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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.; and
SAMSUNG TELECOMMUNICATIONS AMERICA, LLC

Petitioner,

v.

BLACK HILLS MEDIA, LLC,

Patent Owner

Case IPR2014-00717

U.S. Patent 6,108,686

PATENT OWNER'S MOTION TO COMPEL
THE CROSS-EXAMINATION OF MR. SUNGIL CHO

On September 8, 2014, Petitioner submitted the Declaration of Mr. Sungil Cho (Ex. 1009), which contains statements regarding, *inter alia*, the level of involvement of Google in controlling or funding Petitioner for the present proceeding. Paper 17 (“the Additional Discovery Order”) relied upon statements made in Mr. Cho’s declaration. Patent Owner seeks to cross-examine Mr. Cho within the scope of the declaration as routine discovery under 37 C.F.R. § 42.51(b)(1)(ii), but Petitioner has refused to make Mr. Cho available for cross-examination. Patent Owner files this Motion to Compel the Cross-Examination of Mr. Sungil Cho pursuant to the authorization granted in Paper 20.

Patent Owner is entitled to cross-examine Mr. Cho within the scope of his declaration as routine discovery under 37 C.F.R. § 42.51(b)(1)(ii). Specifically, 37 C.F.R. § 42.51(b)(1)(ii) states, “Cross examination of affidavit testimony *is authorized* within such time period as the Board may set” (*emphasis added*). The default time period set for cross-examination is set forth in 37 C.F.R. § 42.53(b)-(c). *See* Office Patent Trial Practice Guide (“OPTPG”), 77 Fed. Reg. 48756, 48762 (Aug. 14, 2012).

Indeed, the Board appears to have already acknowledged this very point on page 4 of the Additional Discovery Order, which states, “***Patent Owner is also entitled to corroboration of the assertions in Mr. Cho’s declaration and to cross-examine Mr. Cho***” (*emphasis added*). It is undisputed that cross-examination of

Mr. Cho was not ordered as additional discovery, so the Board's statement in the Additional Discovery Order appears to acknowledge that Patent Owner has the right to cross-examine Mr. Cho as routine discovery.

A party presenting a witness's testimony by declaration should arrange to make that witness available for cross-examination as routine discovery. OPTPG at 48761. The USPTO's AIA Blog¹ further explains that "there is no need for a party to file a motion for 'routine discovery' with the Board, or serve a request for routine discovery on a party—parties have the burden to come forward and provide such material." To deny Patent Owner the opportunity to cross-examine Mr. Cho within the scope of his declaration would disregard the Code of Federal Regulations, the OPTPG, and the guidance provided by the AIA Blog. Denying the opportunity to cross-examine Mr. Cho would also contradict the Board's earlier statements made in this proceeding.

During the Initial Conference Call, Petitioner contended that the Board had already ruled, in either the Additional Discovery Order or in an email communication (Ex. 2010), that Petitioner was not authorized to cross-examine Mr. Cho. Ex. 2009, 24:24-25:5. However, as noted above, page 4 the Additional Discovery Order specifically states that Patent Owner is *entitled* to cross-

¹ www.uspto.gov/blog/aia/entry/message_from_administrative_patent_judges

examination Mr. Cho. Plus, the Board's email did not preclude the cross-examination as routine discovery.

During the Initial Conference Call, Petitioner also suggested that Patent Owner should not be entitled to cross-examine Mr. Cho because he is in Korea. Ex. 2009, 23:24-24:2, 32:2-5. Denying cross-examination of a declarant on this basis would be improper for several reasons. First, denying the opportunity for cross-examination based on the declarant being located outside of the United States would encourage parties in *inter party* review proceedings to rely on foreign declarants in order to shield their declarants from deposition.² Second, Patent Owner has already expressed that it intends to work with Petitioner in order to facilitate the cross-examination by conducting the cross-examination at a convenient location in the United States or via video conference, if necessary. Third, Mr. Cho is employed by Petitioner, so Petitioner clearly has the ability to make this witness available at any time or location. Finally, it is unreasonable for Petitioner to argue that Patent Owner should not be able to cross-examine Mr. Cho

² It has not been established whether or not this declarant, who graduated from Fordham University School of Law in New York (*see* Ex. 2011), travels to the U.S. as part of his job duties, which involves the “coordination and supervision of outside counsel” with respect to “*inter partes* review” proceedings before the United States Patent & Trademark Office. Ex. 1009, ¶ 2.

when it was Petitioner who decided to submit Mr. Cho's declaration in the first place.

During the Initial Conference Call, Petitioner also argued that Patent Owner should not be entitled to cross-examine Mr. Cho because Petitioner was no longer relying on Mr. Cho's declaration. Petitioner even offered to withdraw the declaration of Mr. Cho after it has already considered by the Board and relied upon in the Additional Discovery Order. Ex. 2009, 30:22-31-6. To deny the opportunity to cross-examine Mr. Cho on this basis would set bad policy and precedent, as it would encourage parties to submit but then withdraw declarations if no longer useful to the submitting party or as a strategic effort to deny a deposition. Such a ruling would promote gamesmanship and would undermine the integrity of *inter partes* review.

Mr. Cho's declaration includes statements that directly contradict Petitioner's responses to interrogatories.³ As one example (among others), Mr.

³ Patent Owner is mindful of the Board's request to explain the specific reasons why Patent Owner desires this deposition testimony and what it intends to cover, but is also concerned about not revealing work product or trial strategy to Petitioner. Patent Owner has tried to strike a balance and respectfully submits that anything further would tread into trial strategy. To be clear, Patent Owner only seeks to cross examine Mr. Cho within the scope of his prior declaration.

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