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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. 40 GRANTING IN PART RESPONDENTS' MOTION TO COMPEL  
DEPOSITIONS**

(July 2, 2010)

On May 26, 2010, Respondents Samsung Electro-Mechanics Co., Ltd. and Samsung Electro-Mechanics America, Inc. (collectively, "Samsung") filed a motion to compel Complainants Murata Manufacturing Co., Ltd. and Murata Electronics North America, Inc. (collectively, "Murata") to make five individual witnesses available for deposition. (Motion Docket No. 692-029.) Samsung further seeks to compel Murata to provide a corporate witness to testify on topics relevant to the Investigation, which were provided in Samsung's second notice of deposition on Murata. (Mot. at 1; Mot. Ex. 1.) In addition, Samsung requests a shortened response time, which is hereby DENIED as moot.

Specifically, Samsung believes that Murata should be required to produce Andreas Glaeser, Yuki Nakamura, Yasunori Sakai, Masahiro Yamaguchi, and Toshiya Kumada for deposition because they allegedly possess information relevant to a claim or defense in this Investigation. (Mot. Mem. at 1.) According to Samsung, it requested depositions for these individuals but Murata refused. (*Id.* at 3.) With respect to the corporate deposition of Murata, Samsung asserts that it has been denied adequate testimony with respect to topic nos. 1-19, 40,

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42-43 of its second deposition notice, dated May 16, 2010, which relate to Murata's sales/offers, expectations of confidentiality, license agreements, and other "narrow issues." (*Id.* at 5-8; Mot. Ex. 1.)

On June 7, 2010, Murata opposed Samsung's motion. Murata argues that near the close of discovery, Samsung requested eleven individual witness depositions and a second round of corporate depositions on 44 topics. (Opp. at 1.) According to Murata, it sought to accommodate Samsung, but objected to the depositions or topics that it deemed were duplicative or irrelevant. (*Id.* at 1-2; Opp., Ex. 5.) Murata also reports that Dr. Glaeser, who is not a testifying expert, is out of the country on sabbatical for four months. (Opp. at 2.) Furthermore, Murata argues that Samsung does not have good cause to require a second corporate deposition of Murata, particularly when Samsung would have needed to seek leave for a second corporate deposition if the case were in federal district court. (*Id.* at 7.) Murata argues that the second set of topics is duplicative of those in the first corporate deposition notice on Murata, as well as overbroad or irrelevant. (*Id.* at 11.)

No other responses were received.

### **Individual Depositions.**

#### 1. Andreas Glaeser.

The record shows that Dr. Glaeser submitted a declaration in support of Murata's opposition to one of Samsung's summary determination motions. (Mot. Mem. at 12; Opp. at 2.) Samsung argues that it is entitled to explore Dr. Glaeser's opinions, as he made substantive opinions as to the meaning and scope of an asserted patent. (Mot. Mem. at 12.) Murata counters that Dr. Glaeser did not submit an expert report, will not be testifying at the hearing, and

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furthermore left the country on May 21.

The Administrative Law Judge finds on fairness grounds that Murata cannot use a witness as a sword to support its position on summary determination and then shield that witness from further discovery that may be unfavorable to it. Notably, Samsung sought Dr. Glaeser's deposition on May 19, prior to his scheduled departure. (Mot. Ex. 5.) The Administrative Law Judge finds that Samsung's motion with respect to Dr. Glaeser should be GRANTED with the proviso that Samsung should do its utmost to conduct the deposition without unduly inconveniencing the witness. The parties should meet and confer no later than July 7, 2010 to determine the best format for the deposition, such as a videoconferenced deposition, deposition on written questions, or a deposition taking place in Italy at a location least likely to disrupt Dr. Glaeser's sabbatical. Said deposition should take place no later than July 12, or at such time as the parties may agree. It should be further noted, that this deposition or its outcome will not be permitted to disrupt or delay the hearing.

2. Yuki Nakamura.

Samsung argues that Mr. Nakamura is "likely" to be familiar with Murata's practices regarding { }  
(Mot. Mem. at 13.) Murata responds that Mr. Nakamura has "little, if any," relevant knowledge, particularly in the time frame at issue. (Opp. at 24.)

The Administrative Law Judge finds that Samsung's motion with respect to Mr. Nakamura should be DENIED. Samsung does not provide a sufficient showing that Mr. Nakamura has relevant evidence. *See* Commission Rule 210.27(b). Indeed, the transcript to which Samsung cites in support of its motion, Mot. Ex. 11, suggests that Samsung is on a fishing

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expedition.

3. Yasunori Sakai.

Samsung argues that Mr. Sakai has personal knowledge relating to Murata's practices regarding { } and further, that his deposition is particularly important because "Murata's corporate designees were unable to testify" on this topic "for specific prior art products." (Mot. Mem. at 14.) Based on the context of Murata's arguments and the particular citation to Samsung's motion, Murata appears to be referring to *Mr. Sakai* in arguing that *Mr. Yamaguchi* has "little, if any," relevant knowledge, particularly in the time frame at issue. (Opp. at 24.)

