Filed: December 12, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC.,

PETITIONER,

v.

BELL NORTHERN RESEARCH, LLC,

PATENT OWNER.

Case No. IPR2020-00108
U.S. Patent No. 8,416,862

PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION FOR JOINDER

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IPR2017-01923, Paper 14 (PTAB May 4, 2018)..7

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I. INTRODUCTION

Patent Owner Bell Northern Research, LLC ("BNR" or "Patent Owner") opposes Petitioner LG Electronics, Inc.'s ("LG" or "Petitioner") motion for joinder (IPR2020-00182, Paper 3 ("LG Mot.")) seeking to join *Huawei Technologies Co., Ltd. v. Bell Northern Research, LLC*, IPR2019-01439 ("the Huawei IPR").

As an initial matter, there are key facts pertaining to the Huawei IPR that LG neglected to tell the Board. On October 23, 2019, after court-supervised mediation between Patent Owner and Huawei, those parties settled the then-pending litigation between them in its entirety, including Patent Owner's lawsuit regarding the '862 Patent. It is a near certainty that LG knew of the settlement because, not only was there a publicly filed order by the district court stating that the case had settled, LG and Huawei are **represented by the same law firm**. Thus, LG, recognizing that the Huawei settlement would likely mean that the parties agreed to request termination of all IPR proceedings Huawei had initiated, sought to "skip the line" and join the Huawei proceeding in an attempt to ensure that it would continue despite the likely impending termination motions. This is the only explanation for LG's motion, because if LG had a true interest in joining the Huawei IPR for the reasons it claims in its brief, it would have either filed a joinder motion months ago—the Huawei IPR was filed in August 2019, and Patent Owner's litigation against LG has been pending since December 2018—or would have waited until

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an institution decision, which is what the statute contemplates and is the most common in practice.

However, notwithstanding LG's true motivation for its joinder motion, LG fails to put forth a sufficient showing that joinder is warranted or justified. ***First***, as a threshold issue, the Huawei IPR must be instituted before LG can join that proceeding. The joinder statute requires that institution of a proceeding is a **condition precedent** before a party later filing a petition under section 311 may join as a party. *See* 35 U.S.C. § 315(c). But the Huawei IPR has **not** been instituted. Moreover, the probability of the Huawei IPR being instituted is low because the parties in the Huawei IPR jointly moved to terminate the Huawei IPR following settlement. *See* IPR2019-01439, Paper No. 7 (filed Dec. 6, 2019). While Patent Owner recognizes that the Board has the discretion despite the parties' preferences, the Board's practice with respect to other cases and including other IPRs that Huawei filed is that the Board accepts the parties' requests and terminates the proceeding. *See* IPR2019-01172, Paper 15 (termination decision); IPR2019-01175, Paper 15 (termination decision). And to the extent LG's motion seeks to influence the proceedings in the Huawei IPR, such interference is inappropriate and does not independently warrant maintaining the Huawei IPR. Without the Huawei IPR, LG's joinder motion is moot and properly denied on this

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