

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC.,
Petitioner,

v.

GENERAL ACCESS SOLUTIONS, LTD.,
Patent Owner.

IPR2024-00392
Patent 7,230,931 B2

Before MELISSA A. HAAPALA, *Acting Deputy Chief Administrative Patent Judge*, and KEN B. BARRETT and TERENCE W. MCMILLIN, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314
Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

A. *Background and Summary*

Ericsson Inc. (“Petitioner”)¹ filed a Petition requesting *inter partes* review of U.S. Patent No. 7,230,931 B2 (“the ’931 patent,” Ex. 1001). Paper 1 (“Pet.”). The Petition challenges the patentability of claims 28 and 29 of the ’931 patent. Petitioner filed, concurrently with the Petition, a Motion for Joinder requesting to be joined as a party to pending *inter partes* review IPR2023-00978, which is captioned as *Cellco Partnership d/b/a Verizon Wireless v. General Access Solutions, Ltd.* (“Verizon IPR”). Paper 3 (“Mot.” or “Motion”). General Access Solutions, Ltd. (“Patent Owner”)² filed an Opposition to the Motion. Paper 7 (“Opp.”). Petitioner filed a Reply to the Opposition. Paper 9 (“Reply”). Patent Owner also filed a Preliminary Response to the Petition. Paper 11 (“Prelim. Resp.”).

An *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (2018).

For the reasons that follow, we institute an *inter partes* review as to both of the challenged claims of the ’931 patent on all the grounds of unpatentability set forth in the Petition. We also *grant* Petitioner’s Motion for Joinder.

¹ Petitioner identifies Ericsson Inc. and Telefonaktiebolaget LM Ericsson as the real parties in interest. Pet. 3–4.

² Patent Owner identifies General Access Solutions, Ltd. as the real party in interest. Paper 6, 1.

B. Related Proceedings

One or both parties identify, as matters involving or related to the '931 patent, *General Access Solutions, Ltd. v. Cellco Partnership d/b/a Verizon Wireless et al.*, No. 2-22-cv-00394 (E.D. Tex.), *General Access Solutions, Ltd. f/k/a Access Solutions, Ltd. v. T-Mobile US, Inc., T-Mobile USA, Inc., Ericsson Inc., and Nokia of America Corporation*, No. 2-23-cv-00158 (E.D. Tex.), *General Access Solutions, Ltd. v. Virgin Mobile USA, L.P. et al.*, No. 2-20-cv-00007 (E.D. Tex.) (no longer pending), and *General Access Solutions, Ltd. v. Sprint Corp. et al.*, No. 2-16-cv-00465 (E.D. Tex.) (no longer pending). Pet. 4; Paper 6, 1.

Additionally, Petitioner notes that the '931 patent was the subject of a prior *inter partes* review before the Patent Trial and Appeal Board in *Sprint Spectrum LP v. General Access Solutions, Ltd.*, IPR2017-01889. Pet. 4.³ That *inter partes* review was the subject of a decision by the United States Court of Appeals for the Federal Circuit. *Sprint Spectrum L.P. v. General Access Sols., Ltd.*, 812 F. App'x 999 (Fed. Cir. 2020) (non-precedential). The parties also note that the '931 patent is the subject of a current *inter partes* review in *Cellco Partnership d/b/a Verizon Wireless v. General Access Solutions, Ltd.*, IPR2023-00978. Pet. 4; Paper 6, 1. Patent Owner further notes that the '931 patent is the subject of a petition filed by Nokia of America Corporation in IPR2024-00461. Paper 6, 1.

³ IPR2017-01889 resulted in the cancelation of claims 1–27 of the '931 patent. See Ex. 1001, *Inter Partes* Review Certificate (located at the end of the challenged patent).

*C. The '931 Patent*⁴

The '931 patent describes a burst packet transmission media access system using selectively adaptable beam forming in a fixed wireless access network. Ex. 1001, 3:28–31. The fixed wireless network may comprise a plurality of transceiver base stations that transmit forward channel (downlink or downstream) broadband signals to subscriber premises and receive reverse channel (uplink or upstream) broadband signals from subscriber premises. *Id.* at Fig. 1, 11:57–64. Each of the transceiver base stations may cover a cell site that is divided into a plurality of sectors. *Id.* at Fig. 2, 12:25–27. Pre-programmed sets of directed beam patterns are used to cover a cell in an angular fashion, which is referred to as “beam scanning.” *Id.* at 28:1–3. The base station establishes a set of beams to cover the cell and based on physical location in the sector, a specific beam is used to communicate with one or more subscribers that lie in that sector. *Id.* at 28:9–12.

Figure 14 of the '931 patent is reproduced below:

⁴ Patent Owner's citations to the '931 patent omit the exhibit number. *See* Prelim. Resp. 5 n.2 (“Citations exclusively to page and line numbers are to U.S. Patent No. 7,230,931 (‘the '931 Patent’).”). To ensure clarity of the record, we instruct Patent Owner to include the exhibit number for all exhibits, including the '931 patent, in all future papers.

