

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ADOBE INC.,  
Petitioner,

v.

RAH COLOR TECHNOLOGIES LLC,  
Patent Owner.

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Case IPR2019-00627 (Patent 7,729,008 B2)  
Case IPR2019-00628 (Patent 8,416,444 B2)  
Case IPR2019-00629 (Patent 7,312,897 B2)  
Case IPR2019-00646 (Patent 7,791,761 B2)<sup>1</sup>

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Before ELENI MANTIS MERCADER, FRANCES L. IPPOLITO, and  
JOHN A. HUDALLA, *Administrative Patent Judges*.

IPPOLITO, *Administrative Patent Judge*.

DECISION

Granting Patent Owner's Motion to Compel Testimony  
*37 C.F.R. § 42.52*

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<sup>1</sup> This Order addresses issues that are the same in the above-identified proceedings. We exercise our discretion to issue one Order to be entered in each proceeding. The Parties are not authorized to use this joint heading and filing style in their papers.

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### *I. Introduction*

On October 24, 2019, during the cross-examination of Petitioner’s declarant, Dr. Charles Poynton, the parties left a voicemail for the Board seeking guidance regarding the proper scope of Dr. Poynton’s deposition. A conference call was held on October 25, 2019, with respective counsel for the parties and Judges Mantis Mercader, Ippolito, and Hudalla. On the call, Patent Owner (“Patent Owner” or “RAH Color Technologies LLC”) asserted that Petitioner’s counsel improperly instructed Dr. Poynton not to answer certain questions based on attorney work product protections afforded by Rule 26 of the Federal Rules of Civil Procedure (FRCP). *See* Ex. 2106, 344:4–345:24; 348:4–20.<sup>2</sup> We authorized the parties to submit briefing on this issue. Paper 56, 6–7.

Subsequently, Patent Owner filed a Motion to Compel Routine Deposition Discovery Regarding Expert Opinion from Adobe’s Expert Dr. Poynton (Paper 48, “Mot.”) in each of the instant proceedings, and Petitioner Adobe Inc. (“Petitioner” or “Adobe”) filed an Opposition (Paper 50, “Opp.”).<sup>3</sup> For the reasons stated below, Patent Owner’s Motion is granted.

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<sup>2</sup> Public and non-public redacted versions of the transcript for Dr. Poynton’s deposition, including the transcribed call with the panel, have been submitted as Exhibit 2106. Patent Owner has filed a motion to seal portions of this transcript. Our citations refer to the public version of Exhibit 2106.

<sup>3</sup> *See* IPR2019-00627, Paper 56, 6–7; IPR2019-00628, Papers 49, 51, 57; IPR2019-00629, Papers 49, 51, 57; IPR2019-00646, Papers 46, 48, 55. Although the analysis herein applies to all four proceedings, we refer to the papers and exhibits filed in Case IPR2019-00627 for convenience.

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## II. Discussion

In all four of these proceedings, Patent Owner seeks to compel Dr. Poynton's responses to the following three (3) questions that were asked but not answered during cross-examination at his deposition:

1. Did Dr. Poynton perform any prior art search?
2. Did Dr. Poynton consider claim charts comparing the patent owner's patent claims to alleged prior art references (or invalidity arguments in another form) prior to Dr. Poynton signing Exhibit 1009?
3. Did Dr. Poynton determine that any reference, or combination of references, that Adobe provided to him did not render any of the 26 RAH Color Technologies patent claims obvious?

*See* IPR2019-00627, Mot. 1.

Patent Owner argues that it is permitted to cross-examine Dr. Poynton's testimony at deposition as part of routine discovery. Mot. 2 (*citing* 37 C.F.R. §§ 42.51(b)(1)(ii), 42.65; Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,761 (Aug. 14, 2012) ("TPG")). In this regard, Patent Owner asserts that the three questions above are directed to the "facts or data" underlying Dr. Poynton's testimony and "any relevant information that is inconsistent with Petitioner's positions." *Id.* (*citing* 37 C.F.R. § 42.65(a), 42.51(b)(1)(iii)). *Id.* at 2–3. Patent Owner contends that "[t]he 'facts or data' an expert considered is critical to testing the expert's independence, reliability, and credibility and the expert report's evidentiary value." *Id.* at 2–3 (*citing* 37 CFR § 42.65(a)). Patent Owner further argues that FRCP Rule 26 does not apply to IPR proceedings.

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Mot. 4–5. Additionally, Patent Owner argues that even if FRCP Rule 26 is instructive on the work product doctrine, FRCP Rule 26(a)(2)(B)(ii) and 26(b)(4)(C)(ii) “mandate disclosure of facts or data a party’s attorney provided to its expert and its expert considered.” Mot. 4.

