

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SEMICONDUCTOR COMPONENTS INDUSTRIES, LLC d/b/a
ON SEMICONDUCTOR
Petitioner,

v.

POWER INTEGRATIONS, INC.,
Patent Owner.

Case IPR2016-00809
Patent 6,212,079 B1

Before THOMAS L. GIANNETTI, DANIEL N. FISHMAN, and
KERRY BEGLEY, *Administrative Patent Judges*.

FISHMAN, *Administrative Patent Judge*.

ORDER
Conduct of Proceeding
37 C.F.R. §§ 42.5 and 42.51

On November 16, 2016, a conference call was held at the request of Patent Owner. Present on the call were Judges Giannetti, Fishman, and Begley, along with Lead Counsel for both parties. During the conference call, Patent Owner requested authorization to file a Motion for Additional Discovery under 37 C.F.R. § 42.51(b)(2) and requested the Board to issue an

order permitting Patent Owner to depose a translator of some of Petitioner's exhibits originally prepared in Japanese. Petitioner opposes both requests.

1. Additional Discovery

Patent Owner contended in its Preliminary Response that the Petition should be denied because Petitioner was in privity with Fairchild Semiconductor International, Inc. ("Fairchild") — an entity that is arguably barred from filing a petition under 35 U.S.C. § 315(b). Prelim. Resp. 1, 4–11. In our Decision to Institute *Inter Partes* Review (Paper 12, "Decision"), we were not persuaded such a privity relationship was established. Decision 9–13. Although Patent Owner presented a merger agreement (Ex. 1028) and a confidentiality agreement (Ex. 2026) between Petitioner and Fairchild, the evidence was insufficient to show any degree of control of the filed Petition by Fairchild — a key factor in establishing privity between Petitioner and Fairchild.

Patent Owner now seeks authorization to file a Motion for Additional Discovery under 37 C.F.R. § 42.51(b)(2) regarding a possible privity relationship between Petitioner and Fairchild. Our rules provide that "[t]he moving party must show that such additional discovery is in the interests of justice." 37 C.F.R. § 42.51(b)(2)(i). That is significantly different from the scope of discovery generally available to litigants under the Federal Rules of Civil Procedure. As the movant, Patent Owner bears the burden of establishing that the request is in the interest of justice. We generally consider five factors (the "*Garmin* factors") in determining whether interests of justice would be served by granting additional discovery requests. *See Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, slip op. at 6–7 (PTAB Mar. 5, 2013) (Paper 26) (precedential). In *Garmin*, we

held that the following factors are important in determining the interests of justice:

1. More Than A Possibility And Mere Allegation — The mere possibility of finding something useful, and mere allegation that something useful will be found, are insufficient to demonstrate that the requested discovery is necessary in the interest of justice. The party requesting discovery should already be in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered.

2. Litigation Positions And Underlying Basis — Asking for the other party's litigation positions and the underlying basis for those positions is not necessary in the interest of justice. The Board has established rules for the presentation of arguments and evidence. There is a proper time and place for each party to make its presentation. A party may not attempt to alter the Board's trial procedures under the pretext of discovery.

3. Ability To Generate Equivalent Information By Other Means — Information a party can reasonably figure out or assemble without a discovery request would not be in the interest of justice to have produced by the other party. In that connection, the Board would want to know the ability of the requesting party to generate the requested information without need of discovery.

4. Easily Understandable Instructions — The questions should be easily understandable. For example, ten pages of complex instructions for answering questions is *prima facie* unclear. Such instructions are counter-productive and tend to undermine the responder's ability to answer efficiently, accurately, and confidently.

5. Requests Not Overly Burdensome To Answer — The requests must not be overly burdensome to answer, given the expedited nature of *Inter Partes* Review. The burden includes financial

burden, burden on human resources, and burden on meeting the time schedule of *Inter Partes* Review. Requests should be sensible and responsibly tailored according to a genuine need.

Id. at 6–7.

In the telephone conference call, Patent Owner did not indicate that it is in possession of any further evidence that a privity relationship existed at the time of filing of the Petition beyond that which it possesses and identified in its Preliminary Response. Thus, Patent Owner has expressed no more than a suspicion (mere speculation) that such evidence exists and would be uncovered by additional discovery. Therefore, Patent Owner’s request fails at least the first *Garmin* factor indicating only the mere possibility that useful evidence of the asserted privity relationship would be found. We determine Patent Owner has not shown that it would be in the interests of justice to authorize a Motion for Additional Discovery.

Furthermore, Patent Owner attached to its email request for authorization proposed interrogatories and requests for production. We indicated to Patent Owner that, even if there were some evidence in its possession meeting the threshold of the first *Garmin* factor, the proposed interrogatories and requests for production are vastly broader than any request we would consider authorizing — thus, likely failing *Garmin* factors 2, 4, and 5.

For the reasons above, we deny Patent Owner’s request for authorization to file a Motion for Additional Discovery.

2. *Deposition of Translator*

Under the Leahy-Smith America Invents Act, discovery is available for the deposition of witnesses submitting affidavits or declarations and for “what is otherwise necessary in the interest of justice.” 35 U.S.C.

§ 316(a)(5). Such a deposition is available as routine discovery under our rules. *See* 37 C.F.R. § 42.51(b)(1)(ii). However, the scope of such a cross-examination deposition is limited to the declarations made in the translator's direct testimony (i.e., the affidavit). *See* 37 C.F.R. § 42.53(d)(5)(ii).

The translator's declaration testifies to his expertise in both English and Japanese and to the accuracy of the translation. *See, e.g.*, Ex. 1019; Ex. 1022; Ex. 1028. Patent Owner argues that the translator included notes indicating he may have consulted with Petitioner to indicate the likely meaning rather than the strict translation. *See, e.g.*, Ex. 1029, 10 n.1. Thus, Patent Owner seeks to cross-examine the translator to determine the independence from Petitioner, or lack thereof, in the translation process.

The issue of independence of the translator's activity, or lack thereof, is beyond the scope of the translator's affidavit and, thus, Patent Owner's request amounts to a request for authorization to file a Motion for Additional Discovery (i.e., under 37 C.F.R. § 42.51(b)(2)) to compel the requested cross-examination testimony beyond the scope of the translator's direct testimony. As above, Patent Owner's request does not meet the threshold of the *Garmin* factors to authorize such a motion. Patent Owner's request fails to meet the third *Garmin* factor — specifically, Patent Owner may provide its own expert translator to counter the translation provided by Petitioner's translator. Furthermore, the exemplary note provided in the translation of Exhibit 1028 fails to demonstrate any collusion between Petitioner and its translator or the lack of independence in the translator's efforts. Thus, Patent Owner's request fails the first *Garmin* factor in that it amounts to

mere speculation that some evidence would be uncovered in the requested deposition.

For the above reasons, we determine Patent Owner has not shown that the requested cross-examination beyond the scope of the translator's affidavit is justified in the interest of justice and we, therefore, deny Patent Owner's implied request for additional discovery in cross-examining Petitioner's translator. We remind the parties that cross-examination within the scope of the translator's direct testimony is authorized as routine discovery.

ORDER

IT IS ORDERED that Patent Owner's request for authorization to file a Motion for Additional Discovery is *denied*; and

FURTHER ORDERED that Patent Owner's request to cross-examine Petitioner's translator regarding collusion with Petitioner or lack of independence in the translation process is *denied*.

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