

**PUBLIC VERSION**

**UNITED STATES INTERNATIONAL TRADE COMMISSION**

**Washington, D.C.**

**In the Matter of**

**CERTAIN SEMICONDUCTOR DEVICES,  
SEMICONDUCTOR DEVICE PACKAGES,  
AND PRODUCTS CONTAINING SAME**

**Inv. No. 337-TA-1010**

**ORDER NO. 42: GRANTING-IN-PART BROADCOM'S MOTION TO AMEND THE  
PROTECTIVE ORDER TO ADD A PATENT PROSECUTION BAR  
AND AMENDING THE PROTECTIVE ORDER**

(October 14, 2016)

On September 2, 2016, Respondents Broadcom Limited and Broadcom Corporation (collectively, "Broadcom") filed a motion to amend the protective order to add a patent prosecution bar (Motion Docket No. 1010-039) ("Motion" and "Memorandum"). On September 15, Complainants Tessera Technologies, Inc., Tessera, Inc., and Invensas Corporation (collectively, "Tessera") filed a response opposing Broadcom's motion ("Response"). On September 20, Broadcom filed a reply in support of its motion ("Reply").

For the reasons set forth below, Broadcom's motion is GRANTED-IN-PART and the protective order is amended as indicated below.

**I. ANALYSIS**

**A. A prosecution bar protects against inadvertent misuse of CBI.**

As a preliminary matter, Tessera argues that a prosecution bar is unnecessary because the protective order already prohibits a recipient of another party's confidential business information ("CBI") from intentionally using that information outside of this investigation. Order No. 1 at ¶ 4(iii). The proscription against using CBI in other matters, however, does not protect against

## PUBLIC VERSION

inadvertent misuse of CBI. “It is very difficult for the human mind to compartmentalize and selectively suppress information once learned, no matter how well-intentioned the effort may be to do so.” *In re Deutsche Bank Trust Co., Americas*, 605 F.3d 1373, 1378 (Fed. Cir. 2010) (quoting *Fed. Trade Comm’n v. Exxon Corp.*, 636 F.2d 1336, 1350 (D.C. Cir. 1980)) (brackets and internal quotation marks omitted). As a result, “even the most rigorous efforts of the recipient of such information to preserve confidentiality in compliance with the provisions of such a protective order may not prevent inadvertent compromise.” *Id.*

One of the situations that raises the potential for inadvertent misuse of CBI is when trial counsel also prosecutes patent applications at the U.S. Patent and Trademark Office (“PTO”). *Id.* In such situations, a patent prosecution bar is an appropriate precaution against the inadvertent misuse of CBI. *Id.* at 1381. In this investigation, seven attorneys representing Tessera are licensed to prosecute patent applications at the PTO.<sup>1</sup> The profiles of these attorneys maintained by the PTO’s Office of Enrollment and Discipline indicate that all seven are “Currently Accepting New Clients.”<sup>2</sup> Thus, all seven of these attorneys are not only licensed to prosecute patent applications at the PTO, but have indicated a willingness to do so. In view of the foregoing, I find that there is a risk of inadvertent use of CBI outside of this investigation.

### **B. A prosecution bar is warranted.**

As the party seeking the prosecution bar, Broadcom must “show that the information designated to trigger the bar, the scope of activities prohibited by the bar, the duration of the bar, and the subject matter covered by the bar reasonably reflect the risk presented by the disclosure

---

<sup>1</sup> The attorneys-in-question are Daniel Valencia, Nitin Subhedar, Anupam Sharma, Laura Muschamp, Christopher Eppich, Matthew Phelps, and Rajesh Paul.

<sup>2</sup> Printouts of the profiles are attached to Broadcom’s motion as Exhibits 14 and 15.

## PUBLIC VERSION

of proprietary competitive information.” *Deutsche Bank*, 605 F.3d at 1381. Broadcom, however, is not required to show that the bar is warranted for each person who will be subject to the bar. Tessera’s argument to the contrary is based on a misreading of *Deutsche Bank*. Response at 15-17. *Deutsche Bank* does not require the party seeking the prosecution bar show on a person-by-person basis that the bar is warranted. 605 F.3d at 1381. Rather, the party seeking exemptions to the prosecution bar must show on a person-by-person basis that each exemption is warranted. *Id.* (holding that “the party seeking an exemption from a patent prosecution bar must show on a counsel-by-counsel basis” that the exemption is warranted).

