UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMMSCOPE TECHNOLOGIES LLC.
Petitioner

v.

BELDEN INC.
Patent Owner

Case: IPR2023-01061
U.S. Patent No. 6,998,537

PETITIONER'S MOTION TO COMPEL "ROUTINE DISCOVERY" PURSUANT TO 37 C.F.R. § 42.51(b)(1)(iii),

OR ALTERNATIVELY TO OBTAIN "ADDITIONAL DISCOVERY" PURSUANT TO 37 C.F.R. § 42.51(b)(2)(i)

Table of Contents

I. Documents From the *Superior Essex* Case Taking an Inconsistent Position Must Be Produced as Mandatory "Routine Discovery" 2

II. In the Alternative, Petitioner Requests "Additional Discovery" that Is in the Interests of Justice 4

Table of Authorities

Cases

Belden Technologies, Inc. v. Superior Essex Inc.,
Case No. 08-0063-SLR, (D. Del. Dec. 11, 2009) .....v, vi, 2

MaxLinear, Inc. v. Cresta Tech. Corp.,
IPR2015-00594, Paper 35 (PTAB Jan. 27, 2016).....2

Other

37 C.F.R. § 42.51(b)(1) 1
37 C.F.R. § 42.51(b)(1)(iii) 2
37 C.F.R. § 42.51(b)(2)(i) 4

Petitioner's Exhibit List

Exhibit No.	Exhibit Description
1001	U.S. Patent No. 6,570,095 (the "**'095 patent**")
1002	Excerpt of Prosecution History of U.S. Patent No. 6,570,095: Nov. 8, 2002 Notice of Allowance
1003	Excerpt of *Inter Partes* Reexamination No. 95/000,474 of U.S. Patent No. 6,570,095: Sept. 20, 2011 Action Closing Prosecution
1004	U.S. Patent No. 6,998,537 (the "**'537 patent**")
1005	Excerpt of Prosecution History of U.S. Patent No. 6,998,537: Nov. 2, 2004 Notice of Allowance
1006	Excerpt of *Inter Partes* Reexamination No. 95/000,476 of U.S. Patent No. 6,998,537: Sept. 20, 2011 Action Closing Prosecution
1007	Declaration of Kenneth Cornelison
1008	*Curriculum Vitae* of Kenneth Cornelison
1009	U.S. Patent No. 3,622,683 ("**Roberts**")
1010	English language translation of German Patent No. 297,19,866 U1 ("**GmbH-866**"), and attached Declaration of translator Anthea Heyes
1011	German Patent No. 297,19,866 U1 (untranslated original)
1012	English language translation of Japanese Patent Publication S43015470 ("**Yanagida**"), and attached Declaration of translator Anthea Heyes
1013	U.S. Patent No. 5,670,748 ("**Gingue**")
1014	U.S. Patent No. 3,894,172 ("**Jachimowicz**")
1015	U.S. Patent No. 4,755,629 ("**Beggs**")
1016	*Electronic Wire & Cable - A User's Guide: Performance and Selection*, Section 5: Multiconductor Cables, AT&T (1987)
1017	Whitham D. Reeve, *Subscriber Loop Signaling and Transmission Handbook – Digital*, IEEE Telecommunications Handbook Series (1995)
1018	Whitham D. Reeve, *Subscriber Loop Signaling and Transmission Handbook – Analog*, IEEE Telecommunications Handbook Series (1992)
1019	U.S. Patent No. 5,380,591

