

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BROADCOM CORPORATION

Petitioner

v.

TELEFONAKTIEBOLAGET L.M. ERICSSON

Patent Owner

Case IPR2013-00602
U.S. Patent No. 6,466,568

**PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION FOR
ADDITIONAL DISCOVERY UNDER 37 C.F.R. § 42.51(b)**

Ericsson’s (“Ericsson”) Motion for Additional Discovery from Broadcom Corporation (“Broadcom”) (the “Motion”) should be denied because Broadcom is not in privity with the Texas Defendants¹ and because Ericsson has not demonstrated that its requested additional discovery is “necessary in the interest of justice.” 35 U.S.C. § 316(a)(5); 37 C.F.R. § 42.51(b)(2)(i).

Discovery in *inter partes* review (“IPR”) is “less than what is normally available in district court patent litigation” because “Congress intended *inter partes* review to be a quick and cost effective alternative to litigation.” IPR2013-00080, Paper 18 at 3. The Board must therefore be “conservative in authorizing additional discovery.” *Id.* Additional discovery—like that requested in Ericsson’s Motion—should only be permitted where such discovery is “necessary in the interest of justice.” *Id.*, at 4. And the requested discovery must be more than a speculation or “mere possibility.” *Id.* There must be “factual evidence or support” underlying a request for additional discovery that demonstrate that “something useful [to the proceeding] will be found.” *Id.* Ericsson, despite all its colorful rhetoric about Broadcom’s “covert efforts” (Mot. at 2), and “attacks” on Ericsson and its patents (*id.* at 2), has failed entirely to satisfy this standard.

¹ The “Texas Defendants” are the defendants in *Ericsson Inc. v. D-Link Corp. et al.*, Civil Action No. 10-cv-473 (E.D. Tex.) (“Texas Litigation”), namely D-Link Corp., D-Link Systems, Inc., Netgear, Inc., Acer Inc., Acer America Corp., Gateway Inc., Dell, Inc., Toshiba Corp., Toshiba America, Inc., Toshiba America Information Systems, Inc., Toshiba America Consumer Products, LLC, and Belkin International, Inc. Broadcom is not a defendant.

Indeed, Ericsson’s Motion, which by Ericsson’s own admission is premised on “circumstantial evidence,” (Mot. at 8, n.6) is precisely the type of “fishing expedition” the Board cautioned against during the December 6, 2013 conference call allowing Ericsson’s Motion. In its Order Authorizing Motion for Additional Discovery, the Board required that Ericsson explain specifically why the discovery sought was “relevant to determining whether any of the [Texas Defendants] are real parties in interest or privies of Petitioner.” *Id.* at 3. Ericsson failed to make such a showing. And any effort to do so is futile, because Broadcom is not in privity with the Texas Defendants, and no amount of discovery in this proceeding or in the Texas Litigation will prove otherwise.

Ericsson also unreasonably delayed in raising this issue with Broadcom and the Board. Ericsson has been aware of the facts upon which its Motion is based since Broadcom filed its Petitions in September. But Ericsson waited until November 15, 2013 to first approach Broadcom regarding this issue. Ex. 2010. Ericsson then delayed further in approaching the Board, waiting until December 6, 2013 to seek permission to file this Motion. Ericsson’s behavior suggests that it is more interested in engaging in irrelevant discovery to delay the Board’s processes than the central issue for this IPR – the invalidity of Ericsson’s patents.

I. Ericsson’s Requested Discovery Is Futile

A. Broadcom Is Not in Privity with the Texas Defendants

Ericsson alleges that additional discovery is necessary to establish that Broadcom is in privity with one or more of the Texas Defendants and therefore barred under 35 U.S.C. § 315(b) from pursuing its IPR petitions. Motion at 3. Ericsson’s “evidence” of such purported privity consists of vague and speculative allegations regarding potential indemnity provisions in product purchase agreements between Broadcom and at least one Texas Defendant. Motion at 4. But the existence of indemnity provisions alone is not, as Ericsson asserts, sufficient to establish privity. *See* IPR2013-00175, Paper 20 (July 23, 2013) (“indemnification is not one of the “substantive legal relationships” cited in *Taylor* [] as binding a person not a party to a lawsuit to a judgment in that suit.”); *see also* IPR2013-00080, Paper 18 at 6 (“Indemnification is not one of the ‘substantive legal relationships’ cited in *Taylor* [] and is significantly different from those relationships, which involve successive property interest.”)²

Whether privity exists focuses on “how courts generally have used the terms to ‘describe relationships and considerations sufficient to justify applying conventional principles of estoppel and preclusion.’” IPR2013-000080, Paper 18 at 4. The Board must evaluate “whether a non-party may be recognized as a ‘real

² In *Taylor v. Sturgell*, 553 U.S. 880 (2008), the Supreme Court held that “non-party preclusion may be justified based on a variety of “substantive legal relationship[s]” between the person to be bound and a party to the judgment. Qualifying relationships include, but are not limited to, preceding and succeeding owners of property, bailee and bailor, and assignee and assignor.” *Id.* at 894.

party-in-interest’ or ‘privy’” and must do so “in a manner consistent with the flexible and equitable considerations established under federal caselaw.” Fed. Reg. at 48759-60 (relevant factors for privity include whether the non-party funded or directed the proceedings or “exercised or could have exercised control over a party’s participation in a proceeding.”) Ultimately, the Board must determine whether the relationship between two parties is “sufficiently close that both should be bound by the trial outcome and related estoppels.” 77 Fed. Reg. 48756, 48759.

[REDACTED]

Ericsson cannot offer evidence to the contrary. In addition to its assertions regarding Broadcom’s purported indemnity obligations, Ericsson identifies Exhibits 2005, 2007, 2009 and 2016 as “evidence” in support of its Motion. (Mot.

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