

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TRIPLE PLUS LTD.,

Petitioner

v.

MORDECHAI BEN OLD,

Patent Owner

U.S. Patent No. 9,671,031

Case No.: PGR2018-00038

**PETITIONER'S MOTION TO EXCLUDE PAPER 7
PURSUANT TO 37 C.F.R. 42.64(c)**

Patent Owner filed a Preliminary Response in the form of his declaration.¹ However, shortly after institution Patent Owner refused to participate in these proceedings—he did not submit a Response; he failed to respond to correspondence about routine discovery; and he failed to appear for his noticed deposition or to otherwise respond to efforts to arrange his deposition.²

Cross-examination by deposition of the other side’s declarant is routine discovery.³ The Patent Trial Practice Guide further states:

The burden and expense of producing a witness for redirect or cross-examination should normally fall on the party presenting the witness. Thus, a party presenting a witness’s testimony by affidavit should arrange to make the witness available for cross-examination.⁴

By failing to make himself available for cross-examination on the scope of his declaration, Patent Owner thwarted Petitioner’s routine discovery—preventing the development of a “fair record,” “meaningful discovery” and information Petitioner “reasonably need[ed] to respond” to the issues raised by Patent Owner’s declaration.”⁵

¹ Paper 7.

² Paper 10.

³ 37 Fed. Reg. 48756, 48761 (Aug. 14, 2012).

⁴ *Id.*

⁵ *Id.*

Accordingly, Patent Owner's declaration/Preliminary Response, Paper 7, should be disregarded and excluded.⁶

Dated: April 19, 2019

Respectfully submitted,

/s/ Mark C. Johnson

Mark C. Johnson, Reg. No. 51,854

mjohnson@rennerotto.com

Kyle B. Fleming (not yet admitted)

RENNER OTTO

1621 Euclid Avenue, Floor 19

Cleveland, Ohio 44115

T: 216-621-1113

F: 216-621-6165

Counsel for Triple Plus Ltd.

⁶ See, e.g., *1964 Ears, LLC. v. Jerry Harvey Audio Holding, LLC*, IPR2016-00494, Order, Paper 40 at p. 4. (“because Petitioner has been deprived [of] that routine discovery, the appropriate remedy is to strike and expunge Exhibits 2037 and 2038 from the record.”).

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. §§ 42.24 *et seq.*, the undersigned certifies that this
Petition complies with the 15 page limitation.

/s/ Mark C. Johnson

Mark C. Johnson, Reg. No. 51,854

mjohnson@rennerotto.com

RENNER OTTO

1621 Euclid Avenue, Floor 19

Cleveland, Ohio 44115

T: 216-621-1113

F: 216-621-6165

Counsel for Triple Plus Ltd.

CERTIFICATE OF SERVICE ON PATENT OWNER

I certify that the foregoing PETITIONER'S MOTION TO EXCLUDE PAPER 7 PURSUANT TO 37 C.F.R. 42.64(c) was served on the Patent Owner by electronic notification, as consented by Patent Owner:

meir@mdpattent.co.il

April 19, 2019

/s/ Mark C. Johnson

Mark C. Johnson, Reg. No. 51,854

mjohnson@rennerotto.com

RENNER OTTO

1621 Euclid Avenue, Floor 19

Cleveland, Ohio 44115

T: 216-621-1113

F: 216-621-6165

Counsel for Triple Plus Ltd.