

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOSHIBA CORPORATION,
Petitioner,

v.

OPTICAL DEVICES, LLC,
Patent Owner.

Case IPR2014-01445 (Patent 7,839,729 B2)
Case IPR2014-01446 (Patent 7,196,979 B2)
Case IPR2014-01447 (Patent 8,416,651 B2)¹

Before ERICA A. FRANKLIN, GLENN J. PERRY, and JAMES B. ARPIN,
Administrative Patent Judges.

ARPIN, *Administrative Patent Judge.*

ORDER

Denying Petitioner's Request for Authorization to File a Motion to Compel
Testimony and Production of Documents
37 C.F.R. § 42.52(a)

¹ The parties are not authorized to use a multiple case caption. They must file individual papers in each case to which they pertain.

IPR2014-01445 (Patent 7,839,729 B2)

IPR2014-01446 (Patent 7,196,979 B2)

IPR2014-01447 (Patent 8,416,651 B2)

On May 7, 2015, the respective counsel for the parties and Judges Franklin, Perry, and Arpin participated in a conference call for the above-captioned cases to discuss Petitioner's request for authorization to file a motion to compel third party testimony and production of documents. During the conference call, Petitioner explained that, after the entry of our Institution Decisions in these cases, Patent Owner timely served objections to the Product Preview for ST TDA7522, "Digital Servo and Decoder" (Ex. 1005; "ST TDA7522")² on the basis of lack of authentication and as inadmissible hearsay, in each case. *See* 37 C.F.R. § 42.64(b)(1). Further, in its Preliminary Responses for these cases, Patent Owner argued that Petitioner failed to demonstrate that ST TDA7522 was a printed publication. *See, e.g., Toshiba Corp. v. Optical Devices, LLC*, Case IPR2014-01445, Paper 6, 20–23. ST TDA7522 provided a basis for one of the grounds of unpatentability, upon which we instituted *inter partes* review in each case.

Petitioner did not serve supplemental evidence upon Patent Owner in response to Patent Owner's objections to ST TDA7522. *See* 37 C.F.R. § 42.64(b)(2). However, as a precaution against arguments that Patent Owner might raise regarding the status of ST TDA7522 as a printed publication in the Patent Owner Response or inadmissibility of ST TDA7522 as unauthenticated or inadmissible hearsay evidence in a motion to exclude evidence, Petitioner now seeks to compel third party testimony and production of documents to obtain information responsive to these potential arguments.

The applicable rule for compelled testimony and production of documents is 37 C.F.R. § 42.52(a), which provides:

(a) Authorization required. A party seeking to compel

² ST TDA7522 is identified by the same exhibit number in each case.

IPR2014-01445 (Patent 7,839,729 B2)

IPR2014-01446 (Patent 7,196,979 B2)

IPR2014-01447 (Patent 8,416,651 B2)

testimony or production of documents or things must file a motion for authorization. The motion must describe the general relevance of the testimony, document, or thing, and must:

- (1) In the case of testimony, identify the witness by name or title; and
- (2) In the case of a document or thing, the general nature of the document or thing.

See Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions; Final Rule, 77 Fed. Reg. 48,612, 48,622 (Aug. 14, 2012) (“A party in a contested case may apply for a subpoena to compel testimony in the United States, but only for testimony to be used in the contested case. See 35 U.S.C. 24. Section 42.52(a) requires the party seeking a subpoena to first obtain authorization from the Board; otherwise, the compelled evidence would not be admitted in the proceeding.”).

During the conference call, Petitioner acknowledged that it had not contacted the third party to determine whether the third party has a witness capable of providing the testimony or documents relating to the information that Petitioner seeks to discover. Moreover, Petitioner acknowledged that it had not discussed with the third party whether the third party would be willing to provide the testimony or documents relating to the information that Petitioner seeks to discover, absent a subpoena.

Further, to the extent that Petitioner’s request may not be too late with respect to submitting supplemental evidence, Petitioner has not demonstrated beyond mere possibility and mere allegation the need to compel testimony or document production from a third party, or the likelihood that such compelled testimony or document production would produce the information sought.

IPR2014-01445 (Patent 7,839,729 B2)
IPR2014-01446 (Patent 7,196,979 B2)
IPR2014-01447 (Patent 8,416,651 B2)

ORDER

Accordingly, it is:

ORDERED that Petitioner's request for authorization to file a motion to compel third party testimony and production of documents is *denied*.

PETITIONER:

Brent K. Yamashita
Alan A. Limbach
DLA PIPER, LLP
Brent.yamashita@dlapiper.com
Alan.kimbach@dlapiper.com

PATENT OWNER:

Thomas Engellenner
Reza Mollaaghababa
Andy Chan
PEPPER HAMILTON LLP
engellenert@pepperlaw.com
mollaaghababar@pepperlaw.com
chana@pepperlaw.com

Theodosios Thomas
OPTICAL DEVICES, LLC
ted.thomas@optical-devices.com