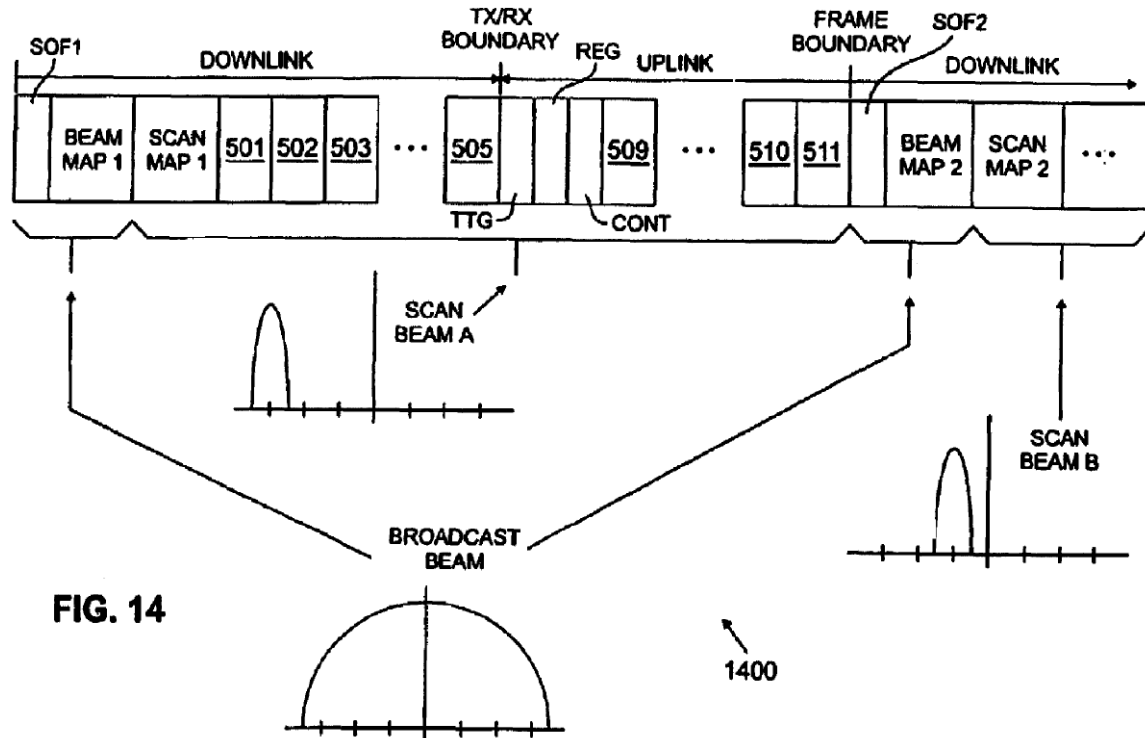


FIG. 14

Figure 14 illustrates the use of broadcast beams and scanning beams in exemplary time division duplex (TDD) signal 1400. *Id.* at 29:3–5. TDD signal 1400 comprises a first TDD frame having a downlink portion comprising a first start-of-frame field (SOF1), a first beam map field (Beam Map 1), and a first scan map field (Scan Map 1). *Id.* at 29:6–10. “The remainder of the downlink portion comprises preamble field 501, management field 502, and N modulation groups, including exemplary modulation groups 503 and 505.” *Id.* at 29:10–13. “[A] modulation group is a group of downlink slots transmitted to one or more subscribers using a common scheme of one or more of: 1) modulation format, 2) FEC [(forward error correction)] codes, and 3) physical beam forming.” *Id.* at 19:31–35. The first TDD frame is followed by a second TDD frame, which comprises a second start-of-frame field (SOF2), a second beam map field (Beam Map 2), and a second scan map field (Scan Map 2). *Id.* at 29:21–25. A spread spectrum Broadcast Beam is used to transmit start-of-frame fields SOF1,

SOF2 and beam map fields Beam Map 1, Beam Map 2 in each TDD frame. *Id.* at 29:26–30. Distinct scan beams (Scan Beam A and Scan Beam B) are used to transmit the scan map fields (Scan Map 1 and Scan Map 2) and the remainder of the uplink and downlink portions of each TDD frame. *Id.* at 29:30–33.

Broadcast Beam Maps 1, 2 provide data indicating which scanning beam (or beams) are used at which time for the frame and also transmit a synchronization field so that all subscribers can maintain synchronization. *Id.* at 29:34–36, 29:47–50. Scanning Beam Maps A, B provide the uplink and downlink map, which state at which time in the frame, using the scanning beam described in the associated Broadcast Beam Map, the downlink modulation groups and specific uplink slots are allocated for the frame using the specific scanning beam. *Id.* at 29:38–43.

D. Illustrative Claim

Challenged claim 28 depends directly from now-canceled independent claim 1. Challenged claim 29 depends directly from now-canceled independent claim 19. Dependent claim 28 is illustrative and is reproduced below along with the limitations of underlying independent claim 1.

1. For use in a wireless access network comprising a plurality of base stations, each of said plurality of base stations capable of bidirectional time division duplex (TDD) communication with wireless access devices disposed at a plurality of subscriber premises in an associated cell site of said wireless access network, a transceiver associated with a first of said plurality of base stations comprising:
 - transmit path circuitry associated with a beam forming network capable of transmitting directed scanning beam signals each directed to substantially only wireless access devices within a different one of a plurality of sectors of a cell site

associated with said first base station, wherein said transmit path circuitry

transmits, at a start of a TDD frame, a broadcast beam signal to wireless access devices within more than one of said sectors, the broadcast beam signal comprising a start of frame field, and

subsequently transmits, in a downlink portion of said TDD frame, first downlink data traffic to substantially only wireless access devices within one of said sectors using one of said directed scanning beam signals.

28. The transceiver as set forth in claim 1 wherein said transmit path circuitry transmits, in said downlink portion of said TDD frame, second downlink data traffic to substantially only wireless access devices within an other of said sectors using an other of said directed scanning beam signals.

Ex. 1001, 30:31–52, 33:4–9. Dependent claim 29 recites a method of communicating that includes the step of “transmitting” the second download data traffic in the manner substantially similar to that recited in claim 28. *Id.* at 32:21–22, 34:1–6.

E. Evidence

Petitioner relies on the following references:

Name	Reference	Exhibit(s)
Vornefeld	U. Vornefeld, et al., <i>SDMA Techniques for Wireless ATM</i> , IEEE COMMUNICATIONS MAGAZINE (Nov. 1999)	1004
Atsuta	US 6,160,800, issued Dec. 12, 2000	1005
Goldburg	US 6,154,661, issued Nov. 28, 2000	1006
Youssefmir	US 6,795,409 B1, issued Sept. 21, 2004	1007

Name	Reference	Exhibit(s)
Tangemann	M. Tangemann, <i>Influence of the User Mobility on the Spatial Multiplex Gain of an Adaptive SDMA System</i> , WIRELESS NETWORKS – CATCHING THE MOBILE FUTURE, PROCEEDINGS OF THE 5TH IEEE INTERNATIONAL SYMPOSIUM ON PERSONAL, INDOOR AND MOBILE RADIO COMMUNICATIONS (1994)	1008

Petitioner also relies on the declaration of Dr. Kevin C. Almeroth (Ex. 1002) in support of its arguments. The parties also rely on other exhibits as discussed below.

F. Asserted Grounds of Unpatentability

Petitioner asserts that the challenged claims are unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. § ⁵	Reference(s)/Basis
28, 29	103(a)	Vornefeld, Atsuta
28, 29	103(a)	Vornefeld, Goldberg
28, 29	103(a)	Youssefmir, Atsuta
28, 29	103(a)	Vornefeld, Atsuta, Tangemann
28, 29	103(a)	Vornefeld, Goldberg, Tangemann

II. PROCEDURAL POSTURE

All of the claims of the '931 patent have been before the Board in a previous *inter partes* review, specifically IPR2017-01889 (the “prior IPR” or the “Sprint IPR”). *See, e.g.*, Ex. 1009, 2 (IPR2017-01889, Paper 43 (Final Written Decision dated March 7, 2019)). The petitioner in that prior IPR was Sprint Spectrum L.P. (“Sprint” or “the prior petitioner”). *Id.* The prior IPR was related to a parallel district court case in which Patent Owner had

⁵ The '931 patent was filed before the effective date of the Leahy Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), and we apply the pre-AIA version of 35 U.S.C. § 103.

sued Sprint in 2016 for patent infringement (the “Sprint Litigation”). Prelim. Resp. 24 (citing Ex. 2001). The Sprint Litigation pertained to Sprint’s and the other defendants’ “products and services . . . utilizing ‘WiMAX’ (Worldwide Interoperability for Microwave Access) and/or ‘LTE’ (Long-Term Evolution) networks, both of which are 4G technologies.” Ex. 2001, 5.

