

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MAXLINEAR, INC.,
Petitioner,

v.

CRESTA TECHNOLOGY CORPORATION,
Patent Owner.

Cases¹

IPR2015-00594 (Patent 7,265,792 B2)

IPR2015-00592 (Patent 7,075,585 B2)

Before PHILLIP J. KAUFFMAN, GREGG I. ANDERSON, and
PATRICK M. BOUCHER *Administrative Patent Judges*.

KAUFFMAN, *Administrative Patent Judge*.

DECISION ON PETITIONER'S MOTION TO COMPEL
PRODUCTION OF CERTAIN ROUTINE DISCOVERY OR, IN THE
ALTERNATIVE, FOR AUTHORIZATION TO SERVE DISCOVERY
REQUESTS RELATED TO THE SAME

37 C.F.R. § 42.51

¹ This order addresses issues raised in both cases. We exercise our discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style heading in subsequent papers.

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I. INTRODUCTION AND BACKGROUND

As authorized by our order (Paper 25), Petitioner submitted a Motion to Compel Discovery of certain information, or in the alternative, to obtain that information as additional discovery. Paper 27 (“Mot.”); *see also* Ex. 1176 (Petitioner’s proposed Requests for Production identifying the requested information).² Patent Owner submitted an Opposition (Paper 30, “Opp.”), and Petitioner submitted a Reply (Paper 33, “Reply”). The information sought includes the transcript of the deposition of Mr. Mombars in the related International Trade Commission (ITC) proceeding, and other information related to inventorship of Favrat. *See* Mot. 1; Ex. 1176.

As an initial matter, we address IPR2015-00592. Favrat is not a reference in any instituted ground of unpatentability in IPR2015-00592. Petitioner does not explain persuasively the relevance of the information sought to IPR2015-00592. *See* Mot., *passim*; Opp. 15 (Patent Owner asserting that the information sought is not relevant to IPR2015-00592); Reply (making no response to Patent Owner’s assertion). Consequently, we need not consider this motion further with regard to IPR2015-00592.

In the Petition of IPR2015-00594, Petitioner contends that “Favrat is a patent granted on an application for patent *by another* filed in the United States before the invention by applicant for patent.” Paper 2 (Petition), 14. The Petition includes a ground of unpatentability against claims 1, 2, 4, 5, 11, and 24–29 based on anticipation by Favrat (Exhibit 1104) under 35 U.S.C. § 102(e), and includes seven grounds of unpatentability based on

² Except where noted otherwise, all references are to IPR2015-00594.

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obviousness under 35 U.S.C. § 103(a) that each include Favrat as a reference. *Id.* at 7–8.

In the Preliminary Response, Patent Owner contends that Favrat is not prior art under 35 U.S.C. § 102(e) because it is not by “by another.” *See, e.g.*, Paper 9, 3–18. Specifically, Patent Owner contends that claims 1, 2, 4, 5, 11, and 24–29 of the ’792 patent were conceived by Group A inventors without contribution from Group B inventors, and contends that claims 13–23 were conceived by the inventors of Groups A and B.³ *Id.* at 5–13.

In our Institution Decision, we conclude that it would be premature to determine whether Favrat is disqualified as prior art against the ’792 patent under § 102(e). Paper 13, 9–10. We instituted on each of the asserted grounds of unpatentability. *Id.* at 15–16.

In Patent Owner’s Response, Patent Owner repeats the contention that claims 1, 2, 4, 5, 11, and 24–29 were conceived by Group A inventors, and that claims 13–23 were conceived by the inventors of Groups A and B. *See, e.g.*, Paper 23, 4–5. In support, Patent Owner provides the Declarations of two Group A inventors, Dominique Python (Ex. 2007) and Didier Margairaz (Ex. 2008). Citing to these Declarations, Patent Owner makes several assertions regarding Mr. Mometers, a Group B inventor. *Id.* at 15–19. Specifically, Patent Owner asserts that Mr. Mometers was deposed

³ The named inventors of Favrat are: Pierre Favrat, Didier Margairaz, Alain-Serge Porret, and Dominique Python (“Group A”). Ex. 1104, 1. The named inventors of the ’792 patent are Group A and Friederich Mometers, Richard Perring, Philippe Duc, and Benito Carnero (“Group B”). Ex. 1101, 1.

