**From:** Trials
**To:** Zhong, Annita; Weidenfeller, Scott; Garr, David; #PictivaIPR; SDC-Pictiva-IPR
**Cc:** Trials
**Subject:** RE: IPR2024-01094, -01095 Conference Call Request
**Date:** Friday, March 28, 2025 4:11:57 PM

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Counsel,

No call is necessary. While Dr. Garland's unavailability for cross examination may impact the testimony's weight, it does not mean the testimony must be withdrawn. Patent Owner is not authorized to file a motion to strike or terminate. From the parties' email, we do not understand Petitioner to be actually requesting permission to file testimony from another declarant at this time. If Petitioner wishes to make such a request, it should do so by contacting the Board.

Regards,

Franchesca I. Alicea Villanueva
Supervisory Paralegal
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

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**From:** Zhong, Annita <HZhong@irell.com>
**Sent:** Thursday, March 27, 2025 8:39 PM
**To:** Trials <Trials@USPTO.GOV>
**Cc:** Weidenfeller, Scott <SWeidenfeller@cov.com>; Garr, David <dgarr@cov.com>; #PictivaIPR <PictivaIPR@irell.com>; SDC-Pictiva-IPR <SDC-Pictiva-IPR@cov.com>
**Subject:** IPR2024-01094, -01095 Conference Call Request

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Dear Board,

It has come to Patent Owner's attention that Petitioner is unable to present one of its declarants, Dr. Rachel Garland of Elsevier, for cross examination in IPR2024-01094 and IPR2024-01095. Dr. Garland submitted a declaration after the petitions in those proceedings, and the Board relied on that declaration to find that it is plausible that a reference may qualify as prior art in at least IPR2024-01094. Last night, Petitioner represented that it had reached out to Elsevier to secure the deposition of the declarant, but had "nothing further to report" and that it "do[es] not have control over Elsevier or Dr. Garland." See attached email. It now represents that "we understand that Dr. Garland is unwilling to testify." See Samsung's statement below.

Routine discovery 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. 37 C.F.R. §§ 42.51–42.53; CTPG at 23-24 ("The burden and expense of producing a witness for redirect or cross-examination should normally fall on the party presenting the witness. Thus, 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.").

Petitioner also refuses to withdraw the declaration. Instead, it now seeks to rely on another declaration (see Petitioner's position below). Petitioner's inability or unwillingness to present a declarant who testimony was relied on for institution is an assault on Patent Owner's due process rights. In other cases where a party has failed to make its declarant available for cross-examination, the Board has found the appropriate remedy to be expungement. *See Shenzhen Pincan Tech., Co., Ltd. v. The Ridge Wallet, LLC*, Case IPR2024-00340 (P.T.A.B. Nov. 20, 2024), Paper 24 ("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 …."); *Abbott Vascular, Inc. v. FlexStent, LLC*, IPR2019-00882, Paper 48 at 34 (P.T.A.B. Oct. 2, 2020) ("[i]t would be manifestly unfair for [Ideahub] to affirmatively rely on the Declaration of [Mr. Lee]…while at the same time contending that it has no control over [Mr. Lee] and refusing to present him for deposition.").

Petitioner argues that its conduct is justified because it was a form declaration "whose contents do not appear to be in any reasonable dispute." The rules do not differentiate between form declaration versus non-form declaration. Moreover, contrary to Petitioner's assertion, Patent Owner does dispute the content of the alleged "form declaration." It is imperative that Petitioner present Dr. Garland for deposition.

Accordingly, Patent Owner seeks a conference call with the Board, including seeking authorization to file a motion to strike or expunge the declaration and/or a motion to terminate the IPRs since the Board's IPR decision relies on a declaration whose declarant is unwilling to be cross examined. As to Petitioner's request for file supplemental information, no good cause was shown in its original email and no good cause is shown here.

Patent Owner is available at the Board's convenience.

Petitioner's position:

Petitioner responds that Patent Owner's email is misleading and, in places, factually incorrect. Petitioner submitted a form declaration that the publisher Elsevier provides to explain the public availability of its publications. That declaration was signed by Dr. Garland of Elsevier, who resides in the United Kingdom. When Patent Owner requested to take a deposition of Dr. Garland, we inquired of Elsevier, but we understand that Dr. Garland is unwilling to testify. Petitioner does not think that cross-examination of Dr. Garland is necessary on this form declaration whose contents do not appear to be in any reasonable dispute, so Petitioner has not sought to compel her testimony. Without presenting argument, Petitioner respectfully directs the Board's attention to its decisions in *Mylan Pharms. Inc. v. Biogen MA Inc.*, IPR2018-01403, Paper 99 (Feb. 5, 2020); *Coastal Industries, Inc. v. Shower Enclosures Am., Inc.*, IPR2017-00573, Paper 27 (Feb. 20, 2018); and *Johns Manville Corp. v. Knauf Insulation, Inc.*, IPR2015-01453, Paper 16 (PTAB Mar. 14, 2016).

Petitioner has also sought to submit testimony from another declarant who is available for cross-examination, and who does not work for Elsevier. Petitioner has not, contrary to Patent Owner's assertion, "even sought the Board's authority to submit supplemental information (which appears to be further declaration(s) from Elsevier)." Petitioner respectfully requests that the additional testimony be added to the record, especially if Dr. Garland's testimony is not considered.

Respectfully,

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