The Administrative Law Judge finds that Samsung's motion with respect to Mr. Sakai should be DENIED, as the Administrative Law Judge is unpersuaded that Mr. Sakai has relevant information regarding "Murata's practices regarding sales and offers for sale of its capacitors." (See Mot. Mem. 14; Mot., Exs. 10, 19, 20.)

4. Masahiro Yamaguchi.

According to Samsung, Mr. Yamaguchi engaged in {

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(Opp. at 24.) Murata further submits that evidence of infringement and copying is only relevant if it is done by Respondents. (*Id.*)

The Administrative Law Judge finds that Respondents' rationale for Mr. Yamaguchi's

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testimony is attenuated at best, and is not persuaded that this witness would provide discovery within the scope of Commission Rule 210.27(b). Accordingly, Respondents' motion with respect to Mr. Yamaguchi is DENIED.

### 5. Toshiya Kumada.

Samsung offers little to explain why Mr. Kumada's testimony should be compelled. (Mot. Mem. at 15.) According to Samsung, this witness made one statement in an email to allegedly suggest that Murata does not have a domestic industry. (*Id.*) Samsung also notes that Mr. Kumada made one statement about Murata's competitor, Samsung. (*Id.*) Thus, Samsung argues that it is "entitled" to question Mr. Kumada. (*Id.*) Murata counters that Samsung has attempted to extrapolate too much from one sentence. (Opp. at 25.)

The Administrative Law Judge finds that Samsung's motion with respect to Mr. Kumada should be DENIED. Samsung has not demonstrated, based on this single e-mail statement, that Mr. Kumada will have much, if any, pertinent information relating to whether Murata practices a domestic industry with respect to the '229 patent.

### **Corporate Depositions.**

#### 1. Topics 1-6, 19, 40.

Samsung argues that Murata's corporate witness, Mr. Tahara, was unprepared to discuss topic nos. 1-6 and that Murata did not designate a witness for topics 19 and 40. (Mot. Mem. at 6-7.)

Murata responds that Samsung is attempting to circumvent Order No. 27 by seeking testimony through topic 19 in lieu of a written response to Interrogatory No. 120. Furthermore, Murata argues that topics 1-6 are duplicative of topic 19, and that Samsung spent hours

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questioning Mr. Tahara on the subject matter at issue during the five days of Mr. Tahara's deposition. (Opp. at 12.) Murata further argues that Mr. Tahara could not provide from memory the level of detail Samsung was requesting, and notes that Murata's counsel offered to provide such detailed information in writing but did not get a response from Samsung. (*Id.* at 13; Mot. Ex. 7.) Murata further argues that Mr. Kubota testified with respect to topic 40 and that this portion of Samsung's motion is moot.

The Administrative Law Judge finds that Samsung's motion with respect to these topics should be DENIED. The Administrative Law Judge finds that topic 19 is not relevant to the Investigation. *See* Order No. 27. In addition, even though second depositions are generally disfavored absent a showing of good cause, Murata sought to provide Samsung with much of the requested discovery. A review of Mr. Tahara's deposition transcript shows that Mr. Tahara was questioned extensively on the topics at issue, and was, for the most part, able to respond substantively regardless of whether he was originally designated for those topics. (*See* Opp. Exs. 9, 10.) It is not clear whether Murata's offer to provide a written response to supplement the material Mr. Tahara was unable to memorize still stands at this late juncture, and while such a written response is encouraged, it is not compelled.

2. Topic 7.

Samsung argues that topic 7 is relevant to its public use defense, and that Murata's witness, Mr. Tahara, was unable to provide testimony relating to specific nondisclosure agreements. (Mot. Mem. at 7.) Murata argues that Mr. Tahara was prepared on this topic, and provided responsive answers. (Opp. at 13.)

The Administrative Law Judge finds that Samsung's motion with respect to topic 7

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should be DENIED. Topic no. 7 does not require testimony relating to specific nondisclosure or confidentiality agreements, but instead seeks “Murata’s expectations of confidentiality.” (Mot. Ex. 1, at 9.) Murata has demonstrated that Mr. Tahara has made “Murata’s expectations of confidentiality” clear.

3. Topic 15.

Samsung argues that Murata has refused to provide a corporate witness to testify with respect to “all license agreements encompassing any MLCC technology under which Murata is a licensee, a licensor, or both, and any and all royalties paid by Murata with respect to each license agreement.” (Mot. Mem. at 8.) Murata argues that topic 15 is duplicative of topics 36-38 from Samsung’s first deposition notice on Murata, and that it has never licensed the asserted patents. (Opp. at 14.) In addition, Murata argues that it has only entered into two licenses, one of which is so old Murata no longer possesses a copy. (*Id.* at 14-15.) According to Murata, the second license, { } was produced to Samsung, is not relevant to the Investigation, although Murata offered to provide royalty information in writing. (*Id.* at 15; Mot. Ex. 7.)

