

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC.
("Ericsson"),

Petitioner,

v.

UNILOC 2017 LLC
("Uniloc"),

Patent Owner.

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

**REPLY TO PATENT OWNER OPPOSITION
TO PETITIONER'S SUPPLEMENTAL MOTION FOR JOINDER**

As clarified in Ericsson's Supplemental Motion for Joinder, Ericsson intends to participate in a classic "understudy" role in the joined proceeding. Ericsson stipulated to all the conditions specified by the Board in its definition of "remain[ing] completely inactive." Order (Paper 8) at 3. In short, so long as Microsoft remains a party, Microsoft controls all aspects of the proceeding, including substantive filings, discovery, deposition, and oral hearing.

I. None of Uniloc's Concerns Justify Denying Joinder.

Pursuant to the Board's Order (Paper 8), Ericsson endeavored in good faith to reach an agreement with Uniloc regarding the conditions of joinder. Consistent with what Ericsson acknowledged in its Supplemental Motion for Joinder, Uniloc expresses two concerns regarding joinder – (1) briefing during any Federal Circuit appeal; and (2) whether Ericsson will "participate" in the drafting of any of the IPR filings controlled by Microsoft. Neither of these concerns justify denying joinder.

First, with respect to potential Federal Circuit review, Uniloc agrees Ericsson can file a notice of appeal but then suggests that Ericsson be prohibited from filing an appeal brief separate from Microsoft. Opp'n at 3-4. Uniloc's focus on the procedure of a different tribunal is not only irrelevant to the Board's joinder analysis, but, more importantly, its request that Ericsson should stipulate to no appeal briefing is also unreasonable. It is unreasonable because Ericsson is not aware of any mechanism in the Federal Circuit that would allow a party to take a

similar “understudy” role in any appeal as a matter of right, and Uniloc has not cited to any.

For Ericsson to participate in a Federal Circuit appeal, Ericsson needs to file or join briefing. For example, if Microsoft and Ericsson were to file notices of appeal, and Microsoft subsequently settled, the appeal would likely be dismissed if Ericsson had not filed or joined briefing. *See* Fed. Cir. R. 31(d). Likewise, if Uniloc were to appeal, and Microsoft subsequently settled, Ericsson could not be heard at oral argument without court permission if Ericsson had not filed or joined briefing. *See* Fed. R. App. P. 31(c). And, while it is typical for the court to consolidate appeals from the same IPR (which Ericsson would welcome), such consolidation is ultimately within the Federal Circuit’s discretion and beyond Ericsson’s control. In sum, if Ericsson did not file an appeal brief during an appeal, Ericsson could lose the right to maintain an appeal.¹

Second, Uniloc also requests that, in addition to the conditions listed in Ericsson’s Supplemental Motion for Joinder, that Ericsson stipulate to “not actively participate in the drafting of filings.” Opp’n at 3. During negotiation

¹ Ericsson cannot speak to what another party meant by that party’s statement that it would not “seek” to file briefing. *See* Opp’n at 4. Regardless, it is of no matter, given that Uniloc found even that statement unsatisfactory. *Id.* at 4 n.1.

regarding this condition, it was unclear whether Uniloc was attempting to prohibit communication between the parties. Uniloc's Opposition reflects its ambiguity regarding communication between parties – "Patent Owner never characterized the proposed stipulation as somehow precluding *any* communication between Ericsson and Microsoft for *any* reason." Oppn' at 3 (emphasis in original). As set forth in the understudy conditions, Microsoft controls the preparation of all filings and Ericsson reserves no right to participate in any way, except should Microsoft withdraw as a party. To date, Microsoft has not expressed any desire for input from Ericsson. Therefore, unless Microsoft withdraws as a party or communicates with Ericsson as Patent Owner acknowledges is permitted, Ericsson will not actively participate in the drafting of any filings.

Uniloc raises a speculative argument regarding whether Microsoft agrees to a "risk of estoppel" that would "potentially" attach under Ericsson's "apparent" interpretation of the conditions of joinder. Opp'n at 5. Again, the clarifications of Ericsson's understudy role in the Supplemental Motion for Joinder make it clear that Microsoft controls all aspects of the IPR proceeding (substantive briefing, discovery, deposition, and oral hearing) so long as Microsoft remains a party².

² Uniloc also "objects to" Ericsson "seeking to skirt" page limit requirements.

Opp'n at 8. There is no basis for Uniloc's objection because Ericsson's

II. Ericsson's second IPR petition does not implicate the concerns regarding serial petitions contemplated by *General Plastic*.

The Board should not use its discretion to deny institution because 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; *see also General Plastic*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential); *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00064, Paper 10 (PTAB May 1, 2019) (precedential) ("*Valve II*"). Unlike in *Valve II*, Ericsson's *second* IPR petition is a copycat joinder petition, rendering the analysis of the *General Plastic* factors different than the analysis in *Valve II*.

For example, with respect to *General Plastic*'s third factor, while Uniloc argues that Ericsson is "seeking to take advantage" of the Patent Owner's preliminary response to Ericsson's earlier IPR petition (IPR2019-01550), Opp'n at 7, that argument makes little sense here. Ericsson's joinder IPR petition is *substantively identical* to the IPR petition filed by Microsoft in IPR2019-01116 before Patent Owner's preliminary response. "Road-mapping" is simply not at

Supplemental Motion for Joinder (Paper 9) is within the allowed 15-page limit (37 C.F.R. § 42.24(a)), and Ericsson's Paper 3 complies with the five-page limit specified in the Consolidated Trial Practice Guide at 60, n. 3.

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