

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, CHRISTOPHER M. KAISER,
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, Jason K. Stowers, Ph.D. *See* Exs. 3004–3006. The substance of the dispute is set forth in Exhibits 3004–3006. At the Board's request (*see* Ex. 3005), Petitioner filed a copy of Dr. Stowers' deposition transcript. Ex. 1032.

Petitioner deposed Dr. Stowers on the declaration prepared in support of Patent Owner's Response. *See* Ex. 2008 (Dr. Stowers' declaration). Petitioner asked Dr. Stowers questions about the substance of an email submitted as Attachment A to the declaration as well as questions about the connection between the email and Dr. Stowers' doctoral thesis. Ex. 1032, 54:17–80:20¹; *see* Ex. 1008 (doctoral thesis); *see also* Ex. 2008, 5–6 (Attachment A to Dr. Stowers' declaration).

Patent Owner objected to some of these questions as outside the scope of Dr. Stowers' declaration. *See, e.g.*, Ex. 1032, 67:5–10, 68:7–9. Petitioner stopped the deposition to discuss the dispute with the Board, but was unable to reach the Board while the parties and Dr. Stowers were available. *Id.* at 68:10–68:19. The parties suspended the deposition without resolution of the dispute. *Id.* at 80:15–81:21.

Petitioner contacted the Board for its guidance on Patent Owner's objections and to seek a continuation of the deposition to complete its questioning of Dr. Stowers. *See* Exs. 3004–3006. The Board held a teleconference on October 24, 2024, attended by Judge Obermann, Judge Kaiser, and Judge Dennett, for the Board; Mr. Dion Bregman and

¹ We refer to the original page numbers of Exhibit 1032, not the page numbers added by Petitioner.

Ms. Alison Patitucci, for Petitioner; and Mr. Michael Wolfe, Mr. Daniel Zeilberger, and Mr. Paul Anderson, 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. Wolfe presented arguments for Patent Owner. Arguments were heard for about 30 minutes.

II. BACKGROUND

On October 11, 2024, Petitioner deposed Dr. Stowers as a matter of routine discovery under 37 C.F.R. § 42.51 because Dr. Stowers prepared a declaration in support of Patent Owner's Response. Ex. 2008 (declaration). The declaration discusses the publication timeline and public availability of Dr. Stowers' doctoral thesis (*id.*), which Petitioner advances in its challenges to the patentability of U.S. Patent No. 9,823,564 B2.

According to the declaration, Dr. Stowers submitted the thesis to the Oregon State University Library with a request to restrict the thesis from public view for a year (an "embargo") in October 2008. Ex. 1008 ¶¶ 4–5, 7. In February 2010, Dr. Stowers emailed a colleague to let them know the embargo had been lifted. Ex. 2008 ¶ 8; *see id.* at 5–6 (Attachment A).

In the email to this colleague, Dr. Stowers stated that the "[r]elevant magic sauce recipe is on page 68. Doug had me leave it vague." *Id.* at 6 (Attachment A). During the deposition at issue in the instant case, Petitioner questioned Dr. Stowers about the meaning of the statement regarding the

“magic sauce recipe,” which led to the current dispute between the parties. *See* Ex. 1032, 59:7–65:22.

In Petitioner’s view, Patent Owner instructed Dr. Stowers not to answer Petitioner’s questions regarding the “magic sauce recipe” because Patent Owner said that it would not allow Petitioner’s line of questioning. *See* Ex. 1032, 65:23–68:17. Petitioner contends it would have asked additional questions about the “magic sauce recipe” if Patent Owner had not put an end to this line of questioning, and argued that such questions relate to Dr. Stowers credibility.

