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Paper 36
Entered: September 5, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEXICHEM AMANCO HOLDINGS S.A. de C.V.
Petitioner

v.

HONEYWELL INTERNATIONAL, INC.
Patent Owner

Case IPR2013-00576
Patent 8,444,874 B2

Before LINDA M. GAUDETTE, FRANCISCO C. PRATS, and JACQUELINE WRIGHT BONILLA, *Administrative Patent Judges*.

BONILLA, *Administrative Patent Judge*.

DECISION
Denying Patent Owner's Motion for Additional Discovery
37 C.F.R. § 42.51(b)(2)

In an Order dated August 26, 2014 (Paper 31), we authorized Patent Owner to file a motion for additional discovery as it pertains to a deposition of Dr. Takashi Shibanuma, who provided previously prepared testimony relied on by Petitioner in its Reply to Patent Owner's Response (Paper 27). The previously prepared testimony is a Declaration of Dr. Shibanuma (Ex. 1076), originally submitted in Reexamination Control Nos. 95/002,189 and 95/002,204 on July 26, 2014, in relation to U.S. Patent No. 7,534,366, which is related, through a number of continuation-in-part applications, to the challenged patent here.

On August 28, 2014, Patent Owner filed its Motion for Additional Discovery (Paper 32), and, on September 2, 2014, Petitioner filed a Response to that Motion (Paper 34). We have considered both papers. Although Patent Owner's position has merit in relation to certain *Garmin* factors,[1] we will not grant the requested additional discovery because we are not persuaded it is "necessary in the interest of justice" under the circumstances of this case. 35 U.S.C. § 316(a)(5); *see also* 37 C.F.R. § 42.51(b)(2). Particularly in view of the fifth factor ("Requests Not Overly Burdensome to Answer") outlined in *Garmin*,[2] we will not compel Petitioner to provide Dr. Shibanuma for cross-examination in a deposition. We will not compel Petitioner to produce a witness who is not under Petitioner's control, who may reside in Japan, especially where such action may require a court subpoena[3] and/or invoke the Hague Convention. Paper 34 at 3-4.

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[1] *Garmin Int'l Inc. et al. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, Paper 26 (PTAB March 5, 2013).

[2] *Id.* at Paper 26 at 7, 14-16.

[3] The Board does not have authority to issue a subpoena for the production of a witness residing in the United States. Such production must be compelled through a subpoena from a U.S. District Court. *See* 35 U.S.C. § 24.

We note, however, that to the extent Petitioner relies on Dr. Shibanuma's previously prepared Declaration (Ex. 1076), we will take into consideration whether Patent Owner has had an opportunity to cross-examine Dr. Shibanuma. Although we will not compel Petitioner to produce the witness, if Petitioner does not produce Dr. Shibanuma for cross-examination, we will give that Declaration little to no weight as Patent Owner has not been offered a fair opportunity to challenge his testimony. *See, e.g.*, Fed. R. Evid. 801 and 802. "[A] party presenting a witness's testimony by affidavit should arrange to make the witness available for cross-examination." Office Trial Practice Guide, 77 Fed. Reg. 48756, 48761 (August 14, 2012).

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's Motion for Additional Discovery is *denied*.

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