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Paper 33
Date: June 25, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

FG SRC LLC,
Patent Owner.

Case No. IPR2020-01449
Patent 7,149,867

Before KALYAN K. DESHPANDE, GREGG I. ANDERSON, and KARA L. SZPONDOWSKI, *Administrative Patent Judges.*

SZPONDOWSKI, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On June 18, 2021, Patent Owner contacted the Board by email to request authorization "to file a Motion for Additional Discovery pursuant to 37 C.F.R. § 42.52." Ex. 3006. Specifically Patent Owner seeks authorization to file a motion compelling testimony of Mr. Zhang, the primary author of one of the references asserted[1] in this proceeding ("the Zhang reference"), and to obtain a subpoena for Mr. Zhang's testimony pursuant to 35 U.S.C. § 24. *Id.*[2] Patent Owner also requested waiver of the requirement to file a formal motion "in order to obtain the requested discovery in time for the Patent Owner Response or Patent Owner Sur-reply." *Id.* Patent Owner's Response is due July 2, 2021. Paper 32 ("Corrected Joint Stipulation to Revise Scheduling Order").

On June 22, 2021, a conference call with counsel for the parties was held with Judges Szpondowski, Deshpande, and Anderson. On the call, Patent Owner stated that it requested Mr. Zhang's testimony as to factual questions regarding a simulation described in the Zhang reference. Patent Owner requested authorization to file a motion for additional discovery in order to obtain a subpoena from the district court to compel Mr. Zhang's testimony. Patent Owner stated that it had contacted and spoken with Mr. Zhang, but Mr. Zhang declined to voluntarily testify. Patent Owner also requested the testimony of Dr. Gupta, a co-author on the Zhang reference

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[1] Xingbin Zhang et al., *Architectural Adaptation for Application-Specific Locality Optimizations*, published in the Proceedings of the International Conference on Computer Design - VLSI in Computers and Processors (IEEE, October 12–15, 1997), 150–156 (Ex. 1003).

[2] Although Patent Owner requested authorization to file a Motion for Additional Discovery under 37 C.F.R. § 42.52, it appears Patent Owner is actually requesting authorization to file a motion compelling testimony under 37 C.F.R. § 42.52.

and Declarant (Exs. 1010, 1030) in this proceeding, as to his understanding of the reference.[3] According to Patent Owner, the experts in this case have taken opposing views as to what the Zhang reference discloses, so Patent Owner seeks testimony from Mr. Zhang and Dr. Gupta to aid in understanding what is described in the Zhang reference. Patent Owner contends such testimony would be helpful to the Board. Patent Owner also argued that during Dr. Gupta's deposition, Petitioner foreclosed testimony as to the witness's understanding of the Zhang reference.

Petitioner opposes for three reasons. First, Petitioner argues that Patent Owner's request is untimely. Second, Petitioner argues that the type of information sought by Patent Owner is not relevant and is not in the "interests of justice." Third, Petitioner argues that Dr. Gupta's testimony was limited to the printed publication status of the Zhang reference and the proffered testimony was beyond the authorized scope. *See* Paper 27, 3.

A party in a contested case may apply to a United States District Court for a subpoena to compel testimony. 35 U.S.C. § 24. A party seeking to compel testimony must first obtain authorization from the Board. 37 C.F.R. § 42.52(a). "[I]n *inter partes* review, discovery is limited as compared to that available in district court litigation." *Garmin Int'l, Inc. v. Cuozzo Speed Tech. LLC*, IPR2012-00001, Paper 26, 5 (PTAB Mar. 5, 2013) (informative). Additional discovery must be "necessary in the interest of justice." 35 U.S.C. § 316(a)(5); 37 C.F.R. § 42.51(b)(2). In determining whether additional discovery in an *inter partes* review proceeding is

[3] We treat Patent Owner's request as to Dr. Gupta as a request for authorization to file a motion for additional discovery pursuant to 37 C.F.R. § 42.51(b)(2).

necessary in the interest of justice, the Board considers the following factors: (1) the request is based on more than a mere possibility of finding something useful; (2) the request does not seek the litigation positions of the other party; (3) the information is not reasonably available through other means; (4) the request is easily understandable; and (5) the request is not overly burdensome to answer. *Garmin*, Paper 26 at 6–7.

We are not persuaded that Patent Owner has shown a basis for authorizing a motion for additional discovery in order to obtain a subpoena from the district court to compel Mr. Zhang's testimony or a motion for additional discovery for Dr. Gupta's testimony. Specifically, Patent Owner has not demonstrated a *prima facie* showing that there is more than a mere possibility that the testimony it anticipates Mr. Zhang and Mr. Gupta will provide will be useful to our determination of the patentability of the challenged claims.

Patent Owner is requesting the testimony of two of the authors of the Zhang reference relating to the substantive content of that reference. The first *Garmin* factor requires us to consider the likelihood that the additional discovery will uncover something useful. The mere possibility of finding something useful is not sufficient to demonstrate that the requested discovery is necessary in the interest of justice. *Garmin*, Paper 26, 6, 7–13. The third *Garmin* factor is whether the party seeking the additional discovery can reasonably figure out or assemble by other means the information sought to be discovered. *Garmin*, Paper 26, 6, 13–14.

Patent Owner has not presented sufficient information to demonstrate that the requested testimony from Mr. Zhang or Dr. Gupta is likely to yield useful information not reasonably available through other means. Although

the Zhang reference is an article describing a proposed machine architecture and performed simulation, Patent Owner asserts that the testimony of Mr. Zhang and Dr. Gupta might provide more information on the simulation itself. However, the relevant issue is what a person skilled in the art at the time of the invention would understand the Zhang reference discloses, not what the authors intended to describe, or how the simulation itself, outside of its description in the article, operates. *See, e.g.*, *HVLPO2, LLC v. Oxygen Frog, LLC*, 995 F.3d 685, 688 (Fed. Cir. 2020) ("Obviousness and each of its underlying components are analyzed from the perspective of a person of skill in the art"); *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) ("Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains."). That is, Patent Owner does not require the testimony of the authors of the Zhang reference in order to ascertain what a person with ordinary skill in the art at the time of the invention would have understood the Zhang reference to disclose. Rather, Petitioner and Patent Owner have offered the testimony of experts in this regard. *See, e.g.*, Ex. 1006 ¶¶ 30–44, 104–110, 127–164; Ex. 2001 ¶¶ 21, 22, 30, 31, 34–49, 75–107. Both parties' experts may be deposed through routine discovery as to their opinions about the disclosure in the Zhang reference. At most, Patent Owner has demonstrated that the parties' experts dispute what the Zhang reference teaches. We are not persuaded that testimony from Dr. Gupta[4] or third party Mr. Zhang as to these topics would resolve this dispute or is necessary.

[4] Although Dr. Gupta provided a Declaration in this proceeding (Ex. 1010, Ex. 1030), his testimony related to the printed publication status of the article, not to the substantive content or disclosure. Under 37 C.F.R.

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