

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHENZHEN PINCAN TECHNOLOGY CO., LTD.,
Petitioner,

v.

THE RIDGE WALLET LLC,
Patent Owner.

IPR2024-00340
Patent 10,791,808 B2

Before WILLIAM V. SAINDON, JASON W. MELVIN, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEYERS, *Administrative Patent Judge*.

ORDER

Granting-in-Part Patent Owner's Motion to Strike
37 C.F.R. §§ 42.5(a), 42.12, 42.51(b)(1)(ii)

INTRODUCTION

On September 27, 2024, Patent Owner emailed the Board with a concern that Petitioner has not yet made its declarant, Dr. Cameron, available for deposition. *See generally* Ex. 3001. Patent Owner states that it first emailed Petitioner on August 18, 2024, requesting deposition dates for Dr. Cameron in September. *Id.* at 3. Patent Owner states further that Petitioner did not respond to its first email nor did it respond to seven additional emails sent thereafter with anything related to its request to make Dr. Cameron available for deposition. *Id.* However, according to Patent Owner, on September 25, 2024, Petitioner responded to Patent Owner with the following: “Please be advised that Shenzhen Pincan Technology Co., Ltd. intends to substitute its counsel in the ongoing IPR.” *Id.*

On September 30, 2024, the Board responded to Patent Owner’s email, “that the parties are free to stipulate to extensions to Due Date 1 (October 10, 2024)” and “[i]f the parties are unable to come to an agreement by October 2, the parties must reach out with mutually-available times and days for a conference call with the Board to be held this week.” Ex. 3001, 2. On October 15, 2024, Patent Owner again contacted the Board, via email, to note that the parties had agreed to extend Due Date 1 from October 10, 2024 to October 24, 2024, but that Patent Owner had still “not received a deposition date for Dr. Cameron” because “Petitioner’s counsel [was] apparently not even authorized to respond on behalf of its client at this time.” *Id.* at 1.

On October 17, 2024, a conference call was convened. Ben Weed appeared for Patent Owner and Tianyu Ju appeared for Petitioner. Judges Saindon, Melvin, and Meyers were present. During the conference call, Mr. Weed informed the Board that Petitioner had still not provided him with a

deposition date for Dr. Cameron. Ms. Ju responded that she was still unable to provide a deposition date for Dr. Cameron, but would have more instruction from Shenzhen Pincan Technology Ltd. later that day.¹

On October 18, 2024, an Order (Paper 23, “Order”) was entered by the Board instructing the parties that if Petitioner fails to provide deposition dates for Dr. Cameron by 5 PM ET on October 23, 2024, Patent Owner’s request to submit a motion to strike Dr. Cameron’s declaration on the basis of Petitioner not making her available for a deposition within a reasonable timeframe would be granted. Order 4. The Order also authorized Petitioner to file an Opposition to the Motion by 5 PM ET on November 7, 2024. *Id.*

On October 28, 2024, Patent Owner filed a Motion to Strike the Declaration of Dr. Cameron (Ex. 1003). Paper 24 (“Motion”). Petitioner did not elect to file its authorized Opposition.

DISCUSSION

Patent Owner “requests that the Board strike and expunge the Declaration of Dr. Kimberly Cameron (Exhibit 1003), as well as the Petition’s (Paper 1) reliance on the same, from the record in this proceeding.” Motion 1. Patent Owner contends that “Petitioner relies on the Cameron Declaration (Ex. 1003) in support of the Petition,” and as such, “cross-examination of Dr. Cameron on her relied-upon testimony is routine discovery under 37 C.F.R. § 42.51(b)(1).” *Id.* at 3 (citing *John’s Lone Star Distrib., Inc. v. Thermolife Int’l, LLC*, IPR2014-01201, Paper 31 at 3 (PTAB

¹ We note that Petitioner has not requested authorization to file a Motion to Withdraw from the representation of Petitioner. 37 C.F.R. § 42.10(e) (requiring Board authorization before counsel can withdraw from a proceeding).

