

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

CM HK LIMITED,
Patent Owner.

IPR2025-01023 (Patent 10,852,846 B2)
IPR2025-01071 (Patent 11,698,687 B2)¹

Before KEVIN F. TURNER,² BENJAMIN D. M. WOOD, and
MICHAEL J. STRAUSS, *Administrative Patent Judges*.

WOOD, *Administrative Patent Judge*.

ORDER

Denying Patent Owner's Second Motion for Additional Discovery
35 U.S.C. § 316(a)(5); 37 C.F.R. § 42.51(b)(2)

¹ We exercise our discretion to issue one Order that applies to both listed cases. The parties are not authorized to use this type of caption.

² Due to unavailability, Lead Administrative Patent Judge Kevin F. Turner replaces Administrative Patent Judge Arthur M. Peslak on the panel.
Paper 48.

I. INTRODUCTION

With our authorization,³ CM HK Ltd. (“Patent Owner”) files a second Motion for Additional Discovery.⁴ Paper 44 (“Second Discovery Motion,” or “2nd Disc. Mot.”). In its Second Discovery Motion, Patent Owner asks us to order Samsung Electronics Co., LTD. (“Petitioner”) to produce communications and documents concerning whether Petitioner subjectively believed that it had waived indefiniteness arguments raised in related District-Court proceedings. 2nd Disc. Mot. 1. For the reasons set forth below, we deny Patent Owner’s Second Discovery Motion.

II. LEGAL STANDARDS

Given its expedited nature, discovery in an *inter partes* review is limited compared to discovery in a district-court infringement action. *See Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 5 (PTAB Mar. 5, 2013) (precedential); 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. Therefore, when seeking additional discovery, the moving party must show, for each proposed discovery request, that the additional discovery is “necessary in the interest of justice.” 35 U.S.C. § 316(a)(5); *see* 37 C.F.R. §§ 42.20(c),

³ Ex. 3003. All citations are to the record in IPR2025-01023 unless otherwise noted.

⁴ We granted in part Patent Owner’s first motion for Additional Discovery. *See* Paper 28 (Patent Owner’s first discovery motion); Paper 33 (Order).

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42.51(b)(2); *Chi Mei Innolux Corp. v. Semiconductor Energy Lab’y Co.*, IPR2013-00028, Paper 25 at 4 (PTAB Apr. 26, 2013).

In *Garmin*, the Board identified several factors to consider when determining whether additional discovery is in the interest of justice, i.e., whether: (1) the requesting party has shown that there is more than a mere possibility that useful information will be uncovered (*Garmin* factor 1); (2) the discovery seeks the other party’s litigation basis and the underlying basis for those positions (*Garmin* factor 2); (3) the party seeking discovery can obtain the requested information without the need of discovery (*Garmin* factor 3); (4) the discovery requests and instructions are easily understandable (*Garmin* factor 4); and (4) the proposed discovery requests are responsibly tailored so as not be overly burdensome to answer given the expedited nature of *inter partes* review (*Garmin* factor 5). *Garmin*, IPR2012-00001, Paper 26 at 6–7.

III. DISCUSSION

Patent Owner’s Second Discovery Motion stems from its previous Motion for Sanctions. Paper 32 (“Sanctions Motion,” or “Sanctions Mot.”). In its Sanctions Motion, Patent Owner asserted that Petitioner made a material misrepresentation to the Board when it stated that it “‘never alleged’ indefiniteness” of the claim term “predicted axial accelerations.” Sanctions Mot. 1 (quoting Paper 14, 1, 5). To support its assertion that Petitioner’s statement was untrue, Patent Owner submitted as evidence Petitioner’s Local Patent Rule 3-3 Disclosures that Petitioner submitted on March 14, 2025, in *Samsung Electronics Co. Ltd. v. CMHK, Ltd.*, No. 4:24-cv-06567-JST (N.D. Cal.). *Id.* at 3 (citing Ex. 2047). In that document

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Petitioner represented to the court that the terms “predicted” and “axial acceleration” were indefinite. Ex. 2047, 69.⁵

In response to the Sanctions Motion (Paper 38, “Sanctions-Motion Opposition” or “Pet. Sanctions-Mot. Opp.”), Petitioner asserted, *inter alia*, that while it preliminarily reserved its rights to argue that certain claim terms were indefinite, it subsequently submitted in the District-Court litigation a joint claim construction statement (Ex. 2007, “JCCS”) that made clear that it was not pursuing that defense. *See* Pet. Sanctions-Mot. Opp. 1 (“The joint claim construction statement unambiguously indicated that it provided ‘a **full list of all disputed terms**,’ and included no indefiniteness position.”); *id.* at 6 (“Any preliminary reservation as to indefiniteness was superseded by the pre-IPR May 13, 2025 joint claim construction statement, where Samsung did not argue indefiniteness.”).

