

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UBIQUITI INC.
Petitioner

v.

XR COMMUNICATIONS, LLC D/B/A VIVATO TECH
Patent Owner

Inter Partes Review No. IPR2024-00148
Patent No. 10,594,376

**PETITIONER'S MOTION FOR LEAVE TO FILE MOTION TO
REOPEN IPR2022-00613**

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I. RELIEF REQUESTED

Pursuant to 37 C.F.R. § 41.121(a)(3), Petitioner Ubiquiti Inc. (“Petitioner” or “Ubiquiti”) moves for leave and respectfully requests that it be permitted to file a motion to reopen IPR2022-00613, the *inter partes* review (“IPR”) of U.S. Patent No. 10,594,376 (the ’376 patent) previously instituted by the Patent Trial and Appeal Board (“Board”).

XR has conducted a years-long campaign to assert invalid and unpatentable claims against Ubiquiti and other defendants across the country. The asserted claims of three different patents have been invalidated in court or held unpatentable in IPRs. At the eleventh hour, XR orchestrated the termination of the IPR2022-00613 proceeding just before the Board was set to issue a final written decision on the ’376 Patent by settling with the petitioners in the proceeding. The Board should revive the IPR for the reasons set forth below and bring an end to XR’s endless scheme of asserting baseless claims.

II. STATEMENT OF RELEVANT FACTS

On March 3, 2022, Samsung, Google, and Cisco (collectively, the “Samsung Petitioners”) filed a petition for *inter partes* review challenging claims 1-34 of the ’376 patent. *See Samsung et al. v. XR Communications, LLC*, IPR2022-00613, Paper 5. In that petition, the Samsung Petitioners listed the below district court

litigation as known related matters. The Board instituted trial in the IPR2022-00613 proceeding on October 20, 2022. *See* IPR2022-00613, Paper 12.

Parties	Docket	District	Filing Date
<i>XR Communications, LLC v. Aruba Networks, LLC</i>	2:21-cv-04912	Central District of California	June 16, 2021
<i>XR Communications, LLC v. Belkin International, Inc.</i>	2:21-cv-4914	Central District of California	June 16, 2021
<i>XR Communications, LLC v. Netgear, Inc.</i>	2:21-cv-4942	Central District of California	June 16, 2021
<i>XR Communications, LLC v. D-Link Systems, Inc.</i>	8:21-cv-01063	Central District of California	June 16, 2021
<i>XR Communications, LLC v. Netgear, Inc.</i>	8:21-cv-1064	Central District of California	June 16, 2021
<i>XR Communications, LLC v. Ubiquiti Networks, Inc.</i>	8:21-cv-1065	Central District of California	June 16, 2021
<i>XR Communications, LLC v. Amazon.com, Inc. et al.</i>	6:21-cv-619	Western District of Texas	June 16, 2021
<i>XR Communications, LLC v. ASUSTeK Computer Inc.</i>	6:21-cv-622	Western District of Texas	June 16, 2021
<i>XR Communications, LLC v. Cisco Systems, Inc. et al.</i>	6:21-cv-623	Western District of Texas	June 16, 2021
<i>XR Communications, LLC v. Google LLC</i>	6:21-cv-625	Western District of Texas	June 16, 2021
<i>XR Communications, LLC v. Samsung Electronics Co., Ltd. et al.</i>	6:21-cv-626	Western District of Texas	June 16, 2021

In light of the Board’s decision to institute *inter partes* review of the ’376 patent, the district court in *XR Communications, LLC v. D-Link Systems*, No. 8:17-

cv-00596 (C.D. Cal.) stayed its proceedings.¹ *See* EX-1034 (Order Granting Motion to Stay).

In November 2022, Eero LLC filed a petition for *inter partes* review of the '376 patent (IPR2023-00174) and a motion to join the IPR2023-00174 proceeding with the IPR2022-00613 proceeding. Netgear and Aruba also filed a petition for *inter partes* review of U.S. Patent No. 10,594,376 (IPR2023-00136) and a motion for joinder of the IPR2023-00136 proceeding with the IPR2022-00613 proceeding. Both petitions were substantively identical to the petition in IPR2022-00613.