In its Opposition, Petitioner argues that Patent Owner seeks to compel testimony about the preparation of Dr. Poynton’s declarations, which are not underlying facts or data for Dr. Poynton’s declaration. Opp. 1, 8–9 (“[P]rior art searches, invalidity claim charts, and communications about non-selected art are obviously not “facts or data.”). Petitioner further asserts that this information is protected by the attorney work product doctrine, and that Board rules exclude attorney work product from routine discovery. *See id.* at 1–5, 10 (“RAH has made no attempt to show why such nonroutine discovery should be allowed under the “interests of justice” standard of § 42.51(b)(2)(i).”). Citing *Pevarello v. Lan*, 85 U.S.P.Q.2d 1771, 2007 WL 594728 (BPAI 2007), Petitioner argues that these questions are a “waste of time” and a fishing expedition. *Id.* at 1, 5–7.

Based on the circumstances and the specific questions at issue, we determine that Patent Owner has the better position. Here, Patent Owner’s questions seek the underlying factual basis for Dr. Poynton’s testimony presented in his declarations. Questions 1–3 each seek information about whether Dr. Poynton reviewed or considered a document or documents (e.g. prior art search, claim chart, or references) in preparing his testimony. The questions do not seek the substance of any communication between Dr. Poynton and Petitioner’s attorneys and do not, for example, seek information regarding the specific content of any prior art search that may have been

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conducted or claim chart that may have been reviewed. Instead, these questions query what documents, i.e., facts, Dr. Poynton considered for his testimony.

Also, we are not persuaded by Petitioner that Patent Owner may only question Dr. Poynton about the prior art references on which review was instituted. *See* Opp. 6 (“None of the questions relates to the prior art references on which the Board instituted trial. None of the questions relates to reasons for combining the references. None of the questions relates to what ordinarily skilled artisans would have understood in the relevant timeframe.”). First, even if Petitioner contests the relevance of the questions, that alone is not a basis for instructing Dr. Poynton not to answer the question. *See* *TPG*, Appendix D (“4. Counsel may instruct a witness not to answer only when necessary to preserve a privilege, to enforce a limitation ordered by the Board, or to present a motion to terminate or limit the testimony.”). Second, we are not persuaded that an opposing party is somehow precluded from inquiring about the facts (e.g., prior art references) that a declarant considered and reviewed in preparing his testimony. These inquiries fall squarely within routine discovery permitted by our rules. *See* 37 C.F.R. § 42.51(b)(1)(ii) (permitting “[c]ross examination of affidavit testimony prepared for the proceeding”). During cross-examination, a party should expect that the underlying basis of its declarant’s testimony will be tested by the deposing side. As part of this testing, the factual bases of the declarant’s testimony must first be identified. Here, Questions 1–3 seek to do just that in identifying the information that Dr. Poynton reviewed and considered for his declaration testimony.

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We further note that our August 2018 Update to the Office Patent Trial Practice Guide explains that

[t]he Board has broad discretion to assign weight to be accorded expert testimony. *Yorkey v. Diab*, 601 F.3d 1279, 1284 (Fed. Cir. 2010). However, *the testimony must be based on sufficient facts and data*. Fed. R. Evid. 702(b). “*Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.*” 37 C.F.R. § 42.65(a). Furthermore, *the testimony must be the product of reliable principles and methods*. Fed. R. Evid. 702(c). Moreover, an expert must reliably apply the principles and methods to the facts of the case. Fed. R. Evid. 702(d).

Update to Office Patent Trial Practice Guide at 4 (Aug. 2018) (emphases added) (“TPG Aug. 2018 Update”).<sup>4</sup> In this way, our TPG Aug. 2018 Update informs parties that the reliability and credibility of expert testimony depends on whether the underlying facts or data of that testimony have been disclosed and explained. *Id.* Thus, per our rules (*see* 37 C.F.R. § 42.65(a)) and our guidance, the parties are encouraged to question the expert on the facts, data, principles, and methods that the expert has considered in providing his testimony.

Additionally, we are not persuaded by Petitioner’s argument that [a]ny non-public prior art claim charts provided to Dr. Poynton by Adobe’s counsel would expose analysis by Adobe’s attorneys of that art. And any references or combinations of references provided by Adobe’s counsel that did not make their way into Dr. Poynton’s declarations would reveal choices made by Adobe’s attorneys and Dr. Poynton to include or not include prior art in this IPR.