In the present motion, Patent Owner argues that the above and similar statements that Petitioner made in its Sanctions-Motion Opposition place at issue and subject to discovery Petitioner’s “subjective belief” as to whether it waived its District-Court indefiniteness arguments. 2nd Disc. Mot. 1–2. Patent Owner therefore asks us to order Petitioner to produce “communications and documents . . . concerning whether Petitioner authorized waiving indefiniteness and/or whether Petitioner or its counsel

⁵ Patent Owner also submitted as evidence supporting its Sanctions Motion the Local Patent Rule 3-3 Disclosures that Petitioner submitted on March 14, 2025 in “Local Patent Rule 3-3 Disclosures,” submitted on March 4, 2025 in *CM HK Ltd. v. Samsung Electronics Co., Ltd.*, No. 2:24-cv-00880-JRG (E.D. Tex.), Patent Owner’s action against Petitioner for infringement of the patents at issue in the above-captioned *inter partes* reviews. Sanctions Mot. 3 (citing Ex. 2012). This submission appears to be identical to that submitted in the litigation pending in the Northern District of California.

actually believed that filing the JCCS waived indefiniteness.” *Id.* at 1; *see id.* at 3 (Patent Owner “seeks contemporaneous documents showing that Samsung and its counsel believed filing the JCCS waived indefiniteness”). Patent Owner acknowledges that such materials may be privileged attorney-client communications, but, according to Patent Owner, Petitioner waives any privilege “when it injects into a proceeding an issue that in fairness requires examination of otherwise protected communications.” *Id.* at 2 (citing, e.g., *Cox v. Adm’r U.S. Steel & Carnegie*, 17 F.3d 1386, 1418–19 (11th Cir. 1994)). Patent Owner further submits that the requested discovery satisfies the *Garmin* factors because, *inter alia*, it is necessary to determine whether Petitioner’s waiver argument is “genuine” as opposed to “post-hoc rationalization.” *Id.* at 3.

In response to Patent Owner’s Second Discovery Motion, Petitioner denies that it discussed in its Sanctions-Motion Opposition its subjective belief that the JCCS waived its indefiniteness defense. Pet. 2nd. Disc. Mot. Opp. 1. Instead, according to Petitioner, it “addressed a legal question—what the JCCS objectively accomplished as a matter of record.” *Id.* Petitioner asserts that its Opposition relied on “the public papers,” not “advice of counsel or other privileged communications that may reflect Samsung’s subjective beliefs.” *Id.* at 3.

Patent Owner’s position essentially is that Petitioner opened the door to Petitioner’s privileged attorney-client communications regarding its “subjective belief” that the JCCS waived its district-court indefiniteness defenses because it “inject[ed] into [this] proceeding” those beliefs. Setting aside the very real question whether such beliefs would even be relevant to our consideration of Patent Owner’s Sanctions Motion, we have found no

evidence in Petitioner’s Sanctions-Motion Opposition that Petitioner is relying on its subjective beliefs. Patent Owner has not identified, and we have been unable to find, any reference in Petitioner’s Sanctions-Motion Opposition to what Petitioner or Petitioner’s counsel subjectively believed to be the legal effect of the JCCS. Instead, Petitioner cites to papers and evidence of record, and provides its interpretations of those papers and evidence. *See generally* Pet. Sanctions-Mot. Opp. (citing Papers 7, 8, 13, 14, 17, 31; and Exs. 1026–1033, 2007, 2012, 2047, 2049, 3102). Citing to and interpreting papers and evidence of record does not “inject[]” the citing party’s (or the party’s counsel’s) subjective beliefs regarding those papers and evidence into the proceeding. To determine otherwise would render meaningless the attorney-client privilege in this forum. Accordingly, Patent Owner has not shown that its requested additional discovery is in the interest of justice.

IV. CONCLUSION

For the reasons discussed above, we *deny* Patent Owner’s Second Motion for Additional Discovery.

V. ORDER

For the foregoing reasons, it is

ORDERED that Patent Owner’s Second Motion for Additional Discover is *denied*.

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