

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

IPR2020-00376
U.S. Patent No. 7,016,676

PETITIONER'S NOTICE REGARDING FILING TWO PETITIONS

Pursuant to the Consolidated Trial Practice Guide dated November 2019, Ericsson Inc. (“Ericsson” or “Petitioner”) submits this notice of ranking and explanation of the differences between its petitions challenging various claims of U.S. Patent No. 7,016,676 to Walke (“the ’676 patent”) for the Board’s consideration.

Over four months ago, Petitioner filed a single IPR petition challenging claims 1, 2, and 8 of the ’676 patent. Now, as described in Petitioner’s Motion for Joinder filed concurrently herewith, Petitioner seeks to join a recently instituted IPR (IPR2019-01116) challenging claims 1 and 2 in an “understudy” role. *See Microsoft Corp. v. Uniloc 2017 LLC*, IPR2019-01116, Paper 8 (PTAB Dec. 4, 2019) (Institution Decision) (“the Microsoft IPR”). As such, Petitioner has filed an IPR petition that is substantively identical to the petition instituted in the Microsoft IPR.

Given that Petitioner’s second petition is a joinder petition, Ericsson’s two petitions are not the sort of parallel petitions contemplated by the Trial Practice Guide as placing “a substantial and unnecessary burden on the Board and the patent owner.” Consolidated Trial Practice Guide at 59. Regardless, Petitioner files this ranking paper out of an abundance of caution.

Ranking of the Petitions

Although Petitioner believes both petitions have merit, Petitioner requests that the Board rank the petitions in the following order and not use its discretion to deny any petition:

Rank	Petition	Claims
A	IPR2019-01550 (“Petition 1”), filed August 29, 2019	Claims 1, 2, and 8
B	IPR2020-00376 (“Petition 2”), filed concurrently herewith	Claims 1 and 2

Explanation of the Differences Between the Petitions

Petitioner's two IPR petitions have two primary differences: (1) the set of claims challenged; and (2) the prior art asserted.

First, the claims challenged in the two IPR petitions do not wholly overlap. Petition 1 challenges claims 1, 2, and 8 asserted against Ericsson in the parallel district court litigation, while Petition 2 challenges only claims 1 and 2. To the extent the challenged claims overlap, this was not of Petitioner's choosing; rather, Petition 2 is merely a joinder petition that mirrors the challenges raised in the Microsoft IPR and therefore challenges the claims Microsoft chose to challenge.

Second, as shown in Table 1 below, the prior art references relied on in each petition are almost entirely different:

Table 1

IPR2019-01550 Claims	References
1, 2	§ 103: Shellhammer
8	§ 103: Shellhammer and Haartsen
8	§ 103: Shellhammer and Panasik
1, 2	§ 103: Lansford
IPR2020-00376 Claims	
1, 2	§ 103: HomeRF
1, 2	§ 103: HomeRF and HomeRF Tutorial
1, 2	§ 103: HomeRF and HomeRF Liaison Report
1, 2	§ 103: Lansford

All but one ground in Petition 1 relies on Shellhammer as the primary obviousness reference, while all but one ground in Petition 2 relies on HomeRF as the primary obviousness reference. Although both petitions raise Lansford as an independent ground, again, this is simply because Petition 2 is a joinder petition that intentionally mirrors the petition in the Microsoft IPR.

The Board should institute Petition 1 and Petition 2

The Board should institute Petition 1 and Petition 2 because doing so would not be redundant consideration of the same grounds or claims, nor would it place a substantial or unnecessary burden on the Board or Patent Owner.

First, Petition 1 and Petition 2 are not redundant. Petition 1 challenges an additional claim—claim 8—that Patent Owner has asserted against Ericsson's products in litigation. Moreover, although claims 1 and 2 are challenged in both

petitions, the prior art references relied upon are largely different between the two petitions.

It is critical that Ericsson have an opportunity to challenge claims 1, 2, and 8 because Patent Owner has asserted each of those three claims against Ericsson's products in district court litigation. For this reason, Petitioner requests that the Board at least institute Petition 1, which addresses all three of the claims asserted against Ericsson's products. Instituting only Petition 2 (and not Petition 1) on non-substantive grounds would deny Petitioner the forum Congress created to address patentability issues in a speedy and cost-effective manner.

Second, instituting both petitions would not place a substantial or unnecessary burden on the Board or Patent Owner. Unlike a true "parallel petition" scenario, here, the Board has already instituted an IPR that is substantively identical to the IPR requested by Petition 2. Thus, instituting Petition 2 would not add any additional burden to the Board or to Patent Owner, as Petitioner has agreed to act in an "understudy" capacity. As a result, the trial schedule for the IPR requested by Petition 2 should be the same as the Microsoft IPR, as explained in Petitioner's associated motion for joinder.

Conclusion

In sum, because Ericsson's second petition is a joinder IPR petition, Petitioner's two petitions do not raise any concerns regarding fairness, timing, or

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