

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHENZHEN BUXIANG NETWORK TECHNOLOGY CO., LTD.,
Petitioner,

v.

IDEAL TIME CONSULTANTS LIMITED,
Patent Owner.

IPR2021-00080
Patent 7,353,555 B2

Before, KEN B. BARRETT, LYNNE H. BROWNE, and
PATRICK R. SCANLON, *Administrative Patent Judges*.

SCANLON, *Administrative Patent Judge*.

ORDER
Denying Petitioner's Motion for Additional Discovery
37 C.F.R. § 42.51(b)(2)(i)

I. INTRODUCTION

We authorized Petitioner to file a Motion for Additional Discovery regarding two documents that witness Mr. Vincent Lau allegedly used before or during his deposition to refresh his recollection. Paper 24. Pursuant to our authorization, ShenZhen BuXiang Network Technology Co., Ltd. (“Petitioner”) filed a Motion for Additional Discovery. Paper 25 (“Motion” or “Mot.”). Ideal Time Consultants Limited (“Patent Owner”) filed an Opposition to the Motion. Paper 27 (“Opposition” or “Opp.”). For the reasons stated below, Petitioner’s Motion is *denied*.

II. DISCUSSION

A. Legal Standards

In *inter partes* reviews, “[t]he moving party has the burden of proof to establish that it is entitled to the requested relief.” *See* 37 C.F.R. § 42.20(c) (2020). We may order additional discovery if the moving party shows “that such additional discovery is in the interests of justice.” *Id.* § 42.51(b)(2)(i); *see also* Patent Trial and Appeal Board Consolidated Trial Practice Guide 24–25 (Nov. 2019) (contrasting the “interests of justice” additional discovery standard for *inter partes* reviews and derivation proceedings with the “good cause” standard for post-grant reviews and covered business method patent proceedings).¹ Discovery in an *inter partes* review proceeding is less than what is normally available in district court patent litigation. *See Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 5–6 (PTAB Mar. 5, 2013) (precedential). The Board has identified several factors (“the *Garmin* factors”) that are important in determining whether additional discovery is in the interests of justice. *Id.* at

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

6–7. Those factors include: 1) whether there is more than a mere possibility or allegation that something useful will be found; 2) whether the requesting party seeks the other party’s litigation positions and the underlying basis for those positions; 3) the requesting party’s ability to generate equivalent information by other means; 4) whether the instructions are easily understandable; and 5) whether the requested discovery is overly burdensome. *Id.*

B. Analysis

Petitioner requests additional discovery of two documents that it identifies as the “Patent Memo” and the “Yellow Highlighted Notes.” Mot. 2. Petitioner contends that Mr. Lau testified that the Patent Memo is a memorandum containing discussions about the patent challenged in this proceeding (i.e., U.S. Patent No. 7,353,555 B2 (Ex. 1001, “the ’555 patent”)) given to him by counsel before his deposition. *Id.* at 2–3 (citing Ex. 1016, 17:9–23:14). In addition, Petitioner contends that Mr. Lau testified that the Yellow Highlighted Notes is a document that he created and had in front of him during his deposition. *Id.* at 3 (citing Ex. 1016, 94:15–104:10).

Petitioner argues that its request for additional discovery should be granted under the *Garmin* factors and pursuant to Federal Rule of Evidence 612. *Id.* 6–10.

1. First Garmin Factor

The first *Garmin* factor requires that “the requestor of information should already be in possession of a threshold amount of evidence or reasoning tending to show beyond speculation that something useful will be uncovered.” *Garmin* at 7. In the context of this factor, “‘useful’ means

favorable in substantive value to a contention of the party moving for discovery.” *Id.*

Petitioner argues that “the requested documents are believed to be part of a concerted effort to script the testimony of [Mr. Lau] to support a ‘swear-behind’ argument.” Mot. 6. According to Petitioner, “Mr. Lau admittedly reviewed the Patent Memo before his deposition to refresh his recollection (EX1016, Lau Depo., 20:4-6), and relied on it for his testimony on the ’555 Patent (*id.* at 18:11-24 and 19:10-20:14).” *Id.* Thus, Petitioner contends that discovery of the Patent Memo “will show whether Mr. Lau testified on the ’555 Patent from his memory or from the ‘cross-examination outline’ counsel had scripted for him.” *Id.* at 7. Petitioner also contends that “discovery of the Yellow Highlighted Notes will be useful toward showing that Mr. Lau’s testimony was entirely or in part based on a script prepared before the deposition, rather than his memory.” *Id.*

