

From: [Trials](#)
To: [Daniels, Scott](#)
Cc: [Cherry, Kevin](#); [Mayberry, James](#); [Trials](#)
Subject: FW: Conference call - today - March 5th- IPR2023-00954, -00959, -00995, -00996 – Request for Board Intervention
Date: Tuesday, March 5, 2024 2:04:46 PM

Good afternoon judges,

Please see below.

Thank you,
Esther

From: Squire, Monté T. <MTSquire@duanemorris.com>
Sent: Tuesday, March 5, 2024 2:01 PM
To: Trials <Trials@USPTO.GOV>
Cc: Tuttle, Kevin <ktuttle@spencerfane.com>; Rafatijo, Homayoon <hrafatijo@spencerfane.com>; Robinson, Erick <erobinson@spencerfane.com>; patdunn64@gmail.com; Elliott, Kyle L. <KElliott@spencerfane.com>; mbrockhaus@dunlapcoddling.com; Allee, J. Lori <JAllee@spencerfane.com>; dsorocco@dunlapcoddling.com; Woo, Philip <PWWoo@duanemorris.com>; McPherson, Patrick D. <PDMcPherson@duanemorris.com>; Belnap, Paul H. <PHBelnap@duanemorris.com>
Subject: RE: Conference call - today - March 5th- IPR2023-00954, -00959, -00995, -00996 – Request for Board Intervention

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To the Honorable Board,

Pursuant to the Board's instructions in its March 4 and 5 email correspondence, the parties hereby submit the following joint email in advance of the teleconference scheduled for March 5 (today) at 4 pm ET.

Petitioner's Statement of the Issue and Pertinent Facts

-

The Phantasy Star Online (PSO) Manual is asserted prior art for grounds challenging claims in IPR2023-00995 and IPR2023-00996. The issue concerns evidence relating to the PSO Manual and arose during the deposition of Petitioner's expert David Crane.

This dispute concerns Patent Owner's improper attempt keep out evidence and terminate a deposition of Petitioner's expert relating to a prior art reference, the *Phantasy Star Online* (PSO) Manual (IPR2023-00995 Ex-1008).

The PSO Manual is the basis of grounds for challenging claims in IPR2023-00995 and IPR2023-

IPR2023-00954, -00995
Ex. 3003

00996. While the Petition presents a multitude of evidence regarding the public availability of the PSO Manual as attested to by Petitioner's prior art searcher Alexander Harry (*see e.g.*, IPR2023-00995, EX1009), and the Board found that "Petitioner has shown sufficient circumstantial evidence to establish a reasonable likelihood of prevailing on its contention that the PSO Manual was publicly accessible" (IPR2023-00995, Paper 11, p. 30), Patent Owner has argued that: "Mr. Harry cannot offer testimony to confirm or deny whether multiple versions of the Manual were associated with the *Phantasy Star Online* game or whether the Manual was updated at different times to reflect corrections of errors or upgrades to the video game. *See e.g.*, IPR2023-00995, Patent Owner's Preliminary Response, Paper 9, p. 36.

The evidence at issue is a declaration from Yoshihiro Sakuta, the designer of the PSO Manual. Mr. Sakuta's declaration provides further independent confirmation that the PSO Manual was published in the United States before the priority dates of the challenged patents. Mr. Sakuta's declaration also addresses the issue raised by Patent Owner in its Patent Owner Preliminary Responses. In particular, Mr. Sakuta's declaration states *inter alia*: "No other version of the U.S. user manual for the *Phantasy Star Online* game was created. Nor was the U.S. user manual for the *Phantasy Star Online* game ever updated or revised."

At the deposition in question, Patent Owner's counsel asked Petitioner's expert witness, David Crane, "What did you do to prepare for your cross-examination today?" 2-26-2024 Hrg. Tr. 10:11-12. Mr. Crane testified in part that he reviewed a "declaration from a Mr. Sakuta, Yoshihiro Sakuta. And Yoshihiro Sakuta was the original author of that Phantasy Online manual that I used as one of my pieces of prior art, in which he testifies as to when that was created, when it was published, and such." *Id.*, 11:15-19. Mr. Crane further testified: "And I had the opportunity to actually speak by Zoom to Mr. Sakuta in the past week, and talked to him about the creation of that -- that manual for Phantasy Star Online." *Id.*, 11:23-12:1. After that testimony from Mr. Crane, Patent Owner's counsel thanked Mr. Crane for his "detailed answer" to the questioning. *Id.*, 12:2-3.

However, when Petitioner's counsel attempted to question Mr. Crane about Mr. Sakuta's declaration during the deposition, Patent Owner's counsel objected and refused to allow Mr. Crane to testify as to the declaration or to allow Mr. Sakuta's declaration to be entered as an exhibit to the deposition, and suspended the deposition disallowing any further redirect on that exhibit.

