

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

**PATENT OWNER OPPOSITION TO
SUPPLEMENTAL MOTION FOR JOINDER**

I. Joinder should be denied at least because Ericsson refused to fully address deficiencies in its overbroad definition for “understudy”

The Board should deny Petitioner Ericsson’s Supplemental Motion for Joinder (Paper 9) as failing to cure the several deficiencies the Board identified in Ericsson’s original Motion for Joinder (Paper 4). *See* Order on the Conduct of Proceeding (Paper 8 or “Order”).

On January 15, 2020, the Board held a conference call with counsel for Patent Owner, counsel for Microsoft, and counsel for Ericsson regarding Ericsson’s original Motion to Join IPR2019-01116. The Board explained during the call, and reiterated in its subsequent Order, that Ericsson’s original definition for “understudy” improperly permits active participation, regardless whether the original petitioner (Microsoft) has been terminated. Consequently, such a definition does not comport with a *true* “understudy” role.

Among other issues, the Board questioned whether Ericsson’s definition for “understudy” purports to reserve the right for Ericsson to actively participate in the *drafting* of filings, including the positions contained therein. *See* Order at 2. After addressing other deficiencies in Ericsson’s original Motion, the Board offered the following helpful explanation of how it expected a true “understudy” role to be defined: “[i]n short, in its ‘understudy role,’ Ericsson *will remain completely inactive*, but for issues that are solely directed and pertinent to Ericsson.” *Id.* at 3 (emphasis added).

Joinder should be denied because Ericsson failed to fully avail itself of the opportunity to correct the deficiencies in its original Motion. Even worse, and as an

additional basis for denial, Ericsson's Supplemental Motion misstates Patent Owner's positions and concerns, which Patent Owner had expressed in a good faith effort to reach agreement before Ericsson filed its Supplemental Motion.

In communication between counsel, which the Board encouraged in its Order, the parties reached an impasse over two main concerns with Ericsson's revised definition for "understudy" set forth in its Supplemental Motion. First, Ericsson refused to accept Patent Owner's proposed compromise language stipulating that "Ericsson shall not participate *in the drafting of any filing*" while the original petitioner (Microsoft) remains active in IPR2019-01116. Patent Owner explained that this proposed stipulation comports with the Board's instruction summarized above and generally captured by the Board's instruction that "Ericsson will remain completely inactive." *Id.* That Ericsson refused to agree to this straightforward stipulation confirms that, if joined, Ericsson will seek to actively participate in the drafting of filings in IPR2019-01116. Contrary to what Ericsson suggests in its Supplemental Motion, Patent Owner never characterized the proposed stipulation as somehow precluding *any* communication between Ericsson and Microsoft for *any* reason.

Second, Ericsson refused to accept Patent Owner's proposed compromise language stipulating that Ericsson will not file its own *appeal briefs*, if the original petitioner (Microsoft) remains active through appeal and files appeal briefing. Contrary to what Ericsson states in its Supplemental Motion, Patent Owner never characterized its proposed stipulation as somehow precluding Ericsson from filing a

notice of appeal (which is not a brief). Rather, Patent Owner explained it intended to protect itself against the unexpected prejudice it recently encountered in another matter, in which *both* an original petitioner *and* a joinder petitioner were authorized to file *separate appeal briefs*, thereby potentially doubling the pages to which Patent Owner is obligated to respond in a single brief. Moreover, Patent Owner invited Ericsson to propose alternative language for a stipulation that addresses this specific and very real concern. That Ericsson refused to do so only confirms that, if joined, Ericsson intends to reserve the right to file its own separate *appeal briefs*, even if the original petitioner (Microsoft) remains active through appeal and files its own appeal briefs.

Ericsson suggests that Patent Owner’s request for a stipulation concerning appeal *briefing* is unreasonable on its face. However, when Patent Owner recently expressed the exact same concerns in another matter, the petitioner seeking joinder there (Apple) at least attempted to address those concerns by offering the following stipulation: “Apple will not seek to file its own appellate brief (addressing Uniloc’s argument at Paper 7 at 7)[.]” *Apple Inc., v. Uniloc 2017 LLC*, IPR2020-00224, Paper 8 at 2.¹ Notably, the petitioner seeking joinder there (Apple) further stipulated that “it will abide by the ‘completely inactive’” role described by the Board and quoted above in the Ericsson IPR”—i.e., the Board’s Order on the Conduct of Proceeding here. *Id.* (citing Paper 8 of this matter).

¹ Apple’s stipulation is still deficient at least in that it does not further stipulate that Apple *will not file* its own appellate brief, even if one is authorized.

Ericsson has now twice failed in this matter to perfect a motion for joinder by setting forth a proper definition for a true “understudy” role. Ericsson’s refusal to avail itself of the unusual opportunity to correct the deficiencies of its original Motion should not be rewarded by granting joinder based on the still-deficient Supplemental Motion. Moreover, denial is appropriate because, as explained above, Ericsson misrepresents Patent Owner’s communications and Patent Owner’s good faith effort to reach agreement on these issues.

Finally, it is unclear whether Microsoft agrees to the risk of estoppel that would potentially attach under Ericsson’s apparent interpretation of the effect of joinder under the overbroad definition for “understudy” it proposes. Paper 9 at 2. According to Ericsson, “[s]hould the joinder motion be granted, Ericsson will be listed as a real-party-in-interest (RPI).” Paper 9 at 2. Ericsson raises this point ostensibly to justify its refusal to stipulate that it will not actively participate with Microsoft in the drafting of filings in IPR2019-01116. *Id.*

Ericsson’s apparent interpretation of the effect of joinder under such circumstances would at least risk tainting Microsoft with the effects of estoppel, should estoppel apply to Ericsson, and *vice versa*. It is doubtful Microsoft has agreed to assume such risk. Indeed, in another matter, Microsoft expressed concerns over whether estoppel of a joinder petitioner would attach to an original petitioner, where the joinder petitioner actively participates in the drafting of filings (or at least purports to reserve the right to do so). *See Microsoft Corp. v. Uniloc 2017 LLC*, IPR2019-01188, Paper 12 (expressing concern over “an apparent lack of clear

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.