

Filed: August 29, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CELLCO PARTNERSHIP D/B/A VERIZON WIRELESS
Petitioner,

v.

GENERAL ACCESS SOLUTIONS, LTD.
Patent Owner.

Case No. IPR2023-00978
U.S. Patent No. 7,230,931

PATENT OWNER'S MOTION FOR ADDITIONAL DISCOVERY

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I. Introduction and Background

Patent Owner General Access Solutions Ltd. (“General Access”) respectfully moves for discovery on the following issues: (1) whether Ericsson and Samsung are time-barred real parties in interest in this IPR; (2) whether Ericsson and Samsung are time-barred privies of the Petitioner; and (3) whether Ericsson and Samsung have a relationship with Petitioner that may be relevant to the Board’s analysis of the *General Plastic* factors.

Petitioner Cellco Partnership D/B/A Verizon Wireless (“Verizon”) identifies itself and two affiliates—Verizon Communications Inc. and Verizon Corporate Resources Group—as the real parties in interest in this IPR. Petition at 3-4. Notably absent from the Petition is any mention of the suppliers indemnifying Verizon against liability for its infringement of the challenged patent. Verizon’s omission of its indemnitors is no accident. These indemnitors were likely also unidentified real parties in interest in an earlier IPR filed by Sprint, IPR2017-01889, which challenged the same claims at issue in this IPR. This Petition should therefore be time-barred under 35 U.S.C. § 325(e) and/or 35 U.S.C. § 315(b).

Even if the indemnitors are not real parties in interest, Verizon’s relationship with its suppliers is relevant to understanding Verizon’s relationship with Sprint—the Petitioner in IPR2017-01889. Sprint and Verizon share the same suppliers—Ericsson and Samsung. Sprint and Verizon also share the same lawyers at Gibson

Dunn. At a minimum, the requested discovery will help the Board determine the nature of the “substantial relationships” between Verizon and its indemnitors and whether those relationships counsel in favor of discretionary denial of the Petition.

II. The Discovery that General Access Seeks

Patent Owner requests four types of documents: (1) indemnification agreements related to the accused 5G base station equipment that Ericsson and Samsung provide to Verizon; (2) supply agreements related to the accused equipment provided by Ericsson and Samsung; (3) joint defense or common interest agreements related to this IPR or the related district court litigation; and (4) communications between Ericsson, Samsung, Sprint, and Verizon concerning this IPR, the prior Sprint IPR, or the related district court litigation.

Patent Owner also requests a limited deposition of Verizon on these issues. The full text of the requested discovery is attached hereto as Appendix A.

III. The Requested Discovery Is in the Interest of Justice

A motion for additional discovery may be granted if the party demonstrates “that such additional discovery is in the interests of justice.” 37 C.F.R. § 42.51(b)(2); *see also* 35 U.S.C. § 316(a)(5) (requiring discovery in IPR proceedings to be limited to “what is . . . necessary in the interest of justice”). When determining whether discovery is in the interest of justice, the Board examines the five “*Garmin*” factors. *See Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, slip op. at

6-7 (PTAB Mar. 5, 2013) (Paper 26) (Precedential). The *Garmin* factors include: (1) more than a possibility and mere allegation that something useful will be discovered; (2) requests that do not seek other party's litigation positions and the underlying basis for those positions; (3) ability to generate equivalent information by other means; (4) easily understandable instructions; and (5) requests that are not overly burdensome to answer. *Id.*

The *Garmin* factors support granting the motion.

IV. Something Useful Will Be Discovered

General Access's requested additional discovery is relevant to two significant issues: (1) whether this Petition is time-barred under 35 U.S.C. § 325(e) and/or 35 U.S.C. § 315(b); and (2) whether Verizon has a "substantial relationship" with the real parties in interest in a prior IPR challenging these claims for purposes of discretionary denial under *General Plastic*. See *RPX Corp. v. Applications in Internet Time, LLC*, IPR2015-01750, IPR2015-01751, and IPR2015-01752 (PTAB Oct. 20, 2015) (Paper 11) (granting in part Patent Owner's motion for additional discovery from Petitioner to determine whether a time-barred third party should have been identified as a real party in interest). General Access has identified evidence indicating that this discovery will assist the Board in making these determinations.

