

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

UNIOLOC 2017 LLC,
Patent Owner.

Case IPR2019-01116
Patent 7,016,676 B2

Before JAMESON LEE, KEVIN F. TURNER, and
MICHELLE N. WORMMEESTER, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

ORDER
Conduct of Proceeding
37 C.F.R. § 42.5

IPR2019-01116
Patent 7,016,676 B2

Introduction

On January 3, 2020, Ericsson Inc. (“Ericsson”) filed a petition for *inter partes* review of US Patent No. 7,016,676 B2 (“the ’676 patent”) and a Motion for Joinder (“Joinder Motion”) with the instant case, IPR2019-01116, which also involves the ’676 patent. IPR2020-00376, Papers 2, 3.

The Board conducted a conference call with the parties in IPR2019-01116 on January 15, 2020. The initially scheduled participants were Judges Lee, Turner, and Wormmeester, counsel for Petitioner and counsel for Patent Owner. Counsel for Ericsson, however, also was present. Counsel for Patent Owner, Mr. Brett Mangrum, represented that he also represents the patent owner in IPR2020-00376, the same patent owner as in IPR2019-01116. Petitioner (hereinafter “Microsoft”) and Patent Owner did not object to participation in the conference call by the parties in IPR2020-00376. Thus, the conference call expanded to include the participation of counsel for Ericsson, and with Mr. Mangrum also as counsel for the patent owner in IPR2020-00376.

In the Joinder Motion, Ericsson states that “Petitioner in the Microsoft IPR [IPR2019-01116] does not oppose Ericsson’s instant motion.” IPR2020-00376, Paper 3, 1. Ericsson also represents that “so long as Microsoft remains an active party in the joined proceeding,” “[a]ll filings by Ericsson in the joined proceeding shall be consolidated with the filings of Microsoft unless a filing solely concerns issues that do not involve Microsoft.” *Id.* at 8. We are not certain what has been proposed by Ericsson or what has been agreed to by Petitioner, and sought clarification through the conference call.

Discussion

It would seem that Ericsson would have few occasions, if any, but for rare exceptions involving issues directed solely to Ericsson, to make any substantive filing in the joined proceeding, if it merely is taking an “understudy” role, as Ericsson asserts in the Joinder Motion. We are uncertain what is meant by “[a]ll filings by Ericsson in the joined proceeding shall be consolidated with the filings of Microsoft.”

For instance, that could mean Ericsson will prepare its own substantive filings and have that material included within a “joint paper” that also includes separately the substantive arguments and assertions of Petitioner. That kind of “consolidation” substantially increases the complexity of the proceeding. Alternatively, the alleged “consolidation” could mean a filing with all positions therein binding on both Microsoft and Ericsson, and agreed to by both Microsoft and Ericsson prior to filing.

We explained on the conference call that, in our view, an “understudy role,” if taken by Ericsson, means Ericsson will not be making any substantive filings and will be bound by whatever substantive filings Microsoft makes, so long as Microsoft remains a party in the proceeding. The same is true for oral hearing presentations. Also, Ericsson will not seek to take cross-examination testimony of any witness or have a role in

defending the cross-examination of any witness,¹ so long as Microsoft remains a party in the proceeding. Likewise with other discovery matters. If and when Microsoft's participation in the proceeding terminates, Ericsson can make its own filings as Petitioner. In short, in its "understudy role," Ericsson will remain completely inactive, but for issues that are solely directed and pertinent to Ericsson. The bullet points on pages 8 and 9 of the Joinder Motion are not consistent with our understanding of an "understudy" role.

Counsel for Ericsson explained during the conference call that the Board's understanding of an "understudy role" is what Ericsson had intended to express in the Joinder Motion. Counsel for Microsoft likewise indicated that what Microsoft had agreed to as an understudy role for Ericsson is what the Board understands as an understudy role. Counsel for Ericsson requested permission to file, in IPR2020-00376, a Supplemental Joinder Motion to make all necessary clarification. We suggested that Ericsson work together with Patent Owner to prepare a Supplemental Joinder Motion to clarify the "understudy role" requested, to minimize, if possible, objections from Patent Owner. Per our order below, we will authorize the filing of a Supplemental Joinder Motion in IPR2020-00376 after Patent Owner has filed its

¹ A possible exception exists only with respect to defending the potential cross-examination by Patent Owner of Jennifer Stephens, a librarian with the law firm of Haynes and Boone, LLP, regarding the dates of publication of certain references. Her declaration is filed in IPR2020-00376 as Exhibit 1011 and she does not provide testimony in the IPR2019-01116 proceeding.

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Mandatory Notices in response to the Notice of Filing Date Accorded to the petition in that proceeding.

ORDER

It is

ORDERED that an order authorizing the filing of a Supplemental Joinder Motion by Ericsson will be forthcoming in IPR2020-00376; and

FURTHER ORDERED that no Supplemental Joinder Motion shall be filed by Ericsson until a specific order authorizing such has been entered in IPR2020-00376.

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