

Filed on behalf of: Wi-Fi One, LLC

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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BROADCOM CORPORATION,

Petitioner,

V.

WI-FI ONE, LLC,

Patent Owner.

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CASE NO.: IPR2013-00602

PATENT NO. 6,446,568 B1

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**PATENT OWNER'S REQUEST FOR REHEARING OF  
FINAL WRITTEN DECISION (PAPER NO. 60)**

Pursuant to 37 CFR § 42.71(d)(2), Patent Owner submits this Request for Rehearing of the Board's Final Written Decision (Paper No. 60).

## I. INTRODUCTION

In its Final Written Decision, the Board made certain fundamental errors with respect to its determination that this IPR Petition is not time-barred under 35 U.S.C. § 315(b). This case is a prime example of concerns expressed less than two weeks ago by USPTO Director Michelle Lee, who noted that Patent Owners frequently are not given sufficient discovery on the “real party in interest” issue, meaning that panels often decide this issue on an inadequate evidentiary record.<sup>1</sup> In light of Director Lee's comments, the Board should take a close look at this request for rehearing.

**First**, in this case the Board misapprehended the purpose and effect of the “real party in interest, or privy” language in § 315(b), as plainly set forth in the text of the statute, and as confirmed by the legislative history and the USPTO's public

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<sup>1</sup> See [http://www.uspto.gov/blog/director/entry/ptab\\_s\\_quick\\_fixes\\_for](http://www.uspto.gov/blog/director/entry/ptab_s_quick_fixes_for), USPTO Director Michelle K. Lee, “PTAB's Quick-Fixes for AIA Rules are to be Implemented Immediately,” (March 27, 2015) (last visited April 6, 2015) (“[W]e understand that the existence of ample discovery to establish the real-party-in-interest (RPI) of the petitioner has been a concern. And we want to be sure that the availability of appropriate RPI evidence does not pose a problem for patent owners.”)

comments. As a result, the Board applied the wrong legal standard for assessing the § 315(b) issue, focusing too narrowly (and exclusively) on whether Petitioner has controlled the co-pending District Court Litigation, and ignoring other relevant facts, such as whether the District Court Defendants are controlling this IPR.<sup>2</sup>

**Second**, the Board overlooked the substantial evidence Patent Owner has presented showing that Broadcom and the District Court Defendants share a common economic and legal interest, and have been in cahoots in opposing the '568 Patent for many years. This evidence shows **both** that (1) Broadcom's District Court Defendant customers are real-parties in interest to this IPR proceeding, **and also** that (2) the District Court Defendant customers are in privity with Broadcom for purposes of this IPR and the District Court Litigation.

The Board's refusal to permit any discovery at all on this issue – even the introduction of Broadcom's known indemnity agreements – is a clear abdication of the Board's duty to consider a full and reasonable evidentiary record on matters related to its own jurisdiction, and inherently renders the Board's decision suspect.

**Third**, the Final Written Decision itself presents additional administrative law issues that Patent Owner raises in this request for rehearing. Because the Petition was

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<sup>2</sup> The terms "District Court Litigation" and "District Court Defendants" refer to parallel infringement litigation and defendants as cited in the Board's Decision denying additional discovery. Paper No. 21 at 2.

and is time-barred under § 315(b), the Board's Final Written Decision is an *ultra vires* action that exceeds the Board's delegated statutory authority. Moreover, the Board's Final Written Decision is contrary to several provisions of the Administrative Procedures Act ("APA"), as discussed more fully below.

It is undisputed that the Board would have no authority, under § 315(b), to consider this IPR Petition if it had been filed by the District Court Defendants themselves. It would have been time-barred. Section 315(b) does not permit Broadcom to assist its customers in circumventing the one-year time-bar. That is precisely what the "real party in interest, or privy" language was intended to prevent.

## **II. IDENTIFICATION OF BASIS FOR REHEARING REQUEST**

As required by 37 C.F.R. § 42.71(d), Patent Owner hereby specifically identifies the matters Patent Owner contends the Board misapprehended or overlooked:

- (1) The Board misapprehended the purpose of the "real party in interest or privy" language in 35 U.S.C. § 315(b), and misapprehended the correct legal standard for determining whether a non-party is a "real party in interest or privy of petitioner" under § 315(b). *See, e.g.* Patent Owner's Request for Rehearing, Paper No. 25 at 3-7.
- (2) The Board misapprehended the entirety of the factual record and overlooked evidence supporting Patent Owner's contention that certain District Court Defendants are real parties in interest and/or privies of petitioner in this IPR. *See* Patent Owner's Response, Paper No. 36 at 3-15.

In addition, the Board's Final Written Decision itself raises certain administrative law issues that Patent Owner could not have previously raised. *See* Section III(D), *infra*.

### III. ARGUMENT

#### A. The Board misapprehended the purpose of the “real party in interest, or privy” language in § 315(b).

##### 1. The purpose of § 315(b), in general, is to prevent district court litigants from using IPR petitions as a delay tactic.

By its plain language, and as confirmed by the legislative history, § 315(b) was intended to impose a time-bar on the filing of IPR Petitions so that district court litigants could not use IPR Practice for purposes of delaying the district court litigation. The statute states:

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. . . .

§ 315(b). The legislative purpose of this statute is to ensure IPR Petitions are *not used as a litigation tactic for purposes of delay*. *See, e.g.*, 157 Cong. Rec. S1326 (daily ed. March 7, 2011) (statement of Sen. Reid) (“The bill . . . imposes time limits on starting an inter partes or post-grant review when litigation is pending. . . . [T]hese reforms will help ensure that post-grant review operates fairly and *is not used for purposes of harassment or delay*.” (emphasis added)); H. Judiciary Comm. Rep., H.

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