1020	U.S. Patent No. 1,727,972
1021	U.S. Patent No. 1,956,730
1022	U.S. Patent No. 3,803,340 (Jachimowicz-340)
1023	Canadian Patent Application No. 2,058,046
1024	U.S. Patent No. 4,262,164
1025	U.S. Patent Pub. No. 2006/0169478
1026	U.S. Patent No. 4,253,890
1027	U.S. Patent No. 5,283,390
1028	U.S. Patent No. 5,969,295
1029	G.F. Moore, *Electric Cable Handbook*, BICC Cables (3d. ed. 1997)
1030	*The New IEEE Standard Dictionary of Electrical and Electronics Terms* (5th ed. 1993)
1031	Neil Sclater and John Markus, *Electronics Dictionary*, McGraw-Hill (6th ed. 1997)
1032	S. Yonechi et al., *Application of Spacer Forming Technique to Communication Cables*, International Wire & Cable Symposium Proceedings (1980)
1033	U.S. Patent No. 7,179,999 (the "'999 patent")
1034	Excerpt of *Inter Partes* Reexamination No. 95/000,475 of U.S. Patent No. 7,179,999: Oct. 14, 2011 Action Closing Prosecution
1035	Alcatel Cable Systems Product Catalog
1036	U.S. Patent No. 5,789,711
1037	Excerpt of Prosecution History of U.S. Patent No. 6,570,095: Oct. 22, 2001 Non-Final Office Action
1038	Excerpt of Prosecution History of U.S. Patent No. 6,570,095: April 3, 2002 Final Office Action
1039	Excerpt of Prosecution History of U.S. Patent No. 6,998,537: March 3, 2004 Non-Final Office Action
1040	Excerpt of Prosecution History of U.S. Patent No. 6,998,537: Terminal Disclaimer
1041	Excerpt of Prosecution History of U.S. Patent No. 6,998,537: May 18, 2004 Amendments
1042	Excerpt of Prosecution History of U.S. Patent No. 6,998,537: June 17, 2004 Final Office Action

1043	Excerpt of Prosecution History of U.S. Patent No. 6,998,537: September 20, 2004 Request for Continued Examination
1044	Excerpt of Prosecution History of U.S. Patent No. 6,998,537: Sept. 9, 2005 Amendment
1045	Excerpt of *Inter Partes* Reexamination No. 95/000,474 of U.S. Patent No. 6,570,095: Feb. 24, 2012 Decision Granting Petition to Terminate *Inter Partes* Reexamination Proceeding
1046	Excerpt of *Inter Partes* Reexamination No. 95/000,476 of U.S. Patent No. 6,998,537: Feb. 24, 2012 Decision Granting Petition to Terminate *Inter Partes* Reexamination Proceedings
1047	Excerpt of *Inter Partes* Reexamination No. 95/000,475 of U.S. Patent No. 7,179,999: Feb. 24, 2012 Decision Granting Petition to Terminate *Inter Partes* Reexamination Proceedings
1048	U.S. Patent No. 5,814,768
1049	U.S. Patent No. 6,037,546
1050	Excerpt of *Inter Partes* Reexamination No. 95/000,474 of U.S. Patent No. 6,570,095: Jan. 11, 2010 Third Party Requester's Comments to Patent Owner's Response
1051	Excerpt of *Inter Partes* Reexamination No. 95/000,476 of U.S. Patent No. 6,998,537: Jan. 22, 2010 Third Party Requester's Comments to Patent Owner's Response
1052	*Belden Techs. et al. v. Superior Essex Comm'cns LP et al.*, No. 08-63-SLR, Dkt. 215 (D. Del. Aug. 8, 2010) – Claim Construction Order
1053	*Belden Inc. v. CommScope, Inc. et al.,* No. 22-783-RGA, Dkt. 292 (D. Del. May 26, 2023) – Scheduling Order
1054	Declaration of Sylvia D. Hall-Ellis, PhD
1055	English Translation of Japanese Patent Publication No. S43-15470 used in prior reexamination of US 6,998,537
1056	Japanese Patent Publication No. S43-15470 (untranslated original)
1057	English language translation of German Patent No. 297,19,866 U1 used in prior reexamination of US 6,998,537
1058	Excerpts from the reexamination of the '537 patent
1059	Excerpts from the reexamination of the '095 patent
1060	Declaration of Peter M. Kohlhepp in Support of Petitioner's Unopposed Motion for *Pro Hac Vice* Admission

