

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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DONGHEE AMERICA, INC. and DONGHEE ALABAMA, LLC,  
Petitioner,

v.

PLASTIC OMNIUM ADVANCED INNOVATION AND RESEARCH,  
Patent Owner.

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Case IPR2017-01633 (Patent 6,866,812 B2)  
Case IPR2017-01647 (Patent 6,814,921 B1)

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Before MITCHELL G. WEATHERLY, CHRISTOPHER M. KAISER, and  
ROBERT L. KINDER, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

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

Patent Owner contacted the Board by email requesting that we  
“compel Petitioners to make their declarant available for deposition on  
August 30.” Ex. 3001. The declarant in question appears to be Dr. David O.  
Kazmer, whose declaration Petitioner filed along with its Reply in each of

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these proceedings. *Id.* Patent Owner’s email to the Board contained a response from Petitioner arguing that it need not make Dr. Kazmer available for deposition because Dr. Kazmer has already been deposed once in this proceeding and once in the District Court litigation between the parties and because there will be no opportunity for Patent Owner to introduce Dr. Kazmer’s deposition testimony into these proceedings. *Id.*

*Inter partes* review proceedings have always provided the opportunity for patent owners to introduce the deposition testimony of witnesses who submit declarations in support of petitioners’ replies. Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,767–68 (Aug. 14, 2012) (“In the event that cross-examination occurs after a party has filed its last substantive paper on an issue, . . . [t]he Board may authorize the filing of observations to identify such testimony.”). In these proceedings, we expressly provided for such a motion for observations as part of the trial schedule. Paper 8, 5, 6, 8; Paper 10, 5, 7.

The Board recently introduced a new update to the Office Patent Trial Practice Guide. 83 Fed. Reg. 39,989 (Aug. 13, 2018). In that update, motions for observation are replaced with sur-replies. Trial Practice Guide Update (August 2018) 14–15, available at [https://www.uspto.gov/sites/default/files/documents/2018\\_Revised\\_Trial\\_Practice\\_Guide.pdf](https://www.uspto.gov/sites/default/files/documents/2018_Revised_Trial_Practice_Guide.pdf). Consistent with that update, Patent Owner here requested authorization to file Sur-Replies in these proceedings. Ex. 3001. We authorized Sur-Replies in lieu of motions for observations. *Id.*

In our email authorizing Sur-Replies, we stated that the Sur-Replies “shall not be accompanied by any new evidence.” *Id.* That statement was in error. It appears that our error caused Petitioner to think that Patent Owner

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would have no means to introduce any testimony resulting from any future deposition of Dr. Kazmer, which caused Petitioner to assume that Dr. Kazmer need not be made available for deposition. We did not intend this result.

All “affidavit testimony prepared for [an *inter partes* review] proceeding” is subject to cross-examination. 37 C.F.R. § 42.51(b)(1)(ii). This includes affidavits and declarations prepared for submission with a Reply, as suggested by the need for motions for observations discussed above. The Trial Practice Guide Update substituting Sur-Replies for motions for observations did not repeal or revise Rule 42.51(b)(1)(ii). Accordingly, Dr. Kazmer’s reply declaration is still subject to cross-examination by deposition. The fact that Dr. Kazmer has already been subject to one deposition does not change this conclusion because his first deposition constituted only cross-examination of his first declaration, not the required cross-examination of his reply declaration. It is unclear to us why the additional fact that Dr. Kazmer also has been deposed in the related infringement litigation should affect this proceeding at all. Indeed, should Petitioner refuse to make Dr. Kazmer available for deposition in order to allow cross-examination of his reply declaration, we would be inclined to give his reply declaration very little, if any, weight.

Accordingly, we order Petitioner to make Dr. Kazmer available for deposition. We leave the timing, length, and location of the deposition itself to the professional skill and good faith of the parties and their counsel.

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It is

ORDERED that Petitioner shall make Dr. David O. Kazmer available for the cross-examination by deposition of his reply declarations in both these proceedings; and

FURTHER ORDERED that the parties shall agree on a reasonable start time, end time, and location for Dr. Kazmer's deposition.

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