

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INNOSCIENCE (ZHUHAI) TECHNOLOGY
COMPANY, LTD., AND
INNOSCIENCE AMERICA, INC.,
Petitioners,

v.

EFFICIENT POWER CONVERSION CORPORATION,
Patent Owner.

IPR2023-01381
U.S. Patent 8,350,294

**PETITIONER'S MOTION TO COMPEL ROUTINE DISCOVERY
UNDER 37 CFR § 42.51**

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Regulations

37 C.F.R. § 42.51	<i>passim</i>
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I. PATENT OWNER SHOULD BE COMPELLED TO COMPLY WITH ITS ROUTINE DISCOVERY OBLIGATIONS

Petitioner moves to compel Patent Owner (“PO”) to produce documents containing “information inconsistent with positions” advanced in PO’s Response (“POR,” Paper 18) under the “routine discovery” rules. 37 C.F.R. § 42.51(b)(1)(iii).

The “routine discovery” rules require PO to automatically (without any request) produce documents containing inconsistent information. *CommScope Tech. LLC v. Belden Inc.*, IPR2023-01061, Paper 27 at 4 (PTAB May 13, 2024). But PO refuses to comply with its routine discovery obligations. PO flatly refuses to produce inconsistent information from the parallel International Trade Commission investigation—*Semiconductor Devices, And Methods Of Manufacturing Same And Products*, Inv. No. 337-TA-1366—where PO alleged infringement of the ’294 patent. As the examples below show, PO and its expert made statements at the ITC on the scope of the claims and the prior art that are inconsistent with positions in the POR. Indeed, PO’s position on the Board call was not that it had reviewed the ITC record for inconsistent information and found none, as required, but rather that it was “**impossible**” to perform the required task. Ex. 1028, 10:14-18.

Petitioner respectfully requests that the Board orders PO to: (i) produce, by August 21, the documents identified in this motion, as well as any other relevant information in PO’s possession that is inconsistent with positions advanced in the

POR; and (ii) certify, also by August 21, that it has complied with the requirements of routine discovery under 37 C.F.R. § 42.51(b)(1)(iii).

II. ALTHOUGH PETITIONER IDENTIFIED DOCUMENTS WITH INCONSISTENCIES IN A LIST, AS REQUESTED, PATENT OWNER REFUSED TO CURE ITS NONCOMPLIANCE WITH THE ROUTINE DISCOVERY RULES, NECESSITATING THIS MOTION

A. The ITC Investigation Addresses Overlapping Claims and Prior Art

The ITC investigation involves overlapping issues and experts with the IPR. At the ITC, PO: (1) asserts infringement of the same patent at issue here; (2) produced expert reports and offered both deposition and hearing testimony by Dr. E. Fred Schubert—the same expert PO relies on here (*see* Ex. 2009); and (3) took positions, offered documents, and testified about the scope of '294 patent claim with respect to prior art at issue here.

B. PO Refused to Provide Routine Discovery of its Own Volition

After receiving the POR, Petitioner emailed PO's counsel (who also represents PO at the ITC) noting that PO and its expert made statements about the scope of the '294 patent, its claims, and the content of the prior art inconsistent with positions advanced in the POR. Ex. 1029, 4. Petitioner asked PO to supplement discovery. *Id.* PO responded suggesting scheduling a call with the Board. *Id.*, 3.

C. PO Refused to Produce Anything at the Parties' Meet and Confer

At the call with the Board, the Board required the parties to meet and confer, for Petitioner to identify the inconsistencies it had found, and for PO to explain its

position on whether there were inconsistencies. Ex. 1028, 23:11-24:4. A day before the meet and confer, Petitioner provided PO with a list of ITC documents that include information inconsistent with positions in the POR. Ex. 1029, 1. Petitioner's list specified pincites for each document. *Id.* During the meet and confer, Petitioner identified (1) specific positions in the POR and (2) inconsistent information in the several ITC documents, both public and non-public, Petitioner listed.

PO disagreed, arguing that the documents did not include inconsistent information, and that some of the documents Petitioner cited had already been produced. After an impasse was clear, Petitioner contacted the Board, reported the meet and confer results, and the Board authorized this Motion to Compel. Ex. 1030.