Petitioner seeks production of Dr. Stowers for a continuation of the deposition to ask additional questions that, in Petitioner’s view, relate to Dr. Stowers’ credibility and the embargo. Specifically, in that regard, Petitioner asserts that Dr. Stowers, during the deposition, demonstrated a “selective memory” about the email and events occurring around the time of the drafting of the thesis and, further, Petitioner seeks a continuation of questioning to try to figure out what Dr. Stowers does not remember. Petitioner argued that two Board decisions are instructive here because cross-examination may include matters affecting a witness’ credibility (*Reactive Surfaces Ltd., LLP v. Toyota Motor Corp.*, IPR2016-01462, Paper 30 at 3 (PTAB May 31, 2017)) and can include information submitted during the proceeding as long as it is relevant to the proceeding (*Sony Interactive Entertainment LLC v. Quantum Imaging LLC*, IPR2023-00954, Paper 22 at 5–6 (PTAB Mar. 13, 2024)).

In Patent Owner’s counterview, Petitioner’s questions about the “magic sauce recipe” and Dr. Stowers’ thesis are outside the scope of Dr. Stowers’ declaration, which is narrowly related only to the facts of its

publication embargo and the question of its date of public availability. *See* Ex. 1008 (Dr. Stowers' declaration).

Further, Patent Owner disagrees that it instructed Dr. Stowers not to answer Petitioner's questions about the "magic secret sauce" that is referenced in the email attachment to the declaration, arguing that, to the contrary, Patent Owner allowed Dr. Stowers to answer Petitioner's questions, even though they were outside the scope of Dr. Stowers' declaration. Patent Owner contends, in addition, that Dr. Stowers answered Petitioner's questions about the "magic sauce recipe" fully and completely, by responding that they do not remember what that phrase means.

At the conclusion of arguments, we denied Petitioner's request for a continuation of the deposition to allow further cross-examination of Dr. Stowers. This Order explains our reasoning.

III. DISCUSSION

"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))² ("CTPG"). The proper scope of cross-examination testimony is controlled by 37 C.F.R. § 42.53(d)(5)(ii), which provides that, "[f]or cross-examination testimony, the scope of the examination is limited to the scope of the direct testimony." The Federal Rules of Evidence also apply to Board proceedings (*see* 37 C.F.R. § 42.62(a)) and provide that cross-examination may also

² *Available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

include “matters affecting the witness’ credibility.” *See* Fed. R. Evid. 611(b). Taken together, we interpret these rules as allowing a witness to be cross-examined on any topic on which they provided direct testimony, as well as any matter affecting their credibility.

The CTPG provides “Testimony Guidelines” for examination and cross-examination. CTPG 127–30. The CTPG provides that an objection to evidence or the manner of taking testimony “must be noted on the record, but the examination still proceeds; testimony is taken subject to any such objection.” *Id.* at 128. Moreover, the CTPG provides that “[c]ounsel may instruct a witness not to answer only when necessary to preserve a privilege, to enforce a limitation ordered by the Board, or to present a motion to terminate or limit the testimony.” *Id.* at 129. We interpret these guidelines as allowing a party to object to an opposing party’s questions during a deposition, but also, as prohibiting the party from instructing its witness not to answer the opposing party’s questions unless necessary to preserve a privilege, to enforce a limitation ordered by the Board, or to present a motion to terminate or limit the testimony.

With these principles in mind, we considered the parties’ arguments and the transcript of Dr. Stowers’ deposition (Ex. 1032).

The deposition transcript supports Patent Owner’s position that Dr. Stowers answered Petitioner’s question, when asked what was meant, at the time of the email, by the term “magic sauce recipe,” as Dr. Stowers responded “I don’t know.” Ex. 1032, 60:16–17. Further, when Petitioner asked Dr. Stowers what meaning would apply to the phrase “magic sauce recipe” today, Dr. Stowers responded that “magic sauce is basically how to do something.” *Id.* at 60:18–61:1. And when Petitioner asked Dr. Stowers if

“magic sauce is really a colloquial way of saying the invention, the special thing, something like that,” Dr. Stowers responded by saying “Yeah, or a joke. I don't remember. It was quite a long time ago.” *Id.* at 61:5–9. We view these as full and complete answers to the questions lodged by Petitioner’s counsel during the deposition.

