

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.

IPR2023-00978
Patent 7,230,931 B2

Before MELISSA A. HAAPALA, *Vice Chief Administrative Patent Judge*,
and KEN B. BARRETT and TERRENCE W. MCMILLIN, *Administrative
Patent Judges*.

BARRETT, *Administrative Patent Judge*.

ORDER
Denying Patent Owner's Motion for Additional Discovery
37 C.F.R. § 42.51

I. INTRODUCTION

Patent Owner General Access Solutions, Ltd., with our authorization, filed a motion for additional discovery pursuant to 37 C.F.R. § 42.51(b)(2). Paper 11 (“Motion” or “Mot.”). Patent Owner seeks discovery concerning alleged unnamed real parties-in-interest (“RPIs”) or privies of Petitioner. Mot. 1. Petitioner Cellco Partnership d/b/a Verizon Wireless (“Verizon”) filed an opposition. Paper 13 (“Opp.”). Petitioner argues that “[t]he discovery requested . . . cannot yield any useful information establishing a time bar or *General Plastic*^[1] discretionary denial and smacks of an impermissible fishing expedition.” Opp. 1.

After considering the parties’ arguments, evidence, and the factual assertions² before us, we determine that Patent Owner has not established that it is in the interest of justice to allow the requested additional discovery. Accordingly, we deny Patent Owner’s Motion for Additional Discovery.

II. BACKGROUND AND PROCEDURAL POSTURE

The challenged patent previously was before the Board and was the subject of a Final Written Decision in IPR2017-01889 (“the prior IPR”), and the petitioner in that IPR was Sprint. Mot. 1; Opp. 1. In litigation related to that IPR, Patent Owner sued Sprint for infringing claims of the challenged patent in 2016. Mot. 7. Thus, Sprint presumably was served with a complaint in or about 2016. According to Patent Owner, Ericsson and

¹ *General Plastic Industries Co. Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (Sept. 6, 2017) (precedential).

² We, for purposes of the present motion, recount the parties’ factual assertions and representations, many of which are made without citation to evidence. We make no fact findings at this very early stage of the case.

Samsung were suppliers to Sprint of accused base station equipment and partnered with Sprint in development of that equipment. *Id.* We understand that the Sprint litigation concluded in 2022. *See* Opp. 1.

About eleven months after the conclusion of the Sprint litigation, Patent Owner sued current Petitioner Verizon, alleging infringement of claims of the challenged patent. *See id.* The Petition in the current IPR subsequently was filed. *See* Paper 2, 4 (the Petition indicating that the related Verizon litigation was ongoing as of the filing of the Petition). Patent Owner asserts that “Verizon has significant, long-standing relationships with the two companies that supply the bulk of its [allegedly] infringing 5G base station equipment—Ericsson and Samsung.” Mot. 4.

Petitioner states that prior petitioner Sprint (now T-Mobile) is a competitor of current Petitioner Verizon. Opp. 4.

III. ADDITIONAL DISCOVERY SOUGHT

As summarized by Patent Owner:

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.

Mot. 2; *but see* Opp. 6 (Petitioner asserting that Patent Owner’s requests do not actually seek discovery directed to the prior Sprint IPR). The full text of the requests is attached to the Motion as an appendix.

IV. VOLUNTARY PRODUCTION

Petitioner states: “[I]n the spirit of cooperation and to avoid any appearance of impropriety, Verizon will produce to [Patent Owner] the pertinent agreements between it and Ericsson and (should Samsung provide authorization) Samsung, subject to agreement on a suitable protective order.” Opp. 2. Petitioner asserts that “[t]his production renders moot, at least, Requests for Production Nos. 1 and 2 and Deposition Topic No. 1.” *Id.*; see Mot., Appendix A (Patent Owner’s proposed discovery requests seeking, *inter alia*, the production of Verizon’s indemnification and supply agreements with Ericsson and Samsung and a deposition on the topic of their indemnification of Verizon).

