

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LAM RESEARCH CORPORATION,
Petitioner,

v.

INPRIA CORPORATION,
Patent Owner.

IPR2024-00033
Patent 9,823,564 B2

Before GRACE KARAFFA OBERMANN and DEBRA L. DENNETT,
Administrative Patent Judges.

OBERMANN, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

I. INTRODUCTION

Petitioner requested a conference call with the panel to address a dispute related to the deposition of Patent Owner's declarant, John S. McCloy, Ph.D. Ex. 3003. The substance of the dispute is set forth in Exhibit 3003. In a nutshell, Patent Owner cited Dr. McCloy's declaration testimony in support of the Patent Owner's Preliminary Response (Paper 11) during the pre-institution phase, but not in the Patent Owner's Response (Paper 19) or Contingent Motion to Amend (Paper 20) during the trial phase. The Response is supported by opinions from a different witness, namely, Sanjay Banerjee, Ph.D. Ex. 2009.

Patent Owner refuses to produce Dr. McCloy for a deposition as a matter of routine discovery, so Petitioner requests that the Board compel Patent Owner to make him available. Ex. 3003. The Board held a teleconference on September 6, 2024, attended by Judge Obermann and Judge Dennett, for the Board, Mr. Dion Bregman and Ms. Alison Patitucci, for Petitioner, and Mr. Daniel Zeilberger and Mr. Michael Wolfe, for Patent Owner. Ms. Kristie Butler-Scarpiello, a Board patent attorney, also attended.

No court reporter was present. This Order is the official record of the teleconference. In the event either party objects to this Order as adequately representing the record of the teleconference, no later than five (5) business days after entry of this Order, the parties shall submit a joint statement identifying their respective positions regarding any objection.

Mr. Bregman presented arguments for Petitioner. Mr. Zeilberger presented arguments for Patent Owner. Arguments were heard for about 30 minutes.

II. BACKGROUND

In Petitioner's view, the opinions of Patent Owner's new declarant, Dr. Banerjee, are "intertwined" with the opinions of Dr. McCloy because Dr. Banerjee says he relies on Dr. McCloy's declaration, his opinions are based on Dr. McCloy's opinions, he agrees with Dr. McCloy's opinions, and he adopts some of Dr. McCloy's opinions. Petitioner further pointed out that Patent Owner did not withdraw the McCloy declaration in the Response and nothing prevents Patent Owner from citing to it later in this proceeding.

Patent Owner, for its part, expressly withdrew Dr. McCloy's declaration during the teleconference and, further, confirmed that Patent Owner would not rely on that declaration during the trial phase of this proceeding. Patent Owner also argued that Dr. Banerjee did not say that he relies on Dr. McCloy's opinions, but instead said that he adopts and agrees with some of Dr. McCloy's opinions. Patent Owner also represented that the portions of Dr. Banerjee's declaration that coincide with Dr. McCloy's declaration are the portions Dr. Banerjee adopts.

The relevant portions of Dr. Banerjee's declaration (Ex. 2009) support Patent Owner's position on that point. Dr. Banerjee's declaration says "I generally agree with the opinions expressed by Dr. McCloy in his declaration and portions of his analysis are adopted as my own in this declaration, where relevant." *Id.* at 8 n.1. Dr. Banerjee states further that "[i]n forming my opinions expressed in this Declaration, I reviewed the following materials and information: . . . McCloy Declaration (EX2001) . . . My opinions contained in this declaration are based on the documents I reviewed and my knowledge and professional judgment." *Id.* ¶¶ 17–18.

Patent Owner further argued that we should not permit Petitioner to depose Dr. McCloy because Patent Owner is no longer relying on his declaration. Patent Owner explained that, although it relied on Dr. McCloy's declaration in the Preliminary Response, it did not rely on that declaration in the Response because Dr. McCloy is serving as one of Patent Owner's witnesses in the related district court litigation and is privy to confidential information in that case. In other words, Patent Owner substituted witnesses to avoid producing Dr. McCloy for a deposition in this proceeding.

At the conclusion of arguments, we denied Petitioner's request. This Order explains our reasoning.

III. DISCUSSION

We have discretion to “determine a proper course of conduct in a proceeding for any situation not specifically covered by [37 C.F.R. § 42] and may enter non-final orders to administer the proceeding.” 37 C.F.R. § 42.5. Additionally, we “may waive or suspend a requirement of parts 1, 41, and 42 and may place conditions on the waiver or suspension.” *Id.* In applying our discretion, we consider the effect “on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings” (35 U.S.C. § 316(b)) in view of the AIA's goal “to establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs” (H.R. Rep. No. 112–98, pt. 1, at 40 (2011)).

“Cross examination of affidavit testimony prepared for the proceeding” falls under “routine discovery” in 37 C.F.R. § 42.51(b)(1) and “the cross-examination of the other side[']s declarants” is included in the definition of “routine discovery” in the Patent Trial and Appeal Board

Consolidated Trial Practice Guide (84 Fed. Reg. 64,280 (Nov. 21, 2019))¹ (“CTPG”). The CTPG makes plain, however, that we have discretion to determine whether “a party has the opportunity to cross-examine a witness providing declaration testimony submitted by another party” (*id.* at 51). As the CTPG explains,

The weight to be given testimonial evidence submitted with the preliminary response in reaching the final written decision will be decided **on a case-by-case basis**. In general, a party has the opportunity to cross-examine a witness providing declaration testimony submitted by another party, after institution, **unless the Board orders otherwise**. 37 C.F.R. § 42.51(b)(1)(ii). If a trial is instituted, **a patent owner may choose not to rely on testimony submitted with the preliminary response**. In that case, the patent owner should advise the Board of its decision, which can be done by affirmatively withdrawing the testimony in the patent owner response. **If a patent owner withdraws a declaration submitted with its preliminary response, that declarant will usually not be subject to deposition on the withdrawn declaration**. If, on the other hand, the patent owner does not withdraw a declaration submitted with its preliminary response, that declaration may be relied upon during the trial, and the declarant would usually be subject to discovery and deposition in the ordinary course of the trial.

