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Paper 24
Entered: July 7, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SMART MODULAR TECHNOLOGIES INC.,
Petitioner,

v.

NETLIST, INC.,
Patent Owner.

Case IPR2014-01372 (Patent 8,001,434 B1)
Case IPR2014-01374 (Patent 8,359,501 B1)[1]

Before LINDA M. GAUDETTE, BRYAN F. MOORE, MATTHEW R. CLEMENTS, and PETER P. CHEN, *Administrative Patent Judges.*

MOORE, *Administrative Patent Judge*.

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.5

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[1] This order addresses issues that are the same in both identified cases. We exercise our discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style heading in subsequent papers.

A conference call in the above proceedings was held on July 1, 2015. Counsel for Petitioner and Patent Owner participated in the call with Judges Gaudette, Moore, Clements, and Chen. The purpose of the call was to discuss a request by Patent Owner for authorization to seek a subpoena from a District Court and for an extension of the deadline to submit supplemental evidence.

DISCUSSION

Petitioner may (but does not have to) object to the admissibility of any evidence relied upon by the Patent Owner in support of the Patent Owner Response. 37 C.F.R. § 42.64(b)(1). Patent Owner may respond to the objection by serving supplemental evidence within ten business days of service of the objection. 37 C.F.R. § 42.64(b)(2). Additionally, the Board has discretion to extend discovery deadlines upon a showing of good cause. 37 C.F.R. § 42.5(c).

The applicable rule for compelled testimony and production of documents is 37 C.F.R. § 42.52(a), which provides:

> (a) Authorization required. A party seeking to compel testimony or production of documents or things must file a motion for authorization. The motion must describe the general relevance of the testimony, document, or thing, and must:
> (1) In the case of testimony, identify the witness by name or title; and
> (2) In the case of a document or thing, the general nature of the document or thing.

See 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) ("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.").

On the call, Patent Owner stated that it had included in its Patent Owner Response (filed June 16, 2015) one page of a transcript of a deposition of an expert, taken on February 12, 2015, in Cases IPR2014-00970 and IPR2014-00971, which contains responses related to the construction of the claim term "cause," which is also disputed in the instant IPRs. *See* Paper 22; Ex. 2018. Cases IPR2014-00970 and IPR2014-00971 involve Patent Owner and a different petitioner. Patent Owner indicated that, on February 19, 2015, Petitioner served an objection to the transcript claiming that the testimony was hearsay.

On the call, Patent Owner requested authorization to move for a subpoena in District Court to compel the expert to testify in the instant IPRs. Patent Owner indicated that it would ask questions to verify the answers given on the one page transcript of the expert's deposition. Patent Owner also asked for an extension of the ten-day deadline to submit supplemental evidence in response to an objection. The deadline to submit such evidence was July 6, 2015, the Monday after the conference call occurred.

Petitioner opposes Patent Owner's requests. On the call, Petitioner asserted that the entire transcript of the expert's deposition was submitted by Patent Owner, not just one page. Patent Owner further asserted that these IPRs were instituted on March 10, 2015, about a month after the deposition at issue occurred; therefore, according to Petitioner the deposition is hearsay. Petitioner argued that Patent Owner's request for subpoena to obtain a

deposition is untimely because discovery has closed. Petitioner further argued that Patent Owner made no attempt to obtain authorization to obtain a subpoena during the discovery period.

As an initial matter, the Panel did not hear arguments on the issue of hearsay because the matter has not been raised in a motion to exclude. We find that the issue of admissibility of the deposition transcript as well as the delay involved in seeking a deposition of the expert to cure any hearsay issue was foreseeable by Patent Owner. Thus, we do not find that there is good cause to extend the deadline to submit supplemental evidence. As such, we decline Patent Owner's request for an extension. We also decline to authorize Patent Owner to seek a subpoena to depose the expert.

Finally, we note that Petitioner has not filed a motion to exclude the evidence of the transcript based on a hearsay objection. If such motion is filed, Patent Owner may argue that the transcript is not hearsay.

ORDER

It is

ORDERED that Patent Owner's request for authorization to seek a subpoena is *denied*; and

FURTHER ORDERED that Patent Owner's request for an extension of the deadline to submit supplemental evidence is *denied*.

IPR2014-01372 (Patent 8,001,434 B1)
IPR2014-01374 (Patent 8,359,501 B1)

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