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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NVIDIA CORP.,
Petitioner,

v.

SAMSUNG ELECTRONICS CO., LTD.,
Patent Owner.

Case IPR2015-01327
Patent 6,287,902 B1

Before JAMESON LEE, PATRICK R. SCANLON, and JUSTIN BUSCH, *Administrative Patent Judge*.

BUSCH, *Administrative Patent Judge.*

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

A conference call was held on October 22, 2015. The participants were respective counsel for the parties and Judges Lee, Scanlon, and Busch. The subject matter for discussion was Petitioner's request for authorization to file a Motion to Compel Routine Discovery pursuant to 37 C.F.R. § 42.51(b)(1)(iii).

At the outset, counsel for both parties were reminded that an email to the Board is an improper time and venue for arguing the merits of requests for authorization to file motions or the merits of the underlying motion itself. An email requesting authorization to file a motion should provide sufficient detail to explain the purpose of the motion for which that party seeks authorization, but should not include argument in support of its position.

During the conference call, counsel for Petitioner explained that it seeks discovery of documents in Patent Owner's possession that allegedly are "inconsistent with a position advanced by" in the Patent Owner Preliminary Response and that Patent Owner, therefore, should have served the documents sought with the Preliminary Response. *See* 37 C.F.R. § 42.51(b)(1)(iii). In particular, Petitioner argues that Patent Owner possesses documents indicating that Patent Owner previously has taken the position that a laid-open Korean patent application is a printed publication. Petitioner asserts the Patent Owner Preliminary Response takes a contrary position, specifically that a Korean patent application with a laid-open date is not a printed publication.

Patent Owner stated on the call that the Preliminary Response argues only that Petitioner has not met its burden to establish that the cited reference qualifies as prior art. Patent Owner asserts the Preliminary Response does not argue that the Korean patent application cited is not a

printed publication. During the call, Petitioner asserted Patent Owner's argument that Petitioner failed to meet its burden to establish the Korean patent application is a printed publication is "tantamount" to an affirmative argument that the reference is not a printed publication. We disagree. The distinction is important which, if not made, leads to an unreasonably broad scope of routine discovery.

Although Patent Owner asserts it challenges only whether Petitioner has met its burden, we look to the arguments, not simply a party's characterization of those arguments, to analyze Petitioner's request. After reviewing the Preliminary Response, we agree with Patent Owner that the Preliminary Response merely asserts Petitioner has not met its burden in establishing that the cited Korean patent application is a printed publication. Therefore, we find the documents Petitioner seeks are not inconsistent with a position taken in the Preliminary Response and need not have been served as routine discovery. Accordingly, we deny Petitioner's request for authorization to file its motion seeking discovery.

Order

It is

ORDERED that a motion to compel discovery is unnecessary and not authorized; and

FURTHER ORDERED that, if either party believes any characterization of its position is inaccurate, that party has no more than three business days to initiate a joint telephone conference call with the Board to discuss the matter.

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Patent 6,287,902 B1

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