

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INCORPORATED
Petitioner*,

v.

NETWORK SYSTEM TECHNOLOGIES, LLC
Patent Owner

Case: IPR2024-00338
U.S. Patent No. 7,373,449 B2

**JOINT MOTION FOR AUTHORIZATION TO APPLY FOR SUBPOENA
UNDER 35 U.S.C. § 24 TO COMPEL TESTIMONY OF SEAN O'BRYAN**

* Qualcomm Incorporated filed a petition and a motion for joinder in IPR2024-01081 and has been joined as a petitioner in this proceeding.

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Petitioner Qualcomm Incorporated (“Qualcomm”) and Patent Owner Network System Technologies, LLC (“NST”) hereby jointly move for authorization from the Board to apply to a United States District Court for a subpoena to compel the testimony of Sean O’Bryan under 35 U.S.C. § 24.

I. BACKGROUND

Mr. O’Bryan¹ submitted a declaration regarding the publication of “Networks on Chip,” edited by Axel Jantsch and Hannu Tenhunen.² NST wishes to cross-examine Mr. O’Bryan. Mr. O’Bryan’s employer, the University of Texas, requires a subpoena for any deposition testimony.

The Board authorized filing of this motion via email on October 23, 2024.

The parties have met and conferred and in an effort to minimize the burden on the third party agree to a deposition limited to sixty minutes of cross-examination and 20 minutes of redirect.

The parties have corresponded with Mr. O’Bryan’s counsel (and attorney for

¹ Mr. O’Bryan is a third party who has not been retained as a consultant by either party to this IPR. Mr. O’Bryan is a librarian at University of Texas Libraries located within the University of Texas, Austin. Ex. 1027 at ¶2.

² Excerpts of “Networks on Chip” were filed as Exhibits 1007 and 1014 in this proceeding.

the University of Texas system) regarding Patent Owner's request for a deposition, and Mr. O'Bryan's counsel has requested that the parties include his email and objections to the request as part of this motion to the Board. Pursuant to that request, attached as Exhibit 1033 is email correspondence with Mr. O'Bryan's counsel.

II. GENERAL LEGAL PRINCIPLES

Cross-examination of the opposing party's declarants is typically provided under routine discovery. 37 C.F.R. § 42.51(b)(1)(ii). If the declarant is unwilling to appear voluntarily, a party in a contested case before the Patent and Trademark Office may apply to a United States District Court for a subpoena to compel testimony. 35 U.S.C. § 24. A party seeking a subpoena to compel testimony must first obtain authorization from the Board. 37 C.F.R. §42.52(a).

III. ARGUMENT

NST has requested to cross-examine Mr. O'Bryan regarding his declaration as part of routine discovery under 37 C.F.R. § 42.51(b)(1)(ii). Because the University of Texas requires a subpoena for deposition testimony, the parties' only option is to seek a subpoena. 35 U.S.C. § 24; 37 C.F.R. §42.52(a). The parties request that the Board authorize the parties to apply for a subpoena for three reasons.

First, authorizing the parties to apply for a subpoena would also be consistent with the mandate that the Board “secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b). Authorizing the subpoena would provide NST with the opportunity to cross-examine the declarant it has requested and also obviate the need for any motion practice regarding the ability of Qualcomm to continue relying on the declaration in this proceeding. The Board followed a similar path in an IPR between the same parties regarding another third-party declarant, and the parties respectfully request the Board do the same here. *See* IPR2024-00343, Paper 30 (PTAB Aug. 29, 2024).

Second, Qualcomm and NST have agreed to limit the deposition to sixty minutes of cross-examination and 20 minutes of redirect to minimize any burden on Mr. O’Bryan and the University of Texas. Such a time-limited deposition would strike the appropriate balance of limiting the burden on a third party while also providing for the cross examination of affiant testimony set forth at 37 C.F.R. § 42.51(b)(1)(ii). *See, e.g., Chicago Mercantile Exchange, Inc. v. 5th Market, Inc.*, CBM2015-00061, Paper 24 at 5-6 (PTAB Nov. 17, 2015). Such a limitation will also help address the concerns expressed by Mr. O’Bryan’s counsel in his email attached as Exhibit 1033.

Third, the Board has granted similar requests in similar situations. *E.g., Chicago Mercantile*, CBM2015-00061, Paper 24 at 6; *Marvell Semiconductor, Inc.*

v. Intellectual Ventures LLC, IPR2014-00553, Paper 28 at 3 (PTAB Apr. 8, 2015).

The parties respectfully request that the Board do the same here.

IV. CONCLUSION

For the foregoing reasons, the parties respectfully request authorization to apply for subpoena to compel the deposition of Mr. O'Bryan. Such a deposition will be limited to sixty minutes of cross-examination and 20 minutes of redirect.

Dated: October 24, 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 October 24, 2024, a true and correct copy of the foregoing Motion was served via electronic mail upon the following:

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