

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LAM RESEARCH CORP.,
Petitioner,

v.

INPRIA CORP.,
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

*Denying Petitioner's Motion for Authorization to
Compel Testimony and Production of Documents;
Setting a Schedule to Complete Routine Discovery;
And Setting a Schedule for Post-Hearing Submissions
37 C.F.R. §§ 42.5; 42.51(b); 42.52*

I. INTRODUCTION

Petitioner seeks authorization to compel (1) a deposition of its own declarant, Ms. Heather Stewart, and (2) production of documents from Ms. Stewart and her non-party employer, ProQuest, regarding Ms. Stewart’s Original Declaration (Ex. 1041). Paper 38 (“Motion”), 1.¹ The Original Declaration was prepared by Ms. Stewart voluntarily at Petitioner’s request and filed in support of Petitioner’s Reply. *Id.* at Ex. A, 1–2 and ¶ 5.²

Petitioner relies on the Original Declaration for the sole purpose of contesting Patent Owner’s evidence that Stowers 2008³ does not qualify as prior art — a pivotal issue, given that Petitioner asserts Stowers 2008 in three of the five patentability challenges identified in the Petition. Paper 27 at 9–10 (Petitioner’s Reply); *see* Paper 19 at 25–28 (Patent Owner’s Response, including evidence that Stowers 2008 does not qualify as prior art); *see also* Paper 1 at 3 (grounds chart, identifying five challenges).

¹ Paper 38 is “Petitioner’s Motion for Authorization to Compel Testimony and Production of Documents under 37 C.F.R. § 42.52(a).” The Motion seeks to compel additional discovery beyond that provided by our routine discovery rule. *See* 37 C.F.R. § 42.51(b) (Board’s routine and additional discovery rules); Paper 38 at Ex. A, 1–2 (proposing document requests and deposition topics that exceed the scope of routine discovery).

² The parties should not file exhibits as attachments to papers. Exhibit A is attached to Paper 38 and consists of two documents with non-sequential pagination: (1) Petitioner’s Requests for Production of Documents and Request for Deposition Topics; and (2) the Declaration of Dion M. Bregman (Petitioner’s lead counsel). When citing Exhibit A, we refer to page numbers of the discovery requests and paragraph numbers of the declaration.

³ Stowers, Jason K., *Direct patterning of solution deposited metal oxides*. Oregon State University, 2009 (Ex. 1008).

Ms. Stewart’s non-party employer, ProQuest, is an information company that collects and publishes “content from a wide range of sources, including dissertations and master’s theses.” Ex. 1041 ¶ 2. Stowers 2008 is the doctoral thesis of Jason K. Stowers, Ph.D., a named inventor of the challenged patent. *See* Ex. 1001, code (72) (list of inventors); Ex. 2008 ¶¶ 3–4 (Dr. Stowers, attesting to the facts surrounding the publication date of his doctoral thesis; that is, Stowers 2008 (Ex. 1008)).

Patent Owner opposes the Motion. Paper 42 (“Opposition”). In its Opposition, Patent Owner states it “has consistently requested Ms. Stewart’s deposition” as a matter of routine discovery, but Petitioner has not satisfied its obligation to produce its declarant for cross-examination as required by our routine discovery rule. Paper 42 at 8; 37 C.F.R. 45.51(b)(1)(ii); Paper 31 (Patent Owner’s notice of deposition of Ms. Stewart).

In support of its Opposition, Patent Owner also relies on Exhibit 2013, which is a Supplemental Declaration of Ms. Stewart. Paper 42 at 3 (citing Ex. 2013). Importantly, Patent Owner advances Exhibit 2013 to establish that Stowers 2008 does *not* qualify as prior art. Paper 43 at 8–10 (Patent Owner’s Sur-reply). In other words, although Exhibit 2013 was prepared by Ms. Stewart at Petitioner’s request, and subsequently disclosed to Patent Owner by Petitioner’s counsel, Patent Owner (not Petitioner) is the party who proffers and relies on that Supplemental Declaration for the truth of the matters asserted. *Id.*; *see* Paper 28 at Ex. A ¶¶ 5–8 (Petitioner’s counsel, Mr. Bregman, attesting to this sequence of events).