A. Verizon Has Substantial Relationships with Ericsson and Samsung

Verizon has significant, long-standing relationships with the two companies that supply the bulk of its infringing 5G base station equipment—Ericsson and Samsung. More than a year before this Petition was filed, Ericsson and Samsung had inked long-term, multi-billion-dollar agreements to supply Verizon with the infringing 5G base station equipment. *See, e.g.*, Ex. 2005 (Ericsson 2021 press release announcing \$8.3 billion deal with Verizon); Ex. 2006 (news report of Samsung’s \$6.6 billion 5G network supply agreement with Verizon). These agreements are not merely arms-length purchasing agreements; they represent long-term partnerships between Verizon and these two suppliers. *See, e.g.*, Ex. 2007, (Samsung press release touting its selection by Verizon “as a 4G macro and 5G **partner**”); Ex. 2005 (Ericsson’s President describing its agreement with Verizon as “a significant strategic **partnership** for both companies”) (emphases added).

Verizon’s partnerships with its key suppliers include indemnification agreements related to the infringing 5G base station equipment. The same district court where General Access’s case against Verizon is pending recently noted in a different case that “Ericsson is obligated to indemnify Verizon for any damages resulting from a finding that Ericsson’s base stations infringe...” *Uniloc 2017 LLC v. Verizon Commc’ns Inc.*, No. 2:18-CV-00513-JRG, 2019 WL 1773118, at *3 (E.D. Tex. Apr. 23, 2019). In addition, Ericsson intervened as a defendant in the parallel district court litigation at the outset of the case. Ex. 2008, Order granting Ericsson’s

Unopposed Motion for Leave to Intervene. Verizon has almost certainly entered a joint defense agreement with Ericsson in connection with that litigation and this IPR.

Verizon and Ericsson have also coordinated their attacks on the validity of the challenged patent in the related district court litigation. Ericsson has submitted joint invalidity contentions with Verizon in that case citing, among other things, the art that is the subject of Verizon's petition. *See* Ex. 2009, Verizon and Ericsson Invalidity Contentions at 1, n.1 (noting that the contentions were jointly presented for Verizon and Ericsson regarding the challenged patent); *id.* at 19-23 (listing the asserted prior art, including all the references relied upon in Verizon's Petition).

The requested discovery will enable the Board to determine the full scope of the relationship between Verizon and its suppliers. As the Director recently determined under similar circumstances, “[p]roviding the specific indemnification agreement [between the supplier and its customer] would allow the Board to accurately determine the scope of the agreement.” *Samsung Elecs. Co., Ltd. v. Netlist, Inc.*, IPR2022-00615, Decision at 9 (Feb. 3, 2023) (Paper 40) (Director Review). Similarly, “any indemnification agreements and related communications between [the supplier and its customer] related to the [pending district court litigation] and this proceeding are likely to help clarify whether [Verizon] is representing [Ericsson and Samsung's] interest (*see RPX*, Paper 128, 8) or filed the Petition on [its suppliers'] behalf (*see Ventex*, Paper 148, 9).” *Id.* at 10.

Much like the indemnification agreements at issue in *Netlist*, with the discovery sought here, “the Board could consider whether the indemnification agreement[s] indicated a ‘fairly standard customer-manufacturer relationship for the [accused] product[s],’ as opposed to ‘an expectation that [Samsung and Ericsson] would be responsible for stepping in, or otherwise protecting [Verizon] from a patent infringement suit.’” *Id.* (citing *WesternGeo LLC v. ION Geophysical Corp.*, 889 F.3d 1308, 1321-22 (Fed. Cir. 2018)). The same is true for supply agreements, joint defense or common interest agreements, and communications related to the Petition, invalidity contentions, and/or prior art. The extent to which Ericsson and Samsung are contributing to Verizon’s attacks on the validity of the patent at issue here will help the Board determine whether this Petition should be rejected. *See RPX Corp.*, IPR2015-01750, slip op. at 39 (Oct. 2, 2020) (Paper 128) (Precedential) (finding, under a *General Plastic* analysis, that a customer’s filings of IPR petitions “were strategically motivated, at least in part, to provide a second chance at invalidating [the] patents to benefit [its supplier].”).

B. Samsung and Ericsson Have Substantial Relationships with Sprint

To the extent that Samsung and Ericsson are determined to be real parties in interest or privies of Verizon, this Petition should be time barred. Ericsson and Samsung were also unidentified real parties in interest in the Sprint IPR.

General Access sued Sprint for infringing the '931 patent in 2016. *See* Ex. 2010. Sprint filed an IPR which invalidated many of the claims in the '931 patent. *See* IPR2017-01889. But both the Board and the Federal Circuit determined that two claims of the '931 patent—Claims 28 and 29—were valid over the prior art. *See id.* at Paper 43, Final Written Decision; *Sprint Spectrum L.P. v. General Access Sols., Ltd.*, 812 F. App'x 999, 1006-07 (Fed. Cir. 2020).