In the prior IPR, Patent Owner, in its response to the petition and again at oral argument, conceded that Vornefeld anticipates the independent claims of the ’931 patent. *See* Ex. 1009, 7 (IPR2017-01889, Paper 43 (the 2019 Final Written Decision citing and parenthetically quoting Patent Owner’s Response and the hearing transcript)). In light of this concession of unpatentability, the Board entered adverse judgment against Patent Owner as to independent claims 1, 10, and 19. *Id.* Eventually, the Board—after a final written decision (Ex. 1009), a decision on appeal by the Federal Circuit, and a final written decision on remand (Ex. 1010)—determined that prior petitioner Sprint had demonstrated the unpatentability of most of the remaining claims, specifically claims 2–9, 11–18, and 20–27. Ex. 1010, 26. The Board further determined that prior petitioner Sprint had not met its burden to prove the unpatentability of dependent claims 28 and 29, the claims challenged in the current Petition. *See* Ex. 1009, 22–24, 30–31; *see also Sprint Spectrum*, 812 F. App’x at 1007 (affirming the Board’s determination as to claims 28 and 29). Subsequently, claims 1–27 were canceled. Ex. 1001, *Inter Partes* Review Certificate (issued Nov. 15, 2021) (located at the end of the challenged patent).

According to Patent Owner, the ’931 patent currently is involved in a suit filed in 2022 by Patent Owner against Cellco Partnership d/b/a Verizon

Wireless (the petitioner in IPR2023-00978) and in a suit filed by Patent Owner in 2023 against T-Mobile US, Inc., T-Mobile USA, Inc., Ericsson Inc. (the Petitioner in the present case), and Nokia of America Corporation (the petitioner in IPR2024-00461). Paper 6, 1 (Patent Owner’s mandatory disclosures). The allegations of infringement in at least the Verizon litigation pertain to 5G products. Ex. 1016, 2.

Verizon filed a petition for *inter partes* review, and a review was instituted. *See* IPR2023-00978, Paper 20. Ericsson and Nokia each have filed a petition for *inter partes* review along with a motion to join the Verizon IPR. IPR2024-00392 (Ericsson); IPR2024-00461 (Nokia).

III. ESTOPPEL UNDER 35 U.S.C. § 315(e)(1)

Patent Owner argues that Petitioner is estopped under 35 U.S.C. § 315(e)(1) from challenging claims 28 and 29 of the ’931 patent, and urges us to deny institution of the requested *inter partes* review. *See* Prelim. Resp. 24–26. Section 315(e)(1), which is under the § 315(e) heading “Estoppel,” provides:

The petitioner in an inter partes review of a claim . . . that results in a final written decision . . . , or the real party in interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

Patent Owner does not allege that current Petitioner Ericsson was the petitioner in a prior proceeding. Rather, Patent Owner notes that prior petitioner Sprint’s challenge to the ’931 patent resulted in a final written decision, and argues that current Petitioner Ericsson was a privy of Sprint and, therefore, is estopped from filing the current Petition. *Id.* The primary basis for this argument is Patent Owner’s assertion that the Board, in another

case, has already determined that Ericsson is a privy of Sprint. *Id.* at 25–26 (citing *Ericsson Inc. v. Regents of the University of Minnesota*, IPR2017-01186, Paper 58 at 7–11, 14 (PTAB June 19, 2020) (“the Regents IPR”)). Patent Owner presents the same arguments in urging the Board to also deny Petitioner’s Motion for Joinder. Opp. 2–4.

Petitioner states that “Ericsson and Sprint are not privies with respect [to] the ’931 Patent, and Ericsson is not estopped from joining IPR2023-00978.” Reply 2; *see id.* at 3 (“As discussed above, however, Ericsson is not in privity with Sprint with respect to the ’931 Patent.”); *cf.* Pet. 3–4 (“The real parties in interest are Ericsson Inc. and Telefonaktiebolaget LM Ericsson. . . . No other parties exercised or could have exercised control over this Petition; no other parties funded or directed this Petition.”). Petitioner contends, *inter alia*, that Patent Owner’s privity argument “is without merit” because the Regents IPR was “a ***different, unrelated*** IPR involving a ***different, unrelated*** patent.” Reply 1. Petitioner argues that Patent Owner “fails to set forth any evidence to support a privity finding between Ericsson and Sprint regarding the ’931 Patent at issue here.” *Id.*

“Whether a party who is not a named participant in a given proceeding nonetheless constitutes a ‘real party-in-interest’ or ‘privy’ to that proceeding is a highly fact-dependent question.” Trial Practice Guide⁶ 13 (citing *Taylor v. Sturgell*, 553 U.S. 880 (2008); 18A CHARLES ALAN WRIGHT, ARTHUR R. MILLER & EDWARD H. COOPER, FEDERAL PRACTICE & PROCEDURE §§ 4449, 4451 (2d ed. 2011)). “Such questions will be handled

⁶ Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

by the Office on a case-by-case basis.” *Id.* (citing *Taylor*, 553 U.S. at 893–95 and 893 n.6).

[The inquiry into whether a party is in privity with another] is grounded in due process concerns for both the petitioner . . . and the opposing party In other words, the inquiry has a dual-focus on preventing the petitioner from now lodging a successive attack for which it already had a first bite, thus, protecting the defending party from an unwarranted second attack, while also ensuring that the petitioner is not unfairly limited in its ability to lodge its challenges if it has not had a full and fair opportunity to do so already.

Uniloc 2017 LLC v. Facebook Inc., 989 F.3d 1018, 1028 (Fed. Cir. 2021) (citations omitted). Accordingly, “the reach of privity cannot extend beyond the limits of due process.” *WesternGeco LLC v. ION Geophysical Corp.*, 889 F.3d 1308, 1319 (Fed. Cir. 2018). “[A] person who was not a party to a suit generally has not had a ‘full and fair opportunity to litigate’ the claims and issues settled in that suit.” *Id.* (quoting *Taylor*, 553 U.S. at 894).

“Because nonparty preclusion risks binding those who have not had a full and fair opportunity to litigate, the Supreme Court has cautioned that there is a general rule against nonparty preclusion, subject to certain exceptions.”

