

**From:** [Christopher, Angelo](#)  
**To:** [Trials](#)  
**Cc:** [Peter M Kohlhepp](#); [Derek Vandenburg](#); [NST v. Qualcomm CCVL](#); [Hayes, Jennifer](#); [Stringfield, Daniel](#); [Zheng, Helena](#); [Girgis, Diana](#)  
**Subject:** IPR2024-00343; Qualcomm Incorporated v. Network System Technologies, LLC  
**Date:** Thursday, August 22, 2024 6:41:23 PM

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Your Honors,

The parties in the above-referenced IPR respectfully request a conference call with the Board to resolve a dispute regarding Patent Owner's deposition request.

### **Patent Owner's Position**

Petitioner submitted a declaration from Gordon Macpherson (Ex. 1018) to support its argument that Radulescu2004 qualifies as prior art. Petitioner has represented that it cannot make Mr. Macpherson available for a deposition because his employer, IEEE, requires a subpoena. However, the Board's rules require that Petitioner make Mr. Macpherson available as part of routine discovery. 37 C.F.R. §§ 42.51-42.54; COPTG at p. 23 ("a party presenting a witness's testimony by affidavit should arrange to make the witness available for cross-examination. This applies to witnesses employed by a party as well as experts and non-party witnesses"). While Petitioner has suggested that Patent Owner seek a subpoena, it has not identified authority holding that Patent Owner must bear the burden of moving to compel what should be routine discovery. Patent Owner has indicated that it would not oppose Petitioner seeking a subpoena so that it can make Mr. Macpherson available, but Petitioner has declined to do so.

Accordingly, Patent Owner respectfully requests authorization to file a motion to strike the MacPherson declaration consistent with prior decisions in which a party was unable produce a declarant for cross-examination. *See, e.g., New World Medical, Inc. v. Microsurgical Tech., Inc.*, IPR2021-01573, Paper 49 (PTAB Nov. 5, 2021); *HTC Corporation et. al, v. NFC Technology, LLC*, IPR2014- 01198, Paper 41 (PTAB Nov. 6, 2015); *John's Lone Star Distribution, Inc. v. Thermolife Int'l, LLC*, IPR2014-01201, Paper 31 (PTAB May 13, 2015).

### **Petitioner's Position**

This issue presents a non-standard circumstance. Petitioner respectfully seeks the Board's guidance, and Petitioner also opposes Patent Owner's request to file a motion to strike as both premature and lacking good cause.

The declaration at issue (Ex. 1018) is from a records custodian at the IEEE organization. Petitioner did not retain the declarant and neither the declarant nor IEEE received any compensation for time related to the declaration. IEEE has informed Petitioner that it requires a subpoena for any deposition testimony. Under the rules, a party unwilling to be voluntarily deposed may be compelled by subpoena, but "[the] party seeking to compel

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testimony” must file a motion for authorization. 37 C.F.R. § 42.52(a). Here that party is Patent Owner (also, it is not currently Petitioner’s discovery window). Petitioner identified a case concerning a similar records custodian where it was the Patent Owner that moved for a subpoena. *Coastal Indus., Inc. v. Shower Enclosures Am., Inc.*, IPR2017-00573, Paper No. 27 (Feb. 20, 2018). Petitioner is also aware of another case concerning a records custodian where the parties jointly requested a subpoena. *Johns Manville Corp. v. Knauf Insulation, Inc.*, IPR2015-01453, Paper 16 at 3 (PTAB Mar. 14, 2016).

Petitioner is mindful of the burden a deposition would impose on a third party that Petitioner has not retained. See *Johns Manville*, IPR2015-01453, Paper 16 at 3. However, Petitioner is also willing to cooperate in a request for a subpoena to compel testimony, if the Board determines that is necessary in order to consider the declaration. Petitioner respectfully seeks the Board’s guidance on this issue.

The parties can be available for a conference call as follows: 8/23 between 10-noon or 3-4 ET; 8/26 between 9-12 or after 4 PM ET; and 8/27 between 9-10:30 ET.

Respectfully submitted,

Angelo Christopher  
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