Sprint did not identify Samsung or Ericsson as real parties in interest in the previous IPR. *See* IPR2017-01889, Petition at 1-2. But, like Verizon, Sprint had long-standing partnerships with both Ericsson and Samsung related to the overlapping products General Access has accused of infringement. At the same time that it was preparing its petition, Sprint was actively collaborating with both Samsung and Ericsson on the development of infringing base station equipment. *See, e.g.*, Ex. 2011 (2017 report touting Ericsson and Sprint's ongoing collaborations); Ex. 2012 (2017 report touting Sprint and Samsung's collaboration on developing infringing base station technology); Ex. 2013 (2017 report detailing how "Sprint has partnered with Samsung" to develop infringing base station technology).

Sprint also purchased accused base station equipment from Samsung and Ericsson. The agreements related to those purchases undoubtedly included indemnification provisions. Indeed, early in the litigation, Sprint identified Samsung as a supplier and potential indemnitor. *See* Ex. 2014, December 2016 Sprint Initial

Disclosures at 3, 10. And both Samsung and Ericsson participated in Patent Owner's settlement discussions with Sprint.

Patent Owner has requested that Sprint (now T-Mobile) voluntarily provide discovery into Samsung and Ericsson's roles in IPR2017-01889. *See* Ex. 2015, Aug. 17, 2023 Email from Knobloch. To date, T-Mobile has not responded. To the extent T-Mobile does not consent to this discovery, Patent Owner intends to seek leave from the Board to issue a subpoena to T-Mobile.

V. The Additional *Garmin* Factors Support Granting This Motion

A. General Access Does Not Seek Verizon's Litigation Positions

General Access's discovery requests are limited in scope and do not implicate Garmin Factor 2. Patent Owner seeks discovery into Petitioner's relationships with its vendor; Patent Owner does not seek information related to the substance of the positions Verizon has taken on the validity of the '931 patent or the bases for those positions. Patent Owner will of course refrain from seeking any discovery that is legitimately protected by the attorney-client privilege and/or work product doctrine.

B. General Access Cannot Generate Equivalent Information by Other Means

General Access has requested that Verizon produce these agreements in this IPR, but Verizon has refused. *See* Ex. 2016, Aug. 17, 2023 Email from Verizon. General Access has also requested that Ericsson permit General Access to rely on the supply agreements that Ericsson has produced pursuant to a Protective Order in

the related District Court litigation. *See* Ex. 2017, Aug. 22, 2023 Email from Knobloch. Ericsson has ignored this request. As such, General Access cannot easily generate equivalent information—it needs the discovery requested here.

C. General Access’s Instructions Are Easily Understandable

Patent Owner’s requests are easily understandable and straightforward. So are its instructions. *See* Appendix A at 2. Patent Owner simply requests that Petitioner (1) produce the documents as they are kept in the ordinary course of business, (2) explicitly state what part of the Request any objection is directed to and if Petitioner is withholding any documents as a result of the objection, and (3) expressly state the basis for any withheld documents on privilege or work product grounds. None of these instructions are controversial or hard to understand.

D. General Access’s Requests Are Not Burdensome to Answer

General Access’s discovery requests are specific, narrow, and few in number. *See Arris Grp., Inc. v. C-Cation Techs., LLC*, IPR2014-00746, slip op. at 3 (PTAB July 24, 2014) (Paper 15) (granting motion for production of an indemnification agreement); *Medtronic, Inc. v. Robert Bosch Healthcare Sys., Inc.*, IPR2014-00488, slip op. at 6-7 (PTAB Nov. 5, 2014) (Paper 25) (finding the two document requests and single interrogatory narrowly tailored where they were limited to communications between Petitioner and a non-party “regarding the preparation or filing of the [present] IPRs”); *Ventex Co., Ltd. v. Columbia Sportswear N. Am., Inc.*,

IPR2017-00651, slip op. at 2-4 (PTAB Dec. 19, 2017) (Paper 40) (granting motion for additional discovery where Patent Owner requested production of “relevant testimony concerning secondary consideration of non-obviousness” and the requests were narrowly tailored). Verizon should also be able to identify precisely the documents sought. In short, any burden on Verizon is both minimal and significantly outweighed by the importance of the discovery sought.

VI. General Access’s Request Is Timely

Petitioner filed its IPR on May 26, 2023. Patent Owner requested leave to file this motion for additional discovery on August 18, 2023. The requested additional discovery should have no impact on the trial schedule. *See One World Techs., Inc. v. The Chamberlain Grp., Inc.*, IPR2017-00126 (PTAB Dec. 15, 2017) (Paper 20) (where the Board granted a motion for additional discovery in part because there were nearly five months remaining in the proceeding and thus ample time to produce and consider the documents, which were easily identifiable, in Petitioner’s possession, and could be easily produced electronically). As such, Patent Owner’s request is timely.