Id. (citing, *inter alia*, *Taylor*, 553 U.S. at 892–93). The Supreme Court in *Taylor* identified considerations where nonparty preclusion would be justified, including:

(1) an agreement to be bound; (2) pre-existing substantive legal relationships between the person to be bound and a party to the judgment (e.g., “preceding and succeeding owners of property”); (3) adequate representation by someone with the same interests who was a party (e.g., “class actions” and “suits brought by trustees, guardians, and other fiduciaries”); (4) assumption of control over the litigation in which the judgment was rendered; (5) where the nonparty to an earlier litigation acts as a proxy for the named party to relitigate the same issues; and

(6) a special statutory scheme expressly foreclosing successive litigation by nonlitigants.

Id. (citing *Taylor*, 553 U.S. at 894–95).

In a privity analysis, “it is important to determine whether the petitioner and the prior litigant’s relationship—as it relates to the [prior *inter partes* review]—is sufficiently close that it can be fairly said that the petitioner had a full and fair opportunity to litigate the validity of the patent in that [prior *inter partes* review].” *Id.*⁷ “In other cases, it may be more relevant to determine whether the petitioner is simply serving as a proxy to allow another party to litigate the patent validity question that the other party raised in an earlier-filed litigation.” *Id.* (citing *Taylor*, 553 U.S. at 895).

Under the circumstances of this case, any finding of privity would have to be based on evidence. Patent Owner, in arguing estoppel due to privity, does not cite to evidence pertaining to the ’931 patent, the prior Sprint IPR (which is alleged to have created the estoppel), or the related district court litigation between Patent Owner and Sprint (other than the complaint offered as evidence that an infringement accusation was made). *See* Prelim. Resp. 24–26. Rather, Patent Owner relies on another Board panel’s determination that Ericsson and Sprint were in privity in *Ericsson Inc. v. Regents of the University of Minnesota*, IPR2017-01186. *See id.* The only exhibits to which Patent Owner cites in support of its estoppel argument are the complaint in the Sprint Litigation and Ericsson’s reply

⁷ *WesternGeco* involves a time-bar under 35 USC § 315(b), which is triggered by the service of an infringement complaint, and the court speaks in terms of parties to a prior lawsuit. *See WesternGeco*, 889 F.3d at 1319. Here, the § 315(e)(1) estoppel is triggered by the issuance of a final written decision in a prior *inter partes* review. Thus, we refer primarily to that prior IPR and to the relationship between Petitioner and the prior petitioner.

brief in support of its motion to intervene in the Regents district court litigation (“the Regents Litigation”), which was related to the Regents IPR. *See id.* at 24–26 (citing Ex. 2001, 1; Ex. 2002, 1); Opp. 2–4 (same).⁸

Petitioner argues that the Regents IPR determination of privity does not apply here because it was “in a different, unrelated IPR involving a different, unrelated patent.” Reply 1 (emphasis omitted).

As mentioned, “determining whether two parties may be in privity ‘is a highly fact-dependent question.’” *WesternGeco*, 889 F.3d at 1318 (quoting the Board’s Trial Practice Guide). In support of its argument, Patent Owner points to facts underlying the other panel’s determination in the Regents IPR. Patent Owner notes that the Regents IPR panel “relied on ‘Ericsson’s supply contract with Sprint’ for ‘Sprint’s use of Ericsson’s LTE stations’ in finding that Ericsson ‘had the opportunity to control the defense of the District Court Defendants with respect to the base stations.’” Prelim. Resp. 25 (citing IPR2017-01186, Paper 58⁹ at 10-11, 14; Ex. 2002, 1). Patent Owner also asserts that the Regents IPR panel found that “‘the supply agreements include indemnification provisions’ and ‘the indemnification provisions in [Ericsson’s] supply agreements with the District Court Defendants specifically address the issue of control.’” *Id.* at 26–27 (citing

⁸ In the § 315(b) time-bar section, Patent Owner cites Exhibit 2032 of the Regents IPR. Prelim. Resp. 27; *see also* Opp. 6 (same). That is the same document as Exhibit 2002 in the record before us.

⁹ The Decision on Institution in the Regents IPR, along with certain exhibits, were filed under seal. Patent Owner cites to the redacted version of that decision that is available to the public, and does not cite to the agreements themselves or related evidence other than the intervention motion brief discussed herein (Ex. 2002).

IPR2017-01186, Paper 58 at 7, 11, 15) (alteration in original). Any finding that these facts were the same in the Sprint IPR would be mere speculation.

We do not have the agreements from the Regents case in the present record before us. We note that the Regents Litigation began in 2014 and the Sprint Litigation began in 2016. Ex. 2002 (the case number for the Regents Litigation beginning with “14”); Prelim. Resp. 26 (Patent Owner sued Sprint in 2016). It would be speculation to find, as Patent Owner implies, that the supply agreements and indemnity provisions were the same in both cases and did not change over time. Similarly, Patent Owner’s attempt to tie the Regent and Sprint IPRs together by characterizing two different plaintiff’s allegations as both pertaining to “Ericsson’s LTE base stations” is unavailing. *See* Prelim. Resp. 25 (Patent Owner arguing that “[t]he Board has already determined that Ericsson is a privy of Sprint with respect to allegations of infringement arising out of Sprint’s use of Ericsson’s LTE base stations, such as those in the Sprint Litigation.”); *see also* Ex. 1001, 30:36–37 (claim 1 of the ’931 patent directed to “a transceiver” that is “associated with a first of said plurality of base stations”). We do not have evidence that the specific component(s) accused of infringing the two different patents are substantively the same such that the indemnity provisions (even if unchanged) applied to the Sprint Litigation.

Ericsson moved to intervene in the Regents Litigation, arguing that, “[i]n light of this indemnification agreement [in that Regents Litigation], there can be no serious dispute about whether Ericsson faces an ‘actual or imminent’ injury in this case.” Ex. 2002, 3. Patent Owner does not allege that Ericsson also attempted to intervene in the later Sprint Litigation, which could suggest that same potential-injury motivations due to the indemnity

provisions was not present in the Sprint Litigation. Consistent with this, and as Petitioner notes (Reply 1–2), Patent Owner, in a related and currently-pending IPR, relies on Sprint’s initial disclosures filed in the district court, in which Petitioner Ericsson’s name was absent from the list of suppliers of “the eNodeBs accused of infringement” and from the list of possible indemnifiers. *See* IPR2024-00461, Paper 7, 5–6 (Patent Owner’s opposition to Nokia’s motion for joinder to the Verizon IPR); Ex. 1100, 3, 10 (Sprint’s initial disclosures in the General Access Solutions/Sprint district court litigation).