Broadcom’s proposed bar with the modifications set forth below reasonably reflects the risk that CBI produced in this investigation will be inadvertently used in the preparation and prosecution of patent applications in terms of (1) the information that will trigger the bar, (2) the activities prohibited by the bar, (3) the subject matter covered by the bar, and (4) the duration of the bar. *Id.*

### **1. Technical CBI is relevant to the preparation and prosecution of patent applications.**

Information triggering a prosecution bar must be relevant to the preparation and prosecution of patent applications. *Id.* (“In evaluating whether to grant a patent prosecution bar in the first instance, a court must be satisfied that the kind of information that will trigger the bar is relevant to the preparation and prosecution of patent applications before the PTO.”). Under Broadcom’s proposal, the prosecution bar is triggered by receipt of another party’s CBI “relat[ing] to the structure, operation, function, design, or development of any existing or potential product.” Proposed Prosecution Bar, ¶ 19.<sup>3</sup> Tessera argues that Broadcom’s proposed

---

<sup>3</sup> Broadcom’s proposed prosecution bar is attached to its motion as Exhibit 1.

## PUBLIC VERSION

prosecution bar will be triggered by information irrelevant to the preparation and prosecution of patent applications, such as “project schedules and financial information relating to the development of an accused product and customer-facing documents relating to the operation of a finished product that has already been fabricated and packaged.” Response at 13-14. Although Broadcom argues in its reply that the proposed bar is only triggered by “confidential *technical* information,” Reply at 6-7 (emphasis in original), the proposed bar’s trigger is not expressly so limited. Broadcom has not made a showing that there is a risk that its non-technical CBI will be inadvertently misused. *See, e.g., Deutsche Bank*, 605 F.3d at 1381 (“[F]inancial data and other sensitive business information, even if deemed confidential, would not normally be relevant to a patent application and thus would not normally be expected to trigger a patent prosecution bar.”).

With regard to technical CBI, Broadcom represents that it has produced and will produce highly-sensitive technical documents relevant to the preparation and prosecution of patent applications. Memorandum at 6. As examples of these documents, Broadcom identifies “design rule” documents that “specify certain geometric and connectivity parameters provided by semiconductor manufacturers to verify that a specific semiconductor can be manufactured properly by the foundries” and GDS files that “provide layer-by-layer descriptions of integrated circuits.” *Id.*<sup>4</sup> Tessera does not contest that the information contained in such documents is relevant to the preparation and prosecution of patent applications.

---

<sup>4</sup> Although reference is made in this instance to Broadcom’s technical CBI, notwithstanding Tessera’s arguments to the contrary, Broadcom’s proposed prosecution bar is not “one-sided.” Response at 3. The proposed bar would apply to “[a]ny attorney, patent agent, expert, or other person who has subscribed to the Protective Order (Order No. 1) on behalf of *any* party in this Investigation or has otherwise accessed material designated by another party” as CBI. Proposed Prosecution Bar, ¶ 19 (emphasis added).

## PUBLIC VERSION

Based on the foregoing, I find that the technical information identified by Broadcom is relevant to the preparation and prosecution of patent applications. The information triggering the prosecution bar shall be expressly limited to technical CBI.

### **2. The activities prohibited under the bar are those that could lead to inadvertent misuse of technical CBI.**

The activities prohibited under the prosecution bar must be limited to those that could lead to inadvertent misuse of technical CBI. *Deutsche Bank*, 605 F.3d at 1381 (holding that “the scope of activities prohibited by the bar . . . [must] reasonably reflect the risk presented by the disclosure of proprietary competitive information”). Under Broadcom’s proposed bar, attorneys and experts will be barred from taking part in patent prosecution activities constituting “competitive decisionmaking” under *Deutsche Bank*. Proposed Prosecution Bar at ¶ 19. While the proposed bar prohibits trial counsel from being involved in amending claims in post-grant review proceedings, such as *inter partes* reviews (“IPRs”), it allows trial counsel to participate in all other aspects of the post-grant review proceedings. *Id.*

