Lee, Tina

From:	Trials
Sent:	Thursday, February 20, 2025 9:59 AM
To:	Yung-Hoon (Sam) Ha; achan@devlinlawfirm.com; Samsung Sung IPR Service; Peter Mazur; Joel Glazer; Andrew Sherman; Jason Shapiro; ljacobson@devlinlawfirm.com; dlflitparas@devlinlawfirm.com; Sung-Samsung-DLF_Intl
Cc:	Trials
Subject:	RE: Request for further resolution on cost sharing for IPR2024-00533, IPR2024-00534, and IPR2024-00535
Attachments:	Urgent Request for Teleconference Call: Issues re Ongoing Depositions in IPR2024-00533, IPR2024-00534, and IPR2024-00535

Counsel,

From the Panel:

This is in response to two separate emails received by the Board involving the three related cases cited in the "Subject" line of this email – IPR2024-00533, IPR2024-00534, and IPR2024-00535. The two received emails both involve the deposition of Dr. Tsai.

<u>The First Email</u>

The first email was sent by Yung-Hoon (Sam) Ha, counsel for Petitioner, on Tuesday, February 18, 2025, at 7:44 AM. The closing line of this email states the email is "Jointly submitted by Petitioner and Patent Owner." A copy of this email appears below. The substance of the First Email relates to the deposition testimony of Patent Owner's expert witness, Dr. Ming-Yi Tsai, who is located in Taichung City, Taiwan. *See* Paper 24 in IPR2024-00533 (authorizing the deposition of Dr. Tsai in Taichung City, Taiwan). The question posed in the first email to the Board is which party, Petitioner or Patent Owner, should bear the travel costs of an in-person court reporter rather than a remote court reporter.

The applicable rule is 37 CFR § 42.53 - Taking testimony. Subsection (g) states:

> (g). Costs. Except as the Board may order or the parties may agree in writing, ***the proponent of the direct testimony shall bear all costs*** associated with the testimony, including the reasonable costs associated with making the witness available for the cross-examination. (emphasis added).

Here, the proponent of the "direct testimony" is Patent Owner. As stated in the first email, "Patent Owner secured a remote reporter from Planet Depos after approaching five vendors who all indicated that no in-person reporter was available but emphasized that there is no substantive difference in the quality and performance of stenography between an onsite reporter and a remote reporter." We are not aware of any problems in PTAB depositions or in PTAB virtual hearings that have arisen from using a remote court reporter. Thus use of a remote court reporter under the circumstances stated in the first email is reasonable. However, "unbeknownst to Patent Owner, Petitioner engaged an onsite reporter from a different country (Hong Kong) via Planet Depos [the same company engaged by Patent Owner to provide remote

court reporting] and agreed with Planet Depos on travel expenses for the onsite reporter, all without informing Patent Owner in advance nor affording Patent Owner an ability to seek information or negotiation on the extent, scope and necessity of any such expenses, including paying for meals, taxis, non-sitting days, and travel days for the onsite reporter." Our understanding of the first email is that Patent Owner has agreed to pay for a remote court reporter. If Petitioner wants an in-person court reporter, Patent Owner should pay the cost of a remote court reporter, and Petitioner should pay the incremental difference of the cost of an in-person court reporter.

<u>The Second Email</u>

The second email was sent by Alex Chan, counsel for Patent Owner, on Tuesday, February 18, 2025, at 8:01 AM. A copy of the second email is attached to this email. Mr. Chan states that "[d]uring the IPR2024-00533 deposition yesterday (Monday), Petitioner questioned Dr. Tsai on numerous issues unrelated to Dr. Tsai's declaration served in that IPR in connection with the '270 patent, including seeking testimony on issues related to IPR2024-00534 and IPR2024-00535, to which Patent Owner objected." We note that the three patents at issue in these three IPR proceeding at issue are closely related. For example, all three are part of the same family tree. *See, e.g.*, IPR2024-00534, Paper 14 at page 5 (illustrating the relationship of these cases). The challenged claims in the three challenged patents use the same or similar terms. There is some overlap of at least one reference in two of these cases. All three cases are at the same stage in the proceedings. We determine there is no problem with asking questions about each of these three cases at any time during the depositions to question or clarify, for example, any alleged inconsistencies in the testimony in each of the proceedings. Patent Owner may object, on the deposition record, but questions should be answered subject to the objection. Patent Owner can consider a motion to exclude based on the objection, in accordance with our rules, if so desired. This form of questioning does not extend the overall time for taking the three depositions. Indeed, it may make it more efficient.

