

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SYNOPSISYS, INC.
Petitioner

v.

MENTOR GRAPHICS CORPORATION
Patent Owner

Case IPR2012-00042 (SCM)
Patent 6,240,376 B1

Before SALLY C. MEDLEY, HOWARD B. BLANKENSHIP, and
JENNIFER S. BISK, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

DECISION
Motion for Additional Discovery
37 C.F.R. § 42.51

INTRODUCTION

Patent Owner, Mentor Graphics Corporation (Mentor Graphics), filed
a motion for additional discovery. Paper 21 (“Motion”). Petitioner

Synopsis, Inc. (“Synopsis”) filed an opposition. Paper 22 (“Opposition”).
The motion is *denied*.

BACKGROUND

Mentor Graphics seeks additional discovery relating to (1) “the legal standard adopted by the Board” regarding 35 U.S.C. § 315(b) (Motion 3); and (2) assignor estoppel.¹ Motion 3-4. Specifically, Mentor Graphics seeks:

- (1) fifteen requests for the production of documents, whereby each of the fifteen requests seeks discovery of multiple documents (Ex. 2018);²
- (2) ten interrogatories (Ex. 2019);
- (3) twenty-three requests for admissions (Ex. 2020); and
- (4) deposition of a “person or persons” with sufficient knowledge to testify on behalf of Synopsis; whereby Mentor Graphics seeks to depose the person or persons on six deposition topics. (Ex. 2021).

¹ The parties disagree that a party may raise assignor estoppel as a defense in an *inter partes* review. Motion 5-9 and Opposition 7-10. Solely for purposes of deciding Mentor Graphics’ motion for discovery, we assume that the issue of assignor estoppel may be raised in an *inter partes* review. The decision does not, otherwise decide, whether assignor estoppel may be raised as a defense in an *inter partes* review.

² For example, Request No. 2 includes “Copies of any memoranda of understanding, commitment letters, letters of intent, or similar documents prepared or sent by EVE or Synopsis in connection with, or in contemplation of, the executed merger or acquisition agreement(s) referred to in REQUEST NO. 1.” Ex. 2018 at 4.

ANALYSIS

Motions

A motion must include a statement of the precise relief requested. 37 CFR § 42.22. A party cannot be granted relief when the relief requested is not clearly articulated or is not meaningful in the first instance. Mentor Graphics motion is not well articulated. Mentor Graphics explains that its request for discovery in relation to 35 U.S.C. § 315(b) is to “allow the Patent Owner an opportunity to show the applicability of a § 315(b) bar under the legal standard adopted by the Board.” Motion 3. The legal standard adopted by the Board is that § 315(b) requires a privity relationship “in 2006 when EVE was served with a complaint alleging infringement of the ’376 patent.” Decision – Institution of *Inter Partes* Review; Paper 16 at 15-16; “Decision;” Rehearing Req. 14. Yet, Mentor Graphics seeks discovery of such things as the effective filing date of the petition and the status of EVE as a real party-in-interest to the *inter partes* review. Motion 3. However, the production of such things has not been shown to be relevant to “the § 315(b) bar under the legal standard adopted by the Board.”

The section regarding the request for discovery for the assignor estoppel issue is also not clear. Missing from that section is an explanation of why the requested discovery would be necessary in the interest of justice. Instead, that section of the motion explains why assignor estoppel can be raised as a defense in an *inter partes* review. Motion 5-9. In that regard, Mentor Graphics argues that the requests for additional discovery will provide an opportunity for it to fully develop and present facts so the Board may consider the applicability of assignor estoppel as a bar. Motion 6.

However, Mentor Graphics must demonstrate that the requests are in the interest of justice by showing first the relevance to the issue it seeks to raise. *See, e.g.*, IPR2013-00026, Paper 32 at 5. That, Mentor Graphics has failed to do. Since Mentor Graphics has failed to clearly and consistently articulate why it needs the discovery in the first instance, the Board cannot grant the request.

Additionally, and for the following reasons, we have considered each item of Mentor Graphics' discovery request (*see, e.g.*, Exhibits 2018-2021) and conclude that Mentor Graphics' motion has not shown that any of the items it requests are necessary in the interest of justice. Accordingly, the discovery request is *denied*.

