

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INCORPORATED and
SAMSUNG ELECTRONICS CO., LTD
Petitioners

v.

NETWORK SYSTEM TECHNOLOGIES, LLC
Patent Owner

Case: IPR2024-00343
U.S. Patent No. 7,594,052

**JOINT MOTION FOR AUTHORIZATION TO APPLY FOR SUBPOENA
UNDER 35 U.S.C. § 24 TO COMPEL TESTIMONY OF GORDON
MACPHERSON**

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 Gordon MacPherson under 35 U.S.C. § 24.

I. BACKGROUND

Mr. MacPherson¹ submitted a declaration regarding the publication of A. Radulescu, et al., “An efficient on-chip network interface offering guaranteed services, shared-memory abstraction, and flexible network configuration” (“Radulescu2004”).² NST wishes to cross-examine Mr. MacPherson. Mr. MacPherson’s employer, IEEE, requires a subpoena for any deposition testimony.

The parties emailed the Board outlining their respective positions and requesting a conference call on August 22, 2024. The Board determined that a conference call was unnecessary and issued an order requiring the parties to meet and confer and authorizing the filing of this motion. Paper 30 at 4. The parties have since met and conferred and now jointly file this motion. The parties agree to a deposition limited to sixty minutes of cross-examination and 20 minutes of

¹ Mr. MacPherson is a Director, Board Governance & Policy Development of the Institute of Electrical and Electronics Engineers, Incorporated (“IEEE”), a third party. Ex. 1018 at ¶¶1-2.

² Radulescu2004 is Exhibit 1005 in this proceeding.

redirect, as suggested by the Board. *See* Paper 30 at 4.

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. MacPherson regarding his declaration as part of routine discovery under 37 C.F.R. § 42.51(b)(1)(ii). Because IEEE 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.

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. MacPherson and IEEE, as the Board suggested. *See* Paper 30 at 4. 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).

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. MacPherson. Such a deposition will be limited to sixty minutes of cross-examination and 20 minutes of redirect.

Dated: September 10, 2024

Respectfully submitted,

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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 September 10, 2024, a true and correct copy of the foregoing Motion was served via electronic mail upon the following:

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