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

In the Matter of

**CERTAIN CERAMIC CAPACITORS AND
PRODUCTS CONTAINING SAME**

Inv. No. 337-TA-692

**ORDER NO. 27: DENYING MOTION BY RESPONDENTS TO COMPEL
COMPLAINANTS TO RESPOND TO INTERROGATORY NO. 120**

(May 20, 2010)

On April 15, 2010, Respondents Samsung Electro-Mechanics Co., Ltd. and Samsung Electro-Mechanics America, Inc. (collectively, “Samsung”) moved for an order compelling Complainants Murata Manufacturing Co. Ltd. and Murata Electronics North America, Inc. (collectively, “Murata”) to provide substantive responses to Samsung’s Interrogatory No. 120 from Samsung’s Ninth Set of Interrogatories. (Motion Docket No. 692-017.)

On April 26, 2010, Murata filed a written opposition to Samsung’s motion. No other responses were received.

Samsung argues that Murata is refusing to provide information that relates to Murata’s own prior art products, which may render asserted claim 3 of U.S. Patent No. 6,014,309 (“the ‘309 patent”) invalid, unenforceable, or both. (Mot. Mem. at 1.) Samsung argues that “[e]lements (c)(1) through (c)(4) of Claim 3 contain the only allegedly novel elements claimed in the ‘309 patent.” (*Id.* at 5.)

Samsung’s Interrogatory No. 120 requests information that relates to subsection (c)(2) of claim 3, (Mot. Ex. 7), which is a limitation on the number of internal electrodes in a ceramic

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capacitor. Subsection (c)(2) states, “the number of said internal electrodes is 200 or more.” (*See* Mot. Ex. 2 at col. 6, ll. 14-37.) Samsung argues that Murata refuses to identify capacitors designed and manufactured by Murata prior to 1998 that have 150 or more electrodes. (Mot. Mem. at 1-2.) Samsung argues that discovery of such Murata prior art products is relevant to this Investigation because a prior art product may invalidate a patent claim. (*Id.* at 10.) Further, Samsung argues that “[t]he relevance of such evidence is not limited to those products that anticipate all of the claim limitations.” (*Id.* at 11.) Samsung asserts:

For example, *a prior art Murata capacitor with 150 internal electrodes would not anticipate Claim 3 of the ‘309 patent. But if it satisfied the other limitations of Claim 3 – (c)(1), (c)(3), and (c)(4) discussed above – it will almost certainly render Claim 3 obvious.*

(*Id.* (emphasis added).) Samsung states that:

The ‘309 patent claims a combination of known capacitor characteristics. Every Murata capacitor *having any of the claimed characteristics*, particularly those with two or more of the claimed elements, increases the strength of [Samsung’s] obviousness case significantly.

(*Id.* at 3 (emphasis added).) Samsung also states that:

[P]rior Murata products *having any of the claimed characteristics*, but fewer than 200 electrodes, would be powerful evidence that the ‘invention’ was already known to Murata and that the recitation of more than 200 layers was an obvious progression or extension of Murata’s earlier designs. The existence of these products may also support an inequitable conduct claim, because Murata did not identify any of its products to the USPTO during prosecution of the ‘309 patent.

(*Id.* at 5 (emphasis added).)

In addition, Samsung argues that “[t]he evidence sought by Interrogatory No. 120 is, by definition, information in Murata’s possession that it did not disclose to the USPTO” and is thus

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relevant to a finding of inequitable conduct. (*Id.* at 12.) Samsung argues that deposition testimony given by Murata's witness, Yasushi Ueno, supports Samsung's belief that Murata "mass produced" products prior to the '309 patent's priority date that had the physical characteristics later claimed as novel in the '309 patent. (*Id.* at 5 (citing Mot. Exs. 1 and 2 (both Ueno Tr.)).) Samsung identifies two Murata products, the GRM 42-6 B105K10¹ and the GRM/40B/X5R105K10², as having certain characteristics claimed in claim 3 of the '309 patent, and argues that "[i]t is clear that Murata had used the claimed ceramic thickness and thickness ratio in prior capacitors. While these capacitors appear to have utilized fewer than 200 electrodes, the increase to 200 or more electrodes was an obvious extension of the technology." (Mot. Mem. at 6.)