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during the ITC proceeding and incorrectly testified that he conceived of some part of claims 1, 4, 5, 24, and 25. *Id.* at 15–16 (citing Ex. 2007 ¶¶ 19; Ex. 2008 ¶¶ 19). Patent Owner elaborates that Mr. Mombers did not contribute to any of the subject matter of claims 1, 2, 4, 5, 11, and 24–29. *Id.* at 15–19 (citing Ex. 2007 ¶¶ 6–8, 19–22; Ex. 2008 ¶¶ –8, 19–22).

Petitioner’s Reply is due on March 7, 2016. *See* Papers 14, 17.

II. THIS IS A DISCOVERY ISSUE

Petitioner has a copy of the Mombers deposition transcript, and the other documents sought. *See* Ex. 1175, 15:6–16; Mot. 1 (citing proposed discovery request at Ex. 1176). Patent Owner contends Petitioner’s request is not a discovery issue because Petitioner has a copy of the information sought. Opp. 1, 3–7 (analogizing to *B/E Aerospace, Inc. v. MAG Aerospace Industries, LLC*, Case IPR2014-01510 (PTAB Oct. 13, 2015) (Paper 64)). For the reasons that follow, we disagree with Patent Owner’s assertion.

In *B/E Aerospace*, a non-precedential Board decision, the Petitioner asked that the Board order the petitioner to submit evidence. *B/E Aerospace*, Paper 64 at 2. The evidence in question was obtained from the patent owner in related litigation and was subject to a protective order from that court. *Id.* The Board stated that such a request was not accurately characterized as a discovery issue. *Id.* at 4. That is, the Board stated that the petitioner’s request that the petitioner be ordered to submit information to the Board was not a discovery issue. In the case at hand, Petitioner does not seek an order directing Petitioner to submit information to the Board. Rather, Petitioner asks that Patent Owner be ordered to comply with its

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routine discovery duties. Because of this distinction, the order from *B/E Aerospace* cited by Patent Owner is not analogous to the situation at hand. *See* Reply 3 (contending that *B/E Aerospace* is distinguishable).

III. PROTECTIVE ORDER

Patent Owner contends that the information sought is covered by an ITC Protective Order that prevents the use Petitioner suggests. Opp. 4.

Petitioner contends that the ITC protective order restricts how a receiving party can disclose or use confidential business information (“CBI”), but does not restrict how a producing party may use its own CBI. Mot. 4–5; Ex. 1179 (ITC Protective Order); Reply 3–4. We agree with Petitioner. The ITC Protective Order limits disclosure by a receiving party in that it requires either permission from the information supplier (producing party) or fitting certain enumerated exceptions to permit disclosure. *See* Ex. 1179 ¶ 3. Further supporting this interpretation, in response to Petitioner’s motion asking the ITC to de-designate the information sought in this Motion, the ITC stated that the ITC Protective order does not preclude Patent Owner from disclosing information. *See* Ex. 1183, 2 (“I find that the identified confidential information on pages 18-22 of Exhibit N is Cresta confidential information, and accordingly, neither the Protective Order in this Investigation nor the Commission Rules preclude Cresta from disclosing that information in any other proceeding”).