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<sup>4</sup> [https://www.uspto.gov/sites/default/files/documents/2018\\_Revised\\_Trial\\_Practice\\_Guide.pdf](https://www.uspto.gov/sites/default/files/documents/2018_Revised_Trial_Practice_Guide.pdf)

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Opp. 8 (footnote deleted). Contrary to Petitioner's suggestion, Patent Owner's questions do not seek the contents of any claim charts or any analysis therefor created by attorneys. Nor do these questions seek information regarding how Petitioner's attorneys chose the references at issue in these proceedings. Again, Questions 1–3 only seek the identity of the documents Dr. Poynton reviewed and considered for his testimony.

Further, we are not persuaded by Petitioner's arguments that these questions seek protected attorney work product that is outside the scope of routine discovery. Petitioner contends that "the Board's rules explicitly exclude from 'routine discovery' anything 'otherwise protected by legally recognized privileges such as attorney-client or attorney work product.'" Opp. 2 (*citing* 37 C.F.R. § 42.51(b)(1)(iii)). First, as explained above, routine discovery includes identifying the factual basis underlying the expert's testimony, which we do not find to be a "waste of time." Second, Petitioner has not explained sufficiently how the information sought by these questions implicate protected information. Petitioner relies on the decision in *Pevarello* to support its argument that questions regarding the preparation of witness declaration implicate attorney work product. Opp. 2–4. However, the specific questions in *Pevarello* were directed to the drafting, editing, and collaboration between the expert and attorney in preparing the declarant's declaration. For example, the questions included:

Did the attorney suggest changes?

Do you have any drafts of your declaration?

Do you recall specific changes made to your declaration?

Do you recall changes suggested by the attorney?

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Can you give me an example of what you say is the attorney's phraseology?

Were there any topics which the attorneys suggested be included in your declaration?

How many meetings did you have with the attorneys?

Did you correspond with the attorneys?

Did you have telephone discussions with the attorney about drafts of your declaration?

Did you ever e-mail the attorneys?

*See Pevarello*, 85 U.S.P.Q.2d 1771 at \*10. Unlike *Pevarello*, in these proceedings, Patent Owner's Questions 1–3 do not seek any information regarding the correspondence or collaboration in editing and drafting Dr. Poynton's Declaration. Furthermore, the *Pevarello* decision is consistent with Rule 42.65(a) in making clear that “[c]ross examination to inquire into whether the witness has a basis for facts asserted and opinions stated in a declaration is fair game. Indeed, inquiry into facts and opinions should be the focus of cross examination.” *Id.* (emphasis added). Thus, *Pevarello* also supports our determination that Questions 1–3, which seek the factual bases for testimony, are “fair game.”

Further, although the Federal Rules of Civil Procedure do not govern these proceedings, we note that FRCP Rule 26 is consistent with our determination. Rule 26(b)(4)(C) provides that

Rules 26(b)(3)(A) and (B) protect communications between the party's attorney and any witness required to provide a report under Rule 26(a)(2)(B), regardless of the form of the communications, except to the extent that the communications:

(i) relate to compensation for the expert's study or testimony;



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(ii) *identify facts or data that the party's attorney provided and that the expert considered in forming the opinions to be expressed; or*

(iii) identify assumptions that the party's attorney provided and that the expert relied on in forming the opinions to be expressed.

Fed. R. Civ. P. 26(b)(3)(C) (emphasis added). Further, the Advisory Committee Notes for the 2010 Amendment provide that

[t]he refocus of disclosure on “facts or data” is meant to limit disclosure to material of a factual nature by excluding theories or mental impressions of counsel. At the same time, the intention is that “facts or data” be interpreted broadly to require disclosure of any material considered by the expert, from whatever source, that contains factual ingredients. *The disclosure obligation extends to any facts or data “considered” by the expert in forming the opinions to be expressed, not only those relied upon by the expert.*

Advisory Committee Notes (emphasis added). Thus, even in this context, FRCP Rule 26 does not support Patent Owner's arguments.

For the reasons discussed above, we grant Patent Owner's motion to compel Dr. Poynton's testimony. However, in the interest of efficiency, we will treat Questions 1–3 as interrogatories. Accordingly, Petitioner shall file as an exhibit Dr. Poynton's certified written responses to these interrogatories by December 19, 2019.

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### ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's Motion to Compel Testimony is granted; and

FURTHER ORDERED that Questions 1–3 shall be treated as interrogatories served on Petitioner; and

FURTHER ORDERED that Petitioner shall file as an exhibit Dr. Poynton's certified written interrogatory responses by December 19, 2019.

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