

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SEMICONDUCTOR COMPONENTS INDUSTRIES, LLC
(d/b/a ON SEMICONDUCTOR),
Petitioner,

v.

POWER INTEGRATIONS, INC.,
Patent Owner.

Case IPR2016-00809
Patent 6,212,079 B1

Before THOMAS L. GIANNETTI, DANIEL N. FISHMAN, and
KERRY BEGLEY, *Administrative Patent Judges*.

FISHMAN, *Administrative Patent Judge*.

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

On June 16, 2017, a conference call was held between counsel for
Petitioner, counsel for Patent Owner, and Judges Giannetti, Fishman, and
Begley. The conference call addressed issues raised by the parties in an

email message sent to the Board on June 8, 2017. Patent Owner provided a court reporter and filed a transcript of the conference call as Exhibit 2073 (“Tr.”).

Patent Owner requests that the Board compel production of certain documents and things believed to be in possession of Petitioner. Specifically, Patent Owner requests the Board compel production of documents and things consisting of (hereinafter “Requested Materials”):

- Datasheets for the AN8087SL and AN8088SL integrated circuit chips.
- Datasheet for the Cosel DC-DC module that incorporates one or both of the AN8087SL and AN8088SL chips.
- The physical Cosel DC-DC module that incorporates one or both of the AN8087SL and AN8088SL chips.
- The shipping history received from Cosel for the DC-DC modules sold with an AN8087SL and AN8088SL chip.

Under our rules, “[a] party seeking to compel 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. . . [identify] the general nature of the document or thing.” 37 C.F.R. § 42.52. We consider Patent Owner’s email and discussion in the conference call as such a motion for authorization.

Patent Owner’s request derives, indirectly, from an allegation in Petitioner’s Reply that, in a conversation with Dr. Madisetti (Petitioner’s expert), Mr. Oda confirmed the understanding of Dr. Madisetti regarding teachings of the Oda reference (Ex. 1029), on which the instituted ground of unpatentability for obviousness relies. Tr. 5:11–19; *see also* Paper 37, 29.

Mr. Oda is the first named inventor of the Oda reference. Petitioner engaged the services of Mr. Kakizaki as an agent in Japan to locate Mr. Oda and arrange for the conversation. *See* Ex. 1078.

In the conference call, Patent Owner asserted the Requested Materials may contain information inconsistent with Petitioner's position regarding the Oda reference and, thus, should have been served as part of routine discovery under 37 C.F.R. § 42.51(b)(1)(iii). Tr. 5:20–24, 17:5–12. In particular, Patent Owner argues the Requested Materials relate to proper interpretation of the Oda reference—an interpretation allegedly inconsistent with Petitioner's interpretation of the Oda reference that Petitioner asserts was confirmed by Mr. Oda in discussions with Dr. Madisetti. *Id.* at 5:24–6:8.

In the conference call, Petitioner responded that the Requested Materials are irrelevant to any ground asserted in the Petition and Petitioner does not rely on the Requested Materials in any assertions of its Petition (including Petitioner's Reply). Tr. 11:22–12:23

We are not persuaded that Patent Owner can make a sufficient showing that the Requested Materials are relevant to any issue in this review. During the conference call, the Board denied the request due to lack of relevance. Tr. 24:11–24. We stated we did not see any need to look at products or data sheets to understand what the Oda reference teaches. *Id.* at 24:13–16. Further, the request does not convince us beyond speculation that the information is likely to be useful. *Garmin Int'l Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, Paper 26, slip op. at 6 (PTAB Mar. 5, 2013) (informative). The Requested Materials may, or may not, provide evidence of implementation of devices that relate to the Oda reference.

However, the mere existence of documents describing devices and corresponding physical devices that may, or may not, implement features of the Oda reference provides no further understanding what the Oda reference itself would have taught or suggested to the ordinarily skilled artisan. We can adequately weigh each party's position and their respective experts' opinions regarding what the Oda reference would have taught or suggested to the ordinarily skilled artisan regardless of whether the Requested Materials are consistent or inconsistent with either party's position. We will determine what the Oda reference would have taught or suggested to the ordinarily skilled artisan based on the reference itself and the opinions of the parties' experts. We are, therefore, not convinced that Patent Owner can show the Requested Materials are relevant to an issue to be decided in our Final Written Decision.

It is, therefore,

ORDERED that Patent Owner's request that we authorize a motion to compel production of the Requested Materials is *denied*.

IPR2016-00809
Patent 6,212,079 B1

PETITIONER:

Roger Fulghum
Brett Thompsen
Brian Oaks
BAKER BOTTS L.L.P.
roger.fulghum@bakerbotts.com
brett.thompsen@bakerbotts.com
brian.oaks@bakerbotts.com

PATENT OWNER:

Stephen Schaefer
Neil Warren
FISH & RICHARDSON P.C.
IPR10256-0021IP1@fr.com
PTABInbound@fr.com