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571-272-7822

Paper 32  
Date:August 24, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLIED MATERIALS, INC.,  
Petitioner,

v.

OCEAN SEMICONDUCTOR LLC,  
Patent Owner.

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IPR2021-01339 (Patent 8,676,538 B2)  
IPR2021-01340 (Patent 6,725,402 B1)  
IPR2021-01342 (Patent 6,968,248 B1)  
IPR2021-01344 (Patent 6,907,305 B2)

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Before MIRIAM L. QUINN, JOHN D. HAMANN, and DAVID COTTA,  
*Administrative Patent Judges.*

COTTA, *Administrative Patent Judge.*

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

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On August 15, 2022, counsel for Patent Owner contacted the Board to request a conference call regarding Petitioner's refusal to produce two experts for deposition. Ex. 3002.<sup>1</sup> Further to this request, a conference call was held on Thursday, August 18, 2022, between counsel for Petitioner, counsel for Patent Owner, and Administrative Patent Judges Quinn, Hamann, and Cotta. At the conclusion of the conference call, we verbally authorized Patent Owner to conduct the requested depositions. This Order memorializes that decision.

The facts underlying this dispute between the parties can be summarized as follows. Petitioner relied upon the testimony of Dr. Stanley Shanfield in the Petitions in IPR2021-01339, IPR2021-01342 and IPR2021-01344 and on the testimony of Dr. Miltiadis Hatalis in the Petition in IPR2021-01340. Although it was entitled to do so, Patent Owner did not depose Dr. Shanfield or Dr. Hatalis before filing its Patent Owner Responses in any of these proceedings. In its Reply to Patent Owner's Response in IPR2021-01339, IPR2021-01342, and IPR2021-01344, Petitioner again relied upon the testimony of Dr. Shanfield and, in its Reply to Patent Owner's Response in IPR2021-01340, Petitioner again relied upon the testimony of Dr. Hatalis. Now, Patent Owner seeks to depose Dr. Shanfield and Dr. Hatalis before its Sur-Reply.

During the teleconference, Petitioner argued that, at this stage in the proceedings, our rules limit new evidence to transcripts from cross-

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<sup>1</sup> For expediency, we cite to the exhibit in IPR2021-01339. The same exhibit was also filed in IPR2021-01340, IPR2021-01342, and IPR2021-01344.

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examination of “reply witnesses.” *See*, 37 C.F.R. 42.23 (providing that a sur-reply, “may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness”). According to Petitioner, because the testimony of Drs. Shanfield and Hatalis was first presented with its Petitions, Drs. Shanfield and Hatalis are not “reply witnesses” as that term is used in our rules. As support for its position, Petitioner cited two Board decisions, *Lenovo Holding Company, Inc. v. Dodots Licensing Solutions LLC*, IPR2019-01279, Paper 22 (PTAB, Sept. 1, 2020) (“*Lenovo*”) and *A.C. Dispensing Equipment Inc. v. Prince Castle LLC*, IPR2014-00511, Paper 17 (PTAB, Oct. 15, 2014) (“*AC Dispensing*”). In *Lenovo*, the panel declined to authorize deposition of Petitioner’s technical expert following the filing of Petitioner’s Reply, finding “Petitioner’s technical expert is not a reply witness.” *Lenovo*, Paper 22, 4. In *A.C. Dispensing*, the panel declined to authorize deposition of a witness on his Petition declaration after the filing of Petitioner’s Reply in part because “[p]ostponing cross-examination until the close of evidence does not promote efficiency” and “impairs the orderly development of the record.” *A.C. Dispensing*, Paper 17, 3.

Patent Owner argued that Drs. Shanfield and Hatalis are “reply witnesses” because their testimony is cited and relied upon in Petitioner’s Reply. In addition, Patent Owner pointed out that Drs. Shanfield and Hatalis have not previously been deposed on their cited testimony.

While we agree with the panel in *A.C. Dispensing* that “[p]ostponing cross-examination until the close of evidence does not promote efficiency” (*A.C. Dispensing*, 3), we were not persuaded by Petitioner’s argument that

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because a Sur-reply's new evidence is limited to cross-examination of "reply witnesses," cross-examination in the instant proceedings could never occur after the Reply, when such witnesses have not been previously deposed. We recognize that our decision may be at odds with *Lenovo* and *A.C.*

*Dispensing*, at least insofar as we authorized Patent Owner to cross-examine two witnesses that under those cases would have been denied. However, we have authority under 37 C.F.R. § 42.5(b) to waive or suspend a requirement, and our decision here is limited to the particular circumstances presented in the captioned cases. Although we have authorized depositions of Drs. Shanfield and Hatalis, we caution Patent Owner that its use of the testimony it obtains is limited by 37 C.F.R. 42.23(b), which provides that "[a] sur-reply may only respond to arguments raised in the corresponding reply."

Accordingly, it is:

ORDERED that Patent Owner is authorized to take the depositions of Drs. Shanfield and Hatalis in the above captioned proceedings.

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