1061	Plaintiffs Belden Technologies, Inc.'s and Belden CDT (Canada), Inc's Memorandum in Support of Their Motion for Partial Summary Judgment No. 2: No Patent Invalidity by Anticipation from *Belden Technologies, Inc. v. Superior Essex Inc.*, Case No. 08-0063-SLR, Dkt. 139 (D. Del. Dec. 11, 2009)
1062	Excerpts from Jury Trial Transcript Volume F from *Belden Technologies, Inc. v. Superior Essex Inc.*, Case No. 08-0063-SLR, Dkt. 306 (D. Del. Jun. 27, 2011)
1063	Excerpts from Jury Trial Transcript Volume G from *Belden Technologies, Inc. v. Superior Essex Inc.*, Case No. 08-0063-SLR, Dkt. 306 (D. Del. Jun. 27, 2011)
1064	Summary Judgment Memorandum Opinion from *Belden Technologies, Inc. v. Superior Essex Inc.*, Case No. 08-0063-SLR, Dkt. 216 (D. Del. Aug. 24, 2010)
1065	Petitioner's Requests for Production

Petitioner brings this motion pursuant to authorization granted on April 18, 2024. In a previous lawsuit against a company called Superior Essex, Patent Owner ("PO") took the position that the GmbH-866 reference ***does*** disclose "twisted pairs." In this IPR, PO takes the position that the same reference ***does not*** disclose "twisted pairs." These positions are inconsistent. Under the "routine discovery" rule, PO must automatically (without any request) produce the documents containing this inconsistent position. The documents are material to this IPR: GmbH-866 (Ex-1011) is the lead reference for Ground 5 of the Petition, and GmbH-866 is asserted against all challenged claims.

Petitioner requests that (i) the Board order PO to produce the documents identified in this motion and the accompanying Ex-1065, as well as any other relevant information of which PO is aware that is inconsistent with a position advanced in the IPR, within three business days, and (ii) further order Petitioner to confirm, also within three business days, whether it has complied with the requirements of routine discovery under 37 C.F.R. § 42.51(b)(1).

In the event the Board reaches the issue, Petitioner alternatively requests an Order granting Petitioner's motion for additional discovery seeking the documents identified in Ex-1065.

I. Documents From the *Superior Essex* Case Taking an Inconsistent Position Must Be Produced as Mandatory "Routine Discovery"

The IPR rules are clear: "unless previously served, a party must serve

relevant information that is inconsistent with a position advanced by the party during the proceeding concurrent with the filing of the documents or things that contains the inconsistency." 37 C.F.R. § 42.51(b)(1)(iii). Such discovery is automatic and does not require any action by Petitioner. *E.g., MaxLinear, Inc. v. Cresta Tech. Corp.,* IPR2015-00594, Paper 35 at 9 (PTAB Jan. 27, 2016).

Available documents from the public docket of the *Superior Essex* lawsuit show that PO took an inconsistent position:

PO position in *Superior Essex* case (08-cv-00063-SLR (D. Del.))	PO position in this IPR (IPR2023-01061)
"The prior art '866 patent discloses shielded data transmission cable that contains at least two twisted pairs of insulated conductors" *PO's SJ Brief, Dkt. 139 at 4 (Ex-1061)*	"GmbH-866 fails to teach or suggest [] 'twisted pairs,' … as required by the Challenged Claims." *PO Response, Paper 20 at 54*
"I say this paragraph is about twisting the individual twisted pairs" *Trial testimony by PO's expert, Dkt. 306 at 1240:12-14 (Ex-1062)*	"[T]he citations [to GmbH-866] on which Petitioner's theory is based is ***not*** referring to twisted pairs. *PO Response, Paper 20 at 55-56*
"The only twisting that's described or stranding that's described [in the '866 patent] is of the individual pairs" *PO's Closing argument, Dkt. 307 at 1360:19-20 (Ex-1063)*	"GmbH-866 does not teach or suggest twisted pairs." *PO Response, Paper 20 at 60*
SJ Order finding PO "concedes that the '866 patent discloses several limitation of claim 27 ['095 patent]," including twisted pairs and that with respect to the '537 Patent the "only limitation at issue is the purported disclosure by the '866 patent of a 'substantially flat' pair separator." *SJ Order, Dkt. 216 at 43, 55 (Ex-1064)*	

The *Superior Essex* docket further confirms that additional *non-public* documents exist that also take this inconsistent position. They include:

- An expert report by PO's expert Horenstein, where Horenstein opines that GmbH-866 refers to "twisting of the [individual] conductor pairs" (Ex. 34 to Dkt. 199, cited in Ex-1064, p. 44)
- A document where PO "concedes" GmbH-866 discloses elements of claim 27 of '095 patent (Ex. 41 to Dkt. 125, cited in Ex-1064, p. 43)
- "JTX-397," a stipulation regarding elements GmbH-866 discloses (Ex-1063, 1308:1-15, 1331:18-1332:11).

