

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,
v.

BLACK HILLS MEDIA, LLC,
Patent Owner.

Case IPR2014-00717
Patent 6,108,686

Before BRIAN J. McNAMARA, DAVID C. McKONE,
and FRANCES L. IPPOLITO, *Administrative Patent Judges*.

McNAMARA, *Administrative Patent Judge*.

ORDER GRANTING MOTION TO COMPEL DEPOSITION OF
SUNGIL CHO

Conduct of the Proceeding
37C.F.R. § 42.51(b)(1)

On August 28, 2014, Black Hills Media, LLC (“Patent Owner”) filed a substitute motion for additional discovery, Paper 15, as authorized in our orders of August 7, 2014, and August 27, 2014. Papers 8, 11. On September 8, 2014, Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America (collectively “Petitioner”) filed its opposition to Patent Owner’s substitute motion for additional discovery.¹ Paper 16. Petitioner attached to its opposition to Patent Owner’s motion for additional discovery the declaration of Mr. Sungil Cho. Ex. 1009 (“Cho Decl.”).

On October 2, 2014, we granted-in-part Patent Owner’s motion for additional discovery, requiring that Petitioner answer certain interrogatories and produce certain documents concerning whether any other party, in particular Google, Inc. (“Google”), is a real party in interest in this proceeding. Paper 17 (“Order Authorizing Additional Discovery”). Petitioner answered the interrogatories and document requests, stating that neither Google, nor Google’s counsel, directed Petitioner to provide a copy of one or more drafts of the Petition to any person or entity, that there was no involvement by any individual not employed by Petitioner or Petitioner’s counsel of record in filing the Petition, and that there were no payments or other financial transactions agreed upon or made to Petitioner or Petitioner’s counsel of record in relation to the indemnification provisions of a Master Application Development Agreement (“MADA”) between Petitioner and Google. Ex. 2012. In addition, Petitioner indicated that there were no

¹ On January 9, 2015, Petitioner filed a Supplemental Mandatory Notice, Paper 30, advising us that Samsung Electronics America, Inc., has merged with Samsung Telecommunications America, LLC, and that the combined entity is a wholly-owned subsidiary of Samsung Electronics Co., Ltd.

documents responsive to Requests for Production authorized by the panel.
Id.

Patent Owner represents that Petitioner has refused Patent Owner's request to produce Mr. Cho for cross-examination and, as authorized in our order of November 26, 2014 (Paper 20), moves to compel Mr. Cho's deposition as a matter of routine discovery under 37 C.F.R. §42.51(b)(1)(ii). Paper 21 (Motion to Compel the Cross Examination of Sungil Cho ("Mot. to Compel")). Patent Owner opposes Petitioner's Mot. to Compel. Paper 24 ("Opp. to Mot. to Compel").

In his declaration, Mr. Cho, who we understand is a member of the bar of the State of New York, Ex. 2011, testified that he is employed by Petitioner Samsung Electronics Co., Ltd., as a Director and is responsible for coordinating and supervising the preparation, review and filing of IPR2014-00717 and IPR2014-00735 (the "Subject Petitions"). Cho Decl. ¶ 2. Mr. Cho testified that he had knowledge of the individuals who received drafts of the Petitions and of the individuals who were involved in the preparation, review, and filing of the Petitions. *Id.* at ¶ 4. Mr. Cho also testified that he directs the activities of the law firm of Covington & Burling (Covington) concerning the preparation of the Subject Petitions. *Id.* at ¶¶ 2, 4. Mr. Cho further testified that Petitioner had paid and is paying all fees with respect to the preparation, review and filing of the Subject Petitions. *Id.* at ¶ 8.

Patent Owner argues that in view of Mr. Cho's direct testimony, it is unreasonable for Petitioner to argue that Patent Owner should not be able to cross-examine Mr. Cho. According to Patent Owner, there are inconsistencies between the testimony in Mr. Cho's declaration and the

answers to the interrogatories. Mot. to Compel 4–5. Petitioner contends that, when viewed in its entirety, the Cho Declaration makes clear that there is no contradiction or discrepancy with Petitioner’s responses to the additional discovery we ordered. Opp. to Mot. to Compel. 2. We express no opinion on either party’s position, as this is a matter on which discovery is not complete. In any case, the testimony in Mr. Cho’s declaration indicates that he has highly pertinent knowledge of facts that may be important to determining whether Petitioner has identified all real parties in interest or privies.

Petitioner argues that routine discovery does not mandate Mr. Cho’s deposition because we fully considered Mr. Cho’s Declaration when granting Patent Owner’s Motion for Additional Discovery. Opp. to Mot. to Compel. 3–4. Although our Order Authorizing Additional Discovery expressed uncertainty as to whether Mr. Cho would be available for cross-examination, we noted that “Patent Owner is also entitled to corroboration of the assertions in Mr. Cho’s declaration and to cross-examine Mr. Cho.” *Id.* In response to a subsequent inquiry, we noted that our Order Authorizing Additional Discovery did not authorize Mr. Cho’s deposition as additional discovery. However, Petitioner having proffered Mr. Cho’s declaration testimony, we see no reason why Patent Owner should not be permitted to cross-examine Mr. Cho as a matter of routine discovery. 37 C.F.R. §42.51(b)(ii).

Patent Owner notes that during a conference call Petitioner stated that it would no longer rely on Mr. Cho’s declaration and even offered to withdraw Mr. Cho’s declaration. Mot. to Compel 4. Patent Owner contends that Petitioner should not be able to withdraw Mr. Cho’s testimony at this

point in the proceedings. *Id.* As discussed above, the panel considered Mr. Cho's statements in determining the scope of additional discovery and they may not be withdrawn for the purpose of discovering information concerning real parties in interest.

We are cognizant, however, of the limited scope of Mr. Cho's declaration and the corresponding limited scope of permissible cross-examination. As we advised the parties during a conference call, we will not permit Mr. Cho's deposition to turn into a "fishing expedition" on other issues. Thus, while we order Petitioner to produce Mr. Cho for deposition, we remind the parties that the scope of the deposition is limited to the subject matter in Mr. Cho's declaration, and limit the deposition to no more than three hours of cross-examination and 45 minutes of redirect.

Mr. Cho's declaration does not identify his country of residence. We are advised that Mr. Cho physically resides in Korea. Ex. 2009 ("Initial Conf. Tr.") 23–24. As discussed above, we also understand that Mr. Cho is a member of the bar of the state of New York. Patent Owner has indicated its willingness to cooperate with Petitioner in arranging to conduct the cross-examination of Mr. Cho at a time and place when Mr. Cho will be in the United States. *Id.* at 33. Patent Owner has also agreed to conduct the cross-examination by telephone or video link. *Id.* We direct the parties to consult with each other to make appropriate arrangements for Mr. Cho's deposition.

In consideration of the above, it is

ORDERED that Petitioner produce Mr. Cho for up to three hours of cross-examination by Patent Owner, and that the redirect of Mr. Cho be limited to 45 minutes of testimony; and

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