

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MEXICHEM AMANCO HOLDINGS S.A. de C.V.  
Petitioner

v.

HONEYWELL INTERNATIONAL, INC.  
Patent Owner

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Case IPR2013-00576  
Patent 8,444,874 B2

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Before LINDA M. GAUDETTE, FRANCISCO C. PRATS, and  
JACQUELINE WRIGHT BONILLA, *Administrative Patent Judges*.

BONILLA, *Administrative Patent Judge*.

DECISION  
Denying Patent Owner's Motion for Additional Discovery  
*37 C.F.R. § 42.51(b)(2)*

In an Order dated August 26, 2014 (Paper 31), we authorized Patent Owner to file a motion for additional discovery as it pertains to a deposition of Dr. Takashi Shibamura, who provided previously prepared testimony relied on by Petitioner in its Reply to Patent Owner's Response (Paper 27). The previously prepared testimony is a Declaration of Dr. Shibamura (Ex. 1076), originally submitted in Reexamination Control Nos. 95/002,189 and 95/002,204 on July 26, 2014, in relation to U.S. Patent No. 7,534,366, which is related, through a number of continuation-in-part applications, to the challenged patent here.

On August 28, 2014, Patent Owner filed its Motion for Additional Discovery (Paper 32), and, on September 2, 2014, Petitioner filed a Response to that Motion (Paper 34). We have considered both papers. Although Patent Owner's position has merit in relation to certain *Garmin* factors,<sup>1</sup> we will not grant the requested additional discovery because we are not persuaded it is "necessary in the interest of justice" under the circumstances of this case. 35 U.S.C. § 316(a)(5); *see also* 37 C.F.R. § 42.51(b)(2). Particularly in view of the fifth factor ("Requests Not Overly Burdensome to Answer") outlined in *Garmin*,<sup>2</sup> we will not compel Petitioner to provide Dr. Shibamura for cross-examination in a deposition. We will not compel Petitioner to produce a witness who is not under Petitioner's control, who may reside in Japan, especially where such action may require a court subpoena<sup>3</sup> and/or invoke the Hague Convention. Paper 34 at 3-4.

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<sup>1</sup> *Garmin Int'l Inc. et al. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, Paper 26 (PTAB March 5, 2013).

<sup>2</sup> *Id.* at Paper 26 at 7, 14-16.

<sup>3</sup> The Board does not have authority to issue a subpoena for the production of a witness residing in the United States. Such production must be compelled through a subpoena from a U.S. District Court. *See* 35 U.S.C. § 24.

We note, however, that to the extent Petitioner relies on Dr. Shibanuma's previously prepared Declaration (Ex. 1076), we will take into consideration whether Patent Owner has had an opportunity to cross-examine Dr. Shibanuma. Although we will not compel Petitioner to produce the witness, if Petitioner does not produce Dr. Shibanuma for cross-examination, we will give that Declaration little to no weight as Patent Owner has not been offered a fair opportunity to challenge his testimony. *See, e.g.*, Fed. R. Evid. 801 and 802. "[A] party presenting a witness's testimony by affidavit should arrange to make the witness available for cross-examination." Office Trial Practice Guide, 77 Fed. Reg. 48756, 48761 (August 14, 2012).

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's Motion for Additional Discovery is *denied*.

For PETITIONER:

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