

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MINIATURE PRECISION COMPONENTS, INC.,
Petitioner,

v.

EAGLE INDUSTRIES, INC.,
Patent Owner.

Case IPR2017-01403
Patent 8,205,592 B2

Before MICHAEL W. KIM, JAMES A. WORTH, and
RICHARD H. MARSCHALL, *Administrative Patent Judges.*

MARSCHALL, *Administrative Patent Judge.*

DECISION

Denying Patent Owner's Motion to Submit Observations
37 C.F.R. § 42.71

Introduction

On July 30, 2018, Patent Owner filed a Motion for Leave to Submit Observations on Deposition Examination. Paper 22 (the “Motion”). The Motion seeks leave to file observations related to the deposition of Dr. Marc Herrmann, Patent Owner’s own declarant. *Id.* at 1.

On August 13, 2018, Petitioner contacted the Board to request a conference call to discuss a dispute over the propriety of Patent Owner’s Motion. Petitioner contends that the Motion lacks merit and fails to comply with our rules and precedent, because a party cannot file observations in this context, where Petitioner’s Reply did not include a reply witness and the Motion relates to cross-examination of Patent Owner’s own witness. The parties met and conferred on the matter, but could not reach agreement.

For the reasons set forth below, the Motion is *denied*.

Analysis

Patent Owner’s Motion for Leave

Patent Owner’s Motion suffers from a fatal flaw. The Motion seeks *leave* to file a motion—to submit observations—yet Patent Owner includes the observations within the Motion for leave to file the observations. *See* Paper 22, 2–6. In that sense, the Motion improperly presumes we have already granted Patent Owner’s Motion for Leave upon filing the Motion. *See* 37 C.F.R. § 42.20(b) (“*Prior Authorization*. A motion will not be entered without Board authorization.”). Although motions for observation of a *reply witness* do not require prior authorization, Patent Owner does not seek leave to file observations regarding such a witness—it seeks to file observations regarding the testimony of its own witness. Paper 22, 1. The Scheduling Order in this case implicitly pre-authorized the filing of a motion

for observations, but only for the situation involving observations regarding a reply witness: “[o]bservation on cross-examination provides the parties with a mechanism to draw the Board’s attention to relevant cross-examination testimony of a *reply witness* because no further substantive paper is permitted after the reply.” Paper 9, 5 (emphasis added).

Our rule requiring a motion for leave prior to filing a motion helps ensure that movants are not able to submit arguments and evidence on the record, without permission, when the facts and circumstances do not warrant it. Patent Owner has done so here, by submitting substantive observations on cross-examination within its filing, without prior permission to do so. We, therefore, deny Patent Owner’s Motion based on this procedural deficiency alone.

Even if we consider the merits of Patent Owner’s Motion, we are not persuaded that the situation here warrants departure from our usual practice of allowing observations on cross-examination from the party taking the cross examination of a reply witness. Patent Owner acknowledges that its request to file observations represents a departure from the typical practice, but does not explain adequately why that rule should not apply here. Paper 22, 1. The mere fact that the deposition of Patent Owner’s witness, and the use of that testimony in Petitioner’s Reply, occurred after Patent Owner filed its Patent Owner Response does not justify allowing the observations here. Patent Owner should have been aware of their own declarant’s testimony, and also should have been aware that their declarant would be subject to cross-examination. The very nature of cross-examination is such that an opposing party attempts to illicit testimony unfavorable to the advancing

party. Put another way, each party advances the testimony of their own declarant at their peril.

Moreover, Patent Owner is incorrect that it has “no other way to bring relevant testimony from Dr. Herrmann’s deposition to the Board’s attention.” Paper 22, 1. For example, Patent Owner can respond to any alleged mischaracterizations of the testimony in Petitioner’s Reply by bringing those mischaracterizations, and any supporting testimony from the deposition, to our attention at oral argument.

Exhibits 1012 and 1013

In the Motion and Petitioner’s request, the parties presume that the deposition transcript in question, Exhibit 1012, has been made of record in this proceeding. *See* Paper 22, 1. Our records do not indicate that either party has filed Exhibit 1012 or Exhibit 1013, even though they are referred to by Petitioner in the Petitioner’s Reply as if they were already filed by Petitioner. *See* Paper 21 (Petitioner’s Reply), iii. Although neither party has requested leave to file these Exhibits late, we *sua sponte* address the issue and find that it is in the interest of justice to allow for the late filing of Exhibits 1012 and 1013 by Petitioner. *See* 42 C.F.R. §§ 42.5(b), 42.5(c)(3). Among other reasons, Petitioner relies on these Exhibits expressly in their Reply, Patent Owner is clearly aware of these Exhibits, and we are at a point in the proceeding where we are unable to perceive appreciable prejudice to any party or the Board in allowing the Exhibits to be entered.

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Order

It is ORDERED that Patent Owner's Motion for Leave to Submit Observations on Deposition Examination (Paper 22) is *denied*; and

It is FURTHER ORDERED that Petitioner shall file Exhibits 1012 and 1013 within one week of the date of this Order.

For PETITIONER:

John S. Artz
Bryan J. Schomer
DICKINSON WRIGHT PLLC
jsartz@dickinsonwright.com
bschomer@dickinsonwright.com

For PATENT OWNER:

Jacob D. Koering
CANFIELD, PADDOCK & STONE
koering@millercanfield.com