

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MPOWERED INC.,
Petitioner,

v.

LUMINAID LAB, LLC,
Patent Owner.

Case IPR2018-01524
Patent 9,347,629 B2

Before SCOTT C. MOORE, NORMAN H. BEAMER, and
STACY B. MARGOLIES, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

ORDER
Granting Motion for Live Testimony
37 C.F.R. §§ 42.5, 42.70

INTRODUCTION

Patent Owner has moved to present live testimony from Ms. Anna Stork, a named inventor of the challenged patent. Paper 33 (“Motion” or “Mot.”). Patent Owner relies on the declaration of Ms. Stork (Ex. 2005) and documents discussed in her declaration as evidence in support of Patent Owner’s argument that the claimed inventions were reduced to practice before the filing date of the asserted art. *See* Paper 10, 7–44. Patent Owner also relies on Ms. Stork’s declaration and documents cited therein to support its argument that Ms. Stork and another named inventor, Andrea Sreshta, solely conceived of the relevant subject matter described in the Sreshta and Chun references, thereby disqualifying those references as prior art by “another” under 35 U.S.C. § 102(e). *See* PO Resp. 45.

Petitioner opposes Patent Owner’s Motion. Paper 34 (“Opposition” or “Opp.”). The parties also presented arguments regarding the Motion during the October 30, 2019, pre-hearing conference.

For the reasons set forth below, we *grant* Patent Owner’s Motion.

DISCUSSION

“Occasionally, the Board will permit live testimony where the Board considers the demeanor of a witness critical to assessing credibility.” July 2019 Trial Practice Guide Update, 12 (available at <https://www.uspto.gov/TrialPracticeGuide3>). “Live testimony will be necessary only in limited circumstances and requests for live testimony will be approached by the Board on a case-by-case basis.” *Id.*

Factors we may consider in deciding a motion for live testimony include the “importance of the witness’s testimony to the case, i.e., whether it may be case-dispositive,” and whether that person is a fact witness. *K-40*

Elecs., LLC v. Escort, Inc., Case IPR2013-00203, Paper 34, 3 (PTAB May 21, 2014) (precedential).

Patent Owner contends that Ms. Stork's testimony will demonstrate that the invention of the challenged patent was conceived and reduced to practice prior to the critical date in this case, June 18, 2010. Mot. 1; Paper 10, 7. According to Patent Owner, Petitioner has "made Ms. Stork's credibility a central issue in this case by calling her 'biased and incomplete' in her presentation of her invention story." *Id.* (citing Paper 22, 3). Patent Owner also argues that the availability of Ms. Stork's declaration and deposition transcript are not sufficient for Patent Owner's opportunity to be heard because they do not allow the issues that the Board finds important to be specifically addressed. Mot. 4. For example, Patent Owner posits that Ms. Stork may demonstrate in her live testimony that her Gmail emails still exist on Google's servers and have not been falsified. *Id.* Patent Owner further argues that this case is similar to the Board's precedential decision in *K-40 Electronics*, in which a Board panel allowed live testimony from an inventor in support of a patent owner's attempt to antedate prior art references. *See* Mot. 3 (citing *K-40 Elecs, LLC v. Escort, Inc.*, IPR2013-00203, Paper 34 at 1 (PTAB May 21, 2014)). Patent Owner contends that the two *K-40 Electronics* factors discussed above favor live testimony because Ms. Stork is a fact witness, and her testimony may be case-dispositive. *Id.* at 2.

Petitioner argues in response that live testimony would be duplicative because our rules would not permit Ms. Stork's live testimony to exceed the scope of her declaration. Opp. 2. Petitioner represents that there is no need for Ms. Stork to "demonstrate for the Board that her records still exist on Google's servers, and are not merely photocopies that could be falsified"

because “Petitioner has not questioned the existence of Ms. Stork’s emails or accused her of falsifying electronic records.” *Id.* Petitioner then argues that “Ms. Stork’s credibility is not an issue” because Petitioner “has not attacked Ms. Stork’s credibility,” but rather “merely highlight[ed] that her testimony is uncorroborated.” *Id.* at 3–4. According to Petitioner, Ms. Stork’s testimony, even if true, is insufficient to establish prior conception and reduction to practice because it “is not corroborated by independent evidence.” *See id.* at 4.

We appreciate the clarifications in Petitioner’s Opposition, which streamline the case and resolve at least the potential dispute concerning the authenticity of Ms. Stork’s Gmail emails. However, it is apparent from the record that Ms. Stork’s credibility remains in dispute. For example, Petitioner argues in its Reply that “contemporaneous evidence establishes at least Alice Chun as a co-inventor of the subject matter claimed in the ’629 Patent.” Paper 22, 8. This argument appears to directly contradict Ms. Stork’s declaration. *See Ex. 2005 ¶ 3.* Moreover, if we were to reject Petitioner’s argument that Ms. Stork’s declaration lacks sufficient corroboration, this case might well turn on Ms. Stork’s credibility. Thus, Ms. Stork’s testimony may be case dispositive. In addition, Ms. Stork is a fact witness and a named inventor who, like the witness in *K-40 Electronics*, seeks to offer testimony in support of an attempt to antedate prior art references. Under the facts and circumstances present here, we determine that Ms. Stork should be permitted to offer live testimony.

During the October 30, 2019, pre-hearing conference, Patent Owner requested 30 minutes to examine Ms. Stork and 30 additional minutes for oral argument. Petitioner requested 30 minutes to examine Ms. Stork and 60 additional minutes for oral argument. After considering the parties’

positions, we determine that each party shall have up to 30 minutes to examine Ms. Stork, and that each party shall have up to 60 minutes for oral argument.

ORDER

In view of the foregoing, it is, therefore,

ORDERED that Patent Owner's Motion for Live Testimony is *granted*;

FURTHER ORDERED that such testimony is limited to 30 minutes of direct examination by Patent Owner's counsel, followed by no more than 30 minutes of cross-examination by Petitioner's counsel, provided that Patent Owner may reserve a short amount of time for redirect examination, if desired;

FURTHER ORDERED that the scope of Ms. Stork's direct testimony shall be limited to the scope of her declaration and deposition testimony in this proceeding, that the scope of Petitioner's cross-examination shall not exceed the scope of the direct examination, and that the scope of any redirect examination by Patent Owner shall not exceed the scope of the cross-examination; and

FURTHER ORDERED that the hearing on November 4, 2019, will begin with the presentation of live testimony from Ms. Stork, followed by the oral argument.

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PETITIONER:

Christopher Agrawal
cagrawal@bomcip.com

Kirsten Johnson
kjohnson@bomcip.com

Dinesh Melwani
dmelwani@bomcip.com

PATENT OWNER:

John Dragseth
dragseth@fr.com

Jennifer Huang
jjh@fr.com

Dorothy Whelan
whelan@fr.com