To facilitate this production, we authorize either party to propose a protective order for entry in this case.³

V. DISCUSSION

In an *inter partes* review, discovery is limited as compared to that available in district court litigation. *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26, 5 (Mar. 5, 2013) (precedential). Consistent with the objective of providing a cost-effective alternative to litigation, “[l]imited discovery lowers the cost, minimizes the complexity, and shortens the period required for dispute resolution.” *Id.*

³ A protective order must be proposed by one or more parties and must be approved and entered by the Board. The Board encourages the parties to adopt the Board’s default protective order if they conclude that a protective order is necessary. See Consolidated Trial Practice Guide 19–22 (“Public Availability and Confidentiality”), 107–122 (App. B, Protective Order Guidelines and Default Protective Order), <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

A party moving for additional discovery “must show 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); 37 C.F.R. § 42.20(c) (“The moving party has the burden of proof to establish that it is entitled to the requested relief.”). The Board has identified factors relevant to the determination as to whether additional discovery is in the interests of justice. *See Garmin*, Paper 26 at 6–7. The *Garmin* factors include: (1) more than a possibility and mere allegation that something useful will be discovered; (2) requests that do not seek the other party’s litigation positions and the underlying basis for those positions; (3) the requesting party’s ability to generate equivalent information by other means; (4) easily understandable instructions; and (5) requests that are not overly burdensome to answer. *Id.*

A. Garmin Factor 1

For the first factor, *Garmin* explains that “[t]he mere possibility of finding something useful, and mere allegation that something useful will be found, are insufficient to demonstrate that the requested discovery is necessary in the interest of justice.” *Garmin*, Paper 26 at 6. “The party requesting discovery should already be in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered.” *Id.* “‘Useful’ in that context does not mean merely ‘relevant’ and/or ‘admissible.’” *Id.* at 7. Rather, “‘useful’ means favorable in substantive value to a contention of the party moving for discovery.” *Id.* Thus, we focus our discussion on Patent Owner’s contentions.

1. Patent Owner’s Statutory Bar Contentions

Patent Owner argues that the requested discovery is relevant to “whether this Petition is time-barred under 35 U.S.C. § 325(e) and/or 35

U.S.C. § 315(b).” Mot. 3. Because § 325(e) pertains to post-grant reviews, we, like Petitioner (Opp. 3), assume Patent Owner intended to cite 35 U.S.C. § 315(e), the estoppel provision applicable to *inter partes* reviews. Patent Owner argues that suppliers Samsung and Ericsson are indemnitors of Verizon and are unnamed real parties-in-interest in the current IPR, and it appears Patent Owner is alleging that they also are privies of current Petitioner Verizon. Mot. 1; *see also id.* at 1 (arguing that an issue for discovery is whether the suppliers are time-barred privies, but only actually alleging that they are RPIs); *id.* at 6 (arguing that the Petitioner should be time-barred “[t]o the extent that Samsung and Ericsson are determined to be real parties in interest or privies of Verizon,” but not explicitly alleging that they are Verizon’s privies). Patent Owner further argues that “[t]hese indemnitors were likely also unidentified real parties in interest in an earlier IPR filed by Sprint . . . [and t]his Petition should therefore be time-barred under 35 U.S.C. § 325(e) and/or 35 U.S.C. § 315(b).” *Id.*

Section § 315(b) provides that “[a]n inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year 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.” As mentioned above, prior petitioner Sprint presumably was served with a complaint in or about 2016 and, thus, is subject to the time bar of § 315(b). However, Sprint is not “the petitioner” in the current IPR and is not alleged to be an RPI or privy of current Petitioner Verizon (i.e. “the petitioner” of § 315(b)). Patent Owner does not allege that current Petitioner Verizon or either of the purported RPIs was served with a complaint over a year before the filing date of the current Petition. As such, Patent Owner has not

explained adequately how the current Petition may be time-barred under § 315(b) such that discovery on the issue is in the interest of justice. *See* Opp. 1 (Petitioner arguing that, “despite arguing that Ericsson and/or Samsung may be RPIs in both IPRs, [Patent Owner] fails to mention that neither entity was served with an infringement complaint (and thus no time bar applies)”).

The estoppel provision of 35 U.S.C. § 315(e) provides: “The petitioner in an inter partes review . . . that results in a final written decision . . ., or the real party in interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.” In this provision as applied to our context, “the petitioner” refers to prior petitioner Sprint. Patent Owner does not allege that current Petitioner Verizon was a petitioner in an IPR that resulted in a final written decision and thus does not allege that Verizon is barred by § 315(e).

Patent Owner asserts that “Sprint identified Samsung as a supplier and potential indemnitor,” Mot. 7 (citing Ex. 2014, 3, 10), and makes the unsupported assertion that Samsung and Ericsson—purportedly Sprint’s suppliers of the accused devices—participated in settlement discussions in that prior litigation, *id.* at 8. Patent Owner indicates that it recently “has requested that Sprint (now T-Mobile) voluntarily provide discovery into Samsung and Ericsson’s roles in IPR2017-01889,” and that it intends to ask, at some unidentified future date, the Board to authorize the issuance of a subpoena if T-Mobile does not consent to the discovery. Thus, Patent Owner impliedly asserts that it hopes to discover, at a later time, helpful

information to support its argument that the Petition is barred under 35 U.S.C. § 315(e) and/or U.S.C. § 315(b).