Finally, Samsung argues that Interrogatory No. 120 is not overly broad or unduly burdensome, stating:

By limiting the interrogatory to those prior art Murata capacitors with 150 or more internal electrodes, [Samsung] has tailored its request as narrowly as possible. [Samsung] should not be forced to blindly accept Murata's determination of whether any particular prior art capacitor with 150 or more internal electrodes satisfies the other claim limitations. Instead, [Samsung] is *entitled to all pre-1998 Murata capacitors with 150 or more internal electrodes.*

(*Id.* at 11 (emphasis added).) And:

Murata has likely already collected the universe of design documents relating to its pre-1998 ceramic capacitors in order to respond fully and accurately to Interrogatory Nos. [sic] 28 (requesting identification of all pre-1998 capacitors with 200 or more electrode layers) and Interrogatory No. 95 (requesting identification of all pre-1998 capacitors with 180 or more

¹ Murata states that Samsung has had full discovery regarding this product. (*See Opp.* at 11.)

² Murata states that "Respondents provide no support for [the assertion that Murata mass produced this product] other than a partial Murata document without a certified translation." (*See Opp.* at 11, fn. 2.)

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electrode layers).

(*Id.* at 13.) Thus, according to Samsung, it is easy for Murata to obtain this information and its existence is powerful evidence of the obviousness of claim 3 of the '309 patent. (*Id.* at 2-3.)

Murata argues that it has already responded in good faith to multiple rounds of discovery, including prior interrogatories from Samsung that requested similar information to that which Samsung now requests in Interrogatory No. 120. (Opp. at 1.) Specifically, Murata argues that it responded to Samsung's Interrogatory Nos. 28 and 95, which sought, respectively, identification of each and every multi-layer capacitor manufactured by Murata prior to 1998 having (1) 200 or more and (2) 180 to 200 internal electrodes. (*Id.* at 1, 4-5 (citing Opp. Exs. 1 and 3).) Murata states that, in response to Interrogatory No. 28, it identified four pre-1998 products having 200 or more internal electrodes and, in response to Interrogatory No. 95, it could not locate a single pre-1998 product having 180-200 internal electrodes. (*Id.* at 4-5 (citing Opp. Exs. 2 and 4).)

Murata argues that its pre-1998 files are maintained only in paper form and, having already reviewed them twice to generate responses to Interrogatory Nos. 28 and 95, it would be unduly burdensome for Murata to have to do so a third time in order to respond to Interrogatory No. 120. (*Id.* at 5-6, 15-16.)³ Murata argues that Interrogatory No. 120 is overly broad because it is not "tethered in any way" to the other limitations in claim 3 of the '309 patent, *i.e.*, to subsections (c)(1), (c)(3), and (c)(4). (*Id.* at 13, 16-17.) Murata argues that the information Samsung now seeks is not relevant:

³ For example, Murata states that inventor Yasushi Ueno testified that it would take between 10 and 20 days for a Murata employee to review the necessary files. (*Id.* at 5, 15-16 (citing Mot. Ex. 16 (Ueno Tr.)).)

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[T]o the extent Interrogatory No. 120 seeks information that is relevant or reasonably calculated to lead to the discovery of admissible evidence, it is *entirely duplicative* of Interrogatory Nos. 28 and 95. To the extent it is not duplicative, it seeks information that is completely irrelevant to this Investigation.

(*Id.* at 8 (emphasis added); *see also id.* at 14.) Further:

[Samsung's] approach to discovery strongly suggests that Respondents will not recognize any limits to discovery; if Murata is compelled to provide a response to Interrogatory's [sic] No. 120 regarding pre-1998 products with 150 or more electrodes, that may well simply lead to a new request for information on all pre-1998 products with 120 or more electrodes.

(*Id.* at 7 (emphasis added); *see also id.* at 15-17.) Murata also argues that there is likely to be no benefit to expending additional resources to review the pre-1998 documents a third time because Murata is unlikely to locate responsive information. (*Id.* at 16.) Thus, according to Murata, "this is a classic case where the request is disproportionately high in comparison to the 'likely' benefit."

(*Id.*)

Based upon the motion papers and responses thereto, the Administrative Law Judge finds as follows.

