

**PUBLIC VERSION**

**UNITED STATES INTERNATIONAL TRADE COMMISSION  
Washington, D.C.**

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**In the Matter of**

**CERTAIN SEMICONDUCTOR  
INTEGRATED CIRCUITS USING  
TUNGSTEN METALLIZATION AND  
PRODUCTS CONTAINING SAME**

Inv. No. 337-TA-38

**Order No. 48: Denying Complainants' Motion For Reconsideration Or, In  
The Alternative, Leave To Seek Interlocutory Review**

Complainants LSI Corporation and Agere Systems Inc. ("LSI") have moved for reconsideration of the undersigned's ruling, made during a telephonic conference on February 25, 2009, that a deposition witness appearing on behalf of respondent Cypress Semiconductor Corp. ("Cypress") need not answer questions with respect to claim 4 of United States Patent No. 5,227,335, inasmuch as only claim 1 is asserted against Cypress. In the alternative, complainants request that leave be granted to seek interlocutory review of this ruling, pursuant to 19 C.F.R. § 210.24(b)(1). (Motion No. 648-69).

Cypress filed an opposition to complainants' motion. Respondents Micronas GmbH, Microchip Technology, Inc., ProMOS Technologies, Inc. and Dongbu HiTek Semiconductor Business join in Cypress' opposition. The Commission Investigative Staff ("Staff"), which did not offer a position during the telephonic conference, has filed a response in support of complainants' motion.

For the reasons set forth below, the motion is DENIED in all respects.

LSI argues that the requested discovery from Cypress regarding claim 4 is proper under Commission Rule 210.27(b). 19 C.F.R. § 210.27(b). It states that with respect to the scope of

discovery in a Commission investigation, Rule 210.27(b) provides that “a party may obtain discovery regarding any matter not privileged, that is relevant to,” *inter alia*, “[t]he claim or defense of the party seeking discovery or to the claim or defense of any other party.” Mot. at 3.

At the outset, LSI’s request for discovery from Cypress fails to satisfy this fundamental, threshold rule setting forth the “scope” of discovery. To begin, under Rule 210.27(b), as a party LSI may obtain discovery of non-privileged matter that is relevant to a “claim” that it asserts. Because LSI asserts only claim 1 against Cypress, its request for discovery as to claim 4 (which it admits it does not assert against this respondent) is beyond the scope of allowable discovery. Next, because LSI is the complainant, its discovery request as to claim 4 does not fit within the allowance of Rule 210.27(b) for discovery regarding the “defense” of the party seeking discovery. Obviously, that provision does not apply here.

Thus, having no basis upon which to seek discovery against Cypress as to claim 4 under the Rule 210.27(b)(1) provision relating to “[t]he claim or defense of the party seeking discovery,” if LSI is to prevail in this discovery dispute, it must find support in the remainder of the Rule which provides, “or to the claim or defense of any party.” This portion of Rule 210.27(b), however, is of no more help to complainant than the earlier portion of the Rule discussed above.

In that regard, LSI’s seeking discovery from Cypress on claim 4, when it only asserts claim 1 against this respondent, simply does not fit within the phrase “the claim or defense of any party.” The fact that LSI asserts claim 4 against five of the 21 respondents involved in this investigation does not mean that complainants can pursue discovery against the other 16 respondents (including Cypress) who are not charged with infringing claim 4. The phrase “the

claim or defense of any party” is not broad enough to cover the circumstances of this discovery dispute.<sup>1</sup> Thus, LSI’s discovery request of Cypress on claim 4 goes beyond the scope of discovery permitted by Rule 210.27(b).

Nonetheless, complainants and Staff primarily base their arguments for discovery from Cypress as to claim 4 on Commission Rule 210.28(d). 19 C.F.R. § 210.28(d). *See* Mot. at 3; Staff Resp. at 2. Commission Rule 210.28(d) provides, *inter alia*, that “[e]vidence objected to shall be taken subject to the objections, except that privileged communications and subject matter need not be disclosed.” 19 C.F.R. § 210.28(d). As seen from the plain language of the Rule, except in cases of privilege, an attorney representing a deposition witness cannot instruct the witness not to answer a question, but rather should make an objection on the record based on relevance or another ground, and permit the deposition to proceed.

