLECTUAL PROPERTY LAW, P.C.

[jft@iplawgroup.com](mailto:jft@iplawgroup.com)

[rdl@iplawgroup.com](mailto:rdl@iplawgroup.com)

[sro@iplawgroup.com](mailto:sro@iplawgroup.com)