

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY INTERACTIVE ENTERTAINMENT LLC,
Petitioner,

v.

QUANTUM IMAGING LLC,
Patent Owner.

IPR2023-00954 (Patent 8,458,028 B2)¹
IPR2023-00959 (Patent 10,255,724 B2)
IPR2023-00995 (Patent 10,846,941 B2)
IPR2023-00996 (Patent 10,991,165 B2)

Before SCOTT A. DANIELS, KEVIN W. CHERRY, and
JAMES J. MAYBERRY, *Administrative Patent Judges*.

DANIELS, *Administrative Patent Judge*.

ORDER
Conduct of Proceeding
37 C.F.R. § 42.10

¹ This Order addresses issues that are the same in each of the identified proceedings. We exercise our discretion to issue one Order to be entered in each of the proceedings. The parties are not authorized to use this style caption unless later permitted.

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I. BACKGROUND

On March 4, 2024, the Board received an email from Petitioner’s counsel, Monté T. Squire, requesting a conference call with the Board. Ex. 3004.² Petitioner explained that the deposition of Petitioner’s declarant, Mr. David Crane, “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.” *Id.* (emphasis added). Responsive to a subsequent email request from the Board, on Tuesday, March 5, 2024, the parties submitted a follow-up joint email, including both parties’ respective summaries of the circumstances and arguments surrounding the suspension of the deposition. *Id.* The Panel, Judges Daniels, Cherry, and Mayberry, conducted a conference call with the parties’ counsel on March 5, 2024 after receiving the requested joint email. In addition to the Panel, the conference call included Mr. Squire for Petitioner, and Mr. Kevin Tuttle and Mr. Douglas Sorocco for Patent Owner. No court reporter was engaged by the parties. We summarize the facts and circumstances of this disagreement below.

In IPR2023-00995 and IPR2023-00996, Petitioner relies on a reference entitled Phantasy Star Online (PSO) Manual (“PSO Manual”) for invalidity based on obviousness. Paper 2, 37–40 (“Petition” or “Pet.”); Ex. 1008. Patent Owner disputes the public availability of the PSO Manual.

² Unless otherwise noted, we refer in this Order only to the paper and exhibit numbers in IPR2023-00996.

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Paper 9 (“Patent Owner’s Preliminary Response” or “Prelim. Resp.”). In the March 5th joint email to the Board, Patent Owner explains that the *certain exhibits*, is a declaration by Mr. Yoshihiro Sakuta (the “Sakuta declaration”) which Petitioner alleges “provides further independent confirmation that the PSO Manual was published in the United States before the priority dates of the challenged patents.” Ex. 3004. The Sakuta declaration, which apparently originated in related district court litigation, is not currently in the record of these proceedings.

Petitioner explains that, during cross-examination, counsel for Patent Owner asked Mr. Crane “[w]hat did you do to prepare for your cross-examination today?” *Id.* In response to that question, Mr. Crane stated that he reviewed the Sakuta declaration. *Id.* According to Petitioner, Mr. Crane testified further that “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.*

In the joint email, for its part, Patent Owner describes that during redirect “Petitioner attempted to introduce the Sakuta declaration, and Patent Owner objected on the record.” *Id.* Patent Owner argues that “[t]he Sakuta declaration first appeared in the[se proceedings] at the transcribed deposition of Petitioner’s declarant, Mr. Crane, on February 26, 2024 . . . 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.” *Id.*

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The parties' joint email goes on to explain that counsel disagreed as to the admissibility of the Sakuta declaration and that Patent Owner's counsel refused to allow Mr. Crane to testify as to the Sakuta declaration, and refused to allow entry of the Sakuta declaration as an exhibit to the deposition. *Id.* Apparently, because of the late hour at which this dispute occurred during the deposition of Mr. Crane on the west coast, the deposition was suspended without further redirect on the Sakuta declaration. The parties explained during the conference call with the Panel that the deposition was complete, except for Petitioner's desire to ask Mr. Crane questions regarding the Sakuta declaration.