Yet, the Rule does not prohibit a judge from ruling upon a specific deposition question, or line of questioning, to determine whether it is relevant or otherwise proper.<sup>2</sup> *See, e.g.* FRCP 30(c)(2) (“A person may instruct a deponent not to answer ... to enforce a limitation ordered by the court.”) Essentially, that is exactly what happened here after the parties contacted the undersigned for the telephonic conference. Given this recurring deposition problem as recounted

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<sup>1</sup> Indeed, by LSI’s own admission, the questions that the Cypress witness was instructed not to answer were “questions regarding various steps in a Cypress flow.” Mot. at 2. “The process flow steps relate principally to dependent claim 4.” *Id.* Accordingly, complainants’ claim that “the testimony sought is clearly relevant and reasonably calculated to lead to the discovery of admissible evidence” is incorrect, as evidence regarding Cypress’ process flows relating to claim 4 would not appear to be admissible at hearing inasmuch as LSI only asserts claim 1 against Cypress.

<sup>2</sup> In fact, the Commission’s Rules provide that there are instances in which an administrative law judge can order that information may not be obtained. *See* 19 C.F.R. § 210.27(b) (“Scope of discovery”); 19 C.F.R. § 210.34 (“Protective orders”).

by LSI, the undersigned limited the deposition questioning to the claims asserted against the respondent. Hence, the court's concern over completing this investigation within the time set in the already modified procedural schedule. *See* Teleconference Tr. at 9-10 (Rough) ("This investigation will never come to a conclusion.")

In addition, neither complainants nor the Staff cite any authority for the proposition that once a dispute is presented to a judge for a ruling, the judge is unable to limit the scope of a deposition as part of the inherent powers of the court to provide for a more orderly hearing and to prevent the wasteful expenditure of the parties' resources. In fact, the Staff cites to FRCP 30(c), which supports an opposite conclusion. Moreover, the applicable ground rules contemplate such a situation. Ground Rule 2w states:

If a witness testifying at a deposition is instructed by his attorney not to answer a question (on any basis other than a claim of privilege), and the question is not withdrawn, the parties shall contact the Administrative Law Judge by telephone so that the matter can be presented to the Administrative Law Judge for an immediate ruling.

Order No. 2, Ground Rule 2(w).

Such is the case here. After Cypress' counsel instructed a Cypress engineer not to answer a deposition question the parties contacted the undersigned, who ruled upon the line of questioning at issue. That line of questioning is whether or not it was proper to inquire of the Cypress witness about technical information related only to possible infringement of claim 4 of the asserted patent, when only claim 1 is asserted against Cypress.<sup>3</sup> *See* Mot. at 2. The

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<sup>3</sup> It appears that Cypress counsel followed the Ground Rule by contacting the undersigned as soon as possible for a ruling on the line of questioning that he found to be  
(continued...)

undersigned ruled that such questions were not permissible. *See* Conf. Tr. 8-9 (Mot. Ex. 1, pp. 11-12).

The purpose of the telephonic conference was not merely to settle a dispute as to whether Cypress counsel made a proper objection to the claim 4 inquiries (although that may have been the parties' initial intention). In ruling upon this discovery dispute, it was the intention of this court to make a substantive ruling on the line of questioning at issue (both as to Cypress and the remaining 16 respondents also not asserted to have infringed claim 4) so as to advance the taking of the deposition, without needless expenditure of the parties' resources. This is consistent with the Ground Rules.<sup>4</sup>

LSI argues at length in their motion, and the Staff concurs, that as a general matter, complainants must be allowed to question Cypress and other respondents about claims that they are not accused of infringing, so that this investigation might be further expanded.<sup>5</sup>

Complainants argue that because they seek discovery before making formal infringement allegations, they risk being "penalized for acting properly." *See* Mot. at 7-8. As discussed below, that argument rings hollow.

Although this investigation was instituted almost 10 months ago (*see* 73 Fed. Reg. 29534

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<sup>3</sup>(...continued)  
objectionable. *See* Conf. Tr. 9 (Mot. Ex. 1, p. 12).

<sup>4</sup> The Staff submits, however, that "[a]s complainants note, the line of questioning here would not have taken up a significant portion of the deposition." Staff Resp. at 3. *See* Mot. at 3 (LSI counsel's reference to "a few questions about process flow steps poses no burden at all.") While the Staff's observation is actually beside the point, it offers no support for its rather optimistic prediction.

<sup>5</sup> LSI already has been denied leave to amend the complaint so as to assert claim 4 against Cypress. *See* Order Nos. 17 & 35.

(2008)), complainants and Staff offer no end to the process of collecting discovery, and filing motions to amend a complaint that has already been amended several times. Indeed, they promise more depositions, and likely more motions to amend to the complaint. *See Mot.* at 8 (“[A] general ruling that deposition questions regarding claim 4 are proper is needed. This issue has now arisen during three depositions, the other two being Microchip and Micronas.”); *Staff Resp.* at 2-3.

In other words, LSI effectively seeks to change what presently is a Commission investigation into its own private pre-complaint investigation. Complainants appear to take the position that for discovery purposes they are entitled to probe into all aspects of the investigation whether or not a particular claim is asserted against a particular respondent. Thus, in LSI’s view (and the Staff’s as well), the only discovery limitation in an investigation is the number of claims asserted.

