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Paper 9
Date: December 11, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BROADCOM CORPORATION
Petitioner

v.

TELEFONAKTIEBOLAGET LM ERICSSON (PUBL)
Patent Owner

Cases IPR2013-00601(Patent 6,772,215 B1)
IPR2013-00602 (Patent 6,446,568 B1)
IPR2013-00636 (6,424,625 B1)[1]

Before KARL D. EASTHOM, KALYAN K. DESHPANDE, and MATTHEW R. CLEMENTS, *Administrative Patent Judges.*

EASHTOM, *Administrative Patent Judge.*

ORDER
Authorizing Motion for Additional Discovery
37 C.F.R. § 42.1(b)(2)

[1] The Board exercises its discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading.

On December 6, 2013, the following individuals participated in a conference call:

(1) Dominic E. Massa and Michael A. Diener, counsel for Petitioner;

(2) Peter J. Ayers and J. Christopher Lynch, counsel for Patent Owner; and

(3) Karl D. Easthom, Kalyan K. Deshpande, and Matthew R. Clements, Administrative Patent Judges.

The conference discussion involved Patent Owner's request for, and Petitioner's opposition to, Patent Owner's request to file a motion for additional discovery. Specifically, Patent Owner requests discovery regarding certain alleged agreements between Petitioner and defendants in related litigation, *Ericsson Inc., et al. v. D-LINK Corp., et al.*, Civil Action No. 6:10-CV-473 (LED/KGF) ("Texas Litigation"), where the challenged patents in the instant proceedings were found infringed. Petitioner was not a party to the Texas Litigation. *See* Pet. 1-2.[2]

According to Patent Owner, the requested information is relevant because one or more of the co-defendants in the related Texas Litigation were served with a complaint more than one year prior to the date the instant proceedings were filed, and if those defendants are real parties in interest or privies of Petitioner, an *inter partes* review may not be instituted under 35 U.S.C. § 315(b). Patent Owner argued that it has a basis for seeking discovery because the alleged agreements between Petitioner and defendants in the Texas Litigation are indicative of one or more of the defendants being a real party in interest or privy.

Petitioner argued that Patent Owner's request is outside the proper scope of discovery and may raise privilege and confidentiality issues, even if Petitioner had any agreements with the defendants, Petitioner's customers, in the Texas

[2] Reference is to the Petition in IPR2013-00601, which makes similar assertions to the Petitions in the other two cases.

Litigation. Petitioner also represented that it is the sole real party in interest for the instant proceedings, and none of the defendants in the Texas Litigation has a relevant privy relationship with Petitioner.

During the conference, the parties discussed the following cases that have relevance to the dispute here: *Garmin International, Inc. et al. v. Cuozzo Speed Technologies LLC*, IPR2012-00001 ("Decision on Motion for Additional Discovery") (Paper 26) (important factors in determining whether a discovery request meets the applicable standard); *Apple v. Achates Reference Publishing, Inc.*, IPR2013-00080 ("Decision – Achates Motion for Additional Discovery") (Paper 17) (indemnity agreements).

After hearing from both parties, the panel informed them that briefing on the matter is warranted: Patent Owner was authorized to file an eight page motion for additional discovery, and Petitioner was authorized to file an eight page opposition. Patent Owner's motion must explain specifically what discovery is being requested and why such discovery is "necessary in the interest of justice." *See* 35 U.S.C. § 316(a)(5); 37 C.F.R. § 42.51(b)(2).

In particular, Patent Owner's motion should address what evidence shows that Petitioner and defendants in the Texas Litigation made discoverable agreements that are relevant to determining whether any of those defendants are real parties in interest or privies of Petitioner.

In consideration of the foregoing, it is hereby

ORDERED that Patent Owner's authorized motion for additional discovery under 37 C.F.R. § 42.51(b)(2) is due by December 11, 2013 and is limited to eight pages; Petitioner's authorized opposition is due by December 20, 2013 and is also limited to eight pages; and no reply is authorized; and

FURTHER ORDERED that in its motion, Patent Owner identify the discovery being requested and why the discovery is necessary in the interest of justice, specifically addressing Petitioner's alleged agreements, evidence of their existence, and why the sought-after discovery will establish the required privy or real party relationship.

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