Tessera argues that a “prosecution bar that covers aspects of IPR proceedings would unfairly prejudice Tessera by removing its right to counsel of choice and preventing that counsel from effectively and efficiently coordinating Tessera’s litigation strategy.” Response at 19. Any prejudice to Tessera, however, will be minimal. Tessera’s trial counsel will still be able to participate in post-grant proceedings with regard claim construction and prior art. It is uncertain and highly speculative whether Tessera will amend any claims in post-grant proceedings. Assuming *arguendo* that Tessera does so, Tessera has not provided any explanation as to why it would be unduly prejudiced if its trial counsel are barred from the amendment process. Provisions similar to the one proposed by Broadcom have been found to strike the appropriate balance between the interests of the patent holder and accused infringer. *See, e.g., Evolutionary*

## PUBLIC VERSION

*Intelligence, LLC v. Foursquare Labs*, 2014 WL 1311970, at \*1 (N.D. Cal. 2014) (allowing patent holder’s litigation counsel to participate in IPRs “subject to the limitation that she cannot participate in drafting or amending patent claims”), *Endo Pharm. Inc. v. Actavis Inc.*, 2014 WL 3950900, at \*3 (S.D.N.Y. 2014) (“The related defendants’ protective orders . . . do not bar Dechert from participating in the *inter partes* review proceedings as long as Dechert is not involved in claim amendment.”); *Prolitec Inc. v. ScentAir Tech., Inc.*, 945 F. Supp. 2d 1007, 1012 (E.D. Wis. 2013) (allowing patent-holder’s litigation counsel to participate in IPRs, so long as they are not involved in amending, substituting, or adding claims); *Certain Activity Tracking Devices, Systems, & Components Thereof*, Inv. 337-TA-963, Order No. 7, Ex. A, at § D (Oct. 2, 2015) (“These prohibitions are not intended to and shall not preclude counsel from participating in reexamination or reissue proceedings on behalf of a party challenging or defending the validity of any patent, but are intended, *inter alia*, to preclude patentee’s counsel from participating in the drafting of any claim amendments in reexamination or reissue proceedings.”).

Tessera argues that any prosecution bar should exclude post-grant review proceedings in their entirety because in such proceedings patent holders are allowed to make only amendments that narrow the scope of the claims and the amendments must be supported by the existing specification. Response at 18. This argument, however, is unpersuasive. Although the ability of a patent-holder to amend claims in post-grant review proceedings is limited in certain respects, “claims may still be restructured . . . in a way that would undoubtedly benefit from access to an alleged infringer’s proprietary information.” *Software Right Archive v. Facebook, Inc.*, 2014 WL 116366, at \*2 (N.D. Cal. 2014).

## PUBLIC VERSION

### **3. The subject matter covered by the bar is commensurate with the scope of this investigation.**

The subject matter covered by the bar must reasonably reflect the risk of inadvertent misuse of technical CBI produced in this investigation. *Deutsche Bank*, 605 F.3d at 1381 (holding that “the subject matter covered by the bar [must] reasonably reflect the risk presented by the disclosure of proprietary competitive information”). The proposed bar covers four different subject matter categories: (1) semiconductor device interconnects, (2) planarization of semiconductor device surface topography, (3) packaging of semiconductor devices, and (4) the subject matter of the patents-in-suit. Proposed Prosecution Bar at ¶ 19. Tessera argues that the subject matter categories “semiconductor device interconnects,” “the packaging of semiconductor devices,” and the subject matter of the patents-in-suit are overbroad. Response at 14.<sup>5</sup>