There are almost certainly additional such documents, including (i) deposition transcripts and (ii) discovery responses that pertain to GmbH-866. Petitioner's Requests for Production, filed as Ex-1065, identify these documents specifically.

Under the "routine discovery" rule, PO should have *already* produced these documents, concurrently with filing its PO Response taking the position that GmbH-866 does not disclose twisted pairs. PO did not, and PO has continued to refuse to do so. But the rules do not permit PO to keep these documents hidden from Petitioner, and the Board should compel PO to produce them promptly.

During Petitioner's call seeking authorization for this motion, counsel for PO represented to the Board that it was it was not aware of any inconsistent information and therefore not obligated to provide "routine discovery," *because it had not looked at any of the documents from the Superior Essex case*. PO's counsel also contended that the *Superior Essex* documents, such as PO's own expert

reports, were marked confidential under that case's protective order and therefore PO's current counsel could not see them. This is a facially baseless position. The IPR rules impose the requirement to produce "routine" discovery ***on the party***, not the party's counsel. The difference in counsel between the *Superior Essex* matter and this IPR is immaterial. Further, the prior inconsistent positions are in *Belden's own documents* and testimony by *Belden's own witnesses*, and also concern *public prior art*. It is inconceivable that the protective order in the prior case somehow bars Belden from producing its *own* information concerning *public* prior art.

There also cannot be any dispute that the *Superior Essex* documents are "inconsistent," for the purpose of the routine discovery rule. In *Superior Essex*, PO took the position that GmbH-866 ***does*** disclose twisted pairs; in this IPR PO takes the position that GmbH-866 ***does not.*** That is inconsistent, no matter how one spins it. Any potential *explanation* for the inconsistency Belden pursues at this stage does not obviate the discovery obligation to at least produce the documents. If the "routine discovery" rule does not apply in this situation, it is difficult to envision one where it would.

II. In the Alternative, Petitioner Requests "Additional Discovery" that Is in the Interests of Justice

A party may obtain "additional discovery" when it shows such discovery is "in the interests of justice." 37 C.F.R. § 42.51(b)(2)(i). Even if the Board were to conclude PO is not obligated to produce the documents regarding GmbH-866 as

"routine discovery," it is still in the interests of justice for PO to produce them. The *Garmin* factors show that Petitioner is also entitled to these documents as "additional discovery." IPR2012-00001, Paper 26 at 6-7.

Exhibit 1065 specifically identifies the documents Petitioner seeks. As to *Garmin* (1), there is certainly more than a possibility of useful information—as Petitioner explained above, the documents exist and they pertain to a material issue: whether GmbH-866 discloses twisted pairs, something PO disputes with respect to Ground 5 of this IPR trial. As to *Garmin* (2), the discovery does not seek PO's litigation positions or the basis for those positions. As to *Garmin* (3), Petitioner tried to obtain the information via the *Superior Essex* docket, but the documents are not publicly available, and PO has refused to provide them. Petitioner also did serve a subpoena seeking certain *Superior Essex* documents in its own district court case, but that case is now stayed pending this IPR. Regarding *Garmin* (4), the instructions associated with Exhibit 1065 are short and easily understandable. As to *Garmin* (5), the discovery is not burdensome, as it seeks specific, discrete litigation documents that Petitioner already has (e.g., expert reports, deposition transcripts, discovery responses, and specific trial exhibits). In the interest of justice, documents containing PO's prior (inconsistent) positions on the same prior art references should be provided to Petitioner.

Respectfully submitted,

Dated: April 25, 2024

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CERTIFICATION OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e) and the agreement of the parties, the undersigned certifies that on April 25, 2024, a true and correct copy of the foregoing Motion was served via electronic mail upon the following:

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