In addition to the Regents IPR panel’s determination, Patent Owner relies on Exhibit 2002, which is Ericsson’s reply brief in support of its motion to intervene in the Regents Litigation. Prelim. Resp. 25–26. Patent Owner argues that, “[b]ecause the Sprint IPR—as in *Regents*—arises ‘from patent infringement claims arising out of Sprint’s use of Ericsson’s LTE base stations,’ the ‘detailed indemnification provisions’ in ‘Ericsson’s supply contract with Sprint’ must make Ericsson a privy of Sprint’s in the Sprint IPR just as it was a privy with Sprint in the Regents litigation.” *Id.* at 26 (quoting Ex. 2002, 1). Petitioner disagrees, and also quoting from Exhibit 2002, argues that “Ericsson’s indemnity of Sprint, on which the Regents IPR privy finding was based, was limited to ‘infringement claims made by Plaintiff [Regents] against Ericsson base stations in [the Regents] lawsuit.’” Reply 2 (quoting Ex. 2002, 3 n.1) (alterations in original). We do not agree with Patent Owner’s argument that Exhibit 2002 evidences Ericsson’s agreement (with its “detailed indemnification provisions”) in the Regents Litigation “must make Ericsson a privy of Sprint’s in the Sprint IPR just as it was a privy with Sprint in the Regents litigation.” Prelim.

Resp. 26. As discussed above, due to the lack of evidence in the record, it would be speculation for us to find that the indemnification agreement analyzed in the Regents IPR is the same as and applies to the accused components in the Sprint Litigation.

Patent Owner does not provide evidence connected to the prior Sprint IPR or the district court litigation between General Access Solutions and Sprint that has a tendency to show that Sprint is or was in privity with Petitioner regarding the '931 patent. As such, Patent Owner is left with a mere assertion of privity, which is not enough to justify a determination that Petitioner had a full and fair opportunity to litigate the patentability of the '931 patent in the prior Sprint IPR, and is not enough to estop Petitioner from maintaining the present IPR. Accordingly, we determine that there is insufficient evidence to reasonably call into question whether Petitioner is a privy of prior petitioner Sprint. *Cf. Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1244 (Fed. Cir. 2018) (“A mere assertion that a third party is an unnamed real party in interest, without any support for that assertion, is insufficient to put the issue into dispute.”). We do not deny the Petition or the Motion for Joinder based on estoppel under § 315(e)(1). Our determinations at this stage of the proceeding merely are preliminary, and based on the evidentiary record developed thus far. *Cf. Uniloc 2017 LLC v. Facebook Inc.*, 989 F.3d 1018, 1027 (Fed. Cir. 2021) (“[T]he Section 315(e)(1)’s use of ‘maintain’ contemplates that the estoppel provision ‘governs at any stage of a subsequent proceeding before the PTO—its application is not limited to the institution stage.’”).

IV. TIME-BAR UNDER 35 U.S.C. § 315(b)

Patent Owner argues that the Petition is time-barred under 35 U.S.C. § 315(b). Prelim. Resp. 26–28. Patent Owner presents the same arguments in urging the Board to also deny Petitioner’s Motion for Joinder. Opp. 5–6.

Section 315(b) provides:

An inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent. The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).

The referenced subsection (c) of section 315 is the provision under which Petitioner has filed its Motion for Joinder. Mot. 1.

Patent Owner reiterates its argument that prior petitioner Sprint is Petitioner’s privy, and argues that, therefore, Petitioner is time-barred under § 315(b) because Sprint was served with a complaint more than a year prior to the filing of the Petition in the present case. *See* Prelim. Resp. 26–27. Patent Owner relies again, as the basis for the privity argument, on the determinations made in the Regents IPR and argues that “Ericsson must similarly be time-barred.” *Id.* We do not agree with Patent Owner. The statute provides that “[t]he time limitation set forth in [§ 315(b)] shall not apply to a request for joinder under [§ 315(c)].” 35 U.S.C. § 315(b). Because Petitioner’s Motion is a request for joinder under § 315(c), the statutory one-year time-bar does not apply.

Patent Owner next asserts that, “[a]lthough the Board has the discretion to permit a time-barred petitioner to join an IPR, ‘the existence of a time bar under 35 U.S.C. § 315(b) is one of several factors that may be considered when exercising discretion under 35 U.S.C. § 315(c),’ and the

Board ‘will do so only where fairness requires it and to avoid undue prejudice to a party.’” Prelim. Resp. 27 (quoting the Trial Practice Guide at 76–77).¹⁰ Patent Owner, however, does not explicitly argue that undue prejudice will result from granting the joinder. *See id.* at 27–28. Rather, Patent Owner argues that “[Petitioner] Ericsson has provided no reason that fairness requires it to join a petition” where its alleged privy was sued for infringement over seven years ago, that alleged privy brought an IPR, and a district court case was dismissed with prejudice. *See id.* (citing Ex. 2003, 1¹¹). We do not agree with Patent Owner’s arguments. For the reasons discussed above, Patent Owner’s assertion that Sprint is a privy of Petitioner is unsupported by evidence in the record.

Accordingly, we do not deny the Petition or the Motion for Joinder based on the time-bar of § 315(b).

¹⁰ Patent Owner’s quotation of the Trial Practice Guide omits certain important phrases. For example, the last part of Patent Owner’s assertion reads, in unedited form: “[W]hen an otherwise time-barred petitioner requests *same party and/or issue joinder*, the Board may exercise its discretion to permit joinder, but will do so only where fairness requires it and to avoid undue prejudice to a party.” Trial Practice Guide at 76–77 (emphasis added) (citing *Proppant Express Invs. v. Oren Techs.*, IPR2018-00914 at 19 (PTAB Mar. 13, 2019) (Paper 38) (de-designated as precedential July 24, 2023)). Neither same-party joinder nor the joinder of new issues is implicated in the present case.

¹¹ Although Patent Owner appears to characterize Exhibit 2003 as pertaining to “Ericsson’s District Court case,” the caption in the single-page exhibit identifies Sprint but not Ericsson as a party and does not otherwise mention Ericsson.

V. DISCRETIONARY DENIAL UNDER 35 U.S.C. § 325(d)

Patent Owner argues that we should exercise discretion under 35 U.S.C. § 325(d) to deny the Petition, applying the Board’s precedential decision in *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential) and *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (Dec. 15, 2017) (precedential as to § III.C.5, first paragraph). Prelim. Resp. 49–55.¹²

Section 325(d) provides that, in determining whether to institute an *inter partes* review, “the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d). Patent Owner argues that we should discretionarily deny the Petition because “[t]he Board and the Federal Circuit have already conducted *inter partes* review of Claims 28 and 29 of the ’931 Patent based on the Vornefeld reference and confirmed the patentability of the claims,” and, “while Ericsson now cites additional prior art references, those new references add nothing of significance to Vornefeld and the other prior art references previously considered by the Board and the Federal Circuit.” Prelim. Resp. 49.

