UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC.,
Petitioner

v.

UNILOC 2017 LLC
Patent Owner

IPR2020-00315
U.S. PATENT NO. 7,075,917

PATENT OWNER OPPOSITION TO MOTION FOR JOINDER

I. INTRODUCTION

The '917 patent has not and is presently not the subject of any district court litigation. On April 19, 2019, Microsoft filed an IPR petition challenging claims 1–3 and 9 and 10 of the '917 Patent. *See Microsoft Corporation v. Uniloc 2017 LLC*, IPR2019-00973 (the "Microsoft IPR"), Paper 2 at 1. Ericsson seeks to join the Microsoft IPR. *See generally* Paper 3 ("Mtn."). Ericsson acknowledged conferring with Microsoft regarding Ericsson's petition and motion *before* filing, though Ericsson does not name Microsoft as a real party in interest. *See* Mtn. 1 ("Petitioner in the Microsoft IPR does not oppose Ericsson's instant motion").

While Ericsson asserts that, if joined, it will take an "understudy' role" (Mtn. 1), in another IPR matter involving the same parties,[1] the Board recently considered and rejected Ericsson's same definition for "understudy" as impermissibly reserving the right to actively participate, regardless whether the original petitioner (Microsoft) has been terminated.

II. ARGUMENT

As the moving party, Ericsson has the burden of proof to establish that it is entitled to the requested relief. 37 C.F.R. §§ 42.20(c), 42.122(b). When determining whether to grant a motion for joinder, the Board considers factors including: (1) time and cost considerations, including the impact joinder would have on the trial schedule; and (2) how briefing and discovery may be simplified. *See* Order

[1] *Ericsson Inc. v. Uniloc 2017 LLC*, IPR2020-00376, Paper 8 (PTAB January 21, 2020) ("Conduct Order").

Authorizing Motion for Joinder (Paper 15, 4), *Kyocera Corp. v. SoftView, LLC*, IPR2013-00004 (PTAB Apr. 24, 2013).

Even when a party seeks to join a nearly identical petition, joinder should not be granted as a matter of right. *See* 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b); 157 CONG. REC. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) ("The Director is given discretion . . . over whether to allow joinder. This safety valve will allow the Office to avoid being overwhelmed if there happens to be a deluge of joinder petitions in a particular case.").

Here, Ericsson's motion should be denied for the same reasons articulated by the Board in the Conduct Order (issued just today) involving the same parties. *See Ericsson Inc. v. Uniloc 2017 LLC*, IPR2020-00376, Paper 8 (PTAB January 21, 2020) ("Conduct Order"); *see also Microsoft Corp. v. Uniloc 2017 LLC*, IPR2019-01116, Paper 10 at 3-5 (PTAB January 16, 2020) (referencing the Conduct Order). Specifically, Ericsson's motion should be denied at least because Ericsson purports to reserve impermissible for a joinder petitioner rights by offering the same rejected definition for "understudy" which risk causing undue prejudice to Patent Owner.

In another IPR matter involving the same parties, the Board very recently considered Ericsson's same definition for "understudy" and found it permissive of active participation that does not comport with a true "understudy" role. *Ericsson Inc. v. Uniloc 2017 LLC*, IPR2020-00376, Paper 8 (PTAB January 21, 2020) ("Conduct Order"); *see also Microsoft Corp. v. Uniloc 2017 LLC*, IPR2019-01116, Paper 10 at 3-5 (PTAB January 16, 2020) (referencing the Conduct Order).

Specifically, the Board summarized the Board found the same definition for "understudy" Ericsson repeats here as leaving upon the possibility for the joinder petitioner to play an active role, regardless whether the original petitioner has been terminated from the proceeding. *Id*.

There, the Board first addressed language analogous to what is presented in Ericsson's instant motion as follows: "all filings by [the joinder petitioner] in the joined proceeding be consolidated with [the filings of the original petitioner in the Microsoft IPR] unless a filing solely concerns issues that do not involve [the original petitioner in the Microsoft IPR]." Mtn. 8. The Board observed that such language, on its face, purports to reserve the right to participate in filings. Conduct Order 2–3.

The Board questioned whether such participation might impermissibly include allowing a joinder petitioner to "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." *Id*. This clearly would "substantially increase[s] the complexity of the proceeding." *Id*.

The Board further questioned whether an "understudy" defined in the same manner at issue here would be allowed to actively participate in drafting filings, "with all positions therein binding on both [original petitioner] and [joinder petitioner], and agreed to by both [original petitioner and joinder petitioner] prior to filing." *Id*. Such active participation exceeds a true "understudy" role. *Id*.

The Board further addressed other questionable language analogous to what is presented in Ericsson's instant motion as follows: "[Petitioner] at deposition shall not receive any direct, cross-examination or redirect time beyond that permitted for [the petitioner in the Microsoft IPR] alone under either 37 C.F.R. § 42.53 or any agreement between [Patent Owner] and [the petitioner in the Microsoft IPR]." Mtn. 7 (brackets original); *see also* Conduct Order 2–3. The Board correctly recognized that such language purports to reserve the right for a joinder petitioner to use up the remainder of any direct, cross-examination or redirect time that an original petitioner opts to not use, *even though the original petitioner remains in the proceedings*. Conduct Order 2–3. The Board further explained that in a true "understudy" role, a joined petitioner would not be allowed to "seek to take cross examination testimony of any witness or have a role in defending the cross-examination of a witness, so long as Microsoft remains a party in the proceeding." *Id*.

The Board summarized a true "understudy role" as follows: "[the petitioner seeking joinder] will remain *completely inactive*, but for issues that are solely directed and pertinent to [the joinder petitioner]." *Id*. (emphasis added).

Applying the same reasoning in the Conduct Order summarized above, Ericsson's similar motion for joinder here should be denied at least because it offers the same overbroad definition for "understudy" (verbatim), which is permissive of *active* participation that does not comport with a true "understudy" role. Consequently, Ericsson's overbroad definition risks causing delay undue prejudice to Patent Owner for the same reasons.

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