

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MARVELL SEMICONDUCTOR, INC.,
Petitioner,

v.

INTELLECTUAL VENTURES I LLC,
Patent Owner.

Case IPR2014-00552
Patent No. 6,754,195

THOMAS L. GIANNETTI, *Administrative Patent Judge.*

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

A conference call in this proceeding took place on February 10, 2015. The parties were represented by their respective counsel. The conference was requested by Patent Owner to discuss a request to compel discovery relating to its contention that Webster U.S. Patent No. 7,274,652 is disqualified as prior art under the provisions of 35 U.S.C. § 103(c). Paper

20. A court reporter was present on the call. Patent Owner will arrange for filing of the transcript.

Petitioner and Patent Owner have narrowed the issues in dispute. The Board is appreciative of this effort. Some disputed issues remain, however.

Patent Owner has had discussions with counsel for Intersil regarding certain documents collected by Intersil showing the corporate relationship between Intersil Americas, Inc. and Intersil Corporation during the relevant time period. The documents appear to be relevant to a contested issue. Intersil, however, has refused to produce the documents without a subpoena.

Patent Owner has located and been in touch with named inventors Webster and Seals. Patent Owner has submitted a declaration by Mr. Webster regarding his obligation to assign his patent to Intersil. Ex. 1021. Patent Owner, however, was not able to state whether Mr. Webster would voluntarily appear for a deposition to permit Patent Owner to cross-examine him.

After discussing the situation further, the Board determined that compelled discovery was warranted and requested the parties to meet and confer on a form of order for compelling the depositions of Intersil, Webster, and Seals, and to submit a proposed form of order or orders to the Board by noon eastern time on Friday, February 13th. If the parties are unable to agree they are to submit separate orders.

At Patent Owner's request, the Board agreed to extend Due Date 1 to accommodate the discovery.

After hearing argument, the Board also took under advisement Petitioner's motion for rehearing in IPR2014-00553.

It is, therefore,

ORDERED that Patent Owner's request for compelled discovery is granted;

FURTHER ORDERED that Due Date 1 in the Scheduling Order (as modified by the parties), currently set for February 25, 2015, is extended by three weeks to March 18, 2015;

FURTHER ORDERED that counsel shall meet and confer and submit to the Board via email a proposed order or orders (in Word format) for the depositions of Intersil, and co-inventors Webster and Seals, by noon on Friday, February 13, 2015; and

FURTHER ORDERED that the scope of discovery of Intersil shall be strictly limited to information sufficient to show the corporate relationship between Intersil Americas, Inc. and Intersil Corporation during the relevant time period.

IPR2014-00552
Patent 6,754,195

PETITIONER

Walter Renner
axf@fr.com

Jermery Monaldo
IPR27410-0021IP1@fr.com

PATENT OWNER

Herbert Hart
hhart@mcandrews-ip.com

Peter McAndrews
pmcandrews@mcandrews-ip.com

Donald Coulman
dcoulman@intven.com

[Michael Carrozza](mailto:mcarrozza@mcandrews-ip.com)
mcarrozza@mcandrews-ip.com