

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INCORPORATED,

Petitioner,

v.

NETWORK SYSTEM TECHNOLOGIES, LLC,
Patent Owner.

IPR2024-00343
Patent 7,594,052 B2

Before CHARLES J. BOUDREAU, JOHN R. KENNY, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

KENNY, *Administrative Patent Judge*.

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

Via email, the parties requested a conference call to discuss a dispute regarding cross-examination of Mr. Gordon MacPherson, a declarant in this IPR. Ex. 3003. A conference call, however, is not needed because, based on the information the parties provided us, we can resolve this dispute via this Order.

Petitioner submitted, and relies on, a declaration from Mr. MacPherson (Ex. 1018) (“Declaration”). Paper 3, viii, 2. The parties indicate that Mr. MacPherson is an employee of IEEE, which will not allow Mr. MacPherson to appear for cross-examination without a subpoena. Ex. 3003.

Petitioner argues that Patent Owner has the burden of subpoenaing Mr. MacPherson for cross-examination. Ex. 3003. Patent Owner disagrees and seeks authorization to file a motion to strike the Declaration. *Id.*

To support its contention, Petitioner relies on two decisions from IPR proceedings in which a party seeking to cross-examine a declarant either moved or jointly moved for authorization to subpoena the declarant. Ex. 3003 (citing *Coastal Indus., Inc. v. Shower Enclosures Am., Inc.*, IPR2017-00573, Paper 27 (Feb. 20, 2018); *Johns Manville Corp. v. Knauf Insulation, Inc.*, IPR2015-01453, Paper 16 at 3 (PTAB Mar. 14, 2016)). Petitioner argues that, under 37 C.F.R. § 42.52(a), the party seeking to compel testimony must file a motion for authorization. *Id.* Petitioner suggests that this means that Petitioner is not obligated to seek a subpoena since it perceives no need for further testimony from Mr. MacPherson. *Id.* Petitioner also suggests that it cannot move for authorization to file a subpoena because it is not currently in its “discovery window.” *Id.*

We disagree with Petitioner. Cross-examination of a declarant constitutes routine discovery, so Petitioner should undertake efforts to make Mr. MacPherson available for cross-examination. 37 C.F.R.

§§ 42.51(b)(1)(ii), 42.12(b)(ii); Consolidated Trial Practice Guide¹ 23 (“[A] party presenting a witness’s testimony by affidavit should arrange to make the witness available for cross-examination. This applies to witnesses employed by a party as well as experts and non-party witnesses.”). Further, Petitioner risks having the Declaration excluded or not considered if it does not undertake such efforts. 37 C.F.R. § 42.12(b)(ii); *Coastal Indus.*, Paper 27 at 8–9;

In addition, neither IPR decision cited by Petitioner holds that the party seeking to cross-examine a declarant *must* move to subpoena the declarant. *Coastal Indus.*, Paper 27 at 4; *Johns Manville Corp.*, Paper 16 at 3. *Coastal Industries*, in fact, held that the party submitting the declaration “should consider that if a declarant is not available for cross-examination, the proponent of that testimony ‘runs the risk that the direct testimony will not be considered.’” *Coastal Indus.*, Paper 27 at 8–9 (quoting *Int’l Bus. Machs. Corp. v. Intell. Ventures II LLC*, Case IPR2015-01322, Paper 15 at 3 (PTAB Feb. 2, 2016)).

Because Mr. MacPherson requires a subpoena to appear for cross-examination, if Petitioner wants to rely upon the Declaration, Petitioner should file a motion to apply for a subpoena for Mr. MacPherson (“Motion”). We authorize Petitioner to file that Motion during the current discovery period. We encourage Patent Owner to join the Motion, but

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

authorize Patent Owner to file a Response to the Motion if joining is not feasible. The parties shall meet and confer before the due date for the Motion to determine what, if any, disputes the parties have regarding the Motion. If the Motion is granted and Petitioner continues to want to rely upon the Declaration, Petitioner should then apply under 35 U.S.C. § 24 for a subpoena for Mr. MacPherson from the Clerk of the appropriate United States district court.

The Motion and any Response shall be no more than five pages each. For the parties' benefit, if the Motion is granted, the Board will likely limit the authorized cross-examination and authorized redirect to sixty minutes and twenty minutes, respectively, given the Declaration's limited scope.

ORDER

It is

ORDERED that Petitioner and Patent Owner shall meet and confer regarding the Motion (described above) within FOUR business days of the issuance of this Order;

FURTHER ORDERED that Petitioner is authorized to file the Motion within SEVEN business days from the issuance of this Order;

FURTHER ORDERED that if Petitioner timely files the Motion, then Patent Owner is authorized to file a Response to the Motion within FOUR business days from the filing of the Motion (although Patent Owner is encouraged to join the Motion if feasible);

FURTHER ORDERED that the Motion and any Response shall be no more than five pages each;

FURTHER ORDERED that if Petitioner does not timely file the Motion, then Patent Owner is authorized to file a motion to exclude the

Declaration of no more than five pages within TEN business days from the issuance of this Order. Otherwise, Patent Owner is not authorized at this time to file a motion to exclude the Declaration; and

FURTHER ORDERED that if Petitioner does not timely file the Motion and Patent Owner timely files a motion to exclude the Declaration, then Petitioner is authorized to file a response to the motion to exclude of no more than five pages within SEVEN business days from the filing of the authorized motion to exclude.

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For PETITIONER:

J. Derek Vandenburg
Aaron W. Pederson
Nathan D. Louwagie
Ryan D. Rypka
CARLSON CASPERS VANDENBURGH & LINDQUIST, P.A.
dvandenburg@carlsoncaspers.com
apederson@carlsoncaspers.com
nlouwagie@carlsoncaspers.com
rrypka@carlsoncaspers.com

For PATENT OWNER:

Jennifer Hayes
Daniel S. Stringfield
Angelo J. Christopher
Hang Zheng
NIXON PEABODY LLP
jenhayes@nixonpeabody.com
dstringfield@nixonpeabody.com
achristopher@nixonpeabody.com
hzheng@nixonpeabody.com