In essence, a claim against one respondent is a claim against all respondents for discovery purposes. In this scenario, unfortunate is the respondent with one claim being asserted against it to be in an investigation with a co-respondent having multiple claims asserted against it. Under LSI’s and the Staff’s approach, both of these respondents would be open to the same discovery, regardless of the fact that one of the respondents has only a single claim asserted against it and the other respondent has many claims asserted. This approach simply makes no sense and, in fact, presents the potential for discovery abuse.

At complainants’ request, the undersigned has already permitted the complaint and notice of investigation to be amended to add new respondents; later permitted the complaint and notice of investigation to be amended to add new patent claims; and has permitted the complaint to be

amended three times to allow complainants to charge respondents with infringement under additional claims. Most, if not all, of these amendments were ordered by the undersigned despite the strenuous objections of numerous respondents, including arguments that such amendments would cause them prejudice. *See* Order No. 15 (Initial Determination Granting Complainants' Motion to Amend the Complaint and Notice of Investigation to Add Additional Respondents); Order No. 17 (Initial Determination Granting, in Part, Complainants' Motion to Amend the Complaint and Notice of Investigation); Order No. 34 (Granting, in Part, Complainants' Second Motion to Amend the Complaint As to Claim 3); Order No. 35 (Granting, in Part, Complainants' Motion to Amend the Complaint As to Claims 3 and 4). In addition, the undersigned has already extended the target date for completion of this investigation to 20 months, due largely to the need to accommodate an investigation that has been widely expanded upon complainants' request. *See* Order No. 23 (Initial Determination Extending the Target Date).

Now, with expert reports due in less than two weeks, and the evidentiary hearing set for July of this year, it is, as expressed by the undersigned during the recent telephonic conference, unclear how this investigation can move forward if complainants are allowed at this late date to question deponents on claims that are not at issue with respect to particular respondents. *See* Conf. Tr. at 8-9 (Mot. Ex. 1, pp. 11-12); Order No. 22 (Modifying Procedural Schedule).

Further, neither complainants, nor the Staff, have provided any scenario in which their requests could be granted and the investigation could proceed under the current target date, or adhere to anything even approximating the modified procedural schedule. *See* Mot. at 4 (arguing that timing concerns do not justify precluding complainants from gathering relevant evidence). Yet, this investigation must be completed. The target date cannot be extended indefinitely and

respondents required to linger for years under allegations of patent infringement before being afforded a hearing.

Accordingly, for the foregoing reasons, LSI's request for reconsideration of the adverse discovery ruling must fail. Further, leave to seek interlocutory review cannot be granted. Commission Rule 210.24(b)(1) would require the undersigned to file a determination "in writing, with justification in support thereof, that the ruling involves a controlling question of law or policy as to which there is substantial ground for difference of opinion, and that either an immediate ruling may materially advance the ultimate completion of the investigation or subsequent review will be an inadequate remedy." 19 C.F.R. § 210.24(b)(1). However, it has not been shown how the undersigned could justify an appeal based on Commission Rules 210.27(b) and 210.28(d), or how there could be any difference of opinion concerning the need to advance this investigation in order to meet its modified procedural deadlines and extended target date.

Accordingly, complainants' Motion No. 648-69 is DENIED.

Within seven days of the date of this document, each party shall submit to the Office of Administrative Law Judges a statement as to whether or not it seeks to have any portion of the document redacted from the public version. The parties' submissions may be made by facsimile and, or, by hard copy. Any party seeking to have a portion of this document redacted from the public version must submit to this office a copy of this document with red brackets

indicating the portion, or portions, asserted to contain confidential business information.

So Ordered.

Carl C. Charneski  
Carl C. Charneski  
Administrative Law Judge

Issued: March 11, 2009

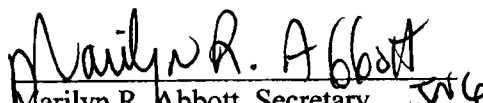
**CERTAIN SEMICONDUCTOR INTEGRATED CIRCUITS USING TUNGSTEN  
METALLIZATION AND PRODUCTS CONTAINING SAME**

**INV. NO. 337-TA-648**

**PUBLIC CERTIFICATE OF SERVICE**

I, Marilyn R. Abbott, hereby certify that the attached **ORDER** has been served upon the Commission Investigative Attorney, Ret Snotherly, Esq., and the following parties as indicated, on April 16, 2009

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METALLIZATION AND PRODUCTS CONTAINING SAME**

**INV. NO. 337-TA-648**

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INV. NO. 337-TA-648

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**INV. NO. 337-TA-648**

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