

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA, INC.,
SAMSUNG SEMICONDUCTOR, INC., and
SAMSUNG AUSTIN SEMICONDUCTOR, LLC,
Petitioner,

v.

CHIEN-MIN SUNG,
Patent Owner.

IPR2024-00533 (Patent 8,974,270 B2)
IPR2024-00534 (Patent 9,138,862 B2)
IPR2024-00535 (Patent 9,724,802 B2)¹

Before BARRY L. GROSSMAN, GEORGE R. HOSKINS and
FRANCES L. IPPOLITO, *Administrative Patent Judges*.

IPPOLITO, *Administrative Patent Judge*.

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

¹ This Order is being filed in each proceeding listed in the caption, due to the common issues addressed. The parties are not authorized to use a combined caption in these proceedings.

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On February 4, 2025, we held a first call with counsel for both parties to discuss the deposition of Patent Owner's expert witness, Dr. Ming-Yi Tsai, who is located in Taichung City, Taiwan. Counsel for Patent Owner represented to the Board that Dr. Tsai is unable to travel outside of Taichung City due to his role as caretaker for an elderly family member who is seriously ill. Patent Owner's counsel stated Patent Owner recognized its obligation under our rules and guidelines to pay at least a portion of Petitioner's travel expenses in this situation. The parties differed, however, on the specific amount of these travel expenses and the number of people required to travel to Taiwan to take the deposition on behalf of Petitioner. On February 5, the Board issued an order instructing the parties to meet and confer to attempt to agree on a reasonable figure for travel expenses that Patent Owner should reimburse Petitioner for Petitioner's counsel to travel to Taichung City. Paper 22.²

On February 7, the parties informed the Board via email that they had met and conferred but "remain at an impasse" as to the "reasonable expenses" figure. The parties indicated that "Patent Owner has offered \$1,965.70," for one person to travel to Taiwan and stay in a hotel for 5 days, whereas Petitioner has proposed "about \$8,500," for two people to travel to Taiwan." *Id.*

² For expediency, we cite to papers and exhibits in IPR2024-00533. Similar papers and exhibits were filed in IPR2024-00534 and IPR2024-00535.

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On February 7, we held a follow-up call with counsel for both parties. During the call, the parties explained that they disagreed as to the number of attorneys reasonably necessary for Petitioner to conduct the deposition of Dr. Tsai. Patent Owner argued that one attorney is sufficient, while Petitioner argued that two attorneys is common and reasonable. Patent Owner also argued that Petitioner's \$8,500 proposal is excessive because it includes lodging at a "5-star hotel" for two attorneys, when less expensive lodging is available in Taichung City. Patent Owner further argued that airfare should be limited to \$1,400 based on its review of available economy flights using Google Flights to search for airfare from New York City to Taipei. Petitioner responded that the less expensive flights included a layover in San Francisco that increased the total travel time to 21 hours when a direct flight from New York City to Taipei would be only 17 hours.

Having considered the parties' positions, the panel has determined that Patent Owner shall reimburse Petitioner the total sum of \$4,000.00 USD for one attorney to travel from New York City to Taichung. That amount approximately reflects the cost of one direct, round-trip economy flight from New York City to Taipei, train travel from Taipei to Taichung City, and five nights lodging at a hotel of Petitioner's choosing in Taichung City. This \$4,000 figure also includes a daily per diem for meals and incidental expenses. Petitioner may also arrange for one or more other attorneys and/or paralegals to appear remotely, or in person, at the deposition at Petitioner's sole expense.

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ORDER

Accordingly, it is

ORDERED that the deposition of Dr. Tsai shall be conducted during days and times selected between the parties in person in Taichung City;

FURTHER ORDERED that Petitioner may arrange for a second attorney for Petitioner to appear during the deposition at Petitioner's expense; and

FURTHER ORDERED that Patent Owner shall reimburse Petitioner the total sum of \$4,000.00 USD for travel expenses of one (1) attorney to conduct Dr. Tsai's deposition on behalf of Petitioner.

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