

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MITSUBISHI PLASTICS, INC.,
Petitioner,

v.

CELGARD, LLC,
Patent Owner.

Case IPR2014-00524
Patent No. 6,432,586

Before DONNA M. PRAISS and CHRISTOPHER L. CRUMBLEY,
Administrative Patent Judges.

CRUMBLEY, *Administrative Patent Judge.*

DECISION
Motion to Compel Testimony
37 C.F.R. § 42.52(a)

Pursuant to a request from Petitioner Mitsubishi Plastics, Inc. (“MPI”), the Board held a conference call with the parties on April 9, 2015, to discuss MPI’s

request to file a motion for authorization to compel the deposition of Mr. Premanand Ramadass. MPI's request was made jointly with SK Innovation Co. Ltd. ("SKI"), Petitioner in IPR2014-00679 and IPR2014-00680, and LG Chem, Ltd. ("LG"), Petitioner in IPR2014-00692. During the call, Patent Owner Celgard, LLC, stated that it did not oppose MPI, SKI, and LG's (collectively, "Petitioners") request, and would not oppose the motion for authorization to compel.

Accompanying its Patent Owner's Response in this case, Celgard submitted the direct testimony of Mr. Ramadass via a Declaration dated March 4, 2014. Ex. 2907. Petitioners explained during the call that while Mr. Ramadass was employed by Celgard when he executed his Declaration, he has since left the company and is now employed by Apple, Inc. Both Petitioners and Celgard represented to the Board that attempts had been made to secure Mr. Ramadass' cross-examination, but he was unwilling to attend a deposition voluntarily. Petitioners requested to file a motion authorizing it to compel testimony under 37 C.F.R. § 42.52(a), and noted that there was little time before the due date for MPI's Reply, currently set by stipulation of the parties as April 27, 2015. Paper 35.

"A party in a contested case may apply for a subpoena to compel testimony in the United States, but only for testimony to be used in the contested case. *See* 35 U.S.C. § 24. Section 42.52(a) requires the party seeking a subpoena to first obtain authorization from the Board; otherwise, the compelled evidence would not be admitted in the proceeding." Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions; Final Rule, 77 Fed. Reg. 48,612, 48,622 (Aug. 14, 2012).

The Board noted that, as Celgard had submitted Mr. Ramadass' testimony via declaration in this case, his deposition is considered to be routine discovery as defined by our Rules. 37 C.F.R. § 42.51(b)(1)(ii) ("*Routine Discovery*. . . . Cross

examination of affidavit testimony is authorized within such time period as the Board may set.”). Given that the requested discovery is routine and unopposed, and the short time remaining before Petitioners’ Replies are due, the Board hereby waives the requirement of 37 C.F.R. § 42.52(a) that Petitioners file a motion for authorization, describing the general relevance of the testimony and identifying the witness by name or title. *See* 37 C.F.R. § 42.5(b). The Board deems Petitioners’ request to be an oral motion for authorization to compel Mr. Ramadass’ testimony, and hereby *grants* the unopposed motion.

Our Rules set a default time limit for compelled testimony of four hours for cross-examination, and two hours for redirect examination. 37 C.F.R. § 42.53(c)(1). The parties did not request any deviation from this default rule. Petitioners may divide the four hours between them as desired, or may designate one party to conduct the cross-examination on behalf of all Petitioners. As Mr. Ramadass’ deposition is for the purposes of cross-examination of his direct testimony submitted as Exhibit 2907, the scope of the deposition is limited to the scope of his Declaration. 37 C.F.R. § 42.53(d)(5)(ii).

Finally, during the call, MPI requested an additional ten pages for its Reply Brief, for a total of twenty-five pages, consistent with United States Patent & Trademark Office Director Michelle K. Lee’s recent blog post¹ outlining rule adjustments for America Invents Act trial proceedings. We exercised our discretion to revise the page limit for Petitioner’s Reply Brief to reflect this change in the rules.

For the foregoing reasons, it is hereby:

ORDERED that MPI’s oral motion for authorization to compel the testimony of Mr. Premanand Ramadass is *granted*;

¹ http://www.uspto.gov/blog/director/entry/ptab_s_quick_fixes_for

FURTHER ORDERED that MPI is authorized to obtain a subpoena, pursuant to 35 U.S.C. § 24, from the United States District Court for the district where the testimony of Mr. Ramadass is to be taken;

FURTHER ORDERED that the scope of the subpoena shall be limited to cross-examination on the direct testimony provided in Exhibit 2907;

FURTHER ORDERED that the cross-examination is not to exceed four hours, shared among MPI, SKI and LG;

FURTHER ORDERED that Celgard is permitted to attend the deposition and conduct redirect examination not to exceed two hours; and

FURTHER ORDERED that pursuant to 37 C.F.R. § 42.5(b), the limit for MPI's Reply to Patent Owner's Response is hereby enlarged to twenty-five pages.

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