The first three subject matter categories—“semiconductor device interconnects,” “planarization of semiconductor device surface topography,” and “packaging of semiconductor devices”—reflect the subject matter of the asserted patents. *See, e.g.*, Complaint, ¶¶ 52 (describing U.S. Patent No. 6,133,136 as “disclos[ing] and claim[ing] a structure for metal interconnects used in semiconductor packaging”); 47 (describing U.S. Patent No. 6,849,946 as “disclos[ing] and claim[ing] a semiconductor layout configuration and method that results in a more efficient planarization process for a semiconductor chip”); ¶ 42 (describing U.S. Patent No. 6,856,007 as “disclos[ing] and claim[ing] a compact and economical semiconductor chip assembly that includes a packaged semiconductor chip, a chip carrier with a metallic thermal conductor, and a circuit panel with a thermal conductor mounting”). Because the first three

---

<sup>5</sup> Tessera does not contend that the subject matter category “planarization of semiconductor device surface topography” is overbroad. Response at 14.

## PUBLIC VERSION

categories cover the subject matter of the asserted patents, the fourth category—“the subject matter of . . . the patents-in-suit”—is redundant and will not be included in the amended protective order.

While Tessera argues that the subject matter categories “semiconductor device interconnects” and “the packaging of semiconductor devices” are overbroad, its assertion is conclusory. Response at 14. Tessera is seeking and obtaining discovery commensurate with the scope of the asserted patents. *See, e.g.*, Tessera’s Motion to Compel (Motion Docket No. 1010-030). As discussed above, the subject matter categories set forth in the proposed prosecution bar mirror the subject matter of the asserted patents.

Based on the foregoing, I find that the subject matter of Broadcom’s proposed prosecution bar reflects the subject matter at issue in this investigation. Accordingly, the proposed bar reasonably reflects the risk of technical CBI being inadvertently misused.

#### **4. The proposed duration reflects the risk of inadvertent misuse of CBI.**

The duration of a proposed bar must reasonably reflect the risk of inadvertent misuse of CBI. *Deutsche Bank*, 605 F.3d at 1381 (holding that “the duration of the bar . . . [must] reasonably reflect the risk presented by the disclosure of proprietary competitive information”). The proposed prosecution bar remains in effect for “two (2) years after the earlier of (i) the final resolution or termination of this investigation, including all appeals, or (ii) the withdrawal of that attorney from the Protective Order.” Proposed Prosecution Bar, ¶ 19. Tessera relies on *Certain Electronic Devices with Communication Capabilities, Components Thereof, and Related Software*, Inv. No. 337-TA-808 (“*Certain Electronic Devices*”), Order No. 12 at 4 (Apr. 4, 2012) to argue that the duration is unreasonable. Response at 14-15.

Tessera’s reliance on *Certain Electronic Devices* is misplaced for two reasons. First, administrative law judges presiding in other investigations—including the one who presided in

**PUBLIC VERSION**

*Certain Electronic Devices*—have routinely entered prosecution bars extending two years after the completion of the investigation. *See, e.g., Certain Set-Top Boxes, Gateways, Bridges, & Adapters & Components Thereof*, Inv. 337-TA-915, Order No. 10 (Aug. 5, 2014).

Second, Tessera fails to address a fundamental difference between the proposed bar in *Certain Electronic Devices* and Broadcom's proposed bar. The proposed bar in *Certain Electronic Devices* did not allow attorneys or experts to withdraw from the protective order prior to the termination of the investigation. Rather, anyone who had subscribed to the protective order was barred from prosecution activities for two years after the investigation's termination. *Certain Electronic Devices*, Apple's Motion to Amend Protective Order (Jan. 25, 2012), Ex. A at 3. Thus, under the bar proposed in *Certain Electronic Devices*, attorneys who subscribed to the protective order would have been barred from prosecuting patents for upwards of five years, even if they stopped working on the case and accessing CBI prior to the termination of the case. *Certain Electronic Devices*, Order No. 12 at 4. Unlike the bar rejected in *Certain Electronic Devices*, the bar proposed by Broadcom allows attorneys and experts to withdraw from the protective order prior to the termination of the investigation. Anyone who elects to do so is barred from prosecution activities for only two years from the date of his or her withdrawal. Tessera does not contend that this duration is unreasonable.

Based on the foregoing, I find the duration of Broadcom's proposed prosecution bar reasonably reflects the risk of CBI being inadvertently misused.