The Supplemental Declaration (Exhibit 2013) proffered by Patent Owner includes Ms. Stewart’s sworn testimony that:

(1) contradicts her Original Declaration (Ex. 1041), proffered by Petitioner, which indicates that Stowers 2008 was published in January 2009, *prior to* August 5, 2009, the earliest priority date of the challenged claims (*id.* ¶ 8); and

(2) attests that Stowers 2008, in fact, first was published in December 2009, and corroborates Dr. Stowers' sworn testimony (Ex. 2008 ¶¶ 1–10) that, due to a one-year embargo on publication, his thesis (Stowers 2008, which bears a date of August 14, 2008) published only *after* August 5, 2009, the earliest priority date of the challenged claims.

Compare Ex. 1041 ¶ 8, *with* Ex. 2013 ¶ 8; *see* Paper 28 at Ex. A ¶¶ 5–8 (Petitioner's counsel, Mr. Bregman, generally attesting to these factual circumstances); Ex. 1001, code (63) (establishing August 9, 2009, as the earliest priority date for the challenged claims).

II. ANALYSIS

A. *Resolution of Routine Discovery Issues*

This Order was prompted by Petitioner's Motion for additional (as opposed to routine) discovery under 37 C.F.R. § 42.51. *See supra* n.1. The information presented in the Motion and Opposition, however, makes plain that both parties have failed to comply fully with their routine discovery obligations under that rule. In particular, two declarations of Ms. Stewart are in evidence (Exs. 1041, 2013), yet to date, Ms. Stewart has not been produced for cross-examination as required under Section 42.51(b)(1)(ii).

We begin our analysis by instructing both parties to complete routine discovery according to the parameters and time table set forth below. Our *sua sponte* action is warranted, given the exceedingly advanced stage of this proceeding; namely, all trial-phase briefs have been filed and final oral arguments are set to commence in a matter of weeks. Paper 14 (Scheduling

Order). Our *sua sponte* resolution of the outstanding routine discovery issues, moreover, simplifies our decision on the opposed Motion.

1. Original Declaration of Ms. Stewart (Ex. 1041)

A party is entitled to cross-examine an opposing party's declarant as a matter of routine discovery. 37 C.F.R. § 42.51(b)(1)(ii). Ms. Stewart is Petitioner's declarant because Petitioner is the party who proffered her Original Declaration (Ex. 1041) and, further, Petitioner relies on that declaration in support of its Reply. Paper 27 at 9–10 (citing Ex. 1041).

Petitioner has not satisfied its obligation to produce Ms. Stewart for cross-examination by Patent Owner about Exhibit 1041, even though Patent Owner noticed the deposition of Ms. Stewart on November 8, 2024 (Paper 31). In that regard, Petitioner “recently suggested that” Patent Owner should “wait to take Ms. Stewart's deposition until after the Board acts on” the instant Motion. Paper 42 at 8 (citing Ex. 2015).

To be clear, the provisions of Section 42.51(b)(1)(ii) “**require** that when a party proffers a witness's testimony by affidavit, that party **must** make the witness available for cross-examination by the other party.” *New World Medical, Inc. v. Microsurgical Tech., Inc.*, IPR2020-01573, Paper 49 at 5 (PTAB Nov. 5, 2021) (and authority cited therein) (Board's emphasis).

For the above reasons, we instruct Petitioner to produce Ms. Stewart for cross-examination by Patent Owner about Exhibit 1041 pursuant to Rule 42.51(b)(1)(ii). *See* Ex. 1041 (Original Declaration filed by Petitioner); Paper 27 at 9–10 (Petitioner, relying on Exhibit 1041).

2. Supplemental Declaration of Ms. Stewart (Ex. 2013)

Rule 42.51(b)(1)(ii) applies with equal force to the Supplemental Declaration of Ms. Stewart. Ex. 2013 (Supplemental Declaration filed by

Patent Owner). Although Ms. Stewart prepared the Supplemental Declaration at Petitioner's request, Patent Owner (not Petitioner) is the party who proffered, and relies upon, that declaration as bearing on the prior art status of Stowers 2008. Paper 43 at 8–10 (Patent Owner's Sur-reply Reply, citing Exhibit 2013). In other words, Ms. Stewart is not just Petitioner's declarant, but likewise is Patent Owner's declarant.