Patent Owner argues that Petitioner’s assertion that it *believes* the requested documents are part of a concerted effort to script Mr. Lau’s testimony to support a swear-behind argument fails to satisfy the first *Garmin* factor. Opp. 6. Patent Owner asserts that “[i]t is difficult to conceive of a more obvious assertion of ‘a possibility and mere allegation’ than resorting to Petitioner’s own subjective ‘belief’ about what will be discovered,” and “Petitioner fails to demonstrate that it is ‘in possession of evidence’ that substantiates its subjective belief ‘beyond speculation.’” *Id.* (quoting *Garmin* at 6).

We agree with Patent Owner. Petitioner’s assertions that the requested documents could be part of a concerted effort to script Mr. Lau’s testimony are not sufficient to establish evidence or reasoning tending to show beyond speculation that something useful will be uncovered.

Regarding the Patent Memo, Mr. Lau first testified that he reviewed various documents provided to him by counsel in preparing for his deposition. Ex. 1016, 17:1–11. Mr. Lau further testified that these “documents would include the exhibits and also the discussion about the patent.” *Id.* at 19:1–12. When asked about “the document that contained the discussions about the patent” (i.e., the Patent Memo), Mr. Lau testified that “*I guess* it’s all about the contents of the patent and just to refresh my memory.” *Id.* at 19:25–20:6 (emphasis added). When asked to describe the subject matter of the Patent Memo generally, however, Mr. Lau also testified that “the main thing was to go through *my declaration* and we discussed a few points, I guess, within the *declaration*.” *Id.* at 21:11–22 (emphases added). Thus, Mr. Lau’s testimony about the nature of the Patent Memo is equivocal and does not support, beyond speculation, Petitioner’s contention that the Patent Memo will show a concerted effort to script Mr. Lau’s testimony to support a swear-behind argument.

As for Petitioner’s contention that the Patent Memo will show whether Mr. Lau testified on the ’555 patent from memory or from the outline counsel had scripted for him, we note that Mr. Lau also testified that “I wouldn’t a hundred percent rely on the documents. I rely on what I know.” *Id.* at 18:15–17. For these reasons, we are not persuaded that the Patent Memo will show something favorable in substantive value to any of Petitioner’s contentions.

Petitioner’s evidence and reasoning regarding what the Yellow Highlighted Notes would show is even less persuasive. Petitioner argues that Mr. Lau testified that he had prepared the Yellow Highlighted Notes without participation of counsel, when he was informed of the deposition and specifically for the purpose of the deposition. Mot. 7 (citing Ex. 1016

97:8–17, 100:1–5). Petitioner does not explain adequately, however, why this testimony demonstrates that the Yellow Highlighted Notes would show whether Mr. Lau’s testimony about the ’555 patent was based on a script rather than his memory. Accordingly, we are not persuaded that the Yellow Highlighted Notes will show something favorable in substantive value to any of Petitioner’s contentions.

For the above reasons, we determine that the first *Garmin* factor, which has primary relevance in this case, weighs against granting the Motion.

2. *Remaining Garmin Factors*

Petitioner argues that each of the second through fifth *Garmin* factors favors the requested additional discovery. Mot. 8–9. Patent Owner does not address these other *Garmin* factors directly, but argues that “[b]ecause Petitioner fails to satisfy the first *Garmin* factor, it cannot demonstrate that the ‘interests of justice’ warrant additional discovery in this case. Opp. 6 (citing *Redline Detection, LLC v. Star EnviroTech, Inc.*, IPR2013-00106, Paper 31 at 5 (PTAB Aug. 27, 2013)). We agree with Patent Owner that, even when weighing the remaining *Garmin* factors in Petitioner’s favor, Petitioner has not met its burden to show that the additional discovery is necessary in the interest of justice for the reasons provided above.

