

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC.,
Petitioner,

v.

UNIOLOC 2017 LLC,
Patent Owner.

Case IPR2020-00376
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

On January 3, 2020, Petitioner (“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 proceeding in IPR2019-01116 which also involves the ’676 patent. Papers 2, 3.

In the Joinder Motion, Ericsson states that “Petitioner in the Microsoft IPR [IPR2019-01116] does not oppose Ericsson’s instant motion.” Paper 3, 1. Petitioner 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 and seek clarification through this communication.

It would seem that Ericsson would have few occasions, if any, to make any substantive filing in the joined proceeding, if it merely is taking an “understudy” role as Ericsson asserts in the Joinder Motion. *Id.* 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 Microsoft. 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. It is uncertain whether Microsoft has agreed to that arrangement.

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 a witness, 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.

ORDER

It is

ORDERED that Petitioner is required to submit a Supplemental Joinder Motion, within seven days of the date of this Order, to clarify the matters discussed above;

FURTHER ORDERED that the parties may arrange a joint conference call with the Board to discuss any of the above-noted matters, prior to Petitioner’s filing of the Supplemental Joinder Motion;

FURTHER ORDERED that the Petitioner and Patent Owner are encouraged to reach agreement on the above-noted matters prior to filing of the Supplemental Joinder Motion by Petitioner, and to indicate in the Supplemental Joinder Motion such agreement if agreement is reached;

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FURTHER ORDERED that the Supplemental Joinder Motion shall clearly indicate specifically what terms have been agreed to by Microsoft with respect to the requested joinder, if there is any such agreement;

FURTHER ORDERED that Patent Owner's opposition to the Joinder Motion as modified by the Supplemental Joinder motion, if any, is due one week after the filing of Petitioner's Supplemental Joinder Motion; and

FURTHER ORDERED that Patent Owner will inform the Board within one week of the filing of Petitioner's Supplemental Joinder Motion whether Patent Owner intends to waive the filing of a preliminary response in this proceeding.

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