The Trial Practice Guide (TPG), Section II, K—with the heading "Challenging Admissibility; Motions to Exclude; Motions to Strike"—addresses the situation at hand. Section II, K of the TPG provides: "A party wishing to challenge the admissibility of deposition evidence must make an objection during the deposition. 37 C.F.R. § 42.64(a)." APPENDIX D to the TPG further provides: "2. An objection at the time of the examination -- whether to evidence, to a party's conduct, to the officer's qualifications, to the manner of taking the testimony, or any aspect of the testimony -- must be noted on the record, but *the examination still proceeds*; testimony is

taken subject to any such objection.” (emphasis added). In short, the TPG does not allow a party to halt a deposition, or unilaterally refuse the admission of evidence during a deposition just because that party wants to keep out the evidence. As such, the refusal by Patent Owner’s counsel to allow the further questioning of Mr. Crane regarding Mr. Sakuta’s declaration or to allow Mr. Sakuta’s declaration to be entered as an exhibit to the deposition was improper.

Patent Owner’s counsel cited to Point 9 of APPENDIX D to the TPG as providing a basis for counsel to terminate the examination. Point 9 of APPENDIX D is inapposite, as it essentially allows a party to move for a protective order to protect its witness from unreasonable harassment. Point 9 states: “At any time during the testimony, the witness or a party may move to terminate or limit the testimony on the ground that it is being conducted in bad faith or in a manner that unreasonably annoys, embarrasses, or oppresses the witness or party. The witness or party must promptly initiate a conference call with the Board to discuss the proposed motion. 37 C.F.R. § 42.20(b). If the objecting witness or party so demands, the testimony must be suspended for the time necessary to obtain a ruling from the Board, except as the Board may otherwise order.” Importantly, Point 9 of APPENDIX D does *not* allow a party to suspend a deposition for purposes of keeping out evidence that the party objects to for evidentiary reasons or otherwise wishes to exclude.

Patent Owner’s Statement of Pertinent Facts

IPR2023-00954, -959, 995, and 996 were instituted on December 11, 2023. Mr. Crane submitted a declaration and exhibits in support of the Petition as filed. Patent Owner filed and served objections to Petitioner’s evidence in all IPRs on December 26, 2023. Petitioner did not serve supplemental evidence.

Patent Owner began the deposition of Mr. Crane on February 26, 2024. In response to a question from Patent Owner, Mr. Crane indicated he spoke with and reviewed a declaration from a Mr. Yoshihiro Sakuta. Mr. Sakuta has not submitted direct testimony in support of the Petition, and the Sakuta declaration is not an exhibit to the Petition or Crane declaration as filed with the Petition.

The deposition continued for a second day, on February 29, 2024. Patent Owner concluded cross-examination on February 29th, and Petitioner began redirect examination. Petitioner attempted to introduce the Sakuta declaration, and Patent Owner objected on the record. The parties disagreed regarding the admissibility of the Sakuta declaration. Patent Owner requested that the deposition be suspended to seek Board intervention. Petitioner resumed, and concluded redirect examination on February 29th. Patent Owner concluded re-cross examination on February 29th. Patent Owner’s Response is due March 18th.

Brief Description of Patent Owner Arguments

Patent Owner can provide additional detail on the call with the Board; but in brief, the “certain evidence” is a declaration of Mr. Yoshiro Sakuta, and it is not relevant because it is not evidence in IPR2023-00954, -959, 995, and 996 (“Sony IPRs”). Petitioner did not contact the Board during the deposition of Mr. Crane to resolve this evidentiary dispute involving the Sakuta declaration and the deposition has since concluded rendering this evidentiary and relevancy issue moot. Admission of the Sakuta declaration at this time as evidence is prejudicial to Patent Owner.

The Sakuta declaration is not evidence in and thus not relevant to the Sony IPRs. The Sakuta declaration first appeared in the Sony IPRs at the transcribed deposition of Petitioner’s declarant, Mr. Crane, on February 26, 2024. The Sakuta declaration is new evidence proffered by Petitioner as it was not part of the Petition or exhibits filed by Petitioner, was not part of Mr. Crane’s uncompelled direct testimony filed with the Petition, and is thus beyond the scope of the Petition and Mr. Crane’s direct testimony. The Sakuta declaration was not served on Patent Owner as supplemental evidence in response to Patent Owner’s objections to evidence. Use of the Sakuta declaration as evidence in the Crane deposition is untimely, irrelevant to the direct testimony, and prejudicial to Patent Owner.

Petitioner did not resolve this dispute during the deposition of Mr. Crane, so this evidentiary and relevancy issue is moot. Cross-examination of Mr. Crane began on February 26, and continued on February 29th. During cross-examination of Mr. Crane, the deponent, in response to a question from Patent Owner, indicated he reviewed a declaration from a Mr. Yoshiro Sakuta. Patent Owner did not inquire further about the Sakuta declaration. During redirect examination, Petitioner attempted to introduce the Sakuta declaration as an exhibit, and Patent Owner objected on the record pursuant to Board Rules, the Consolidated Trial Practice Guide, and the Federal Rules of Evidence. The scope of cross-examination is limited to the scope of the direct testimony, and redirect examination is limited to the scope of cross-examination. The parties disagreed on the admissibility of the Sakuta declaration. Patent Owner indicated a call with the Board was needed to resolve the dispute. Petitioner did not contact the Board to resolve the dispute during redirect examination. Thereafter, Petitioner concluded redirect examination, and Patent Owner concluded re-cross examination, and the deposition of Mr. Crane concluded on February 29th. Mr. Crane did not state that he relied on the Sakuta declaration in the preparation of his declaration submitted with the Petition.