Patent Owner further alleges that Sprint had “long-standing partnerships” with Ericsson and Samsung regarding products accused of infringement and they were “actively collaborating . . . on the development of infringing base station equipment.” Mot. 7 (citing Exs. 2011–2013). Petitioner responds that, [a]t most, the cited documents establish standard supplier-customer relationships, which is not enough to constitute an RPI.” Opp. 3–4 (citing *WesternGeco LLC v. ION Geophysical Corp.*, 889 F.3d 1308, 1321 (Fed. Cir. 2018); *Wi-Fi One, LLC v. Broadcom Corp.*, 887 F.3d 1329, 1341 (Fed. Cir. 2018)). We find to be persuasive Petitioner’s position.

Additionally, the requested discovery is of Petitioner Verizon. We agree with Petitioner that Patent Owner “provides no reason why Verizon—a competitor of Sprint—would possess relevant information concerning Ericsson’s or Samsung’s relationship with Sprint.” Opp. 4 (emphasis omitted).

We determine that Patent Owner’s argument—that Ericsson and Samsung were RPIs in the prior Sprint IPR and that there is, by virtue of that relationship, a statutory bar—is based on speculation. This is “insufficient to demonstrate that the requested discovery is necessary in the interest of justice.” *Garmin*, Paper 26 at 6.

2. Patent Owner’s Discretionary Denial Contentions

Patent Owner also argues that the requested discovery is relevant to “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*.” Mot. 3 (citing *RPX Corp. v. Applications in*

Internet Time, LLC, IPR2015-01750, Paper 11 (Oct. 20, 2015)). Patent Owner states that it is seeking discovery on “whether Ericsson and Samsung have a relationship with Petitioner that may be relevant to the Board’s analysis of the *General Plastic* factors.” Mot. 1. Patent Owner contends that “[t]he 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.” *Id.* at 6 (citing *RPX Corp. v. Applications in Internet Time, LLC*, IPR2015-01750, Paper 128, 39 (Oct. 2, 2020) (precedential)).

Patent Owner does not clearly explain its *General Plastic* theory. *General Plastic* and its progeny involve concerns about a follow-on petition filed by the same petitioner or a by a party having a significant relationship with a prior petitioner. *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11, 2 (PTAB April 2, 2019) (precedential) (“[O]ur application of the *General Plastic* factors is not limited solely to instances when multiple petitions are filed by the same petitioner. Rather, when different petitioners challenge the same patent, we consider any relationship between those petitioners when weighing the *General Plastic* factors.”); *id.* at 10 (determining that “[t]he complete overlap in the challenged claims and the significant relationship between [petitioner] Valve and [prior petitioner] HTC favor denying institution.”). Patent Owner does not allege that current Petitioner Verizon or either of the alleged RPIs previously filed a petition. Thus, even if Patent Owner adequately demonstrated that it would be appropriate to allow discovery of the purportedly “substantial relationship” between Verizon and the alleged RPIs, that would not, in itself, be of substantial value to Patent Owner’s apparent contention that the current

Petition should be discretionarily denied as a follow-on petition. As with the statutory bar contentions, Patent Owner needs an adequate tie between the alleged RPIs on the current Petition and the prior petition filed by Sprint. For the reasons discussed above, Patent Owner has not shown beyond speculation that such a tie exists.

Additionally, although Patent Owner refers to “the ‘substantial relationships’ between Verizon and its indemnitors,” it does not allege that the two petitioners, Verizon and Sprint, have a substantial relationship. *See* Mot. 1–2. Patent Owner merely asserts that “Sprint and Verizon share the same suppliers” and “also share the same lawyers at Gibson Dunn.” *Id.* Petitioner responds that the use of common suppliers and common representation do not support an allegation of collusion. Opp. 5 (citing *AMX, LLC v. Chrimar Sys.*, IPR2016-00569, Paper 18, 6 (May 19, 2016) (“We are not persuaded . . . that common representation adds anything beyond speculation that something useful will be uncovered regarding additional real parties in interest in these proceedings. There are reasons apart from control by one party for different parties to retain the same counsel.”)). We determine that Patent Owner has not demonstrated that there is more than speculation that there is a legally significant tie between the two petitioners.

