

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC.,
Petitioner,
v.
DALI WIRELESS INC.,
Patent Owner.
IPR2022-01345

COMMSCOPE TECHNOLOGIES, LLC, Petitioner,
v.
DALI WIRELESS INC., Patent Owner.
IPR2023-00820

T-MOBILE, USA, INC., Petitioner,
v.
DALI WIRELESS INC., Patent Owner.¹
IPR2023-00832

Patent 11,006,343 B2

Before KARL D. EASTHOM, SHARON FENICK, and JOHN R. KENNY,
Administrative Patent Judges.

EASTHOM, *Administrative Patent Judge.*

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

¹ Petitioners CommScope Technologies, LLC (“CommScope”) and T-Mobile, USA, Inc. (“T-Mobile”) each filed a Motion for Joinder with its Petition in IPR2023-00820 (Papers 2, 3) and IPR2023-00832 (Papers 2, 3), respectively, seeking to join IPR2022-01345 as a party. The parties must obtain prior authorization to use a joint caption.

The Board conducted a conference call with the parties to determine if the current schedule in IPR2022-01345 would present scheduling issues arising from the recent Motions for Joinder (*supra* note 1) in IPR2023-00820 and IPR2023-00832, and the pending Joint Request to File Settlement Agreement (Paper 20) and pending Joint Motion to Dismiss (Paper 19) jointly filed by Patent Owner Dali Wireless, Inc. and Petitioner Ericsson Inc. in IPR2022-01345, if the Board were to grant the pending Motions for Joinder. During the call, counsel for Ericsson Inc., Patrick D. McPherson, counsel for CommScope and T-Mobile, Philip P. Caspers, 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 Motions for Joinder.²

Nevertheless, during the call, Patent Owner indicated an intent to file an opposition to the Motions for Joinder in IPR2023-00820 and IPR2023-00832 or to otherwise present its opposition to joinder in a preliminary response. However, the record shows that Patent Owner did not timely file an opposition in either case and the Board informed Patent Owner during the call that Patent Owner appears to have forfeited the filing thereof. Patent Owner countered that circumstances have changed since the filing of Motions for Joinder as evidenced by the pending Joint Request to File Settlement Agreement (Paper 20) and pending Joint Motion to Dismiss (Paper 19). Patent Owner argued that the Board normally encourages such a settlement.

² Also present for the call were counsel for an additional petitioner and Judge Barbara A. Benoit, to discuss related issues in IPR2022-01212, IPR2022-01419, IPR2023-00646, IPR2023-00818, and IPR2023-00820.

Even though circumstances have changed based on a pending settlement between Patent Owner Dali Wireless, Inc. and Petitioner Ericsson Inc. in IPR2022-01345, the record shows that any settlement was foreseeable as evidenced by Petitioners' Motions for Joinder. *See* IPR2023-00820, Paper 2, 6 ("Petitioner will assume a primary role only if the Ericsson IPR petitioners cease to participate in the IPR."); IPR2023-00820, Paper 2, 6 (same).³ In other words, the Motions for Joinder show that a settlement was foreseeable during the time period that Board rules allow for a patent owner to file an opposition to a motion for joinder. *See* IPR2023-00820, Paper 2, 6; IPR2023-00820, Paper 2, 6; 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 a opposition to joinder and is not authorized to include arguments for opposing joinder in any preliminary response it may file.

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

So Ordered.

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