Sincerely,
Monté T. Squire
Counsel for Petitioner

Monté T. Squire
Partner

Duane Morris LLP

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From: Trials <Trials@USPTO.GOV>

Sent: Tuesday, March 5, 2024 7:56 AM

To: Trials <Trials@USPTO.GOV>; Squire, Monté T. <MTSquire@duanemorris.com>

Cc: Tuttle, Kevin <ktuttle@spencerfane.com>; Rafatijo, Homayoon <hrafatijo@spencerfane.com>; Robinson, Erick <erobinson@spencerfane.com>; patdunn64@gmail.com; Elliott, Kyle L. <KElliott@spencerfane.com>; mbrockhaus@dunlapcoddling.com; Allee, J. Lori <JAllee@spencerfane.com>; dsorocco@dunlapcoddling.com; Woo, Philip <PWWoo@duanemorris.com>; McPherson, Patrick D. <PDMcPherson@duanemorris.com>; Belnap, Paul H. <PHBelnap@duanemorris.com>

Subject: Conference call - today - March 5th- IPR2023-00954, -00959, -00995, -00996 – Request for Board Intervention

Counsel,

Correction: the conference call is scheduled for **today (March 5th) at 4 pm ET.**

IMPORTANT: No later than **2pm, Tuesday, March 5,** Petitioner shall send a joint email to the Board containing a detailed statement of the issue, pertinent facts on which the parties agree, and describing in detail the “certain evidence” upon which Petitioner desires Mr. Crane’s testimony.

Also in the email, Petitioner shall submit a brief explanation of the necessity for Mr. Crane’s testimony on this issue, and why the evidence and testimony is relevant in this proceeding. Patent Owner shall submit a brief description of their arguments as to why the evidence and Mr. Crane’s testimony is not relevant.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Trials <Trials@USPTO.GOV>

Sent: Monday, March 4, 2024 5:13 PM

To: Squire, Monté T. <MTSquire@duanemorris.com>; Trials <Trials@USPTO.GOV>

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<PWWoo@duanemorris.com>; McPherson, Patrick D. <PDMcPherson@duanemorris.com>; Belnap, Paul H. <PHBelnap@duanemorris.com>

Subject: RE: IPR2023-00954, -00959, -00995, -00996 – Request for Board Intervention

Counsel,

A conference call with the Panel has been scheduled for **Tuesday, May 5, 4pm ET.**

The dial-in number is: 877-937-3589 and the passcode is: 1563929#.

IMPORTANT: No later than 2pm, Tuesday, May 5, Petitioner shall send a joint email to the Board containing a detailed statement of the issue, pertinent facts on which the parties agree, and describing in detail the “certain evidence” upon which Petitioner desires Mr. Crane’s testimony.

Also in the email, Petitioner shall submit a brief explanation of the necessity for Mr. Crane’s testimony on this issue, and why the evidence and testimony is relevant in this proceeding. Patent Owner shall submit a brief description of their arguments as to why the evidence and Mr. Crane’s testimony is not relevant.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Squire, Monté T. <MTSquire@duanemorris.com>

Sent: Monday, March 4, 2024 10:03 AM

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Subject: IPR2023-00954, -00959, -00995, -00996 – Request for Board Intervention

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To the Honorable Board,

Petitioner respectfully requests the Board’s intervention and permission to proceed with the deposition of Petitioner’s declarant David Crane, which was suspended in part on Thursday evening, February 29 by Patent Owner’s counsel during Petitioner’s redirect examination of

the witness due to Patent Owner's objection to Petitioner's use of certain exhibits during the redirect examination.

The parties conferred regarding this dispute both on and off the record at Mr. Crane's deposition, but were unable to reach resolution.

Patent Owner's statement of the issue:

Patent Owner objects to Petitioner's characterization of the issue as being substantive argument. Patent Owner opposes Petitioner's request. If the Board desires a call, the subject matter of the dispute is an evidentiary issue that occurred during Patent Owner's deposition of Petitioner's declarant. Patent Owner concluded cross-examination and re-cross examination, and Petitioner concluded redirect examination.

Should the Board desire a conference call with the parties, respective counsel for the parties are available for a conference call during the following times:

Tuesday, March 5, 11 am – 12 pm ET or 4-5 pm ET

Wednesday, March 6, 10 am – 12 pm ET or 3-5 pm ET

Sincerely,

Monté T. Squire

Counsel for Petitioner

Monté T. Squire

Partner

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