

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BROADCOM CORPORATION
Petitioner

v.

TELEFONAKTIEBOLAGET LM ERICSSON (PUBL)
Patent Owner

Cases IPR2013-00601(Patent 6,772,215 B1)
IPR2013-00602 (Patent 6,446,568 B1)
IPR2013-00636 (6,424,625 B1)¹

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

EASHTOM, *Administrative Patent Judge*.

DECISION
Ericsson's Motion for Additional Discovery
37 C.F.R. § 42.51(b)(2)

¹ The Board exercises its discretion to issue one Order to be filed in each case. The parties are not authorized to use this heading style.

Introduction

Patent Owner (“Ericsson”) filed a redacted motion for additional discovery in the instant proceedings (Paper 13, “Mot.” or “Motion”), and Petitioner (“Broadcom”) filed a redacted opposition (Paper 16 “Opp.” or “Opposition”).² In its Motion, Ericsson requests discovery regarding indemnity agreements, defense agreements, payments, and email, or other communications, between Broadcom and defendants (“D-Link Defendants”) in related litigation, *Ericsson Inc., et al. v. D-LINK Corp., et al.*, Civil Action No. 6:10-CV-473 (LED/KGF) (“Texas Litigation”). *See* Mot.; Ex. 2001 (“Patent Owner’s Requests for Production,” hereinafter “Request”).

In the Texas Litigation, a jury found Ericsson’s challenged patents in the instant proceedings infringed by the D-Link Defendants due partly to their use of Broadcom’s Wi-Fi compliant products. *See* Pet. 1–2. Broadcom was not a party to the Texas Litigation. *Id.* at 1. According to Broadcom, the jury did not address the issue of validity with respect to the patents challenged in IPR2013-00601 and IPR2013-00602. *See* IPR2013-00601, Paper 3, 2; IPR2013-00602, Paper 2, 1-2. Ericsson maintains that the requested discovery will show that “Broadcom is in privity with at least one D-Link Defendant” in the Texas Litigation. Mot. 4.

For the reasons stated below, Ericsson’s motion is *denied*.

35 U.S.C. § 315(b)

Under 35 U.S.C. § 315(b), “[a]n inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year

² The parties also filed sealed redacted versions. *See* note 3. Unless otherwise noted, reference throughout is to redacted papers filed in IPR2013-00636. The same or similar papers are filed in the other two cases, IPR2013-00601 and IPR2013-00602.

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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.” Broadcom does not dispute that one or more of the D-Link Defendants were served with a complaint more than one year prior to the filing of the Petition. Therefore, if Ericsson can show privity existed between the D-Link Defendants and Broadcom in the Texas Litigation, an *inter partes* review may not be instituted under 35 U.S.C. § 315(b). *See* Paper 9 (Order Authorizing Motion for Additional Discovery).

Request

Pursuant to its discovery Motion, Ericsson seeks the following discovery items:

1. All executed contracts or agreements between Broadcom and any of the D-Link Defendants relating to Wi-Fi compliant products, such as the BCM4313 and BCM4321, that are used in any of the D-Link Defendants’ products accused of infringement in the D-Link Litigation.
2. All executed contracts or agreements between Broadcom and any of the D-Link Defendants that include any indemnity or duty to defend provisions.
3. All joint defense agreements, or other agreements addressing cooperation on the defense of the D-Link Litigation, between Broadcom and any of the D-Link Defendants relating to the D-Link Litigation.
4. All invoices provided to or received from any of the D-Link Defendants, or their counsel, seeking reimbursement for any fees or expenses incurred in the D-Link Litigation.
5. Records of any payments made by Broadcom to any of the D-Link Defendants, or their counsel, or to Ericsson, pursuant to any actual or alleged contractual duty to defend or

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indemnify any [of] the D-Link Defendants for any fees or expenses incurred in the D-Link Litigation.

6. All emails and written correspondence between any of the D-Link Defendants, or their counsel, and Broadcom, or its counsel, relating to any claimed duty of Broadcom to defend or indemnify any of the D-Link Defendants in the D-Link Litigation from January 1, 2010 to the present.

7. All emails and written correspondence between Broadcom, or its counsel, and any of the D-Link Defendants, or their counsel, from January 1, 2010 to the present relating to:

A. The filing of IPR2013-00601, IPR2013-00602, and IPR2013-00636;

B. Intervention by Broadcom in the D-Link Litigation;

C. The claim construction or interpretation of any of the patents at issue in the D-Link Litigation, including, but not limited to, the '568 Patent, the '625 Patent, or the '215 Patent; and

D. The validity or alleged invalidity of any of the patents at issue in the D-Link Litigation, including, but not limit[ed] to, the '568 Patent, the '625 Patent, or the '215 Patent.

Ex. 2001.

Analysis

To show privity, Ericsson relies, *inter alia*, on known indemnity agreements, wherein Broadcom agreed to indemnify certain D-Link Defendants. Ericsson also relies on allegations about litigation activity by Broadcom, filing of an amicus appeal brief by Broadcom in the Texas Litigation, SEC filings, communications with Acer, Inc., a D-Link Defendant, Broadcom's use of Ericsson's expert report in the filing of the Petition, timing of the filing of the IPRs, and email correspondence about indemnity and other matters. *See* Mot. 1-7 (citing Ex. 1010; Exs. 2002-

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2017).³ For its part, Broadcom asserts that “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.” Opp. 2.

Pursuant to the America Invents Act (AIA), certain discovery is available in *inter partes* review proceedings. See 35 U.S.C. § 316(a)(5); 37 C.F.R. §§ 42.51-53. Discovery in an *inter partes* review proceeding, however, is less than what is normally available in district court patent litigation, as Congress intended *inter partes* review to be a quick and cost effective alternative to litigation. See H. Rep. No. 112-98 at 45-48 (2011). A party seeking discovery beyond what is expressly permitted by rule must do so by motion, and “must show that such additional discovery is in the interests of justice.” 37 C.F.R. § 42.51(b)(2)(i); accord 35 U.S.C. § 316(a)(5) (“such discovery shall be limited to . . . what is otherwise necessary in the interest of justice”).

The AIA legislative history makes clear that additional discovery

³ As indicated above, note 2, in addition to the redacted papers, the parties filed un-redacted papers that remain under seal: Ericsson filed a protected motion, Paper 11, with protected exhibits that remain under seal. Similarly, Broadcom filed a protected opposition, Paper 16, and a protected exhibit, Ex. 1017, that remain under seal. (Broadcom should clarify if Exhibit 1018 is to be placed under seal. It appears, based on the face of the document and related characterizations, that it contains confidential information. It is under seal at PTAB at this time.) After review of the un-redacted materials, the Board determines that they do not alter the outcome. In this Motion Decision, Broadcom’s sealed opposition and exhibits are not addressed further, because they do not impact Ericsson’s initial burden of showing that the requested discovery is necessary in the interests of justice. Ericsson’s sealed motion, Paper 11, additionally shows confidential litigation activity by Broadcom that fails to imply or show control by Broadcom over the Texas Litigation.

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