

Paper No.____

EXHIBIT 2016

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TYLER DIVISION**

ERICSSON INC., et al.,

Plaintiffs,

vs.

D-LINK CORPORATION, et al.,

Defendants.

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CASE NO. 6:10-CV-473

ORDER

Before the Court are Plaintiff Ericsson Inc.’s Emergency Motion for Relief from the Protective Order (Docket No. 662) and Ericsson’s Emergency Motion for Expedited Briefing (Docket No. 664). For the following motions, the motions are **DENIED**.

BACKGROUND

On August 8, 2013, the Court entered final judgment against Defendants Toshiba Corporation and Toshiba America Information Systems, Inc., (collectively, “Toshiba”) and Dell, Inc. (“Dell”) in favor of Plaintiffs Ericsson Inc. and Telefonakiebolaget LM Ericsson (collectively, “Ericsson”). During the course of the litigation, Ericsson discovered (1) an indemnity agreement between Toshiba and non-party Broadcom Corporation (“Broadcom”), (2) an indemnity agreement between Dell and Broadcom, and (3) an email between Dell and Broadcom discussing indemnification (collectively “Indemnity Documents”). Dell and Toshiba disclosed the Indemnity Documents pursuant to the Court’s Protective Order, originally issued on October 18, 2011. Docket No. 148.

In the Motion for Relief from the Protective Order, Ericsson requests to disclose the Indemnity Documents in an inter partes review proceeding (“IPR”) at the Patent Trial and Appeal Board (“PTAB”), which was initiated by Broadcom on September 20, 2013. According to Ericsson, the Indemnity Documents show Broadcom is in privity with Dell and Toshiba, or at least show additional discovery is warranted on the issue. Docket No. 662 at 1. If Broadcom is in privity with Dell or Toshiba, Broadcom would be ineligible to petition for an IPR pursuant to the one-year bar of 35 U.S.C. § 315(b) (“An inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.”). In opposition, Dell and Toshiba argue the potential benefit to Ericsson for modifying the Protective Order will be outweighed by the potential harm they will suffer. Specifically, Dell and Toshiba argue indemnification agreements do not show privity under the PTAB’s recent rulings, and that as non-parties to the IPR, they will no longer in control of their confidential materials. Docket Nos. 668 at 5, 669 at 2–3.

In the Motion for Expedited Briefing, Ericsson requests the Court to order Toshiba and Dell to file redacted, non-confidential versions of their briefs in response to the Motion for Relief from the Protective Order. Docket No. 664 at 2. Ericsson intends to use these briefs to “update the PTAB on the status” of Ericsson’s Motion for Relief from the Protective Order and to show the PTAB the Defendants’ “stated basis for opposing the motion.” *Id.* Dell has agreed to this request and Toshiba opposes. Docket Nos. 666, 667.

ANALYSIS

Motion for Relief from Protective Order

Compared to district courts, the PTAB has an intentionally narrower scope of discovery. *See* 35 U.S.C. § 316(a)(5)(B) (limiting discovery to what is “necessary for the interest of justice”). Additionally, the PTAB has a corresponding narrower protection for the confidentiality of discoverable materials. *See* “Office Patent Trial Practice Guide,” 77 Fed. Reg. 48761 (“Confidential information that is subject to a protective order ordinarily would become public 45 days after denial of a petition to institute a trial or 45 days after final judgment in a trial.”). Granting Ericsson’s request for relief from the Protective Order would allow Ericsson to circumvent this balance between IPR discovery and confidentiality. In essence, Ericsson would be able to use the Court’s broader Rule 26 “relevancy” standard for discovery, yet subject Dell and Toshiba to the PTAB’s narrower protections of confidentiality. *Id.* Relatedly, Ericsson only is aware of the Indemnity Documents as a matter of coincidence because of its former litigation and the broad scope of discovery pursuant to Rule 26.

Moreover, granting Ericsson relief from the Protective Order in this case would undermine the negotiations which produced the Protective Order. Ericsson, as the plaintiff in the district court litigation and the patent owner in any potential IPR, was in the best position to negotiate whether it may disclose documents discovered during litigation in an IPR.¹ Accordingly, Ericsson’s Emergency Motion for Relief from the Protective Order is **DENIED**.

¹ For example, the parties considered proceedings at the PTAB when they negotiated the protective order, and agreed that anyone who viewed confidential information “may not participate, directly or indirectly, in the drafting preparation, or amending of any patent claim [and] may not reveal the content of [confidential] materials to reexamination counsel or agents.” Docket No. 148 at 10–11. Ericsson has failed to show why this protection should not apply to the IPR.

Motion for Expedited Briefing

Ericsson requests an expedited briefing schedule and for Dell and Toshiba to provide redacted, non-confidential briefs in response to Ericsson's Motion for Relief from Protective Order. The Court has ordered an expedited briefing schedule. Docket No. 665. Accordingly, Ericsson's requests concerning the briefing schedule are **DENIED AS MOOT**. Additionally, Dell has agreed to provide a redacted response brief. Docket No. 667. Furthermore, the Court has denied Ericsson's underlying request for relief from the Protective Order. Consequently, there is little, if any, benefit in ordering Toshiba to supply a redacted response brief. Accordingly, Ericsson's request to require Toshiba to file a redacted brief is **DENIED**.

So ORDERED and SIGNED this 20th day of December, 2013.

A handwritten signature in black ink, appearing to read 'Leonard Davis', written over a horizontal line.

**LEONARD DAVIS
UNITED STATES DISTRICT JUDGE**