We understand Petitioner's Motion to include an implicit request to depose Ms. Stewart about Exhibit 2013 as a matter of routine discovery. *See* Paper 28 at Ex. A, 2 (Petitioner's proposed Deposition Topics 3–5). We instruct Patent Owner to produce Ms. Stewart for cross-examination by Petitioner about Exhibit 2013 pursuant to Rule 42.51(b)(1)(ii) according to the parameters and time table set forth below.

First, however, we address Patent Owner's improper filing of Exhibit 2013 in support of its Sur-reply, which violates our rules. *See* 37 C.F.R. § 42.23(b) ("A sur-reply may only respond to arguments raised in the corresponding reply and may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness."). We take notice that this violation is linked directly to Petitioner's failure to timely produce Ms. Stewart for cross-examination by Patent Owner about Exhibit 1041, which thereby deprived Patent Owner of its opportunity to support the Sur-reply with permissible "deposition transcripts of the cross-examination of any reply witness." *Id.*

Accordingly, under the unique and particular circumstances at hand, including that Exhibit 2013 came to the parties' attention exceedingly late in this proceeding, we view Patent Owner's filing of Exhibit 2013 with its Sur-reply as an expedient mechanism for facilitating the just and efficient

development of a full and fair trial record on a crucial factual issue (the prior art status of Stowers 2008). *See* Paper 42 at 9 (Opposition, filed “eight days” prior to the Sur-reply). In addition, any prejudice to Petitioner, resulting from allowing the unauthorized submission of Exhibit 2013 with Patent Owner’s Sur-reply, is mitigated by the routine discovery ordered, and the supplemental briefing authorized, in the next two sections of our analysis.

3. Instructions for Completion of Routine Discovery

Petitioner and Patent Owner both are obligated to produce Ms. Stewart for cross-examination to comply with routine discovery as provided in 37 C.F.R. § 42.51(b)(1)(ii).

Nevertheless, we recognize that, sometime after Ms. Stewart prepared her Original Declaration (Ex. 1041), her employer, ProQuest, retained counsel and ceased cooperating voluntarily with Petitioner’s counsel to secure Ms. Stewart’s appearance for a deposition. *See* Paper 28 at Ex. A ¶¶ 5–12 (Petitioner’s counsel, explaining the trajectory of his dealings with ProQuest). In Patent Owner’s view, ProQuest likely “is now concerned it will face two separate depositions” — one conducted by Patent Owner about Exhibit 1041 and another conducted by Petitioner about Exhibit 2013. Paper 42 at 8 (citing Ex. 2015). To minimize the burden and expense on the non-party declarant and her employer, we instruct Petitioner and Patent Owner to jointly produce Ms. Stewart for a single deposition as follows:

(1) The parties shall jointly produce Ms. Stewart for a single deposition, to be conducted no later than February 5, 2025. That time constraint is necessary to facilitate the Board’s duty to issue a final written decision within one year of institution of this review. Joint production, moreover, is warranted because both parties proffer Ms. Stewart as a

declarant. *See* Paper 27 at 9–10 (Petitioner, proffering Exhibit 1041); Paper 43 at 8–10 (Patent Owner, proffering Exhibit 2013).

(2) The cross-examination of Ms. Stewart shall be strictly limited in scope to the factual assertions in Exhibits 1041 and 2013.

(3) The parties shall cooperate to equitably share the burden and expense associated with Ms. Stewart’s deposition. *See HTC Corp. v NFC Technology, LLC*, IPR20214-01198, Paper 41 at 3–4 (PTAB Nov. 6, 2015) (explaining why the burden and expense of producing a non-party witness for deposition “should normally fall on the party presenting the witness”).

(4) The parties shall work together to accommodate all reasonable requests of Ms. Stewart and her employer, ProQuest, to ensure that the deposition is conducted in a manner that minimizes the burden on these non-parties at a location and time agreeable to these non-parties (within the confines of our instruction that the deposition must take place no later than February 5, 2025). For example, remote attendance of Ms. Stewart by videoconference should be offered as an option.

