

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MG FREESITES LTD,
Petitioner,

v.

SCORPCAST, LLC,
Patent Owner.

IPR2021-00510 (Patent 9,899,063 B2)¹
IPR2021-00512 (Patent 9,703,463 B2)

Before MEREDITH C. PETRAVICK, ERIC C. JESCHKE and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

PESLAK, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. §§ 42.5, 42.11, 42.20

¹ The parties are not authorized to use this caption in future filings. These cases have not been consolidated.

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I. INTRODUCTION

On March 22, 2022, Petitioner contacted the Board by email requesting authorization to file a Motion for Sanctions pursuant to 37 C.F.R. § 42.11(d)(2). Ex. 3001. Petitioner makes various allegations of misconduct during the depositions of Patent Owner’s inventors/declarants, Narbeh Avedissian and Nikhil Sreenath. *Id.* According to Petitioner, “[d]ue to egregious deposition misconduct by both the declarants and their counsel . . . , Petitioner was impeded from conducting a full and fair cross-examination of these declarants as to the details surrounding their purported earlier conception, diligence, and reduction to practice.” *Id.* As a sanction, Petitioner requests that we preclude “Patent Owner from presenting or contesting the issue of entitlement to an earlier effective filing date based on conception and reduction to practice” and that we exclude various exhibits offered by Patent Owner. *Id.* Alternatively, Petitioner requests an opportunity to take additional depositions of Mr. Avedissian and Mr. Sreenath. *Id.*

On March 23, 2022, Patent Owner contacted the Board by email objecting to Petitioner’s request to file a Motion for Sanctions. Ex. 3002. Patent Owner denies that either the declarants or Patent Owner’s counsel engaged in any misconduct during the depositions. *Id.* Patent Owner also accuses Petitioner’s counsel of engaging in misconduct at the depositions. *Id.* Patent Owner notes that “Petitioner did not contact the Board during the depositions to raise any issues,” and “[t]he issue of sanctions was not raised until February 18, 2022 well after Petitioner’s Replies in IPR2021-00510 and 2021-00512 were filed on January 28, 2022.” *Id.*

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II. DISCUSSION

Patent Owner submitted Declarations of Inventors Narbeth Avedissian and Nikhil Sreenath in order to antedate prior art references relied on by Petitioner. Exs. 2089, 2090.

The deposition of Mr. Avedissian occurred on January 13, 2022. Ex. 1044. Petitioner did not contact the Board during Mr. Avedissian's deposition to raise any issues concerning conduct during the deposition. *See generally id.* The deposition of Mr. Sreenath occurred on January 14, 2022. Ex. 1046. Petitioner did not contact the Board during Mr. Sreenath's deposition to raise any issues concerning conduct during the deposition. *See generally id.*

Petitioner filed its Reply to the Patent Owner Response on January 28, 2022, and extensively briefed the issue of whether the challenged patent is entitled to an earlier filing date. Paper 23, 1–14. Petitioner specifically argued that “the purported inventors repeatedly dodged questions relating to their invention and purported conception and reduction-to-practice, often asserting privilege on these questions based on purported conversations with patent prosecution counsel.” *Id.* at 14 (deposition citations omitted). Although Petitioner argued “[t]he inventors should not be rewarded for shielding pertinent information while using their declarations as a sword,” Petitioner did not argue that the conduct was sanctionable. *Id.*

Patent Owner, in turn, filed the Sur-Reply on March 11, 2022. Paper 26. The date for oral hearing in this matter is May 13, 2022. Paper 15, 10.

In accordance with 37 C.F.R. § 42.11(d)(2), on March 1, 2022, Petitioner served its Motion for Sanctions on Patent Owner. Ex. 3001. Petitioner does not offer any explanation for not contacting the Board during

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the depositions to raise the issue of potential misconduct, nor does Petitioner explain why it waited over six weeks after the depositions to serve the Motion for Sanctions on Patent Owner. *See generally* Ex. 3001. Petitioner's failure to raise the issue of potential misconduct by phone with the Board during the depositions and Petitioner's unexplained delay in raising the issue with the Board in a timely fashion after the depositions weighs heavily against granting Petitioner's request to file a Motion for Sanctions. This failure is particularly problematic given the facts that the parties have already filed the Petitioner Reply and Patent Owner Sur-Reply, that the oral hearing, if requested, will occur on May 13, and that our statutory deadline for issuing a Final Written Decision in this matter is fast approaching. Essentially, Petitioner requests a do-over at this late date. For these reasons, we deny Patent Owner's request to file a Motion for Sanctions.

Nothing in this Order shall preclude Petitioner from asserting any evidentiary arguments in connection with the Declarations of Mr. Avedissian and Mr. Sreenath at the oral hearing or in connection with other authorized motions.

It is hereby:

ORDERED that Petitioner's request to file a Motion for Sanctions is denied.

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