¹² Patent Owner, in the Introduction section of the Preliminary Response, argues that “strong grounds exist here for the Board to exercise its discretion to deny the petition under 35 U.S.C. § 325(d) and *Fintiv*.” Prelim. Resp. 2–3. Although the Preliminary Response contains sections arguing for discretionary denial under § 325(d) and *General Plastic*, it does not contain a section discussing *Fintiv*. See, e.g., *id.* at ii–iii (Table of Contents, heading G). We understand the *Fintiv* reference to be an inadvertent holdover from Patent Owner’s very similar preliminary response filed in the Verizon IPR.

We, in the Verizon IPR, instituted an *inter partes* review of the '931 patent on both challenged claims and all asserted grounds of unpatentability. IPR2023-00978, Paper 20 at 54–55. In the Verizon IPR, we addressed Patent Owner's arguments that we should exercise discretion to deny institution under § 325(d), and we declined to deny institution on that basis. *Id.* at 22–27. Petitioner here represents that “[t]he instant Petition is substantially identical to the Verizon Petition; it involves the same claims of the same patent, the same grounds of unpatentability, and the same supporting evidence.” Mot. 1. Patent Owner's § 325(d) arguments in the case currently before us appear to be substantively identical to those made in the preliminary response in the Verizon IPR, with the substitution of “Ericsson” for “Verizon.” *Compare* Prelim. Resp. 49–55 with IPR2023-00978, Paper 15 at 46–53. For the same reasons set forth in our Institution Decision in the Verizon IPR, we decline to discretionarily deny institution under § 325(d) in the current case brought by Petitioner Ericsson. IPR2023-00978, Paper 20 at 22–27.

VI. DISCRETIONARY DENIAL UNDER 35 U.S.C. § 314(a)—
GENERAL PLASTIC

Patent Owner argues that, in view of the Sprint IPR, the Board should discretionarily deny institution of an *inter partes* review under 35 U.S.C. § 314(a) pursuant to *General Plastic Industries Co. Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential) (“*General Plastic*”). Prelim. Resp. 55–59. Patent Owner presents the same arguments in urging the Board to also deny Petitioner's Motion for Joinder. Opp. 7–10; *see also* Prelim. Resp. 56 (“The *General Plastic* factors weigh in

favor of exercising discretion to deny the petition *and joinder*.” (emphasis added)). For the reasons that follow, we disagree.

In *General Plastic*, the Board identified the following nonexclusive factors to consider when deciding whether to exercise discretion under § 314(a) to deny institution based on a follow-on petition:

- 1) whether the same petitioner previously filed a petition directed to the same claims of the same patent;
- 2) whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
- 3) whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition;
- 4) the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
- 5) whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
- 6) the finite resources of the Board; and
- 7) the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

General Plastic, Paper 19 at 9–10.

As to the first factor, although the two challenged dependent claims are a subset of the claims challenged previously, the current Petitioner, Ericsson, is not the same as the prior petitioner, Sprint. However, “our application of the *General Plastic* factors is not limited solely to instances when multiple petitions are filed by the same petitioner.” *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11, 9 (PTAB Apr. 2,

2019) (precedential) (“*Valve*”). “Rather, when different petitioners challenge the same patent, we consider any relationship between those petitioners when weighing the *General Plastic* factors.” *Id.*

Petitioner, referring to its arguments against Patent Owner’s § 315(e)(1) estoppel theory, contends that Patent Owner “provides no evidence to support a privity or other relationship between Sprint and Ericsson with respect to the ’931 Patent,” Reply 3, and states that “Ericsson and Sprint are not privies with respect the ’931 Patent, and Ericsson is not estopped from joining IPR2023-00978,” *id.* at 2. *See also* Pet. 3–4 (Petitioner representing: “The real parties in interest are Ericsson Inc. and Telefonaktiebolaget LM Ericsson. . . . No other parties exercised or could have exercised control over this Petition; no other parties funded or directed this Petition.”); *id.* at 4–5 (Petitioner contending that it has standing and that it is not barred from requesting this proceeding). Petitioner further contends that all of the *General Plastic* factors weigh against discretionarily denying institution and joinder. Reply 3–4.

Patent Owner argues that “[d]iscretionary denial is appropriate here given the substantial relationship between Ericsson and Sprint.” Prelim. Resp. 56. In that regard, Patent Owner, referencing its earlier assertions, argues that “the Board has already held that Ericsson is a privy of Sprint with respect to its supplied LTE base stations at issue here,” and “[t]he Board should reach the same conclusion in this matter.” *Id.* at 56–57. We do not agree with Patent Owner’s arguments at least because, for the reasons discussed above, Patent Owner’s assertion that Sprint is a privy of Petitioner is unsupported by evidence in the record. Additionally, Patent Owner does not explain adequately the basis for the implied argument that the other

Board panel, in 2020, set forth a holding regarding “LTE base stations at issue here” in 2024. *Id.* (“the Board has already held . . .”); *see* IPR2017-01186, Paper 58 (dated June 19, 2020).

Patent Owner argues in the alternative that, “[t]o the extent that the Board determines that Ericsson is not a privy of Sprint, the Board should then consider whether Ericsson nonetheless has a ‘substantial relationship’ with Sprint.” Prelim. Resp. 57 (citing potential rule changes currently under consideration). In that regard, Patent Owner argues that, “[a]s an indemnitor with financial responsibility for Sprint’s infringement, Ericsson clearly has a substantial interest in the outcome of these proceedings,” and “[t]hat overlapping interest weighs heavily in favor of discretionary denial.” *Id.*; *but see* Reply 2 (Petitioner asserting that “Ericsson’s indemnity of Sprint, on which the Regents IPR privy finding was based, was limited to ‘infringement claims made by Plaintiff [Regents] against Ericsson base stations in [the Regents] lawsuit.” (quoting Ex. 2002, 3; alterations in original)). We do not agree with Patent Owner’s argument because, as discussed above, Patent Owner has not presented evidence adequate to support its assertion that Ericsson was or is an indemnitor of Sprint because of products accused of infringing the ‘931 patent in the General Access Solution/Sprint litigation.

On the record before us, no real party in interest, privy, or otherwise legally significant relationship has been shown to exist between current Petitioner Ericsson and prior petitioner Sprint that might warrant denying a follow-on petition by a different petitioner. As such, *General Plastic* factor 1 weighs against denying institution.

“[W]here, as here, the first and second petitioners are neither the same party, nor possess a significant relationship under *Valve, General Plastic* factor one necessarily outweighs the other *General Plastic* factors.” *Videndum Prod. Sols., Inc. v. Rotolight Ltd.*, IPR2023-01218, Paper 12 at 5–6 (Vidal Apr. 19, 2024); *see id.* (“Under USPTO policy and precedent, *General Plastic* has not been extended to any cases in which the first and second petitioners *do not have* a significant relationship.”); *see also Alcatel-Lucent USA Inc. v. Oyster Optics, LLC*, IPR2017-02146, Paper 12 at 12 (PTAB Feb. 28, 2018) (non-precedential) (“Once resolution of factor 1 indicates that Petitioner had not previously filed a petition against the same patent, factors 2–5 bear little relevance unless there is evidence in the record of extenuating circumstances such as a showing that there was a previous petitioner who challenged the same patent and that the previous petitioner and the current petitioner planned the staggered petitions.”).