The relevant portions of Dr. Stowers’ deposition transcript also support Patent Owner’s view that it did not instruct Dr. Stowers not to answer any question posed on the record by Petitioner during the deposition. Nevertheless, we recognize that Patent Owner’s counsel effectively shut down any additional questions by objecting to Petitioner’s line of questioning regarding the “magic sauce recipe.” But Patent Owner did not object to Petitioner’s questions until Petitioner began asking about particular pages of Dr. Stowers’ thesis. *See* Ex. 1032, 62:7–65:22.

Even when Patent Owner objected to the questions about the pages of Dr. Stowers’ thesis, however, it did not instruct Dr. Stowers not to answer Petitioner’s questions, and Dr. Stowers answered them. *See id.* Patent Owner did not do anything more than object to Petitioner’s questions as beyond the scope of the declaration, until Petitioner began asking about the substance of Dr. Stowers’ thesis. *Id.* at 65:23–68:17.

At that time, Patent Owner indicated it was trying to understand how Petitioner’s questions, regarding the technical aspects of the thesis, were relevant to Dr. Stowers’ declaration, which is limited to the issues of embargo and public accessibility of the thesis. *Id.* Petitioner responded by arguing that Dr. Stowers relied on the thesis in the email attached to the declaration (Ex. 2008, Attachment A), and also suggested that the parties take the issue up with the Board. *Id.* Patent Owner disagreed that

Dr. Stowers relied on the technical details of the thesis in the declaration, and disagreed that the technical details of Dr. Stowers' thesis are within the scope of cross-examination. *Id.* Accordingly, Patent Owner indicated it would not allow Petitioner to pursue its line of questioning. *Id.*

Based on our review of the transcript of Dr. Stowers' deposition (Ex. 1032), we agree with Petitioner that Patent Owner effectively shut down its line of questioning regarding the technical aspects of the "magic sauce recipe" to the extent that recipe could be gleaned from the technical disclosures of the thesis. We are not persuaded that Petitioner's additional questions would have been within the proper scope of cross-examination, or that its additional questions would have been so clearly within the proper scope of cross-examination that we should delay the proceeding to require Dr. Stowers to be subjected to further cross-examination.

To be clear, Dr. Stowers' understanding of the term "magic sauce recipe" referred to in the email attached to the declaration is a topic within the scope of direct testimony; however, we find that Patent Owner allowed Dr. Stowers to answer Petitioner's questions about that meaning, and that Dr. Stowers answered the questions with "I don't know" or "I don't remember" as discussed above, which are full and complete answers. *See* Ex. 1032, 60:16–61:1, 61:5–9.

Also as discussed above, we interpret our rules as allowing a witness to be cross-examined on any topic on which they provided direct testimony, as well as any matter affecting their credibility. Petitioner does not show sufficiently that the additional testimony sought via a continued deposition relates to any topic on which Dr. Stowers provided direct testimony in the

form of the three-page declaration, which focuses exclusively on the asserted thesis embargo and public accessibility. *See* Ex. 1008 (declaration).

Nor are we persuaded that Petitioner identifies adequately any further issue of credibility sufficient to require Dr. Stowers, who is a named inventor of the challenged patent, to be subjected to a continued deposition at this relatively late stage of the proceeding about the technical aspects of the thesis. Ex. 2008, Attachment A; *see* Ex. 1001, code (72) (named inventors). Under the particular and unique circumstances presented on this record, we determine that denial of the requested relief properly balances the strong need for a speedy, efficient, and just resolution of this *inter partes* review proceeding against the relative weakness of Petitioner's showing of any true need for the requested discovery.

IV. CONCLUSION

For the above reasons, we deny Petitioner's request for further cross-examination of Dr. Stowers because we are not persuaded that Petitioner's additional questions are properly within the scope of cross-examination, or that Dr. Stowers did not answer the questions Petitioner asked about the "magic sauce recipe."

V. ORDER

It is

ORDERED that Petitioner's request to compel Patent Owner to make Dr. Jason K. Stowers available for additional cross-examination 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 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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