

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 JOINDER OF PROCEEDINGS

TABLE OF CONTENTS

	Page
I. STATEMENT OF RELIEF REQUESTED	1
II. BACKGROUND AND RELATED PROCEEDINGS	1
III. STATEMENT OF REASONS FOR RELIEF REQUESTED	5
A. Joinder is Authorized	6
B. Legal Standard.....	6
C. The <i>Kyocera</i> Factors Favor Joinder	7
1. Joinder Is Appropriate And In The Interest Of Justice.....	7
2. Instant Petition Proposes No New Grounds Of Unpatentability	9
3. Joinder Will Not Unduly Burden The Patent Owner Or Concurrent Proceedings.	10
IV. CONCLUSION.....	11

I. STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c), Petitioner Ubiquiti Inc. (“Petitioner” or “Ubiquiti”) respectfully requests that the Board join this proceeding (IPR2024-00148) to IPR proceeding IPR2022-00613, both of which concern U.S. Patent No. 10,594,376 (the ’376 patent) and the same grounds of invalidity.

Ubiquiti is filing this motion for joinder concurrently with a motion for leave to file a motion to reopen IPR2022-00613, a petition for *inter partes* review of the ’376 patent (the “instant Petition”) in IPR2024-00148, and a motion to waive the time limit for filing a motion for joinder set forth in 37 C.F.R. § 42.122(b).

II. BACKGROUND AND RELATED PROCEEDINGS

On June 16, 2021, XR Communications, LLC (“XR”) filed suit against Ubiquiti in the Central District of California (Case No. 8:21-cv-01065), alleging infringement of the ’376 patent. Around the same time, XR also filed separate actions alleging infringement of the ’376 patent by other industry participants in the Central District of California and in the Western District of Texas, as summarized by the table below.

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

Prior to lawsuits asserting the '376 patent, XR had filed similar patent infringement suits against Ubiquiti (Case No. Case 2:17-cv-02968) and other industry participants in 2017. The various 2017 actions filed by XR were consolidated in *XR Communications, LLC v. D-Link Systems*, No. 8:17-cv-00596 (C.D. Cal.).¹ In particular, XR's 2017 action against Ubiquiti alleged infringement of U.S. Patent Nos. 7,062,296, 7,729,728, and 6,611,231, each of which have been

¹ The 2017 actions that were consolidated with *XR Communications, LLC v. D-Link Systems*, No. 8:17-cv-00596 (C.D. Cal.) included XR's actions against NEWO Corporation (Case No. 5:17-cv-00744); Cisco Systems Inc. (Case No. 2:17-cv-02951); ASUS Computer International and ASUSTek Computer Inc. (Case No. 2:17-cv-02948); Belkin International, Inc. (Case No. 8:17-cv-00674); NetGear, Inc. (Case No. 2:17-cv-02959); Extreme Networks, Inc. (Case No. 2:17-cv-02953); Aruba Networks, Inc. (Case No. 2:17-cv-02945); and Ubiquiti, Inc. (Case No. Case 2:17-cv-02968).

challenged and invalidated.² All the actions filed by XR concerning the '376 patent in the Central District of California in 2021, including the case against Ubiquiti, were also consolidated into *XR Communications, LLC v. D-Link Systems*, No. 8:17-cv-00596 (C.D. Cal.) on June 28, 2021.

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. The Board instituted trial in the IPR2022-00613 proceeding on October 20, 2022. IPR2022-00613, Paper 12. 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. *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

² The asserted 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). The asserted 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.

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 three weeks prior to the Board's statutory due date for entering a final written decision on 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. In the order terminating IPR2022-00613, the Board notes that "the Parties state that the pending District Court litigation between them involving the '376 patent has been dismissed." *See id.* 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.*, No. 6:21-cv-00622 (W.D. Tex.), XR's infringement claims involving the '376 patent remain pending. In light of these ongoing litigations, Ubiquiti respectfully requests that the Board reopen the IPR2022-00613 proceeding and permit Ubiquiti to join the proceeding to enable a just and efficient resolution and bring an end to XR's endless campaign of asserting invalid and unpatentable claims.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

Ubiquiti respectfully requests that the Board exercise its discretion and grant joinder of the instant Petition and the IPR2022-00613 proceeding. Ubiquiti submits that joinder of its petition for *inter partes* review in IPR2024-00148 with the IPR2022-00613 proceeding is warranted. *See Motorola Mobility LLC v. Softview, LLC*, IPR2013-00256, Paper 10 at 5 (PTAB June 20, 2013). Joinder is proper under the statutory design of *inter partes* review, and in this case will not increase the number of issues before the Board, as the grounds upon which Ubiquiti seeks review of the '376 patent in the instant Petition are the same as those upon which the Board has already instituted review in IPR2022-00613, and are the

same as those raised in oral hearing on July 20, 2023. The Board should therefore order joinder of Ubiquiti's instant Petition in IPR2024-00148 with IPR2022-00613.

A. Joinder is Authorized

The Board is authorized to join these proceedings pursuant to 35 U.S.C. § 315(c). *See Motorola Mobility LLC v. Softview, LLC*, IPR2013-00256, Paper 10 at 3. Although Ubiquiti was served with a complaint for infringement of the '376 patent more than 12 months prior to the date it has submitted its petition, §§ 315(b) and (c) authorize the Board to institute trial on the basis of Ubiquiti's petition because it is accompanied by a motion for joinder. *Dell v. Network-1 Security Solutions, Inc.*, IPR2013-00385, Paper 17 at 5 (PTAB July 29, 2013) ("The one-year bar, therefore, does not apply to [Petitioner] because it filed a motion for joinder with its Petition.").

