

From: [Trials](#)
To: [Wolfe, Michael](#); [Trials](#)
Cc: [PH-Lam-Inpria-IPR](#); [MLB-Lam-IPR-Team](#); [Bregman, Dion M.](#)
Subject: RE: IPR2024-0003 / Urgent Request for Guidance on Deposition Order
Date: Friday, February 21, 2025 12:37:38 PM

Counsel: Taking account of the parties' positions as set forth below, the Board agrees with Patent Owner that Petitioner is the party who introduced Ms. Stewart's testimony into this proceeding and, therefore, our routine discovery rules require Petitioner to produce the witness for cross-examination by Patent Owner, if Petitioner (who bears the burden of proof on the factual issues about which the witness has testified) is to prevail in persuading the Board to give any weight to Ms. Stewart's testimony.

Further, as Patent Owner points out, although Patent Owner subsequently entered into the record a second declaration of Ms. Stewart, that second declaration was prepared by Ms. Stewart for Petitioner (not Patent Owner). Under these particular and unique circumstances, where an agreement cannot be reached, Patent Owner shall be the party who questions Ms. Stewart first during her deposition, but the parties must share equally the time allotted for the deposition. The Board shall enter a copy of this correspondence as Exhibit 3013.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571) 272-5366

From: Wolfe, Michael <michaelwolfe@paulhastings.com>
Sent: Friday, February 21, 2025 10:05 AM
To: Trials <Trials@USPTO.GOV>
Cc: PH-Lam-Inpria-IPR <PH-Lam-Inpria-IPR@paulhastings.com>; MLB-Lam-IPR-Team <MLB-Lam-IPR-Team@morganlewis.com>; Bregman, Dion M. <dion.bregman@morganlewis.com>
Subject: RE: IPR2024-0003 / Urgent Request for Guidance on Deposition Order

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Your Honors,

Petitioner sent its proposed email to the Board to Patent Owner at 8:20pm last night, and Patent Owner was preparing to send an email back to Petitioner when Petitioner sent its email.

Petitioner's email is improper, inaccurate, and incomplete. To preserve Inpria's rights, Inpria provides the following response.

Resolution of who goes first should be fairly simple. The Board sua sponte ordered Ms. Stewart's deposition as routine discovery for both parties. (Paper 51 at 4-5, 9.) Because Lam is the party that introduced Ms. Stewart's testimony (EX1041), Inpria should get the first deposition. Lam's claim to entitlement to go first depends on a false narrative that Ms. Stewart is merely some third-party witness that Inpria has opposed being deposed. Lam brought Ms. Stewart into this IPR, not Inpria. Inpria never solicited a declaration from Ms. Stewart.

Lam originally submitted a declaration from Ms. Stewart with its petitioner's reply. As such, Inpria was entitled to a deposition of Ms. Stewart and, in fact, scheduled a deposition for November 18, 2024. (Paper 31.) If that deposition had occurred, Inpria would have asked questions first, with Lam being able to ask its questions after. The fact that Inpria submitted Ms. Stewart's supplemental declaration with its sur-reply (after receiving authorization from the Board to do so (EX3007)), does not transform Ms. Stewart into Inpria's witness. That supplemental declaration was provided by Ms. Stewart to Lam, as Lam's witness, in preparation for the deposition of Ms. Stewart noticed by Inpria. Inpria only submitted the supplemental declaration because Lam didn't after receiving it from Ms. Stewart. Indeed, if Inpria's noticed deposition properly proceeded on November 18 as noticed, the supplemental declaration would have been used by Inpria as impeachment evidence during Ms. Stewart's deposition.

Contrary to Lam's arguments, Inpria has consistently requested the deposition of Ms. Stewart. It was Lam that failed to timely produce her, and in fact took actions that stifled a deposition from happening. (*See, e.g.*, Paper 42 at 8, 9 n.2.) Inpria should thus go first in the deposition scheduled for February 24.

Inpria notes that the Board's order suggests that the non-party witness's preference should be taken into account. (Paper 51 at 8.) Inpria offered to Lam that the parties jointly ask ProQuest if they have a preference to avoid burdening the Board with this issue, but Lam refused.

Respectfully,
Michael Wolfe

From: Bregman, Dion M. <dion.bregman@morganlewis.com>

Sent: Friday, February 21, 2025 9:57 AM

To: Trials <Trials@USPTO.GOV>

Cc: PH-Lam-Inpria-IPR <PH-Lam-Inpria-IPR@paulhastings.com>; MLB-Lam-IPR-Team <MLB-Lam-IPR-Team@morganlewis.com>

Subject: [EXT] IPR2024-0003 / Urgent Request for Guidance on Deposition Order

Your Honors,

In ordering the deposition of the third-party ProQuest witness, your Honors stated: "Counsel may examine Ms. Stewart in any order agreed to by all parties and the non-party witness." (Paper 51, pg.

8, para. 6). Despite conferring, the parties are at an impasse on which side examines the witness first, and, as such, all parties cannot agree on the order of the deposition.

Petitioner Lam filed the motion to compel the third-party deposition, while Patent Owner Inpria opposed it at every step, including opposing authorization for the motion, the motion itself, and the extension of subpoena and briefing dates. Concurrently, and notwithstanding your Honor's order, ProQuest's counsel attempted to persuade the Michigan District Court to deny the deposition. The District Court ultimately ordered the deposition, which is scheduled for this coming Monday.

Despite repeatedly opposing the deposition, Patent Owner Inpria is now insisting on examining the witness first and suggests allowing the third-party deponent to decide the order. However, as the moving party who successfully compelled this deposition, Petitioner Lam should examine the witness first. Additionally, as the issuer of the subpoena, Petitioner Lam holds the right to proceed first. Patent Owner Inpria made clear to your Honors in the parties' joint email of February 6 that they again objected to the deposition going ahead. Finally, allowing the third-party deponent's counsel to determine the order, as suggested by Inpria, contradicts standard practice.

Therefore, we respectfully submit that Petitioner's counsel should examine the third-party ProQuest witness first.

Petitioner Lam has conferred with Patent Owner Inpria but the parties are unable to agree on the deposition order. Petitioner Lam also offered Patent Owner Inpria the opportunity to add their position to this email, but has not received a response. Due to the urgent nature of this request, Petitioner Lam is sending this email, and assumes that Patent Owner will respond with a follow-up email.

Accordingly, we respectfully request the Board's guidance on this issue.

Thank you for your attention to this matter.

Sincerely,

Dion Bregman
Counsel for Petitioner Lam Research

Dion M. Bregman

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