V. ROUTINE DISCOVERY

A. *Mombers Deposition Transcript*

1. 37 C.F.R. § 42.51(b)(1)(i)

Petitioner contends that the Mombers deposition transcript was cited in testimony submitted with Patent Owner's Response and consequently must be served as routine discovery. Mot. 5–6 (referring to Paper 23; citing 37 C.F.R. § 42.51(b)(1)(i)). Specifically, Petitioner contends that Patent Owner referred to the Declarations of Messrs. Python and Margairaz (Exhibits 2007, 2008, respectively) opining that Mr. Mombers's testimony before the ITC regarding inventorship was incorrect. *Id.* at 7. Indeed, as explained above, the testimony of Messrs. Python and Margairaz cites to the Mombers deposition transcript, and this testimony was submitted with Patent Owner's Response. *See* PO Resp. 15–19 (citing Ex. 2007 ¶¶ 6–8, 19–22; Ex. 2008 ¶¶ 6–8, 19–22).⁴

Patent Owner contends that the Mombers deposition transcript need not be provided under this rule because it was not cited. Opp. 9–10 (analogizing to *Corning v. DSM*, Case 2013-00050 (PTAB June 21, 2013) (Paper 23)).

Corning is not analogous to the situation at hand. In *Corning*, a non-precedential Board decision, Petitioner relied on the testimony of an expert witness regarding testing samples. *Corning* at 1–2; *see also* Reply 2–3 (contending that *Corning* is distinguishable). The patent owner filed a Motion for Discovery, and one of the contentions was

⁴ Paragraph 20 of Exhibits 2007 and 2008 most directly refers to Mr. Mombers's testimony.

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that the petitioner should have provided laboratory notebooks and associated protocols for the sample testing as routine discovery pursuant to 37 C.F.R. § 42.51(b)(1)(i). *Corning* at 2–3. The Board held that such an interpretation of this rule would be overbroad. *Id.* at 3. In *Corning*, the laboratory notebooks and protocols were tangential to the evidence (expert testimony regarding sample tests). Here, the connection is much more direct in that the testimony of Messrs. Python and Margairaz cites to and contradicts the Mombers deposition transcript, and this testimony was submitted with Patent Owner’s Response. The Mombers deposition transcript is not merely tangential because it is “cited in a paper” filed by Patent Owner. *See* 37 C.F.R. § 42.51(b)(1)(i).

We determine that the Mombers deposition transcript should have been provided as routine discovery under 37 C.F.R. § 42.51(b)(1)(i) based on Patent Owner’s Response.

2. *37 C.F.R. § 42.51(b)(1)(iii)*

Petitioner contends that the Mombers deposition transcript is relevant information that is inconsistent with a position advanced by Patent Owner, and for that reason must have been served as routine discovery. Mot. 9–11. Specifically, Petitioner contends that Patent Owner did not dispute whether Favrat was prior art in the ITC dispute, but Patent Owner disputes whether Favrat is prior art in this proceeding. Mot 10.

Patent Owner responds that in the ITC proceeding Patent Owner argued that Favrat did not anticipate the challenged claims and, in this proceeding, contends that Favrat is not prior art. Opp 11–

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13. According to Patent Owner, the ITC has a different burden of proof, and choosing different defense strategies is not inconsistent.

Id.

We agree with Patent Owner that the failure to assert that Favrat is not prior art in the ITC proceeding is not, without more, inconsistent with making such assertion in this proceeding. There are many reasons a party may assert a defense in one proceeding and not in another, and that, without more, does not demonstrate that Patent Owner has taken an inconsistent position in this proceeding.

However, in its Reply, Petitioner makes the following assertion regarding inconsistency.

If an inventor testifies that Jones conceived of an invention in one case, but then later testifies that Jones did not conceive of the same invention, those positions are inconsistent. If not, what would ever qualify as inconsistent?

Reply 1.

Petitioner does not explain effectively how this analogy fits the situation at hand. If Petitioner means that Messrs. Python and Margairaz testified in the ITC proceeding that Mr. Mombers conceived of the subject matter of claims 1, 2, 4, 5, 11, and 24–29, and in this proceeding present testimony that Mr. Mombers did not conceive of the subject matter of those claims, the record does not support such a position. Rather, as explained above, the record indicates that Messrs. Python and Margairaz testified in this proceeding that Mr. Mombers incorrectly testified in the ITC proceeding. Even if the testimony was incorrect, such a fact, standing alone, would not establish that it is “inconsistent with a position

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advanced by the party during the proceeding.” *See* 37 C.F.R. § 42.51(b)(1)(iii). Consequently, Petitioner’s analogy is not persuasive. However, this does not end our inquiry.

