

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

QUALCOMM INC.,
Patent Owner.

Case IPR2018-01283
Case IPR2018-01452
Patent 7,834,591 B2¹

Before TREVOR M. JEFFERSON, DANIEL J. GALLIGAN, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

JEFFERSON, *Administrative Patent Judge*.

ORDER

Conduct of Proceeding, Compelling Testimony and Production
37 C.F.R. §§ 42.5, 42.52

¹ This Order applies to both listed cases. The parties may not use this style heading unless authorized.

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Petitioner filed an authorized “Motion Under 37 C.F.R. § 42.52(a) to Apply for Subpoena Under 35 U.S.C. § 24 to Compel Production of Documents and Testimony from Analog Devices, Inc.” on April 19, 2018 in IPR2018-01283 and IPR2018-01452. Paper 11.² In both cases, Petitioner seeks authorization to file a subpoena to compel the production of documents and testimony of third party Analog Devices, Inc. related to Exhibit 1007.³ *Id.* at 1–2. Petitioner’s motion addresses the factors set forth for such discovery in *Garmin International, Inc. v. Cuozzo Speed Technologies LLC*, Case IPR2012-00001, slip op. at 6–7 (PTAB Mar. 5, 2013) (Paper 26). *Id.* at 2–4. The motion also includes as an attachment a copy of the subpoena and requested discovery from the third party. *Id.* at Appendix 1.

Patent Owner informed the Board by email on April 26, 2019, that “the parties have conferred and Petitioner has agreed to work with Patent Owner to coordinate the timing of the depositions sought [via third-party subpoena]. In view of that agreement, Patent Owner has elected not to oppose [Petitioner’s] motions.” Ex. 3001 (April 26, 2019 email to Board). Thus, Petitioner’s motion is unopposed.

A party moving for subpoena “must show that such additional discovery is in the interests of justice.” 37 C.F.R. § 42.51(b)(2). The Board

² Similar papers and exhibits having the same numbering were filed in the two subject cases. For clarity and expediency, references to paper or exhibit numbers apply to both IPR2018-01283 and IPR2018-01452, unless indicated otherwise.

³ Walt Kester, Ed., *Practical Design Techniques for Power and Thermal Management*, Analog DEVICES, 1998 (Ex. 1007).

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has identified factors important in determining whether an additional discovery request meets the standard of being “in the interest of justice.” *Garmin International, Inc.*, Case IPR2012-00001, slip op. at 6–7. Having reviewed Petitioner’s request and arguments, we find that *Garmin* factors weigh in favor of allowing the discovery. Paper 11, 2–4. Petitioner has also shown reasonable efforts to obtain the production and testimony from Analog Devices, Inc. *Id.* at 1–2. In light of the parties’ agreement, Patent Owner’s election not to oppose Petitioner’s motion (Ex. 3001), and Petitioner’s arguments, we grant the requested subpoena.

It is

ORDERED that Petitioner’s Motion Under 37 C.F.R. § 42.52(a) to Apply for Subpoena Under 35 U.S.C. § 24 to Compel Production of Documents and Testimony from Analog Devices, Inc. is *granted*;

FURTHER ORDERED that Petitioner is authorized under 35 U.S.C. § 24 to apply for a subpoena from the Clerk of the United States court for the district where testimony of Analog Devices, Inc. is to be taken.

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