Even if factor one did not necessarily outweigh the other factors, we would not agree with Patent Owner’s argument that discretionary denial under *General Plastic* is appropriate. For example, for factor 2, Patent Owner argues that “[prior petitioner] Sprint and [current Petitioner] Ericsson knew or should have known of [Ericsson’s] ‘new’ art at the time of the original petition in the Sprint IPR,” Prelim. Resp. 58, but the lack of a legally significant tie between Petitioner Ericsson and the prior Sprint IPR renders Patent Owner’s argument as to Ericsson’s knowledge, at the time of filing of the first petition in 2017, merely conclusory and speculative.

Patent Owner lumps together factors 3–5 under the label “Timing,” and impliedly bases its arguments on the unpersuasive assertion of a significant relationship between the two petitioners. *See* Prelim. Resp. 58

(quoting findings from a “significant relationship” case and arguing that “[t]he same is true here”). Patent Owner argues that “Petitioner had the benefit of reviewing not only the original petition in the Sprint IPR and Patent Owner’s preliminary response, but also the Board and the Federal Circuit’s decisions before filing its petition,” and that “[t]his Petition is plainly crafted as an effort to overcome the specific deficiencies identified by the Board and the Federal Circuit.” *Id.* at 58. Under the facts of this case, we determine that the concerns underlying factor 3 are not implicated significantly. The Board, in *General Plastic*, explains:

Our intent in formulating the factors was to take undue inequities and prejudices to Patent Owner into account. Thus, factor 3 is directed to Petitioner’s potential benefit from receiving and having the opportunity to study Patent Owner’s Preliminary Response, as well as our institution decisions on the first-filed petitions, prior to its filing of follow-on petitions. . . . [W]e are concerned here by the shifts in the prior art asserted and the related arguments in follow-on petitions. Multiple, staggered petitions challenging the same patent and same claims raise the potential for abuse. The absence of any restrictions on follow-on petitions would allow petitioners the opportunity to strategically stage their prior art and arguments in multiple petitions, using our decisions as a roadmap, until a ground is found that results in the grant of review. All other factors aside, this is unfair to patent owners and is an inefficient use of the *inter partes* review process and other post-grant review processes.

General Plastic, Paper 19 at 17–18 (citation and footnote omitted). In this case, it is not the same petitioner refining arguments by filing multiple, staggered petitions. Rather, based on our understanding of the timeline, current Petitioner filed this Petition after the prior IPR and litigation against the prior petitioner, Sprint, concluded and after Patent Owner sued Petitioner in a separate action for alleged infringement of the only two claims out of

twenty-nine that survived the prior IPR. *See* Paper 6, 1 (Patent Owner’s mandatory notices indicating that the suit against Petitioner was filed in 2023 and after the filing of the Verizon suit in 2022); IPR2023-00978, Paper 13, 1 (Verizon representing that Patent Owner—about eleven months after the conclusion of the district court litigation between the prior petitioner, Sprint, and Patent Owner—sued Verizon, alleging infringement of the claims of the challenged patent.); Ex. 1001, *Inter Partes* Review Certificate for IPR2017-01889 (located at the end of the challenged patent; issued in 2021 and canceling all claims of the ’931 patent except claims 28 and 29). Patent Owner does not persuasively argue that declining to discretionarily deny institution in this case would result in undue inequities and prejudice to Patent Owner. *See* Prelim. Resp. 58 (Patent Owner simply arguing that Petitioner’s efforts to overcome deficiencies of the prior petitioner’s challenge “is precisely this sort of redo that these factors are intended to prevent”).

Patent Owner does not present specific arguments regarding factors 4 and 5, which pertain to the timing of the filing of the current Petition relative to when Petitioner learned of its asserted prior art and relative to the filing of the first petition. *See* Prelim. Resp. 58.

We determine that *General Plastic* factors 2–5 weigh against denying institution. And, even if factor 3 weighed in favor of discretionary denial, it would not change our ultimate decision to not exercise that discretion.

As to factors 6 and 7, Patent Owner argues:

With deference and respect, the Board’s finite resources should not be expended re-reviewing strikingly similar challenges by

related parties to claims previously upheld by both the Board and the Federal Circuit.

Id. at 59. In the prior IPR (the Sprint IPR), the Board and the Federal Circuit merely determined that the prior petitioner, who relied on Figure 3 of Vornefeld, had not met its burden of proving that Vornefeld disclosed the limitations of dependent claims 28 and 29. *See* Ex. 1009, 22–24 (the 2019 Final Written Decision in the prior IPR); *Sprint Spectrum L.P.*, 812 F. App’x at 1006–07. The Petition, relying on other references for those limitations, does not ask us to re-review whether Vornefeld’s Figure 3 discloses the subject matter of the challenged claims. Further, concerns about the finite resources of the Board are not implicated here because we have instituted a review in the Verizon IPR and, as represented by Petitioner, the “Petition includes identical arguments and the same grounds raised in the existing Verizon IPR proceeding.” Mot. 4–5. Additionally, “the Board’s mission to improve patent quality and restore confidence in the presumption of validity that comes with issued patents outweighs the impact on Board resources needed to evaluate the merits of a petition.” *Code200 v. Bright Data, Ltd.*, IPR2022-00861, Paper 18 at 6 (Vidal Aug. 23, 2022) (precedential) (internal quotations omitted).

Patent Owner’s arguments fail to meaningfully address factor 7, which pertains to the timing of a final determination. We do not foresee an issue in that regard, particularly where Petitioner, in moving to join the Verizon IPR, “agrees to adhere to all applicable deadlines set forth in the Verizon IPR Scheduling Order.” Mot. 6.

For these reasons, the circumstances in this case do not warrant denying, under § 314(a) and *General Plastic*, the Petition or Petitioner’s Motion to join the Verizon IPR.

VII. INSTITUTION OF *INTER PARTES* REVIEW

We instituted an *inter partes* review in the Verizon IPR on both of the challenged claims and on all asserted grounds of unpatentability.