On May 22, 2023, the Board joined both proceedings with IPR2022-00613, and ordered all further filings to be made in IPR2022-00613. *See* IPR2022-00613, Papers 7 and 8. Oral hearing was held on July 20, 2023. Between June and September 2023, various petitioners reached settlement agreements with XR. *See* IPR2022-00613, Papers 29, 37, and 49.

On September 29, 2023, XR and Netgear, the final petitioner in IPR2022-00613, filed a joint motion to terminate the IPR proceeding after reaching a settlement agreement. *See* IPR2022-00613, Paper 49. This was just three weeks prior to the Board's statutory due date for entering a final written decision on

¹ On June 28, 2021, all the listed actions in the Central District of California, including the case against Ubiquiti, were consolidated into a lead case, *XR Communications, LLC v. D-Link Systems*, No. 8:17-cv-00596 (C.D. Cal.).

October 20, 2023. *See* 35 U.S.C. § 316(a)(11). On October 3, 2023, the Board terminated IPR2022-00613. *See* IPR2022-00613, Paper 52.

Ubiquiti is filing concurrently with this motion: a petition for *inter partes* review of the '376 patent (IPR2024-00148) on the same grounds raised by the earlier petition in IPR2022-00613, on which the Board rendered its Decision to Institute *Inter Partes* Review; a motion for extension of time to file a motion for joinder; and a motion for joinder of the petition with IPR2022-00613.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

In its October 3, 2023 decision terminating IPR2022-00613, the Board notes that XR and the petitioners in IPR2022-00613 had stated that “that the pending District Court litigation between them involving the '376 patent has been dismissed.” *See* IPR2022-00613, Paper 52 at 3. However, there are other ongoing claims involving the '376 patent in at least two district court cases, which the Board previously acknowledged as related matters. *See* IPR2022-00613, Paper 12 at 2-3. In *XR Communications, LLC v. D-Link Systems*, No. 8:17-cv-00596 (C.D. Cal.), XR’s claims against Ubiquiti and Belkin International, Inc., alleging infringement of the '376 patent, remain pending. Likewise, in *XR Communications LLC v. ASUSTeK Computer Inc.*, in 6:21-cv-00622, XR’s infringement claims involving the '376 patent remain pending. The Board can enable “the just, speedy, and inexpensive resolution of” multiple disputes relating to the '376 patent by reopening

IPR2022-00613 and allowing Ubiquiti to join the proceeding. *See LaRose Indus. v. Capriola Corp.*, IPR2013-00121, Paper 11 at 24.

The interests of justice warrant the Board to consider Ubiquiti's request to reopen IPR2022-00613. 37 C.F.R. § 42.5(c). Although XR and other industry participants have settled their claims, there remains a strong public interest in resolving doubts about the validity of the '376 patent at an administrative level. *Perkins v. Kwon*, 886 F.2d 325, 329 (Fed. Cir. 1989) ("The public interest in the benefits of a patent system is best met by procedures that resolve administratively questions affecting patent validity."). The Board's skepticism of the patent's validity was warranted at the time it instituted *inter partes* review of the '376 patent, and is warranted today.

Finally, the record in IPR2022-00613 was fully developed and "the public's interest in the status of the challenged . . . patent is at its peak." *See Rubicon Comms v. Lego*, IPR2016-01187, Paper 100 (PTAB Dec. 14, 2017). XR and Petitioner Netgear filed their motion to terminate IPR2022-00613 due to settlement on September 29, 2023 (Paper 49), two months after oral hearing was held and three weeks prior to the statutory due date to enter a final written decision. *See* 35 U.S.C. § 316(a)(11). In other cases at this stage, the Board has declined to terminate an IPR proceeding despite the joint request of the parties that have reached a settlement. *See e.g. Rubicon Comms v. Lego*, IPR2016-01187, Paper 100 (PTAB Dec. 14, 2017) (denying a joint

termination request that came “very near the conclusion of the proceeding,” after all briefing had been completed and about two months after the oral hearing); *Apple Inc. v. OpenTV, Inc.*, IPR2015-00969, slip op. at 4–5 (PTAB Sept. 10, 2016) (Paper 29); *see also Apple, Inc. v. Smartflash LLC*, Case CBM2015-00015, slip op. at 6 (PTAB Nov. 4, 2015) (Paper 49) (“There is a public interest in resolving the issues raised by these challenges because the record is fully developed.”).