(5) To further mitigate the burden on the non-party declarant and her employer, and because the deposition shall be strictly limited to the relatively narrow and discrete factual assertions set forth in Exhibits 1041 and 2013, the deposition shall be limited to three (3) hours in duration. *See Coastal Industries., Inc. v. Show Enclosures America, Inc.* IPR2017-00573, Paper 27 at 2, 9–10 (PTAB Feb. 20, 2018) (limiting the deposition of a non-party declarant to three (3) hours, where cross-examination was limited to facts surrounding the publication date of an asserted prior art reference).

(6) Counsel may examine Ms. Stewart in any order agreed to by all parties and the non-party witness, but must comply with these parameters:

Patent Owner's cross-examination of Ms. Stewart about Exhibit 1041 shall not exceed sixty (60) minutes; Petitioner's cross-examination of Ms. Stewart about Exhibit 2013 shall not exceed sixty (60) minutes; Patent Owner's re-direct examination shall not exceed thirty (30) minutes; and Petitioner's redirect examination shall not exceed thirty (30) minutes.

(7) The parties shall jointly present this Order to ProQuest's counsel, along with a joint request that ProQuest consent to the voluntary production of Ms. Stewart for a deposition conducted according to the parameters and time table set forth in this Order.

(8) In the event that ProQuest declines to voluntarily produce Ms. Stewart, the parties, under 37 C.F.R. § 42.52(a), shall cooperate to jointly seek a federal district court subpoena to compel her appearance for the deposition. *See Johns Manville Corp. v. Knauf Insulation Inc.*, IPR2015-01453, Paper 16 (PTAB March 4, 2016) (authorizing parties to jointly seek a district court subpoena to compel testimony from a non-party declarant).

B. Impact on the Schedule and Mitigation of Prejudice

The Board does not anticipate that this Order will require postponing the final hearing. However, taking account of the importance of the issue at hand (namely, whether Stowers 2008 qualifies as prior art), and in an effort to mitigate any prejudice to the parties resulting from the timing of Ms. Stewart's deposition, which may occur after the final hearing, we *sua sponte* authorize the following submissions:

(1) As soon as practical, the parties shall jointly file as an exhibit in this proceeding the official transcript of Ms. Stewart's deposition.

(2) No later than February 19, 2025, each party may file a supplemental brief, not to exceed five (5) pages in length, strictly limited to

addressing the relevancy of Ms. Stewart's deposition testimony to the issue of whether Stowers 2008 qualifies as prior art against the challenged patent claims.

(3) No later than February 26, 2025, each party may file a paper, not to exceed five (5) pages in length, that responds to their opposing party's supplemental brief.

(4) No later than February 28, 2025, the parties shall meet and confer to resolve whether the Board should conduct a telephonic conference with the parties to hear arguments on the supplemental briefs.

(5) No later than February 28, 2025, the parties shall jointly file a paper, not to exceed one (1) page in length, which indicates their joint position (or, if no joint position is reached, clearly and succinctly sets forth their respective positions) about such a conference.

(6) No new declaration evidence may accompany any paper authorized by this Order.

C. Resolution of Additional Discovery Issues

We next resolve the Motion, in which Petitioner seeks from Ms. Stewart additional discovery, beyond that provided by routine discovery. *See supra* n.1; Paper 38 at Ex. A, 1–2 (proposed discovery). Petitioner, as the moving party, bears “the burden of proof to establish that it is entitled to the requested relief.” 37 C.F.R. § 42.20(c). Petitioner's burden, in that regard, is to show that the additional discovery is “necessary in the interest of justice.” 35 U.S.C. § 316(a)(5); *see* 37 C.F.R. § 42.51(b)(2).

Petitioner argues that the requested additional discovery is necessary in the interest of justice under the five factors set forth in the Board's precedential *Garmin* decision. *See* Paper 38 at 7; *Garmin Int'l, Inc. v.*

Cuozzo Speed Techs. LLC, IPR2012-00001, Paper 26 at 6–7 (PTAB Mar. 5, 2013) (precedential) (setting forth the five *Garmin* factors). Patent Owner opposes the Motion by arguing that Petitioner does not make an adequate showing based on the *Garmin* factors. Paper 42 at 5–8.