Commission Rule 210.27(b) governs the scope of discovery and says that a party may obtain discovery about any non-privileged matter that is relevant to any claim or defense it may have. It is not grounds for objection that the information sought may be inadmissible at the hearing, if the information sought appears reasonably calculated to lead to the discovery of admissible evidence. 19 C.F.R. § 210.27(b). Thus, the scope of discovery has been held to be broad. *See Certain Audio Processing Integrated Circuits, and Products Containing Same*, Inv. No. 337-TA-538, Order No. 6 at 5 (July 14, 2005); *Certain Optical Disk Controller Chips and Chipsets*,

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and Products Containing Same, Including DVD Players and PC Optical Storage Devices, Inv. No. 337-TA-506, Order No. 32 at 3 (Dec. 22, 2004). Because of this broad discovery rule, “the burden of proving that an issue is beyond discovery rests squarely with the party resisting the discovery.” See *Certain Encapsulated Integrated Circuit Devices and Products Containing Same*, Inv. No. 337-TA-501, Order No. 50 (May 18, 2004).

Claim 3 is the only asserted claim of the ‘309 patent. The pertinent language of claim 3 reads as follows:

A laminated ceramic electronic part comprising . . .

(c) said ceramic element satisfying the requirements:

(1) the thickness of each said internal ceramic layer is 10 μm or less;

(2) *the number of said internal electrodes is 200 or more;*

(3) the ratio of the average thickness of each said internal electrode to the average thickness of each said internal ceramic layer is 0.10 to 0.40; and

(4) the ratio of the combined volume of said internal electrodes to the combined volume of said ceramic element is 0.10 to 0.30.

(Mot. Ex. 2 at col. 6, ll. 14-37 (emphasis added).)

Samsung’s Interrogatory No. 120 relates to subsection (c)(2) of claim 3. (Mot. Ex. 7.)

Interrogatory No. 120 states:

Identify *each and every* multi-layer capacitor manufactured by Murata prior to 1998 having more than 150 internal electrodes.

(*Id.* (emphasis added).) Murata’s response to Interrogatory No. 120 states:

Murata objects to this interrogatory on the ground that it seeks information that is neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. *Murata objects in particular to the extent this*

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interrogatory seeks identification of 'each and every' responsive product without regard to any criteria that are rationally related to any asserted claim of a patent-in-suit. Murata also objects to this interrogatory on the ground that it is unduly burdensome, and oppressive and is not reasonably calculated to lead to admissible evidence. Murata further objects to this interrogatory to the extent it requests information that is no longer within Murata's possession, custody or control.

(Mot. Ex. 8 (emphasis added).)

The Administrative Law Judge finds that Murata has met its burden to demonstrate that the information Samsung requests in Interrogatory No. 120 either is duplicative of information Samsung previously requested and has been privy to discovery of or is beyond the scope of discovery. Murata states in its opposition that it searched for and produced documents related to every pre-1998 Murata product having (1) 200 or more internal electrodes and (2) 180-200 internal electrodes in response to Samsung's Interrogatory Nos. 28 and 95. (Opp. at 1, 4-5 (citing Opp. Exs. 1 and 3).) In addition, in response to said interrogatories, Murata identified four pre-1998 products having 200 or more internal electrodes and zero pre-1998 products having 180-200 internal electrodes. (*See id.* at 4-5 (citing Opp. Exs. 2 and 4).) Thus, the Administrative Law Judge finds that Murata has provided substantive responses to Samsung's Interrogatory No. 120 to the extent that said interrogatory covers products having 180 or more internal electrodes.

The Administrative Law Judge finds that Samsung's arguments regarding its need for additional information related to Murata's pre-1998 products, *i.e.*, products having 150-180 internal electrodes, are unpersuasive. Samsung itself states that "a prior art Murata capacitor with 150 internal electrodes *would not anticipate* Claim 3 of the '309 patent." (Mot. Mem. at 11 (emphasis added).) While Samsung argues that such a capacitor would be relevant to an

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obviousness analysis if it met any of the other limitations of claim 3, (*id.* at 3, 5, 11), the Administrative Law Judge finds that Samsung failed to tailor Interrogatory No. 120 to include only products that meet any of those other limitations. (*See* Opp. at 13, 16-17 and Mot. Ex. 7 (requesting identification of “each and every” capacitor).) The Administrative Law Judge further finds that Samsung fails to explain how a capacitor having 150 internal electrodes might otherwise be relevant to (1) an obviousness analysis, *e.g.*, whether a person of ordinary skill in the art would view such a product as potential evidence of the obviousness of claim 3, or (2) inequitable conduct.