Regards,

Andrew Kellogg,
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Patent Trial and Appeal Board
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From: Yung-Hoon (Sam) Ha <YHa@desmaraisllp.com>
Sent: Tuesday, February 18, 2025 7:44 AM
To: Trials <Trials@USPTO.GOV>
Cc: achan@devlinlawfirm.com; Samsung Sung IPR Service <SamsungSungIPRService@desmaraisllp.com>; Peter Mazur <PMazur@devlinlawfirm.com>; Joel Glazer <jglazer@devlinlawfirm.com>; Andrew Sherman <asherman@devlinlawfirm.com>; Jason Shapiro <jshapiro@devlinlawfirm.com>; ljacobson@devlinlawfirm.com; dlflitparas@devlinlawfirm.com; Sung-Samsung-DLF_Intl <Sung-Samsung-DLF_Intl@devlinlawfirm.com>
Subject: Request for further resolution on cost sharing for IPR2024-00533, IPR2024-00534, and IPR2024-00535

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Dear Honorable Board:

Parties thank the Board for the order issued on February 12, 2025.

In the course of arranging the logistics of Dr. Tsai's deposition, the parties have unfortunately developed another cost-sharing issue, which the parties are at an impasse.

Petitioner's position: In the course of arranging the logistics of the deposition, the parties have unfortunately developed one additional cost sharing issue in which the parties are at an impasse. Consistent with 37 C.F.R. § 42.53(g) and IPR2016-01444, Paper 41, Patent Owner has agreed to arrange and bear the costs of the court reporter. But Patent Owner informed Petitioner that no in-person court reporter was available in Taiwan and requested the use of a remote court reporter. As such, Petitioner arranged for an in-person court reporter to travel from Hong Kong. Patent Owner is refusing to pay for the court reporter's travel costs and Petitioner's position is that Patent Owner is responsible for the cost of travel of the court reporter as well to provide deposition conditions commensurate with if they were to occur in the U.S.. The approximate travel cost of the court reporter is $3325.

Patent Owner's position: Patent Owner is mindful not to make any arguments on any email to the Board. As Patent Owner was unable to secure a neutral statement, Patent Owner reluctantly provides his position below.

Patent Owner secured a remote reporter from Planet Depos after approaching five vendors who all indicated that no in-person reporter was available but emphasized that there is no substantive difference in the quality and performance of stenography between an onsite reporter and a remote reporter. This included Planet Depos—the same vendor from whom Petitioner secured the onsite reporter (more below). All vendors made clear that the quality of the transcript is not (nor would it be) impacted by the modality of stenography, be it remote or onsite. Based on Planet Depos' representation, a remote reporter was secured for Dr. Tsai's three-day deposition. At that same time, Patent Owner informed Petitioner about the unavailability of an onsite reporter in Taiwan, but unbeknownst to Patent Owner, Petitioner engaged an onsite reporter from a different country (Hong Kong) via Planet Depos and agreed with Planet Depos on travel expenses for the onsite reporter, all without informing Patent Owner in advance nor affording Patent Owner an ability to seek information or negotiation on the extent, scope and necessity of any such expenses, including paying for meals, taxis, non-sitting days, and travel days for the onsite reporter. Planet Depos then removed Patent Owner's remote reporter as a result of its engagement with Petitioner. Having pulled the trigger on an onsite reporter without involving Patent Owner, Petitioner now seeks forgiveness from the Board. The Board should not condone Petitioner's shoot-first-ask-questions-later approach and hold Patent Owner financially accountable for travel expenses that *Petitioner* agreed to. To be sure, Patent Owner has asked Planet Depos to generate a separate invoice for the reporter's appearance fee, which underscores that Patent Owner has met his obligation for shouldering costs related to the engagement of a reporter for Dr. Tsai's deposition. Nothing more is required under Rule 42.53(g). Similarly, IPR2016-01444 does not suggest, let alone explicitly so state, that the court reporter must be physically present. Since the parties have already stipulated to the jurisdictional authority of a non-US court reporter to administer oaths, the issue as to whether the parties would need "an officer authorized to administer the necessary oaths at that site" is moot at this point. Court reporters are entitled to appear remotely and there is no PTAB precedent requiring their in-person appearance.

