

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

ERICSSON INC.,

Petitioner

v.

UNILOC 2017 LLC,

Patent Owner

---

IPR Case No. IPR2020-00420  
U.S. Patent No. 6,868,079

---

**PETITIONER'S REQUEST FOR REHEARING PURSUANT TO  
37 C.F.R § 42.71(d)**

**Table of Contents**

I. INTRODUCTION .....1

II. ARGUMENT.....1

    A. The Board mistakenly determined that claim 17 is the only asserted claim in district court. ....2

    B. The Board did not account for the relative timing of Patent Owner’s district court assertions on the *GP* factors. ....7

    C. The Board improperly disregarded that Petitioner was not previously aware of Alamouti and Ling in the analysis of *GP* factors two and four. ....11

    D. Good cause exists for admitting public district court filing Exhibit 1042 into the record. ....12

III. CONCLUSION .....14

## I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.71(d), Petitioner, Ericsson Inc. (“Petitioner” or “Ericsson”), respectfully requests rehearing of the Board’s Decision Denying Institution, Paper 7 (June 18, 2020) (“Decision”), which discretionarily denies Ericsson’s Petition for *Inter Partes* Review.

Patent Owner did not dispute that it asserts claims 1–5, 7 and 17 in the related district court litigation as set forth in the Petition. Even though the identity of the asserted claims was not in dispute, the Board *sua sponte* reviewed select district court pleadings and arrived at the incorrect conclusion that claims 1–5 and 7 are not asserted. Because the Board’s decision rests on a factual misunderstanding of which claims are asserted in district court litigation, and additionally because the Board did not properly account for the relative timing of Patent Owner’s lawsuits and did not apply *General Plastic* factors 2 and 4 correctly, Ericsson respectfully requests that the Board reverse its decision and institute review.

## II. ARGUMENT

Ericsson respectfully requests reconsideration of the Board’s decision to deny Ericsson’s petition, which the Board based on the existence of two other instituted IPR proceedings: IPR2019-00510 (“IPR510”) (filed by Apple Inc., LG Electronics Inc., and Samsung Electronics Co., Ltd.); and IPR2020-00038

("IPR038") (filed by Motorola Mobility LLC). First, the Board's decision misunderstood which claims are asserted in litigation. Second, the Board should have taken into account that the IPRs filed against the '079 Patent are staggered in time as a foreseeable result of Patent Owner's staggered district court assertions against the various entities. Third, the Board applied an incorrect legal standard—one contrary to Board precedent—in analyzing *General Plastic* factors 2 and 4. See *General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i) ("*General Plastic*" or "*GP*").

Because the factual findings in the Decision are not supported by substantial evidence, and because the Decision is based on an erroneous interpretation of law and reflects an unreasonable judgment in weighing relevant factors, Ericsson respectfully submits that the Decision reflects an abuse of discretion. See *Huawei Device Co., Ltd. v. Optis Cellular Technology, LLC*, IPR2018-00816, Paper 19 at 2–3 (PTAB Jan. 8, 2019) (precedential).

**A. The Board mistakenly determined that claim 17 is the only asserted claim in district court.**

The Board denied institution based on its incorrect determination that Petitioner's representation that challenged claims 1–5 and 7 are asserted in district court is "refuted by what we find in the public records." Decision at 16. In making that factual determination, the Board mistakenly assumed that the Patent Owner

was limited to asserting only those claims that were explicitly enumerated in the Complaint (Ex. 3001). *Id.* at 15. Furthermore, despite consideration of the district court Docket Report (Ex. 3002), the Board overlooked other public records on the Docket Report listing the claims asserted against intervenor-defendant Ericsson, particularly the Order staying the case pending the outcome of related IPRs. *See* Ex. 3002, Docket Entry 47; *see also* related motion at Docket Entry 45<sup>1</sup>). For example, the Court's Order staying the case reiterates a joint stipulation of the parties, stating: "The asserted claims of the '079 patent are claims 1, 2, 3, 4, 5, 7 and 17." Ex. 1042 at 1–2 (¶ 3). Thus, Petitioner respectfully submits that public documents on the district court Docket Report confirm Petitioner's original statement (*see* Pet. at 71, n. 2) that claims 1–5 and 7 (and claim 17) are asserted against its products in district court litigation.

The Board correctly recognizes that Patent Owner asserts the '079 Patent against AT&T entities and that Patent Owner's Complaint in *Uniloc 2017 LLC v. AT&T Services, Inc., AT&T Mobility LLC*, 2:19-cv-00102-JRG (E.D. Tex.) specifically alleges infringement of claim 17. Decision at 15 (citing Ex. 3001). The Board erred, however, in its conclusion that, based on the Complaint, "only []

---

<sup>1</sup> *See also* Docket Entry 32, Motion to Intervene by Ericsson Inc., at 5, 7-9 (explaining Ericsson's duty to indemnify AT&T).

# 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.