IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMMSCOPE TECHNOLOGIES LLC,
Petitioner

v.

DALI WIRELESS INC.,
Patent Owner

Case IPR_____
U.S. Patent No. 11,006,343
Issued: May 11, 2021
Filed: May 13, 2019

MOTION FOR JOINDER TO
***INTER PARTES* REVIEW IPR2022-01345**

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I. STATEMENT OF PRECISE RELIEF REQUESTED

Petitioner CommScope Technologies LLC ("Petitioner" or "CommScope") hereby moves for joinder of Petitioner's contemporaneously-filed petition for *Inter Partes* Review ("IPR") of claims 1-22 of U.S. Patent No. 11,006,343 (the "'343 Patent") with an already-instituted IPR filed by Ericsson Inc. against Dali Wireless Inc., IPR2022-01345 ("Ericsson IPR").

The Ericsson IPR was filed on August 3, 2022 and instituted on March 9, 2023, on the same patent and the same claims as this Petition. This Petition and supporting declaration are substantively identical to the petition and declaration submitted in the Ericsson IPR. More specifically, Petitioner here asserts that the same claims are obvious over the same prior art based on the same arguments presented by the same expert as in the Ericsson IPR.

Patent Owner opposes but did not give any reason other than stating it intends to withdraw infringement allegations of the '343 Patent as to Petitioner. This is not a reason to deny institution and joinder. *Keysight Techs., Inc. v. Centripetal Networks, Inc.*, IPR2022-01199, Paper 13 at 33-35, 40-42 (PTAB Jan. 4, 2023). Petitioner has been sued by Patent Owner in at least five other cases involving related patents and has an interest in making sure it has the freedom to operate. *Id.*; *see* 3:16-cv-00477 (N.D. Tex.); 1:19-cv-00952 (D. Del.); 2:22-cv-00012 (E.D. Tex.); 6:22-cv-00104 (W.D. Tex.); 2:22-cv00414 (E.D. Tex.).

Ericsson does not oppose joinder. Petitioner here has agreed to take an understudy role if joined. Joinder will not cause any delay in the resolution of the Ericsson IPR. Joinder is, therefore, appropriate because it will promote the efficient, consistent resolution of the same patentability issues of the same patent. It will not delay any schedule in the Ericsson IPR schedule, and the parties in the Ericsson IPR will not be prejudiced.

II. STATEMENT OF MATERIAL FACTS

1. Dali Wireless Inc. ("Patent Owner") purportedly owns the '343 Patent.

2. The following litigation or *inter partes* reviews involve the '343 Patent:

- *Ericsson Inc. v. Dali Wireless Inc.*, IPR2022-01345 (PTAB);
- *Dali Wireless, Inc. v. Ericsson Inc.*, 6:22-cv-1313 (W.D. Tex.);
- *Dali Wireless, Inc. v. Cellco P'ship, et al.*, No. 2:23-cv-002 (E.D. Tex.);
- *Dali Wireless, Inc. v. T-Mobile US, Inc., et al.*, No. 2:22-cv-414 (E.D. Tex.).

3. On August 3, 2022, Ericsson Inc. filed a petition challenging claims 1-22 of the '343 Patent in *Ericsson Inc. v. Dali Wireless Inc.*, IPR2022-01345, and filed a corrected petition February 27, 2023. The Ericsson IPR was instituted March 9, 2023.

4. Along with this Motion for Joinder, Petitioner here has

simultaneously filed a Petition for *inter partes* review, which argues, *inter alia*, that the same claims of the ’343 Patent are obvious over the same grounds and reasons set out in the Ericsson IPR. The Petition is also supported by the expert declaration of Dr. Henry Houh, the same expert who submitted an identical declaration in support of the Ericsson IPR.

5. The grounds proposed in the present Petition are therefore the same grounds of unpatentability. The Petition does not contain any additional arguments or prior art or cite to any new evidence in supporting the grounds asserted against claims 1-22 of the ‘343 Patent.

6. The ’343 Patent is asserted against present Petitioner (CommScope) only in *Dali Wireless, Inc. v. T-Mobile US, Inc.*, No. 2:22-cv-414 (E.D. Tex.).

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Joinder is Timely.

The motion for joinder is timely because it is submitted within one month after the institution date of the Ericsson IPR. *See* 37 C.F.R. § 42.122(b).

B. Joinder is Appropriate.

The Board has discretion to, and should, join this IPR with the Ericsson IPR. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b).

1. Legal Standard

In considering a motion for joinder, the Board considers the following factors: (1) the reasons why joinder is appropriate; (2) new grounds of unpatentability asserted in the petition; (3) the impact (if any) joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *See Dell Inc. v Network-1 Security Solutions, Inc.*, IPR2013-00385, Paper No. 17 at 4 (PTAB July 29, 2013). All of these factors weigh in favor of joinder.

2. Joinder Is Appropriate Because Petitioner Proposes No New Grounds of Unpatentability.

Joinder is appropriate here because the Petition asserts the same grounds and relies on the same evidence for unpatentability presented in the Ericsson IPR. Specifically, the Petition relies on the same combinations of prior art references. Further, the same expert declaration from Dr. Houh, has been submitted in both IPRs. Thus, the arguments in both petitions are identical; there are no new grounds of unpatentability asserted in this Petition. Accordingly, the Petition will not add any additional dimension to the substantive issues in the Ericsson IPR.

