

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,

Petitioner,

v.

BRADIUM TECHNOLOGIES LLC,

Patent Owner.

Case No. IPR2016-01897

Patent No. 9,253,239 B2

**PETITIONER'S MOTION FOR AUTHORIZATION
TO TAKE ADDITIONAL DISCOVERY**

I. INTRODUCTION

Pursuant to 37 CFR 42.52, Petitioner Microsoft Corporation (“Microsoft”) moves for authorization to request a deposition of co-inventor Yonatan Lavi via the Hague Convention of 1970 on the Taking of Evidence Abroad in Civil or Commercial Matters (hereinafter “Hague Convention”). Mr. Lavi is the true technical inventor of the challenged patent in this matter and his testimony is relevant to multiple issues expected to be argued by Bradium in its Patent Owner Response, including allegations of secondary indicia of non-obviousness introduced by Bradium’s co-owner and named inventor Isaac Levanon. While Mr. Lavi resides in Israel, his testimony may be readily compelled because Israel has taken a permissive approach to such discovery requests.

Microsoft’s makes its request now to ensure timely completion of Mr. Lavi’s deposition through the Hague Convention under the Board’s current schedule, and to avoid Bradium again arguing that a deposition through the Hague could not be timely completed.

II. SUMMARY OF FACTS

On January 9, 2015, Patent Owner Bradium (“Bradium”) filed a lawsuit in the U.S. District Court for the District of Delaware, No. 1:15-cv-31-RGA (hereinafter “Delaware Case”) alleging infringement of three U.S. Patents, Nos. 7,139,794 (“the ’794 Patent”), 7,908,343 (“the ’343 Patent”), and 8,924,506 (“the

'506 Patent"). On March 14, 2016, Bradium amended its complaint to allege infringement of U.S. Patent No. 9,253,239 ("the '239 Patent"), which is the subject of this *inter partes* review (IPR). All four patents are related- they claim priority to the same set of six provisional applications filed in December 2000, and the '239 Patent is a continuation of the '506 Patent. Each patent lists Isaac Levanon and Yonatan Lavi, both of Ra'anana, Israel, as the inventors.

During the pending IPRs of the '343 and '506 Patents, Bradium submitted a declaration from Levanon in support of its secondary indicia of non-obviousness arguments. *See generally* IPR2016-00448, Ex. 2004.¹ In his declaration, Levanon generally alleged that 3DVU, Inc.- a small company operating out of the suburbs of Tel Aviv- had achieved commercial success and received praise for its technology, and that Levanon had discussed a potential acquisition of 3DVU with Microsoft in 2005.² Ex. 1045. Mr. Levanon also acknowledged that he "close[d] 3DVU around 2010." Ex. 1030, ¶ 94. Mr. Levanon failed to disclose to the Board in his declaration that he had an indirect 50% interest in Bradium and no ability to read or write software code. Ex. 1031 at 9:22-15:13, 28:21-32:2, 38:19-39:14.

¹ Copy attached as Ex. 1030. All exhibits to this motion are for the purposes of this motion only, and Microsoft reserves the right to object if Bradium seeks to introduce the same exhibits on the merits.

² 3DVU was previously known as GACentral.com, Inc. and Flyover Technologies. While the exact corporate structure of 3DVU is unclear, 3DVU included at least a Delaware Corporation, 3DVU, Inc., and an Israel subsidiary, 3DVU, Ltd.

During the prosecution of the '239 Patent, Bradium filed a Substitute Statement in Lieu of Oath or Declaration stating that Mr. Lavi “cannot be found or reached despite diligent effort.” Ex. 1032. However, Microsoft’s counsel were able to contact Mr. Lavi easily, and learned that he had in fact been contacted on multiple occasions in 2015 and 2016 by Chris Coulson, Bradium’s lead counsel in this IPR. Ex. 1033 (emails from C. Coulson to Y. Lavi).

Mr. Lavi provided a declaration in connection with IPR2016-00448 and IPR2016-00449 after Microsoft’s counsel informed Mr. Lavi that standard PTAB trial practice required a deposition if requested. In his declaration, Mr. Lavi testified, *inter alia*, that (1) 3DVU did not invent the file structure claimed in the various patents, and in fact had borrowed a pre-existing file format from another company (Ex. 1034, ¶¶ 6, 11-12); (2) 3DVU’s original prototype was not written for a mobile system (*id.*, ¶ 16); (3) 3DVU’s car navigation products (relied on by Mr. Levanon as evidence of commercial success) were self-contained and did not access data over a network (*id.*, ¶ 20); (4) Mr. Lavi developed significant improvements to the 3DVU technology not covered by the asserted Bradium claims which were incorporated in later 3DVU products (*id.*, ¶¶ 22-26, 33-34, 36); (5) 3DVU did not provide detailed technical information or source code to Microsoft during the 2005 discussions (*id.*, ¶¶ 27-30); (6) 3DVU’s “Navi2Go” product relied primarily on downloading map information first to a desktop

computer, then transferring it to a portable device, because the “real time” mobile downloading features did not work well (*id.*, ¶¶ 31-35); and (7) 3DVU was not commercially successful, as shown by its inability to expand beyond a small number of developers or pay stock dividends to its employees (*id.*, ¶¶ 37-39).

After Microsoft filed Mr. Levanon’s declaration, Bradium requested a deposition and threatened retaliation against Mr. Lavi. Bradium accused Mr. Lavi of disclosing 3DVU confidential information, despite the fact that Mr. Lavi testified on the same topics Mr. Levanon did in his *public* declaration, and despite 3DVU having been closed for seven years and nonexistent as a corporate entity for six. Exs. 1035, 1045 (showing 3DVU, Inc. status as “void”).

Microsoft promptly communicated Bradium’s deposition request to Mr. Lavi and informed Mr. Lavi that Microsoft would pay for his travel expenses to come to the United States for deposition. Nevertheless, Mr. Lavi indicated that he did not want to be deposed because he was concerned about legal and other retaliation from Mr. Levanon. Ex. 1036. Microsoft was unable to obtain Mr. Lavi’s agreement to be deposed in the United States despite several phone calls.

Microsoft attempted to work with Bradium to seek Mr. Lavi’s deposition in Israel through the Hague Convention, which Bradium refused. Ex. 1037. After the Board asked the parties to attempt to negotiate an agreement to obtain Mr. Lavi’s cooperation, Bradium responded with a proposed agreement that would have

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