We determine that Patent Owner’s allegations that there may exist evidence relevant to a *General Plastic* discretionary denial analysis is insufficient to demonstrate that the requested discovery is necessary in the interest of justice.

B. The Other Garmin Factors

Garmin factor 2 pertains to whether the requests seek the other party's litigation positions and the underlying basis for those positions. Paper 26 at 6. Patent Owner asserts that it does not seek discovery of Petitioner Verizon's litigation positions. Mot. 8. Petitioner responds that this is incorrect. Opp. 8. We agree with Petitioner. Patent Owner, for example, broadly seeks "any communications regarding . . . prior art, [Verizon's] IPR Petition, [and Verizon's] *invalidity contentions in the Related District Court Litigation*." Mot., Appendix (Request for Production No. 4) (emphasis added); *see also id.* (Instruction 3 indicating that privileged information is encompassed by the requests). Factor 2 weighs against finding that the requested discovery is in the interest of justice.

Factor 3 pertains to the requesting party's ability to generate equivalent information by other means. *Garmin*, Paper 26 at 6. Patent Owner asserts that it "has requested that Verizon produce these agreements in this IPR, but Verizon has refused." Mot. 8. As mentioned above, Petitioner represents that it shall produce certain agreements. Opp. 2. Thus, at least as to those agreements, Patent Owner may obtain them by means short of ordered discovery. Patent Owner further asserts that it "has also requested that Ericsson permit [Patent Owner] to rely on the supply agreements that Ericsson has produced pursuant to a Protective Order in the related District Court litigation," but that "Ericsson has ignored this request." Mot. 8–9 (citing Ex. 2017). As Patent Owner appears to already have in its possession the documents, we fail to see why Patent Owner needs ordered discovery of the same. *See* Ex. 2107 (Patent Owner asking Ericsson if it may *cite* in the IPR the already-produced documents). Whether the

documents may be cited in this IPR (under a protective order, for example) is a different matter.

Factor 4 pertains to whether there are easily understandable instructions. *Garmin*, Paper 26 at 6–7. Petitioner, pointing to text in the Motion itself, argues that certain instructions are unclear. Opp. 9. Petitioner, quoting the Motion’s list of entities using the word “and,” argues that “it is unclear whether [Patent Owner is] seeking communications that actually involve all four parties (i.e., correspondence for which all four entities are recipients) or whether it seeks communications between any two of the listed entities (in which case the request is undoubtedly overbroad).” *Id.* at 9 (citing Mot. 2). The actual request uses the term “or,” not “and.” Mot., Appendix (Request for Production No. 4). We are not persuaded by Petitioner’s argument that the instructions are not easily understandable.

Factor 5 pertains to whether the requests are overly burdensome to answer. *Garmin*, Paper 26 at 7. Petitioner argues that Patent Owner’s “requests are overly burdensome by virtue of seeking discovery in order to present arguments that, *a priori*, are not relevant without first establishing that Ericsson and/or Samsung were RPIs in the Sprint IPR,” and, accordingly, that “*any* effort by Verizon to respond to discovery requests would be overly burdensome relative to the probative value of such information.” Opp. 10. We find this argument persuasive because discovery into only the relationship between current Petitioner and Ericsson and Samsung are not calculated to lead to evidence probative of a statutory bar or discretionary denial of the Petition. *Cf. SharkNinja Operating LLC v. iRobot Corp.*, IPR2020-00734, Paper 11, 16–20.

Petitioner also argues that “communications” Deposition Topic No. 3 is overly broad and therefore overly burdensome. *See* Opp. 10; *see also* Mot. Appendix (Deposition Topic No. 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.”). Patent Owner contends that the requests are specific and narrow. Mot. 9. Petitioner specifically argues that the topic encompasses privileged information and does not even limit its scope to bases of invalidity eligible under IPR, and on its face encompasses other bases of invalidity including, e.g., §§ 101 and 112.” Opp. 10. We agree that the breadth of the request renders it unduly burdensome.

VI. CONCLUSION

For reasons discussed above, we conclude that Patent Owner’s Motion has not met the “necessary in the interest of justice” standard for any one of the requested items of discovery in its proposed Requests for Production and proposed Deposition Topics for a deposition of a representative of Petitioner pursuant to Federal Rule of Civil Procedure 30(b)(6).

VII. ORDER

For the foregoing reasons, it is

ORDERED that Patent Owner’s motion for additional discovery is *denied*.

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