**C. Tessera has not made the requisite showing for exemptions to the prosecution bar.**

Circumstances may warrant exempting particular individuals from the prosecution bar. *Deutsche Bank*, 605 F.3d at 1381. For such exemptions, Tessera must show that (1) the individual's activities before the PTO do not constitute competitive decisionmaking and (2) the potential injury to Tessera from subjecting the individual to the prosecution bar outweighs the

## PUBLIC VERSION

potential injury to Broadcom from inadvertent misuse of its technical CBI. *Id.* The bar prohibits only prosecution activities that constitute competitive decisionmaking. Proposed Prosecution Bar, ¶ 19. Tessera concedes that other than post-grant review proceedings, it is unlikely that its trial counsel will be performing the proscribed activities. Response at 15 (“However, Respondents make no showing that any individual attorney litigating this Investigation is actively engaged in competitive decision making that would warrant a prosecution bar.”).

With regard to post-grant review proceedings, as discussed above, Tessera’s trial counsel will still be able to participate in most aspects of such proceedings. The only potential impact on Tessera’s trial counsel is that they would be unable to participate in amending claims. Whether claims will in fact be amended during a post-grant review proceeding is uncertain and highly speculative. Further, as discussed above, amending claims during post-grant review proceedings carries with it the risk of inadvertent use of technical CBI. *Software Right Archive*, 2014 WL 116366, at \*2. Thus, even if claims are amended during post-grant review proceedings, the potential injury to Broadcom from inadvertent misuse of its technical CBI outweighs any potential injury to Tessera.

## II. AMENDMENT TO THE PROTECTIVE ORDER

The Protective Order (Order No. 1) is hereby amended to include the following provisions relating to a prosecution bar:<sup>6</sup>

19. **Prosecution Bar** Any attorney, patent agent, expert, or other person who has subscribed to the Protective Order (Order No. 1) on behalf of any party in this Investigation or has otherwise accessed technical material designated by another party as “CONFIDENTIAL

---

<sup>6</sup> On September 26, the Protective Order (Order No. 1) was amended to include provisions relating to GDS files. Order No. 38.

## PUBLIC VERSION

BUSINESS INFORMATION SUBJECT TO PROTECTIVE ORDER” and/or “CONFIDENTIAL SOURCE CODE-ATTORNEYS’ EYES ONLY INFORMATION” which relates to the structure, operation, function, design, or development of any existing or potential product (and does not promptly unsubscribe after the ALJ grants the motion to amend the Protective Order in this Investigation to include the instant paragraph)<sup>7</sup> shall not be involved in Patent Prosecution on behalf of the party represented by that person or one of such party’s affiliates relating to the subject matter of (i) semiconductor device interconnects, (ii) planarization of semiconductor device surface topography, and (iii) the packaging of semiconductor devices (hereinafter collectively referred to as “Semiconductor Devices”) before any foreign or domestic agency, including the United States Patent and Trademark Office. For the purposes of this paragraph, “Patent Prosecution” shall be defined as substantive patent prosecution activities involving “competitive decisionmaking” as set forth by the Federal Circuit in *In re Deutsche Bank Trust Co. Americas*, 605 F.3d 1373, 1378 (Fed. Cir. 2010), such as supervising, assisting or participating in (including preparing, drafting, amending, filing, or otherwise prosecuting applications, claims, responses to office actions, oaths or declarations, or any other paper) the prosecution of any pending or future patent application before the United States Patent and Trademark Office or any other patent foreign or domestic authorities, with respect to any patent application of the represented party claiming (in whole or in part) the subject matter of: (a) Semiconductor Devices; or (b) any of the parents (grand-parents or other predecessor applications in the chain) or descendants of the patents-in-suit (“Related Patents”).

---

<sup>7</sup> Any person who unsubscribes from the Protective Order for the purpose of avoiding the prosecution bar described in the instant paragraph must certify that he/she did not access any technical material relating to the structure, operation, function, design, or development of any existing or potential product designated as “Confidential Business Information.”

