

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMMISSARIAT À L'ENERGIE ATOMIQUE ET AUX ENERGIES
ALTERNATIVES,
Petitioner,

v.

SILICON GENESIS CORPORATION,
Patent Owner.

Case IPR2016-00831 (Patent 6,162,705)
Case IPR2016-00832 (Patent 6,013,563)
Case IPR2016-00833 (Patent 6,103,599)¹

Before JONI Y. CHANG, J. JOHN LEE, and SHEILA F. McSHANE,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

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

¹ This Order addresses issues that are substantially the same in all of these cases. Therefore, we exercise our discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style heading in any subsequent papers without prior authorization.

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A conference was held with the parties on October 27, 2016, regarding the above-captioned cases (“CEA-SiGen IPRs”). At the conference, Patent Owner Silicon Genesis Corporation (“SiGen”) requested authorization to file a motion seeking discovery from Petitioner, Commissariat à L’Energie Atomique et aux Energies Alternatives (“CEA”), regarding allegedly unnamed real parties in interest. Specifically, SiGen seeks at least one deposition of a witness designated by CEA to testify about its relationship with non-party Soitec S.A. (“Soitec”), any joint defense agreement that may exist between CEA and Soitec, and evidence showing any payments made by Soitec to CEA relating to the CEA-SiGen IPRs.

SiGen’s stated basis for seeking this discovery is that such evidence would be inconsistent with the position taken by CEA in its petitions in the CEA-SiGen IPRs that CEA is the only real party in interest to these proceedings. *See, e.g., Commissariat à L’Energie Atomique et aux Energies Alternatives v. Silicon Genesis Corp.*, Case IPR 2016-00831, Paper 1, 1 (PTAB Apr. 1, 2016). Thus, according to SiGen, this discovery is routine discovery under 37 C.F.R. § 42.51(b)(1)(iii), and SiGen asserts CEA is withholding such routine discovery.

CEA opposed SiGen’s request for authorization and asserted the discovery SiGen seeks is neither routine discovery nor permissible additional discovery under 37 C.F.R. § 42.51(b)(2)(i). CEA’s counsel represented that CEA is not withholding any discovery that is inconsistent with its position that CEA is the sole real party in interest. Further, CEA argued SiGen has not satisfied the requirements for obtaining additional discovery set forth in *Garmin International, Inc. v. Cuozzo Speed*

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Technologies, Case IPR2012-00001, slip op. at 6–16 (PTAB Mar. 5, 2013) (Paper 26) (precedential).

As explained in the Office Patent Trial Practice Guide, whether a particular entity is a real party in interest is a “highly fact-dependent question” that is assessed “on a case-by-case basis.” *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,759 (Aug. 14, 2012) (citing *Taylor v. Sturgell*, 553 U.S. 880, 893–95 (2008)). Although multiple factors may be relevant to the inquiry, “[a] common consideration is whether the non-party exercised or could have exercised control over a party’s participation in a proceeding.” *Id.*; see *Zoll Lifecor Corp. v. Phillips Elec. N. Am. Corp.*, Case IPR2013-00609, slip op. at 10 (PTAB Mar. 20, 2014) (Paper 15).

SiGen’s basis for its belief that CEA is withholding routine discovery is speculative at best. SiGen relies on the following allegations:

- (1) The three patents challenged in the CEA-SiGen IPRs are the same patents asserted against Soitec (and GlobalFoundries U.S., Inc.) in pending litigation in district court and at the U.S. International Trade Commission. These patents are now challenged by CEA despite that CEA is not a party to that litigation, and CEA has not been sued for infringement of these patents.
- (2) CEA and Soitec collaborated on the development of Soitec’s technology that is accused of infringement in the litigation against Soitec, and have a business relationship that, at least in part, relates to that technology.

Based on these allegations, SiGen asserts that CEA’s filing of the CEA-SiGen IPRs is “too coincidental,” concluding that Soitec must be exercising

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control over the CEA-SiGen IPRs, and that Soitec may be paying for the CEA-SiGen IPRs as well. Even if the above allegations are true, however, they do not support SiGen's speculative conclusions and do not indicate sufficiently that routine discovery may have been withheld.

Being sued for infringement is not a prerequisite for filing an IPR; indeed, anyone who is not the owner of a patent may file a petition to institute an *inter partes* review of the patent. 35 U.S.C. § 311(a). Thus, the fact that CEA has not been sued for infringement does not indicate other parties must be controlling or paying for the CEA-SiGen IPRs. Nor does the fact that CEA has or had a business relationship with Soitec indicate control or payment. SiGen did not identify any specific reason regarding the nature of that relationship that reasonably would lead to such a conclusion. CEA's unspecified "collaboration" or involvement in the development of Soitec's technology, without more, is insufficient.

Consequently, we determine SiGen has not presented a sufficient basis at this time to indicate CEA may have withheld routine discovery. CEA's counsel also represented to the Board that it is not withholding any discovery inconsistent with its position on real parties in interest. Moreover, SiGen has not addressed the *Garmin* factors and, thus, we determine a basis has not been shown at this time to justify authorization for a motion for additional discovery. Therefore, SiGen's request is *denied*.

As an additional matter, both parties indicated during the conference that the parties' attempt to resolve this dispute about discovery only consisted of SiGen's e-mail requesting the discovery, and CEA's e-mail refusing that request. The Board expects, however, that parties will meet and confer in good faith to try to *resolve* disputes before contacting the

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Board, not merely identify that a dispute exists. The parties' efforts here were inadequate. Therefore, all future requests for the Board's intervention to resolve a dispute between the parties shall include an express certification that the parties met and conferred in good faith to try to resolve the dispute.

ORDER

Accordingly, it is

ORDERED that SiGen is not authorized at this time to file a motion to compel routine discovery;

FURTHER ORDERED that SiGen is not authorized at this time to file a motion for additional discovery; and

FURTHER ORDERED that any future request by either party for the Board's intervention to resolve a dispute shall include an express certification that the parties met and conferred in a good faith attempt to resolve the dispute, including the date(s) on which the parties met and conferred.

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