3. *Federal Rule of Evidence 612*

Petitioner argues it is entitled to the Yellow Highlighted Notes under Federal Rule of Evidence 612(a)(1) because Mr. Lau used the Yellow Highlighted Notes to refresh his recollection while answering questions in his deposition. Mot. 9 (citing Ex. 1016, 94:16–26 and 97:3–7). Petitioner argues it is entitled to the Patent Memo under Federal Rule of Evidence 612(a)(2) because Mr. Lau used the Patent Memo to refresh his recollection

before testifying and relied on the contents of the Patent Memo for his testimony. *Id.* (citing Ex. 1016, 17:9–18:24, 20:4–6, 22:9–12). Petitioner also asserts that attorney-client privilege and work-product immunity are waived with respect to a document reviewed to refresh the witness’s recollection. *Id.* at 9–10 (citing *United States v. 22.80 Acres of Land*, 107 F.R.D. 20, 26 (N.D. Cal. 1985); *In re Comair Air Disaster Litig.*, 100 F.R.D. 350, 354 (E.D. Ky. 1983); *Thomas v. Euro RSCG Life*, 264 F.R.D. 120, 122 (S.D.N.Y. 2010); *Heron Interact, Inc. v. Guidelines, Inc.*, 244 F.R.D. 75, 78 (D. Mass. 2007)).

Patent Owner argues that Federal Rule of Evidence 612(a) “applies only to documents that a witness used to refresh his or her memory of facts **about which he or she testified.**” Opp. 5 (citing *Sporck v. Peil*, 759 F.2d 312, 318 (3d Cir. 1985); *In re Kellogg Brown & Root, Inc.*, 796 F.3d 137, 144 (D.C. Cir. 2015)). Then, Patent Owner argues that Petitioner fails to demonstrate that Mr. Lau used either the Patent Memo or the Yellow Highlighted Notes “to ‘refresh his recollection’ of anything pertinent to his testimony.” *Id.* at 7.

We agree with Patent Owner that Petitioner has not established sufficiently that Mr. Lau relied on the Yellow Highlighted Notes for his testimony or that the Yellow Highlighted Notes impacted his testimony. Mr. Lau’s testimony indicates that the Yellow Highlighted Notes was one of seven documents that were on his desk during his video deposition. Ex. 1016, 99:1–11. Mr. Lau testified that the Yellow Highlighted Notes was a document that he prepared for himself (*id.* at 101:17–103:21), but we are not directed to any testimony from Mr. Lau suggesting that he relied on or used the Yellow Highlighted Notes in giving his testimony. Nor has Petitioner provided any other basis to suggest that the Yellow Highlighted

Notes impacted Mr. Lau's testimony. Accordingly, we determine that Petitioner is not entitled to the Yellow Highlighted Notes under Rule 612(a)(1). *See Kellogg*, 796 F.3d at 144 (“[E]ven if the witness consults a writing *while testifying*, the adverse party is not entitled to see it unless the writing influenced the witness's testimony.”); *Sporck*, 759 F.2d at 318 (stating that Rule 612 applies only where a witness's “answers to . . . specific areas of questioning were informed by documents he had reviewed”).

Regarding the Patent Memo, although we determine above that there may be some uncertainty regarding Mr. Lau's testimony on this document, Mr. Lau did testify unequivocally that the Patent Memo helped him refresh his recollection about the '555 patent. Ex. 1016, 22:9–12. Furthermore, we agree with Petitioner that Mr. Lau testified extensively about the '555 patent. *See* Mot. 3 (citing Ex. 1016). Nevertheless, we determine that Petitioner is not entitled to the Patent Memo under Rule 612(a)(2) even if it influenced Mr. Lau's testimony. The reason for this determination is that Rule 612(a)(2) applies to a writing used to refresh memory “before testifying, if the court decides that justice requires the party to have those options.” And, for the reasons discussed above, we determine that Petitioner has not met its burden to show that discovery of the Patent Memo is in the interest of justice.

4. *Conclusion*

After considering the parties arguments and the *Garmin* factors, and for the foregoing reasons, we deny Petitioner's motion for additional discovery.

III. ORDER

In consideration of the foregoing, it is hereby:
ORDERED that Petitioner's Motion is *denied*.

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