The Administrative Law Judge also finds that the evidence Samsung presents to show that additional information exists that is responsive to Interrogatory No. 120 is insufficient to outweigh the burden to Murata of reviewing the pre-1998 documents for a third time. Specifically, regarding the Murata products that Samsung has identified as evidence that additional information may exist – *i.e.*, the GRM 42-6 B105K10 and the GRM/40B/X5R105K10 – the Administrative Law Judge finds that Samsung has already had full discovery of the GRM 42-6 B105K10 and does not provide sufficient support for the assertion that Murata mass produced the GRM/40B/X5R105K10. (*See* Opp. at 11; *see also id.* at 16.) Finally, the Administrative Law Judge finds that there is no indication that, if the Administrative Law Judge compelled Murata to review its pre-1998 documents for a third time with respect to capacitors having 150-180 internal electrodes and Murata identified zero products, Samsung would not submit an additional interrogatory requesting information and documents regarding capacitors having 120-150 internal electrodes, and so forth.

Thus, the Administrative Law Judge finds that Murata has complied with its duty to search for and produce information, documents, and things related to the limitation of subsection (c)(2)

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of asserted claim 3 of the '309 patent that ceramic capacitors have 200 or more internal electrodes.

For the reasons discussed above, Samsung's motion to compel Murata to produce additional information, documents, and things in response to Samsung's Interrogatory No. 120 is hereby **DENIED**.

Within seven days of the date of this document, each party shall submit to the office of the Administrative Law Judge a statement as to whether or not it seeks to have any portion of this document deleted from the public version. The parties' submissions must be made by hard copy by the aforementioned date.

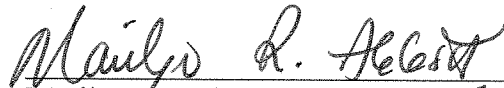
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SO ORDERED.


E. James Gildea
Administrative Law Judge

PUBLIC CERTIFICATE OF SERVICE

I, Marilyn R. Abbott, hereby certify that the attached **ORDER** has been served by hand upon, the Commission Investigative Attorney, **Aarti Shah, Esq.**, and the following parties as indicated on June 7, 2010.


Marilyn R. Abbott, Secretary *JNB*
U.S. International Trade Commission
500 E Street, SW, Room 112A
Washington, D.C. 20436

FOR COMPLAINANTS MURATA MANUFACTURING CO., LTD., MURATA ELECTRONICS NORTH AMERICA, INC.

Steven J. Routh, Esq.
**ORRICK, HERRINGTON &
SUTCLIFFE, LLP**
1152 15th Street, NW
Washington, DC 20005
P: 202-339-8400

() Via Hand Delivery
() Via Overnight Mail
() Via First Class Mail
() Other: _____

FOR RESPONDENT SAMSUNG ELECTRO-MECHANICS CO., LTD.;; SAMSUNG ELECTRO-MECHANICS AMERICA, INC.

V. James Adduci II, Esq.
**ADDUCI, MASTRIANI &
SCHAUMBERG, LLP**
1200 Seventeenth Street, NW 5th Floor
Washington, DC 20036
P: 202-467-6300

() Via Hand Delivery
() Via Overnight Mail
() Via First Class Mail
() Other: _____

**IN THE MATTER OF CERTAIN CERAMIC
CAPACITORS AND PRODUCTS CONTAINING
SAME**

337-TA-692

PUBLIC MAILING LIST

Heather Hall
LEXIS - NEXIS
9443 Springboro Pike
Miamisburg, OH 45342

Via Hand Delivery
 Via Overnight Mail
 Via First Class Mail
 Other: _____

Kenneth Clair
THOMSON WEST
1100 13th Street, NW, Suite 200
Washington, D.C. 20005

Via Hand Delivery
 Via Overnight Mail
 Via First Class Mail
 Other: _____