## PUBLIC VERSION

“Patent Prosecution” shall not include representing a party or otherwise participating in reissue proceedings, *ex parte* reexamination, *inter partes* review, covered business method review, or post-grant review proceedings (“Post-Grant Proceedings”) provided such representation or other participation does not include any involvement in seeking amendment of any claims on behalf of the represented party. This prohibition on Patent Prosecution shall end two (2) years after the earlier of (i) the final resolution or termination of this investigation, including all appeals, or (ii) the withdrawal of that attorney from the Protective Order. This paragraph supplements Order No. 1 in this Investigation, and nothing in this paragraph is intended to weaken the protections afforded by Order No. 1. This prosecution bar is personal to the person subscribing to the Protective Order in this Investigation and shall not be imputed to any other person or entity.

### III. CONCLUSION

For the foregoing reasons, Broadcom’s motion to amend the protective order (Motion Docket No. 1010-039) is GRANTED-IN-PART to the extent indicated above.

This Order is being issued with a confidential designation, and pursuant to Ground Rule 1.10, each party shall submit to the Administrative Law Judge a statement as to whether or not it seeks to have any portion of this order deleted from the public version within seven (7) days. *See* 19 C.F.R. § 210.5(f). A party seeking to have a portion of the order deleted from the public version thereof must attach to its submission a copy of the order with red brackets indicating the portion(s) asserted to contain confidential business information.<sup>8</sup> The parties’ submissions under

---

<sup>8</sup> To avoid depriving the public of the basis for understanding the result and reasoning underlying the decision, redactions should be limited. Parties who submit excessive redactions may be required to provide an additional written statement, supported by declarations from individuals with personal knowledge, justifying each proposed redaction and specifically explaining why the information sought to be redacted meets the definition for confidential business information set forth in Commission Rule 201.6(a).

**PUBLIC VERSION**

this subsection shall not be filed with the Commission Secretary but shall be submitted by paper copy to the Administrative Law Judge and by e-mail to the Administrative Law Judge's attorney advisor.

**SO ORDERED.**



---

Dee Lord  
Administrative Law Judge

**PUBLIC CERTIFICATE OF SERVICE**

I, Lisa R. Barton, hereby certify that the attached **ORDER** has been served by hand upon the following parties as indicated, on **October 24, 2016**



Lisa R. Barton, Secretary  
U.S. International Trade Commission  
500 E Street, SW, Room 112  
Washington, DC 20436

**On Behalf of Complainants Tessera Technologies, Inc., Tessera, Inc., and Invensas Corporation:**

Sturgis M. Sobin, Esq.  
**COVINGTON & BURLING LLP**  
One CityCenter, 850 Tenth Street, N.W.  
Washington, DC 20001

- Via Hand Delivery  
 Via Express Delivery  
 Via First Class Mail  
 Other: \_\_\_\_\_

**On Behalf of Respondents Broadcom Limited, Broadcom Corporation, Avago Technologies Limited, Avago Technologies U.S. Inc., ARRIS International plc, ARRIS Group, Inc., ARRIS Technology, Inc., ARRIS Enterprises Inc., ARRIS Solutions, Inc., Pace Ltd., Pace Americas, LLC, Pace USA, LLC, HTC Corporation, HTC America, Inc., NETGEAR, Inc., Arista Networks, Inc., Technicolor S.A., Technicolor USA, Inc., Technicolor Connected Home USA LLC, Comcast Cable Communications, LLC, Comcast Cable Communications Management, LLC, and Comcast Business Communications, LLC:**

David E. Sipiora, Esq.  
**KILPATRICK TOWNSEND & STOCKTON LLP**  
1400 Wewatta Street, Suite 600  
Denver, CO 80202

- Via Hand Delivery  
 Via Express Delivery  
 Via First Class Mail  
 Other: \_\_\_\_\_

**On Behalf of Respondents ASUSTeK Computer Inc. and ASUS Computer International:**

Lyle B. Vander Schaaf, Esq.  
**BRINKS GILSON & LIONE LLP**  
1775 Pennsylvania Avenue, NW, Suite 900  
Washington, DC 20006

- Via Hand Delivery  
 Via Express Delivery  
 Via First Class Mail  
 Other: \_\_\_\_\_