Necessary in the interest of justice

Under the Leahy-Smith America Invents Act, discovery is available for the deposition of witnesses submitting affidavits or declarations and for “what is otherwise necessary in the interest of justice.” 35 U.S.C. § 316(a)(5); see also 37 C.F.R. § 42.51(b)(2)(“The moving party must show that such additional discovery is in the interest of justice”). Clear from the legislative history is the idea that discovery should be limited; and that the PTO should be conservative in its grant of additional discovery in order to meet time imposed deadlines. 154 Cong. Rec. S9988-89 (daily ed. Sept. 27, 2008) (statement of Sen. Kyl).

One factor in determining whether additional discovery is in the interest of justice is whether there exists more than a “mere possibility” or “mere allegation that something useful [to the proceeding] will be found.” *See Order – Authorizing Motion for Additional Discovery, IPR2012-00001, Paper 20 at 2-3* (explaining several factors to consider in determining

whether additional discovery meets the “necessary in the interest of justice” standard).³ In other words, the “party requesting discovery should already be in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered.” *Id.*

Here, Mentor Graphics does not provide an explanation with evidence sufficient to show that in fact something useful will be uncovered if discovery is authorized. The section of the motion regarding the § 315(b) issue is brief and merely lists the discovery Mentor Graphics seeks.

Motion 3. The “Category 2: Assignor Estoppel” section of the motion is also devoid of an explanation with evidence sufficient to show that in fact something useful will be uncovered if discovery is authorized. Motion 5-9.

As an example, Mentor Graphics seeks “copies of any memoranda of understanding, commitment letters, letters of intent, or similar documents prepared or sent by EVE or Synopsys in 2006 or earlier in connection with, or in contemplation of, an executed merger or acquisition by Synopsys of EVE.” (Ex. 2018; Request No. 13). Mentor Graphics has not directed us to evidence that would tend to show, for example, that in 2006 EVE had any relationship with Synopsys at all. Indeed, all along in this proceeding, Mentor Graphics has advanced a position that Synopsys and EVE were in privity sometime in 2012; never in 2006. Decision 16; *also see* Prelim. Resp. 2 (“EVE and Synopsys were separate companies until the autumn of 2012.”); Prelim. Resp. 7-8 (“In 2006, EVE was the sole owner of all rights in the ZeBu line of products. Any interest Synopsys holds today is derived

³ During a conference call held on March 21, 2013, discussion was had with respect to the “necessary in the interest of justice” standard and decisions in other *inter partes* proceedings that provide guidance for this standard. *See, e.g.*, Ex. 1011 at 15-16.

from its acquisition of EVE.”).

Another factor to consider is whether a request for additional discovery shows what efforts the moving party made to acquire, on its own, any of the requested discovery it now seeks. *See, e.g.*, IPR2012-00001, “factor 3.” Based on the record before us, we do not know what efforts Mentor Graphics made to acquire any of the items it seeks to retrieve from Synopsis. For example, Mentor Graphics requests “[c]ommunications⁴ before October 4, 2012, regarding or relating to Burgun’s role at Synopsys.” Ex. 2018; Request No. 7. Mentor Graphics has not explained adequately why it needs any and all communications “regarding or relating” to Burgun’s role at Synopsis prior to October 4, 2012. We do not know, for example, why Mentor Graphics would need potentially publicly available information that Mentor Graphics could obtain through other means, such as press releases, etc.

Still another factor to consider is whether the requests for discovery are overly burdensome to answer, given the expedited nature of the *inter partes* review. That burden includes financial burden, burden on human resources and burden on meeting the time schedule. *See, e.g.*, IPR2012-00001, “factor 5.” Mentor Graphics’ requests are overly burdensome and would require a significant expenditure of time, along with human and financial resources. For example document request no. 7, requests “[c]ommunications before October 4, 2012, regarding or relating to Burgun’s role at Synopsys.” Ex. 20185; Request No. 7. The request is broad. Synopsis indicates that such a request would be overly burdensome,

⁴ Mentor Graphics defines “communication” to include communications with an external source (someone outside of the Synopsys organization), such as a member of the public. Ex. 2018 at 3.

forcing it to chase down a large volume of documents that reside in the records of three different companies in two countries. Opposition 11. We agree with Synopsis that such a request would be overly burdensome. Indeed, Mentor Graphics has not shown that it tailored narrowly any of its requests or tried to diminish the burden to Synopsis with respect to any of its requests in any way.

CONCLUSION

For the reasons discussed above, we conclude that Mentor Graphics' motion has not shown that any of the items it requests (Exhibits 2018-2021) are necessary in the interest of justice.

ORDER

It is

ORDERED that Mentor Graphics' motion for additional discovery is *denied*.

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