Trials@uspto.gov
571-272-7822

Paper 44
Date: April 11, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUASAR SCIENCE LLC,
Petitioner,

v.

COLT INTERNATIONAL CLOTHING, INC. d/b/a COLT LED,
Patent Owner.

IPR2023-00613 (Patent 10,411,582 B1)
IPR2023-00614 (Patent 10,566,895 B1)[1]

Before GEORGIANNA W. BRADEN and ROBERT J. WEINSCHENK, *Administrative Patent Judges*.

WEINSCHENK, *Administrative Patent Judge*.

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

[1] This Order pertains to both of these cases. Therefore, we exercise our discretion to issue a single Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

I. INTRODUCTION

On April 9, 2024, Judges Braden and Weinschenk held a telephone conference call with counsel for Quasar Science LLC ("Petitioner") and counsel for Colt International Clothing, Inc. d/b/a Colt LED ("Patent Owner"). This Order summarizes statements made during the conference call.

II. ANALYSIS

Petitioner requested a conference call for guidance regarding the deposition of Patent Owner's declarant, Mr. Bruce Finn. According to Petitioner, Patent Owner stopped Mr. Finn's deposition because Petitioner's questions were allegedly outside the proper scope of cross-examination. During the conference call, Petitioner stated that the objected-to questions were directed to the prior art reference known as Ducharme in relation to the challenged claims. Patent Owner argued that the objected-to questions were inappropriate because they addressed portions of Ducharme not mentioned in Mr. Finn's declaration, as well as claim limitations not disputed by Patent Owner in these cases. Thus, according to Patent Owner, Petitioner was gathering information for the related district court litigation, not these cases.

Based on the information provided by the parties during the conference call, we instructed Patent Owner to allow Mr. Finn to answer Petitioner's questions about Ducharme's teachings in relation to the challenged claims. We noted that Mr. Finn's declaration indicates that he reviewed Ducharme and also provides opinions about whether Ducharme teaches certain limitations of the challenged claims. *See e.g.*, Ex. 2094 ¶ 18 ("I reviewed . . . the following materials . . . Ducharme"); *id.* ¶ 38 ("[O]ne with the knowledge and mindset of a person of ordinary skill in the art at the

time of the invention would have perceived Ducharme's combinations with other references as cited herein as unsuitable for commercial image capture.").[2]

Although we instructed Patent Owner to allow Mr. Finn to answer the objected-to questions, we did not determine whether any particular question is within the proper scope of cross-examination. We explained that during the continued deposition of Mr. Finn, Patent Owner may maintain its objections to specific questions as beyond the proper scope of the cross-examination by noting its objections on the record. *See* 37 C.F.R. § 42.64(a). We also explained that if Petitioner relies on answers to any questions for which Patent Owner maintained an objection on the record, Patent Owner may file a motion to exclude. *See* 37 C.F.R. § 42.64(c); Paper 9, 11 ("DUE DATE 5 . . . Motion to exclude evidence).

During the conference call, Patent Owner offered to withdraw Mr. Finn's declaration in lieu of continuing the deposition. We instructed the parties to meet and confer regarding Patent Owner's offer.

III. ORDER

It is hereby

ORDERED that the parties will continue the deposition of Mr. Bruce Finn in accordance with the instructions provided during the conference call and summarized above, unless otherwise agreed upon by the parties.

[2] We cite to the record in IPR2023-00613, unless otherwise noted.

For PETITIONER:

David M. Magee
Trenton Ward
GREENBERG TRAURIG, LLP
david.magee@gtlaw.com
trenton.ward@gtlaw.com

For PATENT OWNER:

David L. Hoffman
NOLAN HEIMANN LLP
dhoffman@nolanheimann.com

Everett Diederiks
Nicholas Whitelaw
DIEDERIKS & WHITELAW, PLC
ediederiks@dwpatentlaw.com
nwhitelaw@dwpatentlaw.com