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Paper 27
Date: May 13, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMMSCOPE TECHNOLOGIES LLC.,
Petitioner,

v.

BELDEN INC.,
Patent Owner.

IPR2023-01061 (Patent 6,998,537 B2)
IPR2023-01062 (Patent 6,570,095 B2)

Before CHRISTOPHER KAISER, KIMBERLY McGRAW, and SHARON FENICK, *Administrative Patent Judges.*

McGRAW, *Administrative Patent Judge*.

ORDER
Granting Petitioner's Motion to Compel Production of Routine Discovery
and
Dismissing as Moot Petitioner's Motion for Additional Discovery
37 C.F.R. § 42.5

On April 18, 2024, a conference call was held between counsel and the Board[1] to discuss Petitioner's email (Ex. 3001) requesting authorization, if needed, to file (1) a motion to compel routine discovery, or alternatively, (2) a motion to obtain additional discovery in each of the above proceedings. Following the Board's authorization, Petitioner filed a Motion to Compel "Routine Discovery" or Alternatively to Obtain "Additional Discovery" (Paper 22[2], "Mot." or "Motion"), to which Patent Owner filed a Response (Paper 23 "Opp. To Mot." or "Opposition") and Petitioner filed a Reply (Paper 26 "Reply to Opp.").

In its Motion, Petitioner states that it believes that there are documents from an earlier district trial (the "*Superior Essex* Litigation"[3]) in which Patent Owner took the position that the GmbH-866[4] reference *discloses* twisted pairs, which is opposite to the position that Patent Owner takes in the present proceeding, namely that the GmbH-866 reference *does not disclose* twisted pairs. Mot. 1; Ex. 3001, 1. Petitioner asserts that these documents

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[1] Administrative Patent Judges Kristina M. Kalan, Kimberly McGraw, and Sharon Fenick participated in that conference call. Judge Kalan has been replaced on the panel by Administrative Patent Judge Christopher Kaiser. Paper 24. As indicated in the caption, Judges Kaiser, McGraw, and Fenick issue this order.

[2] Paper numbers refer to papers filed in IPR2023-01061. Similar papers were filed in IPR2023-01062.

[3] *Belden Technologies, Inc. v. Superior Essex Inc.*, Case No. 1:08-00063-SLR (D. Del.).

[4] The parties refer to German Publication DE 297 19 866 U1, filed Aug. 8, 1997, published May 2, 1998 (Exhibit 1011) as "GmbH-866." Ex. 1011 codes (22), (43); *see also* Ex. 1010 (translation of GmbH-866 relied upon by Petitioner in this proceeding, with translator's declaration at page 11); Ex. 1057 (additional translation of GmbH-866); Ex. 2009 (this exhibit appears to be a concatenated file containing Ex. 1057 and Ex. 1011).

are not publicly available and that Patent Owner should have provided them as routine discovery under 37 C.F.R. § 42.51(b)(1)(iii). Mot. 1. Petitioner requests that the Board order Patent Owner (1) to produce these documents, (2) to produce any other relevant information of which Patent Owner is aware that is inconsistent with a position advanced in these IPR proceedings, and (3) to confirm that Patent Owner has complied with the requirements of routine discovery under 37 C.F.R. § 42.51(b)(1). *Id.*

Patent Owner responds that the positions taken in the *Superior Essex* Litigation and the present proceeding are not inconsistent because the statements in the litigation involved "an uncertified and substantially different translation of GmbH-866 that was not this basis for this IPR." Opp. To Mot. 1, 3 (emphasis omitted) (referring to Ex. 2009).

We disagree with Patent Owner. The foreign language GmbH-866 reference itself, not any particular certified translation, is the prior art reference that is asserted in the present Petition and was asserted in the *Superior Essex* Litigation. Although there may be differences in the English translations of the asserted foreign language GmbH-866 reference, the asserted prior art is the foreign language GmbH-866 reference itself, not any particular translation of that reference. Thus, a Patent Owner statement that the GmbH-866 reference, including any translation of the GmbH-866 reference, teaches twisted pairs is inconsistent with Patent Owner's position in the present proceeding and any such statements must be produced as routine discovery. *See* 37 C.F.R. § 42.51(b)(1)(iii) (stating that unless previously served, "a party must serve relevant information that is inconsistent with a position advanced by the party during the proceeding concurrent with the filing of the documents or things that contains the

inconsistency"). Patent Owner is free to assert during trial that any inconsistent statements about the reference are due to differences in the translations of the reference.

Patent Owner also criticizes Petitioner for failing to identify the specific documents until shortly before the Board's April 18th conference call. Opp. To Mot. 1–2. This argument is not well taken. It is not Petitioner's burden to identify documents that Patent Owner should have produced as routine discovery.