VII. Conclusion

General Access respectfully requests that the Board grant its Motion.

Dated: August 29, 2023

Respectfully submitted,

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APPENDIX A

UNITED STATES PATENT AND TRADEMARK OFFICE

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CELLCO PARTNERSHIP D/B/A VERIZON WIRELESS
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v.

GENERAL ACCESS SOLUTIONS, LTD.
Patent Owner.

Case No. IPR2023-00978
U.S. Patent No. 7,230,931

PATENT OWNER'S DISCOVERY REQUESTS TO PETITIONER

Patent Owner General Access Solutions, Ltd. requests that Petitioner Cellco Partnership d/b/a Verizon Wireless respond and produce the following documents and things. Patent Owner also requests that Petitioner designate a representative, pursuant to Fed. R. Civ. P. 30(b)(6), to testify regarding the following topics.

INSTRUCTIONS

1. Please produce all documents as they are kept in the ordinary course of business.
2. If you object to any of these Requests, you must specify which part of the Request each objection is directed to, and state whether any responsive materials are being withheld on the basis of each objection.
3. For any document or thing withheld on the basis of an alleged privilege, work product protection, or other exemption from discovery, you must expressly state the basis for such withholding. You must also describe the nature of the information withheld in sufficient detail to enable Patent Owner to assess the claim.
4. For the 30(b)(6) deposition, please designate an officer, director, managing agent, or other person to testify on Your behalf. The person designated must testify about information known or reasonably available to the organization.

DEFINITIONS

1. “Patent Owner” means General Access Solutions, Ltd., as well as its officers, directors, attorneys, agents, and employees.

2. “Petitioner” or “You” means Cellco Partnership D/B/A Verizon Wireless, Verizon Communications Inc., Verizon Corporate Resources Group, and any of their subsidiaries (collectively “Verizon”) as well as Verizon’s officers, directors, attorneys, agents, and employees.

3. “Ericsson” means Ericsson, Inc. and its subsidiaries, as well as their officers, directors, attorneys, agents, and employees.

4. “Samsung” means Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and their subsidiaries, as well as their officers, directors, attorneys, agents, and employees.

5. “Sprint” means Sprint Spectrum L.P., SprintCom, Inc., Assurance Wireless USA, L.P., and their subsidiaries, as well as their officers, directors, attorneys, agents, and employees.

6. “Verizon Accused 5G Products” has the same meaning as that phrase was given in Patent Owner’s Infringement Contentions to Verizon, dated January 5, 2023.

7. “Related District Court Litigation” means *General Access Solutions, Ltd., v. Cellco Partnership D/B/A Verizon Wireless, et al.*, No. 2:22-cv-00394, in the Eastern District of Texas.

DOCUMENTS AND THINGS REQUESTED

REQUEST FOR PRODUCTION NO. 1

Your indemnification agreements with Ericsson and Samsung related to the Verizon Accused 5G Products.

REQUEST FOR PRODUCTION NO. 2

Your supply agreements with Ericsson and Samsung related to the Verizon Accused 5G Products.

REQUEST FOR PRODUCTION NO. 3

Any joint defense or common interest agreements You have with Ericsson, Samsung, or Sprint related to this IPR, the Related District Court Litigation, or the Verizon Accused 5G Products.

REQUEST FOR PRODUCTION NO. 4

Your communications with Samsung, Ericsson, or Sprint related to this IPR and/or the Related District Court Litigation, including but not limited to any communications regarding indemnification, prior art, Your IPR Petition, Your invalidity contentions in the Related District Court Litigation, and/or the costs of Your litigation with General Access.

DEPOSITION TOPICS

1. Ericsson and/or Samsung's indemnification of Verizon in connection with this IPR and/or the Related District Court Litigation, including the terms of any such indemnification.

2. Your communications with Ericsson or Samsung concerning their indemnification of Verizon in connection with this IPR and/or the Related District Court Litigation.

3. Your communications with Ericsson or Samsung concerning Your IPR Petition, Your invalidity contentions in the Related District Court Litigation, and/or prior art to the '931 Patent.

4. Your communications with Sprint concerning this IPR and/or the Related District Court Litigation.

CERTIFICATE OF SERVICE

The undersigned certifies, that on this 29th day of August, 2023, the foregoing document is being served by electronic mail (e-mail) on counsel of record for Petitioner as follows:

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