Should a call be needed, parties are available for a call at the following times.

March 3: 10am-2pm, 3-5pm ET
March 4: 10am-2pm, 3-5pm ET
March 5: 10am-5pm ET

Jointly submitted by Petitioner and Patent Owner

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From:	Alex Chan
To:	Trials
Cc:	Yung-Hoon (Sam) Ha; SamsungSungIPRService@desmaraisllp.com; Sung-Samsung-DLF_Intl; DLF- Lit Paras
Subject:	Urgent Request for Teleconference Call: Issues re Ongoing Depositions in IPR2024-00533, IPR2024-00534, and IPR2024-00535
Date:	Tuesday, February 18, 2025 8:01:20 AM
Attachments:	image001.png

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Dear Honorable Board,

Parties thank the Board for the order issued on February 12, 2025. Dr. Tsai's three-day deposition in Taiwan is ongoing. In the course of his deposition, a critical issue has emerged regarding the proper scope of Dr. Tsai's deposition testimony that **requires the Board's immediate intervention in order to minimize undue prejudice on the witness and Patent Owner**.

As background, Dr. Tsai is scheduled to testify in IPR2024-00533 (involving USP No. 8,974,270 ("'270 patent")), IPR2024-00534 (involving USP No. 9,138,862 ("'862 patent")), and IPR2024-00535 (involving USP No. 9,724,802 ("'802 patent")). The deposition for IPR2024-00533 took place yesterday (Monday, Feb. 17), which was not completed but will continue on Wednesday (Feb. 19), after which Dr. Tsai's deposition for IPR2024-00534 for the '862 patent will commence. Dr. Tsai is also scheduled to testify in IPR2024-00535 for the '802 patent on Thursday (Feb. 20).

During the IPR2024-00533 deposition yesterday (Monday), Petitioner questioned Dr. Tsai on numerous issues unrelated to Dr. Tsai's declaration served in that IPR in connection with the '270 patent, including seeking testimony on issues related to IPR2024-00534 and IPR2024-00535, to which Patent Owner objected. The parties have already conferred on whether Petitioner may continue to seek testimony from Dr. Tsai on issues related to his opinions in declarations served in another IPR but remain at an impasse. Petitioner's position is that Dr. Tsai's opinions rendered across all three IPR proceedings are relevant in each of the depositions and are fair deposition topics.

As Dr. Tsai's deposition will resume tomorrow (Wednesday, Taiwan time, which is Tuesday evening), Patent Owner respectfully seeks a ruling to protect Dr. Tsai from Petitioner's tactics, which is designed to circumvent the seven-hour requirement for deposition and allow Petitioner to question Dr. Tsai on any of the three IPRs for more than seven hours. However, parties have already agreed to extend the deposition times of Dr. Tsai in each of the three proceedings by one additional hour to accommodate various issues that have arisen during the deposition.

The parties are available for a teleconference with the Board during the following dates/times:

February 18, anytime.
February 19, anytime.

Jointly submitted by Petitioner and Patent Owner.

DEVLIN LAW FIRM LLC
INTELLECTUAL PROPERTY LAW

Alex Chan
1526 Gilpin Ave, Wilmington, DE 19806
(646) 331-0604
Admitted in CA, TX
Not Admitted in DE

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