

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2020-00315
Patent 7,075,917 B2

Before SALLY C. MEDLEY, KALYAN K. DESHPANDE, and
ROBERT J. WEINSCHENK, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

Granting Motion for Joinder
37 C.F.R. § 42.122(b)

I. INTRODUCTION

Ericsson Inc. (“Petitioner”) filed a Petition for *inter partes* review of claims 1–3, 9, and 10 of U.S. Patent No. 7,075,917 B2 (Ex. 1001, “the ’917 patent”). Paper 2 (“Pet.”). Petitioner also filed a Motion for Joinder with *Microsoft Corporation v. Uniloc 2017 LLC*, Case IPR2019-00973 (“the 973 IPR”). Paper 3 (“Mot.”). Uniloc 2017 LLC (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 9 (“Prelim. Resp.”). Patent Owner also filed an Opposition to the Motion for Joinder. Paper 7 (“Opp.”). Petitioner filed a Reply to Patent Owner’s Opposition. Paper 8 (“Reply”). We have authority under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

For the reasons described below, we institute an *inter partes* review of the challenged claims and grant Petitioner’s Motion for Joinder.

II. RELATED PROCEEDINGS

The parties indicate that the ’917 patent is the subject of several court proceedings and the 973 IPR. Pet. vii; Paper 5, 2. The ’917 patent also was the subject of IPR2019-00259, where a decision to not institute *inter partes* review was rendered. *Id.* The ’917 patent also is the subject of IPR2020-00224.

In the 973 IPR, we instituted an *inter partes* review of claims 1–3, 9, and 10 of the '917 patent on the following ground:

Claims Challenged	35 U.S.C. §	References
1–3, 9, 10	103(a)	TR25.825 ¹ and Abrol ²

Microsoft Corporation v. Uniloc 2017 LLC, IPR2019-00973, Paper 7 at 5, 28 (PTAB Nov. 19, 2019) (“973 Decision” or “973 Dec.”).

III. INSTITUTION OF *INTER PARTES* REVIEW

The Petition in this proceeding asserts the same ground of unpatentability as the one on which we instituted review in the 973 IPR. *Compare* Pet. 3, with 973 Dec. 5, 28. Indeed, Petitioner contends that the Petition “is substantively identical to the Microsoft Petition. The only minor changes reflect changes necessary for proper identification of the party filing the petition and corresponding documents.” Mot. 3–4. Petitioner further explains that it relies on the same technical expert and a substantively identical declaration from that expert. *Id.* at 6. Petitioner does rely on a different “3GPP expert” as the one in the 973 IPR, but contends that its 3GPP expert declaration “is substantially identical as Mr. Rodermund’s declaration in the Microsoft IPR.” *Id.* at 7 n.2.

We have considered Patent Owner’s Preliminary Response. Prelim. Resp. 1–41. Certain of Patent Owner’s arguments and evidence supporting its position that claims 1–3, 9, and 10 would not have been obvious were previously addressed in the 973 Decision, and we need not address them

¹ 3G TR 25.835 V1.0.0 (2000-09) – 3rd Generation Partnership Project; Technical Specification Group Radio Access Network; Report on Hybrid ARQ Type II/III (Release 2000) (Ex. 1005, “TR25.835”).

² US 6,507,582 B1, issued Jan. 14, 2003 (Ex. 1007, “Abrol”).

here again. Certain other arguments against the merits of the Petition closely mirror arguments made in the Patent Owner Response filed in the 973 IPR (*compare* Prelim. Resp. 27–30, *with* 973 IPR Paper 9, 28–31). Those common arguments will be fully considered in the 973 IPR after Microsoft has filed its Reply and Patent Owner has filed its Sur-Reply, and with the benefit of a complete record. Based on the record before us, Patent Owner’s Preliminary Response arguments do not persuade us that Petitioner has not demonstrated a reasonable likelihood of success in prevailing on the same ground as instituted in the 973 IPR.

Accordingly, we institute an *inter partes* review on the same ground as the one on which we instituted review in the 973 IPR.

IV. GRANT OF MOTION FOR JOINDER

The Petition in this proceeding was accorded a filing date of December 18, 2019. *See* Paper 4. The 973 IPR was instituted on November 19, 2019. Petitioner filed a Motion for Joinder on December 18, 2019. Paper 3. Thus, Petitioner’s Motion for Joinder is timely because joinder was requested no later than one month after the November 19, 2019 institution date of the 973 IPR. *See* 37 C.F.R. § 42.122(b).

The statutory provision governing joinder in *inter partes* review proceedings is 35 U.S.C. § 315(c), which reads:

If the Director institutes an *inter partes* review, the Director, in his or her discretion, may join as a party to that *inter partes* review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an *inter partes* review under section 314.

A motion for joinder should (1) set forth reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. *See Kyocera Corp. v. Softview LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15).

The Petition in this case asserts the same unpatentability ground on which we instituted review in the 973 IPR. *See Mot. 5*. Petitioner further explains that it relies on the same prior art analysis and declaration from the same technical expert and a nearly identical 3GPP declaration. *Id.* at 6–7. Thus, this *inter partes* review does not present any ground or matter not already at issue in the 973 IPR.

If joinder is granted, Petitioner anticipates participating in the proceeding in a limited capacity absent termination of the petitioner (Microsoft) in the 973 IPR as a party. *Id.* at 8–9. Petitioner agrees to assume an “understudy” role in the 973 IPR, unless “Microsoft ceased participation in the proceeding.” *Id.* at 9. Petitioner further represents that it will not “raise any new grounds not already instituted by the Board in the Microsoft IPR, or introduce any argument or discovery not already introduced by Microsoft.” *Id.* at 8. Because Petitioner expects to participate only in a limited capacity, Petitioner submits that joinder will not impact the trial schedule for the 973 IPR. *Id.* at 6.

Patent Owner argues that “Ericsson purports to reserve . . . rights” by its definition for “understudy” which risks causing undue prejudice to Patent Owner. *Opp. 2*. Patent Owner further argues that a true “understudy role” is one in which the petitioner remains “completely inactive.” *Id.* at 4.

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