B. Legal Standard

"A motion for joinder should: set forth the reasons joinder is appropriate; identify any new grounds of unpatentability asserted in the petition; and explain what impact (if any) joinder would have on the trial schedule for the existing review." *Hyundai Motor Am. V. Stratosaudio, Inc.*, IPR2022-00224, Paper 11 at 7 (PTAB June 2, 2022) (citing *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013)).

C. The *Kyocera* Factors Favor Joinder**1. Joinder Is Appropriate And In The Interest Of Justice**

Joinder with the IPR2022-00613 is appropriate because the instant Petition is substantively identical to the petition in IPR2022-00613; it involves the same patent, challenges the same claims, and is based on the same grounds and evidence relied upon in IPR2022-00613 petition. The instant Petition would “not present new issues that might complicate or delay” the IPR2022-00613 proceeding which is near its conclusion. *See Enzymotec Ltd. v. Neptune Techs & Bioresources, Inc.*, IPR2014-00556, Paper 19 at 6 (July 9, 2014) (“we are mindful of a policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding”).

Granting the present motion will further the interests of justice because it will provide for an administrative resolution of the patentability of claims 1-34 of the '376 patent. *See* 37 C.F.R. § 42.5(b)(3). “The public interest in the benefits of a patent system is best met by procedures that resolve administratively questions affecting patent validity.” *Perkins v. Kwon*, 886 F.2d 325, 329 (Fed. Cir. 1989).

In instituting trial in IPR2022-00613, the Board found, on the basis of the evidence and arguments presented in the petition filed in IPR2022-00613, that there was “a reasonable likelihood” that the petitioners would prevail in

challenging the patentability of certain claims of the '376 patent. IPR2022-00613, Paper 12 at 39.

The fact that the Samsung Petitioners and other litigants and XR have settled their disputes does not address the patentability of the '376 patent. There remains a strong public interest in resolving doubts about the patentability of the claims of the '376 patent via an *inter partes* review notwithstanding the settlement agreements that XR has reached. In particular, XR continues to allege that Ubiquiti and other industry participants have infringed on the '376 patent. In fact, the Board recognized in its order instituting *inter partes* review in IPR2022-00613 that there were numerous ongoing litigations related to the '376 patent in district courts in California and Texas. IPR2022-00613, Paper No. 12 at 2-3.

The existence of continued litigation involving the '376 patent is a highly pertinent fact in considering the interests of justice. Indeed, the Board routinely considers whether there are other proceedings involving the same patent and unrelated parties in making determinations to terminate a trial after institution. *See, e.g., Macauto v. BOS GmbH & KG*, IPR2012-00004, Paper 23 at 2 (Feb. 20, 2013) (termination warranted where the parties “represented that no other actions [we]re pending.”); *Vestcom Int’l v. Grandville Printing Co.*, IPR2013-00031, Paper 27 at 2

(May 6, 2013) (terminating proceedings where “parties have not identified any other related matters.”).

Here, the interests of justice and administrative efficiency would be furthered by allowing the *inter partes* review in IPR2022-00613, which the Board has already found to be fully warranted and in which oral hearing has already been held, to reopen and proceed. And because this is best accomplished by allowing Ubiquiti to join in this *inter partes* review and pursue a final decision from the Board, it follows that the interests of justice are best served by granting Ubiquiti’s motion for joinder with the IPR2022-00613 proceeding. The IPR was nearly complete, and XR contrived a termination just before the Board was set to issue its final written decision. Under these circumstances, public policy strongly favors the Board’s substantive review of the patentability of XR’s claims.

2. Instant Petition Proposes No New Grounds Of Unpatentability

The instant Petition does not present any new grounds or arguments regarding unpatentability. It is substantively identical to the Petition filed in IPR2022-00613. The Board “routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding.” *BlackBerry Corp. v. Uniloc 2017 LLC*, IPR2019-01283, Paper 10 at 8 (PTAB Nov. 5, 2019). This factor thus favors joinder.

3. Joinder Will Not Unduly Burden The Patent Owner Or Concurrent Proceedings.

Joinder will not unduly burden XR because the instant Petition presents the same grounds and arguments as the Petition in IPR2022-00613. In other words, there are no new issues for Patent Owner to address. *See Sony Corp. v. Memory Integrity, LLC*, IPR2015-01353, Paper 11 at 6 (PTAB Oct. 15, 2015) (granting motion for joinder and instituting IPR where “joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR]”).

Likewise, joinder does not negatively impact the schedule in IPR2022-00613 proceeding, where the Board had already held oral hearing and the proceeding was near its conclusion. Indeed, when the parties filed their motion to terminate IPR2022-00613 due to settlement on September 29, 2023 (Paper 49), that was just three weeks prior to the statutory due date to enter a final written decision. *See* 35 U.S.C. § 316(a)(11). The record was fully developed and “the public’s interest in the status of the challenged . . . patent is at its peak.” *Rubicon Comms v. Lego*, IPR2016-01187, Paper 100 at 2 (PTAB Dec. 14, 2017). In some cases at this stage, the Board has even declined to terminate an IPR proceeding despite the joint request of the parties that have reached a settlement. *See id.* (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., Case 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.”).

IV. CONCLUSION

For the foregoing reasons, Petitioner respectfully submits that joinder is warranted between this proceeding IPR2024-00148 and 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 Joinder 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 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.