UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC.,
Petitioner,
v.
DALI WIRELESS INC.,
Patent Owner.
IPR2022-01419

AT&T CORP., AT&T COMMUNICATIONS LLC, AT&T SERVICES, INC., AT&T MOBILITY LLC, and AT&T MOBILITY II, LLC,
Petitioner,
v.
DALI WIRELESS INC.,
Patent Owner.
IPR2023-00818[1]

Patent 10,334,499 B2

Before KARL D. EASTHOM, BARBARA A. BENOIT, and SHARON FENICK, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

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[1]Petitioner AT&T Corp., AT&T Communications LLC, AT&T Services, Inc., AT&T Mobility LLC, and AT&T Mobility II, LLC (collectively "AT&T") filed a Petition in IPR2023-00818 (Paper 1) and a Motion for Joinder (Paper 2) seeking to join IPR2022-01419 as a party.

The Board conducted a conference call with the parties to determine if the current schedule in IPR2022-01419 would present scheduling issues arising from the Motion for Joinder (*supra* note 1) filed in IPR2023-00818, and the pending Joint Request to File Settlement Agreement (Paper 17) and pending Joint Motion to Dismiss (Paper 16), filed jointly by Patent Owner Dali Wireless, Inc. and Petitioner Ericsson Inc. in IPR2022-01419, if the Board were to grant the Motion for Joinder. During the call, counsel for Petitioners Ericsson Inc. and AT&T, Patrick D. McPherson, and counsel for Patent Owner, Cliff Win, Jr., informed the panel that there are no anticipated scheduling issues in the event that the Board were to grant the pending Motion for Joinder.[2]

Nevertheless, during the call, Patent Owner indicated an intent to file an opposition to the Motion for Joinder in IPR2023-00818 or to otherwise present its opposition to joinder in a preliminary response. Petitioner AT&T argued that Patent Owner did not timely file an opposition and forfeited the filing thereof. Patent Owner countered that circumstances have changed since the filing of Motion for Joinder as evidenced by the pending Joint Request to File Settlement Agreement (Paper 17) and pending Joint Motion to Dismiss (Paper 16). Patent Owner argued that the Board normally encourages such a settlement.

Even though circumstances have changed based on a pending settlement between Patent Owner Dali Wireless, Inc. and Petitioner Ericsson Inc. in IPR2022-01419, as Petitioner AT&T argued during the call, any

[2] Also present for the call were counsel for additional petitioners and Judge John R. Kenny to discuss related issues in IPR2022-01212, IPR2022-01345, IPR2023-00646, IPR2023-00820, and IPR2023-00832.

settlement was foreseeable as evidenced by the Motion for Joinder. *See* IPR2023-00818, Paper 2, 6 ("Joinder is appropriate for the additional reason that the grounds for unpatentability as to the challenged claims can be resolved through AT&T's limited 'understudy' role in the IPR process as long as Ericsson remains in the joined IPR, and through AT&T's assumption of an active role in the event that Ericsson reaches a settlement with Patent Owner or otherwise ceases being an active party in the Ericsson IPR.").[3] That is, the Motion for Joinder shows that a settlement with Petitioner Ericsson Inc. was foreseeable during the time period that Board rules allow for a patent owner to file an opposition to a motion for joinder. *See id.*; 37 C.F.R. § 42.25(a)(1) ("An opposition is due one month after service of the [joinder] motion."); § 42.222 ("Any request for joinder must be filed, as a motion under § 42.22."). In addition, requiring the filing of an opposition for joinder within the time period specified by Board rules is not likely to upset the settlement given that Petitioner Ericsson Inc., who jointly filed settlement and termination papers with Patent Owner, does not oppose joinder. *See supra* note 3.

Based on the foregoing discussion, Patent Owner did not satisfy the timing requirement specified for an opposition to a motion under 37 C.F.R. § 42.25(a)(1), and Patent Owner's reason for not filing an opposition timely rests on the unsupported premise that a settlement was not foreseeable. Accordingly, Patent Owner is not authorized to file an opposition to joinder and is not authorized to include arguments for opposing joinder in any preliminary response it may file.

[3] During the call, counsel for Ericsson Inc. informed the Board that it does not oppose joinder.

To facilitate a smoother transition in the event the Board were to grant the Motion for Joinder, the Board hereby orders Patent Owner to file any preliminary response on or before August 11, 2023, in IPR2023-00818, which is six days prior to the current deadline of August 17, 2023. *See* 37 C.F.R. § 42.5(c)(1).

So *Ordered*.

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