May 13, 2015). According to Patent Owner, other than Petitioner’s counsel’s suggestion that “it may not be Petitioner’s counsel in the future,” “Petitioner has provided no reason for Dr. Cameron’s unavailability.” *Id.* at 5 (citing Ex. 3001, 3).

Patent Owner argues that “[b]ecause Dr. Cameron has not been made available for cross-examination, expungement of the Cameron Declaration is appropriate.” *Id.* at 4 (citing *John’s Lone Star*, IPR2014-01201, Paper 31 at 3). Patent Owner argues further that “[t]he portions of the Petition that find support in only Dr. Cameron’s opinions should also be expunged, and Petitioner should not be permitted to rely on Dr. Cameron’s opinions at all to help try to carry its burden of proof.” *Id.* at 4–5.

We are persuaded that the appropriate action here is to grant Patent Owner’s unopposed Motion to Strike the Declaration of Dr. Cameron (Ex. 1003) from the record.² Under authority of 35 U.S.C. § 316(a)(5), the Director has prescribed regulations “setting forth standards and procedures for discovery of relevant evidence including that such discovery shall be limited to . . . the deposition of witnesses submitting affidavits or declarations.” Routine discovery, as defined by our Rules, requires that when a party proffers a witness’s testimony by affidavit, that party must make the witness available for cross-examination by the other party. *See* 37 C.F.R. §§ 42.51–42.53. Our Consolidated Trial Practice Guide makes clear that “[d]iscovery is a tool to develop a fair record and to aid the Board in assessing the credibility of witnesses,” and that “a party presenting a witness’s testimony by affidavit should arrange to make the witness

² Although Patent Owner further requests that we expunge Exhibit 1003 (Motion 1, 5), we decline to do so in interest of maintaining a complete record upon any appeal.

available for cross-examination. This applies to witnesses employed by a party as well as experts and non-party witnesses.” CTPG 22–23.

We will not consider the declaration of Dr. Cameron without Petitioner making the witness available for the desired cross-examination by Patent Owner. *See, e.g., HTC Corp. v. NFC Tech, LLC*, IPR2014-01198, Paper 42, 3–5 (PTAB Nov. 6, 2015). We agree with Patent Owner that, under the circumstances, it would be improper for us to consider the declaration of Dr. Cameron without Petitioner making Dr. Cameron available for the cross-examination sought by Patent Owner. As discussed above, Patent Owner has made multiple requests, over an extended period of time, for Petitioner to make Dr. Cameron available for deposition, and without adequate explanation, Petitioner has failed to do so. *See Ex. 3001*, 1–2. Based on these circumstances, we determine that allowing the Cameron Declaration to remain in evidence and to be relied upon as support for Petitioner’s arguments against Patent Owner’s positions without cross-examination would not provide the fair record sought by the rules and would render the Board unable to assess the credibility of the witness. However, we deny Patent Owner’s request to strike or expunge portions of the Petition that rely on Dr. Cameron’s opinions. Motion 4–5.

Because Petitioner has not made Dr. Cameron available for cross-examination, Petitioner has failed to comply with the applicable rules in this proceeding, to Patent Owner’s detriment. We, therefore, grant Patent Owner’s Motion to Strike the declaration of Dr. Cameron (Ex. 1003), but deny Patent Owner’s Motion to the extent that we do not modify the Petition or expunge the declaration of Dr. Cameron (Ex. 1003). 37 C.F.R. § 42.12(a) and (b). Therefore, to the extent that Petitioner relies on Dr. Cameron’s

Declaration in its briefing, wholly or in-part, as evidence to support its argument, we give no weight to that reliance on the evidence.

ORDER

It is

ORDERED that Patent Owner's Motion to Strike is granted to the extent that we strike Exhibit 1003 but denied to the extent that we do not modify the Petition or expunge Exhibit 1003; and

FURTHER ORDERED that Exhibit 1003 is stricken from the record.

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