As the same issues will be at issue in both proceedings, joinder is the most efficient and economical manner to proceed. *See, e.g., Dell Inc. v. Alacritech, Inc.*, IPR2018-01307, Paper No. 8 (PTAB Jan. 11, 2019) (granting

motion for joinder where the petition challenged the same claims on the same grounds).

Finally, this is Petitioner's first challenge of the '343 Patent and the request for joinder is to join an already instituted IPR. Accordingly, there is no "potential for abuse of the review process by repeated attacks on patents" in this case. *Apple Inc. v. Uniloc 2017, LLC*, IPR2020-00854, Paper 9 at 5 (PTAB Oct. 28, 2020) (precedential) (quoting *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16–17 (PTAB Sept. 6, 2017) (precedential)). Rather, allowing joinder would enable an appropriate and efficient use of the review process.

3. Joinder Will Not Impact Any Trial Schedule.

The Petition does not include any new grounds of unpatentability. As such, Joinder will not introduce any new prior art, experts, or grounds for unpatentability into the Ericsson IPR. Petitioner consents to the current schedule in the Ericsson IPR and will not request any alterations to any schedule that may issue in the Ericsson IPR based on the requested joinder. Further, Petitioner agrees to take an "understudy" role in the joined proceeding, so long as Ericsson remains an active party in the joined proceeding. Accordingly, joinder will not impact any schedule that may issue or otherwise prejudice the Patent Owner.

4. Joinder Would Simplify Briefing and Discovery.

As the prior art and bases for unpatentability in the petitions in both this IPR and the Ericsson IPR are the same, the same arguments will be made in both proceedings. Both Petitioner and the Ericsson IPR petitioner rely on the same expert to support identical arguments.

Petitioner will maintain only an "understudy" role in the proceeding, if joined. *See, e.g.*, *Apple Inc. v. INVT SPE LLC*, IPR2019-00958, Paper 9 at 5–8 (PTAB May 30, 2019) (granting IPR where petitioners requested an "understudy" role). Petitioner will assume a primary role only if the Ericsson IPR petitioners cease to participate in the IPR. Petitioner expressly consents to the trial schedule issued in IPR2022-01345. Petitioner CommScope also agrees to the following:

(i) while Petitioner CommScope is in an understudy role no additional discovery will be required relative to that in IPR2022-01345;

(ii) while Petitioner CommScope is in an understudy role no further briefing would be submitted by Petitioner except (a) to address any specific points of disagreement with lead petitioner (in which case such additional briefing would be limited to three pages), and (b) to the extent Patent Owner makes any allegations or arguments directed against Petitioner CommScope specifically (in which case such additional briefing would be limited to 5 pages);[1]

[1] The Board has granted joinder with similar briefing stipulations. See e.g., *Enzymotec Ltd. v. Neptune Tech. & Bioresources, Inc.*, IPR2014-00556, Paper 19 at 8 (PTAB July 9, 2014) (granting joinder where understudy petitioner was permitted up to seven pages of additional briefing to address any points of

(iii) while in an understudy role Petitioner CommScope will not receive any direct, cross, or re-direct examination time beyond what is permitted in the proceeding for the IPR2022-01345 petitioner;

(iv) while in an understudy role Petitioner CommScope agrees not to request any additional time to independently argue or submit its own demonstratives at the oral hearing for IPR2022-01345 except to address any points of disagreement with lead petitioner or to address any CommScope specific allegations as set out in point (ii) above, and in which case Petitioner CommScope would reserve the right to request up to five minutes to address such issues.

These agreements remove any potential "complication or delay" caused by joinder, while providing the parties an opportunity to address all issues that may arise and avoiding any undue burden on Patent Owner, the Ericsson IPR petitioner, and the Board. *See, e.g.*, *Motorola Mobility LLC v. SoftView LLC*, IPR2013-00256, Paper 10 at 8–10 (PTAB June 20, 2013). Therefore, briefing and discovery would be significantly simplified if joinder were granted.

IV. CONCLUSION

For the foregoing reasons, Petitioner CommScope Technologies LLC respectfully requests that the Board institute its Petition for *Inter Partes* Review of U.S. Patent No. 11,006,343 and join this proceeding with *Ericsson Inc. v. Dali Wireless Inc.*, IPR2022-01345.

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disagreement with lead petitioner arguments).

Dated: April 6, 2023

Respectfully submitted,

By: /s/*Samuel A. Hamer*

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CERTIFICATE OF SERVICE

The undersigned certifies pursuant to 37 C.F.R. §42.6(e) and §42.105 that on April 6, 2023, a complete and entire copy of the Motion for Joinder, Petition for *Inter Partes* Review of U.S. Patent No. 11,006,343 challenging claims 1-22, Power of Attorney, and all accompanying exhibits were served via Federal Express, to the Patent Owner by serving the correspondence address of record as follows:

Artegis Law Group, LLP
John Carey
7710 Cherry Park Drive Suite T #104
Houston, TX 77095

April 6, 2023
Date

By /s/*Samuel A. Hamer*
Samuel Hamer, Reg. No. 46,754