III. THE ITC RECORD IS REPLETE WITH INFORMATION INCONSISTENT WITH THE PATENT OWNER RESPONSE; PATENT OWNER MUST PRODUCE ANY DOCUMENTS WITH INCONSISTENT INFORMATION

A. Documents From the Related ITC Investigation With Inconsistent Information Must Be Produced as Mandatory "Routine Discovery"

37 C.F.R. § 42.51 is clear: "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." 37 C.F.R. § 42.51(b)(1)(iii) (emphasis added). The requirement is automatic, required with the filing of the document, and should not require any action by Petitioner or Board. *See MaxLinear, Inc. v. Cresta Tech. Corp.*, IPR2015-

00594, Paper 35 at 9 (PTAB Jan. 27, 2016) (“compliance with routine-discovery provisions is Patent Owner’s obligation even without a motion by Petitioner”); *B/E Aerospace Inc. v. MAG Aerospace Indus.*, IPR2014-01510, Paper 61 at 3 (PTAB Oct. 5, 2015) (testimony in a parallel proceeding, if inconsistent, was “routine discovery that should have been served”); Trial Guide, 77 FR 48756 at 48761 (“patent owner should provide . . . evidence that is inconsistent with the contention”).

A. ITC Documents Include Information That is “Inconsistent”

The following are exemplary inconsistencies between POR positions and ITC statements that relate to the scope of the claims and the content of the prior art:

POR Position	Inconsistent PO Position from Public information in the ITC
“The mere <u>presence of hydrogen does not result</u> in a <u>compensated GaN layer.</u>” POR, 31.	“The Mg doped p-type GaN layer with the <u>presence of hydrogen</u>, as evidenced by Innoscience’s admissions and the above SIMS data, demonstrates that the gate material GaN layer is doped with Mg (p-GaN) and passivated by hydrogen <u>evidencing a compensated GaN layer.</u>” Ex. 1031, 17.

POR Position	Inconsistent PO Position from Public information in the ITC
“a POSA would find the doping of a gate semiconductor followed by the <u>cancellation of the effects of the dopant to be highly counterintuitive</u>,” POR, 44.	“<u>Hydrogen implantation is a process that is widely used</u> to render III-V semiconductors highly resistive.” Ex. 1032, 402. “The possibility of rendering III-V semiconductors semi-insulating by <u>hydrogen implantation</u> made this technique <u>very attractive for device applications</u>.” Ex. 1032, 406.
“because the 2DEG is present under Uemoto’s high resistive <u>region 15b</u>, it <u>cannot correspond to the compensated GaN layer</u> of claim 1.” POR, 52	“So <u>layer 15b</u> is gallium nitride, contains magnesium and hydrogen, is passivated, and is non-conductive. So in that sense, it <u>meets the claim term ‘compensated gallium nitride.’</u>” Ex. 2017, 1034:4-7 (testimony by Dr. Schubert)
“It is <u>only the p-type dopants</u> that are passivated by hydrogen,” POR, 53.	“Second, <u>hydrogen forms complexes with donor and acceptor [i.e., both n-type and p-type]</u> impurities (see Sect. 9.3.1). As a consequence, <u>the impurities are neutralized</u> and the free carrier concentration is reduced.” Ex. 1032, 402-403.

The above exemplary inconsistent information is available in **public** ITC documents. With this motion, Petitioner has supplemented the record to include Exs. 1031 and 1032, and, admittedly, PO already produced Ex. 2017 (cited in the

table's third row). But, as Petitioner pointed out during the Board call and the meet and confer, PO cannot offload its discovery obligations to Petitioner. And PO must produce any ITC documents, including **non-public** documents, that include similar inconsistencies. For example, as Petitioner discussed during the meet and confer, the following **non-public** documents include similar inconsistent information:

- Non-public exhibits in Petitioner's ITC complaint.
- Non-public expert report by Dr. Schubert dated November 13, 2023.
- Non-public transcripts of the Dr. Schubert depositions taken December 14 and 15, 2024.
- Non-public portions of the transcript of the ITC evidentiary Hearing held from February 26 to March 1, 2024.

PO should have already produced at least these documents concurrently with its POR as "routine discovery." IPR2023-01061, Paper 27 at 4. PO did not, and it refuses to do so. But PO cannot withhold documents to selectively omit them from this proceeding, hiding inconsistent information on important issues—like construction of the disputed term "compensated GaN" and the disclosures in prior art *Uemoto* (Ex. 1006)—from the Board. PO should be compelled to produce these documents promptly along with **any** other document in PO's possession with information that is inconsistent with PO's positions. The Board has previously compelled broad production of inconsistent information as routine discovery under

similar circumstances. *C&D Zodiac, Inc. v. B/E Aerospace, Inc.*, IPR2014-00727, Paper 37 at 2-3 (PTAB Apr. 14, 2015) (ordering “Patent Owner Shall produce all documents within its possession or control” that **“concern”** the inconsistent information).

PO argues the documents Petitioner cited did not include inconsistencies. Ex. 1028, 10:19-21. PO alleges that because other documents or statements reflected consistent positions, there are no inconsistencies. But that PO made other statements that it considers “consistent” with its positions does not negate the inconsistent information, or relief PO from producing it. Although Petitioner discussed additional exemplary inconsistencies at the meet and confer, for space, and to preserve confidentiality, Petitioner addresses three here.