The Administrative Law Judge finds that Samsung’s motion with respect to topic 15 should be DENIED. However, the Administrative Law Judge does not agree with Murata that topic 15 is duplicative of topics 36-38 from the first deposition notice. (Opp. Ex. 8, at 12.) Those topics were limited to the asserted patents, as well as related patents. (*Id.*) Topic 15 is broader, and Samsung argues that it did not seek to compel topics 36-38 earlier because of Murata’s objections to their scope. (Mot. Mem. at 8; Mot. Ex. 11.) Here, the Administrative Law Judge is not persuaded that the two license agreements at issue are of sufficient relevance to require a deposition on the eve of the hearing. However, Murata is ordered to provide Samsung

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with the royalty information in writing, as offered in Motion Exhibit 7. Murata should produce this written information to Samsung no later than July 12, 2010. As noted above with Dr. Glaeser, this written answer and any resulting reaction by Samsung will not be permitted to disrupt or delay the hearing.

4. Topic nos. 8-14, 16-18, 42, and 43.

With respect to topic 8, Samsung argues that Mr. Sano, Murata's corporate designee, was unprepared. (Mot. Mem. at 9.) Samsung notes that Murata provided Mr. Sano for an additional day of testimony, "but that day was used primarily to explore the content of the declaration Mr. Sano offered in support of Murata's opposition to [Samsung's] motion for summary determination. . . ." (*Id.* at n.25.) Murata argues that Samsung had ample opportunity to question Mr. Sano on topic 8—indeed was given an extra day to do so—but chose to spend the time on other issues. Thus, Murata argues, it should not be penalized for Samsung's tactical decision on how to use the deposition time. The Administrative Law Judge agrees. Samsung's motion with respect to topic 8 is DENIED.

With respect to topics 9-14, Samsung says little more than that these topics seek information with respect to the scope, validity, and valuation of Murata's patents. (Mot. Mem. at 9; *id.* at n. 26.) Murata argues, *inter alia*, that Samsung has not explained how these topics are not duplicative of Samsung's first deposition notice on Murata, or provided more than conclusory assertions as to their relevance. (Opp. at 16.)

The Administrative Law Judge finds that Samsung's motion with respect to topics 9-14 should be DENIED. Samsung does not adequately explain the relevance of topics 9-12. Murata's competitors (other than Samsung) have not been accused of infringement in this



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Investigation. Topic 13 is duplicative of at least topics 25-28 of Samsung's first deposition notice on Murata, and furthermore is inappropriately crafted to assume that inequitable conduct has occurred. Indeed, for Murata to assign a corporate designee for this topic would create an implied admission that Murata did fail to disclose, or engage in efforts to withhold, material prior art during prosecution of the asserted patents. Topic 14 is duplicative of topic 34 of Samsung's first deposition notice on Murata. Samsung further fails to adequately explain why it did not move to compel with respect to topic 34 of Samsung's first deposition notice, or even how Murata's response to that topic was in some way deficient.

Regarding topics 16-18 and 43, Samsung argues that it sought further corporate testimony after receiving Murata's documents relating to its pre-suit investigation. (Mot. Mem. at 10.) Murata argues that these topics are duplicative of topics 11 and 15 from Samsung's first deposition notice on Murata, and further notes that Samsung explored these issues in full during Dr. Burn's deposition.

The Administrative Law Judge DENIES Samsung's motion with respect to topics 16-18 and 42. Samsung had an opportunity to depose Murata on its pre-suit investigation. To the extent that Samsung moved to compel additional discovery relating to materials withheld based on privilege, that motion was limited to written discovery responses. *See* Order No. 16. Samsung did not request further corporate testimony at that time, and further, does not explain how Dr. Burn's deposition provided inadequate supplementation.

With respect to topic 42, Samsung argues that Mr. Wilder, Murata's corporate designee, was unable to testify "comprehensively" on this topic, although Samsung attaches no evidence to support this assertion. (Mot. Mem. at 11.) Murata argues that the topic, "[a]ny other fact,

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allegation, or circumstance which Murata intends to rely upon to meet the economic prong of the domestic industry requirement and any facts or circumstances contradicting the same,” is “exceedingly broad” and not appropriate for a corporate deposition. (Opp. at 18.) The Administrative Law Judge agrees. It is further noted that several other corporate designees have provided testimony with respect to domestic industry. (Opp. at 19.) Samsung’s motion with respect to topic 42 is DENIED.

For these reasons, Samsung’s motion to compel (Motion Docket No. 692-029) is GRANTED IN PART, as noted above.

Within seven days of the date of this document, each party shall submit to the Office of the Administrative Law Judges a statement as to whether or not it seeks to have any portion of this document deleted from the public version. The parties’ submissions may be made by facsimile and/or hard copy by the aforementioned date.

Any party seeking to have any portion of this document deleted from the public version thereof must submit to this office a copy of this document with red brackets indicating any portion asserted to contain confidential business information. The parties’ submissions concerning the public version of this document need not be filed with the Commission Secretary.

**SO ORDERED.**


*E. James Gildea, by permission*  
E. James Gildea  
Administrative Law Judge *S. Z.*

**IN THE MATTER OF CERTAIN CERAMIC  
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SAME**

337-TA-692

**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 July 22, 2010.

  
Marilyn R. Abbott, Secretary *JRA*  
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**337-TA-692**

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