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Paper 20
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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 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.

On February 4, 2025, we held a call with counsel for both parties to discuss the deposition of Patent Owner's expert witness, Dr. Ming-Yi Tsai, who is located in Taiwan. Petitioner indicated that it had contacted Patent Owner on January 26 and that Patent Owner had stated that Dr. Tsai is unable to travel to the U.S. for deposition because his father is severely ill and Dr. Tsai is acting as the primary caretaker for his father.

During the call, the parties disagreed as to the best procedure for conducting the deposition. Petitioner argued that it is unwilling to stipulate to a remote or virtual deposition, especially in light of the need for an English interpreter to provide translation services during the deposition. Petitioner indicated that it had offered to travel to Taiwan for the deposition, but that it had made three demands from Patent Owner in exchange:

1. Patent Owner must disclose whether Dr. Tsai submitted his declaration (Ex. 2004) before or after his father fell ill.
2. Patent Owner must disclose whether Dr. Tsai has traveled outside of Taiwan since his father fell ill.
3. Patent Owner must agree to pay for travel expenses for two of Petitioner's attorneys, including hotel and business class airfare.

Patent Owner argued that there is good cause for a virtual deposition because Dr. Tsai's father is severely ill, and there would not be any prejudice to Petitioner. Patent Owner also argued that there is no dispute as to credibility, and, thus, "body language" is not a major concern in this case, which weighs in favor of allowing virtual testimony. Patent Owner argued that the business class airfare requested by Petitioner is unreasonably costly

given that Patent Owner is an individual without the resources of a large company like Samsung. Counsel for Patent Owner also indicated that he had taken a remote deposition in 2021 in PGR2020-00051.

On the call, the panel explained that absent agreement of the parties, the Board was not inclined to order a virtual deposition of Dr. Tsai in this case, at least in part because of the need for an interpreter which may slow down the process and could require extra time. We further noted that the Patent Trial and Appeal Board Consolidated Trial Practice Guide ("CTPG") (Nov. 2019)[2] states that "[i]f there are associated expenses such as expert witness fees or travel those should be borne by the party presenting the testimony." CTPG at 23–24.

The parties were asked for an estimate of what they believe to be reasonable travel expenses for this case. Petitioner indicated that it had not investigated the cost of business class airfare or hotels in Taiwan. Patent Owner indicated that the hypothetical travel costs for Dr. Tsai, had Dr. Tsai been able to travel to San Francisco, would have been approximately $1,500–$1600 including hotel and economy class airfare. Patent Owner also estimated that the cost of business class airfare and hotel for two people might be approximately $25,000.

The parties were instructed to meet and confer regarding the **reasonable** travel expenses and how each party may bear those costs. The

[2] Available at https://www.uspto.gov/TrialPracticeGuideConsolidated.

parties should provide the Board with an email update by Friday, February 7, 2025. If the parties are unable to reach an agreement, the parties may email Board staff to request another conference call.

ORDER

Accordingly, it is

ORDERED that respective counsel for Petitioner and Patent Owner shall meet and confer and provide the Board with an update via email no later than February 7, 2025.

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