As discussed above, several industry participants remain in litigation with XR over the alleged infringement of the ’376 patent. The reopening of IPR2022-00613 would enable the just and efficient resolution of multiple disputes. XR, which has already had numerous patents and claims invalidated in court or cancelled or amended in whole or in part over the course of the past *six years*,² should not be able to obviate the Board’s review of the ’376 patent—which was very nearly complete

² For example, ten claims in U.S. Patent No. 6,611,231 were invalidated in the U.S. District Court for the Northern District of California, affirmed by the Federal Circuit. *See XR Commc'ns v. D-Link Sys.*, No. 2022-1785 (Fed. Cir. May 18, 2023). 17 claims of U.S. Patent No. 7,062,296 were found unpatentable in a final written decision in IPR issued on October 10, 2019. *See Ruckus Wireless, Inc. et al v. XR Communications, LLC*, IPR2018-01017, Paper 44 at 77. The asserted claim of U.S. Patent No. 7,729,728 was found unpatentable in IPR (*Ruckus Wireless, Inc. et al v. XR Communications, LLC*, IPR2018-01018, Paper 39 (Nov. 12, 2019) at 56) before XR filed new asserted claims of the same patent in a new lawsuit and then dismissed the newly asserted claims against Ubiquiti with prejudice in July 2022, along with ten asserted claims of the ’376 patent. *See XR Communications, LLC v. D-Link Systems*, No. 8:17-cv-00596 (C.D. Cal.), ECF No. 376.

after lengthy, extensive substantive proceedings—by settling with the original petitioners, further prolonging multiple district court proceedings in multiple states.

IV. CONCLUSION

For all of these reasons, Ubiquiti respectfully requests that it be granted leave to file a motion for the Board to reopen IPR2022-00613.

Dated: November 10, 2023

Respectfully submitted,

By: /s/ Bo “Bryan” Jin
Bo “Bryan” Jin (Reg. No. 80,983)
2745 Hanover Street
Palo Alto, CA 94304
Simpson Thacher & Bartlett LLP
Telephone: 650-251-5000
Fax: 650-251-5002
Email: bryan.jin@stblaw.com

Jonathan C. Sanders
Simpson Thacher & Bartlett LLP
Telephone: 650-251-5000
Fax: 650-251-5002
Email: jsanders@stblaw.com

Attorneys for Petitioner
UBIQUITI INC.

CERTIFICATE OF SERVICE

I certify that on November 10, 2023, I caused a true and correct copy of the foregoing Motion For Leave To File Motion To Reopen IPR2022-00613 to be served via overnight delivery on the Patent Owner at the following correspondence address of record as listed on PAIR:

XR Communications, LLC
C/O Farjami & Farjami LLP
26522 La Alameda Ave., Suite 360
Mission Viejo, CA 92691
(949) 282-1000

A courtesy copy was also sent via electronic mail to the Patent Owner's litigation counsel listed below:

Reza Mirzaie
Russ, August & Kabat
12424 Wilshire Boulevard, 12th Floor
Los Angeles, CA 90025
rmirzaie@raklaw.com

Dated: November 10, 2023

Respectfully submitted,

By: /s/ Bo "Bryan" Jin
Bo "Bryan" Jin (Reg. No. 80,983)
2745 Hanover Street
Palo Alto, CA 94304
Simpson Thacher & Bartlett LLP
Telephone: 650-251-5000
Fax: 650-251-5002
Email: bryan.jin@stblaw.com

Jonathan C. Sanders
Simpson Thacher & Bartlett LLP
Telephone: 650-251-5000
Fax: 650-251-5002
Email: jsanders@stblaw.com

Attorneys for Petitioner
UBIQUITI INC.