During the conference call, Mr. Squire requested the Board's authorization to continue the deposition of Mr. Crane for an additional two hours to question Mr. Crane regarding the Sakuta declaration. Mr. Sorocco argued against continuation of the deposition arguing that the Sakuta declaration amounts to supplemental evidence that hasn't been timely submitted or properly admitted. Mr. Sorocco also noted that Patent Owner has not had an opportunity to depose Mr. Sakuta. When asked if he would provide Mr. Sakuta for cross-examination, Mr. Squire indicated that Petitioner does not have "control" over Mr. Sakuta, who resides in Japan, and it would be difficult to make Mr. Sakuta available to Patent Owner for deposition. Despite this, Mr. Squire argued that the appropriate procedure would be to continue the deposition and to allow entry of the Sakuta declaration as a deposition exhibit, along with Mr. Crane's testimony, and that Patent Owner could then file a motion to exclude evidence.

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II. ANALYSIS

The Sakuta declaration has not been entered as an exhibit in any of the above-captioned proceedings. Based on the parties' description of events at the deposition of Mr. Crane, it appears to be undisputed that Petitioner's counsel attempted to introduce the Sakuta declaration for the first time during Petitioner's redirect examination of Mr. Crane, (albeit after relying on Mr. Crane's statement that he reviewed the Sakuta declaration to prepare for his deposition).

The Board's Trial Practice Guide ("TPG") provides, on one hand, that an objection to evidence or manner of taking testimony "must be noted on the record, but the examination still proceeds; testimony is taken subject to any such objection." TPG, 128. On the other hand, it also explains that "[c]ounsel may instruct a witness not to answer only when necessary to preserve a privilege, to enforce a limitation ordered by the Board, or to present a motion to terminate or limit the testimony." *Id.* at 129.

The tradition in the federal courts has been to limit the scope of redirect examination to the subject matter brought out on cross-examination. *United States v. Riggi*, 951 F.2d 1368, 1375 (3d Cir. 1991). Such redirect may be "used to rebut false impressions arising from cross-examination." *United States v. Bilzerian*, 926 F.2d 1285, 1296 (2d Cir. 1991). However, "[w]hen a party opens up a subject, even though it may not be strictly relevant to the case, he cannot complain . . . if the opposing party introduces evidence on the same subject." *United States v. Carter*, 720 F.2d 941, 948 (7th Cir. 1983) (citation omitted)

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Petitioner acknowledges that Patent Owner's counsel did not ask any substantive questions about prior art status of the PSO Manual or the Sakuta declaration during cross-examination. Indeed, Petitioner had not even identified the Sakuta declaration to Patent Owner before the deposition. Nor does Petitioner contend that Patent Owner asked any questions that might have created a false impression regarding the prior art status of the PSO Manual. Accordingly, it was improper for Petitioner to attempt to introduce the Sakuta declaration as a deposition exhibit during redirect examination of Mr. Crane. Patent Owner's question posed to Mr. Crane was simply "[w]hat did you do to prepare for your cross-examination today?" This does not reasonably open the door to redirect testimony by Mr. Crane regarding the Sakuta declaration. Accordingly, even though Mr. Crane explained that he reviewed the Sakuta Declaration, absent Patent Owner's counsel raising the issue expressly, further redirect testimony regarding the Sakuta declaration was outside the proper scope of the deposition. *See* 37 C.F.R. § 42.61(a) ("Evidence that is not taken, sought, or filed in accordance with this subpart is not admissible.").

For these reasons, Petitioner's request to continue the deposition of Mr. Crane is denied. At the same time, we make no substantiative ruling regarding the potential admissibility of the Sakuta declaration. There may be opportunities for Petitioner to introduce the Sakuta declaration during the trial. *See Hulu LLC, v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29, pp 12–16, PTAB (Dec. 20, 2019).

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III. ORDER

Accordingly, it is

ORDERED that Petitioner's request to continue the deposition of Mr. Crane is *denied*; and

FURTHER that Patent Owner's objection to Mr. Crane's redirect testimony regarding the Sakuta declaration is *sustained*.

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