

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VALEO, INC., VALEO S.A., VALEO GMBH, VALEO SCHALTER UND
SENSOREN GMBH, AND CONNAUGHT ELECTRONICS LTD.,
Petitioner,

v.

MAGNA ELECTRONICS, INC.,
Patent Owner.

Case IPR2014-00221 (Patent 7,991,522)
Case IPR2014-00227 (Patent 7,877,175)¹

Before JAMESON LEE, PHILLIP J. KAUFFMAN, and
MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

CLEMENTS, *Administrative Patent Judge*.

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.5

¹ This order addresses issues that are the same in all identified cases. We exercise our discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style heading in subsequent papers.

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A teleconference was held on Wednesday, November 12, 2014, among counsel for Petitioner, counsel for Patent Owner, and Judges Lee, Kauffman, and Clements. Counsel for Patent Owner requested the teleconference to seek guidance regarding (1) new evidence submitted with Petitioner's Reply in IPR2014-00221 and IPR2014-00227; and (2) whether it will be entitled to a deposition of a declarant if a declaration is filed in response to a Motion to Exclude, and if so whether the timing of the deposition can be arranged to not interfere with the Christmas Holiday. We discuss each in turn.

New Evidence

Patent Owner alleges that Petitioner relies upon new evidence in its Reply, and that the new evidence constitutes supplemental evidence. Patent Owner asks us to either expunge the new evidence from the record or require Petitioner to file a revised Reply omitting reference to the new evidence.

Petitioner contends that the evidence is not new, that it is directly responsive to arguments made by Patent Owner in its Patent Owner Response, that it is used only with respect to the credibility of Patent Owner's expert, and that it is not used to bolster the instituted grounds of unpatentability.

Patent Owner disagrees with Petitioner's characterization and notes further that, if the evidence was truly being relied upon to discredit its expert, Petitioner should have used it at the deposition of its expert.

We indicated that the Board will determine whether the new evidence is outside the proper scope of a reply when writing the final written decision. To preserve the issue in the words of the parties, we asked the Patent Owner

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to file a brief statement, limited to a single page, that identifies the new evidence introduced in Petitioner's Reply, and we asked Petitioner to file a brief response, limited to two pages, that identifies the portion of the Patent Owner Response to which the new evidence identified by Patent Owner is a proper response. Also, either party may bring up the subject at the time of oral hearing. If, while preparing the final written decision, we agree with the Patent Owner that the references are beyond the proper scope of a reply, then the Petitioner's new arguments will not be considered. If, on the other hand, the arguments and evidence are merely responsive to positions taken by the Patent Owner in its Patent Owner Response, then they are proper and will be considered.

Deposition of Declarant

Counsel for Patent Owner explained that it believes Broggi is not prior art. According to Patent Owner, it objected timely to Broggi. Petitioner then served Patent Owner with a declaration directed to the authenticity of Broggi. Patent Owner then objected timely to the declaration. Petitioner then served Patent Owner with a second declaration by the same declarant directed to the authenticity of Broggi. Patent Owner then objected timely to the second declaration. Patent Owner now intends to file a Motion to Exclude Broggi and expects that Petitioner will include the second declaration as an exhibit to its Opposition to Patent Owner's Motion to Exclude. Patent Owner seeks an order from the Board that it is entitled to depose the declarant either before its Motion to Exclude is filed or, alternatively, between the due date for the Opposition to Patent Owner's Motion to Exclude and due date for Patent Owner's Reply in support of its Motion to Exclude. Patent Owner indicated that it has not yet tried to

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depose the declarant because it believed it was not entitled to do so until Petitioner relied upon the declaration by entering it in the record.

Counsel for Petitioner contends that the evidence is self-authenticating, and that the declaration is merely a certification compliant with Federal Rule of Evidence 902(11). Counsel for Petitioner noted that she was not aware of any instances where the Board has authorized a deposition as to publication date, that Patent Owner has not cited any authority for the proposition it is entitled to a deposition for a FRE 902(11) certification, and that, in any event, the Board lacks subpoena power to compel third-parties to attend a deposition. Counsel for Petitioner further noted that at least one previous Board decision, *Liberty Mutual v. Progressive*, Case 2012-00010, Paper 59, has concluded that such documents are self-authenticating.

We decline to order Petitioner to make its declarant available for deposition at this stage of the proceeding. The declaration was not served recently. Although the declaration has not yet been filed in PRPS, Patent Owner has been in possession of the declaration at issue for some time, and was not precluded from pursuing a deposition of the declarant merely because Petitioner has not yet filed it. Cross-examination of the opposing party's declarants is provided for under routine discovery. *See* 37 C.F.R. § 42.51(b)(1)(ii); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,761 (Aug. 14, 2012).

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ORDER

It is

ORDERED that:

(1) no later than five (5) days after entry of this Order, Patent Owner is authorized to file a paper not exceeding one (1) page to identify the new evidence relied upon in Petitioner's Reply that it believes to be beyond the proper scope of a reply;

(2) no later than five (5) days after the filing of the above paper by Patent Owner, Petitioner is authorized to file a paper not exceeding two (2) pages to identify the portion of the Patent Owner Response to which the new evidence identified by Patent Owner is a proper response; and

(3) to the extent that either party files a request for rehearing of this Order, such request may not exceed five (5) pages.

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