Id. (Board’s emphasis).

We interpret this excerpt of the CTPG as generally providing a petitioner the opportunity to cross-examine a patent owner’s witness, where that witness provides declaration testimony in support of the patent owner’s preliminary response, but we have the discretion to order otherwise if the patent owner withdraws the declaration. Non-precedential orders, entered by the Board in proceedings in which a patent owner’s preliminary response

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

relied on testimony from one declarant and the patent owner's response relied on testimony from a different declarant, support that conclusion. *See, e.g., Google LLC v. Cywee Group Ltd.*, IPR2018-01257, Paper 17 (PTAB Apr. 18, 2019); *Reactive Surfaces Ltd., LLP v. Toyota Motor Corporation*, IPR2016-01462, Paper 30 (PTAB May 21, 2017).

For example, in *Google*, the Board acknowledged that “[r]outine discovery includes ‘[c]ross examination of affidavit testimony prepared for the proceeding’” but, nonetheless, concluded that the petitioner was “not entitled to cross-examine” the patent owner's declarant because the patent owner expressly indicated that it would file an express withdrawal of the declaration testimony. *Google*, Paper 17 at 1–2.

In *Reactive Surfaces*, by contrast, the Board concluded that cross-examination of the patent owner's declarant “is available as a matter of routine discovery” and determined that “[i]f the testimony is prepared for the preliminary proceeding and not subsequently relied upon during the trial, cross-examination of the declarant may be unnecessary, but it is permitted.” *Reactive Surfaces*, Paper 30 at 2. The Board was “not persuaded that there is a clear need for Petitioner to take the deposition of [patent owner's expert declarant],” however, permitted the petitioner to depose the declarant about the asserted grounds on which the Board instituted trial and matters affecting the declarant's credibility. *Id.* at 2–3.

Petitioner's request to depose Dr. McCloy falls within the scope of routine discovery because Dr. McCloy prepared affidavit testimony for the proceeding. But because Patent Owner has expressly withdrawn Dr. McCloy's declaration, we have discretion to consider whether cross-

examining Dr. McCloy furthers the speedy, fair, and cost-effective resolution of the case. For several reasons, we are not persuaded that it does.

During the teleconference, the Board pointed out that Dr. McCloy's opinions are no longer at issue in this proceeding. Against that backdrop, Petitioner was unable to articulate a "clear need" for the requested discovery. *Reactive Surfaces*, Paper 30 at 2. Further, Petitioner failed to explain adequately why cross-examination of Dr. Banerjee, regarding the basis of his opinions, is inadequate under the particular facts and circumstances of this case. *See* Ex. 2008 ¶ 17 & n.1 (Dr. Banerjee, indicating that, in "forming" ***his own opinions***, he "reviewed" the McCloy declaration and, "where relevant," adopted them "***as his own***") (Board's emphasis). Instead, Petitioner repeatedly asserted, in conclusory terms, that Dr. McCloy's opinions are "intertwined" with those of Dr. Banerjee.

Petitioner persisted in arguing that the record reflects that Dr. Banerjee's opinions are "intertwined" with Dr. McCloy's opinions, even after Patent Owner averred that, where Dr. Banerjee adopts Dr. McCloy's opinions "as his own" (Ex. 2008 8 n.1), the opinions are included word-for-word in the Banerjee declaration. Petitioner was not able to provide any cogent reason why a deposition of Dr. Banerjee, under these circumstances, is insufficient to satisfy Petitioner's genuine discovery needs.

Petitioner also faulted Patent Owner for failing to timely withdraw Dr. McCloy's declaration with the Patent Owner's Response. We consider Patent Owner's failure to withdraw Dr. McCloy's declaration in the Response harmless, where Patent Owner readily and expressly withdrew the declaration during the teleconference. We see no prejudice as a result of the timing of the withdrawal.

In addition, Patent Owner provides a reasonable explanation for its decision to substitute the Banerjee declaration, during the trial phase, for the McCloy declaration, which supported the Preliminary Response. As discussed above, Patent Owner substituted Dr. Banerjee for Dr. McCloy out of an abundance of caution because Dr. McCloy is privy to confidential information in the related district court litigation and Patent Owner does not want to expose him to cross-examination in this forum. Patent Owner also averred that it will not cite the McCloy declaration during the trial phase of this proceeding, thereby removing any of Petitioner's concerns on that point.

IV. CONCLUSION

Based on the unique and particular facts at hand, we deny Petitioner's request to cross-examine Dr. McCloy because his opinions are no longer at issue, Patent Owner has expressly withdrawn his declaration, the opinions set forth in Dr. Banerjee's declaration plainly are his own (even if formed after review of the McCloy declaration (Ex. 2008 ¶ 17 & n.1)), Patent Owner explains adequately why it seeks to shield Dr. McCloy from cross-examination in this proceeding, and Petitioner does not demonstrate a "clear need" for the requested discovery. *Reactive Surfaces*, Paper 30 at 2.

V. ORDER

It is

ORDERED that Petitioner's request to compel Patent Owner to make Dr. John S. McCloy available for deposition as a matter of routine discovery is *denied*; and

FURTHER ORDERED that, in the event either party objects to this Order as adequately representing the record of the teleconference, no later

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than five (5) business days after entry of this Order, the parties shall submit a joint statement identifying their respective positions regarding any objection.

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