

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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IPR2013-00601 (Patent 6,772,215 B1)  
IPR2013-00602 (Patent 6,466,568 B1)  
IPR2013-00636 (Patent 6,424,625 B1)<sup>1</sup>

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

CLEMENTS, *Administrative Patent Judge*.

DECISION  
Request for Rehearing  
*37 C.F.R. § 42.71(d)*

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<sup>1</sup> 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.

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## I. SUMMARY

Patent Owner, Wi-Fi One, LLC,<sup>2</sup> requests rehearing of the Final Written Decisions (IPR2013-00601, Paper 66, “601 Dec.”; IPR2013-00602, Paper 60, “602 Dec.”; IPR2013-00636, Paper 60, “636 Dec.”). Paper 70 (“Req.”).<sup>3</sup> Patent Owner seeks rehearing on the grounds that:

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); and
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 proceeding.

Req. 2. Patent Owner also argues that our Final Written Decisions raise administrative law issues. *Id.* at 4, 13–15.

The Requests for Rehearing are *denied*.

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<sup>2</sup> On July 11, 2014, Patent Owner filed an Updated Mandatory Notice in IPR2013-00601 indicating that the patent-at-issue had been assigned to Wi-Fi One, LLC, and that Wi-Fi One, LLC and PanOptis Patent Management, LLC are now the real parties-in-interest. Paper 43. The same paper was filed in IPR2013-00602 (Paper 40) and IPR2013-00636 (Paper 38).

<sup>3</sup> Patent Owner filed a Request for Rehearing in each of IPR2013-00601 (Paper 70), IPR2013-00602 (Paper 64), and IPR2013-00636 (Paper 64). All three requests put forward substantively the same arguments and, thus, we address them together with reference to the Request in IPR2013-00601. Citations are to IPR2013-00601, unless otherwise noted.

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## II. DISCUSSION

The applicable standard for a request for rehearing is set forth in 37 C.F.R. § 42.71(d), which provides in relevant part:

A party dissatisfied with a decision may file a request for rehearing, without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, opposition, or a reply.

### A. 35 U.S.C. § 315(b)

Patent Owner argues that the Board misapprehended the purpose of the “real party in interest, or privy” language of § 315(b). Req. 4. Specifically, Patent Owner argues that “the legislative purpose of [35 U.S.C. § 315(b)] is to ensure IPR Petitions are not used as a litigation tactic for purposes of delay” (*id.* at 4), and that “[t]he plain text of the statute makes clear that . . . § 315(b) is intended to prevent litigation defendants from subverting the statutory time-bar by having their agents or cohorts file an IPR petition that they themselves are barred from filing” (*id.* at 5). Patent Owner also argues that the legal standard for determining whether a third party is a “real party in interest, or privy of petition” under § 315(b) “is purposefully broad and flexible so that the Board can determine, on a case-by-case basis and in light of all relevant facts, whether particular parties are attempting to circumvent the § 315(b) time-bar.” Req. 7.

Patent Owner has not argued in its Patent Owner Response the legislative purpose of § 315(b). We could not have misapprehended or overlooked arguments not before us. Moreover, Patent Owner identifies

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nothing in our Decision that it contends mischaracterizes the legislative purpose of § 315(b). We are not persuaded, therefore, that we have overlooked or misapprehended the legislative purpose of § 315(b).

Patent Owner also argues that we misapprehended the legal test that should be applied to determine whether a non-party is a “real party in interest, or privy” for purposes of § 315(b). Req. 6. Specifically, Patent Owner contends that “the Board applied a narrow and rigid standard that is erroneous as a matter of law” (*id.* at 7) because it “requires — as an absolute and necessary condition — that Broadcom controlled or could have exercised control over one or more of the District Court Defendants in relation to the District Court Litigation” (*id.*) without “also considering, *inter alia*, the non-party’s control over the IPR” (*id.* at 8). According to Patent Owner, “the issue under § 315(b) is whether the District Court Defendants have attempted to circumvent the one-year statutory time-bar.” Req. 9.

Although our Decision on Patent Owner’s Motion for Additional Discovery (Paper 23) focuses primarily on Broadcom’s (“Petitioner”) exercise of control, or opportunity to exercise control over the prior District Court lawsuit (Req. 8), that is because that was the focus of Patent Owner’s Motion for Additional Discovery. *See, e.g.*, Paper 14, 6 (“Here, evidence will prove that Broadcom has had the opportunity to control and maintains a substantive legal relationship with the D-Link Defendants sufficient to bind Broadcom to the District Court’s judgment.”).

That decision, however, did not characterize the legal standard, for all cases, as being limited strictly to a petitioner’s control, or opportunity to control, a non-party in previous litigation. To the contrary, it addressed

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control, or opportunity to control, by a non-party generally as one of a number of factors:

Whether parties are in privity, for instance, depends on whether the relationship between a party and its alleged privity is “sufficiently close such that both should be bound by the trial outcome and related estoppels.” [*Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,759 (Aug. 14, 2012)]. Depending on the circumstances, a number of factors may be relevant to the analysis, including whether the non-party “exercised or could have exercised control over a party’s participation in a proceeding,” and whether the non-party is responsible for funding and directing the proceeding. *Id.* at 48,759-60.

Paper 23, 7.

That decision also addresses Patent Owner’s theory that the indemnity agreements imply that the District Court Defendants are real parties in interest in these *inter partes* reviews (“IPRs”). *See id.* at 12–13. Patent Owner relied on substantively the same arguments and evidence in its Patent Owner Response as in its Motion for Additional Discovery, and our Final Written Decision, thus, applied essentially the same analysis. 601 Dec. 8–9. Accordingly, we are not persuaded that we misapprehended the proper legal standard for establishing privity or real party in interest.

#### *B. District Court Defendants*

Patent Owner argues that we misapprehended and overlooked evidence establishing that certain District Court defendants are real parties in interest and/or are in privity with Petitioner for purposes of this proceeding. Req. 10–13. Specifically, Patent Owner argues that it has made “a strong circumstantial showing that Petitioner and at least some of their District Court Defendant customers are in cahoots” because “there are indemnity

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