IPR2023-00978, Paper 20 (institution decision); *see also* IPR2023-00978, Paper 2 (the “Verizon petition”). The current Petitioner, Ericsson, represents that “[t]he instant Petition is substantially identical to the Verizon Petition; it involves the same claims of the same patent, the same grounds of unpatentability, and the same supporting evidence.” Mot. 1; *see also id.* at 5 (“Ericsson’s Petition includes identical arguments and the same grounds raised in the existing Verizon IPR proceeding (*i.e.*, challenges the same claims of the same patent, relies on the same expert declaration, and is based on the same grounds and combinations of prior art submitted in the Verizon Petition).”). Patent Owner’s arguments regarding Petitioner’s grounds appear to be substantively identical to those made in the preliminary response in the Verizon IPR, with the substitution of “Ericsson” for “Verizon.” *Compare* Prelim. Resp. 23–24, 28–49 *with* IPR2023-00978, Paper 15 at 24–46. For the same reasons set forth in our Institution Decision in the Verizon IPR, we institute an *inter partes* review on all grounds raised in the Petition. IPR2023-00978, Paper 20 at 27–55.

VIII. MOTION FOR JOINDER

Joinder in an *inter partes* review is subject to the provisions of 35 U.S.C. § 315(c), which provides:

If the Director institutes an *inter partes* review, the Director, in his or her discretion, may join as a party to that *inter partes* review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for

filing such a response, determines warrants the institution of an inter partes review under section 314.

To join a petitioner to an instituted IPR, the Board first determines whether the Petition “warrants” institution under § 314. *See Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020). For the reasons discussed above, we determine that institution of *inter partes* review is warranted.

The Board next determines whether to exercise “discretion to decide whether to ‘join as a party’ the joinder applicant,” who is the Petitioner in this proceeding. *Id.* Petitioner timely filed its Motion for Joinder (i.e., no later than one month after the institution of the Verizon IPR). *See* Mot. 1; Verizon IPR, Paper 20; 37 C.F.R. § 42.122(b). Petitioner represents that “[c]ounsel for Verizon indicated that Verizon will not oppose this motion.” Mot. 2.

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). In deciding whether to join a case, we consider: (1) the reasons why joinder is appropriate, (2) whether the petition raises any new grounds of unpatentability, (3) any impact that joinder would have on the cost and trial schedule for the existing review, and (4) whether joinder will add to the complexity of briefing or discovery. *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15, 4 (PTAB Apr. 24, 2013); Trial Practice Guide at 76.

Petitioner contends that “joinder with the Verizon IPR is appropriate because Ericsson’s Petition includes identical arguments and the same grounds raised in the existing Verizon IPR proceeding (*i.e.*, challenges the same claims of the same patent, relies on the same expert declaration, and is based on the same grounds and combinations of prior art submitted in the

Verizon Petition).” Mot. 4–5. According to Petitioner, “good cause exists for joining Ericsson to the Verizon IPR proceeding so that the Board can efficiently ‘secure the just, speedy, and inexpensive resolution’ of Ericsson’s and Verizon’s petitions in a single proceeding.” *Id.* at 5 (quoting 37 C.F.R. § 42.1(b)). Petitioner also represents that it will act as an “understudy,” and that it “agrees to adhere to all applicable deadlines set forth in the Verizon IPR Scheduling Order,” and contends that, accordingly, the trial schedule should not be adversely impacted by the joinder. *Id.* at 2, 6. Petitioner further asserts that, because no new issues are being introduced by the requested joinder, “Patent Owner will . . . not be required to provide any additional analysis or arguments beyond what it will already provide in response to the petition in the Verizon IPR proceeding,” and that, because Petitioner “is introducing no additional evidence or witnesses, . . . no additional depositions will be needed.” *Id.* at 6.

Petitioner further contends that its agreement to take an understudy role will simplify briefing and discovery. *Id.* Petitioner states:

In this “understudy” role, Ericsson agrees to the following conditions upon joining the Verizon IPR proceeding (*i.e.*, IPR2023-00978) so long as Verizon remains an active party in that proceeding:

(a) Ericsson shall not make any substantive filing and shall be bound by the filings of Verizon, unless a filing

concerns termination and settlement, or issues solely involving Ericsson;

(b) Ericsson shall not present any argument or make any presentation at oral hearing on issues not solely involving Ericsson;

(c) Ericsson shall not seek to cross-examine or defend the cross-examination of any witness, unless the topic of cross-examination concerns issues solely involving Ericsson; and

(d) Ericsson shall not seek discovery from Patent Owner on issues not solely involving Ericsson.

Id. at 6–7. Petitioner further states that, “[u]nless and until the current petitioner in IPR2023-00978 ceases to participate in the instituted Verizon IPR proceeding, Ericsson will not assume an active role therein.” *Id.* at 7 (footnote omitted).

Patent Owner argues that the Motion should be denied due to estoppel under § 315(e)(1) and the § 315(b) time-bar and should be discretionarily denied due to the time-bar and under *General Plastic*. Opp. 2–10. We have addressed those arguments above, and, for the same reasons, we do not deny the Motion under either of the statutory provisions and we do not discretionarily deny the Motion.

We agree with Petitioner that joinder with the Verizon IPR is appropriate under the circumstances. Accordingly, we *grant* Petitioner’s Motion for Joinder.¹³

¹³ The Board also joined Nokia of America Corporation as a petitioner in this proceeding in IPR2024-00461. Should Verizon’s participation in this IPR proceeding terminate and if more than one petitioner remains, the remaining petitioners shall meet and confer and then advise the Board as to which one petitioner shall take over responsibility for subsequent filings and discovery. The other remaining petitioner shall continue to serve in an understudy role.

IX. ORDER

For the foregoing reasons, it is

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 28 and 29 of the '931 patent is instituted with respect to all grounds of unpatentability set forth in the Petition;

FURTHER ORDERED that, pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122, Petitioner's Motion for Joinder is granted, and Petitioner is joined as a petitioner in IPR2023-00978, subject to the above-described limitations on Petitioner's participation in that proceeding;

FURTHER ORDERED that the asserted grounds of unpatentability on which the Board instituted *inter partes* review in IPR2023-00978 are unchanged and remain the only instituted grounds;

FURTHER ORDERED that the Scheduling Order in IPR2023-00978, and any modifications thereto, shall govern the schedule of the proceeding;

FURTHER ORDERED that all further filings are to be made in IPR2023-00978;

FURTHER ORDERED that the case caption in IPR2023-00978 for all further submissions shall be modified in a manner consistent with the example included below; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record in IPR2023-00978.

IPR2024-00392
Patent 7,230,931 B2

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[Sample Case Caption]

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CELLCO PARTNERSHIP D/B/A VERIZON WIRELESS,
Petitioner,

v.

GENERAL ACCESS SOLUTIONS, LTD.,
Patent Owner.

IPR2023-00978¹
Patent 7,230,931 B2

¹ The Board joined Ericsson Inc. and Nokia of America Corporation as petitioners in this proceeding in IPR2024-00392 and IPR2024-00461, respectively.