

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PASCAL TECHNOLOGIES,
Petitioner,

v.

CAMBRIDGE ENTERPRISE LIMITED, UNIVERSITAT DE
BARCELONA, and UNIVERSITAT POLITÈCNICA DE CATALUNYA,
Patent Owner.

IPR2024-01235
Patent 11,230,656 B2

Before HYUN J. JUNG, CARL M. DeFRANCO, and
DEVON ZASTROW NEWMAN, *Administrative Patent Judges*.

NEWMAN, *Administrative Patent Judge*.

ORDER

*Conduct of the Proceeding; Authorizing Motion to Submit Supplemental
Information and Foreign Deposition
37 C.F.R. §§ 42.5 and 42.53*

On April 29, 2025, a conference call was held between counsel for Petitioner, counsel for Patent Owner, and a Board panel consisting of Judges Jung, DeFranco, and Newman. *See* Ex. 3001. Counsel and the panel discussed issues raised in an email received from Petitioner on April 24, 2025. *See id.*

*Petitioner's Request for Authorization to File
a Motion to Submit Supplemental Information*

The email from Petitioner “requests authorization to file a motion to submit supplemental information” where “[t]he information Petitioner seeks to submit consists of a supplemental declaration of Sylvia Hall-Ellis, Ph.D., and accompanying materials, served on Patent Owner as supplemental evidence on April 21, 2025.” *See* Ex. 3001. Petitioner submits that this “supplemental declaration addresses public availability of the prior art references upon which trial was instituted (Exs. 1006, 1007, 1009, and 1021),” thereby pertaining to “the first issue raised in Patent Owner’s request for direct review, filed on April 7, 2025, and Patent Owner’s objections to Petitioner’s evidence, also filed April 7, 2025.” *Id.* (citing Paper 8 at 20 n.5); *see also* Papers 10–11 (filed by Patent Owner on April 7, 2025).

Petitioner also indicates that Patent Owner has stated that it opposes Petitioner’s request for authorization to file such a motion to submit supplemental information. Ex. 3001.

After hearing the parties’ preliminary arguments regarding Petitioner’s request for authorization to file a motion for submission of supplemental information, the panel determines that additional briefing on

the issue would be of benefit in this proceeding. Petitioner's request for authorization to file the motion is, accordingly, *granted*.

Petitioner may accordingly file a Motion to Submit Supplemental Information under 37 C.F.R. § 42.123(b), not to exceed 5 pages. A motion for the late submission of supplemental information is governed by 37 C.F.R. § 42.123(b), which requires the movant to show why the supplemental information reasonably could not have been obtained earlier and that consideration of the supplemental information would be in the interests-of-justice. The Motion should therefore address these issues and also address subject and scope of the supplemental information Petitioner seeks to submit. In addition, we request that Petitioner file the supplemental information for which submission is sought, as an *attachment* to the Motion, not as an *exhibit*.

Patent Owner is authorized to file a response, not to exceed 5 pages, stating its reasons for opposing entry of the proposed supplemental information.

*Parties' Request for Authorization to Proceed with
a Deposition Outside the United States*

The email from Petitioner also submits the parties' "request that the Board authorize the parties to proceed with deposition outside the United States." *See* Ex. 3001. The email explains that Patent Owner seeks to depose Petitioner's expert witness, Dr. Mircea Dincă, who is currently on sabbatical in Spain, and that "[p]ursuant to 37 C.F.R. § 42.53(b)(3), the parties have met and conferred and reached agreement on a procedure for conducting cross-examination of Dr. Dincă in Barcelona, Spain on June 5, 2025." *Id.*

Rule 42.53 governs the taking of testimony, including cross-examination testimony. As Rule 42.53 notes, parties are generally required to make witnesses available for depositions in the United States. *See* 37 C.F.R. § 42.53(b)(2). Nevertheless, in light of the parties' cooperation in arranging Dr. Dincă's deposition, we waive the regulatory requirement that Dr. Dincă be deposed in the United States, and authorize her deposition to be taken in Spain. *See* 37 C.F.R. § 42.5(a), (b) (Board may determine a proper course of conduct for situations not specifically covered by regulations, and may waive or suspend regulations). 37 C.F.R. § 42.53(b)(3) states that "[u]ncompelled deposition testimony outside the United States may only be taken upon agreement of the parties or as the Board specifically directs." *See also Ariosa Diagnostics v. Isis Innovation Ltd.*, IPR2012-00022, Paper 55 (PTAB Aug. 7, 2013). Here, the parties indicate they have agreed to taking the deposition in a location outside of the United States (i.e., Spain, on June 5, 2025). Ex. 3001.

The parties are encouraged to review carefully the national laws and treaties which may apply to this deposition outside of the United States (e.g., relevant national laws, including any blocking statutes, as well as treaties such as the Hague Convention).

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's request to file a Motion to Submit Supplemental Information, which shall be limited to 5 pages, and identify with specificity each document to be submitted and its relevance to this proceeding, is *granted*;

FURTHER ORDERED that the Motion to Submit Supplemental Information shall be filed within seven calendar days from the date of this Order;

FURTHER ORDERED that the Motion shall have as attachment(s) the supplemental information for which submission is sought, but the supplemental information at issue shall not be filed as exhibits;

FURTHER ORDERED that Patent Owner is authorized to file an Opposition to Petitioner's Motion, limited to 5 pages, within seven calendar days of the filing date of Petitioner's Owner's Motion; and

FURTHER ORDERED that the conference call held on April 29, 2025, satisfies the requirements pursuant to 37 C.F.R. § 42.53(b)(3) for any future deposition in this matter taken outside the United States.

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