First, Ex. 1031 includes inconsistent information and PO should have produced it. In Ex. 1031, PO stated that “presence of hydrogen ... evidenced a compensated GaN layer.” *Id.*, 17. To the PTAB, however, PO now argues that “mere presence of hydrogen does not result in a compensated GaN layer.” POR, 31. That is inconsistent. At the meet and confer PO attempted to justify the inconsistency arguing that because the ITC Administrative Law Judge (“ALJ”) had found “presence of hydrogen” to be one of several factors in determining a “compensated GaN layer,” there was no inconsistency. But PO purported justifications for the inconsistency does not negate PO’s discovery obligations. Regardless of the ALJ

determinations, Ex. 1029 includes “relevant information that is inconsistent” with a position in the POR. PO had to produce it.

Second, Ex. 1032 also includes inconsistent information with a POR position. In Ex. 1032, Dr. Schubert stated that “neutralizing” dopants with hydrogen implantation was “widely used” and “very attractive for device application.” *Id.*, 379-383. Yet, to the PTAB, PO and Dr. Schubert argue that such process would be “highly counter intuitive.” POR, 44. This is also inconsistent. PO argued that the exemplary inconsistent information was not representative of Dr. Schubert’s overall position and that he provided other opinions consistent with the POR. But, again, that Dr. Schubert provided additional opinions does not change the fact that Ex. 1032 includes relevant inconsistent information that PO should have produced.

Third, at the ITC hearing Dr. Schubert admitted that in prior art *Uemoto* “layer 15b ... meets the claim term ‘compensated gallium nitride.’” Ex. 2017, 1034:4-7. To the PTAB, PO now argues that the “region 15b ... cannot correspond to the compensated GaN layer.” POR, 52. That is inconsistent. PO argued that even if Dr. Schubert’s statement was inconsistent, other of his statements in the ITC record were consistent. But PO’s attempt to explain the inconsistent information with other documents or statements, does not negate its discovery obligations to “serve relevant information that is inconsistent with a position.” 37 CFR § 42.51(b)(1).

In each of these three examples, PO's attempt to justify the evident inconsistencies between information provided to the ITC and its POR positions does not excuse an incomplete production. The above-cited ITC documents include "relevant information that is inconsistent with a position advanced by the party." 37 CFR § 42.51(b)(1). The ITC documents contain information that is "inconsistent," regardless of whether PO also presented other information it considers consistent. The ITC documents undoubtedly include "information that is inconsistent with a position [PO] advanced" (*id.*), no matter how PO spins them. And any proffered explanation for the inconsistency does not obviate the discovery obligation to at least produce the documents. Regardless of whether PO believes the inconsistent positions were justified, corrected later, or explained elsewhere, the documents including the inconsistent information must have been disclosed.

B. PO Should Certify It Complied With Its Discovery Obligations

At the Board call, PO represented that he "would not object to filing a certification, assuming that is [its] obligation" and that "[i]f [it] look[s] at everything and [is] satisfied that [it has] met [its] obligation, to certify that." Ex. 1028, 22:5-13.

Petitioner has identified exemplary inconsistent information from the public ITC record. At the meet and confer, Petitioner identified even more inconsistencies in the non-public ITC record. It is likely there are even more not yet identified. But "[i]t is not Petitioner's burden to identify documents that Patent Owner should have

produced as routine discovery”(IPR2023-01061, Paper 27 at 4) and “this obligation applies to all information of which Patent Owner is aware, not just the information specifically identified by Petitioner” (IPR2015-00594, Paper 35 at 10). To the extent PO continues to contend that it has complied with its discovery obligations, PO should at least certify that compliance. *See Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 4 (PTAB Mar. 5, 2013) (requiring written confirmation of routine discovery production). This is proper here because PO, its counsel, and its expert have yet to confirm that they have even investigated the potential inconsistent information.

IV. THE ITC PROTECTIVE ORDER DOES NOT PREVENT THE REQUESTED DISCOVERY

Some of the ITC documents with inconsistent information are not public. But the Board can still compel production of those documents. The Board can enter a protective order, the parties can agree to de-designate portions of the documents for use in this proceeding, or they can redact confidential and not relevant information to this proceeding. IPR2015-00594, Paper 35 at 10 (“the ITC Protective Order does not preclude Patent Owner from disclosing documents to Petitioner”). Much, if not all, of the information Petitioner requests (e.g., interpretation of “compensated GaN layer” and information related to prior art) does not qualify as confidential.

Dated: August 9, 2024

/Lionel M. Lavenue/
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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on August 9, 2024, a complete and entire copy of this Petitioner's motion to compel routine discovery under 37 CFR § 42.51 and Exhibits 1029-1032 were provided by email, to the Patent Owner, by serving the correspondence email address of record as follows:

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