Patent Owner states that it will provide the specific documents that were requested by Petitioner, redacted to remove irrelevant or confidential information, with one exception, as additional discovery, thereby mooting this motion. Opp. To Mot. 5. We disagree that Patent Owner's offer moots Petitioner's motion. Patent Owner's offer is limited to certain documents identified by Petitioner. However, as noted above, it is not Petitioner's obligation to identify documents containing Patent Owner inconsistent statements. Patent Owner makes no representation that producing the specific documents identified by Petitioner will satisfy its obligations to produce routine discovery under § 42.51(b)(1), including producing all documents that have relevant information that is inconsistent with positions advanced in this proceeding.

The one document identified by Petitioner that Patent Owner has not agreed to produce is a document referred to by the Petitioner as "JTX-397." Opp. to Mot. 2. Patent Owner states that "Trial counsel was unable to locate that document and it is not listed on the Trial Exhibit List." *Id.* at 2 n.1. Petitioner states that Patent Owner's inability to find this document is concerning because the document includes Patent Owner's formal

stipulation that GmbH-866 discloses twisted pairs and because the trial transcript confirms that it was Patent Owner that introduced the stipulation into evidence. Reply to Opp. 1–2 (citing Ex. 1063, 1331:18–1332:23; Ex. 1066, 1268:24–1269:2, 1142:1–12).

We agree with Petitioner that Patent Owner's inability to locate a document that purportedly includes Belden's formal stipulation that GbmH-866 discloses twisted pairs raises concerns as to whether Patent Owner has sufficiently satisfied its obligations to produce routine discovery. As noted above, a Patent Owner statement that the GmbH-866 reference, including any translation of the GmbH-866 reference, teaches twisted pairs is inconsistent with Patent Owner's position in the present proceeding and any such statements must be produced as routine discovery. We remind Patent Owner that it has a duty of candor and good faith to the Office during this proceeding and that failing to produce relevant information within the scope of 37 C.F.R. § 42.51(b)(1)(iii) is improper. *See* 37 C.F.R. § 42.11(a) (stating, *inter alia*, "Parties and individuals involved in the proceeding have a duty of candor and good faith to the Office during the course of a proceeding"); *see also L'Oreal USA, Inc. v. Liqwd, Inc.*, PGR2017-00012, Paper 37 at 13 (PTAB Sept. 27, 2017) (stating that hiding relevant information that should be produced as routine discovery violates the duty of candor and good faith to the Office).

Patent Owner's statement that it will redact "confidential" information, without specifying whether that information was designated confidential by Patent Owner or by a third party, is also troubling to the extent Patent Owner intends to redact information designated confidential by Patent Owner in the *Superior Essex* Litigation. During the conference call,

Patent Owner stated that it could not produce the requested documents because they contain confidential information of both Patent Owner and a third party. The Board explained during the call, however, that the fact that a document may contain Patent Owner confidential information is not a reason for Patent Owner to withhold production of that document. *See* Consolidated Trial Practice Guide,[5] 19–22 (discussing the handling of confidential information); *see also* 37 C.F.R. § 42.54 (describing the availability of tailored protective orders to protect confidential information). Additionally, during the conference call, Patent Owner conceded that it is possible for its trial counsel to redact third party confidential information so that the documents containing Patent Owner confidential information could be produced without violating the protective order in the *Superior Essex* Litigation and stated that this is a procedure that trial counsel is "working on." Petitioner states that it will not object to redactions of third party confidential information. Reply to Opp. 1. To clarify, the Board disagrees with any contention that Patent Owner may refuse to produce information because such information was designated confidential by Patent Owner in the *Superior Essex* Litigation.

In its Reply, Petitioner objects to Patent Owner redacting information that Patent Owner unilaterally deems "irrelevant" and asserts that Belden should produce the complete documents with only the confidential information of third parties redacted. Reply to Opp. 1.

As noted above, Rule 42.51(b)(1)(iii) requires production of "relevant information that is inconsistent with a position advanced by the party during the proceeding concurrent with the filing of the documents or things that

[5] Available at https://www.uspto.gov/TrialPracticeGuideConsolidated .

contains the inconsistency." Petitioner has not provided any persuasive argument that Patent Owner should produce information beyond that required to be produced as routine discovery. Patent Owner, however, is again reminded that it has a duty of candor and good faith to the Office during this proceeding and that deeming relevant information "irrelevant" to avoid production of routine discovery is improper. *See* 37 C.F.R. § 42.11(a).

For the foregoing reasons, Petitioner's Motion to Compel "Routine Discovery" is granted. Because we grant Petitioner's request to compel the production of documents as routine discovery, Petitioner's alternative motion to obtain the documents to be produced as additional discovery is dismissed as moot.

ORDER

In consideration of the foregoing, it is

ORDERED that Petitioner's Motion to Compel "Routine Discovery" is granted;

Patent Owner is ordered to produce by May 16, 2024 all relevant information of which Patent Owner is aware that it is inconsistent with a position advanced in the IPR;

Patent Owner is ordered to confirm by May 16, 2024 whether it has complied with the requirements of routine discovery under 37 C.F.R. § 45.51(b)(1); and

ORDERED that Petitioner's alternative motion to obtain additional discovery is dismissed as moot.

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