

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BROADCOM CORPORATION
Petitioner

v.

TELEFONAKTIEBOLAGET L. M. ERICSSON
Patent Owner

Case IPR2013-00601 (Patent 6,772,215)
Case IPR2013-00602 (Patent 6,466,568)
Case IPR2013-00636 (Patent 6,424,625) ¹

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

CLEMENTS, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ We exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

Case IPR2013-00601, -00602, -00636
Patent 6,772,215; 6,466,568; 6,424,625

An initial conference call in the above proceeding was held on April 1, 2014, between respective counsel for Petitioner and Patent Owner, and Judges Easthom, Deshpande, and Clements. The following subjects were discussed during the conference:

Related Matters

The parties are aware of no reexamination proceedings concerning the Subject Patents. Patent Owner has asserted the Subject Patents in litigation styled *Ericsson Inc., et al. v. D-LINK Corp., et al.*, Civil Action No. 6:10-cv-473 (E.D. Tex.). The verdict in that case is on appeal to the Federal Circuit in an appeal styled *Ericsson Inc., et al. v. D-LINK Corp., et al.*, Case Nos. 2013-1625, -1631, -1632, and -1633.

Scheduling Order

Neither party seeks changes to the Scheduling Order. Patent Owner indicated that it has filed Writs of Mandamus with the Federal Circuit regarding the Board's Order denying additional discovery, and that those may impact the schedule in the future.

To the extent that issues arise with DATES 1-3, the parties are reminded that, without obtaining prior authorization from the Board, they may stipulate to different dates for DATES 1-3, as provided in the Scheduling Order, by filing an appropriate notice with the Board. The parties may not stipulate to any other changes to the Scheduling Order.

Motions

Prior to the conference, Patent Owner filed a list of proposed motions. The parties indicated that there are currently no motions to be addressed.

Case IPR2013-00601, -00602, -00636
Patent 6,772,215; 6,466,568; 6,424,625

Patent Owner indicated that it may file a Motion to Amend. The Board takes this opportunity to remind Patent Owner that a motion to amend must explain in detail how any proposed substitute claim obviates the grounds of unpatentability authorized in this proceeding, and clearly identify where the corresponding written description support in the original disclosure can be found for each claim added. If the motion to amend includes a proposed substitution of claims beyond a one-for-one substitution, the motion must explain why more than a one-for-one substitution of claims is necessary. For further guidance regarding these requirements, Patent Owner is directed to several decisions concerning motions to amend, including *Nichia Corporation v. Emcore Corporation*, IPR2012-00005, Paper No. 27 (June 3, 2013); *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027, Paper No. 26 (June 11, 2013), Paper No. 66 (January 7, 2014); *ZTE Corp. v. ContentGuard Holdings*, IPR2013-00136, Paper 33 (November 7, 2013); and *InvenSense, Inc. v. STMicroelectronics, Inc.*, IPR2013-00241, Paper No. 21 (January 9, 2014); *Toyota Motor Corp. v. American Vehicular Sciences LLC*, IPR2013-00423, Paper No. 27 (March 7, 2014). Patent Owner has met the requirement to confer with the Board before filing a motion to amend. 37 C.F.R. § 42.121(a). However, to the extent that questions arise later, we encourage Patent Owner to contact the Board to arrange a call.

Patent Owner also indicated that it anticipates filing a motion to exclude evidence. The parties briefly explained the nature of the evidence

Case IPR2013-00601, -00602, -00636
Patent 6,772,215; 6,466,568; 6,424,625

that Patent Owner anticipates moving to exclude. Patent Owner served Petitioner with its objection. Petitioner intends to respond by the deadline.

The parties are reminded that, except as otherwise provided in the Rules, Board authorization is required before filing a motion. 37 C.F.R. § 42.20(b). A party seeking to file a motion should request a conference to obtain authorization to file the motion. No motions are authorized in this proceeding at this time, except as noted above.

Discovery

The parties are reminded of the discovery provisions of 37 C.F.R. § 42.51-52 and Office Patent Trial Practice Guide. *See id.* at 48,761-2. Discovery requests and objections are not to be filed with the Board without prior authorization. If the parties are unable to resolve discovery issues between them, the parties may request a conference with the Board. A motion to exclude, which does not require Board authorization, must be filed to preserve any objection. *See* 37 C.F.R. § 37.64, Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,767.

Protective Order

The Board's default protective order has been entered in this proceeding.

Settlement

The parties were not aware of any immediate prospect of settlement of this proceeding. In the event that the parties wish to terminate this proceeding pursuant to a settlement, they should request a conference with the Board.

Case IPR2013-00601, -00602, -00636
Patent 6,772,215; 6,466,568; 6,424,625

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