As detailed above, Patent Owner contends that Favrat is not prior art regarding the ground of unpatentability based on anticipation by Favrat because claims 1, 2, 4, 5, 11, and 24–29 were conceived by Group A inventors. However, as Patent Owner acknowledges, Mr. Mombers testified that he conceived some part of claims 1, 4, 5, 24, and 25. *See* Paper 23, 15–19. The Mombers deposition transcript is inconsistent with this position advanced by Patent Owner. As such, Patent Owner is obligated to provide the Mombers deposition transcript as routine discovery. *See* 37 C.F.R. § 42.51(b)(1)(iii).

We recognize that, as the moving party, Petitioner bears the burden of demonstrating it is entitled to the relief requested. 37 C.F.R. §§ 42.20, 22. However, compliance with routine-discovery provisions is Patent Owner’s obligation even without a motion by Petitioner.⁵ We determine that the Mombers deposition transcript is routine discovery under 37 C.F.R. § 42.51(b)(1)(iii) triggered by Patent Owner’s Response.

B. Other Documents

Petitioner seeks certain information in addition to the Mombers deposition transcript. *See* Ex. 1176. As explained above, Petitioner made the assertion that this information is subject to routine discovery based on an

⁵ Because this is Patent Owner’s duty even absent a motion by Petitioner, the timeliness of Petitioner’s actions are not relevant. *See, e.g.*, Opp. 5, 7–9.

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inapposite perspective on inconsistency under 37 C.F.R. § 42.51(b)(1)(iii).

Patent Owner's articulated perspective on this issue is also inapt.

Patent Owner must provide relevant information that Patent Owner is aware of, *including information from the ITC proceeding*, that is inconsistent with the assertion that claims 1, 2, 4, 5, 11, and 24–29 were conceived only by Group A inventors. We emphasize that this obligation applies to all information of which Patent Owner is aware, not just the information specifically identified by Petitioner.⁶

We note that, as explained above, the ITC Protective Order does not preclude Patent Owner from disclosing documents to Petitioner for this proceeding. Consequently, Patent Owner's contention that the ITC Protective Order precludes such disclosure is unpersuasive.

If the information that Patent Owner is obliged to produce as routine discovery is confidential, Patent Owner can provide it under a protective order for this proceeding. Although it does not appear that such an order has yet been entered in this case, Patent Owner has not contended that there is any barrier to cooperating with Petitioner to seek entry of an appropriate protective order. *See* 37 C.F.R. §§ 42.14, 54; *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,760 (Aug. 14, 2012), App'x B.

Given our determination regarding routine discovery, we need not address Petitioner's alternative request for additional discovery.

If compliance with this order does not resolve the matter, either party may request a conference call.

⁶ The obligation does not extend to legally recognized privileges. *See* 37 C.F.R. § 42.51(b)(1)(iii).

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VI. ORDER

A. *IPR2015-00594*

It is hereby ORDERED that Petitioner's motion to compel discovery of the Mombers deposition transcript is *granted*; and

FURTHER ORDERED that Patent Owner shall serve the Mombers deposition transcript and any other relevant information of which Patent Owner is aware and that is inconsistent with a position advanced by Patent Owner as detailed above, no later than three business days from entry of this order; and

FURTHER ORDERED that Patent Owner shall, no later than three business days from entry of this order, confirm whether it has, up to that date, complied with the requirements of routine discovery under 37 C.F.R. § 42.51(b)(1).

B. *IPR2015-00592*

It is ORDERED that Petitioner's motion is *denied*.

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