

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

EFFICIENT POWER CONVERSION CORPORATION,
Patent Owner.

IPR2023-01381
Patent 8,350,294 B2

Before JON B. TORNQUIST, JEFFREY W. ABRAHAM, and
KIMBERLY McGRAW, *Administrative Patent Judges*.

TORNQUIST, *Administrative Patent Judge*.

ORDER
Denying Petitioner's Motion to Compel Routine Discovery
37 C.F.R §§ 42.51(b)(1), 42.52(a)

I. INTRODUCTION

With prior authorization, Innoscience (Zhuhai) Technology Company, Ltd. and Innoscience America, Inc. (collectively “Petitioner”) filed a Motion to Compel Routine Discovery. Paper 21 (“Mot.” or “Motion”). Efficient Power Conversion Corporation, Patent Owner, filed an Opposition to Petitioner’s Motion. Paper 23 (“Opp.”). For the reasons set forth below, we *deny* Petitioner’s Motion.

II. MOTION TO COMPEL

A. Petitioner’s Arguments

Pursuant to 37 C.F.R. § 42.51(b)(1)(iii), “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 contain the inconsistency.” Petitioner contends that Patent Owner “flatly refuses to produce inconsistent information from the parallel International Trade Commission investigation . . . where [Patent Owner] alleged infringement of the ’294 patent.” Mot. 1.

Petitioner points to statements made in Patent Owner’s ITC Complaint (Ex. 1031), a text book written by Patent Owner’s expert, Dr. Schubert, that was relied upon in both the ITC and the present IPR proceeding (Ex. 1032), and testimony provided during an evidentiary hearing before the ITC (Ex. 2017) as containing information that is inconsistent with statements relating to the scope of the claims and content of the prior art that were set forth in Patent Owner’s Response. Mot. 4–5. Although this evidence is now of record, Petitioner contends it was Patent Owner’s burden to produce such inconsistent information in the first

instance and that Patent Owner must produce non-public documents that contain similar inconsistencies. *Id.* at 5–6.

Petitioner identifies certain non-public information as containing similar inconsistent statements, including (1) non-public exhibits to Petitioner’s ITC complaint; (2) a non-public expert report by Dr. Schubert dated November 13, 2023; (3) non-public deposition transcripts of Dr. Schubert taken between December 14–15, 2024; and (4) non-public portions of the ITC evidentiary hearing transcript from February 26 to March 1, 2024. Mot. 6.

Petitioner contends the inconsistent statements in both the public and non-public information relate to whether the presence of hydrogen evidences a compensated GaN layer, whether hydrogen passivation of dopants was counterintuitive in the relevant time frame, whether layer 15b of Uemoto is a compensated GaN layer, and whether hydrogen can neutralize both n-type and p-type impurities. Mot. 4–5, 7–8.

Petitioner requests that Patent Owner be compelled to produce any and all inconsistent information and that Patent Owner be compelled to certify compliance with its discovery obligation under 37 C.F.R. § 42.51(b)(1)(iii). Mot. 9–10.

B. Patent Owner’s Arguments

Patent Owner contends that the information identified by Petitioner does not in fact contain any inconsistencies. Opp. 1. Patent Owner addresses each of Petitioner’s alleged inconsistencies and asserts that, when viewed in context, the arguments and evidence identified by Petitioner are not inconsistent with Patent Owner’s arguments. *Id.* at 1–8. For example, although Dr. Schubert’s book indicates that neutralizing dopants with

hydrogen implantation was “widely used” and “very attractive for device application,” Patent Owner contends that Dr. Schubert was not addressing GaN or cancellations within a gate. *Id.* at 3–4. Thus, according to Patent Owner, Dr. Schubert’s statements in his book regarding hydrogen implantation are not inconsistent with statements made in the Patent Owner Response that doping of a gate semiconductor followed by cancellation of the effect of the dopant is highly counterintuitive. *Id.* at 3. Patent Owner further asserts that it is “wholly inappropriate to conclude that Dr. Schubert intended statements in his book to apply to GaN technology.” *Id.* at 4 (also stating that the arguments set forth in the Patent Owner response pertain to compensated GaN).

Patent Owner also states that, after conducting a review of the potentially inconsistent information, “Patent Owner certifies that, to the best of its knowledge, Patent Owner has complied with its routine discovery obligations under 37 C.F.R. § 42.51(b)(1)(iii). Opp. 8.

C. Analysis

Upon review of the parties’ arguments, as well as Patent Owner’s explanations as to why the asserted evidence and information are not inconsistent with a position advanced by Patent Owner in this proceeding, we are not persuaded that Patent Owner has failed to comply with the requirements of 37 C.F.R. § 42.51(b)(1)(iii). In particular, when the broader context of Patent Owner’s arguments and assertions are considered, especially in light of Patent Owner certification of compliance, we cannot conclude that the information identified by Petitioner is inconsistent with positions taken by Patent Owner in this proceeding.

Of course, during the course of this proceeding, Petitioner may

marshal the allegedly inconsistent evidence, of which it is clearly aware, and to the extent truly inconsistent arguments have been made before the two tribunals, this may serve to damage the credibility of Patent Owner's arguments and Dr. Schubert's testimony. But, as noted above, we are not persuaded that such inconsistent information has yet been identified.

We note that in a portion of its Opposition, Patent Owner asserts that some identified statements from the ITC proceeding were made before Patent Owner had the benefit of any fact or expert discovery and before Patent Owner prepared and served its infringement contentions. Opp. 2 (citing Ex. 1031). To the extent that Patent Owner's arguments may have evolved during that proceeding, we remind Patent Owner that it is still required to produce information that is inconsistent with arguments made in this proceeding, even if it no longer advocates for those positions.

III. CONCLUSION

For the reasons set forth above, we deny Petitioner's Motion to Compel Routine Discovery. We remind Patent Owner, however, that its discovery obligations are ongoing, and any "information that is inconsistent with a position advanced by" Patent Owner "during the proceeding," must be produced.

IV. ORDER

For the foregoing reasons, it is:

ORDERED that Petitioner's Motion to Compel Routine Discovery is *denied*.

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