As to the first *Garmin* factor, we determine that Patent Owner has the much stronger position. Specifically, Petitioner does not show beyond speculation that the requested additional discovery would lead to more than a possibility of information useful to establish that Stowers 2009 qualifies as prior art. *See* Paper 38 at Ex. A, 1–2 (proposed additional discovery). To the contrary, Petitioner acknowledges that the evidence advanced by Petitioner on that issue (namely, Exhibit 1041) lacks the required oath (Paper 38 at Ex. A ¶ 6), whereas the contrary evidence advanced by Patent Owner to show that Stowers 2008 does *not* qualify as prior art includes the necessary oaths (Exhibit 2013 and Exhibit 2008).

Patent Owner admits that second and fourth *Garmin* factors are neutral in this proceeding. Paper 42 at 7–8.

The third *Garmin* factor weighs heavily against granting the additional discovery requested, however, because Petitioner has not addressed, much less demonstrated sufficiently, its inability to generate equivalent information by other means. *Id.*; Paper 38 at 5–6. In particular, Petitioner has not addressed how or why any genuine discovery needs cannot be met adequately within the confines of the routine discovery permitted as of right in our forum.⁴

⁴ Congress intended *inter partes* reviews to serve as a faster and more cost-effective alternative to litigating validity in district courts, therefore, discovery in our forum is limited compared to that provided in the district

Finally, we address the burden imposed on the non-party declarant and her non-party employer, ProQuest. Petitioner's proposed discovery requests seek broad categories of documents and open-ended deposition topics not properly confined to Exhibit 1041. *See* Paper 38 at Ex. A, 1–2 (discovery requests). We are not persuaded that Petitioner demonstrates adequately, on this record, any reasonable basis for thrusting on these non-parties any burden beyond that necessary to comply with routine discovery as authorized according to the parameters and time table set forth above. *See* Paper 38 at 6–7. .

Applying the five *Garmin* factors to the facts at hand, therefore, we deny the Motion. *See Garmin*, Paper 26 at 6–7 (five factors).

III. ORDER

It is

ORDERED that Petitioner's Motion for Authorization to Compel Testimony and Production of Documents is *denied*;

FURTHER ORDERED that the parties shall complete routine discovery by jointly producing Ms. Heather Stewart for a deposition pursuant to the parameters and time table set forth in this Order;

FURTHER ORDERED that, pursuant to 37 C.F.R. § 42.52(a), we authorize the parties to jointly seek, as necessary to ensure Ms. Stewart's appearance for the deposition, under 37 C.F.R. § 42.52(a), a federal district

courts. *See* 154 Cong. Rec. S9982, S9988–89 (daily ed. Sept. 27, 2008) (statement of Sen. Kyl). “Limited discovery lowers the cost, minimizes the complexity, and shortens the period required for dispute resolution.” *Garmin*, IPR2012-00001, Paper 26 at 5.

court subpoena to compel her appearance for a deposition strictly limited to the parameters and time table set forth in this Order;

FURTHER ORDERED that, as soon as practical, the parties shall jointly file as an exhibit in this proceeding the official transcript of Ms. Stewart's deposition;

FURTHER ORDERED that, no later than February 19, 2025, each party is authorized to file a supplemental brief, not to exceed five (5) pages in length, strictly limited to addressing the relevancy of Ms. Stewart's deposition testimony to the issue of whether Stowers 2008 qualifies as prior art against the challenged patent claims;

FURTHER ORDERED that, no later than February 26, 2025, each party is authorized to file a paper, not to exceed five (5) pages in length, that responds to their opposing party's supplemental brief;

FURTHER ORDERED that, no later than February 28, 2025, the parties shall meet and confer to resolve whether the Board should conduct a telephonic conference with the parties to hear arguments on the supplemental briefs authorized by this Order;

FURTHER ORDERED that, no later than February 28, 2025, the parties shall jointly file a paper, not to exceed one (1) page in length, which indicates their joint position or, if no joint position is reached, clearly and succinctly sets forth their respective positions, about such a conference; and

FURTHER ORDERED that no new declaration evidence may accompany any paper authorized by this Order.

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